

patent involving the introduction of dependent claims so as to provide a fall-back position would ever be acceptable on discretionary grounds.

The *Sara Lee v. Johnson Wax* judgement should be applicable in post-grant amendment proceedings before the UK Patent Office, where validity is not normally called into question. If a proprietor becomes aware of prior art or arguments which cast doubt on the validity of a granted independent claim, the proprietor should not be able both to maintain that claim (which would be an obstacle to trade) and to introduce new dependent claims (to provide a fall-back position).

The judgement is consistent with current EPO practice in opposition proceedings. Although a patent proprietor may present a main request and a series of auxiliary requests, each based on different versions of the independent claims under attack, it is not permissible to provide a fall-back position by introducing new dependent claims. All amendments submitted during opposition proceedings must be directed to meeting grounds of opposition: the introduction of new dependent claims cannot fulfil this requirement.

If the judgement in *Sara Lee v. Johnson Wax* had gone the other way, it would beg the question: why stop at inserting only one or two new dependent claims? Why not advance a cascade of fall-back claims of decreasing scope? If an independent claim were challenged at some future stage, the proprietor would have a range of dependent claims to assert, each incrementally narrower than the one before. The proprietor could maintain and assert them all, leaving the Comptroller or Court to decide in revocation proceedings how far one must descend the cascade before the prior art is avoided. Not only would this have the potential to extend hearings substantially, with a consequential increase in costs, but in the meantime it would also be unfair by leaving third parties uncertain as to the valid scope of protection.

Christopher Thornham and Dudley Hawkins

Case referred to:

1. Chancery Division, Patents Court – Judgment 20 December 1999; see also January [2000] CIPA 28
2. (1950) 67 RPC 226 at 230, lines 1-9
3. (1998) RPC 727 at 790, lines 32-37
4. EPO Technical Board of Appeal decision T0829/93
5. Court of Appeal – Judgment 24 November 1999

Stamp Duty errata

The telephone numbers for enquiries from the Inland Revenue on stamp duty on documents recording intellectual property transactions given in both para. 30.10 of the Fifth Supplement to the *C.I.P.A. Guide* and in the current Membership List were either wrong or have been changed. The current numbers for the Stamp Office in Newcastle-upon-Tyne are – Tel: 0191 261 1282; Fax: 0191 230 4262. Enquiries should be made to Mr. Archie Brown, Deputy Director.

The *C.I.P.A. Guide* also states that a document which records an agreement to assign intellectual property rights, but does not actually do so, is itself stampable as if it were the actual assignment. However, a recent discussion with Mr. Brown revealed that this is only so as regards an agreement to assign United Kingdom rights. Thus, if a "global" assignment of intellectual property rights is prepared in the form of an agreement for future assignment, coupled with a "further assurance" clause to require execution of an actual assignment upon demand, then such document is only stampable as regards the consideration for the UK assignment, even if this agreement to assign is executed in the United Kingdom, see now Finance Act 1999, Sched. 13, para. 7(1)(b)(v). Such an arrangement can then lead to individual assignment documents for the separate countries covered by the global agreement, but (for foreign IP rights) these must be executed and kept off-shore to avoid UK stamp duty thereon. If the agreement to assign is eventually terminated before the assignments take place, it appears that any stamp duty which has been paid upon that agreement can be recovered from the Inland Revenue.

It is suggested that clients should be encouraged to avoid global assignments of IP rights because of the difficulty of registering these in the various countries covered; and the arrangement of having the head agreement as one to assign at a later date has much merit, not only for reduction of UK stamp duty liability but as a matter of administrative convenience, leading to the subsequent creation of individual national stand-alone assignment documents in the required language for registration purposes, thereby avoiding translation costs.

Alan W. White