

PATENTS ACT, 1949 AND 1977

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14 OCT 1981

SCIENCE REFERENCE BY

IN THE MATTER OF an application by  
Rank Xerox Limited for the Revocation  
of Patent No 1485710 in the name of  
Gerhard Ritzerfeld

#### DECISION

Revocation of the patent has been sought on the grounds of prior publication, prior use and obviousness having regard to the said publication and use.

The application was filed on 10 January 1979, and in a letter dated 2 March 1979 the patentee's agents notified the Office that the patentee deceased on 9 February 1978 and that they were now being authorised to act on behalf of his beneficiaries.

A counterstatement was filed on 11 April 1979 in which patentee's personal representatives offered to amend the claims of the patent, and a print of the specification showing the proposed amendments followed on 28 June 1979, accompanied by an indication that these amendments were conditional upon their being regarded by the applicants as disposing of the revocation action.

Evidence in support of the application was then filed and the beneficiaries responded on 7 February 1980 by filing Form 18/77 offering to surrender the patent. At this stage it was pointed out in an official letter dated 15 February 1980 that since they were not yet confirmed as proprietors of the patent, no action could be taken in respect of the offer until other formalities were completed.

The patentee had been domiciled in West Berlin, and considerable difficulties appear to have been experienced in obtaining a grant of probate and the appointment of a personal representative in the United Kingdom, and it was not until July of this year that the beneficiaries were in a position to complete the necessary assignment.

Meanwhile, the patent in suit lapsed irrevocably on 9 April 1981, and thus, there being no patent in force to assign, it was no longer possible to formalise the offer to surrender. No action in respect of the Form 18/77 will therefore be taken, and it is to be observed that in any case, under the terms of the

Patents Act 1977 such offer would not have been sufficient to conclude the revocation proceedings. Likewise the lapsing of a patent does not result in the automatic termination of such proceedings.

In the circumstances therefore, since the intended beneficiaries have clearly indicated by their actions in not filing evidence in response to the invitation contained in the official letter of 7 January 1980, by attempting to surrender the patent and in allowing it to lapse, that they are not prepared to pursue the matter, I regard the revocation proceeding as now being undefended. Accordingly, I shall confine my attention to the specification in its form as published and, in dealing with the issues raised, I must assume that the truth of every statement made by the applicants in their statement of case has been conceded, unless it is contradicted by facts to be found elsewhere in the documents filed.

The patentee's invention is concerned with a masking means for use with copying apparatus and is defined in its broadest terms in claim 1 (the other claims being directly appendant to claim 1) as follows:

"1 Masking means to partially mask an image of an original to be copied in sections by copying apparatus, the masking means comprising a tape provided with a series of masks, which are successively displaceable into a masking position relative to the original to partially mask the image thereof and which each have spaced first and second transparent portions respectively through which, in the masking position of the mask, an invariable first section and a variable second section of the image are visible for copying, the second transparent portion having a different spacing from the first transparent portion in each mask."

For their attack of prior publication and obviousness associated therewith, the applicants rely principally upon their own United Kingdom specification No 1206633, published in 1970, and relating to a document presentation device which may be used with a copying machine. The recital of prior art on page 1, lines 12-22, indicates that in many systems associated with copying machines it is required to copy a master document with various portions added or subtracted, eg to produce invoices, accounts, etc, all of which are derived from the same basic information. It is possible to arrange a master document with various overlays on a copying machine and to copy each combination in a separate operation, but when high speeds of copying are required an automatic system is desirable. Such a system is then described in the specification, using an overlay web 16 comprising a "tape" provided with a series of masks, the tape being

wound on a pair of rollers 17 and 18 and movable so that the individual overlays are in turn carried into an appropriate "masking" position. On page 1, at lines 69-74, it is stated that each overlay is printed on a transparent film "to add or subtract the required information to or from the master document". Thus, the specification does not specifically state that the overlays should possess both an invariable and a variable transparent portion, as is required by the claims of the patent in suit, and whilst it may be argued that this is implicit from the disclosure and particularly from the prior art recital mentioned above, I am not convinced that there is prior publication of the patentee's invention by reason of UK 1206633.

However, when considering the question of obviousness having regard to this document, I find the evidence of the applicant's witness Mr Martin, relating to the practice of modifying an original for copying by the use of masking techniques to be highly persuasive in demonstrating that those skilled in the copying art were already familiar, and had been for some time before the application date of the patent in suit, with the various possibilities of masking in order to modify an original. In consequence, I am satisfied that if at that time the notional skilled worker had been presented with the teaching of UK specification No 1206633 it would have been purely a routine matter for him to prepare a series of masks whereby one portion of an original was reproduced invariable in combination with successively different portions, and to assemble the series in the form of a tape or web for machine use. In this connection, it is observed that the second document relied upon by the applicants for obviousness, viz the article in "Reproduction", December 1973, is confirmatory of the witness's opinion that it was well known to use a series of overlays designed to enable a single master original to be modified, particularly in relation to dealing with invoices, orders, despatch notes etc. Accordingly, I find that claim 1 at least of the patent in suit is obvious having regard to UK specification 1206633.

Turning now to the allegation of prior use, I find that the evidence of Mr Norman, Chief Accountant of H G Sanders & Son Limited, establishes that a Rank Xerox 720 copying machine fitted with an automatic overlay device (AOD) was demonstrated by Rank Xerox in 1970 and that a similar machine together with the AOD device was installed by his company on 19 January 1971. Mr Martin confirms in paragraph 7 of his declaration that the AOD device of that machine included at that date, and still includes, a series of masks in web form with several of the masks having a first, fixed transparent portion at the top of the mask, with a second variable-position transparent portion revealing successive printed lines of information from a master on successive masks. The precise detail of the masks is shown in

his accompanying Exhibits MAM3-9, and further confirmation of the method of use is provided by Exhibit MAM-10 which indicates a web sequence chart. Thus there is clear evidence of the supply of the AOD device and associated webs by Rank Xerox to a customer, apparently without any restriction as to secrecy, and I find that these circumstances constitute a public prior use of the invention as claimed in at least claim 1 of the patent in suit.

In view of the above, there is no need for me to consider the remaining issue, namely that of obviousness having regard to the prior use.

In the result, therefore, having found the applicants to succeed in their allegations of prior use and of obviousness having regard to UK specification No 1205633, I order revocation of the Letters Patent.

In the particular circumstances of this case, I make no award of costs.

Dated this <sup>13<sup>th</sup></sup> day of *October* 1981

  
N B DEAN

Superintending Examiner, acting for the Comptroller



PATENT OFFICE