

PATENTS ACT 1977

IN THE MATTER OF proceedings for
revocation under Section 73(2) of patent no
2168252 in the name of Madeline Thomas

DECISION

During the course of examination of application no 8431418, filed on 13 December 1984, the examiner became aware of a corresponding application for a European patent (UK) no 0185517 filed by the same applicant on 12 December 1985 and claiming priority from no 8431418 and from a divisional application thereon (now abandoned) no 8525207. He warned the applicant by telephone on 7 October 1988 that action under Section 73(2) might have to be considered by the Comptroller if the application proceeded to grant.

No further action in this matter was taken by the applicant in respect of no 8431418, and grant of a patent thereon under serial no GB 2168252 B was notified in the Official Journal on 15 February 1989. Some sixteen months later, on 20 June 1990, grant of the European application (UK) was mentioned in the European Patent Bulletin. After the "relevant date" defined by Section 73(3) had passed, proceedings under Section 73(2) were instituted. During these proceedings the applicant's agent, Mr Guy Selby-Lowndes argued that patent no 2168252 should be revoked only from the date of grant of the European patent (UK), 20 June 1990. The examiner was not persuaded that revocation could be other than ex tunc, ie from its own date of grant, and the matter came before me at a hearing on 25 November 1991.

At the hearing this was the only matter in dispute, but it is desirable that I should first dispose of two preliminary points. First, it is not and never has been in dispute that the two patents relate to the same invention. There are slight differences in the wording of the claims, but I am satisfied in the light of the approach taken by the Hearing Officer in Maag Gear Wheel and Machine Co Ltd's Patent [1985] RPC 572 that the patents relate to the same invention.

Second, amendment of the specification of the patent no 2168252 is not considered by Mr Selby-Lowndes to serve any useful purpose, and so there are no amendments that I have to consider.

I turn therefore to the matter in issue. Mr Selby-Lowndes explained his reasons for seeking revocation ex nunc, ie only from the date of grant of the European patent: briefly these are as follows. At the time of filing application no 8431418 it was important for the applicant to obtain rights in the United Kingdom as rapidly as possible, and the view was taken (correctly as it turned out) that the domestic application offered a speedier prospect of grant. However, since a European patent (UK) has now been granted, the United Kingdom patent no 2168252 has deliberately been allowed to lapse by the renewal fee that fell due on 13 December 1990 not being paid. (The extended period prescribed by Section 28 also expired on 13 June 1991 without the fee being paid.) Mr Selby-Lowndes contends that there has been "double grant" only for the period 20 June 1990 to 13 December 1990, that this is the problem Section 73(2) was designed to overcome, and that revocation of the patent should therefore be allowed to date from 20 June 1990. Further, he considers that revocation from the date of grant, 15 February 1989, will unjustly deprive the applicant of protection for the period between the grant of the patent no 2168252 and the grant of the European patent (UK). Even though no proceedings for infringement of the no 2168252 have yet been instituted, Mr Selby-Lowndes points out that such proceedings are still possible up until 19 June 1996 by virtue of the Limitation Act 1980, and so the matter is not purely academic.

The examiner, as has been stated, was unable to accept that revocation of a patent, whether under Section 72 or Section 73, could be anything other than ex tunc. At the hearing Mr Selby-Lowndes sought to counter this view by drawing a distinction between the powers of the Comptroller under Section 73(1) and Section 73(2) to revoke patents on his own initiative. He suggested that Section 73(1) (giving power to revoke where a patent forms part of the state of the art by virtue of Section 2(3)) was directed to a situation where a patent was fundamentally flawed and where it would be correct to revoke ex tunc. However Section 73(2) dealt with a situation which was quite different and which had never been contemplated before the coming into force of the European Patent Convention. There was therefore no authority for revocation under Section 73(2) being effective from any particular date and no

reason to adopt the same approach as in Section 73(1). Rather Section 73(2) should be applied so as to avoid injustice to the proprietor of the patent: in the present case revocation of no 2168252 ex nunc from 20 June 1990 would be more appropriate than revocation ex tunc.

I am afraid that I cannot accept this argument. In the absence of any clear indication in the Act to the contrary, I consider myself bound by the usual principles of statutory construction to give "revocation" the same meaning in both Section 72 and Section 73. Revocation, for the purposes of Sections 72 and 73(1), extends back to the date of grant, and if Parliament had intended a different meaning to apply in Section 73(2) it would surely have said so. I find support for my view in the decision of the Hearing Officer in Turner and Newall's Application [1984] RPC 49 where, in response to a suggestion that the problem of double grant might be solved by the lapse or surrender of a European patent (UK), he states (at page 53 lines 41-45):

"I do not consider that either course of action would overcome the objection since in either of the cases proposed, there would still have existed a period of time, however short, when both patents were in existence. This is because lapse and surrender would operate only ex nunc and not, as does revocation, ex tunc."

I am aware of no case where revocation has been effective from a date other than the date of grant, and Mr Selby-Lowndes did not draw my attention to any such case.

In the matter of the existence or otherwise of rights prior to 20 June 1990 I believe that Mr Selby-Lowndes may not have considered the effect of Section 69. By this section an applicant is entitled, after a patent has been granted, to bring proceedings for infringement in respect of acts done after publication of the application and before grant. Section 69 is applicable to a European patent (UK) by virtue of Section 78(2), so that in the present case the proprietor will have the aforesaid entitlement in respect of infringing acts committed after 25 June 1986, the date of publication of the European application. Therefore, revocation of patent no 2168252 from its own date of grant will not deprive the patentee of rights in the

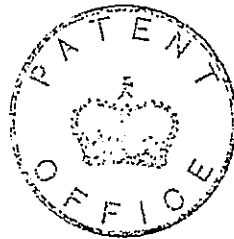
way that Mr Selby-Lowndes alleges, and revocation from 20 June 1990 if allowed would not prevent a period of overlap between the two patents from arising.

Accordingly, if patent no 2168252 is to be revoked, I consider that revocation must be effective from the date of grant in the usual manner. Mr Selby-Lowndes said at the hearing that his client had acted in good faith and had kept the UK patent in force by paying renewal fees. I should therefore make it clear that my decision is in no way intended to reflect adversely upon Mr Selby-Lowndes or his client, but follows merely from the way the Act is structured. This holds out the possibility of obtaining, by means of a domestic application, a granted patent in the United Kingdom and making use of it at a time when it may not be certain that a corresponding European patent application will proceed to grant. If the European application is granted, then it will "take over" from the domestic patent. In the present case, although the proprietor has paid renewal fees on patent no 2168252 for a period when no renewal fees are payable on the European patent (UK), she has nevertheless had the advantage of a granted United Kingdom patent during that time.

The objection under Section 73(2) can therefore be overcome only by amending the specification of patent no 2168252, or by revoking it ex tunc from its date of grant. As stated above Mr Selby-Lowndes did not consider that amendment would serve any useful purpose.

I therefore order that patent no 2168252 be revoked.

Signed this 19 day of December 1991



B G Harden

Superintending Examiner acting for the Comptroller

THE PATENT OFFICE