

PATENTS ACT 1977Mr Dennehey
3Y56

IN THE MATTER OF an application under
Section 72(1)(a) by Mr M V Seaman for the
revocation of Patent No 2261586 in the name
of Mr J S Crotty.

DECISION

In an Interim Decision of the 3rd March 1997 issued following a hearing held on the 5th February 1997, I found that claims 1, 2, 5, 6 and 7 of Mr Crotty's patent number 2261586 were invalid and I gave Mr Crotty an opportunity to file amendments with a view to overcoming my finding, failing which I would revoke the patent. Mr Crotty subsequently filed amended claims with his letter of the 28th April 1997 and Mr Seaman's agents, William Jones, wrote on the 5th June commenting upon these amendments.

The effect of Mr Crotty's amendments, which fall to be considered under section 75 of The Patents Act 1977, is to delete all the claims which I found were invalid in my interim decision, and to add the qualification that the cardboard is "corrugated" to the original claims 3 and 4 which are renumbered as claims 1 and 2 and would be the only claims in the patent.

Although Rule 78(1) of The Patents Rules 1995 would allow me to require these amendments to be advertised, I have decided that because the amended claims 1 and 2 are in substance the same as the original claims 3 and 4 of the patent as this was granted, save only for the addition of the word "corrugated" which can only result in a narrowing of the scope of the original claims (if it involves any change at all), it is not necessary to advertise the amendments.

In their letter of the 5th June, Mr Seaman's agents objected to the amended claims.

Though the objection is not made as clear as it might be, mentioning as it does questions of novelty and obviousness, I take it that it amounts to an assertion that the amended claims do not involve an inventive step. However, at the hearing Mr Whittaker, who appeared for Mr Seaman, withdrew the attack on what were then claims 3 and 4, and as a result I do not believe I could or should now entertain any objection from him against what are essentially identical claims. Moreover, I feel bound to say that even if I were to entertain the objection, I could not possibly find that the claims lacked inventive step on the basis of what in fact is no more than a mere assertion that that is the case. As Mr Seaman does not wish to be heard in this matter, I do not need to consider his objection further.

My only remaining qualm about the amendments is that Mr Crotty is not proposing to amend the statements of invention on pages 2 to 4 of the specification to bring them into line with the amended claims. However, because I do not see that there can be any uncertainty over the scope of the invention as this is now to be claimed, I do not think this matters. Accordingly, given that no objection arises under section 76, I believe that the amendments are such as can lawfully be made and I hereby order that the patent is amended as shown in red ink in the attached copy of the specification. The amended patent meets the findings of my interim decision and accordingly, I make no order to revoke the patent.

This then leaves the question of costs, both sides having asked for an award. Mr Seaman's application for revocation has succeeded in part and has resulted in certain invalid claims being deleted from Mr Crotty's patent. It therefore seems to me that Mr Seaman is entitled to a contribution to his costs on that basis. In determining a figure, I have borne in mind that Mr Crotty failed to appear when the hearing was originally held and did not give Mr Seaman sufficient notice to prevent him and his representative making a wasted journey to London. Normally in these circumstances I would have added to the award the full amount shown on the comptroller's published scale for attendance at the abortive hearing but, because I accept that Mr Crotty was indeed ill and unable to travel, I have reduced the amount of the award in this respect by one half. In

the result, I hereby order that Mr Crotty should pay the amount of £600 (six hundred pounds) to Mr Seaman as a contribution to his costs.

Any appeal against this decision must be lodged within six weeks.

Dated this 8th day of July 1997



P HAYWARD

Superintending Examiner, acting for the Comptroller

