

**PATENTS ACT 1977**

IN THE MATTER OF section 73(2) and of  
Patent No 2,152,377 in the name of  
Albright & Wilson Limited

BLO 1/142/94

**RESCISSION OF DECISION**

A decision by Mr G C Brown, acting for the Comptroller, dated 14 March 1994, and, based on the papers on file, revoked patent no 2155377 under section 73(2).

The decision referred to no reply having been received either to an official letter dated 22 November 1993 setting out the examiner's objection under section 73(2), or to a letter of 28 January 1994 allowing 21 days to request a hearing.

However, a letter dated 2 March 1994 from the proprietors was received in the Office on 3 March 1994 and proposed an amendment of claim 1 of the specification. Unfortunately this letter did not reach the file, due in part to movement of the file between London and Newport, before Mr Brown reached his decision and the decision was issued. The failure of the file to contain all the relevant papers before the hearing officer reached his decision is an irregularity in procedure, despite this letter being filed outside the 21 days given by the official letter of 28 January 1994. This irregularity was detected before any other action was taken apart from issuing the decision to the proprietor. In particular, no entry of the revocation has been entered on the register of patents.

In the circumstances, I rectify the irregularity, under Rule 100 of the Patents Rules 1990, by rescinding the decision to revoke the patent. I refer the matter back to the examiner to consider the proposed amendment, and to reopen the proceedings under Section 73(2).

Signed this 23<sup>rd</sup> day of March 1994

B G Harden  
Superintending Examiner, acting for the Comptroller



**THE PATENT OFFICE**

**PATENT ACT 1977**

01142/94

IN THE MATTER OF section 73(2) and  
of Patent No. 2,152,377 in the name of  
Albright & Wilson Limited.

**DECISION**

This decision follows objection by the examiner that the above patent is for the same invention as European Patent (UK) 0 147 207 and should consequently be revoked under section 73(2).

The applicant has not responded to an official letter of 28 January 1994 allowing 21 days in which to request a hearing and this decision is, therefore, based on the papers on file.

The patent in suit derives from UK Application 8432386.4 made by Tenneco Organics Limited, and was assigned to the present patentee in 1988. It has a declared priority date of 22 December 1983, based on UK Application No. 8334249 and relates to a disinfectant, claimed in claim 1 as:

A concentrated disinfectant composition comprising a peroxy acid which is peracetic acid or perpropionic acid; hydrogen peroxide and a wetting agent characterised in that the wetting agent is an alkyl substituted aryl sulphonic acid.

Claims 2 – 20 are appendant to claim 1 and relate to preferred features of the invention.

European Patent (UK) 0 147 207 is in the name of the present patentee and claims the same priority date, based on the same UK application. It too relates to a disinfectant composition, which, following opposition in the European Patent Office, is claimed in claim 1 of the B2 document as:

A concentrated disinfectant composition consisting of : (1) a stable mixture comprising hydrogen peroxide, peracetic or perpropionic acid, and acetic or propionic acid; and

(2) a wetting agent, characterised in that said wetting agent consists of free alkyl benzene sulphonic acid.

Claims 2 – 19 of the European (UK) Patent are appendant to its first claim and, in the main correspond to claims 2 – 19 of the UK patent.

It will be noted that there are a number of differences between the UK and European claims quoted above. In particular:

(a) mixture (1) in the European claim must be stable, whereas the corresponding peracetic or perpropionic acid of the UK claim is not limited in this way and

(b) the alkaryl sulphonic acid wetting agent of the UK claim is limited in the European claim to an alkyl benzene sulphonic acid.

It was suggested by the patentee, in an agent's letter of 5 May 1993, that in the light of these differences the two patents cannot be said to relate to the same invention. However, the examiner did not accept this. He submitted, in an official letter of 7 July 1993 that the two claims, although not identical, relate to essentially the same monopoly. Although the UK claim is not limited to stable peracids, the claim clearly covers such acids and is exemplified in the description by essentially the same compositions as those disclosed in the European specification. Similarly, in the examiner's submission, the use of an alkyl benzene sulphonic acid is covered by the UK claim and illustrated in the disclosure of the UK specification.

In a further agent's letter of 12 July 1993, the patentee maintained that the only significant question was whether or not the two claims protected the same monopoly and argued that they did not. In the patentee's submission, the nature of the disclosures on which they were based was not relevant.

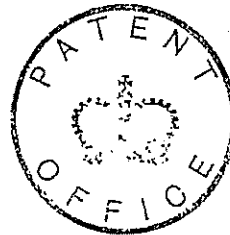
Following this letter, proceedings were stayed to await a decision of the Court of Appeal on what appeared to the examiner to be a similar situation. Marley Roof Tile's UK Patent (now Marley (UK) Limited's Patent) 2,101,984 claimed a concrete article *per se*. A corresponding EP(UK) Patent had a similar disclosure, but claimed the article only when made by a particular process. The High Court had found that these two patents were not for the same

invention ([1992] FSR 614). However, the Court of Appeal concluded that since the invention protected by the UK Patent was also protected by the EP(UK) Patent the two patents were for the same invention.

The examiner's objection in the present case was pursued on the basis of the Marley decision in an Official Letter dated 22 November 1993. The applicant did not respond to this letter.

I have reviewed the claims and disclosures of the UK Patent before me and its EP(UK) equivalent, on the basis of the Marley decision, and I am satisfied that, although the claims of these two patents are not of identical scope, they are in similar relationship to the claims considered by the Court of Appeal. Accordingly, I find that the two patents are for the same invention and that the UK Patent, should be revoked in accordance with the provisions of section 73(2).

Dated this 14 day of March 1994



G C BROWN

Principal Examiner, acting for the Comptroller.

**THE PATENT OFFICE**