

IN THE MATTER OF an application  
for Patent No 8018653 by  
Kangaroos USA Inc (formally  
Envoys USA Inc)

## DECISION

Application No 8018653 was filed on 6 June 1980 claiming a priority date of 26 December 1979 and proceeded to substantive examination. After the applicants' agents had effected a succession of amendments to the application to deal with objections reported by the examiner and conveyed in series of official letters, the examiner reported that the amended application was still open to objection on the ground that there was no apparent difference in scope between two of the claims. This latter report was conveyed to the agents in a further official letter dated 15 November 1983 which specified a period for response of two months. The agents duly responded in a letter dated 5 December 1983 requesting cancellation of one of the claims in question, but enclosed with this letter was a Patents Form No 20/77 requesting registration of the applicants' change of name and unfortunately whilst the change of name was duly recorded the letter was not referred at the time to the examiner who therefore remained unaware of the request for amendment.

The result was that no further action was taken in regard to the application until the four and a half year period prescribed under Section 20 had expired in June 1984, and since at that stage it was the prevailing office view that the application did not comply with the requirements of the Act and the Rules, the application was treated as having been refused by the comptroller. An announcement to this effect was made in the

Official Journal and the Register shows that the application was treated as having been refused on 26 September 1984. The agents apparently only became aware of the fate of the application in July 1985 and they then wrote to the office enquiring why the Register contained the entry "Application refused or withdrawn."

The circumstances were explained to the agents in an official letter dated 16 August 1985, and in that letter it was acknowledged that there had been an irregularity in procedure attributable to the office and that since the examiner now reported that the application was in fact in order for grant as at 6 December 1983, i.e. the date of filing of the agents' letter dated 5 December 1983, it was proposed to issue a decision reviving the application. It was also indicated to the agents, however, that it was further proposed to afford protection to third parties who may have begun to exploit the present invention, or made serious plans to do so, in good faith between the date of the above-mentioned announcement in the Official Journal and the date of the decision, along the same lines as in restoration proceedings under Section 28 and as in unreported decisions on applications numbered 8025017 (Akebono Brake Industry Co.) and 8025017 (Coal Industry). In view of this latter proposal, a period of one month was allowed in which to request a hearing or submit comments. In the event, no hearing was requested but the agents objected to the proposed third party protection and submitted comments to be taken into account when deciding the matter.

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On the facts of the case, the office was clearly at fault in not taking the action requested by the agents in their letter of 5 December 1983 and I am able under the provisions of Rule 100 to rectify this very regrettable error. The amendment proposed, ie the deletion of claim 13, would have met the outstanding objection raised by the examiner and I am satisfied that the application so amended may be said to comply with the requirements of the Act and Rules. I therefore direct that the application be so amended. I further direct that the Register be

amended to cancel the entry that the application was refused or withdrawn.

Rule 100 also provides that any amendment made to rectify an irregularity may be subject to such terms as thought fit by the comptroller. It is here that the interest of third parties come up for consideration. In responding to the office view that protection is needed for third parties who may be caught by the resuscitation of the application, the agents have argued that this case is distinguished both from restoration applications and from the cases which are the subjects of the decisions referred to above. With regard to the former they point out that in those cases there has been a failure by the patentee to act within an allowed period, and with regard to the cited unreported decisions it was submitted that the circumstances of the applications to which those decisions relate were different from those of the present application which was put completely in order and the only failure was that of the examiner to forward the application for grant. In the agents' view, it was perfectly clear that their response to the official letter dated 15 November 1983 dealt satisfactorily with the only remaining objection and there was therefore no need for them to make any further checks with the examiner. They add that, if protection is afforded to third parties along the lines proposed, the applicants' rights would possibly be reduced and through no fault of their own.

As far as Section 28 is concerned, I fully accept that the position of the patentee in restoration proceedings is quite different from that of the applicants in the present case. I also have to agree that the particular circumstances in the Akebono and Coal Industry applications differ from those which have led us to the present situation. However, they have one factor in common with the present case and that is the possible existence of a third party who has seen the entry in the Register and, on the understanding that patent protection for the invention could not exist, took steps to operate the invention. Whatever blame may be apportioned between an applicant and the

office in such a situation, one thing is clear: the third party is blameless and should be protected from any possible charge of infringement. Section 28 sets out terms which provide such protection and it is for this convenience that the section is referred to. I recognise that the applicants' rights might as a consequence be diminished but the balance of justice in my view requires that such terms be applied.

Accordingly I allow the application, amended as outlined above, to proceed to grant subject to the following terms:-

That any person who, between 26 September 1984 (the date on which it was published that the application was treated as refused) and ~~24.09.84~~ 1987 (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.

As far as renewal fees are concerned, the situation is unaffected by the above events and payment must be made in accordance with Rule 39 as though no lapse had occurred.

This decision being in respect of a matter of procedure, a period of 2 weeks is allowed for appeal.

Dated this *14th* day of *October* 1985

N G TARNOFSKY  
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE