

## PATENTS ACT 1977

IN THE MATTER OF an application  
for Patent No 79 07693 by  
Societe Anonyme dite : Alsthon-Atlantique

## DECISION

Application No 79 07693 was filed on 5 March 1979 and proceeded through preliminary examination to substantive examination. Examiner's reports under Section 18(3) were issued on 10 June and 14 December 1982 and in the second of these reports the applicant was informed that a reply had to be filed within four months. No such reply was received and had still not been received when the four and a half year period prescribed by Rule 34 for putting the case in order had expired, this being on 5 September 1983. No request for extension of the period was made under Rule 110(3) and the application was consequently refused. An announcement to this effect was made in the Official Journal and the Register shows that the application was treated as refused on 18 January 1984.

On 2 February 1984 two letters and copies of amended pages of the specification were received in the office from the applicants' agents, CAS Behrens & Co. The letters were signed by Mr Marland, the agent prosecuting the case, and in them he sets out the reasons for the delay. This application is one of seven which were overlooked in the same circumstances and I am satisfied from the explanation provided by Mr Marland that the cause of the delay resided in the Paris office of the industrial property organisation known as SOSPI where Mr Marland was employed as a British agent and in his oversight when transferring cases to London and that no blame can be laid at the door of the applicant company.

Mr Marland requested that the Comptroller exercise his discretion to extend the time limits for replying; alternatively that the specification which was on file at the time be deemed to have been in order. As I see it, there is no provision in the Act or Rules which gives me the power to extend the time limit as required. I have therefore considered the alternative request and the application was accordingly referred to the examiner to reconsider the objection raised in the Official letter dated 14 December 1982

and to report on the possible acceptability of the application as on that date. She has reported to me that indeed the objection could be waived and the specification regarded as in order. Having looked into the matter myself, I am satisfied that this conclusion is correct and the application, in the form in which it existed before the Official letter of 14 December 1982, may be said to have complied with the requirements of the Act and Rules.

It follows therefore that the entry in the Register on 18 January 1984 that the application was treated as refused was an irregularity in procedure on the part of the Office and under the provisions of Rule 100 I cancel this entry and direct that the Register be amended accordingly.

A complication of the earlier announcement is that any member of the public would have been free to take advantage of the disclosure and to exploit the invention. Resuscitation would be a serious blow to such a person and I must have regard for his interest. Rule 100 allows me to apply such terms as I think fit and it seems reasonable to me that protection for third parties should be on the same lines as is provided in restoration proceedings under Section 28. As far as renewal fees are concerned, the situation is unaffected by these events and payment must be made in accordance with Rule 39 as though no lapse occurred.

Thus, I allow the application to proceed to grant subject to the following terms:-

"That any person who, between 18 January 1984 (the date on which the application was treated as refused) and 22 March 1984 (the date of the decision cancelling the earlier announcement in the Register), has done or begun to do in good faith an act which would constitute an infringement of the patent if it were in force or has made in good faith effective and serious preparations to do such an act, shall have the right -

- a) to continue to do or, as the case may be, to do that act himself; and
- b) if it was done or preparations had been made to do it in the course of a business, to assign the right to do it or to transmit that right on his death or, in the case of a body corporate on its dissolution, to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it, or to authorise it to be done by any partners of his for the time being in that business;

and the doing of that act by virtue of these rights shall not amount to an infringement of the patent concerned.

These rights shall not include the right to grant a licence to any person to do an act so mentioned.

Where a patented product is disposed of by any person to another in exercise of these rights, that other and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor."

Dated this *22<sup>nd</sup>* day of *March* 1984



N G TARNOFSKY

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE