

## **PATENTS ACT 1977**

IN THE MATTER OF an application  
under section 72 by McAlpine &  
Company Ltd for revocation of UK  
patent no. 2329332 in the name of  
Eskander Corporation NV

### **DECISION**

#### **Introduction**

- 1 In an earlier decision of 27<sup>th</sup> January 2003, issued following a hearing on 4<sup>th</sup> December 2002, I found that claims 1 to 9, 11 and 12 of UK patent no. 2329332 as granted were invalid for lack of an inventive step in the light of the prior art. However I gave Eskander (the defendant and patentee) the opportunity to file amendments with a view to overcoming my finding. I also deferred consideration of omnibus claim 13 pending consideration of those amendments.

#### **The amendments**

- 2 The defendant filed proposed amendments with the Office on 7<sup>th</sup> March 2003 under cover of a letter from their patents agents Williams Powell, and a copy was faxed by them to the claimant, McAlpine, on 14<sup>th</sup> March 2003. The claimant subsequently confirmed that it would raise no objection to the proposed amendments.
- 3 The amendments take the form fresh pages in which original claims 1 and 10 are combined to provide a new claim 1, claims 5 to 7 and 10 are deleted and the remaining claims renumbered. There were a few small bugs in the amendments as originally proposed, but following an exchange with the Office the defendant filed further amended pages to deal with them. They were supposedly filed on 4<sup>th</sup> June, but they seem to have gone astray *en route* somewhere and so they were refiled under cover of a fresh letter from the defendant's patent agents dated 26<sup>th</sup> June. The claimant has not objected to these further changes. Thus the amendments now proposed are those embodied in new pages 1 and 10 accompanying William Powell's letter dated 7<sup>th</sup> March 2003 and new pages 1a, 2 and 9 accompanying William Powell's letter dated 26<sup>th</sup> June 2003.

#### **Conclusion and order**

- 4 I am satisfied that these amendments are allowable, and that they overcome my finding that the patent as granted was invalid. I am also satisfied that the omnibus claim, formerly claim 13 but now claim 9, is patentable. I therefore order that the specification of the patent be amended by replacing the original pages 1, 2, 9 and 10 by the new pages identified in the preceding paragraph. As the amended patent meets the findings of my previous decision, I make no order to revoke the patent.

- 5 In its statement of defence and at the hearing the defendant asked that a certificate of contested validity under Section 65(1) be granted should the patent be found to be valid. Of course the patent as granted was not found to be valid. However, the validity of the patent as now amended was effectively contested because the validity of the original claim 10 was contested, and I have now found that the amended patent is valid. I accordingly certify that the validity of GB 2329332 as amended was contested on the grounds of lack of inventive step having regard to the disclosure in the documents considered in my earlier decision, and I have found the patent as amended to be valid.

### **Costs**

- 6 The costs for the substantive hearing have been dealt with in my previous decision and any further costs incurred by the claimant in considering these amendments will be small. Accordingly I make no further order for costs.

### **Appeal**

- 7 Under the Practice Direction to Rule 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

Dated this 22<sup>nd</sup> day of September 2003

**P HAYWARD**

Divisional Director acting for the Comptroller

**THE PATENT OFFICE**