

**PATENTS ACT 1977**

IN THE MATTER OF an application under  
Section 33 of the Patents Act (1949) by  
Toyo Suisan Kabushiki Kaisha for revocation  
of Patent No 1441508 in the name of  
Nissin Shokuhin Kabushiki Kaisha

and

IN THE MATTER OF an offer to surrender  
the patent by Nissin Shokuhin Kabushiki  
Kaisha

**DECISION**

Patent No 1441508 was published on 7 July 1976. On 19 October 1990, Toyo Suisan KK applied under Section 33 of the Patents Act (1949) for revocation of the patent, filing documents purporting to demonstrate that the invention which is the subject of the patent was not new on the date of application, that the invention was obvious and did not involve an inventive step on the date of application, that the complete specification does not sufficiently and clearly describe the invention, that the scope of the claims is not sufficiently clearly described and that they are not fairly based on the matter disclosed in the specification and that the patent was obtained on a false suggestion or representation.

The application proceeded through the normal stages to the point at which the applicants filed their evidence in reply and, in a letter to the Office dated 22 November 1993, the proprietors stated that they were withdrawing from the action and formally offered to surrender the patent by filing Form 18/77.

Since an offer to surrender takes effect from the date on which it is formally accepted by the Office, whilst revocation takes effect retrospectively, I have to consider whether it is appropriate to accept the offer to surrender or to order the revocation of the patent.

In such circumstances it is the practice to consider the matter as though no counterstatement had been filed, that is, as if each specific fact set out in the statement had been conceded except insofar as it is contradicted by other documents before the Office.

The application for revocation was made primarily on the grounds that the invention claimed is not novel and does not involve an inventive step. Several documents are cited to support the application, of which the most significant would appear to be Japanese Published Patent Application No 48-8951 which was available on the shelves of the National Reference Library of Science and Invention on 6 April 1973 and some 18 months before the priority date of the patent. A comparison of the Patent in Suit and the English translation of the cited Japanese document shows that the disclosures are substantially the same and this conclusion is not contradicted by any other documents before the Office.

It follows that, at the date of the application for the patent, the alleged invention was not new. I therefore find that the grounds for revocation have been made out and I therefore refuse the offer to surrender and order that the patent be revoked.

In their statement the applicants ask for an award of costs and, in the circumstances of this case, Rule 76 of the Patents Rules 1990 requires me to consider whether the proceedings might have been avoided if the applicant had given reasonable notice to the proprietor before the application for revocation was filed. Since the proprietor has contested the action beyond the point at which the applicants filed evidence in reply, it must follow that the proceedings would not have been avoided by the applicants notifying the proprietor of their intention to bring a revocation action and that the applicants are entitled to their costs.

I therefore direct that the proprietors (Nissin Shokuhin KK) do pay to the applicants for revocation (Toyo Suisan KK) the sum of £350 (three hundred and fifty pounds) by way of contribution to their costs.

Dated this 23 day of May 1994



P J Herbert  
Superintending Examiner, acting for the Comptroller

**THE PATENT OFFICE**

