

## **PATENTS ACT 1977**

IN THE MATTER OF a reference under sections 8, 12, 13 and 82 by I.D.A. Limited, Colin Thomas Metcalfe, David Julian Lax and Polymer Powder Technology (Licensing) Limited in respect of UK application No GB 9814507.1, international application No PCT/GB99/02090, European application No 99929525.6 and Australian application No 4631799 in the name of the University of Southampton, and of applications for a patent deriving or claiming priority therefrom

## **PRELIMINARY DECISION AND ORDER**

### **The applications in suit**

- 1 Application No GB 9814507.1 entitled “A method and apparatus for controlling pests” was filed on 3 July 1998 in the name of the University of Southampton (“the University”). International application No PCT/GB99/02090, European application No 99929525.6 and Australian application No 4631799 claim priority from the GB application, which was withdrawn before publication. The international application was published on 13 January 2000 as No WO 00/01236.
- 2 The inventors are named as Philip Edwin Howse and Roger Edward Ashby. Dr Howse is an entomologist at the University; although he is now Professor Howse, I will refer to him by his title at the relevant time as this appears in most of the documents pertaining to the case. Mr Ashby is the managing director of Southampton Innovations Limited, a company used by the University to promote its technology.
- 3 The applications in suit relate to the control of insect pests, particularly cockroaches, by exposing them to a composition comprising magnetic particles. The particles adhere to the insects, and interfere with their ability to maintain a grip on, or fly away from, a surface, making it easier to trap or kill them. Electrostatically charged particles are known to produce a similar effect, and indeed Dr Howse has been much involved in this technology. However, electrostatic particles have the disadvantage that they lose their charge and hence effectiveness in conditions of high humidity.

### **The background to the dispute**

- 4 The present reference was filed with a statement of case on 17 September 2001. The questions referred and the relief sought are extensive, but essentially the reference alleges that I.D.A Limited (“IDA”) are at least in part entitled to the applications and patents granted thereon, that Colin Thomas Metcalfe and David Julian Lax (both of whom provided consultancy services to IDA) are the inventors and that Polymer Powder

Technology (Licensing) Limited (“PPTL”) are entitled to royalty-free licenses under any patents. After amendment at the instigation of the Office, the statement was served on the University, Dr Howse and Mr Ashby (the defendants) on 19 October 2001 inviting the filing of a counter-statement by 30 November 2001.

- 5 Before any reply from the defendants was received, the claimants wrote to the Office on 23 October 2001 expressing concern that rights in countries outside the UK which might devolve to them could be lost if they did not act with due diligence. They asked the comptroller to make an order under rule 106 of the Patents Rules 1995 that the defendants should disclose the identity and status of all national and regional filings deriving or claiming priority from the applications specifically mentioned in their reference, and asking to be heard if the comptroller were minded to refuse. They explained that the defendants had not been willing to provide this information, that it was not possible to carry out a complete overseas search via databases, and it was impractical to write to all patent offices and overseas agents.
- 6 The Office did not think it appropriate to press this matter before the defendants had had an opportunity to reply and to file a counter-statement. A further round of correspondence between the claimants and the Office failed to resolve the matter, but on 30 November 2001 the defendants filed their counterstatement. In this they disputed the claimants’ contention, stating that it was possible to find out the information that they sought by making local enquiries through a patent attorney, except for the USA where they confirmed that application No 09/736023 with a filing date “28<sup>th</sup> February 2001 (as of 1-7-99)” was pending.
- 7 This did not satisfy the claimants who wrote on 18 December 2001 to both the defendants and to the Office. They stated that they had already discovered the US application, and (the Office in the meantime having invited them to file their evidence by 16 January 2002) that they needed information about which jurisdictions were in issue in order to identify the real issues between the parties and to file evidence in relation to all relevant jurisdictions. The claimants also asked the defendants to supply copies of certain documents referred to in the counter-statement and to provide further information concerning allegations made in it, which they did not consider to be set out clearly enough for them to know the case they had to answer. The defendants replied on 20 December 2001 supplying some further documents and information concerning the matters in the counter-statement, but this still failed to satisfy the claimants.
- 8 In a further development, on 4 January 2002 the defendants wrote to the Office seeking security for costs on the grounds that IDA had no significant assets and that PPTL (a Jersey-based company) were outside the jurisdiction; the claimants replied on 8 January 2002 offering a sum of £800 to avoid further delay. IDA are a UK-based company and the Office pointed out that it appeared to have no powers under section 107(4) of the Act to require security from them.
- 9 A preliminary hearing (intended also to serve in effect as a case management conference to settle the future course of the proceedings) was held before me on 16 January 2002 to address the preliminary matters which appeared to the Office to be in dispute namely:

- why the claimants required details of foreign applications and why the defendants

were unwilling to supply them; and what bearing the existence of further foreign applications had on the evidence to be filed;

- what disagreements if any remained as to (a) the documents and (b) information to be filed;

- whether the period for the claimants to file their evidence-in-chief (which expired on the day of the hearing) ought to be extended; and

- whether the defendants were content with the offer of security from the claimants.

At the hearing James St Ville, instructed by Raworth, Moss & Cook, appeared for the claimants and Susan J Allard of Boulton Wade Tennant appeared for the defendants.

- 10 It will be helpful first to outline very briefly the technical background to the invention and the matters on which this dispute turns. The claimants' case is that the applications have been filed in breach of confidence. They take as their starting point an article published in the Times newspaper on 2 April 1998 describing a cockroach trap made available by Dr Howse, in which an electrostatically charged talcum powder caused a cockroach alighting on it to slip and fall on to a flypaper. The claimants allege that it was Mr Metcalfe who, on reading this article, had the idea of replacing the electrostatic powder by magnetic powder, and that he disclosed this in confidence to Mr Ashby at a meeting on 27 April 1998. They also allege that thereafter Mr Metcalfe and Dr Lax (who they say conceived the aspects of the invention concerning encapsulation of the magnetic materials) disclosed the subject matter of the applications in a series of confidential meetings down to June 1998 involving Dr Howse and Mr Ashby amongst others at the University.
- 11 The defendants on the other hand contend that Dr Howse conceived the idea of using magnetic particles to trap or kill insects and had disclosed it to others in the autumn of 1997, and that Mr Ashby had provided details of magnetic materials. They allege that Mr Metcalfe's contribution at the meeting on 27 April 1998 lay solely in suggesting IDA or PPTL as a supplier of magnetic materials; that the encapsulation of the particles was in the public domain; and that the notes for the preparation of the UK application were sent to Boulton Wade Tennant on 22 May 1998 before any work was undertaken by Dr Lax.
- 12 It is clear therefore that there is an acute conflict as to the facts of the case, and it is not disputed that cross-examination of witnesses is likely to be necessary to resolve the matter. However Mr St Ville and Ms Allard did not agree as to the approach to be taken at this stage of the proceedings. Mr St Ville argued that there was not a full enough story for the claimants to understand what was being said, and to investigate and answer it. In his view cross-examination alone would not resolve the matter, and justice would not be done to the claimants without early disclosure of the information and documents that he sought. Ms Allard took the view that the statement of case together with the further information that she had already provided gave the claimants a sufficient indication of the case they had to answer: as she put it, she did not think it right to be put in the position almost of giving the defendants' evidence to the claimants before she filed it herself. I will say more about these matters later, but will now turn to the specific matters in dispute.

## Information concerning foreign filings

13 The claimants ask me to make an order under rule 106 of the Patents Rules 1995 for:

“details of all national and regional filings for patent applications under the laws of countries other than the United Kingdom or under treaties or international conventions (including those designated in international application No PCT/GB99/02090), deriving and/or claiming priority from patent application No GB9814507.1, international application No PCT/GB99/002090 or any of the other patent applications in suit including:

(a) in which countries and under which treaties or international conventions such corresponding applications have been made;

(b) the relevant application number corresponding to each such application;

(c) the current status of each application and the nature and timing of any deadline which has to be met in relation thereto;

(d) in which countries and under which treaties or international conventions such corresponding applications could have been made (and/or have been made) but have not been pursued.”

14 Mr St Ville argued that the comptroller would need this information to know the extent of the jurisdiction she was being called on to exercise, in order to do justice to the claimants and not deprive them of a fair hearing. In his view it was necessary for the claimants to have details of all applications derived from the basic UK filing so that the claimants could decide whether and when to adduce evidence of foreign law and practice, both to enable the comptroller to make an appropriate order concerning any foreign applications, and to enable the claimants to take any procedural steps necessary to protect their interests in any foreign jurisdictions (as in the case of the European application, where proceedings had been stayed under rule 13 EPC).

15 Ms Allard however argued that the comptroller needed this information only when the basic issues of entitlement and ownership had been settled. It was manifestly unlikely to affect the evidence on these issues, and was not therefore relevant at this stage. She maintained that the claimants could make local enquiries via patent attorneys if they needed the information, except for the USA, which was why she had been prepared to give information about the corresponding US application.

16 Indeed Ms Allard suggested that the claimants were in reality engaged in a “fishing exercise” to find out in which countries the defendants were seeking actively to protect their invention and so put themselves in a better position commercially in relation to other third parties. Thus even though details of foreign applications might individually be in, or about to enter the public domain, the “sum total” of where applications had or had not been filed was confidential information. I asked Ms Allard why in that case she had felt able to disclose details of the US application. She explained that the defendants had in fact not been happy about her doing this.

17 It is well known that section 12 of the 1977 Act presents the comptroller with the difficulty that, whilst she may be able to make a determination as to entitlement, she may

not be able to make any order effective in foreign jurisdictions, especially if no evidence of the law in those jurisdictions is available. However, I am not aware of, and was not directed to, any previous cases in which the comptroller has been asked to order disclosure of information about corresponding applications in order to protect the interests of the claimant in an entitlement action, or to enable a more effective order to be made under section 12.

- 18 Mr St Ville drew my attention to *Norris' Patent* [1988] RPC 159 and *Cannings' United States Application* [1992] RPC 459 to illustrate the need to know the extent of the jurisdiction to ensure that justice could be done to the claimant. In *Norris*, the comptroller (upheld on appeal to the Patents Court) was able to issue a declaration of fact concerning entitlement, but in the absence of any evidence of foreign law declined to make any order giving effect to this finding (see page 169 at lines 3-8). In *Cannings* the comptroller was prepared make a finding of entitlement to a United States application and to any patent granted thereon and to order an employee to execute an assignment in order to give effect to that determination, but declined to make any order in respect of any continuation, continuation-in-part or divisional of that application without evidence of their possible contents. As Mr St Ville put it, in *Cannings* there was a contractual right which enabled the comptroller to make an order *in personam* to enable a right to be transferred, but no order could be made which directly related to the proprietary right under US law.
- 19 In neither of these cases as reported does there appear to have been any request or suggestion that the comptroller should require details of further applications or of foreign law and practice before concluding a reference under section 12. However, I do not regard this as preventing me from doing so if I consider it right in the circumstances of the particular case. Before deciding this matter there are three points which arose either in correspondence or in argument before me, and which I should first dispose of.
- 20 Firstly, as to the feasibility of local enquiries, the claimants in their letter to the Office of 18 December 2001 (to which a declaration of truth had been appended with a view to treating the letter as evidence in support of their request) stated that information about applications in some jurisdictions was not available at this stage of processing; and that enquiries via databases would not indicate those jurisdictions in which information would not be available until grant. Enquiries therefore needed to be made via local agents in each jurisdiction: this would cost about £500 per jurisdiction making a total of £38,000 for the 73 national and 3 regional designations in the international application for which they had no information.
- 21 Ms Allard at the hearing did not dispute that enquiries would need to be made in this way, but thought that the costs would be much lower, and nearer to £200 per jurisdiction. Both she and Mr St Ville, confirmed, in response to a question that I put to them, that it was not possible to find out this information simply by writing to the patent offices of the countries and regions concerned. I accept this.
- 22 As I understand it, Ms Allard was not suggesting any inability on the part of the defendants to supply this information if required to do so. It therefore appears that the claimants will be put to substantial expenditure to find out information which the defendants have in their possession and which will not be difficult for them to supply if it is required. I cannot see that on any reasonable view this is proportionate between the

parties. If therefore this information is required at this stage of the proceedings - and that is what I must decide - I consider that it should be for the defendants to supply it.

- 23 Second, I should comment on the significance of the designations in the international application. The claimants appeared to me at least in their correspondence to be suggesting that the existence of 74 national and 4 regional designations in the international application was some evidence of intent to proceed with applications in all of these territories. For the avoidance of doubt, I should say that I have made no such assumption in reaching my decision. Ms Allard confirmed at the hearing that this was an “all countries and regions” designation, and I am aware that this is a practice common amongst those who regularly file international applications. This avoids the difficulties under the Patent Cooperation Treaty of adding later any designations inadvertently missed out when filing the application. It is facilitated by the fact that above a fairly low threshold number, no fees for further designations are payable, and that merely by taking no further positive steps to enter a national or regional phase the application will lapse in those territories which turn out to be of no interest.
- 24 Third, Mr St Ville drew my attention, where evidence of foreign law was needed, to a presumption that it would be the same as English law unless evidence to the contrary was given. He took me to the cases of *Royal Boskalis Westminster NV v Mountain* [1997] 2 All ER 929, 976h - 977i (a marine insurance case) and *University of Glasgow v The Economist* [1997] EMLR 495, 501 (a libel case) in which this presumption was applied. He noted that it did not appear to have been argued in any cases decided to date under section 12 of the 1977 Act.
- 25 In the absence of any argument to the contrary, I take this presumption to be established. However, I would be somewhat loath on the arguments before me to suggest that, if the defendants did not rebut the presumption, the comptroller might rely on it to go beyond a mere declaration of entitlement to make an order intended to have effect in another jurisdiction. In any case, as I understood it, Mr St Ville did not wish to found his case on this presumption, but referred to it mainly to show that the comptroller’s full powers under section 12 had not always been used. Rather he wished to find out where patents had been applied for so that the claimants could file additional evidence at an appropriate stage. Thus evidence might be needed before the substantive issues were determined if differences in the law of entitlement were involved, but could be left until later if the differences related only to relief. I do not therefore believe that anything will turn on the presumption, and do not think that I need to consider it further in reaching my decision.
- 26 As I have explained above, the claimants have pressed for immediate disclosure on two grounds: that they need it in order to complete their evidence, and to take any procedural steps necessary to protect their interests. As to the first ground, I am not persuaded that the absence of the information sought prevents the claimants from filing evidence-in-chief as to entitlement and ownership, which are the issues upon which this reference must ultimately turn, and which may well suffice for many jurisdictions. If the claimants are successful on these issues, I accept that they should have an opportunity to file evidence as to the law and practice governing the relief available under other jurisdictions. However, I believe that in the interests of expediting these proceedings, I should hesitate to delay any further their evidence-in-chief (which was due to be filed on 16 January 2002) to allow such evidence to be filed, unless there is a strong likelihood of injustice to one

of the parties.

- 27 The claimants have not in my view put forward any very strong case as to why evidence of entitlement and ownership should differ according to country, or identified any particular jurisdiction of interest to them where this would be a real concern. I do not see that justice would be denied to the claimants by requiring evidence-in-chief as to entitlement and inventorship to be filed at this stage, leaving any evidence as to foreign law and practice to be filed after these issues have been determined.
- 28 I accept that the claimants' statement of case goes further than entitlement and inventorship by asking the comptroller to determine also the entitlement of PPTL to royalty-free licenses under the patent but (and without taking any view as to whether sections 8 and 12 give the comptroller any powers to decide this question) this does not alter my view. I cannot see that evidence of licensing requirements in other countries is necessary at this stage.
- 29 However, I believe the claimants to be on stronger ground when they argue that there may be countries or regions in which (as in the case of the European application) proceedings ought to be stayed or some other step taken at this stage to draw attention to their interests. I am mindful that where an entitlement action under section 8 of the Act has been launched, the Office will avoid taking any irrevocable action which might be to the detriment of the claimant if subsequently found to be entitled, and I believe the same approach should, as far as possible, be taken for actions under section 12.
- 30 Accordingly, for any application for protection of an invention which claims priority from or is equivalent to any of the applications in suit, the defendants should disclose to the claimants and to the Office the information in parts (a) to (c) of the claimants' request, and of part (d) insofar as it relates to applications which actually were made (or as regards the international application, applications which resulted from positive entry into a national or regional phase). I do not see that it is necessary to go further than this by requiring details of applications which were contemplated but never made, or where, though an application was notionally in being by virtue of the international application, no positive action was taken to enter a national or regional phase. This would to my mind move away from protecting the claimants' interests to investigating the defendants' reasons for not proceeding in certain countries, which I do not consider appropriate in these proceedings.
- 31 The question also arose at the hearing as to whether if I made an order of this nature I should also order the defendants to maintain in being all the applications involved in order to maintain the status quo pending determination of the reference. I do not think it would be right for me to go this far in the absence of any information about what steps precisely it would require the defendants to take. If, having seen the list of applications and their current status, the claimants consider that this does not enable them adequately to protect their interests, it is open for them to come back to me with reasons and I will then consider the matter further.
- 32 I am mindful that Ms Allard believed the information which I am asking the defendants to supply to be confidential, but I do not accept that this is the case on the reason that she put to me, which is that it will put the claimants into a better position to know the scope of the defendants' commercial activities in relation to the invention. Bearing in mind that

for the international application the national and regional phases should have been entered around a year ago in the normal course of events for most countries, details of many of the applications resulting from it may already be in the public domain or about to enter it. I am not convinced that in such a case there can be confidentiality merely in knowing the overall picture of applications made or not made simply because it makes it easier for the claimants than if they made their own enquiries to establish that information.

- 33 Before leaving this matter, I would say that in the interests of certainty and of expediting the proceedings I accept Mr St Ville's contention at the hearing, that if the information is to be disclosed it should be done by way of a single list rather than leave it to be supplied piecemeal as and when the defendants are prepared to make information available, or when the claimants discover relevant information.

### **Provision of further information**

- 34 The request for this was maintained in respect of paragraphs 6 and 10 of the counter-statement, the relevant parts of which read as follows:

“6. .... The concept of the invention was disclosed in confidence by Philip Howse to other parties in the Autumn of 1997. Roger Ashby, who is a metallurgist, provided information regarding magnetic materials. ....”

“10. At the first meeting between Philip Howse and Colin Metcalfe, Philip Howse made it quite clear that he had already conceived of the idea of using magnetic powders in insect control and needed a source of the magnetic particles. Colin Metcalfe suggested that IDA Limited or Polymer Powder Technology (Licensing) Limited could supply finings from the sieving of mining waste. These “finings”, i.e. magnetic powder of a very small particle size were commercially available. The only role of Colin Metcalfe, IDA Limited or Polymer Powder Technology (Licensing) Limited was therefore as a supplier, to supply the Opponents a magnetic powder of a small particle size which was a commercially available product at that time. ....”

and was as follows:

“Under paragraph 6, please state

(a) what is meant by “the concept of the invention which it is alleged was disclosed in the autumn of 1997;

(b) please identify the “other parties” to whom it is alleged that details of the invention were disclosed in the Autumn of 1997;

(c) please state whether it is alleged that the said disclosure was made orally or in writing and (i) if orally, when, where, to whom and in what words it is alleged the said disclosure was made; and (ii) if in writing, please provide a copy of any document in which it is alleged the said disclosure was made or recorded.”

“Under paragraph 10, please state

(a) from whom it is alleged that the magnetic powder referred to in paragraph 10 was commercially available;



(b) exactly what commercial product is being referred to;

(c) the composition of the magnetic powder referred to; and

(d) is it thereby alleged that the Applicants obtained the said powder from a commercial source and if so please state where, when, from whom and upon what commercial terms it is alleged the Applicants obtained the magnetic powder referred to.”

