

THE PATENT OFFICE

FOS: 18

Room 1Y31
Concept House
Cardiff Road
Newport
Gwent, NP9 1RH

Tuesday, 14th September, 1999

Before:
THE DEPUTY DIRECTOR
(Mr Bruce Westerman)

(Sitting for the Comptroller-General of Patents, etc.)

In the Matter of THE PATENTS ACT 1977 s.73(2)

and

In the Matter of IBS LICENSING LIMITED

For the Proprietor to show cause why
Letters Patent No GB2240751 should
not be revoked

Transcript of the Shorthand Notes of Harry Counsell (Wales)
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(Tel: 01792 773001 FAX: 01792 700815)
Verbatim Reporters

MR R A GIBSON appeared on behalf of the Proprietors

MR KARL WHITFIELD (Examiner, The Patent Office)

APPROVED DECISION

THE DEPUTY DIRECTOR: Application 9026696.5 was filed on 7th December 1990 by Peter Alvin Ritson, and the application was granted with effect from 22nd December 1993 under the number 2240751. An entry in the Register of Patents dated 20th December 1994 records an assignment of the patent from Mr Ritson to the current proprietors IBS Licensing Limited.

In October 1997 the Comptroller became aware that European Patent 0504246 designating the United Kingdom was granted on 11th September 1996. In an official letter dated 10th October 1997 the examiner stated that in his opinion UK Patent 2240751 and EP(UK) 0504246 related to the same invention, and he indicated that revocation of the UK patent under section 73(2) was under consideration. The letter invited the proprietor to submit observations and/or proposals for amendment, and gave a period of three months within which these should be filed.

In a letter dated 17th November, Mr Gibson for IBS Licensing Ltd said that they had not previously been aware of the EP(UK) patent, and he asked whether assignment of the EP(UK) patent would be automatic. In the Office reply the examiner said that it would not be so, but explained the possibility now that the EP(UK) was granted, of registering the change of ownership with the UK Office. In the circumstances the examiner allowed a further two months for observations and/or proposals for amendments to be filed.

Mr Gibson wrote again on 23rd December 1997 asking for copies of forms to effect the assignment of the EP(UK), which were supplied with an Office letter dated

7th January 1998 . This letter also reminded the proprietor of the date for submission of observations and/or proposals for amendment.

In a letter dated 23rd February 1998 Mr Gibson urged the Office not to revoke the UK patent before assignment of the EP(UK). He also included the sentence, "As I believe that the applications submitted to the UK and European Patent Offices were the same, I can see no merit in attempting to amend the patent at this time".

Mr Gibson contacted the Office in June 1998 and was supplied with a copy of the EP(UK) as granted. On 6th August 1998 the examiner wrote reiterating the section 73(2) situation and noting the filing of Form 21.77 to register the assignment of the EP(UK) patent, and on 26th November 1998 again wrote, in this case noting that the assignment of the EP(UK) had been registered on 28th October 1998, in both cases with further extensions of time to respond.

On 18th March 1999, after the expiry of the latest period, an Office letter was issued stating that the Comptroller would decide the matter, subject to the right to be heard. Mr Gibson wrote on 31st March 1999 indicating that he did not feel the patent should be revoked, and asking for a hearing.

The matter then came before me on 14th September 1999 with Mr Gibson appearing for IBS Licensing Ltd. Mr Whitfield was present as the examiner on the case. The proceedings were under section 73(2) of the Patents Act 1977, which was amended by the Copyright, Designs and patents Act 1988, and reads:

"If it appears to the Comptroller that a patent under this Act and a European Patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the Comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the Comptroller shall revoke the patent".

It is a matter of record that both the UK patent and the EP(UK) declare the same priority application GB8927667.9, and both were filed by Mr Ritson.

As I have noted above, the proprietor has been given the opportunity to make observations and/or to amend the specification. In response to the need to safeguard his rights by ensuring the EP(UK) was properly registered in his name, the examiner in my view quite rightly deferred the action until this was so.

The only comment in the proceedings regarding the issue as to whether the two patents relate to the same invention is the sentence I quoted above, which I take to be an admission that they do in fact protect the same invention. At the hearing Mr Gibson confirmed that this was the case, and he accepted that the patents were in fact for the same invention. His main concern expressed at the hearing was a commercial one, as to whether the loss of the GB patent by revocation would in any way undermine or affect his company's finances. However, I have to work under the law, and I do not consider that this is something I could take into account, given the mandatory nature of section 73 (2).

I have carefully considered the relationship between the claims of the two patents, and in light of the admission by the proprietor I am satisfied the conditions of section 73 (2) are met. I therefore order the revocation of UK Patent 2240751.

This being a substantive matter, this decision may be appealed by filing the appeal within six weeks from today. However, since this is an oral decision and it will take some time to get a formal copy of the transcript, if there is a need to extend the time for appeal (if an appeal is under consideration) then the Comptroller will be minded to provide an extension. However, if an extension is needed you must approach the Comptroller before the expiry of the six week period, and you should be clear that you would not normally be given more than one extension to that period.

That concludes my decision.

B WESTERMAN

Deputy Director
Acting for the Comptroller