

IN THE MATTER OF an application
for Patent No 8025017 by
Akebono Brake Industry Co Ltd

DECISION

Application No 8025017 was filed on 31 July 1980, claiming a priority date of 31 July 1979, and proceeded to substantive examination. Objection was raised by the examiner under Section 1(1)(a) which was contested by the agents for the applicants and after an exchange of letters a telephone conversation took place on 1 September 1983 between the examiner and the agent in which the matter was discussed. It is apparent from subsequent events that no agreement was reached and furthermore that, after the conversation, each party had a different view as to how the proceedings were to continue. The examiner believed he had made it clear that he had not been persuaded by the agents' arguments, although the objection had apparently by now shifted to Section 1(1)(b), and he accordingly awaited the filing of suitable amendments. The agent, on the other hand, understood that the examiner would consider his arguments and send out a further official letter. Evidence that this was his understanding is clear from a copy of his letter to the applicants dated 12 October 1983.

The resulting inactivity continued until the four and a half year period prescribed under Section 20 expired and, since it was the prevailing Office view that the application did not comply with all 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 refused on 18 April 1984. Unaware of the fate of the application, the agent telephoned the examiner on 1 November 1984 enquiring as to the progress of the application and on 5 November the examiner telephoned back to impart the information.

In his letter dated 6 November 1984 the agent requested that the comptroller adopts either one of two positions: (1) that the examiner withdraws his objection on reconsideration of the arguments put forward in the agent's letter of 13 June 1983 so that the application can be considered to have been in order on the date of receipt of that letter, or (2) that there was an error,

default or omission on the part of the Office in failing to communicate the objections properly and to set a period for response and that discretion be exercised under Rule 100 to extend the period of four and a half years laid down in Rule 34 to enable the applicants to deal with the objection.

It seems to me that whatever view one might hold as to the apportionment of blame for this unfortunate state of affairs, and here I may observe that a period of fourteen months elapsed before the agent took steps to enquire about the application, well after its expiry date, nevertheless the first requirement is to consider whether the examiner's objection was sustainable. The application was therefore referred to the examiner to reconsider his objection in the light of the arguments presented in the agent's letter of 13 June 1983, and to report on the possible acceptability of the application as existing on 15 June 1983 when that letter and accompanying documents were received. He has reported to me that the objection could indeed be waived and the application regarded as in order. Having looked into the matter I am satisfied that this conclusion is correct and the application in the form in which it existed on 15 June 1983 may be said to have complied with the requirements of the Act and Rules.

It follows therefore that the entry in the Register that the application was treated as refused on 18 April 1984 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.

The matter, however, cannot rest there. As a consequence of the announcement of the refusal of the application 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 to his interest. Rule 100 allows that the rectifying of the irregularity be subject to such terms as the comptroller may direct. It seems reasonable to me that protection for third parties should be along 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 had occurred.

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

That any person who, between 18 April 1984 (the date on which it was published that the application was treated as refused) and 9th January 1985 (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 9th day of January, 1985

N G TARNOFSKY

Superintending Examiner, acting for the Comptroller