35 Before the hearing, the matter of Mr Ashby’s qualifications as a metallurgist appeared to be in dispute. However, at the hearing, the parties were content to leave this to be dealt with in evidence, but the claimants remained concerned as to his role in relation to the magnetic materials. Mr St Ville accordingly also sought information concerning the magnetic materials in paragraph 6.

36 Once again the claimants and defendants approach this matter from rather different standpoints. Mr St Ville argued that the claimants needed this information in order to be able to understand fully the case against them, to make investigations, to gather the appropriate evidence, and if necessary interview the people to whom Dr Howse had made the alleged disclosure. Effectively, in his view the allegations in question in the counter-statement were that an element of the inventive material came from either Dr Howse or Mr Ashby, or was already in the public domain, but the information was too vague in each case to work out the real thrust of the argument.

37 Mr St Ville drew heavily on the practice outlined in Tribunal Practice Notice 1/2000 (“TPN 1/2000”, reported at 2000 [RPC] 587) outlining the way in which the Office intended to conduct its tribunal proceedings as a result of its review of these matters following the Lord Woolf’s report *Access to Justice*. He took me in particular to paragraphs 15-19 which deal with the adequacy of statements of case with reference to the trade mark cases of *LIFESAVERS* [1997] RPC 567, *DEMON ALE* [2000] RPC 345 and *COFFEE MIX* [1998] RPC 717.

38 I do not think I need to quote extensively from these paragraphs or cases. Suffice to say that they make the point that it should not be left to the evidence rounds to define the area of contention between the parties. They emphasise the need to particularise the case by providing a focussed statement which includes all of the grounds which the party intends to pursue and which are to be supported by evidence, with sufficient particularisation for the other side and the Patent Office to have a clear view of the nature of the dispute. The statement should be full in the sense that it should outline each of the grounds relied on and state the case relied on in support of those grounds. It should be as succinct as possible but should be complete.

39 Ms Allard contended that the defendants had given sufficient details of their case in the counter-statement for the claimants to be able to file their evidence-in-chief. As I understood it, she accepted that there might be a need for the claimants to file further evidence if the if the defendants’ evidence raised points which the claimants needed to answer.

40 In the circumstances of this case I believe that Ms Allard’s view of the matter is correct, and I do not think that this is in any way to set my face against the practice outlined in

TPN 1/2000. It should be borne in mind that this notice was issued against a background of past practice, in the Trade Marks Registry in particular, to accept statements which were little more than a recitation of the sections of the legislation under which the action was to proceed. That is very far indeed from being the case here, where I do not think there is any dispute that the statements are at least reasonably full.

- 41 I have considered very carefully all the arguments which Mr St Ville put forward. In essence I think these boil down to establishing precisely what magnetic materials Mr Ashby is alleged to have given information about, what exactly Dr Howse did disclose to “other parties” in the autumn of 1997 (since he was unlikely to have used the precise wording of the patent claims in such discussions) and what exactly was the source and composition of the magnetic powders referred to in paragraph 10 of the counter-statement (the claimants not accepting Ms Allard’s explanation in her letter of 20 December 2001 that the “finings” were those from PPTL referred to in the second sentence of the paragraph).
- 42 It may be more convenient for the claimants to wrap up as many of their enquiries as possible before filing any evidence, but I do not consider that this is enough to justify me in ordering the provision of the information sought at this stage, which might well turn out to be wider than is actually necessary to dispose of the case. For instance, I can see no justification for seeking information about the commercial terms upon which the defendants obtained magnetic powders from their suppliers. All of the items requested appear to me to concern matters where there is a very strong likelihood that the defendants’ evidence will provide sufficient clarification to fill in the details of the issues in dispute where they are not already clear, and minimise any further enquiries which the claimants need to make.
- 43 The claimants will of course have an opportunity to file evidence in reply to the defendants’ evidence and I cannot see any reason on the arguments before me why this should not provide a satisfactory basis for cross-examination of witnesses at the substantive hearing. The purpose of evidence in reply is precisely to enable the claimants to deal with any matters raised by the defendants’ evidence which their own evidence-in-chief does not cover, and I am not persuaded that there will be any injustice to the claimants by proceeding in this way.
- 44 Putting it another way, I do not believe that this is a case where the statements of case can be said to be inadequate in the sense described by TPN 1/2000. I believe that the defendants’ case is sufficiently clear and complete for the defendants to take the step of filing evidence in support of their own case.
- 45 However, concerning the identity of the “other parties”, Mr St Ville drew my attention to some precedent cases, and I must consider these before disposing of the matter. The disclosure to the other parties is said in the counterstatement to have been made in confidence. In her letter of 20 December 2001 to the claimants, Ms Allard explained that this was an oral disclosure, and at the hearing she explained that she hoped to be able to substantiate that fully in evidence but did not see the need to produce further information at this stage.
- 46 Mr St Ville asked me to treat with scepticism any assertion that the identity of a person to whom something was disclosed should, without further explanation, be treated as

confidential. He drew my attention to *Marriott v Chamberlain* [1886] L.R. 17 Q.B.D., a case in which the Court of Appeal held that the defendants in a libel action were entitled in interrogatories to require discovery from the plaintiff of the names and addresses of an informant in whose hands he alleged had seen a copy of a letter, and of persons to whom he alleged the letter had been sent and who now had a copy, on the grounds that this was a substantial part of the facts material to the plaintiff's plea of justification. It was not sufficient answer for the plaintiff to say that he intended to call those persons as witnesses at the trial.

