

PATENTS ACT 1977

IN THE MATTER OF

an application by Contra Vision Limited
to amend Patent Number GB 2165292 C
and an opposition thereto by Clear Focus Imaging Inc

DECISION

Introduction

1. Contra Vision Limited ("Contra Vision") applied to the comptroller to amend the specification of Patent No GB 2165292 C ("the UK patent"). The application stands opposed by Clear Focus Imaging Inc ("Clear Focus"). The matter came before me at a hearing and was the subject of my decision of 3 March 2000. My decision on the request to amend is summarised in paragraph 59, which reads:

“59. In summary, having considered carefully all the evidence and argument before me, I refuse the request to amend the patent on the grounds that:

⊘ the proposed amendment to claim 1 at least does not cure the stated defect, in that it does not serve to distinguish the claim over the prior art;

⊘ the request, at least insofar as it relates to claims 95, 126, and 134, adds new matter in contravention of section 76;

⊘ the request as a whole introduces unacceptable prolixity of claims.”

2. Paragraphs 60 and 61 of the decision went on to propose next steps. They read:

“60. I am inclined to the view that Contra Vision should be allowed an opportunity to submit revised amendments to the patent to remedy the deficiencies I have found

currently to exist in the proposed amendments, and in such a way that others are not introduced. The sort of order I have in mind might take the following terms:

“Considering it appropriate in the circumstances of the present case, I hereby allow the proprietor a period of two months within which to submit to the Patent Office revised proposals for amendment with a view to overcoming the deficiencies I have found in the present ones. The proprietor should send a copy of the revised proposals to the opponent, who will then have a period of one month from the date of receiving the copy within which to submit any comments to the Patent Office, copied to the proprietor. I will then determine how matters should proceed. It being clear from my findings that the amendments as a whole are not acceptable in their present form, I must therefore refuse them if the position remains as at present. Thus, if no revised amendments are submitted by the proprietor within the period I have set, I will issue a decision refusing the application to amend.”

61. This procedural course was not, however, canvassed at the hearing, and I do not think I should make any order laying down such a procedure without first giving the parties a chance to comment on it, both as to the principle and as to its detail. I therefore allow both parties two months from the date of this decision within which to consider and comment on the notion and content of the draft order set out in the previous paragraph. After that period, I shall consider any comments submitted in deciding how to proceed.”

Submissions

3. In a letter of 10 April 2000, the applicant raised issues concerning the period for appeal from my decision. Clear Focus took a different view of those issues, which were settled in a decision of the Hearing Officer, Mr Hayward, of 13 April 2000. I shall return to the consequence of that decision in due course.

4. On the substantive point about the draft order, in correspondence the applicant has

confirmed its acceptance of the terms of the draft order. The opponent on the other hand has suggested that the appropriate further course of action in these proceedings would be for me to refuse the current application to amend; in the opponent's view, this would be the normal consequence of my finding that the amendments as a whole are not acceptable in their present form. It argues that to give the applicant a further opportunity to amend within the present proceedings is tantamount to enabling the applicant to make a further application within them rather than, in the normal way, having to commence new proceedings. The opponent also points out there may be an effect on parallel proceedings under section 71 which are presently stayed. For these reasons, the opponent opposes the draft order. The applicant's response to these arguments is that the way forward proposed in my decision achieves a resolution of the issue of amendment in the shortest practical time, and contrasts that with the significant additional delay which fresh amendment proceedings would incur.

5. Both parties have since indicated that they are content for me to settle this point on the basis of the papers on file, which I shall now do.

Reasoning

6. The opponent's argument in short seems to be that since I have found that at least some of the amendments are bad, I should refuse the whole application, and indeed that it would be normal for me to do so. They add that it would also be normal for the applicant, if it wished to pursue its desire to amend the patent, to be forced to launch a fresh amendment application. I have to say that I do not believe that such a course would indeed be "normal" in proceedings before the comptroller. More than that, I am not persuaded that it would be sensible, especially in the present case where the proceedings are procedurally far advanced. Rather than drive the applicant to making an entirely fresh application, with the procedural timetable and implications that has, it seems to me by far the better course to allow it to submit fresh amendments in these proceedings, provided there is no overriding bar to the consideration of further amendments. The opponent has not suggested that such a bar exists, for example on the issue of discretion, and I do not see one.

7. On this basis, I am not of the view that the opponent has made out a case against the draft order, bearing in mind the applicant's agreement to it. For that reason, I am now prepared make the order formally. I should, however, make clear that in doing so I am not envisaging a continuing process of iteration. The onus is on the applicant to get its amendments substantially right at this second bite of the cherry.

Order

8. Considering it appropriate in the circumstances of the present case, I hereby allow the proprietor a period of two months within which to submit to the Patent Office revised proposals for amendment with a view to overcoming the deficiencies I have found in the present ones. The proprietor should send a copy of the revised proposals to the opponent, who will then have a period of one month from the date of receiving the copy within which to submit any comments to the Patent Office, copied to the proprietor. I will then determine how matters should proceed. It being clear from the findings in my decision of 3 March 2000 that the amendments as a whole are not acceptable in their present form, I must therefore refuse them if the position remains as at present. Thus, if no revised amendments are submitted by the proprietor within the period I have set, I will issue a decision refusing the application to amend.

Costs

9. As in the earlier decisions of 3 March and 13 April, consideration of the question of costs is deferred.

Appeal

10. As this is a decision other than on a matter of procedure, any appeal against it shall be filed within six weeks from the date of this decision.

11. Moreover, as a consequence of paragraph 8 of the decision of the Hearing Officer of 13 April 2000, by which he extended the period for appeal against my decision of 3 March 2000, any appeal against that decision of 3 March shall be filed within six weeks from today.

Dated this 7th day of November 2000

S N DENNEHEY

Divisional Director, acting for the comptroller

THE PATENT OFFICE