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Dr Ferdinando

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PATENTS ACT 1977

IN THE MATTER OF an application under
Section 72(1) by Electro-Nite International N.V.
for the revocation of Patent No 2193375
in the name of Vesuvius Crucible Company

1/6/94

DECISION

The patent in suit is entitled "Protective structure for an immersion pyrometer". The application was filed on 6 February 1987, claiming priority of 1 August 1986, and the patent was granted on 17 January 1990.

On 4 December 1991 Electro-Nite International N.V. ("the applicants") applied to the Comptroller under section 72 for revocation of the patent. On 11 May 1992, before filing a counter-statement in the revocation proceedings, Vesuvius Crucible Company ("the proprietors") informed the Patent Office that they had initiated infringement proceedings in the Patents County Court against Electro-Nite (UK) Ltd, of whom the applicants are the parent company. They requested that the revocation proceedings be stayed pending a final resolution of the Patents County Court proceedings.

On 13 May 1992 the proprietors notified the Patent Office of amendments they were intending to apply for in the infringement proceedings under section 75. These amendments were advertised in the Official Journal (Patents) on 17 June 1992, and no opposition was entered. On 30 June 1992 the revocation proceedings were stayed pending resolution of the infringement proceedings before the Patents County Court.

In letters dated 21 December 1993 and 20 January 1994 the applicants withdrew unconditionally from the revocation proceedings, and in subsequent correspondence it was confirmed that, following settlement between the parties, the infringement action and the application to amend the patent had been stayed by the Patents County Court on 21 December 1993. On 31 January 1994 the proprietors applied to the Comptroller under

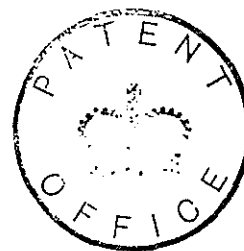
section 27 to amend the patent, the amendments submitted being, subject to minor clerical differences, identical to those originally applied for under section 75.

Despite the withdrawal of the applicants, the practice of the Patent Office, supported by *General Motors Corporation (Turney & Barr's) Application* [1976] RPC 659, is to pursue the revocation action in the public interest, and not to regard the action as completed until a decision has issued. It follows that the revocation action was still to be regarded as pending, and therefore that the amendments sought could not be considered under section 27 in view of section 27(2), which prohibits amendment under section 27 where there are proceedings pending, *inter alia* before the Comptroller, in which the validity of the patent may be put in issue.

The proprietors accepted the Office's proposal that the application to amend under section 27 should be withdrawn, and that it should instead be dealt with as if it had been submitted under section 75 in the revocation proceedings.

I find that the requested amendments are allowable since they both distinguish the invention claimed from the prior art identified in the revocation action 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 sought and, on the basis of the specification so amended, make no order for revocation.

Dated this | day of JUNE 1994



Dr P FERDINANDO

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE