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Eric Dumas 3480
01/15/92

PATENTS ACT 1977

IN THE MATTER OF proceedings for
revocation under section 73(2) of patent
No 2176670 in the name of Citizen Watch Co
Ltd

DECISION

Patent No 2176670 (hereinafter the 'UK patent') was granted in pursuance of application No 8612181 filed on 20 May 1986 and claiming priority from four earlier filings in Japan. Notice of grant was published in the Official Journal (Patents) on 13 July 1988 in accordance with section 24(1). In the course of substantive examination of the application, the examiner became aware of a corresponding application for a European Patent (UK) No 0205923 filed by the same applicant on 20 May 1986 and claiming priority from the same Japanese filings. The examiner took the view that the two applications related to the same invention, and that view was communicated to the applicants in a report under section 18(3) which issued on 17 November 1987. At that stage, the applicants were further advised that if patents were granted for the same invention on the two applications it would be necessary for the comptroller to consider revoking the UK patent under section 73(2) after the "relevant date" defined by section 73(3).

Mention of the grant of European patent (UK) No 0205923 (hereinafter the 'EP (UK) patent') appeared in the European Patent Bulletin on 8 August 1990 and in an official letter which issued on 24 July 1991, ie after the end of the opposition period mentioned in section 73(3), the proprietors were advised that at least the respective claim 1 of that patent and of the UK patent related to the same invention. In accordance with rule 77(1), a period of 3 months was allowed for filing observations or proposals for amendment of the UK patent.

In the course of subsequent correspondence with the examiner, the proprietor's agent, Mr R E Skone James, did not contest the examiner's view that the two patents had been granted for the same invention and he offered no proposals for amendment. He did,

however, seek to persuade the examiner in effect that revocation of the UK patent was not inevitable in circumstances where "double-patenting" occurred as specified in section 73(2), notwithstanding that the EP(UK) patent had been neither amended as indicated in section 73(3) nor surrendered as indicated in section 73(4). In Mr Skone-James' submission, the amendments to section 73 introduced by the Copyright, Designs and Patents Act 1988 and which came into effect on 7 January 1991, provide for the "double-patenting" problem to be resolved by revocation or by voluntary surrender/abandonment of either of the patents.

The examiner was unable to accept Mr Skone James' interpretation of section 73, and the proprietors were notified to that effect in an official letter dated 31 December 1991 and allowed an additional 2 months in which to file further observations and/or proposals for amendment. During that period it transpired that the EP/UK patent had in fact ceased on 20 May 1991 due to non-payment of renewal fee, and the period for response to the official letter was extended to 29 April 1992 to permit the proprietors to consider the implications. In the result, the proprietors did not contest the matter further, either by responding to the official letter of 31 December 1991 within the time allowed or by accepting an invitation to be heard as communicated in an official letter of 22 June 1992, which specified a period for response of 21 days.

In the absence of any further response from the proprietors, or a request that they be heard, it now falls to me to decide the matter.

I should indicate at the outset, that although the claims of the UK patent are formulated differently to those of the EP/UK patent, to my mind the differences are matters of style rather than substance and I am therefore satisfied that the examiner was correct in contending that both patents were in fact granted for the same invention. To the extent that the proprietors have not questioned that contention, I have assumed that they also accept it as correct, and I should indicate further that there is no dispute that both patents were granted pursuant to applications filed by the same applicant and claiming the same priority date.

It is also not in dispute that, by virtue of its earlier grant and the fact that it has since remained in force, the UK patent was in force during the life of the EP(UK) patent, ie from

8 August 1990 to 20 May 1991. Thus the matter to be determined is whether the UK patent stands to be revoked under section 73(2), as the examiner has argued, or whether that sanction can be avoided as Mr Skone James has contended.

It is useful at this point to refer to the provisions of subsections (2) - (4) of section 73:

73 (2) If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent.

