

PATENTS ACT 1977

IN THE MATTER OF

an application under section 72

by ABV Engineering Pte Ltd

for the revocation of Patent No GB 2266111

in the name of Eng Siang Ong

and

IN THE MATTER OF

an offer under section 29

by Eng Siang Ong

to surrender Patent No GB 2266111

DECISION

1. Patent No GB 2266111, entitled "A self-transportable pile driving apparatus", was filed on 15 April 1993 as application number GB9307815.2 claiming a priority date of 16 April 1992. The patent was granted on 23 August 1995 in the name of Eng Siang Ong.
2. On 16 January 1996, ABV Engineering Pte Ltd filed an application for revocation of the patent on the grounds that the invention claimed is not a patentable invention because all the claims are anticipated and/or rendered obvious by piling machines developed by the applicant and publicly used in Singapore and disclosed prior to the priority date of the patent. The proprietor opposed the application for revocation in a counter-statement filed on 10 June 1996.
3. The matter proceeded through the usual evidence stages, and during this procedure a conditional offer to amend claim 1 of the patent was made by the proprietor. A substantive hearing was appointed for 11 and 12 June 1998 but, in view of considerable difficulties in

arranging the attendance of all those called for cross-examination, especially those from the Far East, this had to be postponed. Those difficulties did not diminish, and if anything grew, for reasons I do not need to go into here.

4. In further correspondence it was agreed between the parties that discovery (as it was then called) might remove the need for at least one witness to attend for cross-examination, and on 7 July 1998 I issued a direction ordering discovery of certain documents.

5. In a letter from the proprietor dated 14 December 1998 the Office was informed that negotiations were taking place between the parties and that a settlement was hoped for. On 27 April 1999, a letter from the applicant was received which read:

“A settlement between the parties has now at long last been concluded. The agreement requires the above application for revocation to be withdrawn and the patentee to surrender the patent. We have agreed with Marks & Clerk [agents for the proprietor] that these two procedures will be effected today and we therefore now withdraw the above application for revocation herewith.”

6. On the same day, 27 April, a Form 2/77 and statement were filed by the proprietor to initiate surrender proceedings. The offer to surrender the patent was advertised in the *Patents & Designs Journal* on 14 July 1999; no response to the advertisement was received.

7. Since surrender only takes effect from the date when notice of acceptance of surrender is published in the *Patents and Designs Journal*, whereas revocation has retrospective effect, it is the comptroller’s practice in cases such as the present one to consider in the public interest whether it is appropriate to accept the offer to surrender, or whether to order revocation of the patent. The approach which the Office initially takes is set out in *The Manual of Patent Practice* at paragraph 72.38, which reads:

“72.38 The matter should be considered as though no counterstatement had been filed, that is, as if each specific fact set out in the statement had been conceded except

insofar as it is contradicted by other documents before the Office. If on this basis it is determined that at least one ground for revocation has been made out (and provided that the two month period has expired without an opposition being lodged), the parties should be informed that it is proposed to issue a formal decision revoking the patent, and consequently not to accept the offer to surrender, unless within one month either party opposes this course of action.”

8. An official letter making just such a proposal was issued on 20 September 1999. In a letter of 8 October 1999 the proprietor objected to the proposed revocation, and requested that the offer to surrender be accepted, for four reasons. Paraphrasing, the first three reasons were: the applicant for revocation has agreed to the surrender; advertisement of the offer to surrender has not prompted any opposition; the applicant withdrew its application for revocation on the same day as the offer to surrender was filed. While each of these is undoubtedly true, none of them, it seems to me, goes to the issue of whether any ground of the revocation application has been made out, nor therefore whether the comptroller should proceed to revocation of the patent in the public interest.

9. In presenting the fourth reason, the proprietor acknowledges that even if an application for revocation has been withdrawn it is the practice of the comptroller to revoke the patent in suit where it is clear from the documents already filed that the patent should be revoked. However, the proprietor goes on to argue that in the present revocation proceedings a large amount of conflicting evidence was filed by the parties, and submits that in view of what it regards as a serious conflict of evidence, there is no case for the comptroller to revoke the patent, and that the offer to surrender the patent should be accepted.

10. I have carefully considered the proprietor’s submissions and all the evidence and other documents on file, in particular the allegations of public prior use and disclosure cited by the applicant in the revocation proceedings, and I have come to the conclusion that on the balance of probabilities a case for revocation is not made out. Accordingly, I make no order for revocation, and instead accept the offer of surrender of the patent.

11. In the statement accompanying the offer to surrender on Form 2/77, the stated agreement between the parties included that each party will withdraw its claim for costs. Accordingly, I make no order for the award of costs in these proceedings.

Dated this 25th day of February 2000

S N DENNEHEY

Divisional Director, acting for the comptroller

THE PATENT OFFICE