



**PATENTS ACT 1977**

PROPRIETOR Cisco Technology Inc.

ISSUE Whether Patent Number GB 2 386 032 B should be  
revoked under Section 73(2)

HEARING OFFICER Stephen Probert

Hearing date: Decision off papers

**DECISION**

1. An official letter dated 14<sup>th</sup> November 2013 reported that the above UK patent appeared to be for the same invention as European patent (UK) 1 481 511 B1 and that revocation of the GB patent under Section 73(2) might therefore be necessary. The proprietor submitted observations dated 18<sup>th</sup> December 2013. These were considered by the Examiner, but he was still of the opinion that the patents were for the same invention. A hearing was therefore offered in an official letter dated 22<sup>nd</sup> May 2014, but the proprietor has not asked to be heard.
2. The first claim of the GB patent and the EP(UK) patent, with the differences highlighted in red and blue text, are as follows:-

**GB 2 386 032 B**

1. A method of estimating **the effect of a modification of a** communications network, the network comprising a plurality of nodes being interconnected by links, the method comprising the steps of
  - (a) obtaining **data indicative of traffic going** through said nodes and/or links as input data;

**EP(UK) 1 481 511 B1**

1. A method of estimating **traffic values or intervals in** a communications network, the network comprising a plurality of nodes being interconnected by links, the method comprising the steps of:
  - (a) obtaining **traffic data** through said nodes and/or links as input data;

- (b) correcting said input traffic data if inconsistencies are detected;
- (c) obtaining network data relating to the network topology and network behaviour; and
- (d) estimating the effect of a modification of said communications network and/or its behaviour by calculating traffic information between a selected first and a selected second node of said network using said input data and said network data.

- (b) correcting said input traffic data if inconsistencies are detected;
- (c) obtaining network data relating to the network topology and network behaviour; and
- (d) estimating the effect of a modification of said communications network and/or its behaviour by calculating traffic information between a selected first and a selected second node of said network using said input data.

3. The GB patent also has a further independent claim (13) directed to a method of modifying a communications network. There is no equivalent claim in the EP(UK) patent. To allow easy comparison, I have reproduced claims 1 and 13 of the GB patent side by side:-

1. A method of **estimating the effect of a modification of a** communications network, the network comprising a plurality of nodes being interconnected by links, the method comprising the steps of

- (a) obtaining data indicative of traffic going through said nodes and/or links as input data;
- (b) correcting said input traffic data if inconsistencies are detected;
- (c) obtaining network data relating to the network topology and network behaviour; and
- (d) **estimating the effect of a modification of said communications network and/or its behaviour by calculating traffic information between a selected first and a selected second node of said network using said input data and said network data.**

13. A method of **modifying** a communications network, the network comprising a plurality of nodes being interconnected by links, the method comprising the steps of

- (a) obtaining data indicative of traffic going through said nodes and/or links as input data;
- (b) correcting said input traffic data if inconsistencies are detected;
- (c) obtaining network data relating to the network topology and network behaviour; and
- (d) **automatically selecting promising candidates for a network modification by calculating a cumulated flow using said traffic and network data, wherein the candidates are selected according to predefined selection criteria.**

5. In their A/L of 18<sup>th</sup> December 2013, the proprietor points out that the single independent claim of the EP(UK) patent does not recite using the network data (as well as the input data) and does not have a claim to a method of modifying a communication network. On this basis, the proprietor submits that the two patents are not directed to the same invention, and that consequently the GB patent should not be revoked.
6. In a response from the office dated 12<sup>th</sup> March 2014, the examiner accepts that the preamble of claim 1 of each patent is different, but observes that the steps required by claim 1 in each case are fundamentally the same. In particular, he reports that they both involve obtaining and correcting traffic data, obtaining network data and *'estimating the effect of a modification of the said communications network and/or its behaviour'*.
7. Commenting on the fact that claim 1 of the EP patent does not recite using the network data, the examiner takes the view that this omission renders the claim unclear and unsupported. Since claim 1 of the EP patent clearly involves obtaining the network data, the use of that data must be implied since it is not explicitly mentioned. Moreover, he says that use of the network data is necessary in order to perform the invention as described.
8. I make no comment myself on the issues of clarity and support in respect of claim 1 of the EP patent, but I do agree that *use* of the network data in the method of the invention must be implied. There would be no point obtaining the network data if it was not going to be used. Furthermore, the description of the invention does clearly state that the network data is used — see for example paragraphs [0058] & [0059] of the EP Patent, as well as figure 4.

## **The Law**

9. These proceedings have been initiated under section 73(2) which reads:

**73(2)** If it appears to the comptroller that a patent under this Act and a European patent(UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent.

## **Comparing the two patents**

10. Both patents have the same priority date (1<sup>st</sup> March 2002) and they were both filed by the same applicant (Parc Technologies Limited). The current registered proprietor is the successor in title to both patents by virtue of assignment dated 27<sup>th</sup> July 2005.
11. I have carefully considered and compared claim 1 of each of the patents, trying to take the most generous view I can of the matter, but it is nonetheless clear to me that they both relate to the same invention. There are three places where the wording of the claims differ. The second difference ('traffic data' instead of 'data indicative of traffic ...') is a trivial matter of semantics. The third difference (no explicit use of 'network data') appears to be a clerical error or mistake which is so obvious that it

could be corrected using Section 117 (as distinct from an amendment under Section 27).

11. That only leaves the first difference - the wording of the preamble to the claims. In this particular instance, I concluded that if it walks like a duck, swims like a duck, and quacks like a duck, then it's a duck. <sup>1</sup> I.e. it does not matter what the invention is called; if all the steps of the methods are the same (and they are), then it is the same invention.
12. I have found that claim 1 of GB 2 386 032 B has been granted for the same invention as claim 1 of EP 1 481 511 B1. I don't think it matters that the EP(UK) patent does not also claim a method of modifying a communication network — ie. corresponding to claim 13 of the GB patent. As Balcombe LJ observed in *Marley* <sup>2</sup> the obvious purpose of section 73(2) is to avoid the possibility of “... *a defendant who has successfully defeated a claim for infringement of one patent being threatened with proceedings for infringement of the other in relation to the same activities.*” As Balcombe LJ explained, revocation of the GB patent is necessary, “... *irrespective of the fact that other linked inventions may be included in the claims of either patent.*”
13. I therefore order the revocation of GB 2 386 032 B.

### **Appeal**

14. Any appeal must be lodged within 28 days after the date of this decision.

**Stephen Probert**

Deputy Director, acting for the Comptroller

---

<sup>1</sup> James Whitcomb Riley (1849-1916)

<sup>2</sup> *Marley Roof Tile Co. Ltd.'s Patent* [1994] RPC No. 6. See p240 line 40 to p241 line 8.