

PATENTS ACT 1977

01/61/94

IN THE MATTER OF an application under
section 27 by Securistyle Limited to amend
Patent No GB2081804B in the name of Securistyle Limited
and opposition thereto by Cego Limited

DECISION

Securistyle Limited filed an application to amend their patent GB2081804 on 18 April 1990 in order to more clearly distinguish it from prior art in GB1102048, effectively by combining claims 1 and 2, and to provide a new claim 4 to "provide specific protection for the preferred and commercial embodiment of the invention". The proposed amendments were advertised in the Official Journal(Patents) on 26 September 1990 and notice of opposition was filed by Cego Limited on 21 December 1990. The grounds for opposition are that:

1. the proprietor's conduct had been such that the amendments should not be permitted in the exercise of the Comptroller's discretion; and
2. the specification as amended does not comply with the requirements of section 76(2) and section 18(5) of the Patents Act 1977.

Statement and counterstatement and evidence were filed by the parties and the opponents filed an application for an order for discovery. Cego then filed an application for revocation of the patent under section 72 on 22 October 1991 and consequently the proceedings under section 27 were stayed under section 27(2) by an official letter dated 28 November 1991.

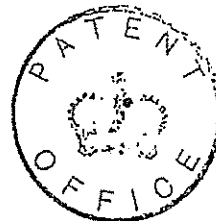
Cego informed the Patent Office in a letter dated 27 January 1994 that they had decided not to proceed with the application for revocation. As regards the application under section 27 they maintained their opposition and added that they did not intend to attend any hearing but were relying solely on their statement of opposition filed under rule 40(3).

The proceedings under section 27 were resumed in an official letter dated 21 February 1994 following a decision dated 21 February 1994 by the Comptroller not to make an order

revoking the patent. The letter set out the preliminary view of the office that the Comptroller should not exercise his discretion to allow the amendments because, although section 18(5) is not a proper ground for opposition to an application under section 27, it is none the less a long standing principle that the same monopoly should not be granted twice over and the proposed new claim 4 does not differ in substance from claim 9 of patent GB2081803 referred to in the statement under rule 40(3). The letter indicated that the opponents had failed to make out their case on the other proposed amendments.

The applicants have now withdrawn the proposed new claim 4 in their agent's letter dated 16 March 1994. I have reviewed the papers and am satisfied that the preliminary view of this office set out in the official letter dated 21 February 1994 concerning the remaining amendments is correct and I find that the proprietor's conduct has not been such that the Comptroller's discretion to allow them should not be exercised and they do not conflict with the requirements of section 76. I therefore allow the proposed amendments indicated in red ink in pages 2, 3 and 8 of the copy of the printed specification filed by the applicants with their application, subject to the condition that the proprietor file within one month a copy of the amended specification in a form complying with Rule 40(7) of the Patents Rules 1990.

Dated this 20 day of April 1994



W J LYON

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

PATENTS ACT 1977

IN THE MATTER OF an application under
section 72 by Cego Limited for the revocation of
Patent No GB2081804B in the name of
Securistyle Limited

SUPPLEMENTARY DECISION

This application for revocation was made by Cego Ltd on 20 February 1992. The principal ground of objection to the patent was that the apparatus that was the subject of the patent had been sold and used commercially by the patentees before the priority date of the patent. This was denied by the patentees, and evidence was then filed by the two sides in support of their cases.

An application was made on 26 May 1993 by the applicants for revocation for discovery of documents in the patentees' possession, power or control relating to the period shortly before the priority date. Arrangements were set in train for a hearing to be appointed to deal with the application for discovery, but by a letter dated 27 January 1994, the applicants for revocation stated that they had decided not to proceed with their application for revocation.

Patent Office practice in these circumstances is for the ground of objection to the patent to be considered in the public interest, and this process culminated in a decision issued on 21 February 1994 deciding to make no order for the revocation of the patent. An official letter was also issued, on 4 March 1994, inviting comments within one month on two outstanding issues, namely the matter of costs, and an application by the patentees for a certificate of contested validity under section 65.

As regards costs, a letter has been received from the applicants for revocation containing submissions that "a significant award of costs is not justified", or that at least the award should be no more than one that was in accordance with the Comptroller's published scale. I have carefully considered this submission, and also the submissions of the patentees in their letter of 11 February 1994. I consider that the proper amount to award as a contribution to

the patentees' expenses in this matter is £350, and I direct that the applicants for revocation, Cego Ltd, pay this sum to the patentees Securistyle Ltd.

As regards the application by the patentee for a certificate of contested validity, the preliminary view of the Patent Office, given in the official letter of 4 March, was that

".. the comptroller should not exercise his discretion to issue a certificate [while the patent is likely to be amended under section 27] since the validity of the amended claim will not have been contested. This view appears to be supported by the decision in *PLG Research Ltd v Ardon International Ltd* [1993 FSR 698].....

Further it is the preliminary view of the Office that the issue of the validity of the patent was not properly joined because the [applicants for revocation] withdrew their action without there being any opportunity to test the evidence of their witness, J E Buckley...."

This preliminary view has not been contested by the patentees and I am satisfied that it is right. Moreover, a decision has now been made under section 27 allowing the application to amend. I therefore decline to issue a certificate of contested validity.

Dated this 21 day of April 1994

W J LYON

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE