

BLO / 086 / 86

PATENTS ACT 1977

IN THE MATTER OF an application
for a Patent No 8300513 by
Minnesota Mining & Manufacturing Co

DECISION

The application was filed on 10 January 1983 claiming priority from an earlier application filed in this country on 11 January 1982. The application proceeded through the preliminary examination and search stage and was published on 3 August 1983. It was therefore necessary, in order to meet the requirements of Rule 33(2), for a request for substantive examination to be filed by 3 February 1984.

In fact, the applicants filed a request on Form 10/77 and the prescribed fee for substantive examination through their authorised agents on 11 August 1983 but the application number given on the Form 10/77 was 8300813. It was only after the agents wrote to the office on 6 August 1985 to enquire about the progress of the present application, that it was discovered that anything was amiss. The agents then wrote to the office again on 12 August 1985 explaining that a clerical error in their office had resulted in an incorrect application number being entered on the Form 10/77 intended for the present application, and enclosing a copy of a letter from them to the applicants dated 10 August 1983 which indicated that they had filed a request for substantive examination of application No 8300513 ie the present application. The agents also filed a Form 47/77 requesting correction of the clerical error which appeared on the Patents Form 10/77 which they had filed on 11 August 1983.

In the meantime, the office had treated the application as having been withdrawn under Section 18(1) on 23 May 1984, an announcement to this effect having been made in the Official Journal (Patents) and a corresponding entry having been made in

the Register. The Form 10/77 which had been filed was placed on the file of application No 8300813 (the erroneous number) even though the names of the applicant company and the agents given on the form did not correspond with those of application No 8300813.

The initial view taken by the office and communicated to the applicants in a letter dated 16 October 1985 was that, in the light of the judgement of the Patents Court in Payne's Application 1985 RPC 193, there appeared to be no scope for correcting under Section 117 an application which had been terminated. The applicants' agents then requested, in a letter dated 29 October 1985, that the Comptroller's discretion under Rule 100 be exercised to correct the error on the Form 10/77 and to grant any necessary extension of the prescribed period referred to in Section 18(1) to allow the application to proceed.

Having given the matter careful consideration I have come to the conclusion that the making of the entry in the Register that the application was treated as withdrawn on 23 May 1984 was an irregularity in procedure on the part of the office, and under the provisions of Rule 100 I cancel that entry and direct that the Register be amended accordingly. I also allow the request to correct the Form 10/77, and direct that the application proceed to substantive examination forthwith.

However, following the announcement that the application had been treated as withdrawn any member of the public would have been free to take advantage of the disclosure and to exploit the invention. Reinstatement of the application would have serious consequences to such a person and I must have regard to his interest. Rule 100 allows that the rectifying of the irregularity be subject to such terms as the Comptroller may direct. It seems reasonable to me that protection for third parties should be along the same lines as is provided in restoration proceedings under Section 28. As far as renewal fees are concerned, the situation is unaffected by these events and

payment must be made in accordance with Rule 39 as though no lapse had occurred.

In recent communications between the agents and the office the agents, although accepting that the Comptroller deems it necessary to impose terms for the protection of third parties upon the reinstatement of this application, have argued that such terms should only cover the period until 12 August 1985, (the date upon which steps were taken to reinstate the application) the reasoning behind this argument being that similar provisions are made under Section 28(5). Although I have some sympathy with this argument, I am unable to accept it for the reason that, whereas in Section 28 proceedings an entry is made in the Register when a formal application for restoration has been initiated, no similar entry is made upon an informal request for reinstatement of an application, and there is therefore no reason for a third party who inspects the Register to suspect that an application recorded as having been terminated may possibly be revived. In a telephone conversation held on 24 April 1986 between Mr C A Clarke of the office and Mr P A Bowman, the agent handling the application, Mr Bowman indicated that in the event that the argument concerning the period covered by third party protection terms is not accepted he would not wish to pursue the matter further at a hearing.

Accordingly, should the application proceed to grant, I direct that it should be subject to the following terms:-

That any person who, between 23 May 1984 (the date on which it was published that the application was treated as withdrawn) and 30th April 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 30th day of April 1986

K E PANCHEN
Superintending Examiner, acting for the Comptroller

PATENT OFFICE