

PATENTS ACT 1977

IN THE MATTER OF references under
Section 8 by Cerise Innovation Technology
Limited in respect of four UK Patent
Applications in the name of Melih
Abdulhayoglu and four further UK Patent
applications in the name of Comodo
Technology Development Limited

THIRD PRELIMINARY DECISION

1. This decision is concerned with whether or not I should consolidate two sets of proceedings under section 8 of the Patents Act 1977. It is the third preliminary decision I have had to issue so far as the first set of proceedings are concerned, though it is the first for the second set.

Background

2. Cerise Innovation Technology Company (“the referrer”) originally referred to the Comptroller under section 8(1)(a) of the Patents Act 1977 the question of entitlement to the grant of patents in respect of inventions, which were the subject of four UK patent applications numbered 9801764.3, 9801765.0, 9801767.6 and 9801768.4 in the name of Melih Abdulhayoglu. All of these applications were filed on 28 January 1998 and have since been withdrawn. Although the referrer has not seen these applications, it believes that the inventions forming the subjects of them were made while it was employing Mr Abdulhayoglu and that under section 39(1) of the Patents Act 1977 the inventions belong to it.

3. Subsequently, the referrer made a further reference under section 8(1)(a) in respect of four patent applications filed in the name of Comodo Technology Development Limited (“Comodo”), numbered 9818184.5, 9818186.0, 9818187.8 and 9818188.6. All of these applications were filed on 20 August 1998.

4. In its statement accompanying the second of these references, the referrer stated that it believes the subject matter of the later applications also to have been invented by Mr Abdulhayoglu whilst employed by the referrer and that the inventions forming the subject of them belong to the referrer by virtue of section 39(1). In support of its belief, the referrer has noted that, although it has not seen the later applications either, they have titles which place them in the same field of art as the earlier ones, there are, as with the earlier applications, four of them, and they were filed shortly after the earlier ones were withdrawn. All this has driven the referrer to the conclusion that the later applications relate to the same inventions as the earlier ones.

5. The referrer has since requested that the proceedings with respect to the two sets of applications be consolidated. Mr Abdulhayoglu and Comodo (referred to hereinafter as "the opponents") have resisted consolidation, so the matter has come before me to consider.

Factors relevant to consolidation

6. There are no hard and fast rules for determining whether proceedings should be consolidated. The comptroller will take all the circumstances into account, but the extent to which the issues are the same and the evidence is likely to be the same are obviously important considerations. The extent to which the parties are the same is also relevant, though I do not believe this on its own should necessarily be decisive. Thus I am not prepared to rule out consolidation merely because the opponents to the two sets of references are different, particularly as they are represented by the same patent agent.

7. Having looked at the statements of case I am satisfied that the extent to which the second set of patent applications relates to the same subject matter as the first set is a relevant factor in determining whether the issues are likely to be the same. However, the apparently simple task of comparing the two sets of patent applications immediately brings me up against a problem of confidentiality.

Confidentiality

8. The confidentiality problem is one that arises whenever entitlement proceedings are launched in respect of a patent application that has not yet been published. The comptroller is bound by the terms of Section 118 of the Patents Act 1977. Subsections (1) and (2) read as follows:

(1) After publication of an application for a patent in accordance with section 16 above the comptroller shall on a request being made to him in the prescribed manner and on payment of the prescribed fee (if any) give the person making the request such information, and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application as may be specified in the request, subject, however, to any prescribed restrictions.

(2) Subject to the following provisions of this section, until an application for a patent is so published documents or information constituting or relating to the application shall not, without the consent of the applicant, be published or communicated to any person by the comptroller.

9. None of the eight applications with respect to which a reference has been made has yet been published. The opponents have in each case refused to give consent for any information about the contents of any of the applications to be communicated to the referrer. The furthest that the opponents are prepared to go is for a Patent Examiner to look at the cases and tell the referrer the answer the question: “Are the later applications re-filed versions of the first four applications?” However, this would not really help; the later applications could include some of the subject matter of the earlier applications while not being simple re-filed versions.

10. I cannot draw any adverse inference from the opponents’ refusal to give consent (and to be fair, the referrer has not invited me to do so), because the opponents are fully entitled to withhold consent. However, it places me in an impossible position. In order to give a fully reasoned decision on the matter of consolidation, I cannot avoid disclosing some information about the contents of either the earlier applications, or the later applications or, more likely, both. That would breach section 118(2).

11. Accordingly, as a possible way out of this dilemma I suggested that I could issue an unreasoned decision. This is an exceptional and, in many ways, unsatisfactory solution, but it was difficult to see what else could be done. All the parties have now said they will be content with this, so that is what I will do. They have also said they are happy for me to make the decision on the basis of the papers on file.

Decision

12. Having looked at the eight patent applications and considered the pleadings, I have come to the conclusion that it would be inappropriate to consolidate the two sets of proceedings. They will therefore continue separately.

Continuing the proceedings

13. In the first set of proceedings, ie those relating to the applications numbered 9801764.3, 9801765.0, 9801767.6 and 9801768.4, the evidence-in-chief of the referrer was filed by 9 April 1999, and the opponent's evidence was due, according to my decision of 25 May 1999, on 6 July 1999. While the opponent filed the bulk of his evidence on this date, there was an ongoing exchange of correspondence between the two sides about the location of the original copy of a document and its genuineness, and the opponent asked for a six week extension of time to file supplementary evidence in connection with this. This request was opposed by the referrer, but has not yet been formally considered by the Office pending resolution of the consolidation issue. Indeed, the original six weeks requested has already lapsed.

14. As far as I can see, the correspondence about the disputed document was concluded by the referrer's letter dated 11 August. Five weeks have passed since then with no sign of any supplementary evidence, so I deduce that the opponent does not actually want to file any. However, just in case I am wrong, I will allow the opponent two weeks from today to file supplementary evidence in connection with this document should they wish to do so.

15. The first set of proceedings has already been going for a year, and I believe it is time they were concluded. The referrer has yet to file its evidence in reply, and I allow it two months from today to do this. I have set a period which overlaps with the two weeks I have allowed

the opponent in order to expedite the proceedings, but should the referrer feel it needs a short extension to deal with any supplementary evidence filed by the opponent, it is at liberty to come back to me. Whatever happens, on this timetable the case should be ready for substantive hearing by the beginning of December, and I will therefore ask our Hearings Clerk to set a date for that hearing now. It should preferably be in December, and certainly no later than January.

16. With regard to the second set of proceedings with respect to the applications numbered 9818184.5, 9818186.0, 9818187.8 and 9818188.6, the statements of case are complete and normal periods for the evidence rounds can be established from the date of this decision. Accordingly the referrer now has two months to file its evidence in chief.

Appeal

17. As I have, with the agreement of all the parties, given no reasons for my decision, it is difficult to conceive of any basis on which an appeal could be launched. Nevertheless, the right of appeal is formally there. Accordingly I must say that, this being a procedural matter, any appeal from this decision should be lodged within 14 days.

Dated this 15th day of September 1999

P HAYWARD

Divisional Director, acting for the Comptroller

THE PATENT OFFICE