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PATENTS ACT 1977

Pat / Linda  
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IN THE MATTER OF an application under  
Section 72(1) by Ray Oil Tool Co Ltd for  
revocation of GB Patent No. 2285649 in the  
name of Downhole Products (UK) Limited

DECISION

On 14 May 1996 Ray Oil Tool Co Ltd applied to the Comptroller for an order revoking GB Patent No. 2285649. They have now asked the Comptroller to agree, by issuing a certificate under section 72(7)(b), that the question is one which would more properly be determined by the courts. They are seeking this because the patentees have subsequently launched an infringement action against them in the Scottish courts, and they wish to put the validity of the patent in issue under section 74 by way of defence to that action. In that defence they propose to rely on each of the grounds of revocation set out in the present application. Provided the Comptroller issues the certificate, they also wish to terminate the present proceedings before him.

It would clearly be undesirable for exactly the same issues to be litigated both before the Comptroller and before the Court of Session in Edinburgh. The patentees themselves have agreed that the question of whether the patent should be revoked would be best dealt with by the Court of Session as part of the infringement action. In these circumstances, I too agree that the court would be the more appropriate forum. Indeed, it would be foolish for the Comptroller to attempt to maintain his jurisdiction against the wishes of both sides.

Given the patentees' agreement, Ray Oil Tool Co Ltd probably do not strictly need a certificate from the Comptroller in order to raise the question in the court proceedings because of the provisions of section 72(7)(a). However, I think a certificate would still be desirable, if only as a way of formally terminating the proceedings before the

Comptroller.

Accordingly, I certify that it appears to me that the question of whether the patent should be revoked is one which would more properly be determined by the court, and direct that the revocation proceedings before the Comptroller be treated as withdrawn.

As this is a procedural matter, any appeal against this decision must be lodged within 14 days.

Dated this 9<sup>th</sup> day of January 1997

**P HAYWARD**

Superintending Examiner, acting for the Comptroller



**THE PATENT OFFICE**