

0/175/86

ATENTS ACT 1977

IN THE MATTER OF an application
for Patent No 8218110 in the name of
Robert Bosch GmbH

DECISION

Application No 8218110 was filed on 22 June 1982 and contained a declaration of priority in respect of a German application dated 23 June 1981. The application proceeded through preliminary examination to substantive examination and an Examiner's first report under Section 18(3) was issued on 23 January 1984. No response was received within the six months reply period stipulated in the Examiner's report or within the four and a half years period prescribed by Rule 34 and the application was treated as refused. An announcement to this effect was made in the Official Journal and the Register shows that the application was treated as refused on 16 April 1986.

Subsequently filed evidence shows that in a letter dated 14 August 1986, the applicants' agents, W P Thompson & Co, were alerted to the apparent failure of the application by a company handling renewals on their behalf. Accordingly, on 19 August 1986, Mr C Jones of W P Thompson telephoned the Examiner enquiring as to the status of the application. He

informed the Examiner that a response to the Official Letter had been posted on 12 July 1984. The Examiner advised the Agent that this reply had not been received at the Patent Office and that the application had been terminated after the due time had elapsed. During a subsequent conversation of the same date Mr Jones intimated that although fresh pages for the application had been posted with the reply of 12 July 1984 he did not possess an official receipt from the Patent Office acknowledging the arrival of the pages and letter. The Examiner therefore advised Mr Jones to submit suitable evidence to substantiate his case.

On 25 September 1986 Mr Jones filed evidence in the form of a statutory declaration by himself together with supporting exhibits. One of the exhibits is a certificate of posting provided as evidence that a letter was sent by registered mail from Hull to the Patent Office on 12 July 1984. In his declaration Mr Jones states that he believes he can identify the lettering 12 JL 84 on the date stamp of the certificate. It is quite possible that that is the date shown, but it is not sufficiently legible for me to be certain. Furthermore, the certificate does not bear any reference by number to the application. Taking this exhibit on its own, I cannot therefore come to the conclusion that the date of 12 July 1984 is present or that the certificate relates to the application. However I have carefully considered the remainder of the evidence which relates in some detail the agents' office procedures and the manner in which the file

of the present application was handled. On the basis of that consideration, even though Mr Jones was not himself directly responsible for the application, I agree with an office opinion expressed in a letter dated 8 October 1986 that on the balance of probabilities the response to the Examiners' report under Section 18(3) was posted on 12 July 1984. I further agree with Mr Jones' request that the letter should be deemed under the provisions of Rule 97 to have been received at the Patent Office on 13 July 1984 i.e. within the period set in the Examiner's Section 18(3) report.

The application has accordingly been referred to the Examiner to consider the amendments and he has reported to me that the amendments were such as to place the application in order for grant and he has effected those amendments. I am satisfied that the specification now meets the requirements of the Patents Act and Rules.

It follows therefore that the entry in the Register on 16 April 1986 that the application was treated as refused 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.

A result of this earlier announcement however to which I must direct myself is the possibility that any member of the public would have been free to take advantage of the

disclosure and to exploit the invention. Resuscitation would seriously and adversely affect such a person particularly since the relevant matters were only drawn to the office's attention after a lengthy period of time. The interests of such third parties must be considered and since Rule 100 allows me to apply such terms as I think fit it seems reasonable to me to impose an order on the present application similar to those provided in restoration proceedings under Section 28. It was suggested to the applicants in the Official Letter of 8 October 1986 that resuscitation should be conditional on these terms. In the event the applicants in a letter dated 27 October 1986 accepted these conditions.

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

"That any person who, between 16 April 1986 (the date on which the application was treated as refused) and

28 November 1986 (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 28th day of November 1986

N G TARNOFSKY

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE