

OPI

0/25/97

PATENTS ACT 1977

Mr P Hayward
3Y46

IN THE MATTER OF an application
under Section 72 by Goblin Limited for
revocation of Patent No 2253685 in the
name of Earlex Limited

Bridges 23/1/97

Revocation - withdrawn following
amendment of patent.

DECISION

In order to meet the issues raised in a revocation action launched 1 November 1993 by Goblin Limited (the "applicants"), Earlex Limited (the "proprietors") submitted proposals for amendment of the specification of patent number 2253685. The proposed amendments are shown in a copy of the printed specification annexed to this decision. In response, the applicants have confirmed that they are willing to discontinue the revocation proceedings if the amendments are allowed. The amendments have been advertised and no notice of opposition to them has been filed.

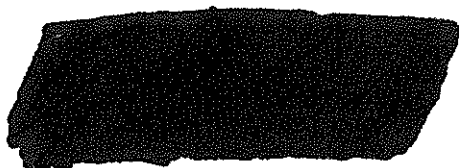
The amendments are such as may lawfully be made in these proceedings. Having considered the objections raised by the applicants for revocation in the light of the proposed amended specification, I decide to allow the specification to be amended in the manner shown in the said copy of the printed specification and make no order for revocation of the patent.

There remains the matter of costs. Both parties have filed written submissions asking for an award of 'full costs'. Following long-established practice, costs awarded in proceedings before the Patent Office are not intended to fully compensate parties for the expense to which they have may have been put, and the Comptroller is instead guided by a scale of costs published from time to time in the Official Journal (Patents) and intended to provide a contribution only towards costs incurred. There is discretion to depart from the published scale in appropriate circumstances but this should only be done in exceptional circumstances such as clear abuse of process (Rizla Ltd's Application [1993] RPC 365).

In the present case, the applicants for revocation point to the substantial amendment of the patent in suit that this action has forced and to the behaviour of the proprietors in maintaining overly broad claims for some three years in the light of prior art known to them as a result of the search report on a corresponding European application. Whilst it is true that the relevant prior art was so known to the proprietors, equally I note that the said European application was granted with claims of a similar scope to those of the patent in suit. Thus, I do not see it as clearly established that the proprietors have acted in a covetous way such as to justify an exceptional order of costs against them.

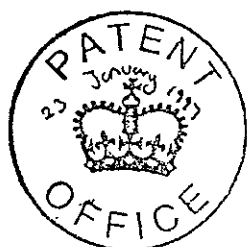
Having considered all of the circumstances of this case, and having noted that the applicants for revocation although having withdrawn their action have nonetheless been successful in attaining significant amendment of the patent, I award the applicants, Goblin Limited, the sum of three hundred pounds (£300) as a contribution towards their costs and I direct that this sum be paid by the proprietors, Earlex Limited.

Dated this 23rd day of January 1997



G M BRIDGES

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE