



PATENTS ACT 1977

BETWEEN

Janson Betonware B.V.

Claimant

And

Ian Robbie Christie

Defendant

PROCEEDINGS

Reference under section 72 of the Patents Act 1977 in respect of GB2414745 B

HEARING OFFICER

P R Slater

PRELIMINARY DECISION

- 1 These proceedings relate to a reference under section 72 of the Patents Act 1977 filed on 22 March 2013 by Janson Betonware B.V. (“the claimant”) in respect of GB2414745 B (“the patent”). The patent was filed in the name of Ian Robbie Christie (“the defendant”) on 4 June 2004 and was granted on 15 August 2007.
- 2 The invention relates to the so-called “*EUROBLOCK*”, a self-interlocking building block manufactured primarily from a mix of concrete sand and cement, as well as elastomer and thermoplastics for use in creating flood prevention barriers.
- 3 The claimant’s original statement of grounds filed 22 March 2013 was subsequently amended on 30 May 2013 to take account of post grant amendments which had been made to the specification. The defendant’s counterstatement was filed on 16 August 2013.
- 4 On 18 December 2013, the claimant’s filed a further amended statement of grounds (“*the re-amended statement*”) together with their evidence-in-chief. The re-amended statement introduced a further ground for revocation that of prior public use of a building block called the “Legioblock” which had allegedly been manufactured and sold by Janson Betonware B.V. prior to the filing of the patent in June 2004.
- 5 The claimant’s arguments as to why I should allow the amendments to be made are set out in their letters of 18 December 2013 and 24 March 2014 respectively. Whilst they acknowledge that the introduction of this new ground represents a significant change to their pleadings, they argue that the evidence was only drawn to their

attention shortly before the re-amended statement was filed on the 18 December 2013, and that the “*Legioblock*” is almost identical to that shown in the patent.

- 6 The defendants have objected to this and have asked me to refuse the amendment. Alternatively, they have asked me to consider “*striking-out*” certain aspects of the statement of grounds or to provide “*summary judgment*” on the basis that the claimant has provided nothing by way of verifiable evidence. The defendant’s objections are dealt with in some detail in their letter dated 3 April 2014 and the accompanying counterstatement.
- 7 I would like to add, that I am grateful to the defendant, Mr Christie for having highlighted certain inconsistencies in the claimant’s evidence-in-chief. Whilst I have already indicated in the Official letter dated 14 April 2014 that I do not intend to deal with these issues here, they will need to be addressed before the case proceeds to substantive Hearing.
- 8 Both parties have indicated that they were prepared for this matter to be decided on the basis of the papers without the need for a formal hearing.
- 9 A request to amend a statement of grounds is a matter for the comptroller’s discretion. In exercising that discretion what matters is the overriding principle to deal with the case justly.
- 10 In *Cobbold v London Borough of Greenwich* (Court of Appeal, 9 August 1999, unreported) Peter Gibson L J considered the approach that should be adopted under the Civil Procedure Rules 1998 to requests to amend (see paragraph 17.3.5 of “Civil Procedure”):

“The overriding objective is that the court should deal with cases justly. That includes, so far as practicable, ensuring that each case is dealt with not only expeditiously but also fairly. Amendments in general ought to be allowed so that the real dispute between the parties can be adjudicated upon provided that any prejudice to the other party or parties caused by the amendment can be compensated for in costs, and the public interest in the efficient administration of justice is not significantly harmed.”
- 11 In considering the arguments put forward by the parties, it seems to me that I will need to take into account the substance of the amendment, the diligence of the claimant, the extent to which the amendment might disadvantage or prejudice the defendant, and the more general question of public interest.
- 12 I have no doubt in my mind, that there is a degree of similarity between the “*Legioblock*” and that which is the subject of the granted patent which cannot be ignored and is clearly relevant when determining whether the patent is valid or should be revoked.
- 13 Was the claimant diligent in their actions? Whilst it is true to say that the claimant’s actions have resulted in the hearing date having had to be postponed, I do not think the filing of the re-amended statement on 18 December 2013 was unreasonable given that evidence of prior-use had only recently been brought to the claimant’s attention.

- 14 Would the defendant be subject to any significant disadvantage should I allow the proposed amendments? It is inevitable that the application to amend the statement will cause the defendant some inconvenience and additional cost. However, I am not persuaded that the defendant would be disadvantaged to such an extent that would justify refusal on these grounds alone. Any additional costs and where appropriate compensation can be dealt with when assessing costs following the hearing.
- 15 I do not think I need to say very much on the question of public interest, other than that it is clearly in the public interest for these proceedings to be taken forward to a conclusion with all relevant issues taken into account.
- 16 In my summary then, I find that the proposed amendments have bearing on the validity of the patent, that the public interest would be best served by taking these proceedings forward to a conclusion with all relevant issues taken into account and that the defendant would not be significantly disadvantaged thereby. I conclude therefore that in order to deal with this case in a just fashion, the comptroller's discretion should be exercised in favour of the claimant and that the proposed amendments to the statement should be allowed,
- 17 Would it be appropriate for me to have certain aspects of the statement "*struck-out*" at this stage or to provide "*summary judgment*" in relation to any aspects of the case. Here the relevant law is summarised in paragraphs 2.69-2.71 of the Patent Hearings Manual as follows:

2.69 A party may apply to the comptroller to have another party's statement of case struck out either in part or in its entirety. Any application for striking out should identify precisely what is to be struck out and the grounds on which this is sought.

2.70...

*2.71 The summary procedure of striking out should be used sparingly. In line with the principles set out in rule 3.4 of the Civil Procedure Rules 1998, it may be used to strike out something which discloses no reasonable grounds for bringing or defending the claim, although often amendment of the pleadings will be more appropriate than striking out. It may also be used when there has been abuse of process, or a failure to comply with any rule or with an order of the comptroller. (For examples of striking out, see *Justwise Group Ltd v Magis S.p.A* BL O/126/05 and *Aleshin v Sony United Kingdom Ltd* BL O/056/05; in *Justwise* a reference under section 246(1) of the Copyright, Designs and Patents Act 1988 was struck out because there was in fact no dispute on any of the matters covered by that section.) The comptroller also has the power, in line with rule 24.2 of the Civil Procedure Rules 1998, to give summary judgment against either party on a claim or on a particular issue where it is clear (without conducting a "mini-trial") that there is no real prospect of success or no other compelling reason for a trial - see *Entertainments UK Ltd's Patent [2002] RPC 11*. This overlaps with the power to strike out (see 'Civil Procedure' at 3.4.6), and should likewise be used sparingly. For instance in *Entertainments*, where success of the pleaded case was improbable as it stood but not impossible, the hearing officer declined to dismiss the case without first giving the claimant an opportunity to submit a revised statement. It should be borne in mind that a summary judgment will create an estoppel in respect of future proceedings (see Chapter 1), but striking out will not - see *Robert Price v Elf Print Media Ltd*, Patents Court 1 February 2001 (unreported)."*

- 18 I think it is important from the outset to emphasise that the provision to strike out a claim in part or in its entirety is one which is to be used *sparingly*, and that I must have no doubt in my mind that there is no reasonable grounds for bringing such a claim in the first place before I can make any order in this respect. Furthermore, I can only give summary judgment in the clearest of possible cases where there is no real prospect of success or no other compelling reason for a trial, *Entertainments UK Ltd's Patent* makes that quite clear.
- 19 Having considered all the evidence before me, particularly that which has been introduced relating to the "*Legioblock*", which prima-facie bears some resemblance to that shown in the patent, I do not think the claim to be an unreasonable one. Although, as I have said there needs to be some clarification of the evidence before the Hearing. I therefore think that it would be inappropriate for me to have this claim struck out, as there is clearly a matter here subject to debate, and I can see no compelling reason why this should not proceed to trial. Furthermore, I cannot at this time say with any certainty that the claimant has no real prospect of success sufficient for me to issue a summary judgment. Indeed, this is a case where cross-examination of the witnesses may play an important role in deciding the dispute.

Conclusion

- 20 In summary, I have decided that in order to deal with this case in a just fashion, the comptroller's discretion should be exercised in favour of the claimant and that the proposed amendments to the statement of grounds should be allowed, I make no order in respect of striking out any part of the claimant's case nor do I think it appropriate, at this point in the proceedings, for me to deliver a summary judgment in relation to any aspects of the case.
- 21 Further directions regarding the filing of evidence including the timetable and proposed date for the Hearing will be issued in due course by the case officer.

Costs

- 22 Whilst the comptroller has discretion to award costs at any point in the proceedings, I do not think it is appropriate for me to do so at this time. However, I acknowledge that my decision to allow the amendments may well give rise to additional costs on the defendants part and that this is something which should be borne in mind when determining costs following the substantive hearing. I therefore defer consideration of costs to a later date in the proceedings.

Appeal

- 23 Any appeal must be lodged within 28 days

P R SLATER

Deputy Director acting for the Comptroller