

0/84/91

PATENTS ACT 1977

IN THE MATTER OF a reference
under Section 37 by Telephone
Information Services and Michael
Brooke in respect of Patent No 2189369
granted to Michael Geoffrey Bere.

PRELIMINARY DECISION

Patent No 2189369 entitled "Telephone announcement systems" was
granted to Michael Geoffrey Bere who is also named as the
inventor.

Telephone Information Services and Michael Brooke (the
"referrers") have referred to the comptroller under section 37(1)
the following questions:

- a. whether Mr Bere or the referrers are the true proprietor of the patent in suit;
- b. whether Mr Bere or Mr Brooke is the true inventor;
- c. whether the patent should have been granted to Mr Bere or to the referrers or to Mr Bere and the referrers jointly; and
- d. whether all rights in the patent should be transferred to the referrers.

The reference was filed on 17 May 1990 accompanied by a statement of case under rule 54(1).

On 30 October 1990, Mr Bere (the "opponent") filed a counter-statement in accordance with rule 54(3) opposing the orders sought in reference.

At the referrers' request, the period for filing evidence in chief in support of their case under rule 54(4) was extended until 22 March 1991. Such evidence in the form of an affidavit by Mr Brooke was duly filed at the Patent Office on the final day of this period but the referrers omitted to send a copy to the opponent as required by rule 54(4).

The referrers' failure to comply with this requirement of rule 54(4) was brought to the attention of their solicitors in a telephone conversation with an official at the Patent Office on 9 April 1991. Following this conversation, the referrers' solicitors sent a copy of the evidence in chief to the opponent's agents under the cover of a letter 10 April 1991 which was received by them on the following day.

In his agents' letter dated 12 April 1991, the opponent contended that since the copy of the evidence was not sent until 10 April 1991, the evidence was inadmissible. This was contested by the referrers and it was subsequently agreed by both parties that the matter should be decided by the comptroller on the papers already submitted without a preliminary hearing.

The opponent's arguments for refusing to admit the evidence in question are contained in their agents' letter of 3 May 1991. These were first that the referrers' solicitors had previously failed to invite the opponent's comments on their earlier request for an extension of the period for filing the evidence in question as a result of which the opponent was not notified of the request until shortly before the normal period expired. Second, that the affidavit forming the evidence was largely irrelevant. Third, that the referrers' explanation in their solicitors' letter of 24 April 1991 regarding the failure to comply fully with the requirements of rule 54(4) was unhelpful.

On this latter point, I would agree with the opponent since the letter in question offers no explanation or apology. Instead,

it is merely contends that the referrers made every effort to file the evidence at the Patent Office in time and that no loss has been suffered by the opponents. Reference is also made to unreasonable requests by the opponent's agents and to the telephone conversation on 9 April 1991 with the Patent Office official but neither of these matters is strictly relevant to the failure by the referrers to send the required copy to the opponent on 22 March 1991.

Nevertheless, despite the unsatisfactory nature of the referrers' response, having considered the matter, I do not find that the grounds put forward by the opponent are such as to justify the extreme step of refusing to admit the evidence in question for what was no more than a technical irregularity which was rectified without delay by the referrers' solicitors once it was pointed out to them.

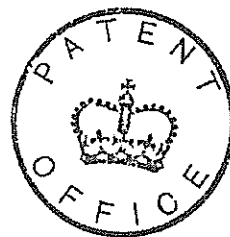
As a supplementary point, the opponent has requested in his agents' letter of 24 April 1991 that the period of filing evidence in answer under rule 54(5) should be suspended pending resolution of admissibility of the referrers' evidence in chief. The referrers have already stated in their solicitors' letter of 24 April 1991 that they have no objections to this and, in my view, it is not an unreasonable request.

In accordance with my findings above, I formally admit the referrers' evidence filed 22 March 1991 under rule 54(4). I also allow the opponent a period of two months from the date of this decision in which to file evidence in answer under rule 54(5).

Finally I hope both parties, will now proceed expeditiously, in accordance with the Patent Rules, with the substance of the

matter in dispute between them to avoid any further delays.

Dated this // day of July 1991.



B G Harden

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE