

before the court, the comptroller may stay any consideration of the offer to surrender and order the proprietor to inform the court that an offer to surrender has been made (*Dyson Ltd's Patent* [2003] RPC 24).

- 6 In *Connaught Laboratories Inc's Patent* [1999] FSR 284 Laddie J revoked a patent where, one day before the trial of the petition to revoke, the respondent gave notice to the petitioner of its intention to surrender the patent. In assessing the impact of section, Laddie J said at page 288:

"An order for revocation may have a different effect to an acceptance of surrender, for example in relation to the royalty provisions in third party licenses."

- 7 Laddie J then said:

"It is open to me therefore to order revocation of the patent if, having regard to what is pleaded and the material which I have seen, that is the appropriate course. Alternatively, I can allow the offer to surrender to be further processed through the Comptroller. The latter course will involve advertisement, the possible involvement of third parties, delay and additional expense."

- 8 I do not think this takes away the comptroller's powers of decision under section 29 where a revocation action is before the court. It does however suggest that, where the court is aware of an offer to surrender, it will consider in all the circumstances of the case whether it is preferable to go ahead with the revocation action or to leave the offer of surrender to take its course before the comptroller. If revocation were ordered, there would of course be no patent left to surrender.
- 9 I do not think that the factors which weighed with Laddie J in *Connaught* are especially pertinent to the present case, since the offer of surrender has already been advertised and has not been opposed. No question of further delay and expense would therefore seem to arise.
- 10 In my view, it would be desirable to bring the offer of surrender into the same forum as the revocation action so that the appropriate course of action can be considered in the light of all the circumstances of the case. Even though there has been no opposition to the surrender – particularly from those whose interests might be affected by revocation of the patent, namely the claimant in the revocation action (Kimberley-Clark Europe Limited) and any licensees under the patent – I believe I should stay further consideration of the matter to await the outcome of the revocation proceedings.
- 11 I should of course take care that in ordering a stay, I do not simply delay the overall settlement of the revocation proceedings or prejudice the position of the proprietor. On the facts before me, I cannot see that any such delay is likely. Further, any deferral of the surrender would not seem to prejudice the proprietor's position: it is still open to them, if they have no interest in the patent and there are no third parties with an interest in it, not to defend the revocation action.

Order

- 12 I therefore order that the proprietor OR Specific Inc should, if it has not done so already, notify the court of the offer to surrender. It should notify the comptroller, within 14 days of their conclusion, of the outcome of the court proceedings; or within

14 days of its making, of any order from the court that the surrender proceedings should continue before the comptroller. The comptroller will then consider the matter further.

Appeal

- 13 The period for appeal is 28 days.

MRS S E CHALMERS

Deputy Director, acting for the Comptroller