

PATENTS ACT 1977

BETWEEN

GMC Tools (UK) Limited

Opponent

and

Makita Corporation

Proprietor

PROCEEDINGS

Opposition to a request under section 117 of the Patents Act 1977
to correct patent number EP(UK) 0570903

HEARING OFFICER

P Hayward

DECISION

- 1 Makita Corporation are the proprietors of patent number EP(UK) 0570903 for a mitre saw. They have asked the comptroller to correct a mistake in the description and claim 2. A particular gear is currently described as a “spur gear” but it should, say Makita, be described as a “bevel gear”.
- 2 Requests for correction are normally non-contentious and straightforward. After all, rule 91(2) of the Patents Rules 1995 requires the correction to be:

“. . . obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.”

However, the present request for correction is not proving straightforward because it has been opposed by GMC Tools (UK) Limited (“GMC”). Not surprisingly, there is more behind this. GMC are pursuing a revocation action in the Patents County Court which is due to be heard on 5 June. The alleged mistake has, I assume, come to light during that revocation action.
- 3 Makita are anxious for the comptroller to decide the allowability of the correction before the case is heard in the Patents County Court. GMC, on the other hand, argue that the comptroller should stay the request for correction until the court

has disposed of the revocation action. Thus what I must decide now is not whether the request for correction is allowable, but simply whether the request should be stayed.

- 4 GMC are represented by Lupton Fawcett LLP and Makita by patent attorneys J A Kemp & Co. Both sides have agreed that I should decide whether to stay on the basis of their written submissions, without an oral hearing. That is a very sensible and proportionate way of dealing with the matter. It has also made it easier for me to deal with the request for a stay fairly quickly, an important factor given the imminence of the trial. It does have the slight disadvantage that the arguments are not quite as full as they might have been had there been a hearing, but I've got enough.
- 5 As always when exercising discretion in a situation like this, I need to take account of all the relevant factors and decide whether the balance lies in favour of or against a stay. In the present case, if I can step back and generalize the submissions from each side, the key questions fall into two categories. First, to what extent are the issues that need to be assessed in deciding the revocation and corrections actions the same? Second, what could be the impact on the court proceedings of dealing with the correction first, and vice versa?
- 6 I will start with one aspect of the first question by looking at the grounds being advanced in the two actions. In the revocation action, there is dispute about what was common general knowledge at the priority date of the patent. In a simple bevel gear drive, the two axes are at right angles. In what I shall call for the purposes of this decision an "angled bevel drive", the two axes are not at right angles. In the revocation action, as a defence against an attack under section 3 that the claims are obvious, Makita argue that angled bevel drives were not part of the relevant common general knowledge. GMC argue they were. Both sides have produced evidence from expert witnesses on this point.
- 7 In their request for correction, Makita assert that it would be immediately evident to the skilled reader that the gear in question – which is part of an angled drive – is a bevel gear and not a spur gear. GMC say this argument is inconsistent with the argument Makita are advancing in the revocation action. If, as Makita allege in that action, angled bevel gears are not part of the common general knowledge, it cannot be said that the correction is obvious as required by rule 91(2). GMC submit that the proper forum for deciding whether or not angled bevel gears were part of the common general knowledge is the revocation action, where the expert evidence will be tested in cross examination, and that the correction action should therefore be stayed until the court has ruled on this point.
- 8 Makita take a different view. They argue that obviousness in the context of section 3 is quite different from obviousness in the context of rule 91(2). Obviousness in the latter context, they say, is not about common general knowledge but about what the skilled reader would have understood from the specification. Thus what the court decides is common general knowledge for the purposes of section 3 will have no bearing on whether the correction should be allowed under rule 91(2).
- 9 With one possible proviso, I agree with Makita. The proviso is that if angled bevel

gears were a long way outside the common general knowledge, there may be an argument that the skilled reader would not have been able to recognize what is shown in the drawing and so the correction wouldn't have been immediately evident. However, although I haven't been through his evidence in detail, my impression is that not even Makita's expert is suggesting that angled bevel gears were quite that foreign.

- 10 However, there is another aspect to this. Deciding whether the correction is obvious could in principle require expert evidence, and I think I can reasonably assume that the parties would rely on the same expert evidence as that already submitted in the revocation proceedings. Indeed, they have already implicitly done so. That evidence will be tested in court, and the court will have to assess the credibility of the witnesses. If the comptroller has to go through the same process, will that lead to unnecessary duplication and/or the risk of inconsistent conclusions?
- 11 This is a point I must consider, even though the parties have not raised it in quite these terms. In my view, the chances of duplication or inconsistency are relatively small. I say that in part because if the comptroller goes ahead and deals with the correction, the court and the comptroller will be looking at different aspects of the expert evidence. Thus if the court preferred the evidence of expert A over that of expert B in respect of common general knowledge, it doesn't follow that the comptroller ought to prefer A over B in respect of the obviousness of the correction unless the court has condemned B as a totally discredited expert. The comptroller would have to look at the matter separately.
- 12 There is, though, an even more pertinent point. As Makita have pointed out, GMC's own expert says:

"However, it is very strong in my mind that this claim [*ie claim 2*] must contain an error as it does not make any sense to an engineer. . . . If there is an error in the claim and the claim should read ". . . and a bevel gear mounted on said motor shaft" . . ."

Makita's expert says much the same thing, that an error is evident in that the so-called "spur" gear is actually an "angular bevel pinion". Thus on the face of it there is probably little disagreement between the experts on this issue, so that makes the chances of duplication or inconsistency very small indeed.

- 13 So, on what I identified as the first key question, the balance in my view is tilted towards going ahead with the correction action. However, what about the second key question, the impact of each proceeding on the other? The first obvious point is that although Makita want the correction request to go ahead so that it is resolved before the trial of the revocation action, I cannot achieve that without riding roughshod over GMC's rights. There are less than four weeks to go before the trial, and even if Makita are willing to curtail the periods which they would normally be given to file evidence in the correction proceedings, it would be quite unreasonable to force GMC to do the same.
- 14 What, then, will be the impact on the revocation proceedings if the correction request hasn't been disposed of before the trial? Makita say the Patents County

Court action will have to proceed on the basis of a corrected and a non-corrected specification in the alternative, and that this will “lead to a significant increase in costs” and “extend the evidence and legal argument to a significant degree”. This is an unconvincing argument coming from Makita, because the whole thrust of their case for correction is that it is utterly obvious – ie that there is nothing much to discuss. Moreover, the correction only affects a subordinate claim, claim 2, and whilst that won’t obviate the need for the parties to address the matter, it isn’t fundamental to the core issue in the revocation action which will, I assume, focus primarily on claim 1. Thus failure to conclude the correction action before 5 June is likely to have only a limited effect on the revocation action.

- 15 That doesn’t in itself justify a stay as the two actions could proceed in parallel. However, having to handle two disputed actions simultaneously increases the burden on the parties and their witnesses. Further, whilst disposing of the correction action won’t dispose of the revocation action, disposing of the latter could dispose of the former in that if the patent were revoked, there would be nothing to correct. Indeed, even if the patent is not revoked, it will not surprise me if the revocation action does indeed effectively dispose of the correction request, either because GMC drop their opposition to the request or because Makita abandon the request. Together, these factors weigh in favour of a stay.
- 16 Thus there are, not surprisingly, factors both for and against staying. Taking everything into account, I have come to the conclusion that the overall balance is in favour of staying until the revocation action is disposed of.
- 17 I have to say that the most efficient solution all round would be for the court to deal with the correction request whilst it is dealing with the revocation action. Unfortunately, as I read the legislation I have no power to refer the matter to the Patents County Court and that court has no jurisdiction to decide it, so that is not an option.
- 18 There is one other point I must address. Makita have asked for security for costs if the current proceedings are stayed or a hearing appointed. GMC have not really had a proper chance to respond to this, but I have to say I can see no grounds whatsoever for ordering security whilst the proceedings are stayed, because whilst they are stayed Makita are not running up any costs. This point should be addressed if and when the proceedings resume.

Order

- 19 I order that the present proceedings be stayed pending the resolution of the revocation action in the Patents County Court. Nevertheless, should there be a significant change in the circumstances, the proprietor is at liberty to come back to the comptroller to request that the stay be varied or lifted.
- 20 Neither side has asked for costs in respect of this preliminary matter, so I make no order at this stage. Any costs in respect of the request for a stay can be dealt with when the substantive issues are addressed.

Appeal

- 21 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

P Hayward

Divisional Director acting for the Comptroller