

0/11/91

PATENTS ACT 1977

IN THE MATTER OF an application
under Section 71 by Mackintosh
Structures Limited for a declaration
of non-infringement of European
Patent (UK) No. 0020152 in the name
of Brupat Limited

DECISION

The applicants, Mackintosh Structures Limited, have applied to the comptroller under section 71 for a declaration of non-infringement of European Patent (UK) No 0020152 granted 16 May 1984 in the name of Brupat Limited.

The patent in suit relates to an anchor. In a letter dated 18 September 1984, the applicants wrote to the proprietors of the patent requesting a declaration of non-infringement of the patent in respect of an anchor which they were proposing to manufacture as depicted in copies of drawings and photographs enclosed with the letter. The proprietors did not furnish an acknowledgement to the effect of the declaration sought in this letter and the applicants subsequently applied to the comptroller for a declaration of non-infringement under section 71 in respect of their anchor.

In accordance with rule 74(1), the applicants filed a statement in support of the application setting out the facts upon which they relied as showing that sub-paragraphs (a) and (b) of section 71(1) had been complied with.

In their counterstatement under rule 74(2), the proprietors stated that there were reasonable grounds for establishing that at least claim 1 of the patent in suit would be infringed by the applicants' anchor.

During the course of the proceedings in suit, the European patent was revoked pursuant to Article 102(1) of the European Patent Convention (EPC) on the grounds of lack of inventive step in a decision of the Opposition Division of the European Patent Office dated 27 March 1987. The proprietors lodged an appeal against this decision under Article 106(1) EPC and, at the request of the proprietors and with the consent of the applicants, the proceedings on the application in suit were stayed pending the outcome of the appeal.

The decision revoking the patent was subsequently set aside in a decision of the Board of Appeal of the European Patent Office following oral proceedings on 30 August 1990 and the case remitted to the first instance with the order to maintain the patent on the basis of claims and description as submitted at the oral proceedings and the drawings as granted.

In a letter to the agents for the applicants dated 4 October 1990, the agents for the proprietors stated:

"We would advise that, as a result of the Appeal proceedings at the European Patent Office, European Patent No 0020152 is to be maintained.

However, the claims and description are to be amended and we enclose a copy of the amended specification. The Euro/UK patent will be amended accordingly. Our client is prepared to acknowledge that Euro/UK Patent No 0020152 including these amendments will not be infringed by your client's anchor."

In a previous decision dated 19 July 1990 in the matter of an application under section 71 also by Mackintosh Structures Limited for a declaration of non-infringement of Patent No 1356259 also in the name of Brupat Limited, I decided that the comptroller is not empowered to make a declaration under section 71 if in the proceedings the proprietor of the patent has given a written acknowledgement to the effect of the declaration sought.

In the light of this decision and the statement in the above letter, the applicants were informed in an official letter dated 22 October 1990 that:

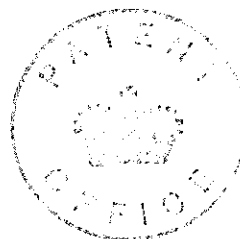
"In the absence of any submission to the contrary within the period allowed for reply to this official letter [one month from the date of the letter], the Office proposes to regard this as an acknowledgement to the effect of the declaration sought within the meaning of section 71(1)(b) and accordingly proposes to issue a decision refusing the application for a declaration on the grounds that the provisions of the above section are not satisfied."

In the event no reply was received either from the applicants or from the proprietors to whom the letter was copied and neither party asked to be heard in the matter.

Accordingly, as foreshadowed in the official letter dated 22 October 1990, I therefore refuse the application for a declaration on the grounds that, the proprietor having given a written acknowledgement to the effect of the declaration sought, the provisions of section 71(1)(b) are not satisfied.

The proprietors have asked for an award of costs. Having taken all the circumstances of this case into account I have decided that an award of costs would not be appropriate.

Dated this 22 day of January 1991



B G HARDEN

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

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