



# Australian Patent Office

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## ANTHONY CHARLES WORRALLO v. DANIEL W ← HALES → and LOIS R ← HALES → [1992] APO 27 (20 May 1992); 24 IPR 273

### OFFICIAL NOTICE

decision of a delegate of the commissioner of patents

**Application** : No. 516018 in the name of ANTHONY CHARLES WORRALLO

**Title** : Improved Locking Device

**Action** : Objection to applicant's application for special leave to adduce further evidence under Regulation 59 in the s. 97(3) opposition by DANIEL W ← HALES → and LOIS R ← HALES →.

**Decision** : Issued . Leave granted. Opponent allowed 1 month from decision to serve evidence in reply.

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### PATENTS ACT 1990

decision of a delegate of the commissioner of patents

Re: Patent No. 516018 by ANTHONY CHARLES WORRALLO, Opposition by DANIEL W ← HALES → and LOIS R ← HALES → to an Application for Restoration and an Application for Special Leave to lodge Further Evidence by the Applicant.

### BACKGROUND

Patent no. 516018 for an invention entitled "Improved Locking Device"

was advertised accepted on 14 May 1981 and was sealed on 9 November 1981. The patent ceased in 1989 due to the non-payment of a renewal fee. On 23 March 1990 the patentee ANTHONY CHARLES WORRALLO (Worrallo) applied under [section 97](#) of the [Patents Act 1952](#) for restoration of the patent, and this application was advertised on 6 September 1990.

DANIEL W  HALES  and LOIS R  HALES (Hales ) jointly lodged a notice of opposition to the restoration on 6 December 1990. Evidence-in-support, comprising one declaration by Peter Chamberlayne Dummer, was lodged on 15 March 1991, and evidence-in-answer, comprising one declaration by Douglas Charles Carter, was lodged on 15 March 1991. Evidence-in-reply, comprising one declaration by Daniel W  Hales , was lodged on 2 July 1991 following the grant of one extension of time. On 19 September 1991 the opponents, through their attorneys, Peter Maxwell & Associates, advised that no further evidence would be filed and requested that the matter be set down for hearing.

On 20 September 1991 Worrallo applied under Regulation 59 of the [Patents Act 1952](#) for special leave to lodge further evidence. The application was accompanied by 2 declarations by Douglas Charles Carter and Anthony Charles Worrallo. The Attorneys for  Hales  lodged an objection to this application for special leave on 8 October 1991. The grounds for opposing the application for special leave were:

- "1. The Declarations which accompanied the Request for Special Leave do not make clear why the Application for Special Leave is necessary.
2. It appears that the evidence supplied in the Statutory Declarations is intended to perform the dual purpose of justifying the Application for Special Leave and also amounts to the further evidence which the Application for Special Leave seeks to have admitted.
3. The evidence provided pre-empts the grant of Special Leave to allow the evidence to be admitted."

Both parties advised that they did not wish to be represented at a hearing on the objection to the application for special leave, but would rely on written submissions.  Hales , through their attorneys, filed a written submission on 21 November 1991. Worrallo, through his attorney, Carter Smith & Beadle, filed a written submission on 6 March 1992.

#### APPLICATION FOR SPECIAL LEAVE

The declaration by Carter filed with the application for special leave (the second Carter declaration) indicates the grounds on which the application is made as follows:

"3. I have read and understood the Statutory Declaration of Daniel W  **Hales**  together Exhibits DWH 1 and DWH 2 lodged as part of the opponent's evidence-in-reply. As that Declaration raises new grounds to which no reference was made in the evidence-in-support lodged by the Opponent, it is desired to answer those new grounds and to clear doubt which might otherwise exist concerning the circumstances which resulted in the inadvertent lapsing of the patent."

The remainder of the Carter declaration concerns the issue of whether Worrallo had given any instruction not to pay the renewal fee on 516018.

The Worrallo declaration explains the circumstances of the non-payment of the renewal fee.

## SUBMISSIONS

On behalf of  **Hales**  the attorney submits that, contrary to the statement in the second Carter declaration, no new grounds were raised in the  **Hales**  declaration, and he qualifies this in these terms:

"4. It is submitted that the  **HALES**  Declaration simply highlights omissions and inconsistencies in the first CARTER Declaration.

5. The fact that the opponent's evidence-in-reply comprising the first CARTER Declaration had omissions and inconsistencies in it and the fact that these inconsistencies and omissions have been highlighted in the opponent's evidence-in-reply comprising the  **HALES**  Declaration does not provide grounds for special leave.

6. The grounds of the opponent's opposition are as stated in the Form 12 Notice of Opposition as filed 6th December, 1990. The grounds of the opposition have not been altered or added to by the content of the Statutory Declaration of DANIEL  **HALES** .

I believe the term "opponent's evidence-in-reply" in the first line of point 5 above should read "applicant's evidence-in-answer".

The attorney's submission on behalf of Worrallo reiterates the statement that the opponent's evidence-in-reply introduces new grounds to the opposition. As further support for the additional evidence the attorney states:

"One course of action open to the applicant was simply to object to the evidence-in-reply at the Hearing to decide the matter. It is believed, however, that all the circumstances surrounding the lapsing of the application and the subsequent filing of the application for restoration must be placed before the Patent Office and the public. It was therefore considered necessary that the additional evidence be adduced to clear any possible doubts which may have been raised by the opponent's Evidence-in-Reply."

Concerning the objection to the application for special leave, the attorney submits that:

. The second Carter declaration states the reason why it is desired to lodge further evidence;

. the 1952 Regulations do not prevent the evidence filed performing the dual purpose of setting out the grounds for and the nature of the further evidence and also comprising the further evidence itself; and

. the grant of special leave is not pre-empted since it is open to the Commissioner to refuse the grant, in which case the further evidence would not be considered.

## DECISION

I will first comment on the grounds for opposing the application. I do not agree with the attorney for  **Hales**  that the declarations do not make clear why the application is necessary. I believe that paragraph 3 of the second Carter declaration (quoted above) gives adequate reason why Worrallo wishes to lodge further evidence, and  **Hales** ' attorney appears to acknowledge this in paragraph 2 of his letter filed 21 November 1991. I would agree with  **Hales** ' attorney that the Worrallo declaration does not support the request for special leave, and Worrallo's attorney acknowledges in his letter filed 6 March 1992 that this declaration is part of the proposed additional evidence.

Concerning the question of whether the statutory declarations filed with the application for special leave perform the dual purpose of giving the nature of the further evidence and also comprise that evidence, Worrallo's attorney agrees they do serve this dual purpose but argues that the Regulations do not prevent this situation. I would agree that this situation is not precluded by the Regulations, but I do not believe it was the intention that the declaration of Regulation 59(3), relating to the nature of the further evidence, would be the same as the declaration required under Regulation 60(1), which concerns the declaration containing the further evidence. However since Worrallo has chosen to combine the declarations in this

manner, I do not believe I should refuse the application for special leave merely because the further evidence has already been filed. I will not however further consider the Worrallo declaration or those parts of the second Carter declaration relating solely to the further evidence in reaching my decision.

My refusal to consider the further evidence at this stage, I believe, negates the third objection by  **Hales**  concerning the pre-empting of the grant of special leave.

In relation to the application for special leave itself, there are several factors that I must consider. The Patent Office Hearings Manual (September 1988) refers to these factors as follows:

i. Is the evidence which it is proposed to adduce, based on the nature thereof and grounds as set out in the declaration, relevant to the action, in the sense that it would contribute to a more correct, just, or expeditious result?

ii. If the application for special leave were to be allowed, would this cause unnecessary protraction of the opposition?

iii. Would there be any injustice done to the other party, if the application were to be allowed?

iv. Has the party seeking to adduce the further evidence been diligent in prosecuting the opposition action?

I will consider the present application against each of the factors in turn.

In relation to point (i), I consider the evidence sought to be adduced is relevant to the action. It relates to the circumstances which resulted in the lapsing of the patent and, according to the second Carter declaration, will "clear doubt" about those circumstances. It seems to me that it will supplement the evidence already on file. Therefore I am satisfied that the evidence to be adduced is likely to contribute to the determination of the [s.97\(3\)](#) opposition by leading to a more correct or just result.

The attorney for  **Hales**  argued that the  **Hales**  declaration simply highlighted inconsistencies and omissions in the applicant's evidence-in-answer and did not raise new grounds. From looking at the evidence it appears to me that the opponent's evidence-in-support goes to the question of undue delay, whereas the evidence-in-reply goes to the question of the patentee's intent. If this is so then I believe the further evidence relating to the circumstances of the lapsing of the patent may clarify matters raised by the opponent, and this appears to again contribute to the determination of the opposition. I therefore believe that point (i) referred to above is satisfied.

In relation to point (ii), I consider the allowance of the special leave application will not cause any

unnecessary protraction of the opposition. The further evidence has already been filed and served on the opponent. The Commissioner cannot set a date for the hearing of the [s.97\(3\)](#) opposition at this stage since, if I grant the application for special leave, the opponent must be given the opportunity to adduce evidence in reply, according to Regulation 59(6). Accordingly I do not foresee any unnecessary delay in the opposition proceedings.

I must next consider, according to point (iii), whether any injustice would be done to the opponents if the application were allowed. In my view no such injustice is likely to arise. As I have said before, it seems that the further evidence merely supplements the evidence on file. The opponents have already had the opportunity to consider the further evidence and have not indicated that they would suffer any injustice were it to be admitted. Furthermore, if special leave is granted, the opponents may adduce evidence in reply pursuant to Regulation 59(6).

Finally I must consider, according to point (iv), whether the applicant has been diligent in prosecuting the opposition action. I note that the applicant's filed their evidence-in-answer 12 days after they were served with the evidence-in-support. I also note that the applicant's filed their application for special leave 2 days after the notification from the opponents that no further evidence-in-reply would be filed. It therefore seems to me that the applicant has certainly been diligent in prosecuting the opposition action.

Having regard to all the circumstances of this case, I consider that a case has been made out justifying the allowance of the application for special leave.

## CONCLUSION

I allow the Regulation 59 application for special leave to lodge further evidence. As the applicant has already filed that evidence and served it on the opponent, the month provided under Regulation 60 (2)(a) for service of evidence in reply to the further evidence will commence from the date of this decision.

(JANET WERNER)

Delegate of the Commissioner of Patents

Patent attorneys for the applicant : *Carter Smith & Beadle, Melbourne.*

Patent attorneys for the opponent : *Peter Maxwell and Associates, Sydney.*