47 Mr St Ville also took me to the decision of Rimer J in *Link House Magazines Ltd v Midsummer Books Ltd* (Chancery Division, 20 May 1999, reported at New Law Online 699076202), a case of passing-off in which a number of witness statements served by the claimant had been blanked out to conceal the identity of the makers of the statements. In this case Rimer J quoted the principle that the defendants were entitled to interview any or all of those witnesses, referring to the decision of the Court of Appeal in *Harmony Shipping Co SA v Saudi Europe Line Ltd* [1979] 1 WLR 1380, and in particular the statement of Lord Denning MR at page 1384. I quote selectively from this as follows:

“So far as witnesses of fact are concerned, the law is as plain as can be. There is no property in a witness. The reason is because the court has a right to every man's evidence. Its primary duty is to ascertain the truth.

.....

In no way can one side prohibit the other side from seeing a witness of fact, from getting the facts from him and from calling him to give evidence or from issuing him with a subpoena.

.....

That principle is established in the case of a witness of fact: for the plain, simple reason that the primary duty of the court is to ascertain the truth by the best evidence available.”

48 However in the present case Ms Allard did not suggest that the identity of the “other parties” should be withheld from the claimants. As she said, she hoped to be able to furnish this as part of her evidence, and to request appropriate restrictions if it remained confidential. I do not think that this is on all fours with the situation in either of the cases quoted by Mr St Ville. In *Marriott v Chamberlain*, the question was whether the matter should be disclosed in the interrogatories or at the trial, and in *Link House* the precise point in the proceedings which the names and addresses should be given did not appear to be in issue, the case turning on how the witnesses should be approached by the defendants.

49 I do not therefore regard these cases as compelling me to order the names of the other parties to be supplied at this stage of the proceedings. I would observe that it is hardly likely to be in the defendants' interests to be less than full in the evidence that they submit of Dr Howse's conversations with these parties, and I am prepared to leave it to Ms Allard to deal with the matter in her evidence.

50 In summary therefore I find that I should not make any order at this stage for provision of the information requested under rule 106. This is without prejudice to whether an order might be necessary at a later stage, particularly as regards the “other parties” to whom Dr Howse is alleged to have disclosed the concept of the invention.

## Disclosure of further documents

51 Pursuant to earlier requests the defendants have supplied the claimants with copies of some documents referred to in the counter-statement, namely notes for the preparation of the patent application which were sent to Boulton Wade Tennant on 22 May 1998 and a copy of the draft patent application said in the counter-statement to have been prepared from these notes with claims defining the invention and without further input from the opponents. In her letter of 20 December 2001 supplying these, Ms Allard explained that the draft was sent for approval to the University on 15 June 1998.

52 The differences between these documents have led the claimants to suggest that more relevant documents exist and ought to be provided. Expanding upon their earlier request in correspondence for disclosure of documents concerning the question of ownership, the claimants' skeleton argument asks for disclosure of all documents which record or contain:

(1) the receiving or alleged creation of information contained in the patent applications in issue by the Applicants or any of them;

(2) the alleged communication of the contents of the patent applications in issue to Boulton Wade Tennant; and

(3) the contracts and communications between the Applicants and Referrers concerning the ownership of the patent applications in question.

(Additionally Mr St Ville suggested at the hearing that category (3) ought also to include the contents of the applications.)

53 In addition the claimants are maintaining a request previously made, which the defendants have resisted, for copies of the "other draft Heads of Agreement" and "other draft Licence Agreements" between the parties from the period 8 August 1998 to 21 December 1999, as referred to in paragraph 13 of the counter-statement, where the defendants state:

"The Referrers refer to one draft Agreement between Southampton Innovations Limited (SIL) and Polymer Powder Technology Limited (PPTL) sent on 30<sup>th</sup> June, 1998 by Mr Ashby to Mr Ralph Brown acting for PPTL. That draft Agreement was neither finalised nor entered into. There were numerous other draft Heads of Agreement or draft Licence Agreements between the parties, or between other interests associated with the parties, and none of these were entered into. The other draft Agreements span the period from 8<sup>th</sup> August, 1998 to 21<sup>st</sup> December, 1999."

54 I will deal with this latter request separately from the other items requested. Ms Allard, in correspondence and at the hearing, has resisted it on the grounds that since IDA was the other party to the various heads of agreement the information should be within the claimants' possession, and that in any case the intention was not to refer to any specific agreement. Rather the intention was to show that, since numerous other draft agreements had been discussed between the parties, the premise set out in the claimants' statement concerning the draft agreement sent on 30 June 1998 was incorrect. However Mr St Ville contended that these documents should be supplied in accordance with rule 112 of the

Patents Rules 1995.

- 55 I am not wholly convinced that disclosure of these documents ought to be resisted on the grounds suggested by Ms Allard: ultimately the submission in paragraph 13 of the counter-statement relies on the content of the documents. However, although I was not addressed on the matter, clearly I should proceed with caution if these “numerous” draft agreements are in whole or in part communications without prejudice between the parties in an attempt to settle a dispute between the parties, which would attract privilege. That is a possibility I should bear in mind, and also that these drafts ought in any case to be within the possession of the claimants. The real problem would seem to be that they have not been identified.
- 56 I therefore consider that the most appropriate course of action at this stage would be for the defendants to provide the claimants with a list of the draft agreements in question, which will enable the claimants to confirm whether or not they already have them. Either party is free to come back to me if this does not resolve the issue.
- 57 In relation to the remaining items, Mr St Ville directed my attention to the differences between the notes sent to Boulton Wade Tennant and the draft specification prepared from these, which is a much more substantial document containing examples of materials which were not present in the notes. I have to say that I find it surprising that this was prepared by Ms Allard, as she stated at the hearing, solely on the basis of information within her own knowledge from other work that she had done for Dr Howse, particularly as some of the extra information concerns specific magnetic materials which would seem to be the essence of the invention.
- 58 It may well be that this aspect of the case requires further information and evidence to be supplied by the defendants, but I am not convinced that this alone justifies me in making an order for disclosure of documents in the terms sought by the claimants, at least at this stage of the proceedings.
- 59 Mr St Ville put it to me that this was a case where because of the acute conflict of fact, disclosure of contemporaneous documents - which he accepted would have to be reciprocal between the parties - would be better than reliance on cross-examination alone to resolve the conflict. He believed this to be a case where the disclosure sought was not disproportionately wide and was sufficiently precise as not to result in a continuing train of enquiry. He considered that the hitherto common practice in proceedings before the comptroller of not ordering disclosure until the evidence rounds had been completed was not necessarily the most efficient way of dealing with the matter, since it might require a further round of evidence following disclosure. Accordingly he urged me not to approach the matter on the basis of whether this was an appropriate stage at which to order disclosure, but of what was efficient to dispose of the matter.
- 60 In support of his arguments Mr St Ville directed me to the observation of Falconer J in *Norris’ Patent* [1988] RPC 157 at page 171 lines 30-41 that where copy documents exhibited were clearly unsatisfactory, there should have been discovery and production of documents and cross-examination of the main declarants on each side. I treat that observation with great respect, but I am not convinced that I can glean much assistance from it in the particular circumstances of this case. I would observe that Falconer J went

no further than suggesting that discovery “should have been sought before the hearing at the Patent Office”, without any greater precision as to the particular stage of the proceedings.

- 61 Ms Allard explained that she had found in her files a copy of an earlier draft application dated 4 June 1998, and that this, and not the draft dated 15 June 1998, was the first draft. It was not quite as full as the later draft, which was prepared following some telephone discussion with Dr Howse of which she now had no record in her file. She fully accepted that the earlier draft should be provided to the claimants, and agreed to do so. I think that the simplest way of dealing with this would be for me to make an order under rule 106 for this document to be supplied.
- 62 Other than that Ms Allard says she has no other relevant documents, and I accept this. However, Mr St Ville correctly pointed out that the request for disclosure went beyond the documents that Ms Allard had in her possession.
- 63 I have some sympathy with the arguments put forward by Mr St Ville, but after careful consideration I am not persuaded that I should order disclosure of the documents sought. As stated in TPN 1/2000 at paragraphs 33-37, disclosure is not common in proceedings before the comptroller and that was not expected to change. The tests laid down in *Merrell Dow Pharmaceuticals Inc's (Terfenadine) Patent* [1991] RPC 221, namely whether the documents should relate to the matters in question and whether their disclosure is necessary to dispose fairly of the proceedings or to reduce costs, are still seen as an appropriate way of taking into account the circumstances of a case and the overriding objectives which are stated at paragraph 5 of TPN 1/2000. It is however accepted that the Office should put greater emphasis on the principle of proportionality and on the need to ensure that proceedings are dealt with expeditiously.
- 64 Even if any disclosure were to be reciprocal, as the parties appear to agree, I doubt whether disclosure at this stage will enable the proceedings to be dealt with expeditiously and not simply introduce unnecessary delays. I think that despite Mr St Ville's contentions, category (1) of the disclosure sought is potentially very wide-ranging, and documents in category (3), with or without the addition suggested by Mr St Ville, ought in any case to be within the claimants' possession. Category (2) is perhaps more pertinent, but I cannot see that there is likely to remain anything by way of documents to be disclosed in the light of Ms Allard's explanation as to the documents she had received and had on her file.
- 65 I also consider there to be a strong likelihood that the evidence of the parties will enable some at least of the points in issue to be resolved without the need for disclosure, and that if disclosure does become necessary at a later stage it can be much more focussed.
- 66 I therefore find that an order for disclosure of documents under rule 103 is not appropriate at this stage, without prejudice as to whether such an order might be appropriate at some later stage. Notwithstanding Mr St Ville's argument, I think that the difficulty with an order for disclosure under rule 103 - and also with a request for information and documents under rule 106 - before any evidence has been filed lies in forming any realistic idea of what exactly might be needed to dispose fairly of a case. For the avoidance of doubt I do not regard it as necessary for the normal evidence rounds to have been

completed before an order for disclosure is made, although that may well be a convenient point for the parties to take stock of the matter.

## **Order**

67 In the light of my findings above, I order that the defendants should supply the following to the Office and to the claimants:

- information as to the application number, country of application and current status (including any treaty or international application under which it was made, and any deadline which is to be met) of each application for protection of an invention which claims priority from or is equivalent to any of the applications in suit; this is to include any applications which have resulted from entry of the international application No PCT/GB99/02090 into a national or regional phase, and applications which have become withdrawn; and

- a copy of the draft patent application dated 4 June 1998 which Ms Allard has on her file;

and that the defendants should provide a list to the claimants of the documents within the categories of “other draft Heads of Agreement” and “other draft Licence Agreements” referred to in paragraph 13 of the counter-statement.

68 I also direct that the claimants should have an opportunity, after the questions of entitlement and inventorship have been determined, and if that determination is in their favour, to file evidence of the law and practice in other jurisdictions if they consider it necessary in order to obtain appropriate relief in these jurisdictions.

## **Timetable for future prosecution of the reference**

69 In their skeleton arguments the claimants proposed a timetable of 7 days after my order for service of information; 21 days after the order for service of disclosure for the claimants to file their evidence; 6 weeks after the disclosure for the claimants to file their evidence; 6-week periods thereafter for the service of the defendants’ evidence and the claimants’ evidence in reply; and the substantive hearing to be in a window of 8 weeks after the latter. The defendants in their skeleton arguments said that the claimants should file their evidence as soon as possible.

70 At the hearing, a number of options were canvassed in the event that I did not grant all the orders requested by the claimants. I also made the point that if I did not grant any of the orders, I would need to be very strongly persuaded that anything other than a very short extension of time for the claimants to file their evidence was justified, given that the normal six-week period had not been extended and had elapsed on the date of the hearing. Ms Allard was keen to get the substantive hearing on as soon as possible and suggested that a period of six weeks after any disclosure for this evidence was too long in the circumstances, whilst Mr St Ville thought this was not actually a very long period given the work that would be involved, and that even if I did not grant the orders he was seeking

it would still take about three weeks to finalise the evidence with the documents attached.

71 Mr St Ville also pointed out that he expected to be away for a period, and that there might be a delay in instructing other counsel if this occurred at a critical period. I do not however think that I should give this too much weight in considering what period is appropriate for the claimants to file their evidence, since this appears to have been known to the claimants. I would therefore expect the claimants to have made adequate contingency planning for this eventuality.

72 In the event both parties were content to leave it to me to fix a timetable for the proceedings. Having regard to the fact that I have ordered the defendants to supply only specific information and documents which ought to be readily available, I direct that:

- the defendants should within 14 days from the date of this decision supply the information and documents specified in my order; and

- the claimants should then have a period of 21 days from the service of the documents and information to file their evidence-in-chief.

73 In setting the latter period, I do not take account of the delay which has necessarily elapsed between the date of the hearing and the issue of my decision, which is very much regretted. Nevertheless, I must have regard to the normal period of six weeks when considering what extension is appropriate, and with that in mind I do not consider that any period longer than 21 days is justified in all the circumstances. If the claimants consider this insufficient, I will consider any submissions they may wish to make, but I will need convincing reasons before granting any further extension. As I have made clear, I do not consider it appropriate to extend the period to allow for the filing of evidence as to the law and practice in other jurisdictions.

74 Thereafter, the normal six-week periods for the defendants' evidence and the claimants evidence in reply will apply. The Office will, in accordance with its usual practice, aim to arrange the date of the substantive hearing approximately four months from the commencement of the final evidence round, but will be prepared to accept an alternative date which is no later than that fixed by the Office.

### **Costs**

75 On the matter of security of costs, I am content with the proposal of the parties for the claimants to pay a sum of £800 into an account specified by Boulton Wade Tennant.

76 As to costs in respect of this hearing, the parties made no submissions and were content for me to decide the matter. No clear winner has emerged, and nor in my view has one side gained substantially more than the other. I have therefore decided to make no award for costs and direct that each party should bear its own costs in respect of this hearing.



**Appeal**

77 This is a decision on a procedural matter and the period for appeal is therefore 14 days.

Dated this 12<sup>th</sup> day of February 2002

**R C KENNELL**

Deputy Director acting for the Comptroller

**THE PATENT OFFICE**