

PATENTS ACT 1977

IN THE MATTER OF

an application under section 72

by Imation Corporation

for the revocation of Patent No EP(UK) 0432712

in the name of E I Du Pont de Nemours and Company

DECISION

1. On 18 September 1996 Imation Corporation ("Imation") initiated proceedings under section 72 of the Patents Act 1977 for the revocation of patent number EP(UK) 0432712 in the name of E I Du Pont de Nemours and Company ("Du Pont"). At a very early stage in the proceedings, Du Pont brought to the Office's attention the existence of a parallel opposition before the European Patent Office ("EPO"), and sought the suspension of the present proceedings pending the EPO's decision on the opposition. Imation opposed such suspension and in due course Du Pont responded by filing a counter-statement and offering amendments to the patent, which it asserted should be maintained in the form as proposed to be amended. The proposed amendments were duly advertised in the *Official Journal (Patents)*.

2. Du Pont repeated its request for a stay of the present proceedings, and Imation continued to oppose it, and in those circumstances the Office gave a preliminary view that a stay should not be ordered, taking account of the judgment of the Court of Appeal in *Beloit Technologies Inc and Another v Valmet Paper Machinery Inc and Another* [1997] RPC 489. However, Imation then changed its position and supported Du Pont's request. In view of this agreement between the parties, in October 1997 I ordered a stay subject to its periodic review.

3. With a letter dated 12 January 1999 Imation enclosed a copy of the Interlocutory Decision of the EPO Opposition Division maintaining the patent in amended form. In a further letter of 2 February Imation confirmed that it would not be appealing against that decision. In that letter Imation also withdrew from the present revocation proceedings, reporting that the parties had

reached agreement whereby Imation would withdraw and each party would bear its own costs. The Office then wrote to Du Pont inviting its comments and alluding to the practice of the comptroller, when an applicant for revocation withdraws, of considering whether he should pursue the application for revocation in the public interest.

4. In a letter of 25 February Du Pont comments *inter alia* that the opposition and the revocation application were essentially the same in content; that the issues raised in the opposition had been met by amendment of the European patent; that the public interest would not be served by the Patent Office revisiting these issues which have already been considered by the EPO; and that there is nothing before this Office which was not also before the EPO.

5. I have reviewed the papers and am prepared to accept Du Pont's submissions. The grounds for revocation raised in the present proceedings have been considered and disposed of by the EPO. So far as the proposed amendments which have been advertised in the *Official Journal* are concerned, I am satisfied they fall with this revocation application. The European patent will take the form as it has been amended before the EPO, provided of course that the proprietor takes any remaining procedural steps, and it will have effect in that form in the United Kingdom. In these circumstances there is nothing for the comptroller to pursue in the public interest, and I make no order for revocation of the patent, or, in view of the parties' agreement, for costs.

Dated this 5th day of March 1999

S N DENNEHEY

Divisional Director, acting for the comptroller

THE PATENT OFFICE