

PATENTS ACT 1977

IN THE MATTER OF

an application under Section 72

by Bowthorpe plc

for the revocation of Patent No GB 2254739

in the name of Raychem Limited

and

IN THE MATTER OF

an offer under Section 29

by Raychem Limited

to surrender Patent No GB 2254739

DECISION

Introduction

1. Patent No GB 2254739, entitled “Cable Joint”, was filed in the name of Raychem Limited on 24 March 1992 as application number GB9206329.6 and was granted on 4 October 1995.
2. Revocation of the patent was applied for on 22 July 1998 by Bowthorpe plc, on the ground as set out in their subsequently amended statement that the cable joint and method defined in the claims are not inventive relative to prior art identified in the statement. In a letter of 16 November 1998, the proprietors stated that they had decided that it was not commercially worthwhile to contest the application for revocation, and accordingly no counter-statement would be filed. As promised in the same letter, they also filed on the same day an offer to surrender the patent. The offer to surrender was advertised in the *Patents & Designs Journal* on 30 December 1998; no response to the advertisement was received.
3. In an official letter dated 11 March 1999, the applicants were asked if they wished to

withdraw their application for revocation in view of the unopposed offer to surrender. The applicants responded that they wished to pursue the application, submitting that the patent should be revoked in its entirety. A subsequent official letter of 2 September 1999 indicated the Office's preliminary view that at least one ground for revocation had been made out, and that subject to any views from either of the parties, or any request to be heard on the issues, the Hearing Officer would issue a decision on the basis of the papers. No reply was received from either party. I have therefore considered very carefully all the papers on file in coming to the present decision.

The Patent

4. The patent relates to a joint for a high voltage electric cable. Claim 1 reads as follows:

“A high voltage cable joint between two or more cables, each of which comprises a plurality of cable cores, wherein:

(a) exposed conductors of stripped cores of one cable are connected to respective exposed conductors of stripped cores of another cable;

(b) each core connection is enclosed within a polymeric insulating tube that has been recovered therearound, preferably by the application of heat thereto, or which has been revolved thereover;

(c) a respective conductive layer extends in contact around each insulating tube, thereby electrically to screen the connection;

(d) an outer closure arrangement encompasses the screened cable connection and is sealed on to an outer protective jacket of each of the cables; and

(e) the interior of the closure arrangement around the insulated and screened cable cores is substantially filled with a cured electrically

insulating material that has been poured into the outer closure arrangement”.

5. Claims 2 to 11 are also directed to a cable joint and are dependent on claim 1. Independent claims 12 and 13 are in the omnibus form and are respectively directed to a high voltage cable joint and a method of forming one.

The Comptroller's Approach

6. Since revocation applies retrospectively, whilst surrender only has effect from the date when notice of its acceptance is published in the *Patents and Designs Journal*, it follows that an offer to surrender does not automatically terminate revocation proceedings. As I have already noted, the applicants have stated that they wish to pursue the application for revocation, notwithstanding the offer to surrender. In circumstances such as these it is the Comptroller's practice to decide whether the patent should be revoked before dealing with the offer to surrender.

7. Paragraphs 72.09 and 72.38 of the *Manual of Patent Practice* set out the approach the Patent Office normally takes where no counter-statement is filed and an offer to surrender is made in the course of revocation proceedings. In essence, this is that the matter should be considered as if each specific fact set out in the statement has 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, the parties are informed that it is proposed to issue a formal decision revoking the patent, and consequently not to accept the offer to surrender, unless either party opposes this course of action. This was the position taken in the official letter of 2 September 1999 which I mentioned earlier and to which no reply from either side was received.

The Case for Revocation

8. I have carefully considered the grounds for revocation submitted by the applicants. In their statement (as amended) the applicants assert among other things that the invention as claimed in claim 1 is lacking in inventive step in view of the disclosures of patent no GB2036460, "Scotchcast" joint kit instructions dated 15 August 1985 and 19 October 1988, "Raychem" joint kit instructions dated 12/77, and what was common general knowledge in the art at the time. It seems to me that it would *prima facie* be an obvious step to replace the tape wrapping of the individual cores in the cable joints of the Scotchcast documents by the heat shrink tubing disclosed in GB 2036460 and the Raychem documents in order to arrive at the cable joint set out in claim 1 of the patent in suit, and hence that the invention claimed in claim 1 at least is lacking in inventive step. I therefore conclude that a ground for revocation has been made out, which in the absence of any defence from the proprietors is sufficient for revocation to proceed.

9. I therefore order the revocation of the patent and decline the offer to surrender.

Costs

10. In their letter of 16 November 1998 the proprietors submitted that they have no liability for costs, for example because, as they assert, no prior approach was made to them in advance of the filing of the revocation action. As for the applicants, although in their statement they ask for their costs, they stated in their letter of 19 February 1999 that they had no comment on the question of costs.

11. Rule 76 of the Patents Rules 1995 requires me in relation to costs to consider in the circumstances of the present case, where an offer to surrender is made in the course of revocation proceedings, whether the revocation proceedings might have been avoided if the applicant had given reasonable notice to the proprietor before the revocation application was filed. The proprietors' submission on costs goes to this point. While it is difficult to assess how the proprietors might have behaved had they been given advanced notice of the application for

revocation, the relative alacrity with which they declined to defend it and made the offer to surrender lead me to believe that a preliminary approach giving notice might well have meant that the revocation proceedings were never launched. Coupled to the applicants' statement that they had no comment on the question of costs, I have decided to make no order for costs in this case.

Appeal

12. This being a decision other than on a matter of procedure, any appeal against this decision shall be issued within six weeks after the date of this decision.

Dated this 14th day of March 2000

S N DENNEHEY

Divisional Director, acting for the comptroller

THE PATENT OFFICE