

Card

DR. P. FERDINANDO  
Dr Ferdinando

3446

**PATENTS ACT 1977**

IN THE MATTER OF an application  
under Section 72 by Esselte Meto  
International Produktions GmbH  
for the revocation of Patent No 2166577  
in the name of Gabriel Ordonez.

24/3/94

**FINAL DECISION**

In an interim decision dated 20 July 1993 I found, in support of the allegations of the applicants for revocation, that the invention as claimed in claim 1 as sought to be amended and in claims 2-5 and 7-10 was obvious and did not involve an inventive step having regard to the disclosure of two prior published patent specifications. I found that part of claim 6 also fell for the same reason, but that the applicants had failed to make their case in relation to claim 6 in so far as it referred to controlling the display to flash intermittently. Claim 1 in unamended form lacked novelty. In other respects the applicants' charges against the patent in suit were not supported. It followed that the patent in suit was found to be unsustainable, either in its unamended form or as sought to be amended in the patentee's pleadings. However, I gave the patentee two months to file fresh amendments to place the patent into a form, consistent with my findings, in which revocation was unnecessary.

Subsequently on 15 March 1994, after a somewhat protracted sequence of events, an amended specification was filed which I am satisfied (except for clerical errors which, to expedite proceedings, were corrected in the Patent Office with the agreement of the parties) is in accordance with the findings of the interim decision. That is to say, it incorporates in proposed claim 1 the matter of claim 1 as granted, together with the hermetic sealing feature included in the unconditionally-amended form of claim 1, as considered at the hearing, and the intermittently flashing feature from granted claim 6. An additional feature, the provision of reset buttons, was included in the proposed claim 1, which reads (with insertions relative to the granted claim underlined and deletions in square brackets) as follows:

"An electronic price ticket for the display of prices on products including a digital display, means for altering the digital display, means for attaching the price ticket in close proximity to a product, the price of which is being displayed, [and including] means for displaying a description of the produce for sale and means for controlling the display to flash intermittently wherein the price ticket is provided with reset buttons to control the display and is hermetically sealed."

The remaining amendments comprise the deletion of claim 6 (as granted), the consequential renumbering of the appendant claims, and corresponding amendments to the statement of invention.

The applicants stated, in a letter dated 25 March 1994, that they have no comments to make regarding the amendments proposed. I take that to indicate that they do not oppose the allowance of these amendments.

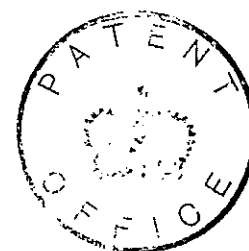
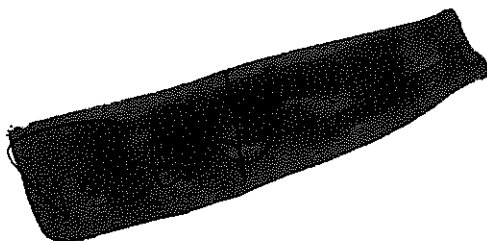
I find that the amendments now offered are allowable since they both provide a cure for the invalidity identified in the interim decision and satisfy the requirements of section 76 in that they neither result in the specification disclosing additional matter nor extend the protection conferred by the patent. I am satisfied that further advertisement of the amendments is not necessary. I therefore allow the specification to be amended in the manner now sought and, on the basis of the specification so amended, make no order for revocation.

In relation to the issue of costs, the applicants have commented that significant unnecessary costs have been incurred as a result of the patentee not immediately acting in a manner in accordance with the interim decision. I recognise that there was confusion on the part of the patentee as to how to respond to the opportunity to amend which was afforded by the interim decision, and that this led to delay and no doubt to the need for additional expenditure by the applicants. However, it is the practice that costs in proceedings before the Comptroller are not intended fully to compensate parties for the expense to which they have been put, but are intended as a contribution to such expense. That said, it is clearly in the public interest that this revocation action has brought about the rectification of a defective patent, and so I award

a sum of £700, to be paid by the patentee to the applicants for revocation as a contribution to their costs in the action.

Any appeal against this decision must be lodged within six weeks from the date of the decision.

Dated this 24 day of May 1994



**Dr P FERDINANDO**

Superintending Examiner, acting for the Comptroller

**THE PATENT OFFICE**