 (3) The comptroller shall not take action under subsection (2) above before -

 (a) the end of the period for filing an opposition to the European patent (UK) under the European Patent Convention, or

 (b) if later, the date of which opposition proceedings are finally disposed of;

and he shall not then take any action if the decision is not to maintain the European patent or if it is amended so that there are not two patents in respect of the same invention.

 (4) The comptroller shall not take action under subsection (2) above if the European patent (UK) has been surrendered under section 29(1) above before the date on which by virtue of section 25(1) above the patent under this

Act is to be treated as having been granted or, if proceedings for the surrender of the European patent (UK) have been begun before that date, until those proceedings are finally disposed of; and he shall not then take any action if the decision is to accept the surrender of the European patent.

Mr Skone James' submissions are contained in his letters dated 12 September 1991 and 6 November 1991. In particular, he has submitted that the "proviso" in subsection (3) applies to both situations (a) and (b), and in relation to (a) it must provide for a voluntary decision by the proprietor not to maintain the EP(UK) patent. According to his interpretation, the proprietor can elect to surrender or abandon the EP(UK) patent and thereby avoid revocation of the UK patent. In declining to accept that interpretation, the examiner observed in effect (official letters dated 29 October 1991 and 31 December 1991) that it would have the result that:

- (i) section 73 would be ineffective in preventing "double-patenting" (surrender and ceasing only operating ex-nunc),
- (ii) the time limit defined by subsection (3) would be indeterminate,
- (iii) subsection (3) would have to be construed without reference to the obvious implications of Articles 99-102 of the European Patent Convention (EPC), in particular Article 102, the wording of which strongly suggests that the decision in question in regard to maintenance of the EP(UK) patent is that of the Opposition Division of the European Patent Office (EPO) when determining the outcome of an opposition, and
- (iv) subsection (4) would be superfluous.

Mr Skone James sought to counter point (i) above by contending that the "double-patenting" problem can be met by revoking either the UK patent or the EP(UK) patent, and he contended further that section 73(2) does not exclude the possibility of a proprietor satisfying the comptroller that there are not two patents for the same invention by voluntarily

surrendering the EP(UK) patent. As I see it, section 73(2) clearly provides only one sanction for "double-patenting", namely revocation of the UK patent, and the comptroller is therefore not authorised to revoke the EP(UK) patent instead. If it had been intended (and permissible) to allow the comptroller discretion in the latter respect, then specific provision for the alternative sanction would surely have been included in section 73(2), but my understanding is that such provision would infringe Articles 138, 139 EPC. As to a possible option for voluntary surrender (or abandonment) of the EP(UK) patent, or even the UK patent, whilst this possibility may indeed not be precluded by the terms of section 73(2) considered in isolation, in my view that subsection stands to be interpreted in the light of subsections (3) and (4) which, as indicated below, clearly limit the scope for avoiding revocation of the UK patent.

The above interpretation of section 73(2), that a subsequent revocation or surrender of an EP(UK) patent in a "double patenting" situation cannot avoid revocation of the UK patent, is consistent with the provisions of the Community Patent Convention (CPC). It is apparent from the Long Title of the 1977 Act and from section 130(7) that one of the objectives behind the Act was to give effect to that Convention as well as to, inter alia, the EPC. Article 80 of the CPC is as follows:-

Prohibition of simultaneous protection

1. Where a national patent granted in a Contracting State relates to an invention for which a Community patent has been granted to the same inventor or to his successor in title with the same date of filing, or, if priority has been claimed, with the same date of priority, that national patent shall be ineffective to the extent that it covers the same invention as the Community patent, from the date on which:

- (a) the period for filing an opposition to the Community patent has expired without any opposition being filed,
- (b) the opposition proceedings are concluded with a decision to maintain the Community patent, or

- (c) the national patent is granted, where this date is subsequent to the date referred to in subparagraph (a) or (b), as the case may be.
2. The subsequent lapse or revocation of the Community patent shall not affect the provisions of paragraph 1.
 3. Each Contracting State may prescribe the procedure whereby the loss of effect of the national patent is determined and, where appropriate, the extent of that loss. It may also prescribe that the loss of effect shall apply as from the outset.
 4. Prior to the date applicable under paragraph 1, simultaneous protection by a Community patent or a European patent application and a national patent or a national patent application shall exist unless any Contracting State provides otherwise.

Of particular relevance is the provision in paragraph 2, which is in accord with the above interpretation of section 73(2), that subsequent lapse or revocation of the community patent shall not affect the "ineffectiveness" of the UK patent in the event of simultaneous protection by both CPC and UK patents. It would, of course, be contrary to the objectives of the 1977 Act for section 73(2) to be found to have a contrary effect to the CPC.

I should perhaps mention that section 73(2) is not included in the list of sections in section 130(7) which have been framed to have the same effect as the corresponding provision of, inter alia, the CPC. However, it would not appear appropriate for section 73(2) to be included in the list since advantage has been taken of paragraph 3 of Article 80 which enables each Contracting State to prescribe its own procedure for determining the extent and timing of the loss of effect of the patent. The power under paragraph 3 does not enable the provisions of paragraph 2 to be overridden.

In regard to point (ii) above, Mr Skone James countered by arguing that the time limit defined by subsection (3) for taking action under subsection (2) is indeterminate in any case since the comptroller can take action "at any time during the life of the patents provided it does not take place under the specific circumstances of subsection (3)". However, whilst I

agree that the time limit is indeterminate in that sense, to my mind the argument rather misses the point which is that if subsection (3) provides for voluntary surrender then the comptroller would seem to be precluded from initiating action under subsection (3) while the proprietor decides whether to surrender or not. More importantly, probably, Mr Skone James indicated that he did not understand the examiner's point (iii) above, and consequently his interpretation of subsection (3) effectively ignored the implications of Articles 99 - 102 EPC. In my view, subsection (3) is clearly intended to take account of the opportunity provided under the EPC for opposition to the EP(UK) patent, and of the outcome of any such opposition, and it is therefore reasonable to interpret the "proviso" or rider in the light of the relevant articles of the EPC, particularly when the rider reflects wording adopted in the EPC rather than wording generally adopted in the Act in relation to patents. Thus, to my mind, the rider relates to the outcome of any opposition, and the "decision not to maintain the European patent" refers to the decision of the opposition division of the EPO and not to a decision by the proprietor to surrender the patent. Moreover, contrary to Mr Skone James' contention, as I see it the rider applies similarly to situation (a) as to situation (b), bearing in mind that it is conceivable that an opposition could be disposed of prior to the end of the period for filing opposition.

I should also mention that, in response to point (iv) above, Mr Skone James contended that subsection (4) is superfluous in any event since it is concerned with a situation before the UK patent has been granted, whereas subsection (2) is only concerned with the situation where both the EP(UK) and UK patents have been granted. Once again, I am unable to accept Mr Skone James' contention, since as I see it subsection (4) simply provides that in the event of a UK patent and an EP(UK) patent having been granted for the same invention then no action is to be taken under subsection (2) if the EP(UK) is surrendered in either of the circumstances prescribed in subsection (4). As indicated in the Office's Manual of Patent Practice, at paragraph 73.11, this provision offers a limited opportunity to avoid the unfortunate consequences of the earlier provisions of section 73 which, as decided in *Turner and Newall's Patent* [1984] RPC 49, precluded avoiding revocation of the UK patent by surrendering the EP(UK) patent. In the result, I find myself in agreement with the examiner that, if subsection (3) is indeed intended to provide for voluntary surrender of the EP(UK) patent, then subsection (4) would in fact be superfluous. I am unable to so find and am

therefore further reinforced in my view that subsection (3) cannot be interpreted as contended by Mr Skone James.

In the light of the above findings, and in the absence of any proposals by the proprietor to amend the UK patent so as to prevent there being two patents in respect of the same invention, I conclude that the objection was properly made under section 73(2) and that the UK patent stands to be revoked in accordance with the requirements of the Act. I therefore order that patent no 2176670 be revoked.

Signed this 17th day of August 1992



B G Harden
Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE