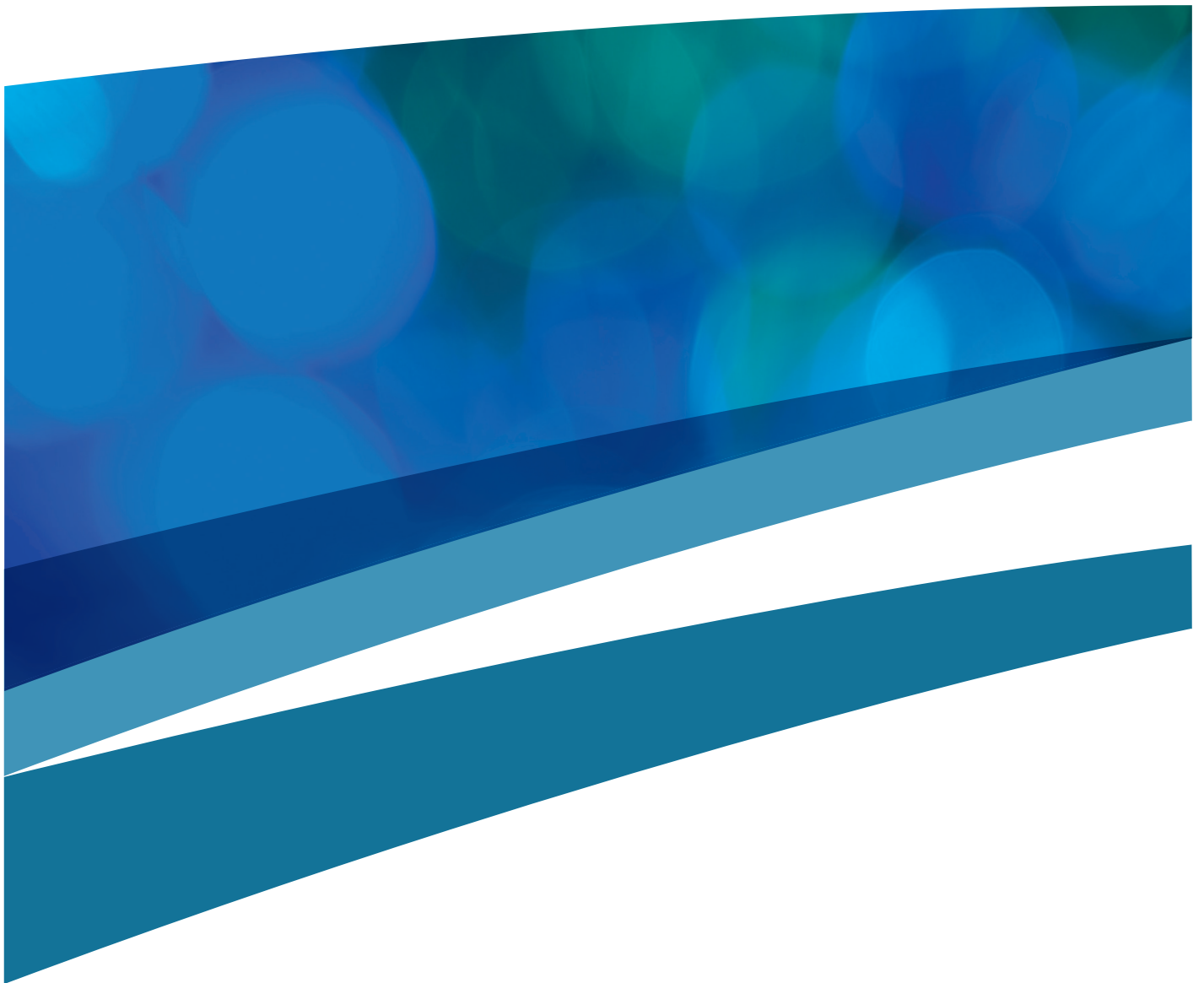




Intellectual  
Property  
Office

# Litigation Manual



## Introduction

This manual is primarily intended to provide guidance to Patents Directorate staff in Litigation Section. The manual contains detailed, up-to-date desk instructions on the practice and procedures Litigation Section staff should follow in the formal examination and processing of statements and evidence filed in *inter partes* proceedings before the comptroller, the formal processing of *ex parte* proceedings including restoration applications and in arranging hearings, issuing decisions and carrying out any subsequent actions. Most of the circumstances that staff can expect to encounter are covered. However situations may arise which are not addressed in the manual. In such cases, advice should be sought from line management or a Hearing Officer as appropriate.

The guidelines contained in the manual do not constitute legal provisions and as such are not authority for any action by the Office, nor do they impose any particular line of action. The ultimate authority on practice and procedures relating to patents is the Patents Act 1977 (as amended) and the Patents Rules 2007 (as amended). For design right, the ultimate authority is the Copyright, Designs and Patents Act 1988 and the Design Right (Proceedings before the Comptroller) Rules 1989. For advice on the interpretation of the provisions of the Patents Act and Rules, reference should be made to the Manual of Patent Practice. There is as yet no corresponding manual covering design right.

Further guidance on matters relating to proceedings before the comptroller can also be obtained from the Patents Directorate's, Patent Hearings Manual. It may also be appropriate to refer to the Civil Procedure Rules 1998 and associated Practice Directions.

This manual is divided into chapters covering different types of proceedings dealt with by the comptroller and distinct topics. Each chapter is further divided into sub-topics identified by sub-headings. The paragraphs are numbered sequentially with each number starting with the number of the chapter.

A list of commonly used terms and abbreviations is included together with a full index.

The manual is updated as appropriate to reflect changes in practice and to correct any errors. A schedule of the latest amendments is included below.

We welcome corrections to the information contained in this manual and also suggestions for improvement. They should be addressed to:

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# 1 STANDARD PROCEDURES

## INTRODUCTION

- 1.01 The Patent Rules 2007 provide a single, flexible framework for all *inter partes* patent proceedings before the comptroller. Part 7 of the rules relates to all patent actions before the comptroller apart from reviews of opinions which are subject to separate rules. The rules are intended to improve speed and efficiency in the conduct of proceedings. They also provide for greater flexibility in managing proceedings. The rules apply to all proceedings from 17 December 2007.
- 1.02 The rules include an explicit statement of the overriding objective for the disposal of proceedings before the comptroller, including criteria corresponding to the overriding objective set out in Part 1 of the Civil Procedure Rules (CPR) (rule 74). As with the CPR, rule 74(4) places an obligation on the parties to help the comptroller to further the overriding objective. However the rule is not intended to change the way cases are dealt with, by, for example Litigation Section
- 1.03 The comptroller and Litigation Section do not just deal with disputes relating to patents. They also deal with certain disputes relating to design right (see Copyright, Designs and Patents Act 1988 sections 246 and 247). Design Right proceedings are governed by the Design Right Rules 1989. The procedures followed are set out in Chapter 15 of this Manual. The rest of this Chapter describes the procedures to be followed when actioning patent proceedings. Annexes 1 and 2 are examples of how the proceedings may progress.

## INITIAL ACTION

### Formal Requirements

- 1.04 Inter partes proceedings are initiated by the filing of a form. For most proceedings under the Patents Act 1977, two copies of Patents Form 2



should be filed. For opposition proceedings, two copies of Patents Form 15 should be filed. Reference should be made to the Act and Rules concerning any time limits restricting the commencement of proceedings. An opposition filed under section 75(2), for example, should be filed within two weeks of the opposition advertisement in the Journal (rule 76(2)(a)). In the case of other oppositions listed in Part 2 of Schedule 3 of the Rules, an opposition needs to be filed within four weeks of the date of the advertisement in the Journal. It is not possible to extend these periods.

- 1.05 In all cases, the forms should be accompanied by the appropriate fee. If the fee has not been paid or is subsequently cancelled, then the action will be deemed not to have been properly filed. The forms should also be accompanied by two copies of a statement of grounds (rule 76(1)). For proceedings started under section 46(3) by a person other than the proprietor, see Chapter 11 and rule 89.
- 1.06 On receipt in the Office, the form and accompanying documents will be scanned to the Office's electronic case management system and an electronic dossier (case file) will be created. Occasionally documents will be received in paper form in Litigation Section. The B3 should send the documents to Indexing and Scanning (see annex 3). An electronic message will be sent to the B3 who will review the dossier, and amend the document codes as appropriate (see list included in Chapter 25). The B3 will carry out an initial check of the case. The check establishes, for example, that the correct section of the Act has been identified, the filing fee has been paid, a statement of grounds has been filed and the correct patent number(s), if appropriate, have been quoted. If these formalities requirements have been met, the B3 should :
- allocate a B2 Case Officer and HO and enter the case details in the inter partes SharePoint list

The B3 should then carry out an analysis of the statement. If this is in order, the B3 should:

- Filter the Form 2, statement of grounds and attachments into the CLAIM PLEADINGS folder within the Inter Partes procedure in PDAX
- serve the proceedings
- make an entry in the register to record the fact that proceedings have been filed
- minute the case to the B2 and request B2 carries out following actions:
  - arranges for the proceedings to be advertised in the Journal
  - diaries case to await a counter-statement
  - updates the front cover of the dossier with the appropriate labels – eg Litigation Proceedings

1.07 If there are minor problems with the documents, the B3 may resolve these by telephone with the claimant/attorney before serving. If, for example, Patents Form 2 has not been completed properly, the claimant/attorney should be contacted, preferably by telephone, and with his/her agreement any corrections may be made by the B3. These should be initialed and dated and a copy of the corrected documents sent to the claimant. A copy of the corrected Form/document should also be sent to the patent applicant/proprietor except where he is the claimant (rules 77(1) and (2), and every person who it appears is likely to have an interest in the case (rule 77(1)).

If the proceedings have been filed by two or more claimants who are not professionally represented, each of the claimants need to sign the Form. This is necessary even though one of the claimants may be shown on the Form as the main contact for the proceedings.

Occasionally, the B3 may request that the B2 review the proceedings and carry out the substantive analysis of the statement and serve.

#### Action by Litigation Assistant (A1)

1.08 Deleted

1.09 Deleted

#### Actions by B2

- 1.10 Where proceedings refer to more than one patent/patent application.
- Create a minute for each of the dossiers to identify the lead dossier for the proceedings and list the other cases in the proceedings as follows:

Proceedings under section X LEAD FILE

See also: GB XXXXXXXX, GB XXXXXXXX, LITYYNNNN

- Process the case using the lead dossier rather than all of the dossiers

Where proceedings are filed under various sections of the Act

- the minutes should be updated to show the relevant sections

#### Status of proceedings

At all stages during the processing of the case, the B2 should update the minutes to reflect the current status of the proceedings. Any diary date entries should be noted within the relevant minute.

## STATEMENT OF GROUNDS

### What should the statement of grounds contain?

1.11 When checking the statement of grounds, reference should be made to rule 76(4) of the Patents Rules 2007. This states that the statement of grounds should set out fully:

- a concise statement of the facts and grounds on which the claimant relies
- where appropriate, include the period or terms of the licence which he believes are reasonable
- specify the remedy the claimant is seeking
- where it accompanies an application under the Community Licensing Regulation, include any information required by the Regulation.

and should be verified by a statement of truth so it can be given in evidence. The statement of truth should be signed and dated.

1.12 The B3/B2 should also ensure that any other requirements specified in the rules are complied with.

### What happens if the statement of grounds does not comply?

1.13 If it appears that the statement of grounds is inadequate, the B3/B2 should seek to resolve the matter. If appropriate, the B3/B2 may discuss observations and recommendations with a HO. The B3/B2 should subsequently issue a letter pointing out the defects and should invite the claimant to file an amended statement.

1.14 The letter should express a preliminary view only e.g. that the statement of grounds appears inadequate or that the claimant appears

to be requesting relief that may not be available. The claimant should be given a period of time in which to respond. The letter, along with a copy of the relevant form and any documents received, should be copied to the patent applicant/proprietor as appropriate and all those likely to have an interest in the case. At this stage the patent applicant/proprietor and others should not be invited to file a counter-statement.

**PDAX:-** Letter is created in Word and imported using manual import (doc code is DEFECT LET)

1.15 If no response is received, the case should be referred to the HO for consideration. If the defects are substantial, a second letter may be sent indicating that, in the absence of a response, the Office proposes to strike out the action or treat it as withdrawn. A copy of this letter should also be sent to all interested parties for information.

**PDAX:-** Letter is created in Word and imported using manual import (doc code is LETTER-IP)

1.16 Sometimes the only defects relate to documents referred to in the statement of grounds, for example, they may not have been filed or where they are filed they are in a foreign language and a translation may be missing. If these are the only defects the B3/B2 may:

- if it is clear from the statement of grounds that the parties would have access to the missing documents/translations, formally serve the proceedings OR
- write to the claimant to request that the missing documents are filed in duplicate (see rule 79(2)) and set a time period of not more than one month for a response. The letter should be copied to all interested parties. They should not be invited to file a counter-statement at this time.

**PDAX:-** Letter is created in word and imported using manual import (doc code is LETTER-IP)

- 1.17 If reference is made within the statement of grounds to without prejudice documents for example resulting from negotiations between the parties, the case should be referred to a HO as it may not be necessary to request copies of such documents (for further details, see Patent Hearings Manual).
- 1.18 If the claimant does not respond to the official letter, the proceedings should be referred to a HO.

#### Serving the Statement of Grounds

- 1.19 If everything is in order or put in order then the B3/B2 should send a copy of the form, the statement of grounds and any other documents filed by the claimant to the patent applicant/proprietor and all those who it appears are likely to have an interest in the case (see annex 4(a)). In determining who to notify, the B3/B2 should consider those named in the Register of Patents and those named in the statement and should refer any recommendations to the HO. The letter should:
- indicate that proceedings have started
  - set a date for the filing of a counter-statement
  - request the counter-statement be filed in duplicate
  - request that any correspondence filed should be marked for the attention of the Case Officer
- 1.20 If the form and documents have already been sent, the letter should advise that the proceedings have formally started and request a counter-statement.

In both instances, correspondence should be copied to the claimant. If appropriate, correspondence sent to all parties may include a reference to mediation (see annex 8); however this will not be appropriate in respect of revocation proceedings. The claimant should also be advised that on receipt of a counter-statement, he will have two weeks to file Patents Form 4 (and fee) to continue the proceedings (see annex 4(b)).

**PDAX:-** Letter is created in Word and imported using manual import (doc code is SERVE LET)

#### Unpublished patent applications

- 1.21 Section 118 and rule 55 does not authorise us to inform a claimant of a patent applicants address for service in respect of unpublished patent applications. Consequently, before copying any correspondence sent to a patent applicant who is not a claimant, the following procedures should be followed:
- 1.22 The patent applicant should be contacted and asked if he is willing for us to disclose his address for service.
- 1.23 If he is unwilling for us to do so, then we must ensure that we blank out any letter heading indicating the address for service of the patent applicant when copying correspondence to the claimant. Similarly, the claimant should not receive copies of letters sent to the named inventors for the unpublished application.
- 1.24 If the case has been dealt with by the B3, he/she should then:
- send the case to the allocated B2 Case Officer
  - highlight any issues that have arisen / are outstanding
  - request the B2 to arrange a Journal advert
  - request the B2 to diary the case to await a counter-statement.

**PDAX:-** The B3 should minute the file with the above information.  
Create and send message to B2 Case Officer. Message = PSM  
Advert is created and imported using manual import (doc code is ADVERT-IP)

If the case has been dealt with by the B2, he/she should then:

- arrange a journal advert
- diary the case to await a counter-statement

**PDAX:-** Advert is created and imported using manual import (doc code is ADVERT-IP)

## **COUNTER-STATEMENT**

1.25 If any person who is sent a copy of the appropriate documentation wishes to oppose the proceedings, he must file a counter-statement (in duplicate) within the period specified. If a counter-statement is not filed, the comptroller will take it that the person concerned supports the claimant's case (rule 77(9)). If various parties such as the patent applicant and named inventors wish to oppose the proceedings, one counter-statement may be filed. However this should include a statement of truth signed by each party (see 1.26 and rule 78(1)). The rules do not prescribe a time period for the filing of a counter-statement but in most cases, six weeks should be allowed. There are however some exceptions. For oppositions under section 47(6), section 52(1) and section 52(2)(b), for example, there is a prescribed period of four weeks (rules 77(6) and (7)).

1.26 The person filing the counter-statement will be known as the defendant. In the counter-statement, the defendant should state:

- which of the allegations in the statement of grounds he denies



- which of the allegations he is unable to admit or deny, but which he requires the claimant to prove
- which of the allegations he admits

Like the statement, the counter-statement should also contain a statement of truth so that it can be given in evidence (rule 78(1)).

On receipt in the Office, the counter-statement and any accompanying documents will be scanned to the electronic dossier and a message sent to the Litigation Team Mailbox. The B3 should check the mailbox on a daily basis and send any messages to the appropriate B2 Case Officer. On receipt of the message the B2 should amend the document codes as appropriate and filter the counterstatement and its attachments into the folder entitled DEF PLEADINGS.

## **STATEMENTS OF CASE**

- 1.27 Taken together, the statement of grounds and the counter-statement which are described generically as 'statements of case' show the facts in dispute.

## **MANAGEMENT OF PROCEEDINGS**

### Serving the counter-statement and continuing proceedings

- 1.28 The B2 should check that the counter-statement has been filed within the prescribed period, including any extension allowed (see Chapter 2 and Chapter 16) and that it complies with the required formalities. If all is in order, a letter should be issued to the claimant enclosing a copy of the counter-statement. The letter should advise the claimant that if he wishes to continue the proceedings, he must file Patents Form 4 and pay the appropriate fee within a specified period (see annex 5a). A letter should also be issued to the defendant acknowledging receipt of

the counter-statement and enclosing a copy of the letter sent to the claimant.

Note: If the proceedings are uncontested, Patents Form 4 and the additional fee are not required.

**PDAX:-** Letters created in Word and imported using manual import (doc code is F4 REQUEST)

#### Patents Form 4 and fee not filed

If Patents Form 4 and the fee are not filed within the specified time limit, the claimant will be considered to have withdrawn from the proceedings. A letter should be issued to the claimant (copied to the defendant) advising that the Office proposes to deem the proceedings as withdrawn and giving a period of two weeks for a response (see annex 5(b)).

**PDAX:-** Letter is created in Word and imported using manual import (doc code is LETTER-IP)

If no response is received, a further letter should be issued to the claimant confirming that the proceedings are to be treated as withdrawn with no matters outstanding. This letter should be copied to the defendant who should be invited to submit comments on the matter (see annex 5(c)).

**PDAX:-** Letters created in Word and imported using manual import (doc code is LETTER-IP)

If the claimant confirms in writing that he will not be filing Patents Form 4 or will not be continuing with the proceedings, follow procedures at 16.69.

If Patents Form 4 is filed late, the claimant will need to apply for an extension of time (see Chapter 16).

### Patents Form 4 and fee filed

The B2 should action as follows:

- make a register entry to record the fact that Patents Form 4 has been filed and the proceedings are to continue (see Chapter 25).
- inform the defendant that Patents Form 4 and fee have been filed.
- inform both parties that the proceedings will now be reviewed and we will consider the best way of proceeding with the case (see annexes 6(a) and (6b)).

**PDAX:-** Letters created in Word and imported using manual import (doc code is LETTER-IP)

### Reviewing proceedings

1.29 The case should then be referred to the allocated HO for review along with recommendations as to how the proceedings may subsequently be progressed. In making recommendations, the B2 should consider the following:

- Mediation: whether the issues and circumstances of the proceedings indicate that the matter could be suitable for settlement by alternative dispute resolution, such as mediation. In general, most cases will be suitable for mediation. [Note: in some instances, it may have been appropriate to mention mediation when serving the statement (see paragraph 1.20)]

- Case Management Conference: whether the issues need further clarification and whether a Case Management Conference could be helpful

The B2 should also seek advice on:

- whether a Preliminary Evaluation is to be issued at this stage in the proceedings and
- how the HO wishes the evidence rounds to be conducted

**PDAX:- If appropriate, minute the file to the HO.**

Create and send message to HO. Message = PSM

### Case Management Conference

1.30 A CMC may be held at any time during the proceedings. If a CMC is to be held, the parties should be informed (see annex 7 for suitable paragraphs). The proceedings should be referred to the hearings clerk who will then make the appropriate arrangements. The parties may be invited to attend a CMC at the Office or alternatively the CMC may be conducted by video or telephone. The parties' legal representatives will normally be expected to attend but it is not necessary for the parties themselves to attend unless they wish to do so.

If the parties disagree that a CMC is necessary, the proceedings should be referred to the HO.

**PDAX:- Place a minute on the file requesting a CMC.**

Create and send message to hearings team. Message = "Arrange CMC".

Letter is created in Word and imported using manual import (doc code is LETTER-IP)

## Preliminary Evaluation

1.31 A Preliminary Evaluation may be issued, for example, either (i) at this early stage in the proceedings or (ii) after the evidence rounds have been completed or (iii) both. A Preliminary Evaluation may set out the Office's views of the issues in dispute or it may highlight questions both sides need to address.

## Issuing early Preliminary Evaluation

1.32 If a Preliminary Evaluation is to be issued at this early stage in the proceedings, the B2 should write to the parties and advise accordingly. If appropriate, the letter should also encourage mediation (see annex 8).

**PDAX:-** Letter is created in Word and imported using manual import (doc code is LETTER-IP)

1.33 On receipt of the Preliminary Evaluation from the HO, the B2 should add the Preliminary Evaluation to the PDAX file and filter into the Determinations Folder and write to the parties as follows:

- enclose the Preliminary Evaluation
- inform the parties how evidence rounds are to be conducted (see Chapter 3)
- invite the parties to file evidence and set out timetable
- advise the parties that where they both appoint expert witnesses to file evidence, the witnesses may need to file a joint statement of agreed and disputed matters if the HO considers this is likely to save time
- Liaise with the Hearings Clerk to establish a week in which the hearing will be held. The Hearings Clerk will check the Hearing Officer's calendar to ensure their availability for that week. The

week should be no later than eight months from the date Patents Form 4 has been received in the Office. The aim is to conclude proceedings within 10 months of the date Patents Form 4 has been received. The week should be communicated to both parties in the timetable letter giving them a period of two weeks to respond if the date is inconvenient for them (see annex 9).

A period of two weeks should be allowed for a response (see annex 9).

**PDAX:-** Letter is created in Word and imported using manual import (doc code is TIMETABLE)

Preliminary Evaluation imported (doc code is PRELIM EVAL)

- 1.34 The period for the parties to consider the Preliminary Evaluation runs concurrently with the filing of the first round of evidence.

#### Preliminary Evaluation not issued

- 1.35 If the HO advises that a Preliminary Evaluation is not to be issued at this time, the B2 should write to the parties (see annex 10) as follows:

- encourage mediation
- advise parties Preliminary Evaluation is not to be issued at this time
- inform the parties how evidence rounds are to be conducted (see Chapter 3)
- invite the parties to file evidence and set out timetable
- advise the parties that where they appoint expert witnesses to file evidence, the witnesses may need to file joint statement of agreed and disputed matters if the HO considers this is likely to save time
- Liaise with the Hearings Clerk to establish a week in which the hearing will be held. The Hearings Clerk will check the Hearing

Officer's calendar to ensure their availability. The week should be no later than eight months from the date Patents Form 4 has been received in the Office. The aim is to conclude proceedings within 10 months of the date Patents Form 4 has been received. This week should be communicated to both parties in the timetable letter giving them a period of two weeks to respond if the date is inconvenient for them (see annex 9).

**PDAX:-** Letter is created in Word and imported using manual import (doc code is TIMETABLE)

#### Actioning response from the parties

**1.36 If one of the parties are unable to make the proposed week the case officer should liaise with the parties, the HO, and the Hearings Clerk to find an alternative. The new hearing date should be communicated to all parties.**

1.37 If the HO is not available on the alternative hearing week, consideration may be given to transferring the case to another HO so that the parties' agreed hearing date can be accommodated. In such a case, the B3 should be asked to allocate another HO and should update the Hearings SharePoint list.

If neither side responds on the suitability of the hearing week then the case officer will assume that both sides are happy with the proposed date and should set a diary to await the first round of evidence.

#### Mediation

If both parties have agreed to mediate, a letter should be issued asking them to confirm whether the proceedings are to continue OR whether they have been suspended pending the outcome of the mediation.

All documents relating to the mediation should be placed in the MEDIATION folder.

**PDAX:-** B2 to create a letter in Word and imported using manual import (doc code is LETTER-IP)

- 1.38 Once all actions have been completed, the proceedings may be diaried to await the outcome of the mediation (if appropriate) or the filing of evidence.

#### Failure to file a counter-statement

- 1.39 Failure to file a counter-statement (except where the claimant has withdrawn unconditionally) will lead to the proceedings being treated as unopposed. Any interested party will forfeit the right to take any further part in them (see Chapter 16). This should be confirmed by letter (see annex 12). A reference under section 37 of the Patents Act 1977, for example, will be considered by the HO as if each specific fact set out in the statement were conceded, except in so far as it is contradicted by other documents available to the comptroller.

- 1.40 If, on this basis, such a reference is successful, then a decision will be issued accordingly.

**PDAX:- Create a minute to the HO.**

Create a minute and message the HO to advise that counter statement has not been filed. Message = "PSM"

The HO will send a decision and abstract to the hearings team by email with a message that the decision should be issued.

**PDAX:-** HO will create a minute to the B2 case officer.

Decision is imported using manual import (doc code is DECISION-IP) and filtered into the DETERMINATIONS folder



However, if it is the preliminary opinion of the Office that the grounds have not been made out, then the claimant should be informed by the B2 of this preliminary view and offered a hearing before the reference is dismissed by a decision of the HO.

**PDAX:- Create a minute to the HO.**

Create and send message to HO. Message = PSM

Letter created in Word and imported using manual import (doc code is LETTER-IP)

## **EVIDENCE ROUNDS**

1.41 The evidence rounds may be conducted sequentially or simultaneously. The HO will advise. Either way, both parties will need to send a copy of the evidence to the other side and to the Office.

### Evidence filed sequentially

1.42 The usual procedure involves three rounds of evidence, each of six weeks. The first and third rounds of evidence will be filed by the person who did NOT file a counter-statement (but see also Chapter 3). The second round of evidence is usually filed by the defendant.

- claimant to file main evidence
- defendant to file main evidence and file evidence in response to the claimant's evidence
- claimant to file evidence strictly in reply to the defendant's evidence

### Evidence filed simultaneously

1.43 Evidence may also be filed simultaneously. In this case, the procedure will involve two rounds of evidence, each of six weeks

- both sides to file main evidence
- both sides to file evidence in reply

#### Format of evidence (see Chapter 3)

1.44 Evidence should preferably be in the form of a witness statement though affidavits or statutory declarations are acceptable. If the comptroller thinks fit, evidence may be given orally at the hearing. Every document or article submitted by either party in support of his case must be made as an exhibit to an affidavit or witness statement if it is to have the force of evidence. This does not apply to documents submitted with a statutory declaration. No further evidence may be filed by either party except by leave or direction of the comptroller.

#### Expert witness evidence

1.45 Where both parties appoint expert witnesses to give evidence concerning the technical matters at issue in the proceedings, the expert witnesses may be required to produce between them a statement of agreed and disputed matters if the HO considers this will save time overall.

#### Action on receipt of evidence

1.46 On receipt of evidence from both sides, the B2 should:

- check evidence has been scanned correctly to the electronic dossier and annotate accordingly. Each witness statement received, for example, should have been indexed separately and should be annotated to show who has filed it. Each exhibit should also have been scanned and indexed separately and should be annotated accordingly (see 1.49 for physical exhibits)

- The B2 should filter the evidence into the correct folder within the Inter Partes procedure and change the document code if necessary
- refer evidence to the HO (send message)
- check following the second round of evidence, if filed sequentially or the final round if filed simultaneously, whether a Preliminary Evaluation is to be issued prior to the hearing (see 1.31)
- check following receipt of final evidence whether it is necessary to request a joint statement from expert witnesses (see 1.45)
- issue letter to the parties (see annex 13) which will: -
  - acknowledge receipt of evidence
  - remind parties to copy to other side if not clear this has been actioned
  - confirm the date for the next evidence round
  - advise parties where appropriate that a Preliminary Evaluation will be issued prior to the hearing
  - request parties file a joint statement from their expert witnesses. Set deadline of 1-2 weeks prior to hearing
  - send message to hearings clerk following second round of evidence if filed sequentially or the first round if filed simultaneously in order for arrangements for the hearing to be confirmed.

**PDAX:-** The B3 should send a message to the B2.

Message = "New Docs"

Letter created in Word and imported using manual import (doc code is LETTER-IP)

Physical exhibits should be taken to the manager of Indexing and Scanning to be recorded on PDAX (see 1.49 below).

If the physical exhibit is an audio or visual cd/dvd then check with the Head of Index & Scanning whether it can be stored as an electronic file within the dossier.

#### Issuing later Preliminary Evaluation

1.47 If a later Preliminary Evaluation is to be issued following completion of the evidence rounds, on receipt from the HO, the B2 should add the Preliminary Evaluation to the PDAX file and send this to the parties. The letter may also request, if appropriate, that the parties file a joint statement from the expert witnesses (see annexes 9 and 13).

**PDAX:-** Letter is created in Word and imported using manual import (doc code is LETTER-IP)  
Preliminary Evaluation imported (doc code is PRELIM EVAL)

#### Receipt of joint statement from expert witnesses

1.48 On receipt of the agreed statement, the B2 should:-

- check status of document on dossier
- refer statement to the HO (send message)
- acknowledge receipt

**PDAX:-** The B3 should send a message to the B2.  
Message = “New Docs”

#### Physical exhibits for PDAX cases

1.49 Where a physical exhibit is filed in evidence, the B2 should take this to the Head of Index and Scanning. A Non Scan code will be imported by Indexing and Scanning with an appropriate annotation. The physical exhibit should be retained by the B2. The claimant may also provide an exhibit for the proprietor. However, if the case is served on any other

interested parties, they should be notified of the existence of the exhibit and advised that it may be viewed at the Office. Alternatively they may contact the claimant to arrange a suitable time and place to view the exhibit. If an exhibit is referred to but not provided by the claimant, the claimant may be requested to make arrangements for the proprietor, any interested parties and the Hearing Officer to view the exhibit. Once proceedings are concluded however, the exhibit should be sent to the Head of Index and Scanning so that records can be updated and the exhibit stored appropriately.

### Non-filing of evidence (see Chapter 16)

#### Sequential

- 1.50 Where evidence is to be filed sequentially, if the claimant informs the Office that he does not wish to file evidence, the B2 should direct that the period allowed for the defendant to file evidence should begin immediately.
- 1.51 If the defendant informs the Office that he does not intend to file evidence, the B2 should inform the claimant that as there is no evidence to reply to, the third round of evidence will not take place.

#### Simultaneous

- 1.52 Where evidence is to be filed simultaneously, if the claimant informs the Office that he does not wish to file evidence, the B2 should inform the defendant. If the defendant files his main evidence, the claimant should be invited to file evidence strictly in reply.
- 1.53 If the claimant files main evidence but the defendant informs the Office that he does not wish to do so, the B2 should inform the claimant and should invite the defendant to file evidence strictly in reply.

## DECISION

- 1.54 Following the substantive hearing, a decision is issued. Occasionally a decision on the papers may be issued. The decision will be circulated to HOs and Litigation Section for information. The hearings clerk will manually import the decision into the dossier and if OPI will arrange for an unsigned version of the decision to be published on the Office's website and added to Ipsum as appropriate (see Chapter 5). The Hearings Clerk will also filter the decision so it appears in the SUB HEARING folder.
- 1.55 He will send a copy of the decision to the B3 with a Clear Records Pro-Forma along with a paper copy of the decision. On receipt, the B3 should update the register, if appropriate, with the result of the decision and return the form to the Hearings Clerk. The pro forma advises the Clerk of any subsequent action that should be taken

### Clear records action

- 1.56 On receipt of the decision and pro forma from the B3 and once the appeal period has expired, the B2 should arrange for clear records action to be carried out as follows:
- arrange Journal entries and if appropriate, make arrangements to update the A &/or B specification front pages. A message should be sent to Publishing after the appeal period has passed.
  - where decision has been issued, add 'Precedent' label to front cover of dossier
  - Update the Inter Partes SharePoint List with the outcome of the decision
  - record all 'clear record' actions have been carried out on the minute sheet

- send a PDAX message to Formalities if the proceedings relate to a GB patent application to inform them of the result of the proceedings

**PDAX:-** Advert for Journal is created in Word and imported using manual import (doc code is ADVERT-IP)

## **EXCHANGE OF INFORMATION - PATENTS COUNTY COURT (PCC)**

1.57 Where parties have filed proceedings at the Office and have informed us that they have also filed proceedings in the PCC, the PCC should be informed of the following:

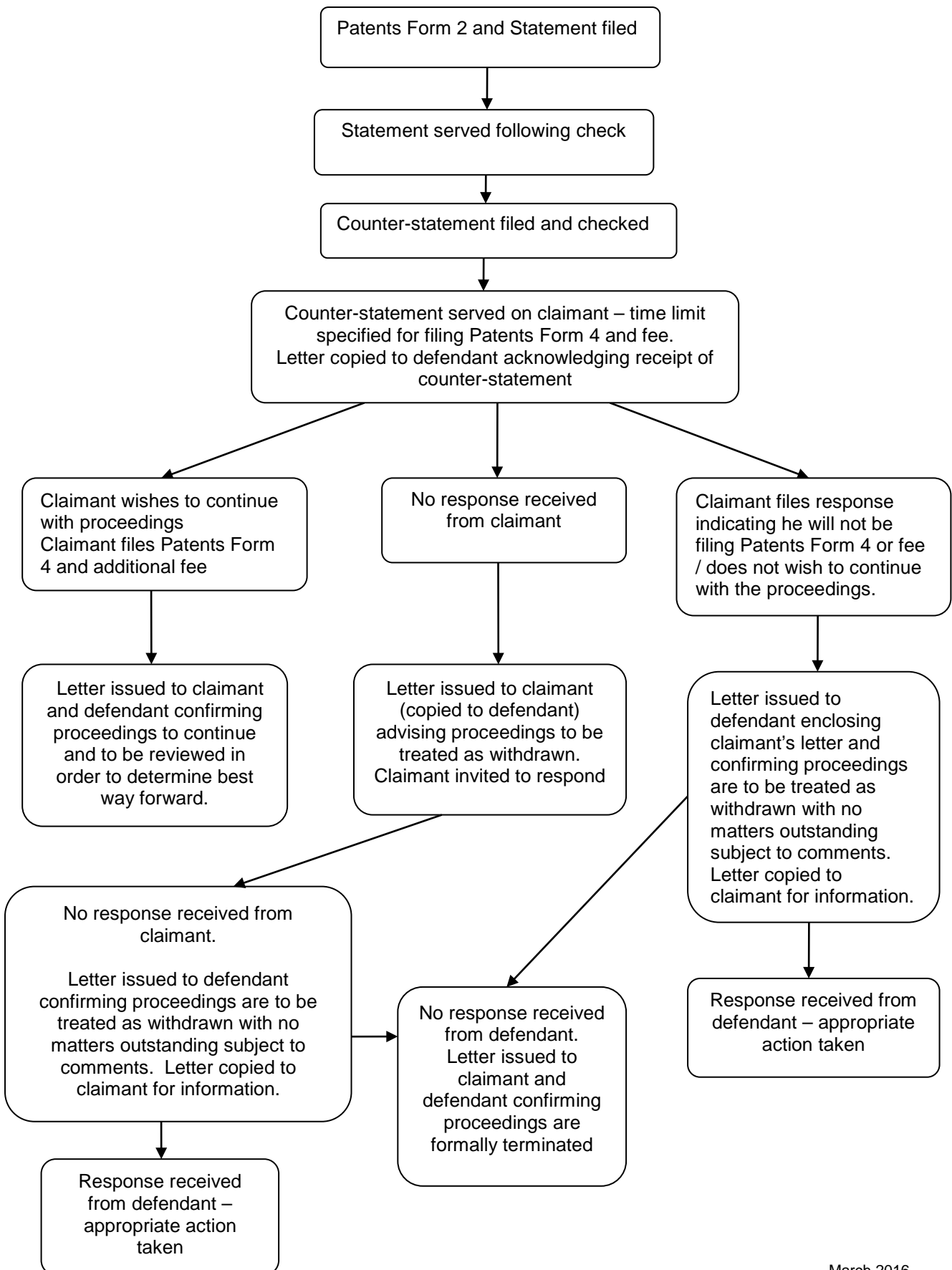
- the nature of the proceedings before the comptroller
- the parties involved and their addresses
- the patent number(s)
- the date the proceedings were filed
- the Patents County Court reference number(s) if provided

The B2 should inform the Hearings Team of the above. The hearings clerk has the relevant PCC contact details and should then pass the information to the Clerk of the PCC.

1.58 Where proceedings have been filed in the PCC relating to a patent, the Clerk of the PCC will inform us.

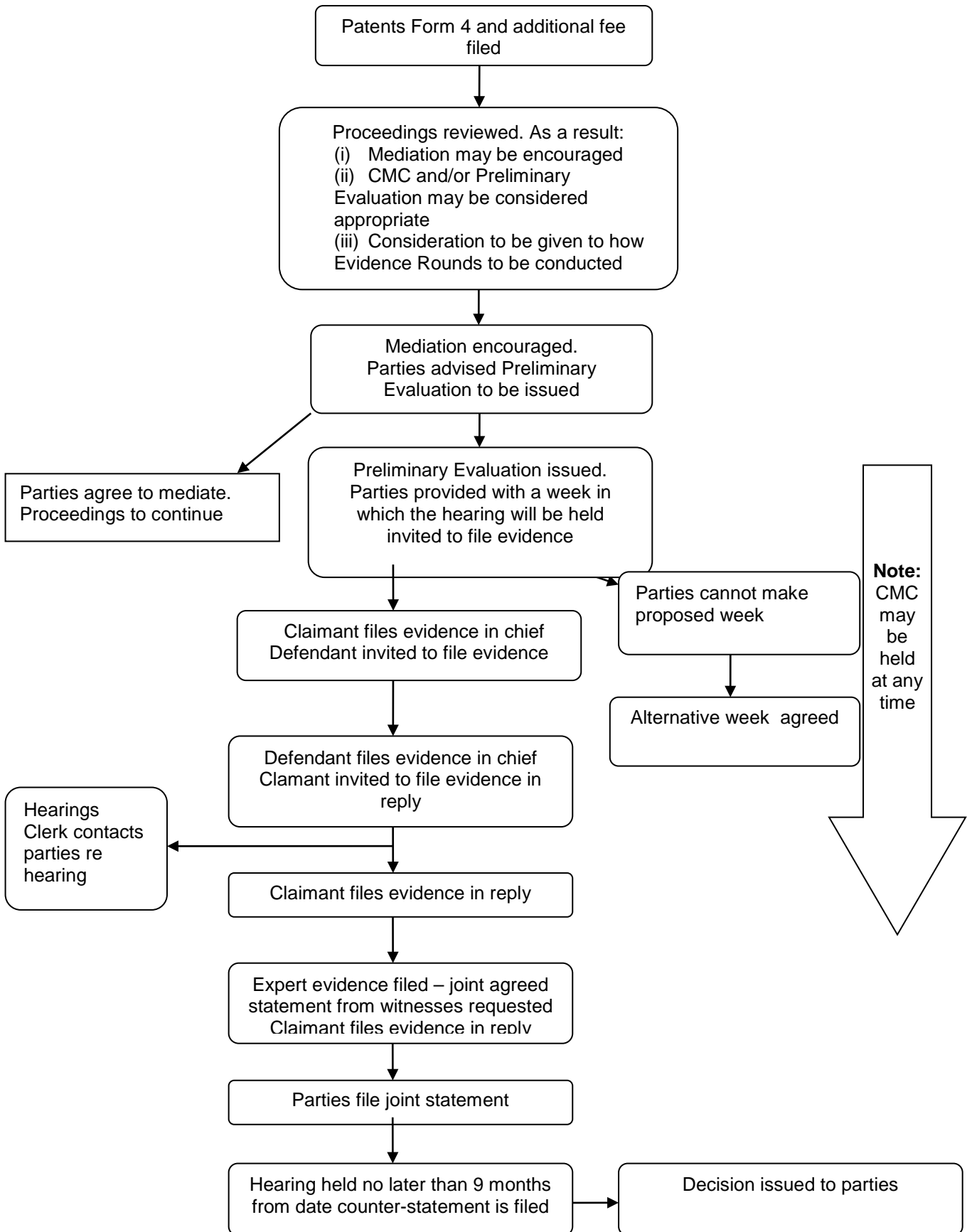
## Annex 1

### Procedure from filing of Patents Form 2 to filing of Patents Form 4





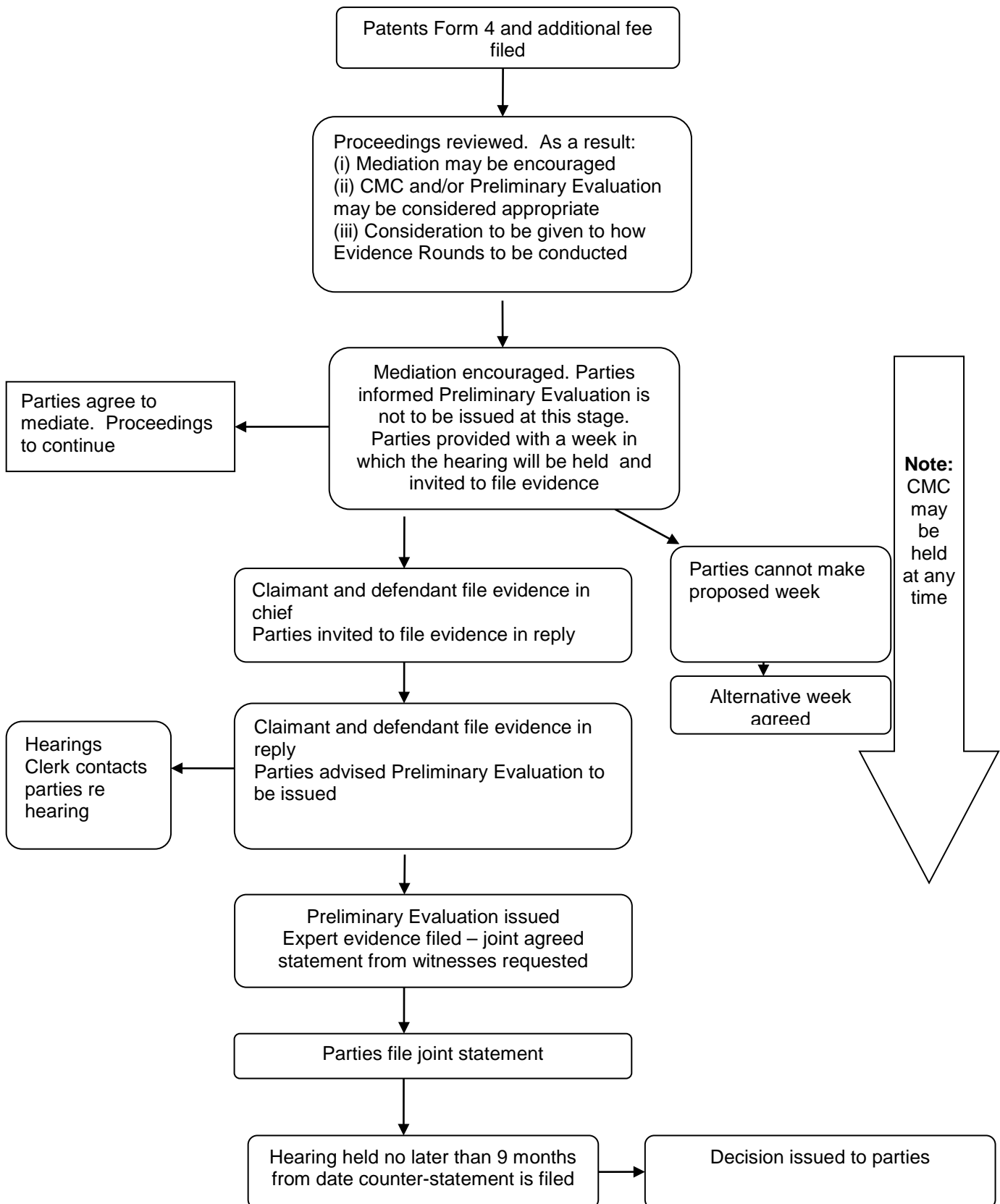
**Annex 2a**  
**Preliminary Evaluation issued after Patents Form 4 filed**  
 (Note: evidence filed sequentially)



**Note:**  
CMC may be held at any time

## Annex 2b

### Preliminary Evaluation issued after evidence rounds completed (Note: evidence filed simultaneously)



### Annex 3

## REQUEST FOR INDEX AND SCAN 1G05

Please provide all of the following information:

|            |                            |
|------------|----------------------------|
| From:      | Insert your name           |
| Section:   | Litigation                 |
| Extension: | Insert your contact number |

|                            |  |
|----------------------------|--|
| Dossier (inc check digit): |  |
| Doc Code:                  |  |
| Doc Date:                  |  |
| Number of Pages:           |  |
| Is this a fax copy?        |  |

Send message (if any) to:

|                |  |
|----------------|--|
| Team:          | Insert 'Inter Partes'                  |
| User (if any): | Insert name of Case Officer (if known) |
| Message text:  | Example: New F2                        |

Does this need to be processed urgently?

YES

NO

Other instructions:

Include any instructions to annotate

## Annex 4(a)

**Your Reference:**

**Our Reference: 1R31/name/number ref**

**Date**

Dear Sirs

**Latest date for filing counter-statement: ..... (insert date)**

**Title**

1. Please find enclosed the following:

[insert list of documents enclosed]

These documents have been filed at the UK Intellectual Property Office in connection with the above proceedings.

[insert paragraph below as appropriate in relation to interested parties]

2. The documents have been sent to you as you are considered likely to have an interest in these proceedings - see rule 77(2) of the Patents Rules 2007. The Patents Rules are available on our website at <https://www.gov.uk/government/publications/the-patents-rules-2007-and-patents-fees-rules-2007>

### **Counter-statement**

3. Should you wish to do so, you may oppose the proceedings by filing a counter-statement (rule 77(5)). The counter-statement should be filed in accordance with the requirements of rule 78. You should file two copies of your counter-statement within **six weeks** of the date of this letter. Your counter-statement should be filed by .....

4. If you do not file a counter-statement, we will take it that you support the claimant's case (see rule 77(9)). However we will not treat you as a party to these proceedings and will not send you copies of any other documents filed in connection with this matter.

## **Professional Representation**

5. Proceedings can be complex and involve intricate aspects of the law. If you decide to oppose these proceedings we strongly recommend you seek professional representation. Below is a link to the Chartered Institute of Patent Attorneys (CIPA) where you can obtain details of patent attorneys practicing in your area:

<http://www.cipa.org.uk>

CIPA may also be able to advise you on obtaining pro bono (free) representation for the purposes of these proceedings.

## **Additional information**

6. Further information relating to proceedings before the comptroller may be found in the enclosed booklet entitled 'Patents: deciding disputes'. Alternatively, please contact me (Telephone: +44 (0)1633 81xxxx).

7. A copy of this letter has been sent today to the claimant for information.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 4(b)

**Your Reference:**

**Our Reference: 1R31/name/number ref**

**Date**

Dear Sir

**Title**

1. Please find enclosed a copy of a letter sent today to .....(insert as appropriate) in connection with the above proceedings.

2. You should note that if a counter-statement is filed in these proceedings, we will:

- send you a copy of the counter-statement
- allow you a period of two weeks to file Patents Form 4 with the appropriate fee in order to continue the proceedings

3. If you do not file Patents Form 4 with the fee, you will be deemed to have withdrawn these proceedings (rule 81A of the Patents Rules 2007)

4. Proceedings can be complex and involve intricate aspects of the law. If you decide to oppose these proceedings we strongly recommend you seek professional representation. Below is a link to the Chartered Institute of Patent Attorneys (CIPA) where you can obtain details of patent attorneys practicing in your area:

<http://www.cipa.org.uk>

CIPA may also be able to advise you on obtaining pro bono (free) representation for the purposes of these proceedings.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 5(a)

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

**Latest date for filing Patents Form 4 and fee: ..... (insert date)**

***Title in bold***

1. Please find enclosed, in accordance with rule 80(1)(a) of the Patents Rules 2007, a copy of the defendant's counter-statement.

2. In accordance with rule 80, as amended, if you wish to continue the proceedings, you need to file Patents Form 4 (copy enclosed) and pay the appropriate fee [.....] (insert fee) within two weeks of the date of this letter.

3. Patents Form 4 and the fee should be filed by ..... (insert date).

4. If Patents Form 4 and the fee are not received by this date, you will be deemed to have withdrawn the proceedings (rule 81A of the Patents Rules 2007).

5. A copy of this letter has been sent today to the defendant.

Yours faithfully

Name

Litigation Section

Patents Directorate

**Annex 5(b)**  
**(Letter to claimant)**

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

**Latest date for response: ..... (insert date)**

***Title in bold***

1. I refer to the official letter dated .....(insert date) which advised that if you did not file Patents Form 4 and pay the appropriate fee, the above proceedings would be deemed withdrawn.

2. Since you have not filed Patents Form 4 and the fee, the Office proposes to treat the proceedings as withdrawn subject to any comments you wish to make,

3. Your comments should be filed within two weeks of the date of this letter, that is, by ..... (insert date).

4. A copy of this letter has been sent today to the defendant.

Yours faithfully

Name  
Litigation Section  
Patents Directorate



**Annex 5(c)**  
**(Example of letter to defendant)**

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

**Latest date for response: ..... (insert date)**

***Title in bold***

1. Please find enclosed, a copy of a letter sent today to the claimant in connection with the above proceedings.
2. The proceedings are considered to have been withdrawn by the claimant.
3. The Office will formally terminate the proceedings with no matters outstanding subject to any comments you may wish to make within two weeks of the date of this letter. Your comments should be filed by .....(insert date).
4. A copy of this letter has been sent today to the claimant.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

**Annex 6(a)**  
**(Letter to claimant)**

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

1. I confirm receipt of Patents Form 4 and the fee to continue the above proceedings.
2. The proceedings will now be reviewed and the Office will consider the best way of proceeding with the case. I will contact you again about this matter as soon as possible.
3. A letter in similar terms has been sent today to the defendant.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

**Annex 6(b)**  
**(Letter to defendant)**

**Your Reference:**  
**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

1. Please find enclosed a copy of a letter sent today to the claimant.
2. The proceedings will now be reviewed and the Office will consider the best way of proceeding with the case. I will contact you again about this matter as soon as possible.
3. A copy of this letter has been sent today to the claimant.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 7

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

### **Case Management Conference**

1. The hearing officer has considered the parties' statements of case and considers it necessary to convene a Case Management Conference under rule 82(1)(i) of the Patent Rules 2007.

**[Confirm with HO the text to be included at paragraph 2]**

2. The case management conference is being arranged to.....  
***[Hearing Officer to supply Information]***

3. If there are other issues that you want to raise at this stage, you should notify me and the other side as soon as possible.

**[Insert appropriate paragraph]**

4. It would be helpful if you would supply ..... by..... for the Case Management Conference. ***[HO to supply this information]***

**[or]**

4. You do not need to supply any documents specifically for the Case Management Conference.

5. The Case Management Conference may be conducted in person, or by video or telephone conference.

6. The hearings clerk in Litigation Section will contact you as soon as possible in order to arrange a date for the Case Management Conference.

7. A letter in identical terms has been sent to the other side.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 8

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

### **Mediation**

1. With regard to the above proceedings, the hearing officer has reviewed the statement and counterstatement and has formed the view that this is a dispute where mediation may result in a quicker and less costly resolution than will be possible through litigation. You are strongly advised to consider the use of mediation in this dispute.

2. If you are unfamiliar with mediation, there is further information in the leaflet enclosed, and on our website at the following address:

<https://www.gov.uk/intellectual-property-mediation>

In addition, if you wish, I can arrange for you to speak to one of the Intellectual Property Office's trained mediators.

3. If you are not prepared to try mediation, you should be aware that the hearing officer may ask you to explain your reasons (without prejudice to matters of privilege).

4. If you and the other side agree to try mediation, you should note that the proceedings will continue. If you and the other side would like us to suspend the proceedings until the outcome of the mediation is known, you will need to put the request in writing and send it to us.

### **Preliminary Evaluation**

Either:

5. A Preliminary Evaluation is to be issued in due course. The Preliminary Evaluation will be sent to you and the other side. For further information about Preliminary Evaluations, please see Tribunal Practice Notice TNP 3/2009 published on our web site at:

[https://www.gov.uk/government/news/archived-versions-of-tribunal-practice-  
notices](https://www.gov.uk/government/news/archived-versions-of-tribunal-practice-<br/>notices)

6. A letter in identical terms has been sent today to the other side. (Edit as appropriate)

Yours faithfully

Name  
Litigation Section  
Patents Directorate

Or:

5. A Preliminary Evaluation is to be issued in due course. The Preliminary Evaluation will be sent to you and the other side.

6. The main aim of a Preliminary Evaluation is to help you and the other side focus on the issues in dispute. It may also assist in the efficient conduct of the proceedings. The Preliminary Evaluation may set out our preliminary views of the issues in dispute or it may highlight questions that you and the other side need to address. It is not however an official decision. This means that you and the other side will not be able to appeal it.

7. You should note that when awarding costs in these proceedings, we will consider whether you and the other side have acted unreasonably in the light of the Preliminary Evaluation.

8. For further information about Preliminary Evaluations, please see the enclosed booklet entitled **Patents: Deciding Disputes** and Tribunal Practice Notice TPN 3/2009 published on our web site at:

[https://www.gov.uk/government/news/archived-versions-of-tribunal-practice-  
notices](https://www.gov.uk/government/news/archived-versions-of-tribunal-practice-<br/>notices)

9. A copy of this letter has been sent today to the other side. (Edit as appropriate).

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 9

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

**Latest date to supply hearing date: .....**

**Claimant to file evidence by: .....**

1. Further to my letter dated ....., please find enclosed for your attention a copy of a Preliminary Evaluation.

[Edit letter to highlight any aspects of the Preliminary Evaluation as appropriate]

### **Evidence**

[Explain how evidence rounds are to be conducted – in this example, evidence rounds follow sequentially]

2. The claimant may now file evidence in support of his case. Evidence should be filed within six weeks of the date of this letter and should be copied to the defendant. The evidence should be filed by .....

3. The defendant will then have six weeks to file evidence in support of his case and in response to the claimant's case. The defendant should send a copy of his evidence to the claimant.

4. Finally the claimant will have six weeks to file evidence strictly in reply to the defendant's evidence. The claimant should send a copy of his evidence to the defendant.



## **Expert witnesses**

5. You are asked to note that where both sides appoint expert witnesses to file evidence, the witnesses may need to file a joint statement of agreed and disputed matters.

## **Hearing Date**

6. The hearing in these proceedings has been scheduled for the week commencing (DATE). You should ensure that all your attendees, including counsel, are available for the whole of the week. We will write to you again at an appropriate time during the evidence rounds to confirm the actual days and make the necessary arrangements for the hearing.

7. The scheduled week provides sufficient time to complete the evidence rounds, for the parties to consider any preliminary evaluation issued after the evidence rounds have been completed and for expert witnesses to provide a joint statement of agreed and disputed matters if required.

8. If this particular week is inconvenient for you then please inform us within two weeks of this letter (DATE) so we may make alternative arrangements.

9. If you are unable to agree a date for the hearing, the Office will set a date within the period mentioned above.

10. A period of two weeks from the date of this letter is allowed for you to inform us of the agreed date. Your response should be filed by .....

11. A letter in identical terms has been sent today to the other side.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 10

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

**Latest date for response:**

**Date for filing of evidence:**

### **Mediation**

1. With regard to the above proceedings, the hearing officer has reviewed the statement and counter-statement and has formed the view that this is a dispute where mediation may result in a quicker and less costly resolution than will be possible through litigation. You are strongly advised to consider the use of mediation in this dispute.

2. If you are unfamiliar with mediation, there is further information in the leaflet enclosed, and on our website at the following address:

<https://www.gov.uk/intellectual-property-mediation>

In addition, if you wish, I can arrange for you to speak to one of the IPO's trained mediators.

3. If you are not prepared to try mediation, you should be aware that the hearing officer may ask you to explain your reasons (without prejudice to matters of privilege).

4. If you and the other side agree to try mediation, you should note that the proceedings will continue. If you and the other side would like us to suspend the proceedings until the outcome of the mediation is known, you will need to put the request in writing and send it to us.

## **Preliminary Evaluation**

5. We do not intend to issue a Preliminary Evaluation relating to these proceedings at this time. However, we may do so, for example, following completion of the evidence rounds.

## **Evidence**

[Explain how evidence rounds are to be conducted – in this example, evidence is filed simultaneously]

6. Both parties may now file their main evidence in support of their case. evidence should be filed within six weeks of the date of this letter and should be copied to the other side. Both sides should file their main evidence by .....

7. On receipt of the main evidence, both sides will then have the opportunity to file evidence in reply. Both sides will be allowed a period of six weeks for filing evidence in reply and should copy the evidence to the other side.

## **Expert witnesses**

8. You are asked to note that where both sides appoint expert witnesses to file evidence, the witnesses may need to file a joint statement of agreed and disputed matters.

## **Hearing Date**

9. The hearing in these proceedings has been scheduled for the week commencing (DATE). You should ensure that all your attendees, including counsel, are available for the whole of the week. We will write to you again at an appropriate time during the evidence rounds to confirm the actual days and make the necessary arrangements for the hearing.

10. The scheduled week provides sufficient time to complete the evidence rounds, for the parties to consider any preliminary evaluation issued after the evidence rounds have been completed and for expert witnesses to provide a joint statement of agreed and disputed matters if required.

11. If this particular week is inconvenient for you then please inform us within two weeks of this letter (DATE) so we may make alternative arrangements.

12. A letter in identical terms has been sent today to the other side.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 11

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

1. I refer to the claimant's letter dated ..... and the defendants' letter dated .....

### **Mediation**

Either:

2. Although the parties have agreed to mediate, you should note that the proceedings are to continue.

3. **[Insert appropriate paragraph explaining what is to happen next eg parties to await Preliminary Evaluation, claimant to file evidence or both sides to file evidence simultaneously]**

Or:

2. I note that the parties have agreed to mediate and have requested that the proceedings be stayed pending the outcome of the mediation.

3. Both sides should note that the proceedings are now stayed.

4. Both sides are asked to inform the Office on a monthly basis of the progress of the mediation, including the dates of the mediation activities. An outline of the results of those activities should also be provided.

5. A letter in identical terms has been sent today to the other side.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 12

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

1. I refer to the official letter dated ..... and note that you have not filed a counter-statement.
2. In view of this, you are not considered to be a party to these proceedings. Any further documents filed by the claimant in connection with the matter will not be sent to you.
3. A copy of this letter has been sent today to the claimant for information.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## Annex 13

**Your Reference:**

**Our Reference: 1R31/name/number ref**

Date

Dear Sir

***Title in bold***

**Edit as appropriate**

### **Evidence received from claimant [filed sequentially]**

1. The claimant has now filed evidence in connection with the above proceedings and has copied this evidence to you.
2. You may now file evidence in support of your case and in answer to the claimant's evidence. Your evidence should be copied to the claimant and should be filed within six weeks of the date the claimant's evidence was sent to you.
3. Your evidence should be filed by .....

### **Evidence received from defendant [filed sequentially]**

1. The defendant has now filed evidence in connection with the above proceedings and has copied this evidence to you.
2. You may now file evidence **strictly in reply** to the defendant's evidence. Your evidence should be copied to the defendant and should be filed within six weeks of the date the defendant's evidence was sent to you.
3. Your evidence should be filed by .....
4. The hearings clerk will contact you both in due course concerning the hearing to be held on .....



**Exchange of evidence [filed simultaneously]**

1. I acknowledge receipt of the claimant's evidence and the defendant's evidence filed in connection with the above proceedings.
2. Both sides are now invited to file evidence **strictly** in reply. Both sides should exchange their evidence in reply on .....
3. The evidence should also be filed at the Office on .....

**Evidence in reply received [filed simultaneously]**

1. I acknowledge receipt of evidence in reply filed by the claimant and the defendant.
2. The hearings clerk will contact you both in due course concerning the hearing to be held on .....

**Preliminary Evaluation**

1. Both sides should note that a Preliminary Evaluation will be issued following completion of the evidence rounds.

[see also annex 8 and edit as appropriate]

**Expert evidence filed – joint statement requested**

1. Both parties have provided expert evidence in the proceedings. The expert witnesses are required to send us a statement setting out the issues on which they agree and the issues on which they disagree. The statement should also include a summary of the reasons for disagreement. The statement should be filed by .....

**Insert as appropriate**

A letter in identical terms has been sent to the other side.  
A copy of this letter has been sent today to the other side.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## CHAPTER 2

### STATEMENTS OF CASE

|   |             |
|---|-------------|
| Introduction  | 2.01        |
| Statement of Grounds  | 2.02 - 2.11 |
| What should it look like?                                       | 2.02        |
| What should a statement of grounds contain?                     | 2.03 - 2.05 |
| When should the statement be filed?                             | 2.06        |
| Statements in a foreign language                                | 2.07        |
| Copies of documents referred to                                 | 2.08        |
| Error in statements   | 2.09 - 2.11 |
| Counter-statement   | 2.12 - 2.29 |
| Introduction  | 2.12 - 2.13 |
| What should a counter-statement contain?                        | 2.14 - 2.15 |
| When should the counter-statement be filed?                     | 2.16 - 2.17 |
| Copies of documents referred to                                 | 2.18        |
| Can the time period for filing a counter-statement be extended? | 2.19 - 2.22 |
| Serving the counter-statement                                   | 2.23        |
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| Counter-statement in section 72 (revocation) action             | 2.26 - 2.29 |
| Amendment of statement of case                                  | 2.30 – 2.31 |

## STATEMENTS OF CASE

### INTRODUCTION

2.01 To initiate *inter partes* proceedings, the claimant files a form under one or more sections of the relevant act. In patent proceedings, for example, the form should be accompanied by a statement of grounds (see rule 76(1) and paragraph 2.04 below for further details). The defendant must, if he wishes to contest proceedings, respond by filing a counter-statement (rule 77(5)). Taken together the statement of grounds and the counter-statement, which are sometimes described generally as 'statements of case', show the facts that are in dispute. Both the statement and counter-statement should be supplied in duplicate. One copy will be scanned electronically to the electronic case file. The other copy will be sent to Litigation Section to serve.

### STATEMENT OF GROUNDS

#### What should it look like?

2.02 Statements of case come in a wide variety of styles. However they should comply with the requirements of Part 1 of Schedule 2 of the Patent Rules 2007. This requires that they should be filed on A4 matt white paper which should be free from tears, folds or similar damage and its contents must be suitable for reproduction. Frames (lines surrounding matter) should not be used. In accordance with rule 4(4), statements of case should only use one side of each sheet of paper. In practice, a statement of grounds and a counter-statement will be acceptable providing it is legible and clear. Typescript or handwritten are both acceptable although typescript is obviously easier to read.

#### What should a statement of grounds contain?

2.03 The requirements for the statement of grounds in patent *inter partes* proceedings are set out in rule 76(4).

2.04 The statement of grounds needs to include:

- a concise statement of the facts and grounds on which the claimant relies
- where appropriate include the period or terms of the licence which the claimant believes are reasonable
- specify the remedy (relief) which the claimant is seeking
- where it accompanies an application under the Community Compulsory Licensing Regulation, include any information required by that Regulation and needs to be verified by a statement of truth.

2.05 See also Patent Hearings Manual Chapter 2.

#### When should the statement be filed?

2.06 The statement should be filed at the same time as Patents Form 2 or Patents Form 15 except where proceedings have been started under section 46(3) by a person other than the patent proprietor (see Chapter 11). On receipt in the Office, the form and accompanying documents will be scanned to the Office's electronic case management system and an electronic dossier (case file) will be created and a message sent to the Litigation team mailbox. The B3 should check the mailbox on a daily basis and assign any work to his personal Inter Partes mailbox.

#### Statements in a foreign language

2.07 If a statement of grounds is filed in a foreign language, a translation will be required (see rule 82(1)(b)).

#### Copies of Documents referred to

2.08 Copies of any documents such as letters, reports, agreements, terms of

employment etc referred to in the statement should also be supplied in duplicate (see rule 79(1) and (2)). However, if the document referred to has been published by the Office or is kept at the Office, this rule does not apply (see rule 79(3)). If any document or part of a document referred to is in a foreign language, a translation of that document should also be supplied (see rule 82(1)(b)). Some documents may be alluded to rather than referred to e.g. "the patent was assigned to the referrer" or "by virtue of deed of assignment dated 12.02.1998 the patent was assigned to". In such cases, a copy of the assignment should be requested.

### Errors in statements

2.09 Office practice is to scrutinise the statement to ensure that formal requirements have been met. Any defects should be brought to the attention of the party filing the statement. They should be invited to file an amended statement and/or form usually within one month. The papers should be served on the other side (see rule 77) together with a copy of the Office letter inviting amendment, but the party(ies) should not be invited to file a counter-statement in the matter until the formal defects in the statement have been resolved.

**PDAX:-** Letter is created and imported using manual import (doc code is DEFECT-LIT)

2.10 Occasionally the only defect will be that a document referred to has not been supplied. This may be a document that will be in the possession of the other side already. Providing rule 79(3) does not apply, the party filing the statement can be given 14 days in which to supply copies to the Office. In such circumstances the time period for the filing of the counter-statement can begin and run concurrently.

2.11 Common errors include failure to supply copies of documents and translations where appropriate, failure to identify the relevant section or

sections of the Patents Act and seeking relief that is not available. If the relief sought is not *prima facie* available, the party should be informed that it would appear that the relief sought might not be available and they should be given an opportunity to amend the statement of grounds. The content of a statement of grounds is a matter for the claimant who may ask the comptroller to consider other or alternative relief. Statements can often be rambling and disjointed but if the general message is there then they should be served and the counter-statement invited.

## **THE COUNTER-STATEMENT**

### Introduction

- 2.12 A person who wishes to oppose or object to what is sought in a statement of grounds must file a counter-statement setting out fully the grounds of his opposition or objection. As with the statement of grounds, the counter-statement should be supplied in duplicate (see rule 77(6)).
- 2.13 The basic purpose of the counter-statement is to identify those allegations which are in dispute and those which are not. In particular, it must reply in a reasonable manner to each of the grounds in issue in the statement by way of admission, denial or (in the case of revocation) an offer to amend.

### What should a Counter-statement contain?

- 2.14 In the counter-statement, the defendant must state:
- which of the allegations he denies and why (and if an alternative version of events is to be put forward, what that version is)
  - which of the allegations he is unable to admit or deny but which he requires the claimant to prove
  - which of the allegations he admits

and he needs to include a statement of truth (see rule 78(1)).

Costs need not be specifically claimed, though they usually are. See also Patent Hearings Manual Chapter 2.

- 2.15 Where there is any doubt as to the position of a potential defendant e.g. where objections have been raised in a letter rather than a counter-statement, Litigation Section should point out that if no counter-statement is filed, the proceedings will be treated as uncontested. If the potential defendant does wish to oppose or object, then he or she should file a counter-statement and, if necessary, request an extension of the period for doing so.

#### When should the counter-statement be filed?

- 2.16 In proceedings, the statement will be filed when the proceedings are initiated. A copy along with Patents Form 2 will be sent to the relevant parties by the B3/B2 (rule 77(4)). The parties will be invited to file a counter-statement within six weeks of the date of the official letter.
- 2.17 The B2 should check that the counter-statement is filed within the prescribed period including any extension and that the counter-statement meets formalities requirements.

#### Copies of Documents referred to

- 2.18 Where a document, other than a document published by the comptroller or kept at the Office, is referred to in the counter-statement, two copies of the document must be filed (see rule 79)). If the document is in a foreign language it should be accompanied by a translation (see rule 82(1)(b)).

### Can the period for filing a counter-statement be extended?

- 2.19 The period for filing a counter-statement may be extended at the comptroller's discretion (see rule 108).
- 2.20 If there is no dispute relating to the extension of time request, the B2 should consider the reasons for the request and if reasonable, may grant the extension.
- 2.21 Where repeated or extended extensions of time are requested, the B2 should seek the advice of the HO before allowing such an extension.
- 2.22 Where, exceptionally, no agreement can be reached, the HO will need to decide the matter formally either at a preliminary hearing or with the agreement of the parties on the papers.

### Serving the counter-statement

- 2.23 If the counter-statement is in order, a copy should be sent to the claimant with a letter pointing out that if he wishes to continue the proceedings, he must file Patents Form 4 and pay the appropriate fee within a specified period (see annex 5a in Chapter 1). On receipt of the form and fee, both parties should be advised that the proceedings are to be reviewed and we will consider the best way of proceeding with the case (see annexes 6a and 6b in Chapter 1).

**PDAX:-** Letters created and imported using manual import (doc code is LETTER-IP)

### Subsequent procedure

- 2.24 The case should then be referred to the allocated HO along with recommendations as to how the proceedings should subsequently be



managed (see Chapter 1 paragraph 1.29). The B2 may also bring any additional issues concerning the proceedings to the attention of the HO.

**PDAX:- Create a minute to the HO.**

Create and send message to HO. Message = PSM

- 2.25 On receipt of the case from the HO, the B2 should write to the parties as directed (see 1.32 and 1.35). The HO may decide to issue a Preliminary Evaluation (see annex 9 in Chapter 1). If the proceedings appear complex, a letter may be issued directing that a Case Management Conference will be convened as soon as possible to determine how the case should proceed (see annex 7 in Chapter 1). The parties may also be encouraged to consider Mediation (see annex 8 of Chapter 1).

**PDAX:-** Letters created and imported using manual import (doc code is LETTER-IP)

Counter-statement in section 72 Revocation proceedings

- 2.26 In revocation proceedings, if the proprietor wishes to contest the application, he must file, within six weeks of the sending of the copies of the application and statement of grounds, a counter-statement in duplicate setting out fully the grounds upon which the application is contested. **Care should be taken when checking counter-statements in section 72 proceedings to establish if the proprietor is offering to amend the patent claims.**
- 2.27 If the proprietor does offer to amend the claims such amendments are made under section 75 and are subject to rule 35 and the rules set out in Part 7.
- 2.28 It should be made clear within the counter-statement on what basis the offer to amend is made, that is, whether the offer is firm (unconditional) or is conditional upon an adverse finding on the un-amended specification.

- 2.29 For further details and procedures see sections 72 and 75 of the MOPP and Chapter 14 of this Manual.

### **AMENDMENT OF STATEMENT OF CASE**

- 2.30 A statement of case may be amended, at the request of the party concerned, at the comptroller's discretion. The amendment may be in the form of a replacement, an amended statement (or counter-statement) or a supplementary statement (or counter-statement). On receipt of a request, the matter should be referred to the HO for consideration as a number of factors will need to be taken into account.
- 2.31 The HO will advise whether the amendment may be allowed. If it is, it will often be necessary to give the other party (or parties) an opportunity to amend their statement and/or file further evidence to deal with the amendment. The B2 will be requested to issue a letter accordingly.

## CHAPTER 3

# EVIDENCE

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### 3 EVIDENCE

#### INTRODUCTION

- 3.01 In *inter partes* proceedings, the evidence has two functions; to support the statement of case and to answer the other side's allegations and/or evidence. Basically it is information which is acceptable to prove or disprove any matter under enquiry.
- 3.02 The usual procedure involves three rounds of evidence each of six weeks. However evidence may also be exchanged simultaneously by the parties. In this case the procedure will involve two rounds of evidence, each of six weeks (see 1.42 and 1.43).
- 3.03 In section 27 opposition proceedings, both sides have a substantial onus to discharge. As such, and in line with practice in the High Court, where evidence is filed sequentially, the usual procedure has been reversed, that is:
- 3.04 The patentee has been invited to file evidence first, followed by evidence from the opponents in support of their case and in answer to the patentee's case. Finally the patentee has been invited to file evidence strictly in reply to the opponent's evidence.
- 3.05 Deleted
- 3.06 Whatever procedure is agreed, evidence will only be considered to have been filed when it has been received by the comptroller and it has been sent to the other parties to the proceedings (rule 80(3)).
- 3.07 Most evidence in proceedings before the comptroller is written. However occasionally physical exhibits are submitted, for example, a sample of the alleged prior art or a sample of the article in which design right is claimed. Case Officers should ensure that any physical exhibits submitted as

evidence have been sent to the other party or alternatively that suitable arrangements have been made for the inspection of such exhibits.

**PDAX:-** Where a physical exhibit is filed, see Chapter 1, paragraph 1.49

## **FORMAT FOR EVIDENCE**

- 3.08 The evidence before the comptroller may be given in the form of witness statements, statement of case, affidavits, statutory declarations or in any other form which would be admissible as evidence in proceedings before the court . Oral evidence may be accepted if the HO thinks fit. (rule 87(1)).
- 3.09 A witness statement or statement of case may only be given in evidence if it includes a statement of truth (rule 87(2)).
- 3.10 Rule 87(3) states that the general rule for evidence is that it should be by witness statement unless the comptroller directs or any other enactment requires otherwise.
- 3.11 Affidavits, statutory declarations and witness statements need to comply with the requirements of Part 1 of Schedule 2 of the Rules unless the comptroller directs otherwise; so they need to be submitted on A4 white paper that is free from tears, folds or similar damage and the contents must be suitable for reproduction. Frames (lines surrounding matter) should not be used.
- 3.12 They should also include a heading referring to the relevant Act, section of the Act, the patent or patent application number and the parties (eg **Patents Act 1977** IN THE MATTER OF an application by John Green to revoke United Kingdom patent number 2345678 in the name of FGH Limited under Section 72 of the Act).

3.13 Evidence in a foreign language may be filed. It should be annexed with a translation into English made by a qualified translator, with an affidavit made by the translator confirming that the translation is true. The three documents and any exhibits must be filed together.

### Affidavit

3.14 An affidavit is a document that has been formally sworn or affirmed before someone authorised to administer oaths. It should commence with the words "I...(full name) of (address)... state on oath...." This is in accordance with the Civil Procedure Rules, Part 32 Practice Direction - Written Evidence.

3.15 Additionally an affidavit should:

- if the person is giving evidence in his professional, business or other occupational capacity, give the address at which he works, the position he holds and the name of his firm or employer
- give evidence in the first person (I, me and so on)
- have each paragraph numbered and as far as possible each paragraph should be confined to a distinct topic
- have each page numbered and where possible, should be bound
- express dates, sums and other numbers in figures not words

3.16 It should end with the jurat. This is a statement set out at the end of the document which authenticates the affidavit. The jurat should read:

"Signed...(signature)". "Sworn at... (address, date)...before me...(signature of the person administering the oath)."

The commissioner of oaths title should complete the affidavit, eg "A solicitor entitled to administer oaths." The jurat should be on the same page as the last page of written evidence and say where and when the affidavit was sworn. The affidavit must be sworn before a person independent of the parties or their representatives.

## Statutory Declaration

3.17 A statutory declaration is a document that a witness signs and declares to be true in front of someone authorised to administer oaths. It should commence with the words "I...(name, address)...do solemnly and sincerely declare that....." in accordance with the Statutory Declarations Act 1835.

3.18 The jurat should consist of the words:

"Signed...(signature)." Declared at...(address), (date)...before me...(signature of the person administering the oath)."

The commissioner of oath's title should complete the statutory declaration eg "A solicitor entitled to administer oaths." The jurat should be on the same page as the last page of written evidence and say where and when the statutory declaration was sworn.

## Witness Statement

3.19 A witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally. It must include a statement by the intended witness that he believes the facts in it are true eg I believe the facts in this witness statement are true. In practice, most evidence filed at the Office is now in the form of witness statements.

3.20 A witness statement should be headed with the title of the proceedings. At the top right hand corner of the first page there should be clearly written:

- the party on whose behalf it is made
- the initials and surname of the witness
- the number of the statement in relation to that witness
- the identifying initials and number of each exhibit referred to
- the date the statement was made

3.21 The statement must, if practicable, be in the intended witness's own words, should be expressed in the first person and should also state:

- the full name of the witness
- his place of residence or, if he is making the statement in his professional, business or other occupational capacity, the address at which he works, the position he holds and the name of his firm or employer
- his occupation
- the fact that he is a party to the proceedings or is the employee of such a party if it be the case

3.22 Additionally, the statement should have each paragraph numbered and, as far as possible, each paragraph should be confined to a distinct portion of the subject. Each page should be numbered and, where possible, bound. All numbers, including dates, should be expressed in figures.

### Defective Evidence

3.23 The burden for ensuring evidence meets the appropriate requirements rests with the parties. Consequently it is not necessary for the B2 to carry out a routine check of any evidence filed.

## **DOCUMENTS REFERRED TO IN EVIDENCE**

3.24 Deleted

### Exhibits:

### Affidavit

3.25 If the evidence is in the form of an affidavit, any documents referred to should be exhibited. The minimal requirement is the signature of the notary



public and the coded designation of that exhibit being entered on the front page of the document. However, usually this information is placed on a fly sheet together with a title. If such documents are not exhibited, the documents should be re-filed as exhibits preferably attached to a second short affidavit under rule 79.

### Statutory Declaration

3.26 If the evidence is in the form of a statutory declaration, the documents referred to need not be exhibited under the Statutory Declaration Act 1835.

### Witness Statement

3.27 If the evidence is in the form of a witness statement, the documents should be exhibited. An exhibit used in conjunction with a witness statement should be verified and identified by the witness and remain separate from the witness statement. Where a witness refers to an exhibit, he should state: "I refer to the (description of exhibit) marked" . The provisions of the Civil Procedure Rules, apply to witness statements as they do to affidavits (see Civil Procedure Rules, Part 32 Practice Direction - Written Evidence).

### **DOCUMENTS PROVIDED BUT NOT REFERRED TO**

3.28 All documents provided should be referred to in the evidence.

### **EVIDENCE AND FAX FILING**

3.29 Where evidence is filed by fax and is of an acceptable quality, there is no need for the parties to file the original documents. However any party filing evidence by fax must make the original documents available on request (see also Chapter 16).

3.30 Any unsworn evidence filed by fax is taken as filed on time. However the party concerned will still need to file a sworn version of the evidence.

## DATE TRIGGERING EVIDENCE ROUNDS

- 3.31 The B2 should set the dates for the evidence rounds and should acknowledge receipt of any evidence filed (see annexes 9, 10 and 13 in Chapter 1). The case officer should ensure that the relevant doc code is assigned to the evidence and that each piece is filtered into the correct folder.

**PDAX:-** Letter is created and import using manual import (doc code is LETTER-IP)

## ARRANGEMENT OF EVIDENCE IN FILE

- 3.32 Case Officers should ensure that any evidence scanned into PDAX is OPI unless it relates to a section 40 application, a patent application that has not yet been published or is the subject of a request for confidential treatment under rule 53. In such cases, the evidence should be marked as NOPI.

**PDAX: -** Any evidence should be annotated to show what it is and who has filed it eg 'Witness statement of XXXXXX'; 'Exhibit XXXX' etc.

- 3.33 Deleted

## CHAPTER 4

### HEARINGS

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## **4 HEARINGS**

### **INTRODUCTION**

#### **What is a hearing?**

- 4.01 When examining a patent application or granted patent, an examiner might object to certain things about it. A patent applicant will always be given a chance to overcome these objections. Before making any decision that might adversely affect the applicant, where there is an element of discretion, the applicant is entitled to ask for “a hearing” (see section 101 of Patents Act 1977).
- 4.02 A hearing gives the applicant the chance to explain his or her case in person to a senior officer known as a “hearing officer”. The hearing officer is independent and will look at all sides of the argument before making the final decision about the case. If the applicant doesn’t agree with the decision, he can file an appeal (see Chapter 6).
- 4.03 Sometimes two or more opposing parties may be in dispute over a patent or patent application. If this happens, we might be able to help settle the dispute, but obviously the parties would need to tell us about it. They may not always agree with what we say. If we can’t overcome these differences, either of those involved may ask us for a hearing. Both sides will be invited to attend the hearing. The hearing officer will listen to both sides of the argument and will give a written decision (see Chapter 5). If one side does not agree with the decision, they can file an appeal (see Chapter 6).

#### **Types of hearings**

- 4.04 There are generally two types of hearings – ex parte and inter partes. There is no fee to pay in relation to either of these. As well as arranging

hearings, the hearings clerks may also be involved in arranging Case Management Conferences (CMCs) and Pre-hearing Reviews.

### **Ex parte hearings**

4.05 An Ex Parte hearing is held between a single party (either private individuals or firms) and the Office. An ex parte hearing may be held prior to the comptroller exercising his discretion adversely (see section 101 of the Patents Act 1977); so, for example:

- where an applicant is in disagreement with an examiner about whether his application meets the requirements of the Act and is patentable, he may request a hearing

OR

- where an applicant is in disagreement with a case officer concerning whether his granted patent should be restored, he may request a hearing

OR

- where an ex parte hearing has been requested near the end of the Rule 30 compliance period, extensions are available to the applicant (see 4.88 – 4.94 for further details). If a Form 52 is received by the section in relation to extending the Rule 30 period a message should be sent to the respective Head of Admin so they can deal with the request.

### **Inter partes hearings**

4.06 Inter Partes hearings are held between two parties who are in dispute over a patent. Inter partes hearings may be:

- Substantive – this is the main hearing held to decide the proceedings

- Preliminary hearings - these may be held to sort out issues that arise within the proceedings. They may be held at the request of either party or at the suggestion of the Office, but require the agreement of the HO. The procedure for preparing a preliminary hearing is similar to that for the substantive hearing. However it is important that the parties are informed in writing of the exact issue to be determined and what documents need to be supplied (see Annex 3, HRGCMC CMC/Pre Hearing Review and Preliminary hearing arrangements letter).

### **Case Management Conference**

4.07 The HO has the authority to call a Case Management Conference (CMC) to help clarify the issues or give directions on the future conduct of a case. A conference may be called at any stage in the proceedings, including straight after the filing of a counter-statement. It will probably be unnecessary for the parties to supply the vast number of documents for the CMC as required by the Civil Procedures Rules (see paragraphs 4.8 and 4.9 of the Practice Direction to Part 63). When arranging a CMC, the hearings clerk should liaise with the B2 Case Officer and HO. They will need to write to the parties using a suitable form of letter template, (Annex 3).

### **Pre hearing Reviews**

4.08 These may be held by the HO so he can give directions regarding the hearing. A review is unlikely to be necessary unless the proceedings are complex. The hearings clerk will need to write to the parties using a suitable form of letter template, (Annex 3).

### ***Is it always necessary to have a hearing?***

#### Ex parte cases

- 4.09 A patent applicant may request that a decision be made by a HO based on the papers he has filed.

#### Inter partes cases

- 4.10 The parties involved in the dispute may request that a HO make a decision on the case based on the papers filed. However both sides involved in the dispute must agree to this – if they don't, then a hearing will probably be required.

### **Where are hearings held? What options are available?**

- 4.11 Hearings are usually held at our Newport Office. They may be held at the London office only with the Hearing Officer's agreement if there are compelling reasons. They may also be held by telephone or video conference link, with the Hearing Officer's agreement. Where the parties consent and the HO is satisfied that the circumstances justify it, in particular that it will result in an overall saving in time and cost, a hearing may be held at locations other than Newport or London. Preliminary hearings are usually held by video conference link though they may also be held at our London Office.

### **Case Management Conferences and Pre-hearing Reviews**

- 4.12 The hearings clerk should consult the HO about how he wishes to run the CMC / Pre-hearing Review before seeking agreement from the parties. These may be conducted by video conference, telephone, or the parties may appear in person before the HO.
- 4.13 When arranging a CMC/ Pre-hearing Review, the hearings clerk needs to check with the party(ies) where they would like this held. Any dispute over venue should be referred to the HO. Remember that the HO must give



approval to any venue except Newport. However, where counsel is involved, London will probably be the preferred venue.

## **ARRANGING AN EX PARTE HEARING (Hearings Clerk) – use Ex Parte Hearings Checklist (Annex 2a)**

- 4.14 Most requests to arrange an ex parte hearing will relate to cases on PDAX. The examiner will send a message to the Hearings Team Mailbox requesting that a hearing be arranged.

### **On Receipt of Request**

The Hearings Clerk will:

- 4.15 Complete as much of the Hearings Arrangement Sheet (Annex 1a) as possible using information from the PDAX dossier, noting the date that the hearing request was made and the date that the request was received in the section.
- 4.16 Select a Hearing Officer from the SharePoint Ex Parte List and try to ensure that hearings are allocated on an equal basis.
- 4.17 On the Ex Parte SharePoint list add “new item” and edit accordingly by entering the case name, patent number, date case received in the section and the allocated hearing officer (HO). Check to see if the applicant has any other hearings outstanding and liaise with the HO’s to see if they can be combined.
- 4.18 On PDAX create a minute on the dossier and use the create message function to send a message to the hearing officer. Delete the request from PDAX and place the paper file in the ‘Hearing Awaiting Date’ folder.

- 4.19 Email the allocated Hearing Officer requesting that their Outlook calendar is up to date. From the SharePoint Hearing Assistant list notify the Hearing Officer of the next available Hearing Assistant (HA). When the HO confirms if he requires an assistant, add the assistant to the case details and move the assistant to the bottom of the HA list noting the number of hearings they have assisted on. If no response is received from the HO, the Hearings Clerk will assume the Outlook calendar is up to date and can be used and that the selected HA can be allocated to the HO.

*Target for above actions is five days from receipt of the message from examiner*

### **Arranging a hearing date**

- 4.20 A hearing should preferably be held within a month of the notification that the applicant requires a hearing.

The Hearings Clerk will:

- 4.21 Prior to telephoning the applicant or their appointed representative, select the first available date or a date 2 weeks from today in Outlook Calendar (PDHearings). Right click and select 'New Appointment', open the 'scheduling assistant' and 'add attendees', enter the names of the hearing team followed by the HO, examiner, any assistants and the SharePoint calendar [pdlitigation@lmoos.ipo.gov.uk](mailto:pdlitigation@lmoos.ipo.gov.uk)

This will allow you to book a time when all required parties are available (the hearing team is selected so that any existing hearings are shown and so that they know of the new hearing through their calendars, they are not expected to attend). Please note that Trademarks block book the room facilities in London. When looking for available rooms where the room is booked as Hearings VC but there is no company name, the room is available.

- 4.22 When ringing the applicant, firstly ensure that they know the options open to them (hearing in person, by telephone conference, by video conference or a decision on papers) and ensure that they are aware that anything other than a face to face hearing in Newport or a decision on papers requires the agreement of the HO. Select a mutually agreeable date and time and note it on the paper file (hearings are held from 10.30 to 13.30 and from 13.30 to 17.00). Inform the applicant that you will be confirming the hearing by post and that one of the team will contact them before the date to check attendees and car details for security if attending on site.
- 4.23 On PROSE select the Ex Parte Hearings template HRG EXP, (Annex 6) and edit as necessary. Import the letter onto the PDAX dossier and annotate. Issue the letter to the applicant.
- 4.24 Enter the details on the paper diary. E-mail accommodation to secure a parking bay, if required, and inform them that you will supply attendee and car details later.
- 4.25 On the Ex-Parte SharePoint list enter the date of the hearing.
- 4.26 The paper file can now be placed in the 'Ex Parte Arranged Hearings' folder and an outlook file can be created for the case.

#### **Additional tasks where a video conference is arranged**

- 4.27 If the applicant requests a video hearing, remind the applicant that you must obtain the HO's approval for the video conference hearing and that you will confirm once the HO has agreed. If the HO agrees to a video conference hearing, there are a few options available. The applicant can use their own facilities and link up with the HO in Newport. If using their own facilities, the applicant must email details of their video conferencing systems so that we can check our systems are compatible. The Hearings Clerk will raise an IT helpdesk call and the applicants video conferencing

details will be added to the drop-down list on the screen in 1R32 (1R32 should always be used where available).

- 4.28 Alternatively, the applicant can opt to use our video conferencing systems in our London office. If this is the case, the V/C rooms in London should be entered into the scheduling assistant to check availability and add rooms using 'add attendees'. Make the appointment in outlook and complete the arrangements as necessary.
- 4.29 If the HO prefers not to conduct the hearing by video conference, liaise with the party to arrange a suitable date that they can attend a face to face hearing or other alternatives given by the HO. If the party insists on a video hearing seek instruction on how to proceed from the HO.

#### **Additional tasks where a telephone hearing is arranged**

- 4.30 If the applicant requests a telephone hearing remind the applicant that you must obtain the HO's approval for the telephone hearing and that you will confirm once the hearing officer has agreed.
- 4.31 Contact the HO to get confirmation that they are content with the telephone hearing. If so let the party know and complete the arrangements as above.
- 4.32 If the HO prefers not to conduct the hearing by telephone conference, liaise with the party to arrange a suitable date that they can attend a face to face hearing or other alternatives given by the HO. If the party insists on a telephone hearing seek instruction on how to proceed from the HO.

#### **Additional tasks where a hearing is to be held in London**

- 4.33 If the applicant wishes to attend a face to face hearing in London, the applicant must provide compelling reasons for the HO to consider why a face to face hearing in London is necessary. If the HO agrees to a face to

face hearing in London, use scheduling assistant to enter London meeting rooms and make the appointment via outlook.

- 4.34 Booking the rooms through Outlook will secure the rooms in London but you should also confirm the booking by e-mail with the London Admin team. Complete the arrangements as above.
- 4.35 If the HO prefers not to attend the hearing in London, liaise with the party to arrange a suitable date that they can attend a face to face hearing or other alternatives given by the HO. If the party insists on a London hearing seek instruction on how to proceed from the HO.

### **Actions 7 - 2 days before the hearing**

The Hearings Clerk will:

- 4.36 Contact the agent/applicant and ask them for a full list of those who are attending. If they are arriving by car ask them for the make and registration. Check if they have sent in any skeleton arguments and that you have received them. E-mail accommodation, telling them that you have a party arriving on site for a hearing and the date and times. Tell them the names of the visitors and the make and registration of any cars, a parking bay should have been reserved earlier (4.24). Ask them to inform security.

### **Additional tasks where a video conference is arranged**

- 4.37 As above and check that you have the ISDN or IP address of their system. If you require help from IT to make the connection, raise a helpdesk call. Ensure that details of the connection to be made are received in good time and check with IT that the systems are compatible. If possible ask to make a practice connection before the hearing. **Remember that the office must always dial out, connections cannot be made by the party dialling in.**

### **Additional tasks where a telephone hearing is arranged**

- 4.38 As above and check that you have the telephone number where they wish to be contacted. If dialling abroad, a test connection is suggested ahead of the hearing in case of any potential issues.

### **Additional tasks where a hearing is to be held in London**

- 4.39 As above but e-mail details of the visitors and of the HO and their team to the London Admin team.

### **On the day of the hearing**

The Hearings Clerk will:

- 4.40 Set up the hearings room as necessary.
- 4.41 If using a digital-recorder check the battery is full and test before use. If the battery is less than full, replace with new battery.
- 4.42 When the agent/applicant arrives, escort them to the room and settle them before informing the HO and his team of their arrival.
- 4.43 When the HO arrives, introduce the parties, ensure that the digital-recorder is set up and place the quiet sign outside the door when leaving.
- 4.44 After the hearing, escort the applicant off-site, clear the room and collect the recorder.
- 4.45 Take the recorder to the IT helpdesk to have it downloaded to your drive. Send a copy of the recording to the HO and HA. Manually import the recording onto PDAX using code HEARING REC and annotate accordingly. Save the recording to the Hearing Recordings cabinet under

Litigation Hearings on Outlook. Also, place a copy of the recording in the outlook file. Once the recording has been placed on the file, delete the recording off the digital recorder.

- 4.46 Move the paper arrangements file to the Decision file. On the SharePoint list enter the date of the hearing into the 'Date ready for a decision' field. This will trigger the timetable for when the decision is due when generating reports. Entering a date into the "date ready for a decision" field will also create tasks for the HO informing them of the due date for the decision. If the HO requests the party to file submissions, the date ready for a decision is the date that the submissions are filed.

### **Decision based on papers**

- 4.47 An applicant/agent may decide that a decision on papers (their file) will meet their requirements. If so they must advise us of this in writing (an e-mail is sufficient). On the SharePoint list edit the decision type field from a hearing to a decision on the papers and enter the date that the request is received in writing in the 'date ready for a decision' field. This should automatically change the 'Status' to 'Ready for a Decision'. This will generate a task for the HO. Minute the dossier with the date that the request has been made. Move the paper arrangements file to the Decision file.

### **SPC Cases**

- 4.48 SPC hearings should always have a transcript writer. See transcript writers 4.67 - 71 and amend the hearing arrangements letter accordingly.

## **ARRANGING AN INTER PARTES HEARING (Hearings Clerk) use Inter Partes Hearings Checklist (Annex 2b)**

4.49 Requests for Inter Partes hearings will normally come from the B2 case officer for the case. There may be a preliminary hearing followed by the substantive hearing and possibly CMCs in between. For the substantive hearing the case officer will inform the hearing clerk of what is required and agree a hearing date window. The hearings clerk and the case officer will complete the initial hearing request form. Regardless of the type of hearing, the procedures for arranging them are essentially the same.

The Hearings Clerk will:

4.50 Using the details provided by the case officer complete a Hearings Arrangement Sheet (Annex 1b). They will also have instructions on a window for when the hearing will take place and what type of hearing is to be arranged.

4.51 For a substantive hearing the HC should confirm that there is availability in the window week. If not, re-arrange the window week with the case officer. If there is availability then the HC should make an 'All day event' appointment through the Outlook 'PD Hearings' calendar for the HO and CO for the entire week annotated as 'GBXXXXXXXX window week'. In the individual daily bookings in the calendar the HC should open each appointment and in the text box write 'GBXXXXXXXX HO', the HO referring to the hearing officer for the case. To close the entry without sending an update, select the close item and select 'save without sending updates. Following the same procedure as for an Ex Parte hearing (4.21) open an appointment in OUTLOOK and enter all the required parties/rooms. If the arrangements are for the substantive hearing, block book the hearing date window agreed with the case officer. The HC should issue a HRG WINDOW IP (annex 9) letter to the parties confirming the window week. Proceed to 4.54.



### **For a CMC or Preliminary Hearing**

- 4.52 Co-ordinate between the parties to arrange a mutually agreeable date and time for the hearing.
- 4.53 When a date/time is agreed confirm the booking on OUTLOOK 'PDHearings' calendar. Note that for a hearing in London, booking the rooms on OUTLOOK will book the rooms in London. Coordinate with the case officer to ensure that the correct letter is sent out. Generally for a CMC the letter in Annex 3 will be issued. Ensure that a copy of the letter is imported to the DOSSIER. Enter the details on to the paper diary and InterPartes SharePoint list.

### **For a Substantive Hearing**

- 4.54 On receipt of the second round of evidence for sequential and the first round of evidence for simultaneous, the CO should liaise with the HC and complete the handover checklist (Annex 8). The case officer will instruct the hearings clerk to issue the hearing arrangements letter (Annex 4), confirming the actual date of the hearing within the previously agreed window. The Hearings clerk and the case officer will liaise to discuss any changes to the standard deadlines or content of the letter. The hearings information sheet (Annex 5) should be enclosed. Generally inter partes hearings are initially booked for 2 days. The HC should try to book them for Tuesday/Wednesday or Thursday/Friday avoiding Monday in case there are any late issues with skeleton arguments or bundles etc. The Outlook calendar should be updated at this stage, delete the all day appointment and add the HO, CO and HA to the daily appointments – send updates to added attendees only. The HC will then have to amend the subject of the daily appointments and close without sending updates.

## **For All Hearings**

4.55 Co-ordinate with the case officer to set up reminders for any dates for the receipt of evidence, bundles or skeleton arguments. Place the paper file in the "IP Arranged Hearings" Folder.

## **Substantive, Preliminary and CMC's**

### **Actions 14 – 2 days before the hearing**

4.56 The Hearings Clerk will:

- Contact the parties to confirm attendees and car registrations if required and forward these to the relevant accommodation section.
- Check if there are any outstanding documents for the hearing such as skeleton arguments or bundles.
- If the hearing is in London or elsewhere, co-ordinate with the case officer to ensure that all necessary documents are sent to the correct venue.
- Check if same day transcripts are required and make the necessary arrangements.

### **Actions on the day of the hearing**

The Hearings Clerk will:

If in London or at another venue

4.57 Confirm with the London Admin team, or responsible party, that they have the list of attendees and that all required arrangements are in place.

## If in Newport

- 4.58 Ensure that the hearing room is set up correctly and confirm the layout with the case officer if required. Ensure that any retiring rooms or room for the transcript writer are also prepared.
- 4.59 If a digital recorder is to be used, change the batteries and check that the date and time are correct.
- 4.60 On arrival, escort all parties to the hearing room and seek assistance if there is more than one party, as visitors cannot be left unescorted on the premises.
- 4.61 You may be required to swear in witnesses but usually the hearing assistant will do this. A selection of religious texts are available as well as the relevant oaths. People not wishing to swear on a holy book have the option to make an affirmation instead and the text for this is also available. Check what is needed before the hearing starts. (Refer to the hearings manual, sections 4.72 – 4.79 for the list of suitable oaths and procedures)
- 4.62 When all parties are settled, call the HO and the team. Ensure that the HO can operate the recorder if required. When leaving the room ensure that the quiet sign is outside the room.
- 4.63 After the hearing, escort the parties back to reception. Tidy the rooms and collect the recorder, if used.
- 4.64 Take the recorder to the IT helpdesk to have it downloaded to your drive. Ask them to delete anything on the recorder. Send a copy of the recording to the HO and HA. Manually import the recording onto PDAX using code HEAR-REC-IP and annotate accordingly. Save the recording to the Hearing Recordings cabinet under Litigation Hearings on Outlook.

## **Additional tasks in Inter Partes hearings**

- 4.65 If an Inter Partes hearing requires video or telephone conference links follow the procedures as for ex-parte hearings.
- 4.66 Sometimes a witness may be unable to attend a hearing in person. In these cases the HO may allow cross examination by video link. It is up to the party whose witness it is to make the necessary arrangements. Ensure that details of the connection to be made are received in good time and check with IT that the systems are compatible. If possible ask to make a practise connection before the hearing. **Remember that the office must always dial out, connections cannot be made by the party dialling in.**

## **Transcripts and transcript writers**

- 4.67 In Ex Parte hearings it is usual to use the digital recorder unless the HO requests otherwise. **In SPC cases a transcript writer must be used.** In Inter Partes hearings the digital recorder is usually used in CMC and preliminary hearings while a transcript writer will usually be used for the substantive hearing. Check with the case officer or HO to find out what is required.
- 4.68 To book a transcript writer, e-mail the contracted supplier giving details of the date, starting time, venue and case number. When confirmation is received keep a printout with the paper arrangements file.
- 4.69 The case officer will inform you if any special arrangements are required, for example, same day transcription service. If so advise the transcription service in good time, check costs and enquire whether they will require a room at the hearing venue.
- 4.70 Transcripts are now normally received electronically. Convert the file to a PDF if required. Send a copy to the HO and HA and import onto PDAX

using the code HEAR-TRANS for ex parte or HEAR-TRAN-IP for inter-partes cases.

- 4.71 Transcripts, whether audio or pdf, may be requested by the parties. If they are NOPI they must be sent by recorded post, otherwise they may be sent by e-mail.

### **Skeleton Arguments**

- 4.72 A skeleton argument is an outline of the submissions a party proposes to make at a hearing. The purpose of the skeleton argument is to assist the HO and the parties, prepare for, and ensure the efficiency of the hearing. They are merely an aid and are not to be read out verbatim at the hearing. They could provide:

- an agenda for the hearing
- a summary of the main points
- propositions and arguments to be developed orally
- a useful way of noting citations and reference
- a convenient place to make cross references
- a time saving means of avoiding laborious note taking

- 4.73 The skeleton argument will normally be sent to the hearings clerk. In all cases it should be received 7 clear days before the hearing. When received transfer it to the dossier and contact the HO, HA and case officer, if applicable, to let them know.

### **Bundles**

- 4.74 It is unlikely for a party to provide bundles at Ex Parte hearings, it is more usual in Inter Partes cases. Bundles consist of copies of all the papers filed in the proceedings. It is the responsibility of the claimant's representative to compile them. Copies should be provided to the other

side in good time so that both parties can use them effectively during the hearing and should be filed 7 days in advance of the hearing. At least two copies should be supplied to the Office (one for the Hearing Officer and one for the shorthand writer), and a further copy should be produced for use by any witnesses who are due to be cross-examined. If there is to be cross-examination and bundles are not used, the parties still need to ensure between them that they have a spare set of all documents for the witness. In inter partes proceedings, the parties should be instructed to send bundles directly to the hearings venue however one copy should be sent to the Office for the Hearing Officer. If they are sent to the hearings clerk then ensure that they are forwarded securely to the venue if it is not in Newport.

### **Authorities**

4.75 These are precedent cases/decisions that a party may refer to in the course of a hearing. They are usually Reported Patent Cases or Fleet Street Reports. Copies of both can be found in Legal Section or electronically using online services such as Westlaw and Bailii if they have not been supplied and are required by the hearing officer. In both inter partes and ex parte proceedings, the party(ies) involved should supply the authorities and , they at the same time as the bundles (4.74)

4.76 Deleted

4.77 Deleted

4.78 Deleted

### **Cancelled/postponed hearings**

4.79 If a hearing is cancelled, notification must be received in writing, verbal instruction is not sufficient. Cancelling a hearing on Outlook will notify all

the parties attending the hearing from the office however an e-mail should also be sent to those involved and the SharePoint list updated.

- 4.80 Import the notice of cancellation onto the dossier. If a transcript writer has been booked e-mail them and make sure that confirmation of cancellation is received. Check if the hearing is withdrawn or if a decision on papers has been requested, update the SharePoint list accordingly and let the HO know if it is a decision on papers. If a decision on papers is requested the HO may wish to offer the parties time for submissions, use the date of the request or the closing date for submissions as appropriate to complete the 'Date decision issued' column on the spreadsheet. Mark the hearing as cancelled in the paper hearings diary.
- 4.81 If a hearing is postponed and the date of the new hearing is known, change the date of the hearing on OUTLOOK. This will update the calendars of the office participants. If the original hearing was in the next few days, e-mail the HO/HA etc so that they are aware. Send the parties involved a new letter with the new dates/venues and import on to the dossier. Update the SharePoint list and hearings diary as necessary.
- 4.82 If the new date of a hearing is not known, cancel the hearing on OUTLOOK, update the SharePoint list and return the paper file to the '*Hearings awaiting date*' folder. Treat the case as a "hearing to be arranged". See 4.21- 4.35 for ex-parte hearings and 4.49 – 4.55 for inter parte hearings.

### **Hearings Diary**

- 4.83 A diary of all Patent hearings is published on the external website. The hearings clerk should update this weekly on a Thursday when there are updates to be made.

- 4.84 The hearings diary is located in the SharePoint hearings library. The last update should be in the folder, open it in Excel and 'save as' with the current date.
- 4.85 The hearings diary spreadsheet should be updated as hearings are booked. Only current hearings should be on the spreadsheet, hearings that have already been held or cancelled should be deleted. Updates should be checked against the 'Arranged Hearings' folder. NOTE THAT ONLY HEARINGS OPEN TO PUBLIC INSPECTION SHOULD BE PUT ON THE DIARY.
- 4.86 In rare occasions, the case officer may instruct you to put NOPI proceedings on the diary. If this is the case check which dates are to be placed on the diary as the hearing may still be closed for some dates.
- 4.87 Send the update to webmaster and check that their return e-mail is correct. Delete previous updates on SharePoint.

### **Correspondence received**

- 4.88 All correspondence received on a case should be imported onto the dossier. The hearing officer and case officer should also be notified, especially if any key dates are approaching.

### **Compliance Periods and Hearings**

- 4.89 The compliance period for putting a patent application in order ends the later of 4 ½ years from the filing/priority date or 12 months from the issue of the first report under s 18(3).
- 4.90 The compliance period may be extended in 2 month tranches. R108(2) allows an of right extension of 2 months and must be requested using form 52 and by paying a fee before the end of two months from the compliance period. R108(3) allows further discretionary two month



extensions and must be requested using form 52 and by paying a fee before the expiry of 2 months after the previously extended period. Evidence must be filed to support the request – each discretionary extension is likely to require more robust evidence than the previous discretionary extension allowed.

- 4.91 If the end of the compliance period is imminent and a hearing is necessary then ideally the hearing should be held before the end of the compliance period (or any extended period). A period of less than the minimum of 14 days notice usually given is appropriate if this means that the hearing could be conducted before the end of the compliance period.

#### **Hearing before end of compliance period**

- 4.92 If the hearing is conducted and the decision issued before the end of the period then the applicant still has an opportunity to amend his application after an adverse decision.

#### **Hearing before the end of two months after the compliance period**

- 4.93 If the hearing results in an adverse decision and the applicant wishes to amend his patent accordingly, he must apply for a two month automatic extension under rule 108(2) using form 52 and paying a fee. Amendments should then be made before expiry of the extended compliance period unless it is further extended.

#### **Hearing after the end of two months after the compliance period**

- 4.94 If the compliance period has not been extended under rule 108(2) then under rule 108(7) no further extension to the compliance period is allowed under rule 108(3) and amendments following an adverse decision will generally not be possible.

4.95 If the compliance period has previously been extended (under rule 108(2) or 108(3)) then a discretionary extension of two months may be available. This must be requested on form 52, paying the fee and providing evidence supporting the request, all within two months of the previously extended period. Amendment following an adverse decision can then be effected. If the discretionary extension is not allowed then amendment is not generally possible.

Annex 1a

|                                      |                   |
|--------------------------------------|-------------------|
| <b>Ex Parte Hearing Arrangements</b> | <b>Date Set -</b> |
|--------------------------------------|-------------------|

(telephone / person / video link)

**PATENT NO.**.....

**Normal**                      **Scottish**                      **SPC**                      **Design**

**OPI / NOPI**                      **SECTION**.....

**TYPE OF HEARING -**                      **REFERENCE**.....

Date request made.....                      Date received in Section.....

Applicant .....

Attorneys .....

Telephone .....

Fax .....

Contact/ref .....

Contact name.....

Email .....

Counsel.....

Clerk .....

Telephone .....

HO .....                      HA.....

Room .....Ext.....                      Room .....Ext.....

CO.....                      ROOM NUMBER.....Time.....

Room .....Ext.....                      BAY No's -                      (if by car)

T/W or Dig Rec –

Attendees .....

.....

*Hearings room booked*

*Transcript writer booked if required*



|  |  |
|--|--|
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|  |  |

### Annex 1b

|   |                   |
|---|-------------------|
| <b>Inter Partes Hearing<br/>Arrangement Sheet</b> | <b>Date Set -</b> |
|---|-------------------|

(telephone / person / video link)

|                          |                 |                          |                |
|--------------------------|-----------------|--------------------------|----------------|
| <b>PATENT NO</b>         |                 |                          |                |
| <b>Standard</b>          | <b>Scottish</b> | <b>SPC</b>               | <b>Design</b>  |
| <b>OPI / NOPI</b>        |                 | <b>SECTION</b>           |                |
| <b>TYPE OF HEARING -</b> |                 | <b>REFERENCE</b>         |                |
| Date request made        |                 | Date received in Section |                |
| <b>Claimant</b>          |                 | <b>Defendant</b>         |                |
| Attorneys                |                 | Attorneys                |                |
| Telephone                |                 | Telephone                |                |
| Fax                      |                 | Fax                      |                |
| Contact/ref              |                 | Contact/ref              |                |
| Contact name             |                 | Contact name             |                |
| Email                    |                 | Email                    |                |
|                          |                 |                          |                |
| Counsel                  |                 | Counsel                  |                |
| Clerk                    |                 | Clerk                    |                |
| Telephone                |                 | Telephone                |                |
|                          |                 | Witness<br>(X)           | Witness<br>(X) |
| <b>Attendees</b>         |                 | <b>Attendees</b>         |                |
|                          |                 |                          |                |
|                          |                 |                          |                |
|                          |                 |                          |                |
|                          |                 |                          |                |
|                          |                 |                          |                |
|                          |                 |                          |                |
|                          |                 |                          |                |
|                          |                 |                          |                |
| HO                       |                 | HA                       |                |
| Room                     | Ext             | Room                     | Ext            |

|      |                  |                        |
|------|------------------|------------------------|
| CO   | ROOM NUMBER      | Time                   |
| Room | Ext              | BAY No's - (if by car) |
|      | T/W or Dig Rec – |                        |
|      |                  |                        |

*PTO for arrangements quick checklist*

|  | Booked/Sent | Confirmed/Arrived |
|--|-------------|-------------------|
| Hearings rooms booked  |             |                   |
| Transcript writer booked   |             |                   |
| Car Park bay booked  |             |                   |
| Arrangement confirmation letter sent   |             |                   |
| Witness list received  |             |                   |
| Cross-examination schedule agreed  |             |                   |
| Running Order  |             |                   |
| Same day transcripts required  |             |                   |
| Special IT requirements  |             |                   |
| Video conferencing   |             |                   |
| Skeleton Arguments received  |             |                   |
| Oaths and affirmations checked   |             |                   |
| Bundles received - electronic  |             |                   |
| Do bundles need printing   |             |                   |
| Bundles received - paper   |             |                   |
| Bundles sent to hearing location –<br>If NOPI secure transport and storage<br>arranged |             |                   |

**Contact log**

| Date | Result |
|------|--------|
|      |        |
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|      |        |





## Annex 2a

### Ex Parte Hearings Checklist – use in conjunction with notes

| <b>On receipt of request</b>   |  |
|--|--|
| Notice received via PDAX or e-mail – note date received  |  |
| From Dossier (PDAX) – use agent letter, EL2 etc as required to complete as much as possible of <b>Ex Parte Hearing Sheet</b> |  |
| Select Hearing Officer and Hearing Assistant from EP Rotas   |  |
| Enter details on SharePoint Ex Parte Cases (including month actioned)  |  |
| On PDax minute dossier with HO and message HO  |  |
| Contact HO to confirm HA selection, check if HO wants to select dates for hearing or use Outlook calendar                    |  |
| Delete request, place paper folder in ‘Cases waiting date’ file  |  |
| <b>Arranging hearing date</b>  |  |
| In Outlook calendar open appointment date and add attendees, rooms, etc  |  |
| Ring the attorney and co-ordinate date and time – check with HO if attorney requests telephone, video or London hearing      |  |
| Compose letter on PROSE, send to attorney, import to dossier –check if NOPI  |  |
| E-mail accommodation, tell them date, time, attendees and car registration   |  |
| Enter the details in paper diary and dates on SharePoint list  |  |
| Enter hearing dates Patents Hearings Diary if OPI  |  |
| Place paper folder in ‘Arranged hearings’ file   |  |
| <b>2 Days before hearing</b>   |  |
| Contact the attorney, confirm attendees, arrival method and status of additional documents                                   |  |
| <b>Day of hearing</b>  |  |
| Newport – Prepare room<br>London – Confirm details with London admin   |  |
| If using digital recorder – check date and battery   |  |
| When attorney arrives, escort them to the room, once settled inform HO and others  |  |

|   |  |
|---|--|
| Ensure HO can operate recorder, place 'quiet' sign outside door                                     |  |
| After hearing, tidy room, collect recorder  |  |
| Transfer recording ( IT Helpdesk) and send to HO, HA and to Dossier                                 |  |
| Enter decision due date or submissions on SharePoint. Transfer hearings pack to 'awaiting decision' |  |

**Annex 2b**  
**Inter Partes Hearings Checklist** – *use in conjunction with notes*

| <b>On receipt of request</b>  |  |
|---|--|
| From Dossier or Paper file – use agent letter, EL2 etc as required to complete as much as possible of <b><i>Hearing Arrangement Sheet</i></b>   |  |
| Co-ordinate with case officer over dates and status of hearing. Fix window week and send letter   |  |
| <b>Arranging the hearing date</b>   |  |
| In Outlook calendar open appointment date and add attendees, rooms, etc   |  |
| Ring the agents and co-ordinate date and time – check with case officer if agent requests telephone, video or London hearing  |  |
| Co-ordinate with case officer over the hearing confirmation letter and wording to send to agents from PROSE, send to agents, import to dossier –check if NOPI – check if HO requires transcriptwriter |  |
| Enter the details in paper diary and on spreadsheet   |  |
| In Outlook set reminders for 2 week, 1 week and 2 days before the hearing   |  |
| Place paper folder in ‘Arranged hearings’ file  |  |
| <b>2 week - 2 days before the hearing</b>   |  |
| Contact the parties, confirm attendees, arrival method and status of additional documents, witnesses and running order, transcript services.  |  |
| Co-ordinate with the case officer to see that all documents are received and if they need to be forwarded on.   |  |
| <b>Day of the hearing</b>   |  |
| Newport – Prepare room<br>London – Confirm details with London admin  |  |
| If using digital recorder – check date and replace battery  |  |
| When agents arrive, escort them to the room, once settled inform HO and others  |  |
| Ensure HO can operate recorder, place ‘quiet’ sign outside door   |  |
| After hearing, tidy room, collect recorder  |  |
| Transfer recording ( IT Helpdesk) and send to HO and Dossier  |  |

### Annex 3

**Your reference:** XXX

**Our reference:** 1R31/Name/GB/EP

Date

Dear Sirs

**Patent Number: GB/EP (Proprietor)**

**Reference under Section XXX of the Patents Act 1977**

1) I am pleased to inform you that the XXXX XXXX in the above proceedings will take place on XX XXX XXXX starting at XX:XX. It will be held at 4 Abbey Orchard Street, London, SW1P 2HT / Concept House, Cardiff Road, Newport, NP10 8QQ. Please report to reception shortly before the hearing is due to start. (*delete as appropriate*)

Or

1) I am pleased to inform you that the XXXX XXXX in the above proceedings will take place on xxXXxx starting at xx:xx. It will be held at Concept House, Cardiff Road, Newport, NP10 8QQ by **telephone conference**. The telephone number that I have on record is **XXXX XXXXX**, if this is incorrect or you would like to use an alternative number, please inform me before the hearing. (*complete as appropriate*)

Or

1) I am pleased to inform you that the case management conference will take place on xxXXxx **starting at xx:xx**. The hearing will be held at Concept House, Cardiff Road, Newport, NP10 8QQ and by **video conference** with our London Office, **4 Abbey Orchard Street, London, SW1P 2HT**. Please report to reception shortly before the hearing is due to start. / with your premises, please send me details of your system as soon as possible so that I may check the compatibility of our systems. (*delete as appropriate*)

2) The XXXX XXXX has been arranged to XXXX XXXX. If there are any other issues that you want to raise, you should notify me and the other side as soon as possible. (*complete as required*)

3) For security purposes, please let me have a list of all those attending from your side as soon as possible, and confirm whether they require any special arrangements to be made for the hearing.

#### **Skeleton Arguments and Authorities**

4) You are expected to provide a skeleton argument (an outline of the argument you intend to present at the hearing) at least **7 working days before the hearing**;

however it would be helpful to provide this sooner where possible You should send a copy of your arguments to the other side in sufficient time before the hearing to enable them to properly consider them. If you intend to refer to any precedents at the hearing, please send them to me at the same time as the skeleton argument.

Or

You do not need to supply any documents specifically for this XXXX XXXX. *(complete as required), however if you intend to rely on any precedents or authorities then these should be supplied to us before hand.*

Or

It would be helpful if you would supply ..... by .....

5) Please be aware, if you are attending a hearing in person, you will be entering an official government building. Therefore, due to security reasons, you will be escorted by a member of staff AT ALL TIMES whilst in the building.

6) Any further correspondence relating to this hearing should be sent to me addressed –

URGENT HEARING

For the attention of the Hearings Clerk room1R31

Intellectual Property Office

Concept House

Cardiff Road

Newport

NP10 8QQ

7) A letter in identical terms has been sent today to the other side.

Yours faithfully

Name (Hearings Clerk)

Litigation Section

Patents Directorate

## Annex 4

**Your reference:** XXX

**Our reference:** 1R31/Name/GB/EP

Date

Dear Sirs

**Patent Number: GB/EP (Proprietor)**  
**Reference under Section XXX of the Patents Act 1977**

I refer to our letter dated xxXXxx in which you were notified of the allocated period for holding the substantive hearing. I can now confirm that the hearing will be held on XX XXX XXXX starting at XX:XX daily. The hearing will be held at 4 Abbey Orchard Street, London, SW1P 2HT / Concept House, Cardiff Road, Newport, NP10 8QQ. Please report to reception shortly before the hearing is due to start.  
*(delete as necessary)*

For security purposes, please let me have a list of all those attending from your side as soon as possible, and confirm whether they require any special arrangements to be made for the hearing.

All correspondence relating to the hearing should now be addressed to the hearing clerk. Please do not use the electronic filing system if sending correspondence. Full instructions on how to send to us can be found on the fact sheet.

Please be aware, if you are attending a hearing in person, you will be entering an official government building. Therefore, due to security reasons, you will be escorted by a member of staff AT ALL TIMES whilst in the building.

**You should do the following by the dates specified:-**

**8 weeks before the Hearing, i.e. by xxXXxx**

### **Arrangements for the Hearing**

You may wish to be represented at the hearing either by a patent attorney, Counsel (a barrister) or another representative. If so, please

- (a) Select your Counsel or other representative and tell us and the other side.
- (b) Tell your own Counsel or representative
  - i) that the case is shortly to be ready for a hearing and that a date has been set.
  - ii) the name and details of the other party's Counsel or representative.

It is essential that you attend to the selection of your representative in good time and that each representative is informed as quickly as possible of each other's name and contact details.

### **2 Weeks before the Hearing, i.e. by xxXXxx**

As agreed, the hearing has been scheduled for **X** day. You should confirm that this is acceptable.

### **Cross Examination & Running Order**

Please inform me if cross-examination is being sought, provide an explanation of why it is needed and indicate how long it is expected to last. You should also provide me with the names of the witnesses you wish to cross-examine. When cross-examination takes place at a hearing, retiring rooms will be provided for each party where possible. If you do not require this facility please let me know. You should also let me know if cross-examination is not required.

Where a hearing is expected to run for more than one day and especially where cross-examination of witnesses is to take place, it is usual for the parties to prepare a running order for the Hearing Officer. This should be provided by the above date.

### **Same Day or Next day transcripts**

Where the hearing extends to more than one day, if you require same day or next day transcripts you will need to contact the office so that we can make the necessary arrangements. **Please note that the parties will be responsible for the extra costs incurred.**

### **Digital Evidence**

If you intend submitting digital evidence at the hearing please let us know by the above date so that we can ensure the necessary IT equipment is in place.

### **7 days before the Hearing, i.e. by xxXXxx**

### **Skeleton Arguments**

You are expected to provide a skeleton argument (an outline of the argument you intend to present at the hearing) by the above date. However it would be helpful to provide this sooner where possible. You should send a copy of your arguments to the other side in sufficient time before the hearing to enable them to properly consider them.

### **Evidence Bundles**

You are expected to supply bundles for the hearing and to take them with you to the hearing venue. If you are unable to do this then please forward them to me by the above date to:-

The Intellectual Property Office  
Patents Hearings Clerk Room 1R31  
Concept House  
Cardiff Road  
Newport  
NP10 8QQ

Please remember to include copies for the other party, the transcript writer, the hearing officer and the witnesses (if there is to be cross examination). **If taking directly to the hearing venue then please send me a copy for the hearing officer, again to arrive at least 7 days before the hearing.**

### **Precedents and Authorities**

If you intend to refer to any precedents or authorities at the hearing please include them at the same time as sending the bundles. Again if you will be taking the bundles direct to the hearing venue then please **send me a copy of the authorities with the bundle for the hearing officer to arrive at least 7 days before the hearing.**

### **Issuing Decisions**

Decisions will normally be issued by post but can be issued by e-mail if requested. Please see attached fact sheet for further information.

Any further correspondence relating to this hearing should be marked –

"URGENT HEARING - for the immediate attention of "Hearings Clerk"  
Room 1R31  
Concept House  
Cardiff Road  
Newport  
NP10 8QQ

A letter in identical terms has been sent today to the other side.

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate



## Annex 5

### **INFORMATION ON HEARING ARRANGEMENTS**

The information below may be of some assistance to you when preparing for your hearing.

### **SENDING CORRESPONDENCE TO THE HEARING CLERK**

All correspondence relating to the hearing should now be addressed to the hearing clerk. If sending anything to us electronically please use the e-mail address above – **do not** use the electronic filing system as we are not directly linked to it and it may take several days to reach us. Incoming e-mails larger than 10 MB may be caught by our firewall so if necessary please send several smaller e-mails rather than one large one. We will acknowledge receipt of all e-mails but if you are worried that we have not received anything then please do telephone us.

### **CROSS EXAMINATION**

During litigation proceedings individuals may be asked to provide a witness statement in evidence to support the case of one of the sides involved in the dispute. When the dispute is “heard”, (i.e. there is a hearing to determine the matter), it is likely that the witness may be called to be cross examined by the other side.

Where a party wishes to cross examine a witness, they must provide details of the witness they wish to cross examine, an explanation of why cross examination is needed and provide an estimate of how long the cross examination is likely to take.

If there are any special arrangements required for cross examination of a witness such as for example, the requirement for an alternative oath or holy text, please inform the Hearings Clerk immediately to ensure there is adequate time to make the necessary arrangements. Please inform the Hearings Clerk if cross examination of a witness by video conference is required. However please note that where a party makes such a request, they will be responsible for making the necessary arrangements for video conferencing.

### **RUNNING ORDER**

A running order is a schedule of the proposed timetable for the hearing and is produced by agreement between both parties. It is usually required where witnesses are to be cross examined or the hearing is scheduled to take place over two days or more. The running order should take into account:-

- Opening arguments by both parties
- An estimate of the length of cross examination
- The order that the witnesses are to be cross examined
- The names of witnesses to be cross examined
- Closing arguments by both parties

The proposed running order should be filed by the claimant for consideration of the hearing officer.

## **TRANSCRIPTS**

A transcript is a typed record of the argument and cross examination conducted during the hearing. A transcript writer will usually be present at all substantive Inter Parte hearings. If the parties require same day or next day transcripts, these can be arranged, however the parties will bear the costs. A digital recorder will usually be used in all other hearings.

## **EVIDENCE BUNDLES**

Bundles are all of the key documents filed by both parties during the proceedings which are likely to be referred to at the hearing. As such copies are required for those present at the hearing. The responsibility for preparing the bundles lies with the claimant but the content should be produced in agreement with the defendant.

Once the parties have an agreed set of bundles, the claimant should provide copies for the:-

- Hearing Officer
- Transcript writer
- Defendant
- Witnesses (where cross-examination is sought, if deemed appropriate)

If the hearing is being held in London or at an alternative venue, one set of bundles should be sent directly to Newport for the Hearing Officer, within the deadline set in the arrangements letter and the remaining bundles should be taken to the hearing venue.

## **SKELETON ARGUMENTS**

A skeleton argument is an outline of the argument to be presented by the parties at the hearing. These should be filed by both parties and sent directly to the Hearings Clerk within the deadline set in the arrangements letter.

## **PRECEDENTS (AUTHORITIES)**

Precedent cases (authorities) are previous legal decisions that either party may wish to rely on during the hearing to support their case. The Hearings clerk should be notified of the precedents required by each party within the deadline stated in the arrangements letter. Copies of any precedents you intend to rely on at the hearing should be sent to the hearing clerk for the hearing officer at the same time as the skeleton arguments or at least 7 days beforehand if you are not supplying any skeleton arguments.

## **DIGITAL EVIDENCE**

If you will be providing evidence in a digital format, wherever possible it should be supplied in MPEG format on a CD-ROM. If you intend taking digital evidence to a hearing you should ensure that it is on a CD-ROM as we will not be able to play evidence submitted in other formats or be able to download from other formats on the day.

## **DECISIONS**

There is an office target to issue decisions within 17 weeks of the hearing date although we do try to issue them within 9 weeks. The need for further submissions, the complexity of the case or other workload priorities may delay the issuing of your decision. Decisions are normally issued by post but if you would like a copy by e-mail then please tell us as soon as possible. We will require notification from you that you accept liability for any loss during transmission and the copy that you receive electronically will not be signed.

**Annex 6**  
**Ex-Parte Hearing Arrangement Letter**

**Your reference:** XXX

**Our reference:** 1R31/Name/GB/EP

Date

Dear Sirs

**Patent Number : GB/EPXXXXXX (Proprietor)**

1) I am pleased to inform you that the hearing will take place on xxXXxx starting at x:xx am. The hearing will be held at Concept House, Cardiff Road, Newport, NP10 8QQ/ 4 Abbey Orchard Street, London, SW1P 2HT (*delete as required*).

Please report to reception shortly before the hearing is due to start.

OR

1) I am pleased to inform you that the hearing will take place on xxXXxx starting at x:xx am. The hearing will be held at Concept House, Cardiff Road, Newport, NP10 8QQ by **telephone conference**. The telephone number that I have on record is **XXXX XXXXXXXX**, if this is incorrect or you would like to use an alternative number, please inform me before the hearing.

OR

1) I am pleased to inform you that the hearing will take place on xxXXxx starting at x:xx am. The hearing will be held at Concept House, Cardiff Road, Newport, NP10 8QQ and by **video conference** with our London Office, **4 Abbey Orchard Street, London, SW1P 2HT**. Please report to reception shortly before the hearing is due to start./ with your premises, please send me details of your system as soon as possible so that I may check the compatibility of our systems. (*delete as appropriate*)

2) For security purposes, please let me have a list of all those attending as soon as possible and confirm whether they require any special arrangements to be made for the hearing.

3) If you intend submitting a skeleton argument please e-mail (if possible) or fax the document **at least 7 days before the hearing, that is xxXXxx**. If you intend to refer to any precedents at the hearing, please send them at the same time as the skeleton argument.

4) Please note it is our practice to digitally sound-record hearings and not to have a transcript writer. If you would like a transcript of the hearing you will need to contact the office so that we can make the necessary arrangements. **Please note that you will be responsible for the extra costs incurred.**

5) Please be aware, if you are attending a hearing in person, you will be entering an official government building. Therefore, due to security reasons, you will be escorted by a member of staff AT ALL TIMES whilst in the building.

6) Decisions will normally be issued by post but can be issued by e-mail if requested. Please see attached fact sheet for further information.

7) Until the hearing, any further correspondence should be marked –  
URGENT HEARING – For the attention of XXXX XXXX ROOM 1R31,  
CONCEPT HOUSE,  
CARDIFF ROAD,  
NEWPORT,  
NP10 8QQ.

All correspondence relating to the hearing should now be addressed to the hearing clerk. Please do not use the electronic filing system if sending correspondence. Full instructions on how to send to us can be found on the fact sheet.

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate

## Annex 7

**Your Reference:**

**Our Reference:**

**Date:**

Dear Sirs

I have been asked to arrange a hearing on your case, GB/EP (Proprietor)

There are 3 options available to you -

1) You can request an oral hearing before a Hearing Officer. This means travelling to Newport, South Wales to attend a hearing. Here you will present your case and the Hearing Officer will, workloads permitting; endeavour to issue a decision in 9 weeks. If you were unable to travel to Newport but could attend our office in Abbey Orchard Street, London, it may be possible to hold the hearing via video link with Newport with the Hearing Officer's agreement.

2) You can request a telephone hearing. This would be similar to option 1 above but you would not be required to travel. You would need to agree a date and time when the Hearing Officer could contact you. Again this would require the Hearing Officer's agreement.

3) You can request to have a decision based on the papers (your file) - again the Hearing Officer would endeavour to issue a decision within 9 weeks which would be based on the papers in your case file.

In all cases, you would be given the opportunity to present a skeleton argument supporting your case together with any supporting documents. This should be sent to me using the contact details above to arrive at least 7 days before the date of the hearing.

Approximately 2 working days before a physical hearing, you will be contacted by a member of our team to ensure that we have the details of all parties attending and in the case of hearings in Newport that we have the make and registration of any vehicle that you are bringing on site.

If you have any queries regarding any of the above, please do not hesitate to contact me by email or telephone using the details above.

Yours faithfully

Name (Hearings Clerk)  
Litigation Section

Annex 8

**INTERPARTES HEARING CHECKLIST**

|   |                                 |
|---|---------------------------------|
| <b>PATENT NUMBER/S</b>  |                                 |
| <b>PROCEEDINGS</b>  |                                 |
| <b>OPI/NOPI</b>   |                                 |
| <b>HEARING TYPE<br/>(PRELIM/CMC/SUBSTANTIVE)</b>                                  |                                 |
| <b>VENUE:-</b>  |                                 |
| <b>PROVISIONAL HEARING WINDOW:-</b>   | <b>CONFIRMED HEARING DATE:-</b> |
| <b>PLEASE ISSUE HEARING WINDOW LETTER WITHIN ONE WEEK OF RECEIPT OF THIS FORM</b> |                                 |
| <b>CLAIMANT:-</b><br><b>ATTORNEY:-</b><br><b>CONTACT DETAILS:-</b>                |                                 |
| <b>DEFENDANT:-</b><br><b>ATTORNEY:-</b><br><b>CONTACT DETAILS:-</b>               |                                 |
| <b>HEARING OFFICER:-</b>  |                                 |

|   |  |
|---|--|
|   |  |
| <b>CASE OFFICER:-</b>   |  |
| <b>HEARING ASSISTANT:-</b>  |  |
| <b>PLEASE SEND FINAL HEARING<br/>ARRANGEMENTS LETTER BY:-</b>                                 | <b>DATE PASSED TO HEARINGS<br/>CLERK:-</b> |
| <b>LETTER BLOCK SENT TO HC:-</b>  |  |
| <b>ANY SPECIAL NOTES (RUNNING ORDER, SPECIAL TRANSCRIPT<br/>SERVICES, HEARING LENGTH ETC)</b> |  |



**Annex 9**  
**Hearing Window Week Arrangement Letter**

**Your Reference:**

**Our Reference:**

**Date:**

Dear sir

**(LETTER HEAD AS SUPPLIED BY CASE OFFICER)**

1. The case officer in the above case has instructed me to make arrangements for the substantive hearing. These hearings will normally take place in our Abbey Orchard Street offices in London.
2. The hearing in these proceedings has been scheduled for the week commencing **XX to XX XXXXXXXX XXXX**. You should ensure that all your attendees, including counsel and any of your witnesses that may be called for cross-examination, are available for the whole of this week. We will write to you again at an appropriate time during the evidence rounds to confirm the actual days and make the necessary arrangements for the hearing.
3. The scheduled week provides sufficient time to complete the evidence rounds, for the parties to consider any Preliminary Evaluation issued after the evidence rounds have been completed and for expert witnesses to provide a joint statement of agreed and disputed matters if required.
4. If this particular week is inconvenient for you then please inform us within two weeks of the date of this letter, that is by **XX XXXXXXXX XXXX** so that we may make alternative arrangements.

A letter in identical terms has been sent today to the other party.

Yours faithfully

Name (Hearings Clerk)  
Litigation Section

## CHAPTER 5

### DECISIONS

|                        |           |
|------------------------|-----------|
| Introduction           | 5.01-5.02 |
| BL numbers             | 5.02      |
| Issuing a Decision     | 5.03-5.30 |
| Hearing Officer action | 5.03      |
| Hearings Clerk action  | 5.04-5.31 |
| External circulation   | 5.18-5.20 |
| Second day             | 5.21-5.22 |
| Third day              | 5.23-5.27 |
| NOPI decisions         | 5.28-5.30 |
| Oral Decisions         | 5.31-5.32 |
| No Appeal Received     | 5.33-5.36 |
| Appeal Received        | 5.37      |
| Bundles                | 5.38-5.39 |

#### Annexes

|          |                                   |
|----------|-----------------------------------|
| Annex 1  | Decision and Abstracts checklist. |
| Annex 2  | Decision Letter NOPI              |
| Annex 3  | Decision Letter OPI               |
| Annex 4  | Decision Letter Redacted          |
| Annex 5  | Decision Letter Scottish court    |
| Annex 6  | Decision Letter Section 13        |
| Annex 7  | Decision Letter SPC               |
| Annex 8  | Decision Letter Design            |
| Annex 9  | Deleted                           |
| Annex 10 | Decision Pro-Forma                |

## **DECISIONS**

### **INTRODUCTION**

5.01 Decisions are usually written by the Hearing Officer (HO) following an *inter partes* or *ex parte* hearing. Occasionally the HO will give an oral decision at the hearing. Where the part(y)ies agree, the HO may write a decision based on the papers filed. Decisions can be:

- Preliminary; where a preliminary point has been decided in order to progress the case to a substantive hearing
- Interim; where the final decision can only be issued once certain points have been fulfilled following the substantive hearing
- Substantive; where the definitive orders of the comptroller are made.

### **BL numbers**

5.02 Each decision is allocated its own British Library number (BL number). The hearings clerk will allocate the BL number on receipt of the electronic version of the decision.

## **ISSUING A DECISION – (see Decisions & Abstracts checklist Annex 1)**

### **HO action**

5.03 The HO will email the Decisions&Abstracts e-mail box with the decision and abstract (summary) and request that the hearings clerk send a copy of the decision to the part(y)ies. An abstract should be supplied at the same time as the decision. If this is not possible then it should be supplied within 5 days.

### **Hearings Clerk action**

5.04 Decisions should be received through the Decisions&Abstracts e-mail box, which is regularly monitored by the hearings clerk. Unless instructed

otherwise, decisions are actioned as a priority and should be processed as soon as possible. The hearings clerk will attach the paper checklist to the relevant 'hearings arrangement' file in the DECISIONS folder if one is available.

The hearings clerk will:

- 5.05 On receipt of the decision, open it in word and check that it is on the correct template and correctly formatted. If not, the HO should be contacted immediately.
- 5.06 Open the BL number spreadsheet, SharePoint\Hearings\BL Numbers Spreadsheet, allocate the next number to the decision and enter the BL number, Parties names, P and the date the decision is issued on the SharePoint List. The BL number and the issue date will then be entered on to the decision.
- 5.07 Add the HO's electronic signature to the decision. Electronic signatures are located in SharePoint in the Signature Library. Save the decision in the SharePoint Hearings Library. The decision should be renamed so that it is saved in the form BL Number\_Dec\_HO Initials.
- 5.08 Print signed copies of the decision for the parties and import a signed copy of the decision as a PDF onto the dossier using Manual Import – doc code DECISION LIT or DECISION-IP as appropriate. The status of the application should be checked and annotated accordingly as OPI or NOPI on the dossier.
- 5.09 Delete the signature on the decision in Word and resave. Print 3 copies for British Library, EPO and RPC editor if OPI. If it is an SPC print a copy for the hearing officer.
- 5.10 Update the Hearings SharePoint List, with the date the decision is issued and the section of the Act. The status should be checked to determine if OPI or NOPI for the OPI/NOPI field.

5.11 In Prose select the appropriate covering letter to be issued with the decision, complete options as follows:-

- Annex 2 for an NOPI decision
- Annex 3 for an OPI decision
- Annex 4 for a redacted decision
- Annex 5 for a decision before the Scottish Court of Session
- Annex 6 for a decision under section 13
- Annex 7 for a decision relating to Supplementary Protection Certificates (SPC's)
- Annex 8 for a decision relating to Designs. Due to changes under the Appointed Person (Designs) Rules 2015, the A3 should refer to the B2 case officer for details on procedure and appropriate content of letters.

The appropriate template should be selected and completed with the necessary information. Any paragraphs not required should be deleted. For Inter Partes proceedings separate letters should be issued to each party. Copies of all letters are imported onto the dossier. The decision should be issued with the covering letter to the parties. If the decision is for an SPC print a copy of the letter and send with the unsigned decision (5.09) to the hearing officer.

5.12 Once the abstract is received open the abstract in word, add the same BL number and date as on the decision. Save the abstract on SharePoint in the Hearings Library. Rename the abstract so it is saved in the form BL Number\_Abs\_HO initials.

5.13 If the decision is OPI it will be placed on the external website. An e-mail should be sent to webmaster with the unsigned copy of the decision in Word attached. The email should be headed 'new patent decision for the website'.  
**Do not send copies of NOPI decisions to webmaster.**

5.14 Copies of all Inter Parte and Ex Partes decisions and abstracts should be

circulated internally to the decisions circulation contact list on Outlook. Section 13 decisions are only circulated to a limited Section 13 decision contact list. **If the decision is NOPI ensure the covering e-mail states this.**

- 5.15 Set a task on Outlook for the following day to add the abstract and for the day following that to check the decision and abstract are available to view on the external website.
- 5.16 Set a task on Outlook for the end of the appeal period plus 2 weeks to clear the decision if no appeal is received. The end of the appeal period can be taken from the covering letter but is usually 28 days from the date of the decision for Patents, 6 weeks from the date of the decision if a substantive decision for a Design or 14 days from the date of the decision if a procedural decision in a Design case. For decisions issued following a hearing in Scotland, the appeal period should be confirmed with the hearing officer.
- 5.17 For a section 13 decision, a message should be sent on PDAX to the case officer requesting 'Clear records and Action'.

### **External Circulation**

The hearings clerk will:

- 5.18 **If the decision is OPI**, send unsigned copies of the decision to the EPO, British Library and the RPC editor
- 5.19 Complete a clear records pro-forma (Annex 10) and pass it to the B3 for processing. This is not required for section 13 decisions.
- 5.20 Enter the date the decision was sent on the BL number spreadsheet in SharePoint.

### **Second day**

- 5.21 The abstract cannot be added to the Patents Decision database on the date

that the decision is issued. It is usually added on the following day. If the HO has not supplied the abstract with the decision then it should be supplied within 5 days. If the abstract is not received the hearings clerk should contact the HO.

The hearings clerk will:

- 5.22 Using the abstract complete the fields in the PATENTS DECISIONS application. If a new hearing officer needs to be added, this is achieved through the PATENTS DECISIONS ADMIN application. Note that all section 13 decisions are Inter Partes. **NOPI abstracts should not be placed on the database until published.**

### **Third day**

- 5.23 The decision and abstract should have been uploaded to the external website overnight.

The hearings clerk will:

- 5.24 Check the website to ensure that the abstract and decision are correct. Any errors should be reported to webmaster.
- 5.25 Enhance the decision on PDAX and annotate the decision as OLF I only if the decision is OPI.
- 5.26 Delete both the abstract and decision (Word and PDF versions) from SharePoint before placing the original e-mail into the 'cabinet' in OUTLOOK. **NOPI decisions should not be deleted in WORD but stored in the NOPI decisions folder in the SharePoint Hearings Library.**
- 5.27 Complete the appeal B/F dates on the checklist. The paper file should then be placed in the AWAITING APPEAL PERIOD folder and a task set in OUTLOOK to check if an appeal has been received.

## **NOPI Decisions**

- 5.28 NOPI decisions, (Not Open To Public Inspection), are not published externally until the Patent is published or unless all parties give their consent. NOPI decisions usually relate to unpublished patent applications, section 40 cases, design right cases and decisions which contain potentially commercially sensitive material.
- 5.29 In the letter issued with the decision (see Annex 2), the parties are asked to inform us if they are content for the decision to be published. If consent is received then a version of the decision may be published or alternatively it may be agreed that all sensitive matter is removed and a redacted version may be published and circulated as above. This redacted decision will also be sent out to the original recipients with a redacted decision letter (Annex 4).
- 5.30 If consent is not received then a Patents Form 49 is sent to the Caveat Clerk in Formalities asking to be informed when the Patent is published. Once it has been published then the Patent can be distributed and circulated in the normal way. Until it is published the electronic versions of the decision and abstract should be stored in the NOPI folder in the Hearings Library on SharePoint.

## **ORAL DECISIONS**

- 5.31 The HO may make an oral decision at the hearing. This may happen in cases where no transcript writer is present. In these cases the HO will provide a decision and annotate that an oral decision was given at the hearing. The decision will then be processed as normal.
- 5.32 Where an oral decision is given in the presence of a transcript writer, the transcript becomes a part of the decision. The hearings clerk should liaise with the HO to ensure that no NOPI information is in the transcript. Upload



the transcript to PDAX as HRG-TRANS or HEAR-TRAN-IP and annotated accordingly. The transcript will be issued to the parties with the decision and then processed as normal. If a transcript forms part of a decision then it must be forwarded to Webmaster with the decision to be published on the website.

## **NO APPEAL RECEIVED**

- 5.33 If no appeal is received by the set date, (see 5.16) the decision can be cleared from the hearing clerk's records.
- 5.34 The arrangement pack should be removed from the 'Awaiting Appeal Period' file. The Pro-Forma (Annex 10) should have been returned from the B3, see 5.19, if not request it from the B3. This will provide the instructions on how to proceed. A minute and message will be sent on PDAX to the Inter Partes case officer or the relevant Formalities group.
- 5.35 For ex-parte cases the date the decision was cleared should be entered on the Ex-Parte SharePoint List.
- 5.36 Remove all unnecessary information from the arrangement pack and dispose of as required. Store the remainder of the arrangement pack – usually just the arrangement sheet, decision checklist, proforma and any non-standard information - in the cleared decisions store. As this becomes full, remove and dispose of the oldest packs.

## **APPEAL RECEIVED**

- 5.37 See chapter 6.

## **BUNDLES**

- 5.38 For some *Inter Partes* hearings bundles consisting of copies of all the papers that may be required at the hearing are produced by the parties (see Chapter 4). These bundles are offered back to the parties.

5.39 Unless the parties request return of the bundles, the hearings clerk should destroy them once the appeal period has expired. **Note that the bundles are not to be confused with the original evidence filed in the proceedings, this will always stay with the case.**

## Annex 1

| <b>DECISION &amp; ABSTRACTS</b> |          |
|---------------------------------|----------|
| Patent number                   | OPI/NOPI |
| Party(s)                        |          |
| Appeal period over              | B/F date |

|  |        |
|--|--------|
| Add this checklist to the paper hearings pack for the case unless Sect.13  |        |
| Open the Decision in Word  |        |
| Go into the BL spreadsheet and allocate a BL number  |        |
| Insert the BL number on the Decision   | O/ /16 |
| Date the Decision the day it is issued   | / /    |
| Add the HO signature to the Decision   |        |
| Save the Decision to Sharepoint (IPO drive/hearings) as BLO/xxx/xx – check saved location and tag if necessary.  |        |
| Print copy(s) of the Decision with the signature on for the party(s).  |        |
| Save decision as PDF – import to dossier – check OPI/NOPI  |        |
| Delete the signature on the decision in Sharepoint & resave, print unsigned copies for BL, RPC & EPO if OPI<br><i>(If SPC print copy of unsigned decision for HO)</i>  |        |
| Update Sharepoint with the date the decision is issued and section of the Act – check OPI/NOPI   |        |
| Compose the letter to go out with decision, check if OPI, NOPI, Scottish, SPC, Design or section 13. CHECK appeal period on decision, print and then import to dossier (if NOPI leave status until decision is made OPI)<br><i>(If SPC print copy of letter(s) for HO and send with copy of unsigned decision)</i> |        |
| New mail to webmaster – click on the paperclip to attach the saved copy of the decision – CHECK NO SIGNATURE<br><small>(If decision is NOPI – do not send to webmaster unless notified by party(s) –always check with the HO before making OPI in case of redacted version as this will go on the website)</small> |        |
| Open the Abstract in word – no abstracts for design decisions  |        |
| Add the BL number and date   |        |
| Save to Sharepoint (IPO drive/hearings) as BLO/xxx/xx abstract – check saved location and tag if necessary.  |        |
| New mail to circulate – click on the paperclip to attach the decision and abstract<br><small>(If NOPI, state on email)</small>   |        |
| Set task for the <b>Next day</b> to put the abstract on the database and for the <b>following day</b> to check the website<br><small>(If NOPI – do not put abstract on until webmaster actioned)</small>   |        |
| Set task for appeal period plus 2 weeks – if no appeal – clear case.<br><small>(If NOPI – state on task to check when OPI, if OPI - re circulate the decision or redacted version, circulate externally) and clear case if no appeal lodged</small>  |        |
| <b>If the decision is a Section 13 – send a PDAX message to the Case Officer to ‘Clear Records &amp; Action’ the case.</b>   |        |
| <b>External circulation</b> – Mail signed copies to parties,<br>Mail unsigned copies to British Library, EPO and RPC editor - <b>NOT IF NOPI</b>   |        |
| Complete Clear Records Pro-Forma and pass to B3 – unless Sect. 13  |        |
| On BL Number Spreadsheet enter date sent   |        |

|   |  |
|---|--|
| <p><b>2<sup>nd</sup> day – put abstract on Decision database</b> if decision check notification is received from Webmaster. ( Section 13 are all IP) - <b>NOT IF NOPI</b></p>                                   |  |
| <p><b>3<sup>rd</sup> day - CHECK DECISION/SUMMARY ON WEB</b><br/> PDax – Enhance decision – OLF1 enhanced decision – <b>NOT IF NOPI</b></p>   |  |
| <p>Delete the Decision and abstract on Sharepoint if OPI, before dragging the e-mail into the cabinet. <b>If NOPI move to NOPI decisions folder.</b> Place hearing pack in 'awaiting appeal period' folder.</p> |  |

**Annex 2**  
**Decision letter NOPI**

**Your reference:** XXX

**Our reference:** 1R31/Name/GB/EP

Date

Dear Sirs

**Patent Number: GB/EP (Proprietor)**  
**Reference under Section XXX of the Patents Act 1977**

1. Please find enclosed a copy of a decision dated xxXXxx.
2. Decisions are normally made available for public inspection in full on our website. However, because this decision relates to an unpublished patent application, you are asked to let us know in writing **within 28 days of the date of this letter** whether you are content for us to publish the decision on our website. If nothing is received in writing from you, the decision will remain Not Open to Public Inspection until such time as the patent application is published.
3. The comptroller has declined to deal with these proceedings therefore under Civil Procedure Rule 63.11 any person seeking the court's determination of the reference needs to issue a claim form at the respective court within fourteen days of this decision. The claim form therefore needs to be filed at the court by (DATE – DECISION + 14 days). *Delete as appropriate – renumber paragraphs if necessary*

OR

3. As the decision has been in your favour, the application has been remitted to the examiner or other relevant case officer who will be in contact with you as required.

OR

3. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, an Appellants Notice (form N161) must be lodged with the Chancery Listings Office. Further details may be obtained from –

H M Courts & Tribunal Service  
Royal Courts of Justice Group  
Chancery Listings Office  
7 The Rolls Building  
Fetter Lane  
London

EC4A 1NL

Telephone no. 020 7947 6890/6294/6243/6690/7121/7717

4. Three copies of the Appellant's Notice must be lodged with the Listings Appeals Office (address above) together with the current fee, grounds of the appeal and a signed copy of the IPO decision within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. Please note that the Appellants Notice should be handed in to the Listing Office or as a last alternative posted to them. It should not be handed in to another court, e-mailed or faxed as this will result in long delays as the Listing Office cannot accept the Notice by these methods. **Any request for an extension to the appeal period identified in the decision must be made to the court.**

5. Once you have filed your appeal, you must send a copy of the sealed Appellant's Notice to both this office and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

6. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

A letter in identical terms is being sent to the other side. *(delete as required)*

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate

**Annex 3**  
**Decision letter OPI**

**Your reference:** XXX

**Our reference:** 1R31/Name/GB/EP

Date

Dear Sirs

**Patent Number: GB/EP (Proprietor)**  
**Reference under Section XXX of the Patents Act 1977**

1. Please find enclosed a copy of a decision dated xxXXxx.
2. The comptroller has declined to deal with these proceedings therefore under Civil Procedure Rule 63.11 any person seeking the court's determination of the reference needs to issue a claim form at the respective court within fourteen days of this decision. The claim form therefore needs to be filed at the court by (DATE – DECISION + 14 days). *Delete as appropriate – renumber paragraphs if necessary*

OR

2. As the decision has been in your favour, the application has been remitted to the examiner or other relevant case officer who will be in contact with you as required.

OR

2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, an Appellant's Notice (form N161) must be lodged with the Chancery Listings Office . Further details may be obtained from –

H M Courts & Tribunal Service  
Royal Courts of Justice Group  
Chancery Listings Office  
7 The Rolls Building  
Fetter Lane  
London  
EC4A 1NL

Telephone no. 020 7947 6690/6890/6294/6243/7121/7717

3. Three copies of the Appellants Notice must be lodged with the Listing Office (address above) together with the current fee, grounds of the appeal and a signed copy of the IPO decision within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. Please note that the Appellants Notice should be handed in to the Listing Office or as a last alternative posted to them. It should not

be handed in to another court, e-mailed or faxed as this will result in long delays as the Listing Office cannot accept the Notice by these methods. **Any request for an extension to the appeal period identified in the decision must be made to the court.**

4. Once you have filed your appeal, you must send a copy of the sealed Appellants Notice to both this office and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

A letter in identical terms is being sent to the other side.*(delete as required)*

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate



**Annex 4**  
**Decision letter Redacted**

**Your reference:** XXX

**Our reference:** 1R31/Name/GB/EP

Date

Dear Sirs

**Patent Number: GB/EP (Proprietor)**

**Reference under Section XXX of the Patents Act 1977**

Please find enclosed a copy of a decision dated xxXXxx.

The version is Open to Public Inspection, since it contains none of the sensitive information contained within the Not Open to Public Inspection version.

If I can be of any assistance please do not hesitate to contact me.

A letter in identical terms has been sent to the other side. (Delete as required)

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate

## Annex 5

### Decision letter Scottish court

Your reference:xxxx

Our reference: 1R31/Name/GBxxxxxxx

Date

Dear Sirs

**Patent Number :**  
**Reference under Section**

1. Please find enclosed a copy of a decision dated xxXXxx.
2. The Patents Act 1977 gives you the right to appeal to the Court of Session against the decision if you wish to do so. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the Court of Session, Parliament House, Parliament Square, Edinburgh, EH1 1RQ.
3. Copies of the Notice of Appeal must be lodged with the Court of Session (address above) together with the fee, within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
4. Once you have filed your appeal, you must send a copy of the sealed Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.
6. Decisions are normally made available for public inspection in full on our website. However, because this decision relates to an unpublished patent application, you are asked to let us know in writing **within 28 days of the date of this letter** whether you are content for us to publish the decision on our website. If nothing is received in writing from you, the decision will remain Not Open to Public Inspection until such time as the patent application is published. *(delete as required)*

A letter in identical terms is being sent to the other side. *(delete as required)*

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate

**Annex 6**  
**Decision letter Section 13**

**Your reference:** XXX

**Our reference:** 1R31/Name/GB/EP

Date

Dear Sirs

**Reference under Section 13 (XXX) of the Patents Act 1977**

Please find enclosed a copy of a decision dated xxXXxx.

If I can be of any other assistance please do not hesitate to contact me.

A letter in identical terms has been sent to the other side. *(Delete as required)*

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate

**Annex 7**  
**Decision letter SPC**

**Your reference:**

**Our reference:**

**Date:**

Dear

**SUPPLEMENTARY PROTECTION CERTIFICATES: REGULATION (EC) No 469/2009 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF THE EUROPEAN COMMUNITIES**

1. Please find enclosed a copy of a decision dated xxXXxx
2. Regulation 5 of the Patents (Compulsory Licensing and Supplementary Protection Certificates) Regulations 2007 extends the existing provisions of the Patents Act 1949 and 1977 to certificates. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedures Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, an Appellant's Notice (form N161) must be lodged with the Chancery Listings Office . Further details of which may be obtained from –

H M Courts & Tribunal Service  
Royal Courts of Justice Group  
Chancery Listings Office  
7 The Rolls Building  
Fetter Lane  
London  
EC4A 1NL

Telephone number 020 7947 6890/6294/6243/6690/7121/7717.

3. Three copies of the Appellant's Notice must be lodged with the Listings Office (address above) together with the current fee, grounds of the appeal and a signed copy of the IPO decision within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. Please note that the Appellants Notice should be handed in to the Listing Office or as a last alternative posted to them. It should not be handed in to another court, e-mailed or faxed as this will result in long delays as the Listing Office cannot accept the Notice by these methods. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
4. Once you have filed your appeal, you must send a copy of the sealed Appellants Notice to both this office and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate

**Annex 8**  
**Decision letter Design**

**Your Reference:**

**Our Reference:** 1R31/name/file reference

Date

Dear Sir

***Title in bold***

1. Please find enclosed a copy of a decision dated \*\*\*\*\*.
2. Decisions are normally made available for public inspection in full. If you are unhappy about any part of the decision being made public in this way (eg because it refers to commercially-confidential information) please let me know **within 28 days from the date of this letter**, explaining your concerns. If the hearing officer accepts your concerns, the decision will be made public in a suitably edited form.
3. The Copyright, Designs and Patents Act 1998 (as amended) gives you the right to appeal to the Chancery Division (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from –  
The Chancery Listing Office  
Rolls Building  
7 Rolls Building  
London  
EC4A 1NL  
(telephone 020 7947 7717)
4. Three copies of the Notice of Appeal must be lodged with the Chancery Listings Office (address above) together with the current fee **within the time period specified in the decision**. The latest date for appeal is therefore xxXXxx. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
5. Once you have filed your appeal, you must send a copy of the Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.
6. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

**[Bundles] (optional delete as necessary)**

7. I note that you produced bundles for use at the hearing. If you would like these returned to you please inform me before the end of the appeal period, otherwise, the bundles will be destroyed.

A letter in identical terms is being sent to the other side.

Yours faithfully

Name

Litigation Section

Patents Directorate.

**Annex 9**  
Deleted



**Annex 10**  
**CLEAR RECORDS PRO FORMA – OFFICE DECISIONS**

**PATENT NUMBER –**

**DECISION NUMBER –**

**DECISION DATE –**

**SECTION OF ACT –**

**APPEAL PERIOD EXPIRES –**

**B3 – Head of Litigation Section**

Susan Eaves

1. Update OPTICS and carry out Register Entries. If S13 case carry out clear records and publishing action.
2. Pass to Hearings Clerk

**Hearings Clerk**

Darran Cooke/Kathryn Jenkins

1. Ex Parte – If no appeal, return to relevant fmls group as:-  
  
Application refused – please terminate the application as of the date of the decision  
  
Application allowed – please refer to examiner or other responsible person
2. Inter Partes – If no appeal, return to relevant B2 case officer for clear records
3. Section 13 / Rule 10(2) – cleared by B3
4. Any other scenario (Specific Instructions required)

## CHAPTER 6

# APPEALS

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## Annexes

- Annex 1 Deleted
- Annex 2 Deleted
- Annex 3 Checklist on receipt of appeal
- Annex 4 Limited circulation list
- Annex 5 Listing of documents to be sent to GLD
- Annex 6 Letter to GLD
- Annex 7 Deleted
- Annex 8 Full circulation list
- Annex 9 OPTICS entry Proforma

## 6 APPEALS

### INTRODUCTION

6.01 If an applicant disagrees with an *ex-parte* decision, he can take the matter further by filing an appeal. *Inter partes* decisions can also be appealed.

#### Rules and appeal periods

6.02 Appeals relating to patents, Supplementary Protection Certificates (SPCs) and Design Right (subsistence/term/identity) are governed by Part 52 of the Civil Procedure Rules and the Practice Direction relating to Part 52. The appeal period as set by the Office is generally 28 days in accordance with Rule 52.4 paragraph (2)(a) unless stated otherwise in the decision document.

6.03 Appeals relating to Design Right Licence of Right cases are governed by the Appointed Person (Designs) Rules 2015.

6.04 Where a hearing has been held in Scotland and a decision is subsequently issued, Court of Session rules will apply.

#### Where should an appeal be filed?

6.05 Appeals relating to patents and SPCs should be filed at the Chancery Listings Office.

6.06 Due to changes under the Appointed Person (Designs) Rules 2015, the Hearings Clerk should refer to the B2 case officer for details on Design Right appeals relating to matters of subsistence, term and identity.

6.07 Due to changes under the Appointed Person (Designs) Rules 2015, the A3 should refer to the B2 case officer for details on Design Right Licence of Right appeals.

6.08 If a decision is issued following a hearing in Scotland, an appeal may be filed

with the Scottish Court of Session.

### Extending the appeal period

6.09 An application to extend the appeal period must be filed directly with the court. For appeals regarding Design Right, due to changes under the Appointed Person (Designs) Rules 2015, the Hearings Clerk should refer to the B2 case officer for details on appeal periods.

### Names of parties

6.10 The person who files the appeal is known as the appellant. The other side is known as the respondent.

### How to file an appeal

6.11 For patents and SPCs, three copies of a completed Notice of Appeal (Form N161) together with the current fee must be filed at the Chancery Listings Office.

6.12 The Notice of Appeals form can be obtained from the:

H M Courts & Tribunal Service  
Royal Courts of Justice Group  
Chancery Listings Office  
7 The Rolls Building  
Fetter Lane  
London  
EC4A 1NL

Tel: 020 7947 6890/6294/6243/6690/7121/7717

6.13 Deleted

### Additional actions by the appellant

6.14 The appellant is required to send a sealed copy of the Notice of Appeal to all

the parties involved in the proceedings, including the comptroller, as soon as practicable and at least within 7 days of filing the appeal.

6.15 Refer to paragraph 6.07.

## **CHECKLIST OF ACTIONS RELATING TO APPEALS**

6.16 See Annex 3 for a full checklist of actions that need to be carried out on receipt of an appeal.

## **ACTIONS ON RECEIPT OF A NOTICE OF APPEAL**

### Initial actions

The hearings clerk will:

6.17 Check the Notice of Appeal has been sealed and has been filed in time. A sealed document should contain a date stamp from the High Court worded “High Court Of Justice – Chancery Appeals”. If the notice has been sealed and filed in time the appeal may proceed. If not, liaise with GLD (Government Legal Department) to see if the appeal is proceeding.

### If the Notice is correctly filed

The hearings clerk will:

- Scan the Notice and any associated documents on to the dossier (Doc Code NTC-OF-APP or NTC-OF-AP-IP).
- Send an e-mail to the Divisional Director to appoint a hearing officer (HO) for the appeal. HOs are normally only appointed in Ex Parte cases. If an appeal is filed on an Inter Partes case, check with the Divisional Director to see if they want to appoint an HO.
- Send an email and PDAX message to the relevant HO to inform them that an appeal has been filed.

- If the appeal is in relation to an *ex parte* case, Counsel will need to be instructed. Email the Notice of Appeal and any supporting documents to GLD. This should be done immediately. GLD will brief Counsel. Counsel will represent us at the appeal.

Note: For *inter partes* appeals it isn't necessary to email documents to GLD as the comptroller is rarely represented in *inter partes* matters. Occasionally, however, the DD will advise that Counsel will be required.

- Update the SharePoint list to show an appeal has been filed, at the High Court. If the appeal is on an SPC case without a BL number, enter the details on the appeals part of the SharePoint list as these will not have been recorded originally.
- Add a file note to the relevant dossier(s) as follows to show an appeal has been filed: 'Appeal to the Patents Court filed on .....(insert date)'. If paper file ask the relevant formalities clerk to add to cover sheet. Pdax message the head of the relevant formalities group to say that an appeal has been received. If the case is an SPC send a copy of the appeal notice to the SPC formalities clerk for the paper file.
- Check that the decision being appealed has been entered on to OPTICS by the B3. If so make a free text register entry on OPTICS as follows: Notice of Appeal against the decision of the comptroller dated .....(insert date) was lodged with the Patents Court on .....(insert date).
- Advertise the appeal in the Journal: only where the full office decision is Open to Public Inspection (OPI). (Full details of Journal entries can be found in Chapter 26).
- Circulate that a Notice of Appeal has been received by email to the Hearing Officer for the original decision, the appointed Hearing Officer for the appeal, both Divisional Directors, the Patent Head of Admin, Head of Litigation and all members of the hearings team.
- Highlight that an appeal has been filed on the front cover of the dossier.

## BRIEFING COUNSEL

6.18 In *ex parte* cases, the comptroller will be represented by Counsel, instructed by GLD.

6.19 In general, the comptroller will not wish to be represented in appeals relating to *inter partes* cases, though he may be represented in exceptional circumstances in the capacity of an intervener.

6.20 If Counsel is to be briefed, they will require copies of certain documents on file. The Hearing Officer will liaise with GLD and may ask for documents to be sent or copied. Occasionally, the hearings clerk may be asked to produce a complete file following the instructions of the Hearing Officer.

6.21 To produce a file:

- The Hearing Officer will produce an Explanatory Memorandum (template on SharePoint) and a list of documents to be included.
- The hearings clerk will obtain prints of the necessary documents and place them in order on the file, the order should be –
  - Explanatory Memorandum
  - Notice of Appeal
  - Office decision that is being appealed
  - Other documents as indicated by the hearing officer in descending date order or as otherwise specified.
- An index should be produced in line with the tagging of the various documents and include a header note (Annex 5).
- Place a copy of the index and the Explanatory Memorandum on the dossier.
- The Explanatory Memorandum is always NOPI.
- The binder should be sent to GLD with a cover letter (Annex 6).
- As some of the folder will be NOPI ensure that the folder is sent to GLD by a secure method.



## **AWAITING THE APPEAL DATE**

6.22 We will usually be informed of the date of the appeal by GLD or occasionally by the Patent Court.

The hearings clerk will:

- In Inter Partes appeals we are usually given a hearing window. As there is not usually any direct involvement with GLD, the hearings clerk should monitor the court website.

[www.justice.gov.uk/about/hmcts](http://www.justice.gov.uk/about/hmcts)

Click on the 'Daily court lists', 'Patents Court Diary', 'Diary section 1'

- Contact the court for information.

It is advisable to email the court as the clerks are very busy and are rarely available to answer telephone calls.

## **ONCE THE DATE OF THE APPEAL IS KNOWN**

6.23 Initially a window of three days may be allocated by the court for the hearing of the appeal.

The hearings clerk will:

- Inform the HO and any other interested party in the Office once the window is known.
- Liaise with GLD on a regular basis to obtain a firm date for the appeal. Check the listings on the Court Service web site or telephone Chancery Listings (Tel: 0207 947 7383). The exact courtroom and time may not be known until the day before the appeal but once they are known, inform the HO and HA and any other interested party in the Office.

Note: The time of the appeal may be found on the Court Service website. The court room number will depend on who is hearing the case.

- Update the SharePoint list with the appeal date.
- Create a file note as follows: “Appeal to be held on ..... (insert date)” and add to the appropriate file. Import to dossier or place on the file cover.
- Enter date of appeal in the electronic diary.

## **AFTER THE APPEAL HEARING**

6.24 Following the appeal hearing, the hearings clerk will:

- Diary the case for one month to await a copy of the Court Judgement and Court Order.

### Initial actions

On receipt of the Court Judgement and/or Court Order the hearings clerk will:

- Scan the Court Judgement and/or Order to dossier or copy and place on file.

### Further actions

On receipt of the Court Judgement/Order, the hearings clerk will:

- Copy the Judgement/Order on to the dossier
- Message the HO through PDAX to let them know that the Judgement/Order has been received.
- Send a copy of the Order to Finance
- Action any instructions received from the hearing officer and circulate that the Court Judgement/Order has been received (see Annex 8). Even if the appeal has been withdrawn, the Judgement/Order must still be circulated. Send the B3 head of litigation a pro-forma indicating that an Order/Judgement has been received (Annex 9). When the Judgement/Order reaches the Head of

Litigation (B3) they will review the Order and will make an appropriate register entry on OPTICS.

- Prepare a Journal advert based on the register entry by the B3 (see Chapter 26).
- Import the advert on to the dossier.
- Add the PRECEDENT label to the front cover of the PDAX dossier.
- Update SharePoint

6.25 The Court Judgement may grant a party leave to appeal to the Court of Appeal. However, if leave to appeal is not granted, a party may still approach the Court of Appeal directly and request leave to appeal.

6.26 Only when it is clear that no appeal has been filed, should the case proceed to the clear records stage. (See Chapter 5 & Chapter 27)

## **COURT OF APPEAL**

6.27 If an appeal has been refused, the appellant may wish to take the matter further. For patent cases, this may mean filing an appeal at the Court of Appeal. Permission to appeal must be obtained from the Patents Court judge. If he refuses to grant leave to appeal, the appellant may apply directly to the Court of Appeal for permission to appeal.

## **ACTIONS ON RECEIPT OF NOTICE OF APPEAL TO COURT OF APPEAL**

### Initial actions

6.28 On receipt of a sealed copy of a Notice of Appeal to the Court of Appeal, the hearings clerk will:

- Scan to dossier or attach copies to the relevant paper files. (Doc code – NTC-OF-APP or NTC-OF-AP-IP, annotate as Notice of Appeal)

## Further actions

The hearings clerk will:

- Update the SharePoint list to show an appeal has been filed at the Court of Appeal
- Add a file note to the relevant file(s) as follows to show an appeal has been filed: 'Appeal to the Court of Appeal filed on .....(insert date)'. Inform formalities that a further appeal has been made.
- Make a free text register entry in OPTICS (where appropriate) as follows: Notice of Appeal against decision of the High Court dated..... (insert date) lodged with the Court of Appeal on ..... (insert date).
- Advertise the appeal in the Journal. [Full details of Journal entries can be found in Chapter 26].
- Import the advert to dossier.
- Send an email and/or PDAX message to the HO and to GLD to let them know that a further appeal has been filed.
- Circulate the Notice of Appeal and any supporting papers as before.
- Contact the parties or the Registry at the Court of Appeal (Tel: 0207 947 6890) to obtain a date for the Court of Appeal hearing since we will not always be told unless we are a party to the proceedings. Or liase with GLD.
- Check the file regularly and inform all interested parties in the Office of any developments.
- Liaise with the Court of Appeal as to procedure.

6.29 Liaise with GLD and follow the instructions of the HO if any further action is required.

## **AFTER THE COURT OF APPEAL HEARING**

The hearings clerk will:

6.30 On receipt of the Judgement and/or Order from the Court of Appeal, follow the procedures outlined above for appeals to the High Court (see 6.24).

6.31 The Court Judgement may grant a party leave to appeal to the Supreme Court. However, if leave to appeal is not granted, a party may still approach the Supreme Court directly and request leave to appeal.

6.32 Only when it is clear that no appeal has been filed, should the case proceed to the clear records stage. (See Chapter 5 & Chapter 27)

**APPEAL TO THE COURT OF APPEAL AGAINST AN ORDER OF THE HIGH COURT FOR REVOCATION OF A PATENT (CPR PART 52 Practice Direction PARAGRAPH 21.2)**

6.33 Where an appeal lies to the Court of Appeal from an Order for revocation of a patent, the appellant must send a copy of the Notice of the Appeal to the other side (the respondent) and also to the comptroller. If the respondent decides not to oppose the appeal or attend the appeal hearing, he must serve a notice of that decision (together with the other papers in the Appeal) on the comptroller.

6.34 On receipt of the Notice from the respondent, Patents Litigation Team 1 will:

- Contact the Deputy Director and enquire whether he will be attending the appeal hearing.
- Within 14 days of receipt of the Notice, send a letter to the appellant advising him whether the comptroller will be attending the hearing and import to dossier.

6.35 The comptroller may attend the appeal hearing and oppose the appeal in any case where he has written to the appellant informing him that he will be attending the appeal and in any other case (including a case where the respondent withdraws his opposition to the appeal during the hearing) if the Court of Appeal directs or permits.

## THE SUPREME COURT

- 6.36 The procedure will be similar to that for Court of Appeal hearings, except that all contact will be made with the Offices of the Supreme Court (Tel: 0207 960 1991) and normally the HO and HA will attend the sitting. (NB. A special pass will be needed to gain access to the Supreme Court). If at any time before the hearing of the appeal the respondent(s) decide not to appeal or to oppose the appeal, they may be required to serve notice on the comptroller and the appellants.

### Leapfrog procedure

Where in any proceedings in the High Court a person appeals or seeks permission to appeal to a court other than the Court of Appeal, that person must obtain a “leapfrog” certificate in order to bypass the Court of Appeal and appeal directly to the Supreme Court. The relevant conditions are that a point of law of general public importance is involved in the judge’s decision. (Supreme Court Practice Directions para 3.6.4). An application for a certificate may be made by any of the parties to any civil proceedings in the High Court. The application should be made immediately after the trial judge gives judgement in the proceedings. The judge may grant a certificate if he is satisfied that the relevant conditions are fulfilled and that all parties consent to the grant of a certificate. Notice of intention to present an appeal, with a copy of the petition to appeal, must be served on the comptroller as well as on the respondents. If at any time before the hearing of the appeal the respondents decide not to file an acknowledgement to oppose the appeal, they must without delay serve notice of their decision on the Comptroller and on the appeal court. Any such notice served on the Comptroller must be accompanied by a copy of the petition under section 32 of the 1949 Act or of the statements of case in the claim and the affidavits filed therein. The Comptroller must, within 14 days of receiving notice of the respondents’ decision, serve on the appellant and file a notice stating whether or not he intends to file an acknowledgement. The Comptroller may appear and be heard in opposition to the appeal in any case where he has given notice of his

intention to appear, and in any other case (including a particular case where the respondents withdraw opposition to the appeal during the hearing) if the court so directs or allows. (Supreme Court Practice Directions – 8.11.3 to 8.11.5)

## **JUDICIAL REVIEW**

6.38 Judicial review is another route by which decisions of the comptroller can be challenged. (For example, *B Knight v Comptroller* [2007] EWHC 2264). Applications for judicial review are dealt with in the High Court and require leave (permission) of the court. The court will not normally grant leave where there is another avenue of appeal.

6.39 The initial procedures are generally similar to those for *ex parte* appeals.

## **INITIAL ACTIONS ON RECEIPT OF APPLICATION FOR JUDICIAL REVIEW**

### Initial actions

6.40 When an application is received the hearings clerk will:

- Scan to dossier or attach copies to the relevant paper files.

### Further actions

6.41 The hearings clerk will:

- Notify the relevant HO immediately and enquire whether the documents received should be emailed to GLD.
- Update the SharePoint list to show that a judicial review has been filed.
- Make a free text register entry on OPTICS as follows: “Application for judicial review lodged with the Patents Court on .....”.
- Advertise the application in the Journal .
- Ensure regular instruction is taken from the HO.

6.42 When the review is finalised, the hearings clerk will:

- Update the SharePoint list with the outcome and add a file note to the file
- Make a register entry and prepare and arrange an advert for the patents & designs journal and import to dossier. The B3 will advise.



## **Annex 1**

Deleted

## **Annex 2**

Deleted

### Annex 3

|                |  |                    |  |
|----------------|--|--------------------|--|
| Patent No.     |  | Date Lodged        |  |
| Court case no. |  | PDAX or Paper file |  |
| Appeal HO      |  | Original HO        |  |
| Case Name      |  |                    |  |

| <b>Notice of Appeal received</b> |   |  |
|----------------------------------|---|--|
| <b>1</b>                         | Is the notice properly sealed? No – appellant contacted<br>Yes – file located, copied and put on file   |  |
| <b>2</b>                         | Has the notice been filed in time? No – court/appellant contacted<br>Yes - continue   |  |
| <b>3</b>                         | If inter partes has HO/DD given direction to instruct counsel?<br>No – go to 6 Yes - continue   |  |
| <b>4</b>                         | <b>All ex parte</b> (DD will inform us if needed for Inter Partes)<br>Notice of appeal & supporting docs <b>e-mailed same day</b> to GLD  |  |
| <b>5</b>                         | Email HO with details – HO appointed by DD  |  |
| <b>6</b>                         | <b>If SPC paper file</b> – send a copy of the appeal notice to the SPC formalities clerk<br><b>PDAX</b> minutes updated with appeal lodged – message to head of formalities group |  |
| <b>7</b>                         | Details recorded on SharePoint  |  |
| <b>8</b>                         | Check that appeal notice and supporting documents on dossier/file   |  |
| <b>9</b>                         | Optics checked for decision entry, if present enter Appeal notice   |  |
| <b>10</b>                        | PDJ notice – <i>Check NOPI</i>  |  |
| <b>11</b>                        | Circulate that appeal notice received (annex 4)   |  |
| <b>Briefing Counsel</b>          |   |  |
| <b>12</b>                        | Action taken from HO minute/instruction   |  |
| <b>13</b>                        | Parts of dossier copied as instructed by HO   |  |
| <b>14</b>                        | Covering document (Annex 5 of manual) prepared and copy put on document file and dossier if required  |  |
| <b>15</b>                        | Documents sent to GLD on instruction of HO  |  |
| <b>Obtaining Hearing Date</b>    |   |  |
| <b>16</b>                        | Monitor court website, GLD will normally inform us  |  |
| <b>Date of Appeal Known</b>      |   |  |
| <b>17</b>                        | HO & other interested parties informed & calendars updated  |  |
| <b>18</b>                        | SharePoint updated  |  |
| <b>19</b>                        | Dossier/proceedings file & appeal folder minuted  |  |
| <b>20</b>                        | Liase with GLD, HO to ensure that all necessary docs and arrangements are ready for the appeal  |  |
| <b>After the Appeal Hearing</b>  |   |  |
| <b>21</b>                        | Note appeal date on SharePoint  |  |
| <b>22</b>                        | Judgement/order received copied & put on dossier/file   |  |
| <b>23</b>                        | Copy of order to finance if costs awarded to office on decision   |  |
| <b>24</b>                        | SharePoint updated  |  |
| <b>25</b>                        | Circulate that order and/or judgement has been received(full circulation)   |  |
| <b>26</b>                        | Check that B3 has updated Optics  |  |
| <b>27</b>                        | PDJ notice – <i>check NOPI</i>  |  |
| <b>28</b>                        | Notice of Appeal to the Court of Appeal received? No – clear records, inform formalities<br>Yes - continue  |  |

| <b>Court of Appeal</b>                              |  |  |
|---|--|--|
| <b>29</b>   | Notice copied & put on dossier/file – notify formalities of further appeal                     |  |
| <b>30</b>   | SharePoint updated   |  |
| <b>31</b>   | Appeal notice circulated (full circulation)  |  |
| <b>32</b>   | Optics updated (A3)  |  |
| <b>33</b>   | PDJ notice - <i>check NOPI</i>   |  |
| <b>34</b>   | Liase with GLD re: date  |  |
| <b>35</b>   | HO , HA & other interested parties informed  |  |
| <b>36</b>   | Liase with GLD, HO to ensure that all necessary docs and arrangements are ready for the appeal |  |
| <b>After the Court of Appeal Hearing</b>            |  |  |
| <b>37</b>   | Judgement/order received copied & put on dossier/file – copy of Order to finance               |  |
| <b>38</b>   | SharePoint updated   |  |
| <b>39</b>   | Circulated (full circulation)  |  |
| <b>40</b>   | Check that Optics updated by B3  |  |
| <b>41</b>   | PDJ notice – <i>check NOPI</i>   |  |
| <b>42</b>   | Appeal to the House of Lords    No – clear records, inform formalities<br>Yes - continue       |  |
| <b>Supreme Court</b>                                |  |  |
| NOTE: HO & HA will normally attend                  |  |  |
| <b>43</b>   | Notice copied & put on dossier/file – notify formalities of further appeal                     |  |
| <b>44</b>   | SharePoint updated   |  |
| <b>45</b>   | Circulated (full circulation)  |  |
| <b>46</b>   | Optics updated (A3)  |  |
| <b>47</b>   | PDJ notice - <i>check NOPI</i>   |  |
| <b>48</b>   | Date obtained for hearing – Liase with GLD   |  |
| <b>49</b>   | HO, HA & other interested parties informed   |  |
| <b>50</b>   | Liase with GLD, HO to ensure that all necessary docs and arrangements are ready for the appeal |  |
| <b>After the Supreme Court Hearing</b>              |  |  |
| <b>51</b>   | Judgement/order received copied & put on dossier/file – copy of Order to finance               |  |
| <b>52</b>   | SharePoint updated   |  |
| <b>53</b>   | Circulated (full circulation)  |  |
| <b>54</b>   | Optics updated by B3   |  |
| <b>55</b>   | PDJ notice – <i>check NOPI</i>   |  |
| <b>56</b>   | Appeal for Judicial Review    No – clear records, inform formalities<br>Yes - continue         |  |
| <b>Judicial Review - refer to Litigation Manual</b> |  |  |

**Annex 4**  
**Limited circulation list**

**APPEAL LODGED**

**Name of the part(y)ies:**

**Patent Number(s):**

**A notice of Appeal was lodged with the Patent Court on ..... against the decision of the Hearing Officer dated.....**

**The Appeal will be heard on/The Appeal date needs to be confirmed (amend as appropriate).**

Send to -

- 1) Hearing Officer for the Appeal
- 2) Hearing Officer for the Decision
- 3) Divisional Director
- 4) Divisional Director
- 5) B3
- 6) C2
- 7) Litigation Section Manager
- 8) Hearings Team

**Annex 5**  
**Listing of documents for Government Legal Department**

**Patent Application Number GB..... ((name).....)**

A notice of appeal against the decision dated ....., whereby the comptroller refused the application under Section..... of the..... Act....., was lodged with the..... Court on..... The date of the appeal hearing has not yet been finalised.

Please find enclosed the following documents for reference:

An explanatory memorandum prepared by the Patent Office for the comptroller's Counsel and the associated pages of the Manual of Patent Practice.

A numbered set of papers for Counsel relating to the proceedings.

(NB The following is an example of the sort of documents that might be included)

1. Official letter dated xxXXxx.
3. Official letter dated xxXXxx.
4. Letter from Name received xxXXxx.
7. Official letter to Name dated xxXXxx.
8. Letter from Name received xxXXxx.
9. Official letter dated xxXXxx.
12. Letter from Name received xxXXxx.
13. Official letter to Name dated xxXXxx.
14. Letter from Name dated xxXXxx.
15. Official letter to Name dated xxXXxx.
24. Office decision dated xxXXxx and transcript of hearing dated xxXXxx
25. Notice of appeal dated xxXXxx.
26. Explanatory Memorandum dated xxXXxx and accompanying background information

**Annex 6  
Letter to GLD**

Government Legal Department  
1 Kemble Street  
LONDON  
WC2B 4TS

**Your Reference:**  
**Our Reference: 1R31/Name/ File Reference**

Dear Sir(s)

**Appeal** -.....

1. Please find a copy of the papers relating to the above appeal.
2. The Hearing Officer/examiner (xxxxxxx) would like to draw your attention to:  
(xxxxxxxxxxxxxxxxxx).
3. xxxxxxxx will be attending the hearing for the Office.

Yours faithfully

Name(Hearings Clerk)  
Litigation Section  
Patents Directorate

Deleted

## **Annex 7**



**Annex 8**  
**Full circulation list**

**APPEAL HEARD**

The Appeal was heard on..... in the .....  
regarding the decision of the Hearing Officer dated ..... Please see  
copy of Order/Judgement on the dossier/file.

Send to -

- 1) HO: .....
- 2) HA: .....
- 3) Divisional Director (if not HO)
- 4) Divisional Director (if not HO)
- 5) Deputy Director (inter partes team)
- 6) Deputy Director (inter partes team)
- 7) Deputy Director (inter partes team)
- 8) Deputy Director (inter partes team)
- 9) Editor MOPP
- 10) Litigation Manager
- 11) Hearings Team

**Annex 9**

**OPTICS entry PRO FORMA  
– Appeals (Orders and Judgements)**

**PATENT NUMBER –**

**DECISION NUMBER –**

**DECISION DATE –**

An **ORDER** and/or **JUDGEMENT** has been received in the above case, it has been placed on the dossier.

Please can you complete the below the line OPTICS entry so that we can continue to process the case.

Once the OPTICS entry case, please pass this form back to -

## CHAPTER 7

### SECTIONS 8, 10, 12, & 37 ENTITLEMENT

|   |             |
|---|-------------|
| Introduction  | 7.01 - 7.07 |
| Initial Action  | 7.08 - 7.10 |
| Formal Requirements   | 7.08 - 7.09 |
| Statement of grounds  | 7.11 - 7.26 |
| What should the statement of grounds contain?   | 7.11 - 7.18 |
| What happens if the statement of grounds does not comply?                             | 7.19 - 7.24 |
| Serving the statement of grounds  | 7.25        |
| Conversion of a section 8 reference into a section 37 reference                       | 7.26        |
| Counter-statement   | 7.27        |
| Management of proceedings   | 7.28        |
| Evidence rounds   | 7.29        |
| Decision  | 7.30 - 7.34 |
| Updating the Register (B3 action) - free text entries<br>(below the line)             | 7.31 - 7.32 |
| Updating the Register (B3 action) - adding proprietor's details<br>(above the line)   | 7.33        |
| Updating the Register (B3 action) - removing proprietor's details<br>(above the line) | 7.34        |
| Registration of assignments   | 7.35        |
| Termination/withdrawal of GB patent applications before publication                   | 7.36        |

#### Annexes

Annex 1 Letter issued on grant of patent: section 8 to section 37

## 7 SECTIONS 8, 10, 12 & 37

### INTRODUCTION

7.01 Within the Patents Act 1977, three sections deal specifically with the question of who is entitled to a patent or patent application. These are:

- **Section 8** which relates to GB patents that have not yet been granted and applies whether or not a patent application, has been filed.
- **Section 12** which relates to patents under foreign or international law which have not yet been granted
- **Section 37** which relates to patents granted under the Patents Act 1977.

7.02 Where a European patent application is concerned, section 82 lays down the jurisdiction of the court and the comptroller to determine such questions. Thus before proceeding with an EP reference under section 12, the B2/B3 should check section 82 provides the appropriate jurisdiction.

7.03 A granted European patent designating the UK, that is a European patent (UK), is treated as if it were a patent under the 1977 Act resulting from an application made under the 1977 Act. Questions with regard to entitlement may therefore be referred to the comptroller under section 37.

7.04 Section 12 applies to applications under the Patent Co-operation Treaty (PCT), during the international phase while section 8 applies during the national phase (see section 89B(4) of the Patents Act 1977).

7.05 In addition to these sections, section 10 of the Act provides that certain disputes between joint applicants for a patent may be resolved by the comptroller on request from any of the parties involved.

- 7.06 Occasionally entitlement references refer to sections 9 and 82 of the Patents Act 1977. These do not provide for proceedings to be filed. Rather they simply affect the extent to which the other sections are applicable.
- 7.07 The procedures in relation to entitlement actions and for requests made under section 10 or section 12(4) by a joint applicant, are set out in the Patents Rules 2007.

## **INITIAL ACTION**

### Formal Requirements

- 7.08 Follow procedures at 1.04 to 1.07.
- 7.09 Upon checking the Form 2 if any of the applications listed are unpublished the proceedings may still be deemed to be OPI if any of the other published applications or patents listed in section 2 of the form claim priority from the unpublished applications. If proceedings are held to be NOPI then no adverts should be prepared for the Patents Journal.

### Action by Litigation

- 7.10 Using the OPTICS function REG ENT, the appropriate free text entry in relation to a reference under section 8, 12 and 37 is as follows:

Reference as to entitlement under Section xx. filed on xxxxxx

Where a request is made under section 10 or section 12(4), the free text entry should read:

Request by joint applicants for directions under Section xx filed  
on xxxxxxxx

## **STATEMENT OF GROUNDS**

### What should the statement of grounds contain?

7.11 Follow procedures in paragraphs 1.11 to 1.12.

#### Relief under section 8

7.12 For a reference made under section 8(1), the comptroller will determine the question and will make such orders as he thinks fit to give effect to the determination (See section 8(2)).

7.13 Where a question is referred to the comptroller under section 8(1)(a), section 8(3) provides, at the discretion of the comptroller, for the making of a new application by the claimant when the original application is no longer proceeding or no longer contains the matter to which the claimant is held to be entitled. The question of third party terms may need to be raised and considered.

7.14 Where a person refers a question under section 8(1)(b), the comptroller may make an order giving directions to any person in relation to transferring or granting any right in or under the application.

#### Relief under section 12

7.15 For a reference under section 12(1)(a) or 12(1)(b), the comptroller may make such orders as he thinks fit to give effect to the determination; however, the extent to which the comptroller is able to determine the question may be affected by a number of factors, for example, the particular foreign or international law under which the application has been made and the stage reached in the prosecution of the application.

#### Relief under section 37

7.16 For a reference under section 37(1)(a),(b) or (c), the comptroller may again

determine the question and make such orders as he thinks fit. Examples of the type of relief available are mentioned in section 37(2).

7.17 Whilst a reference may be referred to the comptroller under section 37 at any time after the publication of the mention of its grant, the remedies available may be restricted if the reference is made more than two years after the mention of grant (section 37(5)). In such circumstances, although, for example, the claimant may claim a proprietary interest, the HO may not make an order that satisfies the relief sought.

#### Section 10, 12 (4)

7.18 For a request made under section 10 or 12(4), the statement should again set out fully the facts relied upon and also the directions sought. Under section 10 of the Act, the comptroller may give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which the application should proceed or both as the case requires.

#### What happens if the statement does not comply?

7.19 Follow procedures at 1.13 to 1.18.

7.20 Where the reference has been made under section 8(1)(a) or 12(1)(a), the letter pointing out the defects in the statement should be copied for example to:

- any person (other than the claimant) alleged in the reference to be entitled to be granted a patent for the invention
- any person, not being a party to the reference, who is shown in the register as having a right in or under the patent
- where the application for the patent has not been published, any person who is an applicant for the patent or has given notice to the comptroller of a relevant transaction, instrument or event

- every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention. Note:- The claimant should not receive copies of letters sent to the named inventors for applications that are unpublished.
- any other persons who it appears are likely to have an interest in the case

7.21 Where the reference has been made under section 8(1)(b) or 12(1)(b), the letter should be copied for example to:

- each proprietor who is not a party to the reference and who has not otherwise indicated his consent to the making of the order sought
- any person to whom it is alleged in the reference that any right in or under an application for a patent should be transferred or granted
- any person not being a party to the reference, who is shown in the register as having a right in or under the patent application
- where the application for the patent has not been published, any person (not being a party to the reference) who has given notice to the comptroller of a relevant transaction, instrument or event
- every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention. Note:- The claimant should not receive copies of letters sent to the named inventors for applications that are unpublished.
- any other persons who it appears are likely to have an interest in the case

7.22 Where the reference is made under section 37(1), the letter should be copied for example to:

- a person who is shown on the register as having any right in or under the patent
- a person who is alleged in the reference to be entitled to a right in or



under the patent

- any other person who it appears is likely to have an interest in the case

7.23 Where a request is made under section 10 or section 12(4), the letter should be copied to each joint applicant and anyone else likely to have an interest in the case.

7.24 A covering letter should be sent with the copy letter. This should point out to the parties concerned that they are not being invited to file a counter-statement until the issues raised with the claimant have been resolved.

#### Serving the Statement of Grounds

7.25 Follow procedures at 1.19 - 1.24

#### Conversion of a Section 8 Reference into a Section 37 Reference

7.26 Occasionally a reference under section 8 will need to be converted to one under section 37 because the patent application in question has proceeded to grant. A letter should be sent to the claimant and copied to the other side (see Annex 1 and Chapter 16). If entitlement proceedings are filed between the date on which the grant letter is issued and the date on which the notice of grant appears in the Journal, no action can be taken under either section 8 or 37. Instead, the proceedings should be treated as having been filed under section 37 on the date on which the notice of grant appears in the Journal.

**PDAX:-** Letter is created and imported using manual import (doc code is LETTER-IP)

#### **COUNTER-STATEMENT**

7.27 Follow procedures at 1.25 to 1.26.

## MANAGEMENT OF PROCEEDINGS

7.28 Follow procedures at 1.28 to 1.40

## EVIDENCE ROUNDS

7.29 Follow procedures at 1.41 to 1.53.

## DECISION

7.30 Follow procedures at 1.54 to 1.55.

### Updating the Register (B3 action) - free text entries (below the line):

7.31 If the reference has been allowed:

- use REG ENT free text and type in a register entry. Examples are below:

In a decision of the comptroller dated (day/month/year) [insert name] was removed as a named proprietor of the patent.

In a decision of the comptroller dated (day/month/year), the comptroller ordered that [insert name and address] should be named as joint applicant/proprietor

7.32 If the reference is refused:

- use REG ENT free text and type in a register entry as in the following example:

In a decision of the comptroller dated (day/month/year), the reference under section XX filed on (day/month/year), was refused.

### Updating the Register (B3 action) - adding proprietor's details (above the line):

#### 7.33

- Check if the proprietor you wish to add has an ADP number - use OPTICS function SEA NAM.
- If no ADP number exists, contact Ex Parte Team 1 who will arrange for one to be created. The person's/company's full name and address need to be supplied.
- Use OPTICS function CHA ROL. . Scroll through the CHA ROL 1 screens inserting Y at the bottom of each page.
- On screen CHA ROL 2, enter in Role Code 1, the start date (the date of the decision) and the ADP number of the person/company you are adding. When this is confirmed, the name and address details should appear on screen. Once this is confirmed as correct, the update is complete.
- To check this, go back into the CHA ROL 1 screen. The added proprietor details should also appear on the DIS FUL print

### Updating the Register (B3 action) - removing proprietor's details (above the line):

#### 7.34

- Use OPTICS function CHA ROL. Rather than removing details from the register, the action taken will close them down. On screen CHA ROL 1, insert end date. This should be the date of the Hearing/Office decision and should be the same date as referred to in the free text entry initially carried out.

Note: The screen on which the free text register entry is typed provides an option to move directly to the CHA ROL screens. Simply change the Roles to Record to Y. From the following pages, select the appropriate options.

## **REGISTRATION OF ASSIGNMENTS WITHIN ENTITLEMENT PROCEEDINGS**

7.35 Where entitlement proceedings are pending before the comptroller, a

request to register an assignment should be referred to a HO. Unless special circumstances apply, the HO will direct the B2 to contact the claimant to determine if he is content with the registration. If the claimant is not content, the registration should be stayed until the proceedings have been settled. The assignment request will be recorded on the register.

**PDAX:-** Minute is created

Create and send message to HO. Message is PSM

Letter created and imported (doc code is LETTER-IP).

## **WITHDRAWAL/TERMINATION OF GB PATENT APPLICATIONS BEFORE PUBLICATION**

Follow procedures in chapter 16, (16.35 to 16.37).

## **Annex 1**

### **Letter issued on grant of patent**

**Your Reference:**

**Our Reference: 1R31/name/number ref**

**Date**

Dear Sirs

**Title**

1. Patent application number..... has now been granted.
2. By virtue of section 9 of the Patents Act 1977, we will treat the entitlement reference you have made under section 8 as though it had been made under section 37. This may affect the relief available to you if you are successful, but should not otherwise affect the course of the proceedings. Unless I hear from you or the defendant to the contrary, I shall assume you are both happy to defer dealing with the question of relief until the substantive hearing
3. A letter in identical terms is being sent to the other side.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

## CHAPTER 8

### SECTION 13 MENTION OF INVENTOR

|   |             |
|---|-------------|
| Introduction  | 8.01 - 8.05 |
| Initial Action  | 8.06 - 8.13 |
| Formal Requirements   | 8.06 - 8.11 |
| Action by Litigation  | 8.12 – 8.13 |
| Statement of grounds  | 8.14 - 8.22 |
| What should the statement of grounds contain?                             | 8.14        |
| What happens if the statement of grounds does not comply?                 | 8.15 - 8.17 |
| Serving the statement of grounds  | 8.18 - 8.19 |
| Unopposed applications  | 8.20 - 8.22 |
| Counter-statement   | 8.23        |
| Management of proceedings   | 8.24        |
| Evidence rounds   | 8.25        |
| Decision  | 8.26 - 8.33 |
| Updating the Register - free text entries (below the line)                | 8.27 - 8.30 |
| Updating the Register - adding an inventors details<br>(above the line)   | 8.31        |
| Updating the Register - removing an inventors details<br>(above the line) | 8.32        |
| <br>  |             |
| Annexes   |             |
| <br>  |             |
| Annex 1 Example of decision (application unopposed)                       |             |

## 8 SECTION 13

### INTRODUCTION

- 8.01 Section 13 of the Patents Act 1977 concerns the right of an inventor to be mentioned in an application or a patent (rule 10(2) of section 13), the obligation on the patent applicant to identify the inventor(s) (section 13(2)), and the right of any person to object to a mentioned inventor. (section 13(3)).
- 8.02 The invention to which a patent or an application relates is determined by the claims. Since these may be amended, it is possible that a person may be entitled to be named as an inventor in the published application but not in the granted patent.
- 8.03 Litigation Section deals with the procedural aspects of disputes arising from inventorship i.e. section 13 (rule 10(2)) and section 13(3)). The procedures governing such disputes are laid down in the Patents Rules 2007. Disputes arising under section 13(1) are filed as an application under rule 10(2) of the Patents Rules 2007.
- 8.04 (Deleted)
- 8.05 In the case of an application for a European patent (UK), inventorship details may be corrected before the EPO under rule 19 of the European Patent Convention. An application under rule 10(2) and 13(3) may be made once the grant of a patent has been mentioned in the European Patent Bulletin. An application may be made under section 13(3) either before or after mention of grant of a patent in the European Patent Bulletin. However, if the application is made before the grant, the relief available in respect of a published application is limited (see section 78(2)).

## INITIAL ACTION

### Formal Requirements

8.06 Section 13 provides that:

*The inventor or joint inventors of an invention shall have the right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.*

8.07 In other words, an application may be made under rule 10(2) to add an inventor or inventors. Under the Patents Rules, any person may make an application; that is, any person may allege that any other person should have been mentioned as an inventor or joint inventor in any patent granted or any published application for a patent for the invention (see rule 10(4)).

8.08 Section 13(3) provides that:

*Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and, if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.*

8.09 In other words, if an inventor or joint inventor is shown on the register and it is considered that he should not be named as such, an application can be made under section 13(3) for a certificate to that effect. If a certificate is issued (it will be in the form of a decision), the register will be altered and any copies of the patent subsequently distributed, will be amended.

8.10 Any person may make such an application under section 13(3).



8.11 Follow the procedures at 1.04 to 1.07.

### Action by Litigation

8.12 Deleted

8.13 Using the OPTICS function REG ENT, the appropriate free text entry is made by the B3 as follows:

For section 13: (adding an inventor)

‘Application under rule 10(2) for inventor to be mentioned filed on.....’

For section 13(3): (removing an inventor)

‘Application under section 13(3) for a person not to be mentioned as an inventor filed on .....

## **STATEMENT OF GROUNDS**

### What should the statement contain?

8.14 Follow procedures at 1.11 to 1.12.

### What happens if the statement does not comply

8.15 Follow procedures at 1.13 to 1.18

8.16 The letter sent to the claimant pointing out the defects in the statement should be copied for example to:

- every person registered as proprietor of, or applicant for, the patent
- every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention
- every other person whose interests the comptroller considers may be affected by the application

8.17 A covering letter should be sent with the copy letter. This should point out to

the parties that they are not being invited to file a counter-statement until the issues raised with the claimant have been resolved.

**PDAX:-** Letter is created and imported using manual import (doc code is LETTER-IP)

### Serving the Statement of Grounds

- 8.18 Follow the procedures at 1.19 - 1.24.
- 8.19 The B2/B3 should send a copy of the statement and Form 2 to those referred to in para 8.16 above other than the applicants under rule 10(2) or 13(3) and any other person who has consented in writing to the application.

### Unopposed applications

- 8.20 If those invited to file a counter-statement do not do so within the time allowed or subsequently confirm in writing that they do not oppose the application filed, the comptroller will allow the application and will issue a decision accordingly (see annex 1).
- 8.21 The procedure may be simplified even further if, when the application is filed, the applicant provides written consent from all parties involved. If an application under rule 10(2) and/or 13(3) is considered unopposed, the B3 should issue a decision to that effect. An example of a decision is included at annex 1. The decision and a summary should be sent to the Hearings Clerk by email (Decisions&Abstracts email box). The Hearings Clerk should be asked to send a PDAX message to the relevant B2 case officer to clear the case once the decision has been issued.
- 8.22 It should be noted that there may be circumstances where it may not be appropriate to file formal proceedings to remove an inventor or joint inventor under section 13(3) because essentially there may not be a dispute. As a result of filing an amendment relating to a published patent application, for example, the contribution made by a particular inventor may be deleted.

While the inventor may be correctly named in the published patent application, it may not be appropriate to name him as such in any patent granted for the invention. Once an amendment has been accepted, if all parties agree that a person should not now be mentioned as an inventor, the Office would not mention him as such in any patent granted for the invention. If the question of inventorship was in dispute, and this was the only matter outstanding, this would not prevent the amended application from proceeding to grant. It would mean however that an application under section 13(3) may be filed in order to resolve the dispute.

## **THE COUNTER-STATEMENT**

8.23 Follow procedures at 1.25 to 1.26.

## **MANAGEMENT OF PROCEEDINGS**

8.24 Follow procedures at 1.28 to 1.40.

## **EVIDENCE ROUNDS**

8.25 Follow procedures at 1.41 to 1.53.

## **DECISION**

8.26 Follow the procedures at 1.54 to 1.56. See also 8.21 above concerning clearing an uncontested application.

### Updating the Register (B3 action) - free text entries (below the line):

8.27 If an application under rule 10(2) is allowed:

- use REG ENT free text and type a register entry in line with the example below:

In a decision of the comptroller dated day, month, year, the application filed on day, month, year, under rule 10(2) was allowed. The comptroller ordered that [insert name and address details] should be

named as a joint inventor.

8.28 If an application under rule 10(2) is refused:

- use REG ENT free text and type a register entry as follows:

In a decision of the comptroller dated day, month, year, the application under rule 10(2) filed on day, month, year, was refused.

8.29 If an application under section 13(3) is allowed:

- use REG ENT free text and type a register entry in line with the following example:

In a decision of the comptroller dated day, month year, the application filed on day, month, year, under section 13(3) was allowed. The comptroller ordered that [name of inventor] should not be mentioned as an inventor.

8.30 If an application under section 13(3) is refused:

- use REG ENT free text and type a register entry as follows:

In a decision of the comptroller dated day, month, year, the application under Section 13(3) filed on day, month, year, was refused.

If the application relates to rule 10(2) and section 13(3), the register entry should record both outcomes.

#### Updating the register (B3 action) - adding an inventor's details:

8.31 When updating the register as a result of a rule 10(2) application being allowed, the B3 should:

- Check if the inventor being added already has an ADP number - use OPTICS function SEA NAM
- If no ADP number exists, contact Team 1 who will arrange for one to be created. The person's full name and address details

will need to be supplied

- On receipt of the ADP number, use OPTICS function CHA ROL. From the CHA ROL 1 screen, make a note of the start date of the other inventor(s) mentioned. Scroll through the rest of the screens inserting Y at the bottom.
- On screen CHA ROL 2, enter in Role Code 2, the start date and the ADP number of the person being added. When this is confirmed, the name and address details should appear on screen. Once this is confirmed as correct, the update is complete.
- To check this, go back into the CHA ROL 1 screen. The added inventor details should also appear on the DIS FUL print.

#### Updating the Register (B3 action) - removing an inventor's details

8.32 When updating the Register as a result of a section 13(3) application being allowed, the B3 should:

- Use OPTICS function CHA ROL. Rather than removing details from the register, the action taken will close them down. On screen CHA ROL 1 insert end date. This should be the day prior to the start date and will remove the inventor from the register completely.

Note: The screen on which the free text register entry is typed provides an option to move directly to the CHA ROL screens. Simply change the Roles to Record to Y. From the following pages, select the appropriate options.

**Annex 1**  
**Example of Decision (application unopposed)**

BLO/000/00  
Date

**PATENTS ACT 1977**

**PARTIES**

Insert name  
of parties

**ISSUE**

Whether (insert name )should be mentioned  
as sole inventor in patent number  
GB(\*\*\*\*\*) as a result of an application  
Under section 13 (rule 10(2)) and 13(3)

**HEARING OFFICER**

Insert name

---

**DECISION**

- 1 Patents Form 7 names one inventor; (insert name of inventor).
  
- 2 (Insert name), the patent proprietors, have applied to have (insert names) named as sole inventor in accordance with rule 10(2) of the Patent Rules 2007 and have made an application under section 13(3) of the Act to the effect that (insert name) should not have been mentioned as an inventor.
  
- 3 (Insert name) and (insert name) have both provided written consent to the application filed under rule 10(2) and section 13(3). I therefore conclude that all the relevant parties agree that (insert name) should be named as sole inventor in the published patent application and granted patent for the invention

- 4 Accordingly I find that (insert name) should be mentioned as the sole inventor in the published patent application and granted patent for the invention. I also direct, in accordance with rule 10(1), that an addendum slip be prepared for the published patent application and for the granted patent for the invention. The slip will mention (insert name) as sole inventor and state that (insert name) should not have been named as an inventor.
  
- 5 This decision serves as a certificate, issued in accordance with section 13(3), to the effect that (insert name) should not have been mentioned as an inventor in the published patent application and granted patent for the invention.

(Insert Hearing Officers name)

(Insert Job Title), acting for the comptroller

## CHAPTER 9

# OPPOSITIONS

|   |             |
|---|-------------|
| Section 27(5) Opposition to amendment of specification after grant        | 9.01 - 9.11 |
| Serving the notice of opposition  | 9.06        |
| Counter-statement   | 9.07        |
| Management of proceedings   | 9.08        |
| Evidence rounds   | 9.09        |
| Further amendments during opposition proceedings                          | 9.10        |
| Withdrawal of opposition  | 9.11        |
| <br>  |             |
| Section 29(2) Opposition to surrender of patent                           | 9.12 - 9.20 |
| Serving the notice of opposition  | 9.16        |
| Counter-statement   | 9.17        |
| Management of proceedings   | 9.18        |
| Evidence rounds   | 9.19        |
| Revocation v Surrender  | 9.20        |
| <br>  |             |
| Section 47(6) Opposition to cancellation of licence available as of right | 9.21 - 9.29 |
| Serving the notice of opposition  | 9.26        |
| Counter-statement   | 9.27        |
| Management of proceedings   | 9.28        |
| Evidence rounds   | 9.29        |
| <br>  |             |
| Section 117(2) Opposition to correction of errors in granted patent       | 9.30 - 9.38 |
| Serving the notice of opposition  | 9.34        |
| Counter-statement   | 9.35        |
| Management of proceedings   | 9.36        |
| Evidence rounds   | 9.37        |
| Withdrawal of opposition  | 9.38        |



## 9 OPPOSITIONS

### SECTION 27(5) OPPOSITION TO AMENDMENT OF SPECIFICATION AFTER GRANT (For amendments under section 27 see Chapter 17)

- 9.01 Any person may oppose an amendment made under section 27. There is no need for an attorney to identify a claimant for whom he is acting (*Sanders Associates Patent BL 0/89/81*).
- 9.02 Notice of opposition should be given on Patents Form 15. This should be filed within four weeks of the date of advertisement of details of the amendments in the Journal. **This period can not be extended.**
- 9.03 Two copies of Patents Form 15 should be filed along with two copies of a statement of grounds setting out fully the facts and grounds on which the claimant relies and the remedy which he is seeking.
- 9.04 The statement of grounds needs to be verified by a statement of truth.
- 9.05 B3 to follow procedures at 1.04 to 1.07.

#### Serving the notice of opposition (see also Chapters 1 and 2)

- 9.06 The B3 should send a copy of the Patents Form 15 and the supporting statement to the applicant applying for the amendment. In the proceedings he will be known as the defendant. (See also procedures set out at 1.19 to 1.24).

#### Counter-statement

- 9.07 Follow procedures at 1.25 to 1.26.

## Management of proceedings

9.08 If a counter-statement is filed with no offer of alternative amendments, then follow the procedures at 1.28 to 1.40.

## Evidence rounds

9.09 Follow procedures at 1.41 to 1.53 (see also Chapter 3)

## Further amendments during opposition proceedings

9.10 If a defendant wishes to offer alternative amendments, he should include them in the counter-statement. He also needs to make it clear whether the offer is a firm one or is conditional upon an adverse finding on the originally requested amendments. The offer should be referred to the Head of Examination Group of the subject matter who will direct the subsequent procedure. He will give his prima facie view on admissibility (MOPP 27.14). If the form of amendments differ materially from the original form, they should be advertised for opposition. The claimant will be allowed to file a supplementary statement opposing the new amendments. If a form of amendments acceptable to the parties and the office is not arrived at, the matter will need to be decided at a hearing (see MOPP section 27). The Deputy Director may direct that the evidence rounds are completed first, in which case refer to Chapters 1 and 3.

**PDAX:-** Minute is created

Create and send message to DD. Message = PSM

Advert is created and imported (doc code is ADVERT-IP)

Supplementary statement is scanned into PDAX (doc code is C-SUP STAT)

### Withdrawal of opposition

- 9.11 Where an opposition has been properly filed but the claimant later withdraws the opposition, the comptroller will take account of matters raised in deciding whether to exercise discretion to allow the amendments.

### **SECTION 29(2) OPPOSITION TO SURRENDER OF PATENT (For surrender under section 29 see Chapter 18)**

- 9.12 Any person may oppose the surrender of a patent under section 29(2).
- 9.13 Notice of opposition should be given on Patents Form 15. This should be filed within four weeks of the date of the advertisement for opposition in the Journal. **This period can not be extended.**
- 9.14 Two copies of Patents Form 15 should be filed along with two copies of a statement setting out fully the facts and grounds on which the claimant relies and the remedy which he is seeking.
- 9.15 The statement of grounds needs to be verified by a statement of truth.

B3 to follow procedures at 1.04 to 1.07.

### Serving the notice of opposition (see also Chapters 1 and 2)

- 9.16 The B3 should send a copy of Patents Form 15 and the supporting statement to the patent proprietor. In the proceedings he will be known as the defendant.

### Counter-statement

- 9.17 Follow procedures at 1.25 to 1.26.

## Management of proceedings

9.18 Follow procedures at 1.28 to 1.40.

## Evidence rounds

9.19 Follow procedures at 1.41 to 1.53.

## Revocation v Surrender

9.20 If proceedings under section 72 to revoke the patent are pending before the comptroller, any opposition to surrender will normally be stayed pending the outcome of the revocation action (see MOPP section 72).

## **SECTION 47(6) OPPOSITION TO CANCELLATION OF LICENCE AVAILABLE AS OF RIGHT (where the application was made by the proprietor of the patent)**

9.21 Applications under section 47(1) or (3) for cancellation of a licences of right entry in the patents register may be opposed.

9.22 Where the application for cancellation is by the proprietor of the patent under section 47(1), any person may make such an opposition. Where the application is under section 47(3), only the proprietor of the patent in question may oppose the cancellation (section 47(6)).

9.23 Every application under section 47(1) or (3) is advertised in the Journal. Notice of opposition to the cancellation of an entry should be given on Patents Form 15. This should be filed within four weeks of the date of advertisement in the Journal. **This period can not be extended.**

9.24 Two copies of Patents Form 15 should be filed along with two copies of a statement of grounds setting out fully the facts upon which the claimant relies and the remedy which he is seeking.

9.25 The statement of grounds needs to be verified by a statement of truth.

B3 to follow procedures at 1.04 to 1.07.

#### Serving the notice of opposition (see also Chapters 1 and 2)

9.26 The B3 should send a copy of the Patents Form 15 and the supporting statement to the applicant for cancellation. In the proceedings he will be known as the defendant. (See also procedures set out at 1.19 to 1.24).

#### Counter-statement

9.27 Follow procedures at 1.25 to 1.26.

#### Management of proceedings

9.28 Follow procedures at 1.28 to 1.40.

#### Evidence rounds

9.29 Follow procedures at 1.41 to 1.53.

### **SECTION 117(2) OPPOSITION TO CORRECTION OF ERROR IN GRANTED PATENT (For correction of errors in patents and specifications see Chapter 24)**

9.30 Where the comptroller is requested to correct such an error or mistake, any person may oppose the request.

9.31 Notice of opposition should be given on Patents Form 15. This should be filed within four weeks of the date of advertisement of details of the correction in the Journal. **This period can not be extended.**

9.32 Two copies of Patents Form 15 should be filed along with two copies of a statement of grounds setting out fully the facts and grounds on which the claimant relies and the remedy which he is seeking.

9.33 The statement of grounds must be directed solely to the allowability of the correction. In particular, the validity of the patent may not be put at issue (section 74(2)).

B3 to follow procedures at 1.04 to 1.07.

#### Serving the notice of opposition (see also Chapters 1 and 2)

9.34 The B3 should send a copy of the Patents Form15 and the supporting statement to the applicant applying for the correction. In the proceedings he will be known as the defendant. (See also procedures set out at 1.19 to 1.24).

#### Counter-statement

9.35 Follow procedures at 1.25 to 1.26.

#### Management of proceedings

9.36 Follow procedures at 1.28 to 1.40.

#### Evidence rounds

9.37 Follow procedures at 1.41 to 1.53.

#### Withdrawal of opposition

9.38 Where an opposition has been properly filed, but the claimant subsequently withdraws the opposition, the comptroller will take account of matters raised

in deciding whether the correction is allowable. If no agreement is reached with the applicant, an *ex parte* hearing is held.

## CHAPTER 10

### SECTION 40 COMPENSATION OF EMPLOYEES FOR CERTAIN INVENTIONS

|  |               |
|--|---------------|
| Introduction   | 10.01         |
| Making an application                                      | 10.02 - 10.05 |
| Who may apply?   | 10.02         |
| To whom should the application be addressed?               | 10.03         |
| Which type of patents can a section 40 application relate? | 10.04         |
| Period during which an application may be made             | 10.05         |
| Public Inspection  | 10.06         |
| Initial Action   | 10.07 - 10.08 |
| Formal Requirements  | 10.07         |
| Deleted  | 10.08         |
| Statement of Grounds                                       | 10.09 - 10.11 |
| What should the statement of grounds contain?              | 10.09         |
| What happens if the statement of grounds does not comply?  | 10.10         |
| Serving the statement of grounds                           | 10.11         |
| Counter-statement  | 10.12         |
| Management of proceedings                                  | 10.13         |
| Evidence rounds  | 10.14         |
| Decision   | 10.15         |



## 10 COMPENSATION OF EMPLOYEES FOR CERTAIN INVENTIONS

### INTRODUCTION

10.01 Section 40 provides for the Court or the comptroller to award compensation to be paid by an employer to an employee in respect of an invention made by the employee, in certain circumstances.

### MAKING AN APPLICATION

#### Who may apply?

10.02 The employee is the person who can apply. He should be named as inventor of the patent. If he has not been named, he will need to file an application under rule 10(2).

#### To whom should the application be addressed?

10.03 The application should be made with reference to the employer not the current proprietors. The employer may be a different person from the current proprietors (*Fellermans Application* (BL 0/11/96)). If there is any confusion on this point, it will need to be addressed in the early stages of the proceedings.

#### Which type of patents can a section 40 application relate to?

10.04 The patent must be a granted patent. Foreign patents as well as GB patents may be the subject of an application. More than one patent may be mentioned on the Patents Form 2.

#### Period during which an application may be made

10.05 The application may be made at any time from the date of grant of the patent until one year after the patent has ceased to have effect (rule 91(1)). If, after failure to pay a renewal fee, a request is made for restoration of the patent under section 28 then:

- if the patent is restored, the period continues as if these events did not occur or
- if the restoration is refused, the period expires either one year after the patent ceased to have effect or six months after the refusal, whichever is the later.

## **PUBLIC INSPECTION**

10.06 Documents filed in section 40 proceedings are not open to public inspection. Decisions are not open to public inspection for 28 days, pending comments by the parties concerning any parts of the decision for which confidentiality is requested. The comptroller may then issue a redacted version of the decision. This is open to public inspection.

## **INITIAL ACTION**

### Formal Requirements

10.07 Follow procedures at 1.04 to 1.07. The B3 should inform the B2 that the proceedings are NOPI.

### Action by Litigation Assistant A1

10.08 Deleted

## **STATEMENT OF GROUNDS**

### What should the statement of grounds contain?

10.09 Follow procedures at 1.11 to 1.12.

**PDAX:-**The B2 should select the Litigation Proceedings, S40 and NOPI labels within the Inter Partes procedure for the relevant dossier.

What happens if the statement of grounds does not comply?

10.10 Follow procedures at 1.13 to 1.18

**PDAX:-**Letters created and imported into the PDAX dossier should be shown as NOPI.

Serving the Statement of Grounds

10.11 Follow procedures at 1.19 to 1.24. A copy of the application should also be served on the employer mentioned in Patents Form 2.

**PDAX:-**Letter created and imported into the PDAX dossier should be shown as NOPI.

**COUNTER-STATEMENT**

10.12 Follow procedures at 1.25 to 1.26.

**PDAX:-**The Indexing and Scanning Request Sheet should show that the counter-statement should be indexed as NOPI.

**MANAGEMENT OF PROCEEDINGS**

10.13 Follow procedures at 1.28 to 1.40.

**PDAX:-** All documents created and received should be indexed as NOPI.

**EVIDENCE ROUNDS**

10.14 Follow procedures at 1.41 to 1.53.

**PDAX:-**All documents created and received should be indexed as NOPI.

## **DECISION**

10.15 Follow procedures at 1.54 to 1.56. See also 10.06 above and 5.12 – 5.14, 5.28 – 5.30.

## CHAPTER 11

### SECTION 46 SETTLEMENT OF TERMS OF LICENCE OF RIGHT

|  |               |
|--|---------------|
| Introduction   | 11.01 - 11.03 |
| Who may apply?   | 11.02         |
| Circumstances in which an application may be made                | 11.03         |
| <br>   |               |
| Proceedings started by patent proprietor                         | 11.04 - 11.12 |
| Making an application  | 11.04         |
| Initial Action   | 11.05 - 11.06 |
| Formal Requirements  | 11.05         |
| Deleted  | 11.06         |
| Statement of Grounds   | 11.07 - 11.09 |
| What should the statement of grounds contain?                    | 11.07         |
| What happens if the statement of grounds does not comply?        | 11.08         |
| Serving the statement of grounds                                 | 11.09         |
| Counter-statement  | 11.10         |
| Management of proceedings  | 11.11         |
| Evidence rounds  | 11.12         |
| Decision   | 11.13         |
| <br>   |               |
| Proceedings started by a person other than the patent proprietor |               |
| Making an application  | 11.14         |
| Initial Action   | 11.15 - 11.16 |
| Formal requirements  | 11.15         |
| Deleted  | 11.16         |
| Notifying the patent proprietor                                  | 11.17         |
| Statement of Grounds   | 11.18 - 11.21 |
| What should the statement of grounds contain?                    | 11.18         |

|   |       |
|---|-------|
| What happens if the statement of grounds does not comply?                   | 11.19 |
| What happens if the patent proprietor does not file a statement of grounds? | 11.20 |
| Serving the statement of grounds  | 11.21 |
| Counter-statement   | 11.22 |
| Management of proceedings   | 11.23 |
| Evidence rounds   | 11.24 |
| Decision  | 11.25 |

# 11 SETTLEMENT OF TERMS OF LICENCE OF RIGHT

## INTRODUCTION

11.01 When licences under a patent are available as of right, any person may apply to the Comptroller for settlement of terms of a licence, under section 46(3).

### Who may apply?

11.02 Any person, including the proprietor, may apply.

### Circumstances in which an application may be made

11.03 If, following a voluntary request by the proprietors under section 46(1), licences of right have been made available, an application under section 46(3) may be made if the parties cannot decide on the terms of the licence between themselves.

## PROCEEDINGS STARTED BY PATENT PROPRIETOR

### Making an application

11.04 An application should be made on Patents Form 2 and should be accompanied by two copies of the draft licence the applicant proposes should be granted (see rule 89(1)).

## INITIAL ACTION

### Formal Requirements

11.05 Follow procedures at 1.04 to 1.07.

### Action by Litigation Assistant A1

11.06 Deleted

## **STATEMENT OF GROUNDS**

What should the statement of grounds contain?

11.07 Follow procedures at 1.11 to 1.12.

What happens if the statement of grounds does not comply?

11.08 Follow procedures at 1.13 to 1.18

Serving the Statement of Grounds

11.09 Follow procedures at 1.19 to 1.20.

## **COUNTER-STATEMENT**

11.10 Follow procedures at 1.25 to 1.26.

## **MANAGEMENT OF PROCEEDINGS**

11.11 Follow procedures at 1.28 to 1.40.

## **EVIDENCE ROUNDS**

11.12 Follow procedures at 1.41 to 1.53.

## **DECISION**

11.13 Follow procedures at 1.54 to 1.56.



## **PROCEEDINGS STARTED BY A PERSON OTHER THAN THE PATENT PROPRIETOR**

### Making an application

11.14 An application should be made on Patents Form 2 and should be accompanied by two copies of the draft licence the applicant proposes should be granted (see rule 89(1)).

## **INITIAL ACTION**

### Formal Requirements

11.15 Follow procedures at 1.04 to 1.07.

### Action by Litigation Assistant A1

11.16 Deleted

## **NOTIFYING THE PATENT PROPRIETOR**

11.17 The B3 should notify the proprietor of the patent that an application has been made and should send a copy of the licence with the notification (see rule 89(2) and (3)). The proprietor should be given a period of six weeks to file a statement of grounds.

**PDAX:-** Letter is created in Word and imported (doc code is LETTER-IP)

## **STATEMENT OF GROUNDS**

### What should the statement of grounds contain?

11.18 Follow procedures at 1.11 to 1.12.

What happens if the statement of grounds does not comply?

11.19 Follow procedures at 1.13 to 1.18

What happens if the patent proprietor does not file a statement of grounds?

11.20 If the patent proprietor does not file a statement of grounds, he will be treated as supporting the applicant's case (see rule 89(5)).

Serving the Statement of Grounds

11.21 Follow procedures at 1.19 to 1.20. The patent proprietor will be the claimant and the applicant will be the defendant (see rule 89(6)).

**COUNTER-STATEMENT**

11.22 Follow procedures at 1.25 to 1.26.

**MANAGEMENT OF PROCEEDINGS**

11.23 Follow procedures at 1.28 to 1.40.

**EVIDENCE ROUNDS**

11.24 Follow procedures at 1.41 to 1.53.

**DECISION**

11.25 Follow procedures at 1.54 to 1.56.

## CHAPTER 12

### SECTION 48 COMPULSORY LICENCES

|  |               |
|--|---------------|
| Introduction   | 12.01 - 12.03 |
| Who may apply?   | 12.02         |
| Period during which an application may be made           | 12.03         |
| Initial Action   | 12.04 - 12.05 |
| Formal Requirements                                      | 12.04         |
| Deleted  | 12.05         |
| Statement of Grounds                                     | 12.06 - 12.13 |
| What should the statement of grounds contain?            | 12.06 - 12.07 |
| WTO (World Trade Organisation)                           |               |
| Proprietors  | 12.08 - 12.10 |
| Non-WTO (World Trade Organisation) Proprietors           | 12.11 - 12.12 |
| What happens if the statement of grounds does not comply | 12.13         |
| Advertising the application                              | 12.14         |
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| Updating the Register – free text entries                | 12.27         |
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## 12 COMPULSORY LICENCES

### INTRODUCTION

12.01 Under section 48, applications may be made to the Comptroller for him to:

- a) order the grant of a licence under a patent or
- b) make an entry in the register making licences under a patent available as of right.

The grounds on which an application may be made are set out in section 48A(1) if the patent proprietor is a World Trade Organisation proprietor (as defined in section 48(5)). For proprietors who are not World Trade Organisation proprietors, the grounds are set out in section 48B(1).

The Patents & Trade Marks (World Trade Organisation) Regulations 1999 replaced the previous section 48 with the current sections 48, 48A and 48B with effect from 29 July 1999. The amendments bring the section more clearly in line with Articles 30 and 31 of the GATT Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) (1994).

#### Who may apply?

12.02 Any person may apply for a licence, including an existing licensee (section 48(1)).

#### Period during which an application may be made

12.03 An application may be made at any time after three years from the date of grant of the patent (Section 48(1)).

## **INITIAL ACTION**

### Formal Requirements

12.04 Follow procedures at 1.04 to 1.07. However please note the following additional actions. Before the B3 serves the case, the B2 prepares an initial advert and an opposition advert for the Patents and Designs Journal (see para. 12.14). The B2 will then refer the case back to the B3 for the purposes of serving. The B3 will notify the proprietor and any interested parties of the appearance of the opposition advert in the Patents and Designs Journal at the same time as the Form 2 and the statement of case are served. The proprietor and any interested parties are invited to file a counterstatement if they wish to oppose the proceedings (see para. 12.21) or they may choose to file a Form 15. (See Annex 1)

### Action by Litigation Assistant (A1)

12.05 Deleted.

## **STATEMENT OF GROUNDS**

### What should the statement of grounds contain?

12.06 Follow procedures at 1.11 to 1.12.

12.07 The statement should set out the grounds on which the application is made; these should be one or more of those specified in section 48A(1) or section 48B(1).

### WTO (World Trade Organisation) Proprietors

12.08 The grounds under section 48A(1) apply when the proprietor is a WTO (World Trade Organisation) proprietor. The latter is defined in section 48(5):

## **Section 48(5)**

*A proprietor is a WTO proprietor for the purposes of this section and sections 48A, 48B, 50 and 52 below if-*

**(a)** *he is a national of, or is domiciled in, a country which is a member of the World Trade Organisation; or*

**(b)** *he has a real and effective industrial or commercial establishment in such a country.*

12.09 The grounds under section 48A are concerned with demand for a product being met on reasonable terms.

12.10 Section 48A(2)-(6) places certain restrictions on orders or entries in the register in respect of certain grounds under section 48A(1).

### Non-WTO (World Trade Organisation) Proprietors

12.11 The grounds under section 48B(1) apply when the proprietor is a not a WTO proprietor. They are concerned with whether or not the invention is being worked or sufficiently worked.

12.12 Section 48B(2)-(5) places certain restrictions on orders or entries in the register in respect of certain grounds under section 48B(1).

### What happens if the statement of grounds does not comply?

12.13 Follow procedures at 1.13 to 1.18

## ADVERTISING THE APPLICATION

12.14 The application should be advertised in the Journal for opposition purposes (see rule 75).

**PDAX:-** Advert is created in Word and imported (doc code is ADVERT-IP)

## OPPOSITION

12.15 Any person may oppose the application (see sections 52(1) and 52(2)(b) and rule 76(3)(c)).

12.16 Notice of opposition should be given on Patents Form 15. This should be filed within four weeks of the date of the advertisement of the application in the Journal. **This period cannot be extended.** (See rule 76(2)(b)).

12.17 Two copies of Patents Form 15 should be filed along with two copies of a statement setting out fully the facts and grounds on which the claimant relies and the remedy which he is seeking. (See rule 76(1) and (4)).

12.18 The statement of grounds needs to be verified by a statement of truth (rule 76).

12.19 Follow procedures at 1.06 to 1.18

Serving the notice of opposition (see also Chapters 1 and 2)

12.20 Follow procedure for Patents Form 2 set out in paragraph 1.19.

## COUNTER - STATEMENT

12.21 Follow procedures at 1.25 to 1.26.

## **MANAGEMENT OF PROCEEDINGS**

12.22 Follow procedures at 1.28 to 1.40.

## **EVIDENCE ROUNDS**

12.23 Follow procedures at 1.41 to 1.53.

## **DECISION**

12.24 Follow procedures at 1.54 to 1.56.

12.25 If an application under section 48(1)(a) is allowed, the Comptroller may order under section 48(2)(a) the grant of a licence to the claimant on such terms as he thinks fit (see section 49). In settling the terms of any licence ordered, particular notice is taken of the provisions of sections 50 and 48A or 48B as appropriate. The royalty for a compulsory licence under section 48 should be one which would be negotiated between a willing licensor and a willing licensee.

12.26 If an application under section 48(1)(b) is allowed, the Comptroller may order under section 48(2)(b) that an entry be made on the register to the effect that licences under the patent are available as of right. If an application is refused, the patent is unaffected.

### Updating the Register - free text entries

12.27 Using OPTICS, a free text entry should be made reflecting the decision as shown below:

In a decision of the comptroller dated ..... the application filed on ..... under section 48 for a compulsory licence/licence of right was allowed/refused. (Delete/insert text as necessary).



## **Annex 1**

**Your Reference:**

**Our Reference:** 1R31/name/number ref

**Date**

Dear Sirs

**Title**

1. Please find enclosed the following:

These documents have been sent to you as you are shown in the register as the proprietor of the patent – see rule 77(1) of the Patents Rules 2007. The Patents Rules are available on our website at

<https://www.gov.uk/government/publications/the-patents-rules-2007-and-patents-fees-rules-2007>

### **Counterstatement**

2. The application has been advertised for opposition in the Patents & Designs Journal xxxx dated xxXXxx and the period for filing any opposition is within four weeks from the date of publication of the Journal. Should you wish to do so, you may oppose the proceedings by filing a counterstatement (rule 77(5)). The counterstatement should be filed in duplicate and in accordance with the requirements of rule 78.

3. Your counterstatement should be filed by xxXXxx.

4. If you do not file a counterstatement, we will take it that you support the claimant's case (see rule 77(9)). However, we will not treat you as a party to the proceedings and we will not send you copies of any documents filed in connection

with this matter.

**Additional information**

5. Further information relating to proceedings before the comptroller may be found in the enclosed booklet entitled "Patents:deciding disputes". Alternatively please contact (Name of Case Officer) on (Telephone: 01633 81xxxx)

6. A copy of this letter has been sent today to the claimants for information.

Yours faithfully

Name

Litigation Section

Patents Directorate

## CHAPTER 13

|   |
|---|
| <p style="text-align: center;"><b>SECTION 71</b></p> <p style="text-align: center;"><b>DECLARATION AS TO NON<br/>INFRINGEMENT</b></p> |
|---|

|   |               |
|---|---------------|
| Introduction  | 13.01 - 13.04 |
| Initial action  | 13.05 - 13.07 |
| Formal requirements   | 13.05         |
| Deleted   | 13.06 - 13.07 |
| Statement of Grounds  | 13.07 - 13.12 |
| What should the statement of grounds contain?                             | 13.07 - 13.10 |
| What happens if the statement does not comply?                            | 13.11         |
| Serving the statement of grounds  | 13.12         |
| Counter-statement   | 13.13         |
| Management of proceedings   | 13.14         |
| Evidence rounds   | 13.15         |
| Decision  | 13.16 - 13.20 |
| Updating the register (B3 action) - free text entries<br>(below the line) | 13.17 - 13.19 |
| Clear records action  | 13.20         |

## **13 DECLARATION AS TO NON-INFRINGEMENT**

### **INTRODUCTION**

13.01 This section provides for the making of a declaration that an act does not, or a proposed act would not, constitute an infringement of a granted patent.

13.02 Before an application can be made under section 71 the person seeking the declaration must-

(a) apply in writing to the proprietor for a written acknowledgement to the effect of the declaration claimed and must furnish him with full particulars in writing of the act in question and

(b) confirm that the proprietor has refused or failed to give any such acknowledgement.

13.03 If the proprietor refuses or does not give the acknowledgement sought, then an application for a declaration may be made to the Comptroller.

13.04 Where proceedings are pending in the court under any of sections 58, 61, 69, 70, 71 or 72, no proceedings may be instigated before the comptroller under section 71 without the leave of the court. However, court proceedings for infringement of a patent may be stayed pending the outcome of proceedings under sections 71 and 72 before the comptroller.

### **INITIAL ACTION**

#### Formal Requirements

13.05 Follow the procedures at 1.04 to 1.07.

#### Action by Litigation Assistant A1

13.06 Deleted.

## STATEMENT OF GROUNDS

### What should the statement of grounds contain?

- 13.07 Follow procedures at 1.11 to 1.12.
- 13.08 The statement of grounds should also indicate that subparagraphs (a) and (b) of section 71(1) have been complied with.
- 13.09 It is not always easy to establish that the requirements of section 71(1)(a) have been complied with and this can often result in a delay with the case. It is important that the claimant gives precise and complete information in relation to the article, process, etc which is alleged not to infringe the patent. However, the provision is satisfied by providing a sample of the alleged non-infringing article providing that its inspection by competent persons will make clear all aspects of the device material to the question of infringement. Also a description to be read in conjunction with a detailed drawing will suffice.
- PDAX:** Physical exhibits should be taken to Index and Scanning to be recorded on PDAX. The physical exhibit should be retained by the B2 until the proceedings have been finalised. It should then be returned to Index and Scanning for appropriate storage.
- 13.10 Although implicit in the application, the relief sought should be stated explicitly in the statement in order to assist the HO at a later date.

### What happens if the statement does not comply

- 13.11 Follow procedures at 1.13 to 1.18

### Serving the Statement of Grounds

- 13.12 Follow the procedures at 1.19 - 1.20.

## **THE COUNTER-STATEMENT**

13.13 Follow procedures at 1.25 to 1.26.

## **MANAGEMENT OF PROCEEDINGS**

13.14 Follow procedures at 1.28 to 1.40.

## **EVIDENCE ROUNDS**

13.15 Follow procedures at 1.41 to 1.53.

## **DECISION**

13.16 Follow the procedures at 1.54 to 1.55.

### Updating the register (B3 action) - free text entries (below the line)

13.17 If the application has been allowed:

- use REG ENT free text and type in a register entry as follows:

*“In a decision of the comptroller dated xxxxxxxx, the application under section 71 for a declaration of non-infringement filed on xxxxxxxx, was allowed”.*

13.18 If the application has not been properly launched:

- use REG ENT free text and type in a register entry as follows:

*“In a decision of the comptroller dated xxxxxxxx the application under section 71 filed on xxxxxxxx was deemed not to have been properly launched”.*

13.19 If the application has been refused:

- use REG ENT free text and type in a register entry as follows:

*“In a decision of the Comptroller dated xxxxxxxx, the application under section 71 filed on xxxxxxxx, was refused.”*

#### Clear records action

13.20 As well as the actions listed in 1.47, if a sample of an alleged infringing article has been filed, place a minute on PDAX to show that the sample filed has been sent to Indexing and Scanning to arrange storage e.g.

“Sample of ..... filed on ..... sent to I&S to arrange storage on .....”.(For action on receipt of an alleged infringing article see 1.46)

## CHAPTER 14

### SECTION 72 APPLICATION FOR REVOCATION

|   |               |
|---|---------------|
| Introduction  | 14.01 - 14.03 |
| What are the grounds for an application?                                  | 14.03         |
| Initial action  | 14.04 - 14.05 |
| Formal requirements   | 14.04         |
| Deleted   | 14.05         |
| Statement of Grounds  | 14.07 - 14.15 |
| What should the statement of grounds contain?                             | 14.07 - 14.10 |
| What happens if the statement does not comply?                            | 14.11         |
| Revocation under section 72(1)(b) - patent granted to person not entitled | 14.12 - 14.14 |
| Serving the statement of grounds  | 14.15         |
| Counter-statement   | 14.16         |
| Amendment   | 14.17 - 14.33 |
| Offer to amend under section 75   | 14.17 - 14.19 |
| EPC 2000 – Central Limitation Process                                     | 14.20         |
| Directions for the electronic delivery of amendments                      | 14.21 - 14.23 |
| Action on receipt of amendments   | 14.24 - 14.28 |
| Opposition to amendments  | 14.29         |
| Advertising amendments  | 14.30         |
| Revocation proceedings and amendments under section 75                    | 14.31         |
| Amendment of the application, statement or counter-statement              | 14.32         |
| Admission of new grounds  | 14.33         |
| Reference to the Hearing Officer  | 14.34         |
| Management of proceedings   | 14.35         |
| Evidence rounds   | 14.36         |
| Withdrawal of application   | 14.37         |



|   |               |
|---|---------------|
| Offer to Surrender  | Chapter 18    |
| Decision  | 14.38 - 14.50 |
| Amendments offered as a result of decision                                      | 14.39 - 14.43 |
| Updating the register (B3 action) - free text entries<br>(below the line)       | 14.44 - 14.48 |
| Updating the register (B3 action) - amending the status<br>following revocation | 14.49         |
| Clear Records   | 14.50         |

## Annexes

|         |   |
|---------|---|
| Annex 1 | Printed Journal Notice                            |
| Annex 2 | Table for website                                 |
| Annex 3 | Letter: withdrawal of application                 |
| Annex 4 | Letter: withdrawal of application accepted        |
| Annex 5 | Letter: withdrawal of application public interest |
| Annex 6 | Form decisions                                    |

## 14 APPLICATION FOR REVOCATION

### INTRODUCTION

14.01 The Court (Patents Court or Patents County Court) or Comptroller may on the application of **any** person order a patent for an invention to be revoked. However, an application on the grounds that the patent was granted to a person who was not entitled to be granted that patent (see section 72(1)(b) and 72(2)) may only be sought by a person who has already satisfied the Court or Comptroller that he himself should have been the sole proprietor or a joint proprietor.

14.02 The section provides for the revocation of a GB patent granted under the Patents Act 1977 or a European patent (UK).

#### What are the grounds for an application?

14.03 The application for revocation can be made on (but only on) any of the grounds set out in section 72(1)(a)-(e).

### INITIAL ACTION

#### Formal Requirements

14.04 Follow procedures at 1.04 to 1.07.

#### Action by Litigation Assistant (A1)

14.05 Deleted

### STATEMENT OF GROUNDS

#### What should the statement of grounds contain?

14.07 Follow procedures at 1.11 to 1.12.

- 14.08 The statement of grounds should be sufficiently explicit to allow the proprietor of the patent to be aware of the specific allegations which he will have to answer if he wishes to defend his patent. Thus whilst normally it is not necessary to provide elaborations of technical fact, where prior disclosure or prior use of the invention are alleged, or an argument of obviousness is put forward, the disclosure or use must be sufficiently identified to allow the proprietor to appreciate the scope of the allegation he is required to meet.
- 14.09 An objection to the adequacy of the statement should be taken if it contains bald statements such as "it will be shown with reference to prior art that the patent is not novel" and "it will be shown that there was prior use". Such statements do not enable the proprietor to appreciate the scope or merit of the attack on his patent. In such circumstances the statement should be referred to the HO. As stated above, the grounds for revocation are clearly set out in section 72(1). Any other ground for revocation would not be acceptable as such and appropriate action should be taken.
- 14.10 The claimant needs to indicate the relief being sought. Although it would appear that this is implicit in the application for revocation itself, this is not always so, for example, the claimant might be seeking partial revocation of the patent. Thus although ideally the claimant should state explicitly that the relief sought is "revocation of the patent", if this request is set out in any attached letter or in the body of the statement this will normally suffice.

What happens if the statement does not comply?

- 14.11 Follow procedures at 1.13 to 1.18.

## Revocation under section 72(1)(b) - patent granted to person not entitled

14.12 An application on the ground that the patent was granted to a person who was not so entitled is the only ground that restricts who may apply. Section 72(2) sets out two requirements:

- such an application can only be made by a person found by the Court in an action for a declaration or declarator, or found by the Court or the Comptroller on a reference under section 37 above, to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked; and
- the action may not be made if that action was commenced or that reference was made after the end of the period of two years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

14.13 It was thought that the Act required that the person lodging the application under section 72(1)(b) must first have been determined by the Court or the Comptroller to be entitled to the patent (*Dolphin Showers v Farmiloe* [1989] FSR 1). However, this case was not followed in a more recent case *Henry Brothers (Magherafelt) Limited v Ministry of Defence and Northern Ireland Office* [1997] RPC 693 where the Court held that it "has jurisdiction under section 72(1)(b) to consider the case without any prior declaration or finding under section 37" (at page 711). This has been followed in a recent case before the Office EP 0683925 (*A C Egertons patent BL 0/170/00*) and sometime ago on GB2171241.

14.14 As to the potential time restriction, this would appear to place an evidential hurdle in front of the claimant. No cases to date have been filed outside the

two years so it is unclear how large a hurdle this requirement would present to a potential claimant applying outside the two year period. There is a similar restriction in section 37(5). In *Yeda Research v. Rhone-Polenc Rorer* [2007] UKHL 43, an entitlement dispute under section 37, the House of Lords held that where entitlement proceedings had initially been commenced before two years from the date of grant the subsequent amendment of the claimant's statement of grounds still constituted the same proceedings and therefore fell within the two year limitation period.

### Serving the Statement of Grounds

14.15 Follow procedures at 1.19 to 1.24.

### **COUNTER-STATEMENT**

14.16 Follow procedures at 1.25 to 1.26.

### **AMENDMENT**

#### Offer to amend under section 75

14.17 If the proprietor offers in his counter-statement to amend the specification in order to overcome prior art, etc, it should be made clear on what basis the offer is made, that is, whether the offer is firm or is conditional upon an adverse finding on the unamended specification.

Where amendment is offered under section 75 in revocation proceedings, the onus is on the proprietor to establish that the comptroller's discretion should be exercised in his favour in allowing amendments to the patent in revocation proceedings.

14.18 A counter-statement is still required even if, before it is due to be filed, the claimant has indicated that he is willing to withdraw on the condition that

certain amendments are made to the specification and the proprietor is agreeable to these amendments. In such a case however it will be sufficient for the counter-statement merely to offer the proposed amendments, stating that the offer is unconditional.

- 14.19 The proposed amendments should be clearly identifiable and should be delivered to the comptroller electronically, if reasonably possible. Any such amendments are made under section 75.

#### EPC 2000 – Central Limitation Process

- 14.20 Following the introduction of the central limitation process, an EP patent may now be amended centrally at the EPO or in each individual contracting state. On receipt of amendments filed under section 75 in proceedings before the comptroller, the online European Patent Register (Register Plus) should be checked to determine whether there is a request to centrally limit the EP patent (see <https://www.epo.org/searching-for-patents/legal/register.html>). If amendments have been filed centrally, the HO will need to be informed as will the claimant in the proceedings. The defendant (the patent proprietor) may need to be contacted to obtain a copy of the amendments filed. If the amendments could result in different claims, the HO will advise on subsequent procedure, for example, it may, after seeking comments from both sides, be appropriate to stay the revocation proceedings until the central amendment proceedings at the EPO have been completed.

#### Directions for the electronic delivery of proposed amendments

- 14.21 Electronic delivery should be made either by e mail to [litigationamend@ipo.gov.uk](mailto:litigationamend@ipo.gov.uk) or on an electronic carrier (such as floppy disc or CD-R) delivered to this office and accompanied by an identifying letter.
- 14.22 Where the proposed amendments are filed electronically

- The office will not accept an e-mail at any e-mail address other than that given above. The e mail should be a plain text message.
- The e-mail should be entitled “*A proposal to amend under s75 before the comptroller*”
- The text may be provided as an attachment to the e-mail.

If we are unable to read the text, we should treat it as not delivered. The B2 should contact the applicant with a view to making alternative arrangements.

14.23 Applicants are encouraged to use conventional word processing features such as markup, colour text and strikeout/strikethrough to set out the amendments on the original version of the text in a way that makes it easy for the reader to appreciate the changes. If it is not possible to identify the amendments, you should contact the applicant with a view to making alternative arrangements.

**PDAX:-**If the amendments are included within the body of an e-mail, import the amendments (doc code is AMEND-IP).

#### Action on receipt of the amendments

14.24 Once the B2 has checked the nature of the proposed amendments and the basis upon which they are offered has been properly indicated, a copy of the amendments should be sent to the other side with a letter pointing out that the proceedings will be reviewed and the Office will consider the best way of proceeding with the case.

**PDAX:-**Create letter and import (doc code is LETTER-IP).

The HO should be advised that amendments have been filed and the case should then be referred to the Head of Examination Group of the subject matter concerned for a preliminary report on the amendments. At this stage the only questions which need to be considered by the Head of Examination Group are whether the amendments would add matter or extend the protection conferred by the patent. No attempt should be made to consider whether they meet the alleged ground of invalidity.

14.25 Any objection arising out of this preliminary scrutiny of the amendments will be communicated to Litigation Section. The B2 will be advised to write to the proprietor allowing a specified period for reply (normally one month). If the proprietor maintains that the amendments are *prima facie* allowable, both parties should be informed that this has been noted and that the matter will be determined at the substantive hearing.

14.26 If new or modified amendments are proposed in reply, they should be consolidated as appropriate with the previous amendments and should be filed electronically if reasonably possible. They should also be presented in a way that clearly identifies them. The procedures outlined in paragraphs 14.23 to 14.24 should be repeated. If the amendments are initially proposed in correspondence, in order to be brought formally into the proceedings, they must be incorporated into or referred to in an amended counter-statement.

**PDAX:** -Once imported into PDAX, annotate the amendments to show they are new /modified

14.27 If the Head of Examination Group is satisfied that there is a clear major objection under section 76, this should be reported in a form suitable for incorporation in a letter expressing the objection as a *prima facie* view. To this end such a letter should be issued by the B2 and should open with



The amendments have been referred to an examiner who has expressed the following *prima facie* view

If however there are no or only minor objections or there is a reasonable element of doubt, the Head of Examination Group should report accordingly and inform Litigation Section that in the circumstances no action on the amendments is necessary at this stage.

14.28 When conditional or unconditional amendments have been submitted either in a counter-statement or at any later stage, the hearing officer will give directions under Rule 75(2) as to whether the amendments will need to be advertised for opposition. If the hearing officer wishes the amendments to be advertised, the opposition period is two weeks.

#### Opposition to amendments

14.29 Where the amendments under section 75 in revocation proceedings are opposed there is also a burden on the opponent to establish his or her case, (see 14.17) and so the onus is split.

In such cases the Office will normally, in accordance with the practice of the court, expect the proprietor to file the first round of evidence but this will depend on how the HO wishes to conduct the evidence rounds.

#### Advertising amendments

14.30 The e-mail or electronic carrier should be forwarded to the B2 who should

- Complete the Journal notice (annex 1). This should be completed if the amendments have been filed electronically or in paper form.
- The A3 when compiling the weekly PDJ will send electronic amendments to webmaster. The table (annex 2) should accompany

the amendments and webmaster must be advised of the date of the journal the notice will appear in.

Webmaster will then arrange a link from the journal notice to the full details of the amendment (electronic amendments only). Where the amendments have been filed in paper form only, on request, a copy should be issued by fax or post as appropriate. The period for opposing the amendments is two weeks from the date of the published advertisement. [Note: The amendments will appear on the Office website].

**PDAX:** - Create advert and import (doc code is ADVERT-IP)

#### Revocation proceedings and amendments under section 75

14.31 The revocation proceedings should usually proceed in parallel with the consideration of the amendments under section 75. The Comptroller may however stay the revocation proceedings at the request of the claimant pending consideration of the amendments. Similarly, if the amendments are opposed, the Comptroller may stay the revocation proceedings pending a resolution of the opposition or may leave the opposition to be decided in the revocation proceedings.

#### Amendment of the application, the statement or the counter-statement

14.32 Amendment of the application for revocation, the statement or the counter-statement is allowable with the leave of the HO acting for the Comptroller; for example a new claimant for revocation may be added or substituted or a new ground or further facts may be introduced. However consideration should be given to any impact on the agreed timetable for filing evidence and the hearing date.

#### Admission of new grounds

14.33 Where the Comptroller decides to admit a new ground, a supplementary or amended statement should be filed. The proprietor should then be given the opportunity to file a supplementary or amended counter-statement in reply. Unless the new ground is not contested or evidence relevant to the new ground has already been filed, each party should be given a specified period (which may run concurrently with any other period set) in which to file further evidence in support of or in response to this new ground.

**PDAX:** -A list of doc codes relating to supplementary or amended statements or supplementary or amended counter-statements is to be found in Chapter 25, annex 2.

#### Reference to the Hearing Officer

14.34 At the discretion of the B2, the case may be referred to the HO at any point in the proceedings when complex problems arise.

### **MANAGEMENT OF PROCEEDINGS**

14.35 Follow procedures at 1.28 to 1.40. It will be for the hearing officer to decide whether mediation may be appropriate.

### **EVIDENCE ROUNDS**

14.36 Follow procedures at 1.41 to 1.53.

### **WITHDRAWAL OF APPLICATION**

14.37 In addition to the normal procedure on withdrawal of the application for revocation by the claimants, consideration of the application in the public interest will be given by the relevant Head of Examination Group for that subject matter (see Chapter 16). When Litigation Section receives notification of withdrawal from the claimant the B2 case officer should establish whether the withdrawal is unconditional or conditional on any

amendments proposed by the proprietor being allowed. If this matter is unclear the B2 case officer should contact the claimant in order to resolve the matter and ask them for a response in writing. The B2 should issue a letter in identical terms to both sides to clarify whether there are any matters outstanding (costs) and to advise the parties that the case will now be referred to an examiner in order to consider whether the withdrawal should be accepted or whether there are public interest considerations (Annex 3). They should refer the proceedings to the Head of Examination Group in charge of the subject matter, to determine whether an action is necessary in the public interest. The B2 should issue a letter in identical terms to both sides where it is considered that there is no question remaining that the comptroller should further consider in the public interest and the proceedings can now be concluded (Annex 4). Where it is considered that there are public interest issues to consider, a letter is issued to the proprietor of the patent which will incorporate the examiner's report (Annex 5). The proceedings are concluded by formal office decision. A hearing officer may issue the decision or alternatively they may instruct the B2 case officer to prepare a decision. There are a variety of scenarios that may arise dependent on whether the withdrawal request is conditional or unconditional and whether the office deems it necessary to pursue the proceedings in the public interest. [Full description see MOPP. 72.24 – 72.34]. The B2 case officer will select the relevant decision (See Annex 6) and refer draft to the hearing officer for approval.

**PDAX:** When approval is received, the B2 case officer should apply the relevant electronic signature (Signature Library on SharePoint) and issue accordingly. Decision and letter to be imported to dossier together with appropriate file note. In cases where the hearing officer accepts the withdrawal, but does not wish to issue a formal decision, a file note should be made accordingly.

## **OFFER TO SURRENDER** (see Chapter 18)

[Full description - MOPP 72.36 - 39]

## **DECISION**

14.38 Follow procedures at 1.54 to 1.56.

### Amendments offered as a result of decision

14.39 Sometimes when a patent has been found to be invalid, the patent proprietor may be given the opportunity to file amendments. In such a case, the hearing officer will specify a time period for doing so in his decision.

14.40 On receipt of the amendments, the B2 case officer should arrange for an entry in the Register to show that amendments have been filed under section 75.

14.41 The amendments should be sent to the hearing officer for consideration. The hearing officer, for example, may invite further amendments if those originally filed are not found to be acceptable.

14.42 The hearing officer will advise whether the amendments need to be advertised for opposition. This may not always be necessary and depends on the nature of the amendments.

14.43 Following directions from the hearing officer, the B2 case officer should copy the amendments to the claimant as the revocation proceedings are in effect still on-going, and if appropriate, arrange to advertise for opposition purposes. The B2 should inform both parties of the Journal advert details.

### Updating the register (B3 action) - free text entries (below the line)

14.44 If the patent has been revoked:

- use REG ENT free text and type a register entry as follows:

"In a decision of the Comptroller dated day/month (in words)/20\*\*, the patent was ordered to be revoked. The appeal period terminates on day/month (in words)/20\*\*."

The status of the case should be amended (see below). Two weeks after the termination of the appeal period, on instruction from the B3, the Hearings Clerk should inform the B3 whether an appeal has been filed. A further register entry should be made on OPTICS as follows:

14.45 a) If no appeal has been received:

- use REG ENT free text to make the following entry:

Following a decision of the Comptroller dated day/month (in words)/20\*\*, no appeal has been received. The patent is thus revoked.

14.46 b) If an appeal has been received:

- use REG ENT free text to make the following entry:

In a decision of the Comptroller dated day/month (in words)/20\*\*, an appeal has been received. [*Additional text* - Revocation stayed pending the appeal].

The status of the patent should be changed back. Where the decision states that the revocation should be stayed pending the outcome of the appeal, this should be included in the register entry (see above). The Hearings Clerk will need to inform the B3 of the outcome of any appeal in due course so that this can be recorded in the register.

14.47 If the patent is not revoked because of amendment:

- use REG ENT free text and type the following entry:

"In a decision of the Comptroller dated day/month(in words)/20\*\*, following amendment, no order for revocation was made."

14.48 If the patent is found not to be invalid:

- use REG ENT free text and type the following entry:

"In a decision of the Comptroller dated day/month(in words)/20\*\*, no order for revocation was made."

#### Updating the register (B3 action) - amending the status following revocation

14.49 When updating the status of a patent on the register to show it has been revoked:

- use OPTICS function CHA CAS
- From screen CHA CAS 1, select option 2 >Bibliographic and Register Information
- From screen CHA CAS 24, select option 3 >Status Information, including Renewal and Licence Information
- On CHA CAS 28, enter code 07 in >Reason not in Force= box. For >Date not in Force=, enter date of decision or date of Court Order (if appropriate)
- To check if the status has changed to show the patent has been revoked, use OPTICS function DIS FUL

#### Clear Records (B3 action)

14.50 Read through the decision. Complete the “Clear Records Pro-forma” and pass this to the appropriate Case Officer for further action.

**PDAX:** - see 1.56 for actions



# Annex 1

Printed PDJ Notice

## Application for Amendment of Specification now open to Opposition

### **Section 75 before the court**

If you intend to oppose the following amendments, you must within 14 days from the appearance of this advertisement, file and serve on all parties and the Comptroller a notice opposing the application. This must include the grounds relied on.

### **Section 75 before the comptroller and Section 27 amendments**

If you intend to oppose the amendments filed under section 75 before the comptroller or amendments filed under section 27, you must within four weeks of the appearance of the advertisement under section 27 and **within two weeks** of the advertisement under section 75, file two copies of Patents Form 15 giving the comptroller notice of opposition to the amendments. You also need to file two copies of a statement setting out fully the facts of your case and the relief that you are seeking.

**Section:** 75 before the Court

**Patent Number:** 2345678

**Patent Court Action Number:** HC 12345

**Title** of **patent:**

XX

x

**International classification:** xx xxxxxx

Name of patent proprietor:  
XX

XX

Patent proprietors address for:  
XX

XX

service

These amendments may be viewed on our website

.....

Section: 75 before the comptroller

Patent Number: 2356487

Title of patent:  
XX

X

International classification:  
XX

XXX

Name of proprietor:  
XX

XXX

For a copy of these amendments, phone Litigation Section (01633 814376)

.....

Section: 27

**Patent Number: 2356487**

**Title of patent:**

XX

**x**

**International classification:**

XX

**xxx**

**Name of proprietor:**

XX

**xxx**

**These amendments may be viewed on our website**

## Annex 2

### Applications for Amendment of Specification

| Sect. | PDJ No. & Date       | Opposition deadline | Patent No. and title                    | Int. Classi | Proprietor (Court action number if any and address for service)                  |
|-------|----------------------|---------------------|---|-------------|--|
| 27    | 3216<br>5 Feb 08     | 4 weeks             | 2345678<br>xxxxxxxxxxxxxxxxxxxxxxx<br>x | H04G        | xxxxxxxxxxxxxxxx   |
| 75    | 3215<br>29 Jan<br>08 | 2 weeks             | 2124567<br>xxxxxxxxxxxxxxxxxxxxxxx<br>x | G22F        | xxxxxxxxxxxxxxxx   |
| 75    | 3214<br>22 Jan<br>08 | 14 days             | 2456789<br>xxxxxxxxxxxxxxxxxxxxxxx<br>x | A69B        | xxxxxxxxxxxxxxxx<br>HC 123456<br>xxxxxxxxxxx,<br>xxxxxxxxxx,<br>xxxxxxxxxxxxxxxx |

## Annex 3

Your Reference:

Our Reference: 1R31/name/number ref

Date

Dear Sirs,

### **Title**

1. I refer to letter dated .....filed by the claimant notifying that they unconditionally/conditionally withdraw their application under section 72 of the Patents Act 1977.
2. The case will now be passed to an examiner in order to consider whether the comptroller should accept the notice of withdrawal without qualification or whether there are questions remaining that the comptroller should further consider in the public interest (Manual of Patent Practice (MOPP. 72.26 refers).
3. In accordance with paragraph 72.31 of MOPP.no further correspondence will be copied to the claimant, unless they request otherwise. For information the claimant will receive a copy of any decision issued.
4. A letter in identical terms is being sent to both sides.

Yours faithfully,

Name  
Litigation Section  
Patents Directorate

## Annex 4

Your Reference:

Our Reference:1R31/name/number ref

Date

Dear Sirs,

### **Title**

1. I refer to official letter dated.....in the above proceedings regarding the claimant's withdrawal of their application for revocation.
2. I confirm that the comptroller considers that there are no questions remaining which should be considered in the public interest.
3. As such these proceedings are now concluded and I confirm that no comments have been received from either side and as such the Office will now treat the application as withdrawn with effect .....(insert date as appropriate). The Patents Register and all other records have been updated accordingly.
4. The decision of the comptroller is attached. (See Annex 6 and select appropriate decision).
5. A copy of this decision is being sent to the claimant for revocation for information.

Yours faithfully,

Name  
Litigation Section  
Patents Directorate

## Annex 5

Your Reference:

Our Reference: 1R31/name/number ref

Date

Dear Sirs,

### Title

1. In their letter dated.....(insert date) the claimants state their intention to withdraw their application for revocation of the patent. Our letter dated .....(insert date) noted this intention and advised that the case would now be referred to an examiner in accordance with the provisions of the Manual of Patent Practice (MOPP. 72.26).
2. I confirm that the examiner has reviewed the case and is of the view that the revocation action should continue in the public interest for the following reasons::..... (Incorporate text from examiner's report). Accordingly the revocation proceedings are still regarded as in being and the comptroller cannot yet decide the case.
3. The defendant is invited to file any comments/ amendments/further amendments or evidence (Delete as appropriate) within one month of the date of this letter that is, by .....(insert date as appropriate). Should the examiner consider that the response does not satisfy the objections raised the defendant will be offered the opportunity to be heard on the matter.
4. This letter has been sent to the claimant for information. However, since he is not actively pursuing these proceedings, the defendant is no longer required to copy any further correspondence on this matter to the claimant.

Yours faithfully,

Name  
Litigation Section  
Patents Directorate

## **Annex 6 Decision Forms**

### **Decision Form B**

#### **(Applicant for revocation under Section 72 has withdrawn unconditionally and there are no amendments)**

The applicants for revocation now state that they no longer wish to pursue the application. Having considered the objections raised by the applicants, I decide to make no order for revocation of the patent.

### **Decision Form D**

#### **(Applicant for revocation under Section 72 has withdrawn conditionally on amendments being accepted)**

In order to meet the issues raised, the proprietors have submitted proposals for amendment of the specification. The proposed amendments are shown in a copy of the printed specification annexed to this decision and the applicants for revocation have expressed their willingness to withdraw their application on the basis of these amendments. The amendments have been advertised and no notice of opposition to them has been filed.

The amendments are such as may lawfully be made in these proceedings. Having now considered the objections raised by the applicants for revocation, I decide to allow the specification to be amended in the manner shown in the said copy of the printed specification and make no order for revocation of the patent.

### **Decision Form G**

#### **(Specification has been amended following an unconditional withdrawal by the applicant for revocation under Section 72)**

The applicants for revocation now state that they no longer wish to pursue the application.

In order to meet the issues raised, the proprietors have submitted proposals for amendment of the specification. The proposed amendments are shown in a copy of the printed specification annexed to this decision. The amendments have been advertised and no notice of opposition to them has been filed.

The amendments are such as may lawfully be made in these proceedings. Having now considered the objections raised by the applicants for revocation, I decide to allow the specification to be amended in the manner shown in the said copy of the printed specification and make no order for the revocation of the patent.



## CHAPTER 15

### DESIGN RIGHT

The Subsistence of Design Right;

The Term of Design Right; The Identity of the Person in whom Design Right first vested

|   |               |
|---|---------------|
| Introduction  | 15.01 - 15.03 |
| Who may apply?  | 15.02         |
| Period during which an application may be made        | 15.03         |
| Public Inspection                                     | 15.04         |
| Formal Requirements                                   | 15.05 - 15.07 |
| Statement   | 15.06         |
| Statement Check                                       | 15.07         |
| Further Procedure                                     | 15.08 - 15.12 |
| Further Statement                                     | 15.08 - 15.10 |
| Evidence  | 15.11 - 15.12 |
| Hearing   | 15.12         |
| Application to Settle the Terms of a Licence of Right |               |
| Introduction  | 15.13 - 15.15 |
| Who may apply?  | 15.14         |
| Period during which an application may be made        | 15.15         |
| Public Inspection                                     | 15.16         |
| Formal Requirements                                   | 15.17 - 15.22 |
| Statement   | 15.18         |
| Settlement of terms where Design Right is unknown     | 15.19 - 15.21 |
| Statement Check                                       | 15.22         |
| Further Procedure                                     | 15.23 - 15.27 |
| Further Statement                                     | 15.23 - 15.25 |
| Evidence  | 15.26         |
| Hearing & Appeal                                      | 15.27 - 15.28 |

## **15 DESIGN RIGHT**

### **GENERAL INTRODUCTION**

There are two types of dispute concerning Design Right :-

- a) The Subsistence of Design Right; The Term of Design Right; The Identity of the Person in whom Design Right first vested.
- b) Application to settle the Terms of a Licence of Right.

### **THE SUBSISTENCE OF DESIGN RIGHT; THE TERM OF DESIGN RIGHT; THE IDENTITY OF THE PERSON IN WHOM DESIGN RIGHT FIRST VESTED**

15.01 Section 246 of the Copyright, Designs, & Patents Act 1988 provides for a party to a dispute involving subsistence of design right, the term of design right or the identity of the person in whom the design right was first invested to refer the dispute to the Comptroller. The procedure is governed by rules 3 - 9 of The Design Right (Proceedings before the Comptroller) Rules 1989.

#### Who may apply?

15.02 The owner (or alleged owner) of the design right or the other party to any such dispute may apply. It is important to note that the dispute must relate to subsistence, term or identity. If the dispute is of a general nature, the comptroller may not have the jurisdiction to decide it.

#### Period during which an application may be made

15.03 The application may be made at any time during the term of the design right.

## **PUBLIC INSPECTION**

- 15.04 **Documents filed in Design Right proceedings are not open to public inspection.**

**Decisions are not open to public inspection for 28 days, pending comments by the parties concerning any parts of the decision for which confidentiality is requested. The comptroller may then issue a redacted version of the decision which will be open to public inspection.**

## **FORMAL REQUIREMENTS**

- 15.05 Two copies of Design Right Form 1 and a statement should be filed (rule 3(1)).

### Statement

- 15.06 The statement should set out the name and address of the other party to the dispute (referred to as the defendant), the issues in dispute, the claimant's case and the documents relevant to the case (rule 3(1)).

### Statement Check

- 15.07 The statement and the Design Right Form 1 should be checked to take into account the points raised above and points raised in Chapters 1 and 2. Any defects in the statement or the Design Right Form 1 should be brought to the attention of the claimant with a request that the appropriate changes be made.

This will often need to be done before the period for filing the counter-statement is set (the Design Right Form 1 and statement are nevertheless copied to the defendant as in 15.08). However, certain defects are of such a nature as to allow the two periods to run concurrently e.g. where a document

referred to in the statement has not been filed by the claimant but which will already be in the possession of the defendant.

## **FURTHER PROCEDURE**

### Further Statements

- 15.08 The Design Right Form 1 and the statement should be copied by the Office to the defendant within 14 days of receipt of the application (rule 3(2)). The defendant is allowed 28 days from the date of receipt of the application in which to file a counter-statement and to copy it directly to the claimant (rule 3(3)). The counter-statement should set out full particulars of the grounds on which the defendant contests the claimant's case, any issues on which both sides agree and any documents relevant to the case.
- 15.09 The claimant will be allowed 21 days from the date the counter-statement is served on him to file a further statement setting out the grounds on which he contests the defendant's case and to copy this direct to the defendant (rule 3(4)).
- 15.10 For checking the counter-statement, see Chapters 1 and 2. The same procedures are used for checking the further statement.

### Evidence

- 15.11 See Chapters 1 and 3. The relevant rules are rules 4 & 5 and Office practice. The claimant usually files the first and third rounds of evidence. However, simultaneous filing of evidence may be appropriate.

### Hearing

- 15.12 The evidence is followed by an oral hearing usually in London (but sometimes in Newport) and a written decision (rules 5, 6 & 9).

## **APPLICATION TO SETTLE THE TERMS OF A LICENCE OF RIGHT**

### **INTRODUCTION**

15.13 Section 247 of the Copyright, Designs, & Patents Act 1988 provides for a person to apply for a licence which is available as of right by virtue of:

- a) Section 237 (licences available in last five years of the design right term) or
- b) An order under section 238 ( licences made available in the public interest by the Monopolies & Mergers Commission).

The provisions of section 19(3) of Schedule I of the CDP Act, allowing an application for such a licence in the case of design documents previously covered by copyright, have now expired. Similarly, section 19(5) of Schedule I, which allowed claimants to adjust the terms of a licence made before 1 August 1989, now no longer applies.

The procedure before the Comptroller is governed by rule 10 of The Design Right (Proceedings before the Comptroller) Rules 1989.

#### Who may apply?

15.14 Any person requiring a licence of right may apply.

#### Period during which an application may be made

15.15 Under section 237, an application may be made in default of agreement, during the last six years of the term (effective during the last five years) (section 247(2)). In default of agreement between the parties, the comptroller may settle the terms of the licence

Under section 238 an application may be made, in default of agreement, at any time after an order under this section has been made (section 247(1)(b)) .

## **PUBLIC INSPECTION**

15.16 See 15.04

## **FORMAL REQUIREMENTS**

15.17 Two copies of Design Right Form 3 and a statement should be filed (rules 10(1) & (2)).

### Statement

15.18 The statement should set out the terms of the licence which the claimant requires the Comptroller to settle. The terms will vary from licence to licence depending on the circumstances of the case. However they usually include an explanation of terms used in the licence (definitions), and a reference to the royalty rate and how this is to be paid, and may contain reference to such things as quality control, auditing of accounts, and termination of the agreement. The statement should also contain the name and address of the owner of the design right (rule 10(2)(a)) and indicate that the application is being made in default of agreement between the parties.

### Settlement of terms where Design Right Owner is unknown

15.19 Where the claimant is unable to discover the identity of the design right owner (section 248), the statement should include the particulars of the enquiries

made by them as to the identity of the owner and the results of those enquiries (rule 13(1)).

15.20 The HO may require the claimant to make further specified enquiries concerning the identity of the owner (rule 13(2)).

15.21 If the owner still cannot be identified, the HO will consider the application and settle the terms of the licence (rule 13(3)). The HO may order a royalty-free licence (section 248(2)).

### Statement Check

15.22 The statement and the Design Right Form 3 should be checked to take into account the points raised above and points raised in Chapter 1. Any defects in the statement or Design Right Form 3 should be brought to the attention of the claimant with a request that the appropriate changes be made. This will often need to be done before the period for the filing of the statement of objection is set (the Design Right Form 3 and statement are nevertheless served on the defendant as in 15.23). However, certain defects are of such a nature as to allow the two periods to run concurrently e.g. where a document referred to in the statement has not been filed by the claimant but which will already be in the possession of the defendant.

## **FURTHER PROCEDURE**

### Further Statements

15.23 The Design Right Form 3 and statement should be copied by the Office to the defendant within 14 days of receipt of the application (rule 10(3)). The defendant is allowed 6 weeks from the date of receipt of the application to file a statement of objection and to copy it direct to the claimant (rule 10(4)). The

statement of objection should set out the grounds of the objection to the terms of the licence proposed in the claimant's statement.

15.24 The claimant is then allowed 4 weeks from the date the statement of objection is received to file a counter-statement and to copy it direct to the defendant (rule 10(5)).

15.25 For checking the counter-statement, see Chapters 1 and 2. The same procedures are used for checking the defendant's statement of objection.

### **Evidence**

15.26 Where evidence is to be filed sequentially, as the claimant files a counter-statement, **the first round of evidence is filed by the defendant.** This is deliberate policy and relates to the fact that the onus of proof does not rest on any party as well as the fact that the defendant may have vital information concerning dealings of the right, particularly comparable licences. However, there may be times when simultaneous filing of evidence will also be appropriate.

### **Hearing and Appeal**

15.27 The evidence is followed by an oral hearing usually in London (sometimes in Newport) and a written decision (rules 11, 5, 6 & 12).

15.28 Appeals against a Design Right decision are governed by the Appointed Person (Designs) Rules 2015. For further details on appeals see Chapter 6.



## CHAPTER 16

### COMPLEX PROBLEMS

|  |               |
|--|---------------|
| Disclosure   | 16.01 - 16.08 |
| Initial request between the parties                                      | 16.02 - 16.05 |
| Request to the Comptroller   | 16.06         |
| Decision by the Hearing Officer  | 16.07 - 16.08 |
| Stay   | 16.09 - 16.16 |
| Parallel proceedings before the Court, IPO or the EPO                    | 16.09 - 16.11 |
| Stay of Court proceedings  | 16.12         |
| Parallel EPC proceedings before a competent authority of another State   | 16.13         |
| Parallel proceedings before the Comptroller                              | 16.14 - 16.16 |
| Decline to deal Ss 8(7), 12(2), 37(8) & 72.(7)                           | 16.17 - 16.18 |
| Confidentiality Rule 53  | 16.19 - 16.30 |
| Confidential evidence on a restricted basis                              | 16.21         |
| Treatment of the rule 53 request   | 16.22 - 16.30 |
| Extension of time (EOT)  | 16.31 - 16.34 |
| Termination/withdrawal of GB patent applications before publication      | 16.35 - 16.38 |
| Warning to relevant Formalities Group                                    | 16.36         |
| Action by Formalities Group  | 16.37 - 16.38 |
| No counter-statement filed   | 16.39 - 16.42 |
| Duty to copy to other side   | 16.43 - 16.48 |
| Fundamental principle of practice  | 16.43 - 16.45 |
| Correspondence   | 16.46 - 16.47 |
| Unpublished patent applications  | 16.48         |
| Uncontested entitlement cases  | 16.49 - 16.52 |
| Parallel proceedings/consolidation of subsequent references/applications | 16.53 - 16.61 |
| Parallel proceedings   | 16.53 - 16.55 |
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|  |               |
|--|---------------|
| Un-consolidation of proceedings/parallel proceedings             | 16.60 - 16.61 |
| Adding, substituting or striking out parties                     | 16.62 - 16.66 |
| Withdrawal of application/reference                              | 16.67 - 16.71 |
| Letter received referring to waiver of costs                     | 16.68         |
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| Withdrawal in section 72 proceedings                             | 16.71         |
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| Enforcement of court orders                                      | 16.74         |
| Filing documents by facsimile in <i>inter partes</i> proceedings | 16.75 - 16.77 |
| Without prejudice communications                                 | 16.78         |

## Annex

Annex 1 Letter – any matters outstanding

Annex 2 Letter – confirmation of withdrawal

## 16 COMPLEX PROBLEMS

### DISCLOSURE

16.01 Rule 86 provides the comptroller with the powers of a High Court judge as regards the discovery and production of documents. However the comptroller does not have the power to punish summarily for contempt of court. Where a party fails to comply with an order by the comptroller for disclosure, it is open to the other party to apply to the High Court for enforcement. Alternatively, the other party could apply to the comptroller for an order striking out the first party's case.

#### Initial Request between the Parties

16.02 Normally a party seeking disclosure will first approach the other side privately (ie not through the Office) in the hope of reaching agreement on the matter. If a request for disclosure comes to us, this is usually because, though admittedly not always, the parties have not been able to reach agreement.

16.03 On receipt of a request, the other side should be asked for their comments on the matter before the request is referred to the Hearing Officer (HO). A period of two weeks may be allowed for this. There may be no need to stay the proceedings at this point. However if you are in doubt, you should refer to the HO.

#### **PDAX:-**

The document code is AGENT-IP and annotated "Request for disclosure"

If the views of other side are sought, B2 case officer should create letter in Word and import. A copy of the letter should be issued to the other side.

If the case needs to be referred to the HO, the Case Officer will need to create a minute and import. Send Message = "PSM".

16.04 Deleted

16.05 If the disclosure issue is not resolved, the HO can be asked to decide the matter.

#### Request to the Comptroller

16.06 The details of the request for disclosure should be filed together with the views of the other side. The parties should indicate whether they wish the HO to decide the matter on the papers or wish to be heard in the matter. The matter is then referred to the HO. All documents relating to the request should be filtered into the Inter Partes Preliminary Issues folder on the PDAX dossier.

**PDAX:** See above for actions

#### Decision by the Hearing Officer

16.07 See Patent Hearings Manual concerning the criteria that HOs will use in exercising their discretion with regard to the ordering of disclosure.

16.08 The HO may order that a list of documents which are or have been in a party's possession be made available to the other side. When the party concerned has provided such a list, the documents may be inspected by and copies supplied to the other party. The HO will lay down a timetable for these stages.

### **STAY**

#### Parallel Proceedings before the Court, IPO or EPO

16.09 A stay in *inter partes* proceedings may be requested if there are parallel proceedings in the Court or before the EPO. A party may also request a stay in proceedings before the comptroller to enable the parties to mediate or consider settlement.

- 16.10 The party requesting the stay should file the details of the request including reasons. The views of the other side should be sought. Additionally, the parties should indicate whether they wish the HO to decide the matter on the papers or wish to be heard in the matter. The matter is then referred to the HO. All documents relating to the request should be filtered into the Inter Partes Preliminary Issues folder on the PDAX dossier.
- 16.11 The HO will decide the matter taking all the circumstances of the case into account - see Patent Hearings Manual.

**PDAX:-**

The document code is AGENT-IP and should be annotated "request for stay".

Letter to other side is created and imported (doc code is LETTER-IP)

If case needs to be referred to HO, B2 Case Officer will need to create a minute and import. Send Message = "PSM".

Stay of Court proceedings

- 16.12 Court proceedings may be stayed pending the outcome of proceedings before the Office eg under section 71 and 72 (*Hawker Siddeley Dynamics Engineering Ltd v Real Time Development Ltd* [1983] RPC 395).

Parallel EPC Proceedings before a Competent Authority of another State

- 16.13 Any reference under section 12 for an EP patent application will be stayed if proceedings before a competent authority of another state, which is a party to the EPC, are already in being (see section 82(7) and MOPP 82.06).

Parallel proceedings before the Comptroller

- 16.14 Entitlement proceedings before the comptroller may be stayed pending revocation proceedings that are also before the comptroller (see *Raychem*

*Ltd v Caradon MK Electric - section 37; Loblite v Caradon MK Electric - section 72).*

- 16.15 The HO may stay revocation proceedings at the request of the claimants pending consideration of amendments requested by the proprietors (MOPP 72.13).
- 16.16 Opposition to surrender under section 29 may be stayed pending section 72 proceedings (MOPP 29.06).

### **DECLINE TO DEAL**

- 16.17 The comptroller has discretion under section 8(7) and similarly under section 12(2) and 37(8) and 72(7) to decline to deal with a question if it appears to him that it involves matters which would more properly be determined by the court. In such a case any person entitled to do so must issue a claim form in the court within 14 days of the comptroller's decision. Any request to extend this period should be made to the comptroller. All documents relating to the request for decline to deal should be filtered into the Preliminary Issues folder on the PDAX dossier.
- 16.18 See Patent Hearings Manual for further details.

### **CONFIDENTIALITY (Rule 53)**

- 16.19 The comptroller has discretion to direct that a document other than a patent form, or any part of a document, be treated as confidential, when so requested by the person filing the document or any party to the proceedings to which it relates.
- 16.20 Since the public are generally entitled to inspect documents relating to a patent, or application for a patent after A publication, a request for confidentiality should not be granted unless it is considered justified for the reasons given.

### Confidential evidence on a restricted basis

16.21 Sometimes a party will go further and seek to submit evidence it does not want the other side to see. Any party to the proceedings has a right to see all the evidence before the comptroller on which the other party relies, so there can be no question of the hearing officer admitting evidence that one party has not seen. However, in suitable cases it may be sufficient to grant access to the confidential evidence on a restricted basis, eg to allow the document to be seen only by the other party's legal representatives and/or by an independent expert, or to require strict undertakings on confidentiality. See Chapter 3 of the Patent Hearings Manual.

### Treatment of the rule 53 request

16.22 The rule 53 request must be made within fourteen days of the filing of the document or receipt of the document by the comptroller, an examiner or the Office and include reasons for the request (rule 53(3)). All documents relating to the request should be filtered into the Inter Partes Confidentiality folder on the PDAX dossier.

16.23 If the request is not supported by reasons, the sender should be telephoned and asked to submit detailed reasons in writing within fourteen days from the date of filing the request. A telephone report should be issued and the case diaried to await a response.

16.24 The document(s) containing the confidential information should be placed on the "not open" part of the dossier pending consideration of the request. However, any document which is submitted with the rule 53 request including the accompanying letter should remain on the "open" part of the dossier (eg a letter that simply contains the rule 53 request).

16.25 In a few cases, the rule 53 request may appear in a letter which also contains some or all of the confidential information/supporting reasons to which the rule 53 request relates. In those cases, the letter should be placed

on the "not open" part of the dossier. It will be necessary for the person to request that this letter is also to be treated as confidential.

16.26 When all the required documentation has been received and placed on the appropriate part of the dossier, the case should be referred to the HO for consideration of the request.

16.27 If the request for confidential treatment is allowed by the HO, the party/parties should be informed accordingly. The status of each of the documents accorded confidential treatment should be "NOPI" (Not Open to Public Inspection) and annotated "R53 Confidential – Not Open to Public Inspection". A certificate should be imported as below:-

**The documents listed below are to be treated as confidential by direction of the comptroller under Rule 53 of the Patent Rules 2007 dated .....**

|   |
|---|
| <p>The documents listed below are to be treated as confidential by direction of the comptroller under Rule 53 of the Patents Rules 2007 dated -----<br/>-<br/><b>(List documents)</b></p> |
|---|

The confidential documents and the certificate should then be filtered into the Confidential folder in the InterPartes procedure tab.

If confidentiality is only allowed for parts of a document, a redacted version (a copy with the confidential parts omitted) will be treated as "OPI" (Open to Public Inspection) and annotated "Redacted version open to public Inspection".

At the end of any appeal period, with the agreement of the B3, the Case Officer should add the B3's electronic signature to the certificate.



Electronic signatures are located on SharePoint in the Signature Library.

- 16.28 The copy of the official letter which informs the sender that the rule 53 request has been allowed should be added to the PDAX dossier and made Open to Public Inspection.
- 16.29 It is possible for a document to be accorded confidential treatment for a limited period only. Where this applies, the action should be taken as above but the case should be diaried as appropriate and the position subsequently reviewed by the HO
- 16.30 Once the relevant period has expired, if a document is not to be accorded confidential treatment, it will be necessary to inform the party/parties accordingly. The B2 should also change the status of the relevant documents from NOPI to OPI and remove the annotation. The certificate should be enhanced to reflect the document is no longer to be treated as confidential.

#### **EXTENSION OF TIME (EOT)**

- 16.31 The period provided for filing the counter-statement, and the timetable set for the filing of evidence are expected to provide sufficient time for the parties to complete the required actions. Whilst there are no hard and fast rules, once a timetable for the proceedings has been set, HOs will grant extensions only in exceptional circumstances. When granted, extensions will only be as long as strictly necessary.
- 16.32 When considering a request for an extension of time, the HO will apply the general principles and the case law underlying the exercise of discretion and will seek to keep delay to a minimum. It is most unlikely that postponement of the hearing itself would be allowed.

- 16.33 A party requesting an extension should keep their request to the minimum necessary to deal with the difficulty that has given rise to it, should state clearly the time period required, should provide a clear and convincing explanation of the steps that they have taken to meet the original deadline, and should explain the nature of the difficulty. All documents referring to the request should be filtered into the Inter Partes Preliminary Issues folder on the PDAX dossier.
- 16.34 The effect of any extension of time on the other party must be considered. To this end the other party's views should be sought, preferably by telephone, before a decision on whether or not to allow the extension is made. Where an extension of time is allowed, Litigation Section or the HO will consider the effect on the timetable as a whole and if appropriate make any changes necessary so as not to disadvantage the other side.

**PDAX:-**

The document code is EOT-REQUEST and should be annotated "EOT request received".

If case needs to be referred to HO, Case Officer will need to create minute and import. Send Message = "PSM".

If EOT is allowed, create letter and import. (Doc Code is EOT ALLOWED). Add annotation "EOT request filed on ..... allowed".

**TERMINATION/WITHDRAWAL OF GB PATENT APPLICATIONS BEFORE PUBLICATION**

- 16.35 In an entitlement dispute, it is not appropriate for the Office to take any irrevocable action which might be to the detriment of the claimants should they subsequently be found to be entitled to the patent application. In section 8 entitlement proceedings, it is important that the relevant Formalities Group be informed of the proceedings so that an application is not terminated/withdrawn without the matter being referred back to Litigation Section. The procedure outlined below should be followed.

### Warning to the relevant Formalities Group

16.36 When the B2 is appointed for a section 8 entitlement in respect of a GB patent application which has not been published, the following action should be taken by the B2:

**PDAX:-** Update the front of the electronic file with the label: Litigation Proceedings

Create minute to Formalities Manager and import. Send message "PSM - Do not terminate case without consulting Litigation Section".

### Action by Formalities Group

16.37 If, before publication, termination action is due or a request to withdraw the patent application has been made, the Formalities Manager will contact the B2. The B2 officer should then refer the case to the HO for appropriate action.

16.38 Deleted

### **NO COUNTER-STATEMENT FILED**

16.39 If no counter-statement has been filed, the application/reference is deemed to be unopposed (see MOPP 72.09).

16.40 It is possible that the defendant did not receive the original official letter or the counter-statement has been sent but has not yet reached the dossier. Consequently, in order to ensure that the defendant is not disadvantaged, an official letter should be issued inviting comments from the parties (see annex 1).

16.41 If a counter-statement is filed in response to the official letter, the defendant will need to request a retrospective extension of time before the counter-

statement may be admitted. If this is opposed by the other side, the case should be referred to the HO for further procedure.

16.42 If no counter-statement is filed in response to the official letter or the defendant states that he/she does not intend to file a counter-statement, the defendants will forfeit the right to take any further part in the proceedings:

- In section 72 revocation cases (see MOPP 72.09) the HO is then asked to consider whether each specific fact as it is set out in the statement is conceded, except insofar as it is contradicted by other documents available to him. If on this basis it is determined that a ground has been made out, then the patent will be revoked. However, if it is the preliminary view of the Office that no ground has been made out, then the claimant should be informed of this view and offered a hearing before the application is dismissed.
- For all other cases, the HO is asked to consider the case. Again he will largely follow the practice as laid down in MOPP 72.09. He will give such directions as he sees fit. He may require that the claimant files evidence concerning specific points raised in his case before coming to a final decision.

**PDAX:-** Create letter and import (doc code is LETTER-IP)

Doc code for counter-statement is D-COUNTER ST.

Doc code for EOT request is EOT-REQUEST

Where appropriate create minute to HO and import. Send message "PSM".

## **DUTY TO COPY TO OTHER SIDE**

### Fundamental principle of practice

16.43 In *inter partes* proceedings, there is a fundamental principle of practice whereby each party has a duty to copy to the other side any correspondence filed by them at the Office. This duty is laid down in *VNU Business Publications B.V. v Ziff Davis (UK) Limited* [1992] RPC 269, a case concerned with copyright, where it was held that:

“There is a general principle that a properly interested party must have the right to see all the information put before the judge, to comment on it, to challenge it and if needs be to combat it, and to try to establish by contrary evidence that it is wrong. It cannot be withheld from him in whole or in part.”

16.44 As such, in patent proceedings the Office will copy the Statements of Case to the other side. With regard to evidence however, the parties will be invited to send a copy to each other and to the Office.

16.45 In the Design Right (proceedings before comptroller) Rules 1989, the duty to copy to the other side is clearly stated with regard to the counter-statement, though the Office is obliged initially to send a copy of any statement filed to the other side. With regard to evidence, in that the comptroller may give such directions as he thinks fit, the parties are requested to copy any documents filed at the Office to the other side.

### Correspondence

16.46 Correspondence received in the Office from one party may already have been copied to the other side. If this is the case, such correspondence will usually indicate this by use of the abbreviation ‘cc’ followed by the name of the other side’s attorney. In such a case, there would be no need for the Office to copy such a letter to the other side.

16.47 If it is not clear whether the correspondence has been copied to the other side, then the correspondence should be forwarded as soon as possible under an official letter. If no action needs to be taken by the other side, it may be sufficient for the letter merely to state that the correspondence (give details eg date and from whom) is enclosed for information purposes.

## Unpublished patent applications

16.48 Section 118 and rule 55 do not authorise us to inform a claimant of a patent applicant's address for service in respect of unpublished patent applications. Consequently, the following procedure should be followed:

- The patent applicant should be contacted and asked if he is willing for us to disclose his address for service.
- If he is unwilling for us to do so, then any letter heading indicating the address for service of the patent applicant should be blanked out when copying correspondence to the claimant (see 1.21 – 1.23)
- The claimant should not receive copies of letters sent to the named inventors for applications that are unpublished.

## **UNCONTESTED ENTITLEMENT CASES**

16.49 If in any entitlement proceedings under sections 8, 12 or 37, no counter-statement is filed after due warning has been given to the defendants (**see No counter-statement filed above**), the reference is treated as uncontested.

16.50 The case should be referred to the HO who will then consider it as if each specific fact set out in the statement were conceded, except insofar as it is contradicted by other documents which are available to the HO.

16.51 The HO may give such directions as he sees fit, including provision of evidence.

16.52 If he is satisfied that the entitlement should be awarded to the claimant, he will issue a decision on an *ex parte* basis.

**PDAX:-** Create minute and import (doc code is MINUTE-IP).

Create message and send to HO. Message = "PSM"

## PARALLEL PROCEEDINGS/CONSOLIDATION OF SUBSEQUENT REFERENCES/APPLICATIONS

### Parallel proceedings

- 16.53 There are instances where it may be appropriate for *inter partes* proceedings to run in parallel, for example, where a number of parties oppose a patent proprietor's application to amend a granted patent. In these instances, either the HO or the parties will suggest that consideration should be given to running the proceedings in parallel.
- 16.54 Where agreement is given by the parties, an official letter will be issued noting the agreement of parallel proceedings, a copy of which should be placed on the dossier. The PDAX dossier should be cross referenced to show proceedings are running in parallel.
- 16.55 It may be possible to set the same periods of time for filing evidence for all of the parties who are involved in those particular proceedings. Alternatively, it may be necessary to revise the timetable in agreement with the parties and with the consent of the Hearing Officer

**PDAX:-** Minute each dossier to show proceedings are running in parallel and list the various patents involved (see 1.10)

### Consolidation of proceedings

- 16.56 Where a subsequent reference/application is filed involving the same parties as one currently before the Office, a request may be made for consolidation of the proceedings. The proceedings may be, for example, for the same section of the act in respect of different patents or for different sections of the act in respect of the same patent.

- 16.57 The evidence filed in both sets of proceedings ie the earlier, and later case, will then cover both (or more) sets of proceedings which will save the need for duplication of evidence.
- 16.58 Where a request is received, the view of each party should be sought prior to submitting the matter to the HO for consideration. The HO will give the request due consideration ie he will consider, for example, the stage reached in the earlier proceedings and the overall effect on the timetable and any hearing date already agreed. All documents relating to the request should be filtered into the Inter Partes Preliminary Issues folder on the PDAX dossier.
- 16.59 Where the request is allowed, an official letter will then be issued to the parties to confirm that the proceedings are going to be consolidated. The letter will normally clarify any matters outstanding and any time periods which should be met. The PDAX dossier should be cross referenced to show the proceedings have been consolidated and should indicate clearly the lead dossier. If the request is declined an official letter should be issued setting out the reasons for this.

**PDAX:-** Label the front cover of each dossier to show proceedings have been consolidated and place a minute on the dossier listing the various patents involved. State clearly which is the lead dossier and include that all correspondence received from the evidence rounds onwards is to be added to the lead dossier only (see 1.10).

#### Un-consolidation of proceedings/parallel proceedings

- 16.60 At any time it may be decided that the proceedings should run independently. This may occur if a reference/application has been withdrawn.
- 16.61 Where we un-consolidate proceedings, the case will be referred to the HO for him to take note. A letter will then be issued to the parties confirming the



proceedings are now running independently. The front of the proceedings dossier should be updated.

**PDAX:-** Untick the consolidated proceedings label on the front cover of each dossier.

## **ADDING, STRIKING OUT OR SUBSTITUTING PARTIES**

- 16.62 Generally, in proceedings before the comptroller, it is possible to add or substitute a party. When such a request is made, the comments of the other party should be obtained. The HO should then be asked to consider the request. All documents relating to the request should be filtered into the Inter Partes Preliminary Issues folder on the PDAX dossier.
- 16.63 Where one of several claimants wishes to withdraw from the proceedings or the defendants believe that one of the claimants has no cause of action, the HO may strike out that party.
- 16.64 If a party is struck out, the statement or counter-statement should be amended as appropriate. Amendment of any relevant form will also be necessary.
- 16.65 If any party is added or substituted in proceedings, then they may either amend the submitted statement or counter-statement or be given the opportunity to file a further statement or counter-statement.
- 16.66 Any new party must be given the opportunity to play a full part in the subsequent proceedings.

**PDAX:-** To amend a document on PDAX, use the Enhance function and amend the document accordingly.

## WITHDRAWAL OF APPLICATION/REFERENCE

16.67 In *inter partes* proceedings, the Office may be advised at any time throughout the proceedings that an application/reference is to be withdrawn. This is normally due to the parties concerned having reached a settlement and it will therefore not be applicable for the application/reference to proceed before the comptroller.

**PDAX:-** The document code is AGNTL-IP and should be annotated

If letter refers to withdrawal, B2 case officer should add annotation "Withdrawal request".

If the case needs to be referred to HO, Case Officer will need to create minute and manually import. Send Message = "PSM".

Any letters issued should be created and imported.

Letter of withdrawal is received from the claimant and refers to the matter of costs being waived by both parties

16.68 The B2 will write to both parties noting the withdrawal. The letter will also state that, in the absence of comments within 14 days, the Office proposes to treat the matter as withdrawn leaving no matters outstanding. (See Annex 1) The B2 should also inform the HO of the withdrawal. Any outstanding issues will be dealt with by the B2 and may need to be raised with the HO. In the absence of comments, the B2 will issue a further letter informing the parties that the Office is treating the matter as withdrawn. (See Annex 2) If a letter of withdrawal is received from the defendant it will be necessary to obtain a letter of withdrawal from the claimant before taking action on the withdrawal. The case may then be cleared.

Letter of withdrawal is received but does not mention costs

16.69 The B2 will write to both parties stating that in the absence of comments within 14 days, the Office proposes to treat the matter as withdrawn leaving no matters outstanding. (See Annex 1) The B2 should also inform

the HO of the withdrawal. Any outstanding issues will be dealt with by the B2 and may need to be raised with the HO. In the absence of comments, the B2 will issue a further letter informing the parties that the office is treating the matter as withdrawn. (See Annex 2) The case may then be cleared.

Letter of withdrawal is received from both parties and both confirm that the matter of costs has been resolved

- 16.70 The B2 will forward the file to the HO with a recommendation that a letter is issued noting that the matter is withdrawn leaving no matters outstanding.

Withdrawal of claimant in section 72 proceedings

- 16.71 For withdrawal in revocation proceedings see Chapter 14.

**SECURITY FOR COSTS**

- 16.72 In many proceedings, where a claimant neither resides nor carries on business in a state that is party to the Brussels Convention, the comptroller can require them to give security for costs under, for example, section 107(4) of the Patents Act 1977 or rule 22(2) of the Design Right (Proceedings before comptroller) Rules 1989, before allowing the proceedings to continue.
- 16.73 Unless the defendant in proceedings makes a request for security for costs, (see rule 85), there is no need to pursue the matter. If a request is made, the matter may be referred to a HO as he or she may need to advise on the appropriate level of security. Instead of a standard amount such as £900 (as previously) the award should be determined, after consideration of argument and, if necessary evidence, wholly on a case by case basis appropriate to the estimated costs likely to be awarded at it's conclusion (see TPN 2/2000 - paragraph 16). A party can take payment to his/her solicitor to hold for the paying party (see Civil Procedure Rules 25.12 for

further information on the manner of payment). The Office also operates an account in the name of third parties in which money can be held. This may be relevant where security for costs is ordered and the party is a private applicant. All documents relating to the request should be filtered into the Inter Partes Preliminary Issues folder on the PDAX dossier.

**PDAX:-** The document code is AGNTL-IP.

If letter refers to security for costs, B2 case officer should add annotation "Request for security for costs".

If the case needs to be referred to HO, Case Officer will need to create minute and import. Send Message = "PSM".

Any letters issued should be created and imported using manual import.

## **ENFORCEMENT OF COURT ORDERS**

16.74 If a party wishes to enforce an order made by a specific court, it is necessary to apply to the same court in order to request enforcement of the court order.

## **FILING DOCUMENTS BY FACSIMILE IN INTER PARTES PROCEEDINGS**

16.75 In all inter partes proceedings before the Office, facsimile filed documents do not need to be followed by confirmation copies through the normal postal system, unless specifically requested.

16.76 If the facsimile copy is of poor quality it will be necessary to request the original document. (See Tribunal Practice Notice 4/2008).

16.77 Where a party files a document by facsimile only they must make the original available on request.

## **WITHOUT PREJUDICE” COMMUNICATIONS**

16.78 Documents marked “without prejudice” should be treated as privileged. (See Hearings Manual). If a party files such documents in proceedings before the comptroller and is the originator of the documents, the party will be taken to have waived privilege and the documents will be treated as OPI. If the documents are filed by a party other than the originator, the party concerned should contact the originator to request that they waive their privilege so that the document can be entered into the proceedings. If this is refused, the document and all references to it, and/or its content should be removed from the proceedings. Should “Without prejudice” documents be filed at any time within proceedings, they should be annotated “without prejudice” and NOPI and the Hearing Officer notified. The Hearing Officer will determine the status of the documents and whether they may be OPI and admitted into the proceedings.

## ANNEX 1

### No counter statement filed

**Your Reference:**

**Our Reference:**

Date

Dear Sirs

**Patent No \*\*\*\*\* (\*\*\*\*\*): \*\*\* under Section \*\*\* of the Patents Act 1977 by \*\*\*\*\***

I refer to the claimant's letter dated xxXXxx advising the Office that the above proceedings are now withdrawn.

Both parties are now advised that in the absence of any comments being filed within 14 days of the date of this letter, the Office proposes to treat the matter as withdrawn leaving no matters outstanding.

Any comments should be filed by xxXXxx.

A letter in identical terms has been sent to both parties.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## ANNEX 2

**Your Reference:**

**Our Reference:**

Date

Dear Sirs

**Patent No \*\*\*\*\* (\*\*\*\*\*): \*\*\* under Section \*\*\* of the Patents Act 1977 by \*\*\*\*\***

I refer to the claimant's letter dated xxXXxx advising the Office that the above proceedings are now withdrawn and our letter dated xxXXxx informing both parties that the Office proposed to treat the matter as withdrawn leaving no matters outstanding in the absence of any comments being filed by xxXXxx.

No comments have been filed by either party. Therefore the proceedings are now treated as withdrawn.

A letter in identical terms has been sent to both parties.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## CHAPTER 17

### APPLICATION TO AMEND THE SPECIFICATION UNDER SECTION 27

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# **APPLICATION TO AMEND THE SPECIFICATION OF A PATENT UNDER SECTION 27**

## **INTRODUCTION**

17.01 This section is concerned with the amendment of the specification of a granted patent on an application made by the proprietor of a patent. The detailed provisions are set out in The Patents Rules 2007 and Section 27 of the Manual of Patent Practice. Section 76 sets out limits on what may be allowed as an amendment. Sub-section 76(3)(a) & (b) indicate that no amendment of the specification of a patent is allowed under Section 27(1) if it:

- results in the specification disclosing additional matter, or
- extends the protection conferred by the patent.

## **MAKING AN APPLICATION**

17.02 For proposals to amend under Section 27, applicants need to file the application identifying the amendment and stating the reasons for it. If reasonably possible to do so, the proposed amendment and the reasons for it should be set out and delivered to the comptroller electronically.

Amendments to EP and GB patents are processed electronically on PDAX. For amendments to an EP(UK) the A3 will contact Index & Scanning Section to request a dossier to be set up. The Section 27 application to amend is recorded on the Exparte Post Grant SharePoint List.

If an EP paper case already exists, this is requested from NMP and scanned onto the dossier along with the application for amendment by Index and Scanning section. If no paper file exists, a BDOC is requested and is scanned onto the dossier along with the application for amendment.

## EPC 2000 – Central Limitation Process

17.03 Following the introduction of the central limitation process, an EP (UK) patent may now be amended centrally at the EPO as well as in each individual contracting state. On receipt of a new S27, the Register Plus website <https://register.epo.org/espacenet/regviewer?lng=en> should be checked to determine whether there is a request to centrally limit an EP (UK) patent. If so, the A3 should establish whether the applicant wishes to stay the UK proceedings until the conclusion of the EPC process or wishes to proceed. A standard letter is issued offering these options. (see annex 8).

A file note should be prepared as follows:

*O/L issued on XX.XX.XX. B/F for 1 month (always to a Wednesday).  
Update Diary EX2 task list within Outlook.*

## **DIRECTIONS FOR THE ELECTRONIC DELIVERY OF APPLICATIONS**

17.04 Electronic delivery of amendments should be made by e-mail to [litigationamend@ipo.gov.uk](mailto:litigationamend@ipo.gov.uk) and accompanied by an identifying letter.

### By e-mail

17.05 The Office will not accept an e-mail for these purposes at any e-mail address other than that given above. The e-mail should be a plain text message.

The e-mail should be entitled “*A proposal to amend under s27*”

The text may be provided as an attachment to the e-mail.

If the Office is unable to read the text, the email will be treated as not delivered, and in these circumstances the A3 should contact the applicant with a view to making alternative arrangements.

### Setting Out The Amendments

17.06 Applicants are encouraged to use conventional word processing features such as markup, coloured text and strikeout/strikethrough to set out the amendments on the original version of the text in a way that makes it easy for the reader to appreciate the changes. However, if the amendments are extensive, replaced pages are required (see annex 7).

### Action on receipt of the amendments

17.07 The A3 should undertake checks to ensure that all appropriate details are provided.

### **INITIAL ACTION – FORMALITIES CHECKS**

17.08 On receipt of an application the A3 will :

- arrange for the application to be indexed and scanned as a PDAX case. Ensure that a date stamp is applied to the amendments.
- enter the application on the Exparte Post Grant SharePoint List
- make a free text entry on OPTICS using REG ENT – *Application to amend the specification under Section 27 filed on DD MMM YYYY*

17.09 The new case will be placed by Index and Scanning in the Litigation team mailbox to be actioned by a member of the ex parte team.

17.10 The A3 carries out formalities checks to ensure that the relevant patent rule has been complied with (rule 35). Once any defects in the application have been resolved with the applicant, an initial advert is prepared for the Journal. (see Annex 10). The advert is prepared whether or not formalities are

complied with. This advert should be copied to SharePoint and a copy placed in the Journal file. The advert will appear in the Journal 3 weeks from the last Wednesday after the advert is prepared and submitted to Publishing. The case should then be referred to the appropriate Head of Examination Group who will report on the proposed amendments. The dossier should be minuted with any actions taken.

A file note is created on PDAX.

Advert is created and imported on PDAX (doc code is ADVERT).

## Formalities

17.11 The application for amendment is checked to ensure:

- the applicant's name is on the application, refer to 17.34
- a current address for service is provided in the UK, an EEA state or the Channel Islands,  
if the AFS provided does not match the register, refer to 17.35
- documents referred to in the application have been submitted, refer to 17.36
- it identifies the proposed amendments and reasons for the amendment are given, refer to 17.38
- for EP patents, EP opposition period has expired or no opposition pending, refer to 17.41
- the application is correctly applied for as an amendment and not a correction, refer to 17.48 (see annex 11)
- the patent has been granted, refer to 17.49
- there is no outstanding revocation or infringement action, refer to 17.58
- that any documents given as supporting evidence and not published in English are accompanied by a translation, refer to 17.62
- patent is not ceased, refer to 17.67
- for EP patents, the specification on the dossier is the latest version - use Register Plus, refer to 17.03

- for EP patents, there are no central limitation proceedings ongoing, refer to 17.03
- for requests to amend the specification, ensure the relevant documents on the dossier are annotated “P” and “working copy”, then check that the correct version of the specification is being utilised. If not, refer to the Index and Scanning manager to action.
- Save the amendments within PDJ Store on SharePoint under “amendments to be advertised”

## **FORMALITIES COMPLIED WITH**

17.12 The following procedure relates to an amendment where all formalities have been complied with. A file note is created on PDAX as follows:

*New S27. Formalities complied with, initial advert prepared for PDJ xxxx (Dated xxXXxx).*

Advert is created and imported on PDAX (doc code is - ADVERT) and is annotated ‘Initial Advert PDJ xxxx dated xxXXxx’. (see annex 9)

### Referring the Application

17.13 Once all formalities have been complied with, the application should be referred to the Head of Examination Group in charge of the subject matter to which the specification relates. A minute should be prepared for the dossier as follows:

Case referred for report under section 27 of the 1977 Patents Act (MoPP 27.07 refers)

To refer a case to the DD, create a minute on PDAX, then create and send

a “PSM – New S27” message

#### Section 27 Application Derived from Section 73(2) Conflict

17.14 If both the GB and the EP patents require amendment in order to remove any conflict, the GB patent is amended under S73(2) and the European patent is amended under S27.

When the amendments are received, carry out formalities checks as per standard process. When any issues have been resolved, refer both sets of amendments to the Head of Examination Group of the S73(2) examiner and explain that amendments have been proposed to both the GB and EP patent.

Once it has been determined that the combination of the two sets of amendments remove the conflict and hence avoid revocation of the UK patent, the EP(UK) amendments are advertised for opposition and the amendments to the UK patent will be stayed until the opposition period has expired. (If a third party opposes the amendment, the conflict is not removed and revocation action is still outstanding.)

The amendments are only applied to both patents and a modified Decision 1 is prepared once the S27 opposition period has expired and it is confirmed that no opposition has been filed.

#### Head of Examination Group’s Report For GB & EP (UK) Patents

17.15 The amendments must comply with Section 76(3) i.e. - amendments must not add matter, nor must they extend the protection conferred by the patent. The reasons for the amendments have to be sufficient and the proprietor is under an obligation to show that they meet all the legal requirements.

#### **AMENDMENTS ARE *PRIMA FACIE* ALLOWABLE**

17.16 The Head of Examination Group will report that he/she considers that the



amendments appear to be *prima facie* allowable, that they are to be advertised, and that the applicant is to be informed. If the report states that the amendments are not allowed, refer to 17.74 or if not to be proceeded with, refer to 17.79.

The A3 Litigation Officer should:

- Prepare the Journal Opposition Advert (see annex 5). The A3 will indicate on the advert whether the amendment has been filed electronically or on paper.
- Complete the summary listing on SharePoint whether the amendments have been filed electronically or in paper form.
- Issue S27A(I) letter (see annex 3) for GB cases advising the applicant when the notice of proposed amendments will be advertised in the Journal or Issue S27A(II) letter (see annex 4) for EP(UK) cases where EP opposition proceedings are pending or Issue S27K letter (see annex 14) for amendments to an SPC

The opposition period lasts four weeks from the date of the published advert in accordance with Section 27(5) and rule 75.

Advert is created and imported by using the Manual Import function on PDAX (doc code is ADVERT).

Letter created, locked and imported from PROSE.

17.17 All electronic filed amendments are located on SharePoint under PDJ Store. These are checked and prepared so that the team compiling the web adverts can clearly identify the correct amended copy before sending to webmaster.

17.18 Webmaster will then arrange a link from the journal notice to the full details of the amendment (electronic amendments only). Where the amendments have been filed in paper form only, full details will be available from

Litigation Section upon request. These should be issued on request by fax or post as appropriate.

17.19 A copy of the advert is placed on the dossier and in the Journal file. The advert is then annotated on PDAX as 'Opposition Advert PDJ XXXX dated xxXXxx'.

17.20 A file note should be prepared as follows:

*Opposition advert prepared for PDJ XXXX (dated xxXXxx.) Letter issued to attorney xxXXxx B/F for four weeks and 1 week from the date of advert for opposition. (Always to a Wednesday).*

File note is created on PDAX. Update Diary EX2 task list within Outlook.

17.21 If opposition is filed, refer to 17.85. The application will then be progressed as an Inter Partes case. If no opposition is filed proceed to amend the specification.

## **APPLY AMENDMENTS & CERTIFICATES**

Where no opposition has been received or opposition proceedings concluded, the proposed amendments should be applied to the original specification.

17.22 For amendments to GB specifications

The description, claims and drawings annotated "P" and "working copy" are copied from PRE-GRANT into the LITIGATION section of the dossier. The amendments are then applied using the assemble and enhance functions. The amended sections of the specification are annotated "C" and "working copy" along with any copied sections not amended. The references to "P" and "working copy" in the original copied documents are deleted. This enables Publishing Section to extract all the documents required to produce

a “C” specification.

For amendments to EP specifications

For amendments to EP patents, if the amendments cannot be applied using enhance or assemble, a copy of the BDOC should be printed from the dossier and the amendments applied manually. The amended BDOC should then be scanned onto the dossier.

- 17.23 If the amendments are extensive and no replacement specification has been filed, one may be requested from the attorney. Issue letter S27(f) (see annex 8).

Letter created, locked and imported from PROSE.

- 17.24 Where a GB or EP complete Replacement Specification has been filed the A3 will ensure that the amendments made are in fact the same as those allowed by the Head of Examination Group. A file note is created on PDAX as follows:

*Specification checked. Please confirm that the amendments incorporated into retyped specification are as advertised and allowed.*

- 17.25 Once the patent is amended or the amended EP BDOC is scanned onto PDAX, the amended patent should be referred to the appropriate Head of Examination Group. A file note should be prepared as follows:-

*No opposition filed to the amendment under section 27. The amendments have been applied to the description/claims/drawings.*

*The description, claims and drawings have been annotated C and working copy in order for publishing to produce a C specification.*

*Please confirm that I can now add your signature to the appropriate certificate.*

Create a minute on PDAX, then send a “PSM – S27 Amends applied and

confirm certificate” message.

## **CASE RETURNED FROM HEAD OF EXAMINATION GROUP WITH AUTHORISATION**

17.26 Once a message is received from the Head of Examination Group, an appropriate certificate should be created and a signature applied. This should then be passed into a word document and imported into the dossier using manual import on PDAX (doc code: CERTIFICATE). The certificates are located on SharePoint and depend upon whether the proprietor’s amendments are for a replacement specification, amendments to the claims/description/drawings or replacement pages.

## **CLEAR RECORDS – AMENDMENTS ALLOWED**

17.27 Once the amendments are allowed, clear records action may be undertaken. A final advert should be prepared for the Journal and the Exparte Post Grant SharePoint List and OPTICS are all updated as detailed below. A clear records proforma is used as a checklist and to inform Publishing Section of the actions to be taken.

A File note is created on PDAX to clear records.

### Final advert

17.28 A final advert should be prepared for the PDJ. This advert should be copied to SharePoint - PDJ Live library and a paper copy placed in the Journal file. The advert will appear in the Journal 3 weeks from the first Wednesday after the advert is prepared and submitted to publishing.

Advert is created and imported using manual import on PDAX (doc code is ADVERT). This is then annotated on PDAX as ‘Final Advert PDJ xxxx dated

xxXXxx'.

### Exparte Post Grant SharePoint List

- 17.29 The relevant entry on the Exparte Post Grant SharePoint List under Section 27 should be updated to show the outcome of the application and the date of the clear records action.

### OPTICS entry

- 17.30 A free text entry should be made on OPTICS indicating the outcome of the application. Use the REG ENT option as follows:-

*Application to amend the specification under Section 27 filed on XX.XX.XX allowed on XX.XX.XX.*

### File referred to Publishing Section/Index and Scanning

- 17.31 If the amendments have been allowed, a request is made to Publishing Section for a 'C' specification. The amended document (s) should be annotated "for publishing purposes". If the 'C' specification was amended, then a 'C2' is requested.
- 17.32 To refer a case to Publishing, a detailed minute should be prepared for publishing (see Annex 12) and also a "PSM – S27 allowed, please prepare a C spec" message to the Publishing Team Mailbox. Publishing Section will then prepare a letter notifying the applicant that the amendments advertised have been allowed and attach a copy of the 'C' specification.

### File returned to Litigation for Clear Erratum

- 17.33 When the Publishing team has produced a 'C' specification, they will notify

Litigation section for erratum purposes. The A3 should review the revised specification and ensure that the amendments have been applied correctly.

## **FORMALITIES NOT COMPLIED WITH**

### Applicant does not match registered proprietor

17.34 The application should be cross-referenced with the OPTICS register. Where there is a discrepancy, the attorneys should be contacted to check proprietorship.

### New attorneys

17.35 If new attorneys have been mentioned on the application, a Patents Form 51 is required. However, if they are only authorised to act with regard to the amendment, no form is necessary. Only correspondence relating to the amendment will be sent to the attorney named on the request and the address for service on the register will remain the same.

### Copies of documents

17.36 Copies of any documents referred to in the application, but not supplied, should be obtained. If any of the documents referred to are not available in the Office, the applicant should be asked to supply copies in accordance with rule 82(1)(a) of the relevant patent rules, before the application is referred to the Head of Examination Group. A period of one month should be given for reply.

17.37 The Patent Rules provide an additional automatic extension of two months for periods not specified in the rules. This may be applied for retrospectively.

As a result, the case should be diaried for one month and a further two months from the date of the letter.

Letter created, locked and imported from PROSE.

File note is created on PDAX. Update Diary EX2 task list within Outlook.

#### Proposed amendments identified and reasons for amendment given

17.38 The A3 should check that the amendments proposed have been identified and the reasons for amendment have been given before referring the application to the Head of Examination Group. If these have not been supplied, the attorney must be contacted and requested to file the necessary documents.

#### EP opposition period

17.39 An EP patent has a nine month opposition period during which opposition proceedings may be taken out and the patent may be amended before the EPO as part of the proceedings. The opposition period begins once the patent is mentioned in the European Patent Bulletin. This date can be found on OPTICS. To determine the status of opposition proceedings a print is obtained from the EP on-line register.

17.40 If an EP patent which designates the UK is amended during opposition proceedings before the EPO, and the EPO's decision is that the patent should be maintained in the amended form, the amendments automatically apply to the European patent (UK) (MOPP 27.05.1). Therefore action under Section 27 with regard to those amendments is not necessary.

#### Opposition Period has not expired and/or opposition proceedings are pending

17.41 Where the EPO opposition period has not expired or when EPO opposition proceedings are pending, amendments can proceed under Section 27. This

is due to the fact that opposition proceedings may take some time to resolve, in which time the European patent (UK) may be invalidated due to infringement or revocation in the UK before the Office or the courts, before the EP opposition amendments are allowed. An applicant may write to inform us that he is aware of the situation but wishes to proceed regardless. Applicants are usually aware that the amendments may be negated as a result of subsequent amendment before the EPO. The file note should be prepared as follows:-

*New S27. Formalities not complied with, initial advert prepared for PDJ xxxx (dated XX.XX.XX) Although the opposition period has not yet expired/the opposition proceedings are pending (delete as appropriate), the attorneys state in their letter dated XX.XX.XX, that they wish to proceed regardless. Case referred for report under Section 27 of the 1977 Patents Act. (MoPP 27.07 refers).*

- 17.42 Where the applicant has not sent us a letter acknowledging that the opposition period has not yet expired and/or opposition proceedings are pending, a standard letter S27C (see Annex 1) is issued giving the applicant the option of either:

staying the request until the opposition period has expired or the opposition proceedings have been settled

or

proceeding with the request under Section 27 on the understanding that the desired amendment may be negated as a result of the subsequent amendment before the EPO.

- 17.43 The minute should be prepared on PDAX as follows:-

*Official letter issued to attorney on XX.XX.XX. B/F for 1 month (always to a Wednesday).*



17.44 The case should be diared for one month and a further two months from the date of the letter. Diary EX2 should also be updated within Outlook.

#### Response To Official Letter - Opposition Period

17.45 The response to the Official letter should be referred to the Head of Examination Group with one of the following minutes according to the nature of the reply:

If the applicant wishes to stay:

17.46 A minute should be prepared for the dossier as follows:

*Attorneys have replied to Official Letter dated XX.XX.XX and have asked to stay the proceedings until the opposition period has expired or the proceedings have been settled. See A/L dated XX.XX.XX*

On return from the Head of Examination Group, B/F the case until the expiry date of the opposition period, or until the opposition proceedings have been settled. During this period, an Official Letter should be issued every 6 months requesting updates on the proceedings. Once the proceedings and expiry date have passed, the case should be referred to the group head with a minute note as follows:

*Case referred for report under Section 27 of the 1977 Patents Act (see para 27.07 MOPP).*

If the applicant wishes to proceed:

17.47 A minute note should be prepared for the dossier as follows:-

*Attorneys have replied to Official Letter dated xx.XX.xx and have asked to proceed regardless. See attorneys letter dated xx.XX.xx . Case referred for report under Section 27 of the 1977 Patents Act (see para 27.07 MOPP).*

### Is the application an Amendment or a Correction?

17.48 The application should be checked to ensure that the applicant has applied the term “amendment” in the correct manner (see Chapter 24 for a description of what constitutes a correction). If it appears that the application is a correction rather than an amendment, the case should be minuted to the appropriate Head of Examination Group for consideration.

Create a minute on PDAX, then send a “PSM – S27/S117 Referral” message to DD.

Where the group head agrees that the case should proceed as a request for correction under Section 117 rather than an application to amend under Section 27, letter S27J (see Annex 13) is to be issued to the proprietor.

### Has the patent been granted?

17.49 An application to amend under Section 27 cannot be actioned by Litigation Section until the granted patent has been published in the Journal or the EP Bulletin. The status of the patent should be checked on OPTICS.

### GB cases

17.50 A DIS FUL will show two dates in connection with the granting of the patent. The first relates to when the applicant was notified by the Formalities Section that the patent was to be granted. The second gives the date when the notice of the grant is published in the Journal.

17.51 If an application to amend is filed before the first date is recorded on OPTICS, the application should be referred to the relevant Formalities Section for amendment under Section 19 (General Power To Amend Before Grant).

To refer to Formalities, create a minute on PDAX, then send a “PSM –

Amendment” message to the relevant Formalities Team Mailbox

- 17.52 Where an application is filed between the two dates, the applicant should be informed that they have filed too early and the Office will therefore stay the proceedings until the notice of grant has been published in the Journal. The application will then be considered to be filed on the day the notice is published in the Journal. The applicant should also be informed of any other defects in the application.
- 17.53 The case is then diaried until the date of the Journal containing the notice of grant. A file note is created on PDAX noting any action taken.

#### EP cases

- 17.54 An application to amend under Section 27 cannot take place until the fact that the patent has been granted is published. This date affects all provisions of the Act from Section 25(1) onwards.
- 17.55 An application to amend a European patent (UK) cannot be considered until the date on which its grant is mentioned in the European Patent Bulletin. OPTICS will show the date on which the patent will take effect, i.e. the publication date.
- 17.56 If an application is filed before this date, the applicant should be informed that they have filed too early and the Office will therefore stay the proceedings until the patent has been mentioned in the EP Bulletin. The application will then be considered to have been filed on that date. The applicant should also be informed of any other defects in their application.
- 17.57 The case is then diaried for the date of the Bulletin mentioning the patent. A file note of action taken should be prepared for the dossier.

#### Outstanding Revocation or Infringement Action

- 17.58 Where the validity of the patent may be put at issue (see Section 72), and proceedings are pending before the court or Comptroller, e.g. revocation or infringement action, an application under Section 27 is not allowed. This is in accordance with Section 27(2). In such circumstances the applicant should be informed that while proceedings are pending, (until the period of appeal has expired and any appeal has been determined) amendment can only be made under Section 75.
- 17.59 To check proceedings against a GB or EP (UK) patent, you should check the below the line entries on OPTICS using the DIS FUL function and any correspondence concerning the patent.
- 17.60 Where a European patent (UK) is undergoing opposition proceedings before the EPO, amendment may still proceed under Section 27 (see paragraph 17.47).
- 17.61 If the applicant wishes to stay the proceedings until court action has been finalised, the case should be diaried until the Court action is completed. When the Court action has been completed, the application may proceed as long as all formalities are complied with. A minute of action taken should be prepared for the dossier.

File note is created on PDAX.

Letter created, locked and imported from PROSE

### Non-English Documents & Translations

- 17.62 Any documents filed as supporting evidence and not published in English should be accompanied by a copy of a translation in accordance with rule 113.
- 17.63 Where a non-English European patent (UK) is cited in evidence, and there is no accompanying translation, a check should be made to see whether

under Section 77(6)(a) translation of the published specification has previously been filed. Check OPTICS or the DIS FOR (DISPLAY FORMS HISTORY) screen (No 10 from the Common Enquiry Menu) and check if a Patents Form 54 (the filing of a translation) has been filed.

- 17.64 If a translation has been filed, the EP file in question should be requested from NMP. The translation and accompanying Patents Form 54 will be found in the main EP file. If the EP case is electronic, locate the required documents on the PDAX dossier.
- 17.65 If no translation has been filed, the applicant should be requested to file a copy of a translation of the cited specification and/or the non-English documents in accordance with the Patents Rules. This should be done before the application is referred to the Head of Examination Group. A period of one month is given for reply. A file note of action taken is prepared for the dossier.
- 17.66 The Patents Rules provide an additional automatic extension of two months for periods not specified in the rules. This may be applied for retrospectively. As a result, the case should be diaried for one month and a further two months from the date of the letter. Update Diary EX2 task list within Outlook.

#### Patent Ceased

- 17.67 A ceased patent may also be amended, though this would be a matter for the Head of Examination Group to consider. Providing all the formalities have been complied with or resolved, the application should be referred to the appropriate Head of Examination Group for consideration as usual.

### **PROBLEMS ARISING FROM REFERRAL OF AMENDMENTS TO THE HEAD OF EXAMINATION GROUP**

#### Amendments not *prima facie* allowable

- 17.68 The Head of Examination Group will report giving reasons why any amendment or group of amendments are not regarded as *prima facie* allowable. He/she will advise on any amendments which he/she considers should also be submitted. An e-mailed version of the report may be sent by the Head of Examination Group for incorporation into a letter. The applicant may also be given the option of withdrawing all proposed amendments or not proceeding with amendments that appear to be not *prima facie* allowable.
- 17.69 The A3 should draft a letter inserting the Head of Examination Group's report together with his name and telephone number e.g. *I refer to your application for amendment filed on XX.XX.XX, the examiner (Mr/Mrs ..... Tel..... ) has reported the following: ..... (see Annex 2).*  
If no reply date is noted by the Head of Examination Group, a period of 2 months should be specified.
- 17.70 Diary EX2 should also be updated.  
File note is created on PDAX.  
Letter created, locked and imported from PROSE
- 17.71 Any further amendments received in response to the Official letter, should be referred back to the Head of Examination Group with the following minute on the dossier:  
  
*Attorneys have replied to the official letter dated XX.XX.XX and have stated in their letter dated XX.XX.XX that ..... For your consideration, please.*  
  
Create a minute on PDAX, then send a "PSM – S27 Response to exam report" message
- 17.72 The Head of Examination Group will produce a new report and again a letter should be prepared and issued by the A3 (see Annex 2). This action continues until a set of amendments are produced that appear to be *prima facie* allowable, the amendments will then be advertised.

Where further amendments are not considered to be allowable, the applicant will be notified of the group head's decision using letter S27O (see Annex 16) offering the applicant the opportunity for a hearing. Where no hearing is requested the A3 will clear records as 'Section 27 not allowed/refused'. (See Clear Records 17.87-17.91)

- 17.73 If an agreement cannot be reached, a hearing will be offered subject to advertisement of the proposed amendments. The advert should state clearly that the allowability of the amendments has not yet been determined. An appropriate letter will be drafted by the Head of Examination Group. A note of the action taken is then recorded on a minute on the dossier.

Advert is created and imported using manual import on PDAX (doc code is ADVERT).

Letter created, locked and imported from PROSE.

File note is created on PDAX.

If a hearing is requested, the case should be referred to the Hearings Clerk.

To refer to the hearing team, create a minute on PDAX, then send a "PSM – set up hearing" message.

If the applicant accepts the Head of Examination Group's decision, records can be cleared, refer to 17.81

#### Amendments not proceeded with

- 17.74 An application may be considered not proceeded with in the following circumstances:

- the applicant fails to file the application correctly
- the applicant requests his application is not proceeded with
- the application is a correction rather than an amendment
- the patent has been centrally limited at the EPO
- the applicant fails to respond to official letters

- an EP patent has been centrally amended during Opposition Proceedings before the EPO. Since the amendments automatically apply to the European patent (UK), action under Section 27 is not necessary.

17.75 If the Head of Examination Group considers that an application to amend should be regarded as not proceeded with, he/she will send a minute to the dossier requesting that the applicant be informed and the Journal and register updated. An additional free text entry to the register may be requested by the Head of Examination Group in order to record the reason for the application not proceeding. He/she may provide suitable wording.

17.76 The A3 should issue an official letter to the applicant informing him of the group head's decision. The A3 will select the relevant 'not proceeded with' letter ie. S27L (see Annex 13) or S27M (see Annex 14) as appropriate, alternatively the wording may be supplied by the Head of Examination Group.

Letter created, locked and imported from PROSE.

File note is created on PDAX.

The next action involves clearing records, refer to 17.81

### Withdrawal Of An Application

17.77 An application cannot be withdrawn once the applicant has been given notice that the amendments are allowable. Any withdrawal request can only be allowed at the discretion of the Head of Examination Group.

17.78 All withdrawal requests are referred to the Head of Examination Group for his consideration with a minute on the dossier as follows:

*Attorneys letter received on XX.XX.XX . The applicant has advised they wish to withdraw the application. For your consideration, please.*



Create a minute on PDAX, then send a “PSM – S27 withdrawal” message.

- 17.79 If a withdrawal is refused and the proposed amendments do not cure the specific defect identified and alternative amendments have not been submitted, the application to amend must also be refused. A register entry reflecting the fact that both the withdrawal and the application itself has been refused should be made. Suitable wording for the additional register entry concerning the refusal to allow the withdrawal should be provided by the Head of Examination Group. The applicant should also be notified of the decision.

Letter created, locked and imported from PROSE.

File note is created on PDAX.

- 17.80 If a withdrawal is allowed, the applicant should again be informed of the Head of Examination Group’s decision by issue of letter S27N (see Annex 15).

Letter created, locked and imported from PROSE.

File note is created on PDAX.

The next action involves clearing records, refer to 17.87

#### **CLEAR RECORDS – NOT ALLOWED/NOT PROCEEDED WITH/WITHDRAWN**

- 17.81 Once the applicant has been informed of the outcome of the application, clear records action may be undertaken. An advert should be prepared for the Journal and the Exparte Post Grant SharePoint List electronic ledger and OPTICS updated. The clear records proforma on word should be updated with all the actions taken.

File note is created on PDAX and titled as ‘Clear records’.

## Final advert

- 17.82 An advert should be drafted manually corresponding with the decision or directions of the Head of Examination Group. The advert should be copied to the Journal folder on SharePoint and a hard copy placed in the Journal file.

Advert is created and imported using manual import on PDAX (doc code is ADVERT)

Exparte Post Grant SharePoint List

- 17.83 The relevant entry on the Exparte Post Grant SharePoint List under Section 27 should be updated to show the outcome of the application and the date of the clear records action.

## OPTICS entry

- 17.84 A free text entry should be made on OPTICS indicating the outcome of the application. Use the REG ENT option as follows:-

*Application for amendment under Section 27 filed on DD MM YYYY not proceeded with/not allowed/withdrawn on DD MM YYYY.*

## **OPPOSITION FILED**

- 17.85 Notice of opposition should be filed on Patents Form 15 within four weeks of the date of the notice of the proposed amendments in the Journal. This period may not be extended.
- 17.86 The opposition should be referred to the B3, with an appropriate minute. It will then be processed as an *inter partes* case.

To refer to B3, create a minute on PDAX, then send a “PSM – S27(5) Opposition filed” message.

## **EXTENSION OF TIME**

- 17.87 Where an automatic extension of time has been granted and a further request for an extension of time has been received, the request should be referred to the Head of Examination Group with the following minute note:

*The attorney by phone/fax/letter on/dated XX.XX.XX has requested a further extension of time. Please advise on action to be taken.*

Create a minute on PDAX, then send a “PSM – S27 EOT request” message

- 17.88 The applicant should be advised of the Head of Examination Group’s decision and a note of the action taken entered on the dossier.

Letter created, locked and imported from PROSE.

File note is created on PDAX.

- 17.89 With regard to extension of time requests relating to an opposition to an amendment, please refer to Chapter 9.

## ANNEX 1 (Letter S27C)

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977.**

**Latest date for reply xx.XX.xx**

I refer to your application for amendment filed on xx.XX.xx .

You are advised that the nine month period allowed to oppose the European Patent (UK) has not yet expired. In these circumstances there are two options available to you

- a. staying the request until the opposition period has expired or the opposition proceedings have been settled, or
- b. proceeding with the request to amend under Section 27 on the understanding that the amendment may be negated as a result of subsequent amendment before the EPO.

Please see paragraph 27.05.1 of The Manual of Patent Practice.

You should advise me of your decision regarding the above by xx.XX.xx.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## **ANNEX 2 (Letter S27D)**

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: GB xxxxxxx (Proprietors Name)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977.**

**Latest date for reply: xx.XX.xx**

I refer to your application for amendment filed on xx.XX.xx. The examiner (Examiner's Name, Tel 01633 81xxxx) has reported the following:

If you would like to propose further amendments, you should file a consolidated version on paper and if reasonably possible to do so, electronically. The amendments should be presented in a way that allows for them to be identified.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## **ANNEX 3 (Letter S27A(I))**

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: EP xxxxxxx (Proprietors Name)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977**

Notice of your application to amend will be advertised for opposition in the Patents and Designs Journal on **xx.XX.xx**. \* As the proposed amendments have been filed electronically, they will also appear on our website from **xx.XX.xx**

A four week period from the date of advertisement will be allowed for any opposition to the proposed amendment.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

\*Text here is optional but should be included if amendments filed electronically.

## **ANNEX 4 (Letter S27A(II))**

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: EP xxxxxxx (Proprietors Name)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977**

Notice of your application to amend will be advertised for opposition in the Patents and Designs Journal on xx.XX.xx. \*As the proposed amendments have been filed electronically, they will also appear on our website from xx.XX.xx.

A four week period from the date of the advertisement will be allowed for any opposition to the proposed amendment.

The amendment appears *prima facie* allowable subject to any opposition, but may be negated as a result of any subsequent amendment before the EPO.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

\*Text here is optional but should be included if amendments filed electronically.





## ANNEX 6

### Applications for Amendment of Specification

\* These amendments have been filed in paper format. Full details of these amendments may be obtained from The Office, Litigation Section (Telephone:+44 (0)1633 814335).

| <b>Sect.</b> | <b>PDJ No. &amp; Date</b> | <b>Opposition Deadline</b> | <b>Patent No. and title</b>     | <b>Int. Class</b> | <b>Proprietor (Court action number if any and address for service)</b>                |
|--------------|---------------------------|----------------------------|---------------------------------|-------------------|---|
| 27           | 3216<br>5 Feb 08          | <b>four weeks</b>          | 2345678<br>XXXXXXXXXXXXXXXXXXXX | H04G              | XXXXXXXXXXXXXXXXXX  |
| 27<br>*      | 3217<br>6 Feb 08          | <b>four weeks</b>          | 2347678<br>XXXXXXXXXXXXXXXXXXXX | H02G              | XXXXXXXXXXXXXXXXXX  |
| 75           | 3215<br>29 Jan 08         | <b>two weeks</b>           | 2124567<br>XXXXXXXXXXXXXXXXXXXX | G22F              | XXXXXXXXXXXXXXXXXX  |
| 75           | 3214<br>22 Jan 08         | <b>14 days</b>             | 2456789<br>XXXXXXXXXXXXXXXXXXXX | A69B              | XXXXXXXXXXXXXXXXXX<br>HC 123456<br>XXXXXXXXXXXX,<br>XXXXXXXXXX,<br>XXXXXXXXXXXXXXXXXX |

**ANNEX 7  
(Letter S27F)**

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs,

**Patent number: EP (Proprietor Name)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977**

No opposition has been filed in connection with the above application. However, the amendments are extensive and, in accordance with rule 35(6), a clean version of the retyped specification incorporating all agreed amendments should be filed within one month from the date of this letter.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## **ANNEX 8 (Letter S27P)**

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

**Date**

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977**

**Latest date for reply xx.XX.xx**

I refer to your application for amendment filed on xx.XX.xx .

On checking the European Patent Office register, it appears that you have filed an application to centrally limit your patent at the EPO. In these circumstances there are two options available to you

- a. staying the request until the conclusion of the central limitation process, or
- b. proceeding with the request to amend under Section 27

If the national and central process results in different amended claims, you should be aware that there may be an issue as to which amendment takes precedence.

You should advise me of your decision regarding the above by xx.XX.xx

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## ANNEX 9

### Section 27 Application Filed

The details of the amendments proposed, which may now be inspected at the Office, will be advertised later (unless the application is abandoned); the application will then be open to opposition. The date included in the entry is the date of filing of the application.

**Patent Number**

PROPRIETOR NAME

Title of the patent

Application to amend specification under Section  
27 filed on xxXXxx

## ANNEX 10

### GB/EP

Amendment under S27 to the specification filed on xxXXxx, allowed on xxXXxx.

#### Clear Records

|                        |  |
|------------------------|--|
| <b>PDJ</b>             |  |
| <b>LEDGER</b>          |  |
| <b>OPTICS REGISTER</b> |  |

#### Publishing

Amendment filed on xxXXxx, allowed on xxXXxx.

Please prepare a C spec for the allowed amendments. The allowed amendment(s) is/are in the form of claims xxx/description pages xxx/replacement pages xxx.

\*For GB cases the claims, description & drawings have been annotated 'C' and 'For publishing purposes' for your information

\*For EP cases the BDOC has been annotated 'C' and 'For publishing purposes' for your information

The current address for service is as follows:-

The letter reference is as indicated in our letter dated xxXXxx.

Name  
Section  
Room Number Tel Ext  
Date

## **ANNEX 11 (Letter S27J)**

**Your reference:**

**Our reference:** 1R31/Name/Proprietor

Date

Dear Sirs

**Patent number: xxx (xxx)**

I refer to your letter filed xxx regarding the above named patent and proposed changes to be made due to a clerical error.

Please be advised that the changes you have requested should be filed under Section 117 Request for Correction rather than Section 27 Application to amend.

Please confirm whether you are content for us to proceed with a Section 117 Request for Correction of error to the specification.

If you have any queries regarding this matter, please contact xxx on (tel: xxx).

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## **ANNEX 12 (Letter S27K)**

**Your reference:**

**Our reference: 1R31/Name/Proprietor**

Date

Dear Sirs

### **SUPPLEMENTARY PROTECTION CERTIFICATE – SPC/xxx/xxx (Proprietor)**

#### **Application to amend the Supplementary Protection Certificate under Section 27 of the Patents Act 1977.**

Notice of your application to amend will be advertised for opposition in the Patents and Designs Journal No. xxx on xxx.

A four week period from the date of the advertisement will be allowed for any opposition to the proposed amendment.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## **ANNEX 13 (Letter S27L)**

**Your reference:**

**Our reference:** 1R31/Name/Proprietor

Date

Dear Sirs

**Patent Number : Patent Number (Proprietor)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977.**

I refer to your application for amendment filed on xxx.

As you are aware the above patent has been the subject of a request for Central Limitation at the European Patent Office which has now been concluded.

As such, patent EP(UK)xxx has been centrally amended by the European Patent Office and the Patent Register has been updated accordingly. There is also a Bx publication produced by the European Patent Office which relates to all designated states.

We will therefore record your Section 27 application to amend filed on xxx as “not proceeded with.”

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate



## **ANNEX 14 (Letter S27M)**

**Your reference:**

**Our reference: 1R31/Name/Proprietor**

Date

Dear Sirs

**Patent Number : Patent (Proprietor)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977.**

I acknowledge receipt of your email received on xxx, in relation to the application to amend under Section 27.

Your request to 'not proceed with' the application to amend under Section 27 has been allowed.

We will therefore record your Section 27 application to amend filed on xxx as "not proceeded with."

Yours faithfully

*Your Name*

Litigation Section  
Patents Directorate

## **ANNEX 15 (Letter S27N)**

**Your reference:**

**Our reference: 1R31/Name/Proprietor**

Date

Dear Sirs

**Patent Number : Patent (Proprietor)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977.**

I refer to your application for amendment filed on xxx.

Your request filed for withdrawal of your post grant amendment filed on xxx, has been allowed.

We will therefore record your Section 27 application to amend filed on xxx as "withdrawn".

Yours faithfully

*Your Name*

Litigation Section  
Patents Directorate

## **ANNEX 16 (Letter S270)**

**Your reference:**

**Our reference:** 1R31/Name/Proprietor

Date

Dear Sirs

**Patent Number : Patent (Proprietor)**

**Application to amend the specification of a patent under Section 27 of the Patents Act 1977.**

**Date for reply:** xxx

I refer to your application to amend under Section 27 filed on (xxx).

I write to advise you that your application to amend is refused due to (insert text)

Should you disagree with this decision, you may request a hearing on this matter before a senior officer.

Should you wish to be heard on this matter please notify us within one month of the date of this letter, that is by (xxx).

Yours faithfully

*Your Name*

Litigation Officer

Patents Directorate

## CHAPTER 18

|  |
|--|
| <b>SECTION 29<br/>SURRENDER OF PATENTS</b> |
|--|

|   |               |
|---|---------------|
| Introduction                                      | 18.01 - 18.03 |
| Initial Action                                    | 18.04 - 18.05 |
| Formalities                                       | 18.06 - 18.10 |
| Formalities checks                                | 18.07 - 18.08 |
| Initial Journal Advert and Subsequent Action      | 18.09 - 18.10 |
| Offer to surrender accepted - no opposition filed | 18.11 - 18.14 |
| Clear records                                     | 18.15 - 18.20 |
| Final Journal Advert                              | 18.16         |
| Electronic Ledger                                 | 18.17 – 18.18 |
| OPTICS Entry                                      | 18.19 – 18.20 |
| Opposition filed                                  | 18.21         |

### Annexes

|         |   |
|---------|---|
| Annex 1 | Letter re Journal advert                |
| Annex 2 | Decision accepting surrender offer      |
| Annex 3 | Letter re acceptance of surrender offer |
| Annex 4 | Clear Records sheet                     |
| Annex 5 | Surrender or cease option letter        |

## **18 SECTION 29, SURRENDER OF PATENTS**

### **INTRODUCTION**

- 18.01 This section provides for the proprietor to offer to surrender a patent, including a European patent (UK), and for opposition by a third party to an offer to surrender. Procedures are prescribed by the Patents Rules 2007 (see rule 42). It is not necessary for the proprietor to file a form or pay a fee when applying to surrender a patent.
- 18.02 The offer to surrender should comprise:
- a declaration that no action is pending before the Court for infringement or for revocation of the patent or
  - if an action before the Court is pending, full particulars of the action in writing
- 18.03 If there is an action before the Court for infringement or revocation or no declaration is filed, the appropriate Head of Examination Group should be consulted.

### **Initial Action**

- 18.04 All offers to surrender are processed electronically on PDAX. A message will be sent by Index and Scanning to the Litigation mailbox when the offer to surrender has been scanned. On receipt of an offer to surrender, the A3 will:
- enter the application in the post-grant SharePoint list and enter the Section of the Act on the front page of the dossier (s29)
  - make a free text entry on OPTICS using REG ENT (see chapter 25 Annex 1)
- 18.05 For paper cases attach a request for index and scan to the application and send it to the index and scanning section. Once scanned a message will be

sent to the Litigation mailbox.

## **FORMALITIES**

18.06 Deleted

### Formalities Checks

18.07 The offer to surrender should be checked to ensure the following details are present:

- the patent number
- the proprietors full name and address
- the relevant section of the act
- an Address for Service in the UK, an EEA state or the Channel Islands
- signature
- contact name and telephone number

18.08 The A3 should check the relevant details against the OPTICS print. The A3 should also check that no section 72 or section 73(2) action is outstanding. If an outstanding section 72 action is found, the case should be referred to the Head of Examination Group of the subject matter. If an outstanding section 73(2) action is found, reference should be made to MOPP 73.09 and 73.11.

The A3 will create, a minute in PDAX, then create and send a “PSM – S29 outstanding revocation” message to the DD.

### Initial Journal Advert and Subsequent Action

18.09 Once all the requirements have been met, a Journal advert should be prepared as follows:



## **OFFER TO SURRENDER ACCEPTED - NO OPPOSITION FILED**

18.11 Once the opposition period has lapsed, and providing no opposition has been filed, a decision to accept the offer to surrender (see annex 2) should be prepared and sent to the relevant Head of Examination Group for signature authorization. The unsigned decision should be exported into word and manually imported onto PDAX (doc code is DECISION-LIT) and annotated accordingly, but not locked on prose so it can be edited.

The A3 will create, a Minute in PDAX, then create and send a “PSM – s29 Please can you authorise the decision.” message to the Group Head.

18.12 Once the decision has been approved by the Head of Examination Group, find the decision in Prose and date it. Effective date of the surrender being accepted is the date the acceptance of the offer of surrender will appear in the Journal. Then export the Decision into word and add the Group Head’s electronic signature. The unsigned decision should then Imported into PDAX.

18.13 A covering letter (see annex 3) should be prepared. The letter and the decision should be sent to the proprietor/attorney.

Letter created, locked and imported from PROSE

18.14 A file note should be prepared as follows:

### File Note

Decision issued on xxXXxx. Patent surrendered on xxXXxx (final advert Journal date)

File note is created in PDAX

## **CLEAR RECORDS**

18.15 To clear records an advert should be prepared for the Journal. The post-



grant SharePoint list should be updated to show the date of surrender. The surrender also needs to be registered on OPTICS. The clear records minute (see Annex 4) should be created in PDAX

### Final Journal Advert

18.16 The following advert should be prepared for the Journal:

#### **Section 29**

#### **Surrender of Patent**

#### **Offer to Surrender Accepted by the Comptroller**

The effective date of the surrender of the patent is the date of this Journal.

|                      |                  |
|----------------------|------------------|
| <b>Patent Number</b> | PROPRIETORS NAME |
|                      | Title            |

The date of the Journal advert should be entered on the clear records template (see annex 4). This date is important as it is the effective date of the surrender.

Advert is created and imported using manual import (doc code is ADVERT).

### Post-Grant SharePoint List

18.17 Update post-grant SharePoint list with the date the surrender was accepted (date of PDJ) and the date of clear records.

18.18 (Deleted)

### OPTICS Entry

18.19 OPTICS should be updated to show that the patent has been surrendered and is therefore no longer in force.

- Enter REG SUR in Next Action
- Type in Authority (A3)
- Type in the patent number
- Enter the date that the offer to surrender has been accepted (final advert Journal date)
- The entry will then appear for you to check, if correct enter Y, if incorrect enter N and repeat the above

18.20 (Deleted)

## **OPPOSITION FILED**

18.21 If an opposition is filed on Patents Form 15, the case should be referred to the B3. The case will then become an *inter partes* case, and will be subject to Part 7 of the Patent Rules 2007.

The A3 will create, a minute in PDAX, then create and send a “PSM – S29 Opposition filed” message to B3.

## ANNEX 1

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**PATENT NO GB xxxxxxxx (PROPRIETOR'S NAME)  
OFFER TO SURRENDER UNDER SECTION 29(1)**

I write to inform you that your offer to surrender filed on xxXXxx, will be advertised in the Patents and Designs Journal to be published on xxXXxx.

A four week period from the date of the advertisement will be allowed for any opposition to the surrender.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## ANNEX 2

*Date*

### PATENTS ACT 1977

PROPRIETOR

*Proprietor's Name*

ISSUE

Acceptance of offer to surrender  
Patent No. GB/EPxxxxxxx under  
Section 29

### DECISION

- 1 *Proprietor's Name*, the patentees of Patent Number *GB/EP xxxxxxx*, granted on *xx Xxx xxxx*, gave notice to the Comptroller on *xxXXxx*, of an offer to surrender the patent. In accordance with Rule 75 of the Patents Rules 2007, the offer was advertised in the Patents and Designs Journal on *xx Xxx xxxx*. No notice of opposition was given within the four week period prescribed by Rule 76(2) (b).
- 2 I therefore accept the said offer. In accordance with Section 29(3), the patent will cease to have effect from the date when the notice of this acceptance is advertised in the Patents and Designs Journal, namely

***Name of Head of Examination Group***

Deputy Director, acting for the Comptroller

## ANNEX 3

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**PATENT NO GB xxxxxxxx (*PROPRIETOR'S NAME*)  
OFFER TO SURRENDER UNDER SECTION 29(1)**

Please find enclosed acceptance of your offer to surrender the above patent filed on xxXXxx. A notice of acceptance will be published in the Patents and Designs Journal on xxXXxx.

The patent will be surrendered and will cease to have effect as from the date the notice of the acceptance is published in the Journal.

*Yours faithfully*

*Your Name*  
Litigation Section  
Patents Directorate

## ANNEX 4

Offer to surrender filed on ..(date).... Accepted on .....(date)....Decision issued.

### Clear Records

|                               |        |
|-------------------------------|--------|
| DATE                          | xxXXxx |
| PDJ                           | xxXXxx |
| POST GRANT<br>SHAREPOINT LIST |        |
| OPTICS                        |        |
| O/L ISSUED                    |        |

## ANNEX 5

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**PATENT NO GB xxxxxxxx (*PROPRIETOR'S NAME*)  
OFFER TO SURRENDER UNDER SECTION 29(1)**

Thank you for your letter dated xxXXxx requesting the above patent be abandoned/withdrawn/not validated. Unfortunately this is not an option we can offer, but you may take the following action:

The proprietor can apply to surrender the patent under Section 29 of the Patents Act. In order to do this they must provide:

- (a) A declaration that no infringement or revocation action relating to the patent is pending before the court;
- (b) If such action is pending, full particulars of the action in writing.

Alternatively, the proprietor may discontinue paying any renewal fees, allowing the patent to lapse.

Please reply on how you intend to proceed by no later than xxXXxx.

*Yours faithfully*

*Your Name*  
Litigation Section  
Patents Directorate

## CHAPTER 19

### SECTION 47 CANCELLATION OF LICENCE OF RIGHT

|  |               |
|--|---------------|
| Introduction                                 | 19.01         |
| Application by proprietor                    | 19.02 - 19.21 |
| Initial Action                               | 19.03 - 19.05 |
| Formalities                                  | 19.06 - 19.10 |
| Opposition filed                             | 19.11 - 19.12 |
| No opposition filed                          | 19.13         |
| Cancellation of the licence of right         | 19.14 - 19.16 |
| Clear records                                | 19.17 - 19.21 |
| Application by other persons                 | 19.22 - 19.31 |
| Initial Action                               | 19.24         |
| Formalities                                  | 19.25 - 19.27 |
| Proprietor opposes the application           | 19.28         |
| No opposition filed                          | 19.29         |
| Cancellation of the licence of right allowed | 19.30 - 19.31 |

#### Annexes

|         |                              |
|---------|------------------------------|
| Annex 1 | Initial advert (Proprietor). |
| Annex 2 | S 47a letter                 |
| Annex 3 | S 47b letter                 |
| Annex 4 | Final advert                 |
| Annex 5 | Initial advert (Third Party) |



## 19 SECTION 47 CANCELLATION OF LICENCE OF RIGHT

### INTRODUCTION

19.01 This section provides for the cancellation of an entry made originally in the register under section 46 i.e. that licences under a patent are to be available as of right. It also provides for opposition to the cancellation (see Section 47 of the MOPP).

Patents Act 1977

*Section 47(1)*

*At any time after an entry has been made under section 46 in respect of a patent, the proprietor of the patent may apply to the comptroller for cancellation of the entry.*

### APPLICATION BY PROPRIETOR

19.02 An entry in the Register that licences under a patent are available as of right, allows renewal fees to be paid at 50% of the total fees. The proprietor of the patent may apply for the cancellation of the licence of right (LOR) entry at any time after it has been made. However, if that endorsement is cancelled those reduced fees have to be repaid. An application should be made on Patents Form 30 and should be accompanied by the back fees payable, as prescribed in section 47(2).

*Section 47(2)*

*Where such an application is made and the balance paid of all the renewal fees which would have been payable if the entry had not been made, the comptroller may cancel the entry, if satisfied that there is no existing licence under the patent or that all licencees under the patent consent to the application.*

## Initial Action

19.03 All cancellations of LOR are processed electronically on PDAX.

A message will be sent to the Litigation mailbox when the F30 has been scanned. On receipt of a Patents Form 30, the A3 will:-

- enter the application in the post-grant SharePoint list and enter the Section of the Act on the front page of the dossier (S47)
- make a free text entry on OPTICS using REG ENT (see chapter 25 Annex 1)

19.04 For a paper case attach a request for index and scan to the application and send it to the Index and Scanning section. Once scanned, a message will be sent to the Litigation mailbox.

19.05 Deleted

## Formalities

19.06 The A3 should carry out the following checks on the Patents Form 30:

- The Applicant under section 47(1) is the proprietor
- The Patents Form 30 is signed
- The form includes a declaration that there is no existing licence under the patent or that all licensees consent to the application.
- That the address for service matches the Register. If not request a Patents Form 51 in order for this to be updated.
- Address for Service provided in the UK, an EEA state or the Channel Islands.

19.07 (Deleted)

- 19.08 The A3 should prepare an initial advert (see annex 1) for the Patents and Designs Journal (PDJ). The advert informs third parties that an application has been made by the proprietor and gives any third parties four weeks to file an opposition on Patents Form 15 should they wish to do so.

Advert is created in Word and imported using manual import (doc code is ADVERT).

- 19.09 The A3 should issue letter s47a (see annex 2) which advises the proprietor of the date when the advert is going to be published in the Journal and the opposition period.

Letter created, locked and imported from PROSE

- 19.10 The A3 should prepare a file note as follows:

File Note

*Formalities complied with, initial advert generated. Official letter issued on xxXXxx.*

The case should be diared for a week after it comes out of opposition. When the case comes out of the opposition period the A3 should check the DIS FOR screen on OPTICS and the PDAX dossier for a Form 15.

File note is created in PDAX.

Opposition filed

- 19.11 Notice of opposition should be filed on Patents Form 15 within four weeks of the advert in the Journal. The four week opposition period is not extendable.

- 19.12 If an opposition is filed, the case will be referred to the B3, with an appropriate file note. It will then be processed as an *inter partes* case.

The A3 will create a minute in PDAX, then create and send a “PSM – s47 Opposition filed” message to the B3.

No opposition filed

19.13 Where no opposition is filed, the A3 should refer the case to the Renewal Section to calculate and process the back payment of renewal fees. The A3 should prepare a minute as follows:

Renewals Section

*An application to cancel an entry in the Register that licences under patent are available as of right for patent number ..... was filed ..... The application was advertised on XX.XX.XX for opposition and no opposition has been received. The case is now referred to you in order to calculate and request payment of the back fees.*

*Once the fees have been recorded on the renewal screens please refer the case back to me.*

*The A3 will create a minute in PDAX, then create and send a “PSM - Calculate/Record back fees” message to the Doc Despatch mailbox.*

Cancellation of the licence of right

19.14 When the case is referred back from Renewals Section, the A3 should check the minute from renewals and the OPTICS - DIS HIS screen to ensure that the back fee payments have been recorded. A minute should be prepared for the B3 as follows:-

Head of Litigation (name)

*An application to cancel an entry in the register that licences under the patent are available as of right, for patent number.....was filed on*

*XX.XX.XX. The back dated fees have been paid, please see OPTICS - DIS HIS. Please cancel the LOR.*

The A3 will create a minute in PDAX, then create and send a “PSM – s47 Cancel LOR” message to the B3.

19.15 The B3 will then make the appropriate register entry by carrying out the following OPTICS action, and, will cancel the LOR.

- From OPTICS main menu choose option 12 Revocations Section Menu.
- From Revocations Section menu choose option 12 Register Licences Of Right.
- From screen REG LIC Ø enter publication/application number.
- From screen REG LIC 1 enter “2” in the selection field, today=s date in Date of Decision field, B3 in authority for Register Entry field.
- From screen REG LIC 2, enter “y” in “Register Entry correct?” field and “y” in “Suppress PDJ Entry?” field. The PDJ entry needs to be suppressed as otherwise an incorrect entry will automatically be generated in the PDJ.
- Press “Enter” to record and exit.

The B3 should then send a message to the A3 confirming that the LOR entry has been cancelled and that a manual entry in the Journal needs to be prepared.

The B3 will create a minute in PDAX, then create and send a “PSM – LOR cancelled” message to Litigation mailbox.

19.16 Once the B3 has cancelled the LOR, the A3 should issue letter s47b (see annex 3) to the proprietor confirming the cancellation.

Letter created, locked and imported from PROSE.

## Clear records

19.17 Once the applicant has been informed of the outcome of the application, clear records action may be undertaken. An advert should be prepared for the Journal (see annex 4) and the electronic ledger updated with the date of the cancellation and the date of clear records. A clear records minute should be created. This should be completed to indicate that all actions have been finalised.

19.18 (Deleted)

19.19 (Deleted)

19.20 (Deleted)

19.21 (Deleted)

Advert is created in Word and imported using manual import (doc code is ADVERT).

## **APPLICATION BY OTHER PERSONS**

19.22 The comptroller makes a licence of right entry only if he is satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent. There is an opportunity, after an entry that licences are available as of right has been made, for cancellation to be applied for by

persons other than the proprietor, for example an exclusive licensee, and/or others who claim that the proprietor was at the time of the entry precluded by a contract from granting licences.

An application by such a person should be made on Patents Form 2 within two months of the relevant entry being made in the register (rule 43(4)); this period cannot be extended. The application should be accompanied by a statement (see rule 76(4)).

19.23 (Deleted)

## Initial Action

19.24 See 19.03 for procedures. The register entry should read

Application by any person to cancel Licence of Right entry under Section 47(3) filed on xxXXxx

## Formalities

19.25 The A3 should carry out the following check on the Patents Form 2:

- The Patents Form 2 is signed and the fee has been paid.

19.26 The A3 should prepare an initial advert referring to section 47(3) (see annex 5) for the Journal.

Advert is created in Word and imported using manual import (doc code is ADVERT).

19.27 The A3 should send a copy of the application and statement to the proprietor and confirm that the application is to be advertised in the Journal for opposition. The claimant should also be notified of the date that the application is advertised.

Letter created, locked and imported from PROSE

## Proprietor Opposes the Application

19.28 Where the proprietor opposes the application by filing a Patents Form 15, the file should be referred to the B3. The case will now proceed as an *inter partes* case.

The A3 will create a minute in PDAX, then create and send a "PSM – s47 Opposition filed" message to the B3.

### No Opposition filed

- 19.29 Where no opposition is received, the case should be referred to the B3 to consider whether the proprietor is and was precluded by a contract in which the claimant is interested from granting licences under the patent (see section 47 of the MOPP).

The A3 will create a minute in PDAX, then create and send a “PSM – s47” message to the B3.

### Cancellation of the licence of right allowed

- 19.30 The B3 will report whether the application may be allowed. The A3 should inform the proprietor of the cancellation and set a period in which the back payment of renewal fees should be paid. If the fees are not paid, the patent will cease to have effect, the effective date being the date that the A3 sets for the payment to be made.

The A3 will create a minute in PDAX, then create and send a “PSM – s47” message to the A3.

Letter created, locked and imported from PROSE.

File note is created in PDAX

- 19.31 When payment of the back fees has been made, the A3 should refer the case to the B3 who will then cancel the LOR entry (See 19.15 for action). Once actioned the A3 should advise the claimant and proprietor of the cancellation. Then clear records action may be undertaken (see 19.17).

The A3 will create a minute in PDAX, then create and send a “PSM – S47 Cancel LOR” message to B3.

The B3 will then create a minute in PDAX, then create and send a “PSM –



s47 LOR cancelled" message to Litigation Team mailbox.

Letter created, locked and imported from PROSE.

Advert is created in Word and imported using manual import (doc code is ADVERT).

## **.ANNEX 1**

**INITIAL ADVERT**

**SECTION 47**

**Cancellation of Entry on the Register of a Licence of Right**

**Application under Section 47(1) by a Proprietor to cancel an Entry**

Any person may give notice of opposition to the undermentioned Application by filing Patents Form 15 within four weeks from the date of publication of this Journal

**Patent Number**     *PROPRIETORS NAME*

*Title*

Cancellation of entry on the Register of a Licence of Right filed  
on     xxXXxx

## ANNEX 2

**Your Reference:**

**Our Reference: IR31/Name/File Reference**

Date

Dear Sirs

**Patent number: xxxxxxxx (*Proprietors Name*)**

**Application to cancel an entry in the register that licences under the patent are available as of right under Section 47 of the Patents Act 1977**

I am writing to inform you that your application to cancel an entry in the register will be advertised for opposition in the Patents and Designs Journal on xxXXxx,

A four week period from the date of advertisement will be allowed for the filing of any opposition to the proposed cancellation.

Yours faithfully

*Your Name*

Litigation Section

Patents Directorate

## ANNEX 3

**Your Reference:**

**Our Reference: IR31/Name/File Reference**

Date

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)**

**Application to cancel an entry in the register that licences under the patent are available as of right under Section 47 of the Patents Act 1977**

### **Confirmation of cancellation**

I am writing to inform you that your application to cancel an entry in the register was advertised in the Patents and Designs Journal on xxXXxx and no opposition was filed within the four week period.

The Licence of Right entry on the Patents Register was therefore cancelled on xxXXxx.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## **ANNEX 4**

### **FINAL ADVERT**

#### **SECTION 47**

#### **Cancellation of Entry on the Register of a Licence of Right**

##### **Cancellation of Entry**

Notice is hereby given that the Licence of Right entry on the Register for the following patent was cancelled on xxXXxx.

***Patent Number***                      *PROPRIETORS NAME*

Title

## ANNEX 5

### INITIAL ADVERT

### SECTION 47

#### Cancellation of entry on the Register of a Licence of Right

#### Application under Section 47(3) by a Third Party to cancel an Entry

Any person may give notice of opposition to the following Application by filing Patents Form 15 within four weeks of the date of publication of this Journal

**Patent Number**     *PROPRIETORS NAME*

*Title*

Cancellation of entry on the Register of a Licence of Right filed on xxXXxx

## CHAPTER 20

### CLAIM/COUNTERCLAIM FOR REVOCATION

|   |               |
|---|---------------|
| Receipt of Claim/Counterclaim for Revocation                  | 20.01 - 20.03 |
| Follow-up procedure   | 20.04         |
| Notification of the outcome of the Claim/Counterclaim         | 20.05 - 20.06 |
| Stays   | 20.07         |
| Appeal to the Court of appeal against an order for revocation | 20.08 - 20.14 |
| Clear Records   | 20.15 - 20.19 |
| Amendments allowed  | 20.18 - 20.19 |

#### Annexes

|         |  |
|---------|--|
| Annex 1 | Letter acknowledging receipt of claim/counterclaim |
| Annex 2 | Letter to proprietor                               |
| Annex 3 | Letter requesting information re progress          |

## 20 CLAIM/COUNTERCLAIM FOR REVOCATION

### RECEIPT OF CLAIM FOR REVOCATION

20.01 There are two types of revocation at the Court: claim for Revocation and counterclaim for Revocation. The claim/counterclaim for revocation will normally be received together with the grounds of invalidity, an accompanying letter and other documents. A claim for Revocation can be recognised on the dossier by having a claim form, particulars of claim, grounds of invalidity and any supporting evidence. A counterclaim for Revocation can be recognised on the dossier by having a defence and counterclaim, grounds of invalidity and any supporting evidence.

20.02 Once the claim/counterclaim for revocation is scanned, a message is sent to the court work mailbox on PDAX, to be actioned as soon as possible. The application is then entered in the Ex-parte post grant SharePoint list. A free text entry is recorded on Optics as follows:-

*Claim/Counterclaim for revocation lodged at the Patents Court on (insert date) (insert Action No).*

A Journal entry is then prepared as follows:-

*Claim/counterclaim for revocation lodged at the Patents Court on (insert date) (insert Action No.).*

Advert is created and imported using manual import (doc code is ADVERT).

20.03 The A3 then sends out a letter (see annexes 1 and 2) acknowledging receipt of the claim/counterclaim and letting the parties know that the claim/counterclaim has been recorded on the Office Register and advertised in the Journal. The letter is copied to the other parties to the proceedings, e.g. proprietor and any other interested parties.

Letter created, locked and imported from PROSE



A file note is then prepared noting all the actions completed.

The A3 will then action as below:

- for both EP and GB cases, if no dossier exists on PDAX, take the hard copy document to Index and Scanning and request they set up a dossier for this patent.

For paper cases attach a request for index and scan to the application and send it to the Index and Scanning section. A message will be sent to the court work mailbox.

The case is then diared in the court work diary in outlook, setting a six month diary date.

If more than one claim or counterclaim for revocation is filed for the same patent but by another party, each claim or counterclaim should be recorded in the interest of clarity. In this scenario, the A3 should ensure that the register and the Journal advert clearly indicate the details of the party filing the action, e.g. filed by second defendant.

## **FOLLOW-UP PROCEDURE**

- 20.04 At approximately six monthly intervals, a follow-up letter (see annex 3) should be sent by the A3, asking for any further progress.

Letter created, locked and imported from PROSE

File note is created in PDAX

## **NOTIFICATION OF THE OUTCOME OF THE CLAIM/COUNTERCLAIM**

- 20.05 Notification of the outcome of the claim/counterclaim usually comes in the form of a letter (often from the successful party). This is not sufficient to record the outcome and it will therefore be necessary to contact the party and ask for them to supply you with a copy of the sealed Court Order.

20.06 On receipt of a copy of the sealed Court Order, the A3 should record the outcome of the court proceedings on OPTICS. The outcome should also be advertised in the next available Journal. The entries may read for example as follows:

*In an Order of the High Court dated ..... (insert High Court number), the patent was revoked.*

*In an Order of the High Court dated ..... (insert High Court number), the proceedings were stayed.*

Advert is created and imported using manual import (doc code is ADVERT).

A letter should be issued by the A3 acknowledging receipt of the Court Order. This should be copied to the other party involved in the proceedings. For clear records see 20.15 – 20.19.

Letter created, locked and imported from PROSE.

File note is created in PDAX.

## **STAYS**

20.07 An Order revoking the patent may also contain an Order granting leave to appeal to the Court of Appeal. If this is the case any action may be stayed for 28 days. If an appeal is lodged, the stay may continue until such time as the appeal has been determined. **NB** If the Order contains notification of a stay it is important that this is included in any notice for the register and Journal since the stay will be suspending the order to revoke. Note on occasion some orders for stays will be Tomlin Orders and in this situation the stay will discontinue the proceedings in the Court. Where such an Order is received, reference should be made to the B3 before records are cleared.

Create minute in PDAX, send a “PSM – Tomlin Order” message to B3.

Advert is created and imported using manual import (doc code is ADVERT).

Letter created, locked and imported from PROSE.

File note is created in PDAX

## **APPEAL TO THE COURT OF APPEAL AGAINST AN ORDER FOR REVOCATION**

20.08 If an appeal is made to the Court of Appeal, the appellant must serve that appeal on the Comptroller. A Journal advert and OPTICS entry should be made accordingly. (For further details and any further appeal to the House of Lords see Chapter 6 on appeals).

Advert is created and imported using manual import (doc code is ADVERT).

Letter created, locked and imported from PROSE.

File note is created in PDAX

20.09 If the respondent decides not to oppose the appeal, or not to attend the appeal hearing, he must immediately inform both the Office and the appellant. He must also provide the Office with copies of the Claim for Revocation, any Statements of Claim and any written evidence filed with the claim.

20.10 The A3 should inform the appropriate Divisional Director of the appeal as soon as possible, as the Office must then advise the appellant whether or not a representative of the Office will attend the appeal. This should be within 14 days of receiving the notice of appeal. (Note: the appropriate Divisional Director will depend on the subject matter of the patent concerned.)

Create minute in PDAX send a “PSM – Appeal lodged” message to the DD.

20.11 [Deleted]

- 20.12 If the respondent withdraws his opposition to the appeal during the hearing the Court of Appeal may direct or permit the Office attend the hearing and to oppose the appeal. These circumstances rarely occur.
- 20.13 The A3 will need to find out when the appeal will be heard either by contacting the Court of Appeal directly or asking the appellants to let us know when they are informed.
- 20.14 The A3 must then inform the Office representative of the date by sending an appointment.

Letter created, locked and imported from PROSE.

File note is created in PDAX

## **CLEAR RECORDS**

- 20.15 A Journal entry is prepared and OPTICS is updated to reflect the outcome of the proceedings as follows:-

*Claim/Counterclaim for revocation lodged at the Patents Court on (insert date), revoked/stayed/dismissed by court order dated (insert date) (Insert Action No.)*

Advert is created and imported using manual import (doc code is ADVERT).

- 20.16 The A3 should issue a letter to the parties acknowledging receipt of the Court Order and notifying them that the register has been updated and a Journal entry prepared.

Letter created, locked and imported from PROSE.

File note is created in PDAX

20.17 The Ex-parte post grant SharePoint list is updated to show the outcome of the proceedings.

### Amendments Allowed

20.18 If amendments under s75 have been allowed and the claim/counterclaim for revocation dismissed, both proceedings can be completed by referring to the Head of Examination Group of the patent subject matter concerned (refer to chapter 23 for s75 proceedings).

Create a minute in PDAX, send a “PSM – Amendments allowed/Claim/Counterclaim/dissmissed” message to Head of Examination Group.

20.19 The A3 should update the register and prepare a Journal entry as follows:-

*Claim/Counterclaim for revocation lodged at the Patents Court on (insert date) dismissed by Court Order allowing amendments on (insert date of Court Order) (Action No.)*

Advert is created and imported using manual import (doc code is ADVERT).

Letter created, locked and imported from PROSE.

File note is created in PDAX

A separate advert will be required for the s75.

The case should then be referred to Publishing Section.

Create Minute in PDAX, send a “PSM – Amendments allowed” message to the Publishing Team mailbox.

## ANNEX 1

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent Number .....** (.....)

**Claim for Revocation by .....** (HC - ..... -.....)

I refer to your letter dated ..... and acknowledge receipt of the copy of the Claim for Revocation and the Particulars of Objections in respect of the above patent.

Notice of the Claim has been recorded on the Register (a copy is enclosed) and your letter and enclosures have been placed on the part of the patents file open to public inspection. I have also arranged for an entry to appear in the Patents and Designs Journal.

Could you please let me know the outcome of these proceedings as soon as possible.

A copy of this letter has been sent to the proprietors for information.

Yours faithfully

*Your Name*

Litigation Section

Patents Directorate

## ANNEX 2

**Your Reference:**  
**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent Number .....** (**.....**)  
**Action No.**

Please find enclosed a copy of a letter sent to the xxxxxxxx

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate

## ANNEX 3

**Your Reference:**

**Our Reference: 1R311/Name/File Reference**

Date

Dear Sirs

**Patent Number ..... (.....)**

**Claim for Revocation by ..... (HC - ..... -.....)**

I refer to the above Claim for Revocation and note that the last communication from you regarding this matter was your letter dated .....

Could you please advise me in writing of any further developments in the above proceedings within one month from the date of this letter. Your response should be filed by .....(insert date)

A copy of this letter has been sent to the other side.

Yours faithfully

*Your Name*  
Litigation Section  
Patents Directorate



## CHAPTER 21

|  |
|--|
| <p style="text-align: center;"><b>REVOCATION ON THE COMPTROLLER'S<br/>INITIATIVE<br/>SECTION 73(1)</b></p> |
|--|

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Annex 12 S73FS2 Fresh specification conformity  
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# **SECTION 73(1) REVOCATION ON THE COMPTROLLER'S INITIATIVE**

## **INTRODUCTION**

21.01 This section relates to the revocation of patents on the Comptroller's initiative under Section 73(1).

## **ACTION BY LITIGATION OFFICER A3**

21.02 All S73(1) revocation actions are processed electronically on PDAX. A patent examiner will either send the patent file to Litigation Section asking for revocation action to commence in respect of the patent or if the case is already on PDAX, he will send a message to the Litigation Team Mailbox. The examiner may cite, for example, a published GB application or a published European patent (UK) application as being in conflict with the relevant GB patent.

For cases not yet on PDAX, the A3 will :

- arrange for the application to be indexed and scanned as a PDAX case.

The new case will be placed by index and scanning in the Ex parte team mailbox to be actioned by a member of the ex parte team.

21.03 The A3 will also need to:

- enter the application on the Exparte Post Grant SharePoint List, the filing date is the date of the minute sent by the examiner to initiate proceedings under Section 73(1).

21.04 A print relating to the European patent (UK) should be obtained via the Online European Patent Register <https://register.epo.org/espacenet/regviewer> (Register Plus). You should check that:

- a) the opposition period of 9 months has elapsed since the grant of the patent
- b) there is no opposition to the grant of the European patent (UK)
- c) the European patent (UK) has designated GB status
- d) there are no requests made for central revocation of the European patent before the European Patent Office under EPC Article 105a. This allows the proprietor to request that their patent is revoked in all contracting States in which the patent is in force (see MoPP 73.10)
- e) the specification on PDAX is the latest version using Register Plus and there are no central limitation proceedings ongoing. If proceedings are ongoing, proceed as follows;

#### EPC 2000 – Central Amendment Process

Following the introduction of the central limitation process, an EP patent may now be amended centrally at the EPO or in each individual contracting state. On receipt of a new S73(1), the online European Patent Register should be checked to determine whether there is a request to centrally limit an EP (UK) patent. If so, you need to obtain a copy of the amendments filed at the EPO and forward these to the examiner. The examiner will consider whether the amendments, if allowed, remove the conflict. If so, the examiner may stay the S73(1) action pending the outcome of the central amendment. If the amendment is not allowed or does not remove the conflict, the S73(1) action may proceed.

A minute should be prepared and referred to the examiner as follows:

*On checking the EPO register, it appears that an application has been filed to amend the patent centrally at the EPO. The amendments are available to view on the dossier. Please consider, if allowed, whether these amendments remove the conflict. If so, please confirm that you wish to stay the S73(1) action pending the outcome of the centrally filed amendment. The register will be checked regularly to monitor the progress of the amendment. If the amendment does not remove the conflict, please confirm that you wish to proceed with the S73(1) action.*

The A3 will create a minute on PDAX, then send a “PSM - S73(1) Central amendment filed” message to the examiner.

If the European patent (UK) has lapsed since grant, revocation action should continue (see MOPP Section 73).

If an opposition to the European patent (UK) has been filed at the European Patent Office (check via EPOnline), the case should be referred to the originating examiner with a minute.

The A3 will create a minute on PDAX, then send a “PSM - S73(1) EP in Opposition” message to the examiner. In most cases, a view will be taken on whether to stay the S73(2) action pending the outcome of the EPO opposition proceedings.

The A3 should also check that any GB patent the examiner wishes to revoke is in force by using the OPTICS function DIS FUL. If the patent is not in force, refer the case to the originating examiner as there was a period of double patenting in place.

The A3 will create a minute on PDAX, then send a “PSM - S73(1) Patent not in force” message to the examiner.

If all formalities have been complied with, an Official Letter PL2 (Annex 2) should be issued to the patentee allowing two months for a response.

A file note should be prepared as follows:

*PL2 issued on ..... (insert date of PL2), B/F to ..... (insert date - 4 months from date of PL2, and always to the nearest Wednesday).*

The case should be diarized accordingly.

Update Diary EX2.

Letter created, locked and imported from PROSE.

A File note is created on PDAX.

- 21.05 An OPTICS free text entry should be made using the function REG ENT.  
The entry should read:

“Section 73(1) action initiated on (date of PL2) in view of xxxxx”.

#### EP (UK) citations

- 21.06 If the examiner cites a published European patent (UK) application, the A3 should proceed as above except:

a check should be made to ensure that the citation designates GB on either the OPTICS DIS FUL print-out or the EPOLINE (European Register) print-out.

a PL1 letter (see Annex 1) should be issued **if** the citation is a European patent (UK) application which was originally cited before

grant but then deferred as a citation because the priority document was not available. If you have any doubts about this, you should consult the appropriate examiner.

Letter created, locked and imported from PROSE.

File note is created on PDAX.

## **RESPONSE TO OFFICIAL LETTER PL1/PL2**

### No objection to revocation

21.07 If a response is received to the PL1 or PL2 stating that the patentee has no objection to the revocation of the patent, the letter should be scanned onto PDAX. A Decision 3a (see Annex 6) should then be prepared for the appropriate Head of Examination Group.

The A3 will create a minute on PDAX, then send a “PSM – Dec 3a to authorise” message.

Once authorisation is received from the group head, an electronic signature can be applied to the decision. The decision should be dated and issued to the patentee with official letter DNL1 (see Annex 4). A file note should be prepared as follows:

*Decision issued on ..... (date of Decision). Patent revoked.  
Clear records.*

Letter created, locked and imported from PROSE.

File note is created on PDAX.

Decisions are created using Word templates and applying the appropriate electronic signature. Electronic signatures can be located on SharePoint.

For clearing records see 21.25 – 21.27

If a response is received to the PL2 that states the patentee has applied to centrally revoke at the European Patent Office, no action under Section 73(1) is necessary. Once we have received confirmation that the EP patent has been centrally revoked, notify examiner.

Once the examiner has agreed that there is no conflict under Section 73(1), issue letter S73 EPOREV (see Annex 16).

For clearing records see 21.25 – 21.27

## 21.08 [DELETED]

### Disagreement that the patents are in conflict

21.09 The patentee may disagree with the examiner's view that the patents are in conflict. In such circumstances, observations will usually be provided to support this view. The observations should be referred to the originating examiner with a suitable minute. If the examiner allows the observations, Decision 2a (see Annex 7) should be prepared for the Head of Examination Group. The A3 will create a minute on PDAX, then send a "PSM – Dec 2a to authorise" message. Once authorisation is received from the group head, an electronic signature can be applied to the decision. The decision should be dated and issued to the patentee with official letter DNL1 (see Annex 5). A file note should be prepared as follows:

*Revocation action under S73(1) not proceeded with on (date of clear records)*

Letter created, locked and imported from PROSE.

File note is created on PDAX

Decisions are created within Prose using Word templates and applying the appropriate electronic signature. Electronic signatures can be located on SharePoint.

Clear records



An OPTICS and journal entry should be prepared to reflect the fact that revocation has not taken place. Using REG ENT on OPTICS, a free text entry should be made as follows:

*Section 73(1) action initiated on (date of PL1/2) in view of ..... not proceeded with on (date of decision)*

The Exparte Post Grant SharePoint List should be updated by entering against the file reference number, Not proceeded with on (insert date of decision) and the date of clear records.

A Journal entry should be prepared as follows:-

*Revocation action under Section 73(1) not proceeded with on (date of decision).*

Advert is created in Word, imported on PDAX using manual import (doc code is ADVERT) and is uploaded to the weekly PDJ Live on SharePoint.

If the observations are not allowed, the examiner will issue further instructions as to how you should proceed in an examination report. This report is then included in an exam letter. The proprietor should also be provided with the opportunity to file amendments to overcome S73(1) conflict. (see Annex 14).

### Patent to lapse or be surrendered

21.10 The patentee may state that he is either:

- allowing the patent to lapse due to non-payment of renewal fees, or
- that he proposes to surrender the patent

It would appear that neither of these options is *prima facie* allowable because both patents would have been granted for a period of time. The

MOPP Section 73.09 indicates that once revocation action has started, it should normally continue even though the patent may have lapsed or an offer to surrender has been made. The case should be referred to the originating examiner with a suitable minute. The examiner will usually ask for a letter to be issued to the patentee pointing out these facts and offering a hearing.

The A3 will create minute on PDAX, then send a “PSM - S73(1) request to lapse/surrender” message to examiner.

#### Amendments allowed instead of revocation

21.11 The patentee may submit proposals to amend the patent in order to remove any conflict.

21.12 When proposals for amendment of a GB patent are received in response to revocation action under Section 73(1), the amendments should be referred to the examiner. The examiner will consider whether the proposed amendments are acceptable or not. If they are not acceptable, the examiner will issue further instructions as to what action should be taken in an examination report. This report is then included in an exam letter. The proprietor should be provided with a further opportunity to file amendments to overcome S73(1) conflict. (see Annex 14).

The A3 will create a minute on PDAX, then send a “PSM – S73(1) Amendments filed” message to examiner.

21.13 If the proposals for amendment are prima facie allowable but are extensive, the examiner may request that amendments are made throughout the whole specification in order to achieve consistency within the specification in order to conform.

The A3 is then instructed by the examiner to issue letter to proprietor for further amendments. (see Annex 12).

If the proposals for amendment are acceptable by the Examiner, but require a freshly typed specification in order for publishing to produce a C spec, letter S73FS1 is issued (see Annex 13).

If the proposals for amendment are acceptable, use the assemble and enhance function to apply the amendments to the B specification. The description, claims and drawings annotated “P” and “working copy” are copied from PREGRANT into the LITIGATION section of the dossier. The amendments are then applied using the enhance and assemble functions. In order to identify the amended sections of the specification, they are annotated “C” and “For publishing purposes” along with the sections not amended.

The references to “P” and “working copy” of the **copied** documents are deleted. This enables publishing section to extract all the documents required to produce a “C” spec. Decision 1 (see Annex 8) should be prepared for the appropriate Head of Examination Group.

If both the GB and the EP patents require amendment in order to remove any conflict, the GB patent is amended under S73(1) and the European patent that it is in conflict with is amended under S27. The amendment under S73(1) is stayed pending the expiry of the S27 opposition period. On expiry of the opposition period, prepare Decision 1a (see Annex 10). For procedures on amendment under S27 see Chapter 17.

Certificates and decisions are created using Word templates and applying the appropriate electronic signature. Certificates and electronic signatures can be located on SharePoint.

Create a minute on PDAX, then send a “PSM – S73(1) Dec 1/1a and CERT to authorise” message.

Once authorisation is received from the group head, an electronic signature

can be applied to the decision and certificate. The certificate is imported using manual import (doc code is CERTIFICATE).

- 21.14 The decision and certificate should be dated and the decision issued to the patentee together with Official Letter DNL2 (see Annex 5). A file note is prepared as follows:-

*Decision issued on (date of decision). Patent amended. Clear records.*

Letter created, locked and imported from PROSE.

File note is created on PDAX.

- 21.15 Clear records

An OPTICS entry should then be made. From the Revocation Section menu select item 7 – amendments allowed – type in the file number and then select item 4 – under Section 73 which will prompt you to insert the date of the decision. When prompted, use A3 as authority for the entry.

- 21.16 A Journal entry should be prepared as follows:

*Specification amended under Section 73(1), on (date of decision).*

Advert is created in Word and imported using manual import on PDAX (doc code is ADVERT) and is uploaded to the weekly PDJ Live on SharePoint.

- 21.17 The Exparte Post Grant SharePoint List should be updated by entering against the file reference number, *Patent amended on (date of decision)* and the date of clear records.

- 21.18 Following this, the case can be referred to Publishing Section for the amended specification to be published.

The A3 will create a detailed minute on PDAX (see Annex 11), then send

a “PSM – S73(1) Produce C Spec and see CERT” message to the Publishing Team mailbox.

## **NO RESPONSE TO OFFICIAL LETTER PL1/PL2**

21.19 If, after the two month period allowed for response to the Official Letters PL1/PL2, no reply has been received, Official Letter PL4 (Annex 3) offering a hearing should be issued, specifying a 21 day period for reply. Diary EX2 should be updated. A copy of the PL4 should be placed on file.

A file note should be prepared as follows:

*No reply received to PL1/PL2 issued on (date of PL1/2) PL4 issued on (date of PL4) B/F to .....*

Letter created, locked and imported from PROSE.

File note is created on PDAX.

### Request for a hearing to Official letter PL4

21.20 The patentee may reply that he would like a hearing. If this is the case, a hearing will need to be arranged by the Hearings Team. Following the hearing, a decision will be written by the hearing officer and issued. If the patent is revoked see 21.24 – 21.27.

To refer to the hearing team, create a minute on PDAX, then send a “PSM – set up hearing” message to the hearings mailbox.

The Hearings Clerk will diary the expiry of the appeal period and will notify the A3 case worker accordingly.

The A3 will then clear records following the expiry of the appeal period.

### No Response to Official Letter PL4

21.21 If no response is received and the B/F period has expired, Decision 5 (see annex 9) should be prepared for the appropriate Head of Examination Group with the following minute:

*No reply has been received to ..... (insert PL1/PL2 as appropriate) or PL4. Decision 5 prepared. Please can you authorise your electronic signature can be applied to the decision.*

Decisions are created using Word templates and applying the appropriate electronic signature. Electronic signatures can be located on SharePoint

Create a minute on PDAX, then send a “PSM – Dec 5 to authorise” message to the Head of Examination Group.

Once authorisation is received from the group head, an electronic signature can be applied to the decision

21.22 [DELETED]

21.23 The decision should be dated and issued to the patentee together with Official Letter DNL1 (see Annex 4).

Letter created, locked and imported from PROSE.

21.24 A file note should be prepared as follows:

Decision issued on ..... (date of Decision). Patent revoked.

Clear records.

File note is created on PDAX.

#### Clear records

21.25 An OPTICS entry should then be made. From the Revocation Section menu, select item 16 – Register Revocation – type in the patent number and then select the section of the act, insert the date of the decision and

use A3 as authority for the entry. If, when registering the revocation of the

patent, it is found that the patent has lapsed, the case should be referred to the B3, who will change the status of the patent so that it can be revoked.

The A3 will create a minute on PDAX, then send a “PSM – Patent Ceased” message to B3.

- 21.26 A Journal entry should be prepared under the following heading as indicated:

**SECTION 73**

**Revocation on the Comptroller’s Initiative**

**Patent revoked under Section 73(1)**

|                      |                                      |
|----------------------|--------------------------------------|
| <b>Patent Number</b> | <b>PROPRIETOR’S NAME</b>             |
|                      | Title                                |
|                      | Patent Revoked on (date of Decision) |

PDJ Advert is created and imported using manual import on PDAX (doc code - ADVERT) and is uploaded to the weekly PDJ Live on SharePoint.

- 21.27 The Exparte Post Grant SharePoint List should be updated by entering against the file reference number, Patent revoked on (date of decision) and date of clear records.  
File note is created on PDAX.

**EXTENSIONS OF TIME**

- 21.28 S117(B) of the Patents Act 1977 provides for an additional automatic extension of two months for periods specified by the Office. This may be

applied retrospectively. Most of the requests for extensions of time relate to proposed amendments. These extensions of time may be allowed with the examiners discretion.

- 21.29 Where an automatic extension of time has been applied and then a further extension of time is received the request is referred to the originating examiner, who will consider it on its respective merits. It should be remembered that Section 73 cases are *ex parte*. Therefore no other parties are involved or need to be consulted.

The A3 will create a minute on PDAX, then send a “PSM – S73(1) Extension of time request” message to DD.

- 21.30 Once an extension of time has been granted, this should be confirmed in writing and a new deadline for a response set. (see Annex 15)

Letter created, locked and imported from PROSE.

File note is created on PDAX.



**Annex 1**  
**Letter S73(1) PL1**

**Your Reference:**  
**Our Reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)**  
**Patents Act 1977: Action under Section 73(1)**

**Latest date for reply: xx XXX xx**

When the examination report of [xxx] was issued, the actual priority date of the relevant disclosure in [xxx] could not be determined because the priority document(s) (was /were) not available.

The examiner (xxxxx tel xxxxxx) has now considered the priority document(s) and is of the view that the relevant disclosure has an earlier priority date than the invention of claims [xxx]. This invention is therefore not new.

By [xxx] you should either propose amendments to meet this objection or make observations on it. If you do not, the patent may be revoked. Alternatively, you may reply advising that you are content with the revocation or have made a request for revocation at the European Patent Office under Article 105a.

(delete as appropriate)

We note from the Register entry for this patent that an exclusive licence has been recorded to [xxx] on [xxx].

We note from the Register entry for this patent that a security agreement has been filed between [xxx] and [xxx] on [xxx].

If you want to propose amendments, it would be helpful if these could be shown in red ink on a copy of the printed specification. However, if the amendments are simple and not extensive you may submit them in a letter. You may not however amend your patent in a way which adds matter or extends the protection conferred by the patent.

No amendment will be needed if you can show that the priority date of your invention is not later than the priority date of the cited disclosure.

Yours faithfully

*Your name*  
Litigation Section  
Patents Directorate

**Annex 2  
Letter S73(1) PL2**

**Your Reference:**  
**Our Reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)**  
**Patents Act 1977: Action under Section 73(1)**

**Latest date for reply: xx XXX xx**

The examiner (xxxxxxx tel xxxx) considers that the invention of claim(s) is not new because it has already been disclosed in [xxx].

By xxxxx you should either propose amendments to the UK patent to meet this objection or make observations on it. If you do not, the UK patent may be revoked. Alternatively, you may reply advising that you are content with the revocation or have made a request for revocation at the European Patent Office under Article 105a.

(delete as appropriate)

We note from the Register entry for this patent that an exclusive licence has been recorded to [xxx] on [xxx].

We note from the Register entry for this patent that a security agreement has been filed between [xxx] and [xxx] on [xxx].

If you want to propose amendments, it would be helpful if these could be shown in red ink on a copy of the printed specification. However, if the amendments are simple and not extensive you may submit them in a letter. You may not however amend your patent in a way which adds matter or extends the protection conferred by the patent.

No amendment will be needed if you can show that the priority date of your invention is not later than the priority date of the cited disclosure.

Yours faithfully

*Your name*  
Litigation Section  
Patents Directorate

**Annex 3  
Letter S73(1) PL4**

**Your Reference:**  
**Our Reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)**  
**Patents Act 1977: Action under Section 73(1)**

**Latest date for reply: xx XXX xx**

Our letter of [xxx] invited you to propose amendments or to make observations in response to an objection that the invention of claims [xxx] had been disclosed in [xxx] and was therefore not new. However no reply has been received.

We will now consider whether your patent should be revoked. If you want to be heard before the Comptroller decides the matter you should ask by [xxx] for a hearing to be appointed.

Yours faithfully

*Your name*  
Litigation Section  
Patents Directorate

Enclosed: Letter dated xx XXX XXXX

**Annex 4  
Letter DNL1**

**Your Reference:**  
**Our Reference: 1R31/Name/Patent**

Date

Dear Sirs

**Action under Section 73(1)**

1. Please find enclosed a copy of a Decision dated
  
2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from H M Courts & Tribunal Service, Royal Courts of Justice Group, Chancery Appeals Office, 7 The Rolls Building, Fetter Lane, London, EC4A 1NL (telephone 020 7947 6890/6294/6243).
  
3. Two copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee **within the time period specified in the decision**. The latest date for appeal is therefore xxxxxx. Any request for an extension to the appeal period identified in the decision must be made to the court.
  
4. Once you have filed your appeal at the court, you must send a copy to the Notice of Appeal to the Comptroller as soon as practicable and no later than 7 days from the date of filing.
  
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Your name  
Litigation Section  
Patents Directorate

**Annex 5  
Letter DNL2**

**Your Reference:  
Our Reference: 1R31/Name/Patent**

Date

Dear Sir

**Patent Number: xxxxxxx (Proprietors Name)**

**Action under Section 73(1)**

Please find enclosed a copy of a decision dated [xxx].

Yours faithfully

Your name  
Litigation Section  
Patents Directorate

**Annex 6**  
**Decision 3a**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE                      Whether Patent Number GB xxxxxxxx should  
   be revoked under Section 73(1)

---

**DECISION**

- 1      An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent did not appear new in the light of [xxx] and that revocation of the UK Patent under Section 73(1) might therefore be necessary. The proprietor, in a letter dated [xxx], advised that they were content with the revocation of the UK patent.
- 2      In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(1) are met. I therefore order revocation of the UK patent.

**Appeal**

- 3      Any appeal must be lodged within 28 days after the date of this decision.

**(Name)**

Deputy Director / Head of Examining Group acting for the Comptroller

**Annex 7**  
**Decision 2a**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxxxx should  
be revoked under Section 73(1)

**DECISION**

1. An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent did not appear new in the light of [xxx] and that revocation of the UK Patent under Section 73(1) might therefore be necessary.
2. The proprietors contested the examiner's view in their letter dated [xxx]. I have considered their observations and I make no order for revocation of the UK patent.

**(Name)**

Deputy Director / Head of Examining Group acting for the Comptroller



**Annex 8**  
**Decision 1**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxxxx should  
be revoked under Section 73(1)

---

**DECISION**

1. An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent did not appear new in the light of [xxx] and that revocation of the UK Patent under Section 73(1) might therefore be necessary.
2. The proprietor submitted proposals for amendment of the specification, which are allowable under Section 76.
3. I am satisfied that the proposed amendments distinguish the claimed invention from the cited disclosure. I therefore allow the specification to be amended as proposed, and make no order for revocation of the UK patent.

**(Name)**

Deputy Director / Head of Examination Group acting for the Comptroller

**Annex 9**

**Decision 5**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxxxx should  
be revoked under Section 73(1)

---

**DECISION**

1. An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent did not appear new in the light of [xxx] and that revocation of the UK Patent under Section 73(1) might therefore be necessary. The proprietor did not submit observations or proposals for amendment. A hearing was therefore offered in an Official letter dated [xxx] but the proprietor has not asked to be heard.
2. In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(1) are met. I therefore order revocation of the UK patent.

**Appeal**

3. Any appeal must be lodged within 28 days after the date of this decision.

**(Name)**

Deputy Director / Head of Examination Group acting for the Comptroller

**Annex 10  
Decision 1a**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent No. GB xxxxxxxx should be  
revoked under Section 73(1)

---

**DECISION**

1. An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent did not appear new in the light of [xxx], and that revocation of the UK Patent under Section 73(1) might therefore be necessary.
2. The proprietors submitted proposals for amendment of both the UK Patent and EP (UK) patent, which are allowable under Section 76.
3. I am satisfied that the proposed amendments prevent there from being two patents in respect of the same invention. I therefore allow the specifications to be amended as proposed, and make no order for revocation of the UK patent.

**(Name)**

Deputy Director / Head of Examination Group Acting for the Comptroller

## Annex 11

### GB/EP

#### Filenote

Section 73(1) initiated on xxxxxx. Amendments filed on ddmmyyyy have been allowed. No order for revocation made under S73(1). Clear records

|                 |   |
|-----------------|---|
| PDJ             | ✓ |
| LEDGER          | ✓ |
| OPTICS/REGISTER | ✓ |
| O/L ISSUED      | ✓ |

#### **Minute to Publishing**

Please prepare a C spec for the allowed amendments filed under Section 73(1) in the form of replacement page xxx/claims xxx/desc xxx. The description, claims and drawings have been annotated 'C' and 'For publishing purposes' for your information.

The current address for service is as follows:-

The letter reference is as indicated in our letter dated xxXXxx

Name  
Section  
Room number  
Ext

Today's date

Delete as appropriate- (Please note amendments for EP cases will follow the S27 procedure -see Chapter 17)

**Annex 12  
Letter S73FS2**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number: Number [Proprietor]**

**Amendment of the specification of a patent under Section 73(x) of the Patents Act 1977.**

**Reply due by: [\*\*\*within one month]**

I confirm receipt of the replacement [xxx] filed on [xxx]

I am pleased to inform you that your proposed amendments are allowable under section 73[x].

However as the amendments are extensive, the Examiner has requested that the xxx should be amended to bring in order to conform with the amended [xxx] of the specification.

A clean version of the retyped specification incorporating all agreed amendments should be filed and presented in a way that allows for them to be clearly identified. Please provide replacement specification within one month from the date of this letter, that is by [xxx].

These pages will then be used for publishing purposes and will clearly show the specification in its finally amended form.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 13  
Letter S73FS1**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number: [Patent Number] [Proprietor]**

**Amendment of the specification of a patent under Section 73(x) of the Patents Act 1977**

I am pleased to inform you that your proposed amendments are allowable under section 73[x].

I am now in the process of preparing a C specification and write to request that you provide a newly typed specification, incorporating all the amendments. These pages will then be used for publishing purposes and will clearly show the specification in its finally amended form.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 14**  
**Letter S73EX**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number : (xxx) [Proprietor]**

**Patents Act 1977: Action under Section 73(x)**

**Date for reply:**

The examiner, xxx, (tel: 01633 81xxxx reports as follows:

If you wish to propose further amendments, you should file a consolidated version and if reasonably possible to do so, file this electronically. The amendments should be presented in a way that allows for them to be clearly identified.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 15  
Letter S73EOT**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number: Number[Proprietor]**

**Patents Act 1977: Action under Section 73(x)**

**Date for reply: xxx**

I refer to your correspondence dated xxx, requesting an extension of time in which to respond to official letter dated xxx

The request for an extension of time is allowed. A response to our letter dated [xxx] is therefore now due by xxx.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate



**Annex 16**  
**Letter S73 EPOREV**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number : Patent Proprietor**

**Patent Act 1977: Action under Section 73(x)**

I refer to your letter dated [xxx] and note that patent EP(UK) [xxx] has been centrally revoked by the European Patent Office on xxx.

As such revocation action under Section 73(x) initiated on [xxx] will be recorded as "not proceeded with".

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

## CHAPTER 22

|  |
|--|
| <p style="text-align: center;"><b>REVOCATION ON THE COMPTROLLER'S<br/>INITIATIVE<br/>SECTION 73(2)</b></p> |
|--|

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Annex 16 Precedent S73(2) Cases

# **SECTION 73(2) REVOCATION ON THE COMPTROLLER'S INITIATIVE**

## **INTRODUCTION**

22.01 This section relates to the revocation of patents on the Comptroller's initiative under Section 73(2).

## **ACTION BY LITIGATION OFFICER A3**

22.02. All S73(2) revocation actions are processed electronically on PDAX. A patent examiner will either send the patent file to Litigation Section asking for revocation action to commence in respect of the patent or if the case is already on PDAX, he will send a message to the Litigation Team mailbox. The examiner will specify the European patent to be cited.

For cases not yet on PDAX, the A3 will:

- Arrange for the patent file to be indexed and scanned as a PDAX case.

The new case will be placed by Index and Scanning in the Litigation team mailbox to be actioned by a member of the ex parte team.

22.03 The A3 will also need to:

- enter the application on the Exparte Post Grant SharePoint List, the filing date is the date of the minute sent by the examiner to initiate proceedings under Section 73(2).

22.04 A print relating to the European patent (UK) should be obtained from the Online EPO Register: <https://register.epo.org/regviewer?lng=en>

You should check that:

- a) the opposition period of 9 months has elapsed since the grant of the patent.
- b) there is no opposition to the grant of the European patent (UK).
- c) the European patent (UK) has designated GB status.
- d) there are no requests made for central revocation of the European patent before the European Patent Office under EPC Article 105a. This allows the proprietor to request that their patent is revoked in all contracting States in which the patent is in force (MoPP 73.10)
- e) the specification on PDAX is the latest version using Register Plus and there are no central limitation proceedings ongoing. If proceedings are ongoing, proceed as follows:-

#### EPC 2000 – Central Amendment Process

Following the introduction of the central limitation process, an EP (UK) patent may now be amended centrally at the EPO as well as in each individual contracting state. On receipt of a new S73(2), the Register Plus website; <https://register.epo.org/regviewer?lng=en> should be checked to determine whether there is a request to centrally amend an EP (UK) patent. If so, you need to obtain a copy of the amendments filed at the EPO and forward these to the examiner. The examiner will consider whether the amendments, if allowed by the European Patent Office, remove the S73(2) conflict. If so, the examiner may stay the S73(2) action pending the outcome of the central amendment. If the amendment is not allowed or it does not remove the conflict, the S73(2) action may proceed.

A minute should be prepared and referred to the examiner as follows:

*On checking the EPO register, it appears that an application has been filed to amend the patent centrally at the EPO. The amendments are available to view in the dossier. Please consider if allowed, whether these amendments remove the conflict. If so, please confirm that you wish to stay the S73(2) action pending the outcome of the centrally filed amendment. The register will be checked regularly to monitor the progress of the amendment. If the amendment does not remove the conflict, please confirm that you wish to proceed with the S73(2) action.*

The A3 will create a minute on PDAX, then send a “PSM - S73(2) Central amendment filed” message to the examiner.

If the European patent (UK) has lapsed since grant, revocation action should continue (see MOPP Section 73).

If an opposition to the grant of the European patent (UK) has been filed at the European Patent Office (check via EPO Online), the case should be referred to the originating examiner with a minute.

The A3 will create a minute on PDAX, then send a “PSM – S73(2) EP in Opposition” message to the examiner. In most cases, a view will be taken on whether to stay the Section 73(2) action pending the outcome of the EPO opposition proceedings.

22.05 You should check that the GB patent is in force by using the OPTICS function DIS FUL.

If the patent is not in force, refer the case to the originating examiner as there was a period of double patenting in place.

The A3 will create a minute on PDAX, then create and send a “PSM – Patent not in Force” message to the examiner.

22.06 If all formalities have been complied with, an Official Letter PL3 (see annex 1) should be issued to the patentee allowing two months for a response. A file note should be prepared on PDAX as follows:

*PL3 issued on (insert date of PL3). B/F to.....*

The case should be diaried accordingly.

Update Diary EX2 within Outlook.

Letter created, locked and imported from PROSE.

22.07 An OPTICS free text entry should be made using the function REG ENT. The entry should read:

*“Section 73(2) action initiated on (date of PL3), in view of EP(UK).....”*

### **RESPONSE TO OFFICIAL LETTER PL3**

#### No objection to revocation

22.08 If a response is received to the PL3 that states that the patentee has no objection to the revocation of the patent, the letter should be scanned onto PDAX by Index and Scanning. A decision 3 (see annex 5) should then be prepared for the appropriate Head of Examination Group. The unsigned decision should be manually imported onto PDAX and annotated accordingly as ‘Draft Decision’.

The A3 will create a minute on PDAX, then send a “PSM – Dec 3 to authorise” message.

Once authorisation is received from the Head of Examination Group, an electronic signature can be applied to the decision. The decision should be dated and issued to the patentee with official letter DNL1 (see annex 3).

Letter created, locked and imported from PROSE.

A file note is created on PDAX.

Decisions are created using Word templates and applying the appropriate electronic signature. Electronic signatures can be located on SharePoint.

For clearing records see 22.25 – 22.28

If a response is received to the PL3 that states that the patentee has applied to centrally revoke at the European Patent Office, no action under Section 73(2) is necessary. Once we have received confirmation that the EP patent has been centrally revoked, notify the originating examiner.

Once the examiner has agreed that there is no conflict under Section 73(2), issue letter S73 EPOREV (see Annex 15).

For clearing records see 22.25 – 22.28

#### Disagreement that the patents are in conflict

22.09 The patentee may reply that he disagrees with the examiner's view that the GB patent and the European patent (UK) are in conflict. In such circumstances, this correspondence is treated as 'Observations filed' and the proprietor will usually provide evidence to support this view. The letter and evidence should be scanned onto PDAX by Index and Scanning section. This is then referred to the originating examiner with a suitable minute. If the examiner allows the patentee's submissions, decision 2 (see annex 6) should be prepared for the Head of Examination Group. The unsigned decision should be manually imported onto PDAX and annotated accordingly.

The A3 will create a minute on PDAX, then send a "PSM – Dec 2 to authorise" message. Once authorisation is received from the Head of Examination Group, an electronic signature can be applied to the decision. The decision should be dated and issued to the patentee with official letter DNL2 (see



annex 4). A file note should be prepared on PDAX as follows:

*Revocation action under S73(2) not proceeded with on (date of clear records).*

Letter created, locked and imported from PROSE.

Decisions are created using Word templates and applying the appropriate electronic signature. Electronic signatures can be located on SharePoint.

### Clear records

An OPTICS entry should be made to show that revocation has not taken place. Using REG ENT on OPTICS, a free text entry should be made as follows:

*Section 73(2) action initiated on (date of PL3) in view of EP (UK) .....not proceeded with on (date of decision)”*

The Exparte Post Grant SharePoint List should be updated by entering against the file reference number, not proceeded with on (date of decision) and the date of clear records.

A Journal entry should be prepared as follows:

*Section 73(2) action initiated on (date of PL3), in view of EP(UK)....., not proceeded with on (date of clear records)*

Advert is created in Word and then imported on PDAX using manual import (doc code is ADVERT). This is then uploaded to the weekly PDJ Live on SharePoint.

If the observations are not allowed, the examiner will provide instructions as to how you should proceed in an examination report. This report is then included

in an exam letter. The proprietor should also be provided with the opportunity to file amendments to overcome S73(2) conflict. (see Annex 13).

Where an agreement cannot be reached between the Comptroller and proprietor, the Deputy Director may decide to issue a fully reasoned Decision. In this instance, the Decision and Abstract will be forwarded to the Hearings Court.

For precedent cases, please see BL 01/109/15 and BL 0/91/93 (Annex 16).

### Patent to lapse or to be surrendered

22.10 The patentee may state that he is either:

- allowing the patent to lapse due to non-payment of renewal fees, or
- that he proposes to surrender the patent

It would appear that neither of these options is *prima facie* allowable because both patents would have been granted for a period of time. The MOPP Section 73.09 indicates that once revocation action has started, it should normally continue even though the patent may have lapsed or an offer to surrender has been made. The case should be referred to the originating examiner with a suitable minute. The examiner will usually ask for a letter to be issued to the patentee pointing out these facts and offering a hearing.

The A3 will create a minute on PDAX then send a “PSM - S73(2) request to lapse/surrender” message to the examiner.

### Amendments allowed instead of revocation

22.11 The patentee may submit proposals to amend the patent in order to remove

any conflict

- 22.12 When proposals for amendment of a GB patent are received in response to revocation action under Section 73(2), the amendments (doc code AMEN-LIT) should be referred to the originating examiner. The examiner will reply after he has considered whether the proposed amendments are acceptable or not. If they are not acceptable, the examiner will issue further instructions as to what action should be taken in an examination report. This report is then included in an exam letter. The proprietor should be provided with a further opportunity to file amendments to overcome S73(2) conflict. (see Annex 13).

The A3 will create a minute on PDAX, then send a “PSM – S73(2) Amendments filed” message to the examiner.

- 22.13 If the proposals for amendment are prima facie allowable but are extensive, the examiner may request that amendments are made throughout the whole specification in order to achieve consistency within the specification in order to conform.

The A3 is then instructed by the examiner to issue letter to proprietor for further amendments. (see Annex 11).

If the proposals for amendment are acceptable by the Examiner, but require a freshly typed specification in order for publishing to produce a C spec, letter S73FS1 is issued requesting a reply within 2 months (see Annex 12).

If the proposals for amendment are acceptable by the Examiner, refer case to the appropriate Head of Examination Group to confirm that the amendments are allowable. Once confirmation is received from the Head of Examination Group that the proposed amendments are allowable, use the assemble and enhance function to apply the amendments to the B specification. The description, claims and drawings annotated “P” and

“working copy” are copied from PREGRANT into the LITIGATION section of the dossier. The amendments are then applied using the enhance and assemble functions. In order to identify the amended sections of the specification, they are annotated “C” and “For publishing purposes” along with the sections not amended.

The references to “P” and “working copy” of the **copied** documents are deleted. This enables publishing section to extract all the documents required to produce a “C” spec.

Where the GB patent is amended Decision 1B (Annex 7) should be prepared for the appropriate Head of Examination Group. The unsigned decision should be manually imported onto PDAX and annotated accordingly.

If both the GB and the EP patents require amendment in order to remove any conflict , the GB patent is amended under S73(2) and the European patent is amended under S27. The amendment under S73(2) is stayed pending the expiry of the S27 opposition period. The amended GB and EP specifications should be published simultaneously. [For procedures on amendment under S27 see Chapter 17.]

Where the EP(UK) patent is amended Decision 1C (Annex 8) should be prepared for the appropriate Head of Examination Group. The unsigned decision should be manually imported onto PDAX and annotated accordingly.

Certificates and decisions are created using Word templates via Prose and then applying the appropriate electronic signature. Certificates and electronic signatures can be located on SharePoint.

Create a minute on PDAX, then send a “PSM – S73(2) Decision 1B or 1C and CERT to authorise” message.

Once authorisation is received from the Head of Examination Group, an electronic signature can be applied to the decision and certificate. The certificate is imported using manual import (doc code is CERTIFICATE).

- 22.14 The decision and certificate should be dated and the decision issued to the patentee with Official Letter DNL2 (see annex 4). A file note should be prepared on PDAX as follows:

*Decision issued on (date of decision). Patent amended. Clear records*

Letter created, locked and imported from PROSE.

- 22.15 Clear records

The Exparte Post Grant SharePoint List should be updated by entering against the file reference number Patent amended on (date of the decision) and the date of clear records.

- 22.16 An OPTICS entry should then be made. From the revocations menu select item 7 - amendments allowed - type in the file number and then select item 4 – under Section 73 - this will prompt you to insert the date of the decision. When prompted use A3 (upper case letters) as authority for the entry.

- 22.17 A Journal entry should be prepared as follows:

*Specification amended under Section 73(2), on (date of decision)*

Advert is created in Word and imported using manual import on PDAX (doc code is ADVERT) and is uploaded to the weekly PDJ Live on SharePoint.

- 22.18 Following this, the case can be referred to Publishing Section for the amended specification to be published.

The A3 will create a minute on PDAX and then send a “PSM – S73(2) Produce C Spec and see CERT” message to the Publishing Team mailbox. (see annex 10)

### **NO REPOSE TO OFFICIAL LETTER PL3: OFFICIAL LETTER PL5**

22.19 If, after the four month period allowed for response to Official Letter PL3 (including retrospective two months), no reply has been received, Official Letter PL5 (see annex 2) offering a hearing should be issued, specifying a 21 day period for reply. A copy of Official letter PL3 should be enclosed with the PL5.

Letter created, locked and imported from PROSE.

22.20 A file note is created on PDAX, this should read:

*No reply received to PL3 issued on (date of PL3),...PL5 issued on (date of PL5) B/F to .....(Always to a Wednesday). Update Diary EX2 within Outlook.*

### Request for a hearing in response to PL5

22.21 If in response to the PL5 letter a hearing is requested, this will need to be arranged by the Hearings Team. Following the hearing, a formal office decision will be issued by the hearing officer and sent to the proprietor by the Hearings Team.

If the patent is revoked see 22.23 – 22.27.

To refer to the hearing team, create a minute on PDAX then send a “PSM – set up hearing” message to the hearings mailbox.

The Hearings Clerk will diary the expiry of the appeal period and will

notify the A3 case worker accordingly.

The A3 will then clear records following the expiry of the appeal period.

#### No Response to Official Letter PL5

- 22.22 If no response has been received to the PL5 letter after the 21 day period has lapsed, Decision 6 (see Annex 9) should be prepared for the appropriate Head of Examination Group with the following minute:

*No reply has been received to either PL3 or PL5. Decision 6 has been prepared. Please can you authorise the application of your electronic signature.*

The unsigned decision is imported onto PDAX and annotated accordingly as 'Draft Decision'.

Decisions are created via Prose, using Word templates and applying the appropriate electronic signature.

Create a minute on PDAX, then send a "PSM – S73(2) Dec 6 to authorise" message.

Once authorisation is received from the Head of Examination Group, an electronic signature can be applied to the decision.

- 22.23 Decision 6 (Annex 9) should be dated, and issued to the patentee with Official letter DNL1 (see annex 3).

Letter created, locked and imported from PROSE.

- 22.24 A file note should be prepared on PDAX as follows:

*Decision issued on .....( date of decision). Patent revoked. Clear records.*

## Clearing Records

22.25 To update OPTICS select item 16 from the revocations menu - Register Revocation. If, when registering the revocation of the patent, it is found that the patent has lapsed, it should be referred to the B3 who will change the status of the patent so that it can be revoked.

The A3 will create a minute on PDAX, then send a “PSM – Patent ceased” message to B3.

22.26 A Journal entry should be prepared under the following heading:

### **SECTION 73**

#### **Revocation on the Comptroller’s Initiative**

#### **Patent revoked under Section 73(2)**

|                      |                                      |
|----------------------|--------------------------------------|
| <b>Patent Number</b> | PROPRIETOR’S NAME                    |
|                      | Title                                |
|                      | Patent Revoked on (date of decision) |

Advert is created in Word and imported to the dossier using manual import (doc code - ADVERT). The advert should also be uploaded to the weekly PDJ Live on SharePoint.

22.27 The Exparte Post Grant SharePoint List should be updated using the file reference number. A file note is then created on PDAX with the outcome of the S73(2) proceedings, the date of decision and the date of clear records.

### **EXTENSIONS OF TIME**

22.28 S117(B) of the Patents Act 1977 provides for an additional automatic extension of two months for periods specified by the Office. This may be applied retrospectively. Most of the requests for extensions of time relate to proposed amendments. These extensions of time may be allowed with the



examiners discretion.

- 22.29 Where an automatic extension of time has been applied and then a further extension of time is received the request is referred to the originating examiner, who will consider it on its respective merits. It should be remembered that Section 73 cases are *ex parte*. Therefore no other parties are involved or need to be consulted.

The A3 will create a minute on PDAX and send a “PSM – S73(2) Further extension of time request” message to the examiner.

- 22.30 Once an extension of time has been granted, this should be confirmed in writing using letter S73 EOT via Prose, offering the proprietor a new deadline for a response. (See Annex 14)  
Letter created, locked and imported from PROSE.  
A file note is created on PDAX.

**Annex 1**  
**Letter S73(2) PL3**

**Your Reference:**  
**Our Reference:1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: xxxxxxxx (*Proprietors Name*)**  
**Patents Act 1977: Action under Section 73(2)**

**Latest date for reply. xx. xx. xx**

The examiner xxx (tel: xxx) considers that this patent has been granted for the same invention as European Patent (UK) No. xxx having the same priority date.

By xxx you should either propose amendments to the UK patent in order to meet this objection or make observations on it. If you do not the UK patent may be revoked. Alternatively, you may reply advising that you are content with the revocation or have made a request for revocation at the European Patent Office under Article 105a. Please be advised that revocation of the UK patent cannot be avoided by allowing the EP(UK) patent to lapse by non-payment of renewal fees, irrespective of whether the EP(UK) lapsed before or after the grant of the corresponding UK patent.

*(delete as appropriate)*

*We note from the Register entry for this patent that an exclusive licence has been recorded to xxx on xxx.*

*We note from the Register entry for this patent that a security agreement has been filed between xxx and xxx on xxx.*

If you wish to propose amendments it would be helpful if these could be shown in red ink on a copy of the printed specification. However, if the amendments are simple and not extensive you may submit them in a letter. You may not however amend your patent in a way which adds matter or extends the protection conferred by the patent.

Yours faithfully

Your name  
Litigation Section  
Patents Directorate

**Annex 2  
Letter S73(2) PL5**

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)**

**Patents Act 1977: Action under Section 73(2)**

**Latest date for reply. xx. xx xx**

Our letter of xx xx xx invited you to propose amendments or to make observations in response to an objection that the patent had been granted for the same invention as European Patent (UK) No xxx . However no reply has been received.

We will now consider whether your patent should be revoked. If you want to be heard before the Comptroller decides the matter you should ask by xxx for a hearing to be appointed.

Please find enclosed a copy of our initial letter issued on DD MMM YYYY for your reference.

Yours faithfully

Your name

Litigation Section

Patents Directorate

Enc: Official PL3 Letter

**Annex 3  
Letter DNL1**

**Your Reference:**  
**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Action under Section 73(2)**

1. Please find enclosed a copy of a decision dated xxxxxx.
2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from H M Courts & Tribunal Service, Royal Courts of Justice Group, Chancery Appeals Office, 7 The Rolls Building, Fetter Lane, London, EC4A 1NL (telephone 020 7947 6890/6294/6243).
3. Two copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee **within the time period specified in the decision**. The latest date for appeal is therefore xxxxxx. Any request for an extension to the appeal period identified in the decision must be made to the court.
4. Once you have filed your appeal at the court, you must send a copy to the Notice of Appeal to the Comptroller as soon as practicable and no later than 7 days from the date of filing.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Your name  
Litigation Section  
Patents Directorate

**Annex 4  
Letter DNL2**

**Your Reference:**  
**Our Reference: 1R31/Name/File Reference**

Date

Dear Sir

**Patent Number: xxxxxx (Proprietors Name)**

**Patents Act 1977: Action under Section 73(2)**

Please find enclosed a copy of a decision dated xxxxxxxx.

Yours faithfully

Your name  
Litigation Section  
Patents Directorate

**Annex 5  
Decision 3**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE                      Whether Patent Number GB xxxxxxxx should  
   be revoked under Section 73(2)

---

**DECISION**

- 1      An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) xxxxxxxx, and that revocation of the UK patent under Section 73(2) might therefore be necessary. The proprietors in a letter dated xxxxxxxx, advised that they were content for the revocation of the UK patent.
  
- 2      In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(2) are met. I therefore order revocation of the UK Patent.

**Appeal**

- 3      Any appeal must be lodged within 28 days after the date of this decision.

**(Name)**

Deputy Director / Head of Examination Group acting for the Comptroller

**Annex 6  
Decision 2**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxx should  
be revoked under Section 73(2)

---

**DECISION**

1. An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) xxxxxxxx, and that revocation of the UK Patent under Section 73(2) might therefore be necessary.
2. The proprietor contested the examiner's view in their letter dated xxxxxxxx. I have considered their observations and I make no order for revocation of the UK patent.

**(Name)**

Deputy Director / Head of Examination Group acting for the Comptroller

**Annex 7  
Decision 1B**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxx should  
be revoked under Section 73(2)

---

**DECISION**

1. An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) xxxxxxxx, and that revocation of the UK Patent under Section 73(2) might therefore be necessary.
2. The proprietor submitted proposals for amendment of the specification, which are allowable under Section 76.
3. I am satisfied that the proposed amendments prevent there from being two patents in respect of the same invention. I therefore allow the specification to be amended as proposed, and make no order for revocation of the UK patent.

**(Name)**

Deputy Director / Head of Examination Group acting for the Comptroller



**Annex 8  
Decision 1C**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxx should  
be revoked under Section 73(2)

---

**DECISION**

1. An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) xxxxxxx B1, and that revocation of the UK Patent under Section 73(2) might therefore be necessary.
2. The proprietor submitted proposals for amendment of both the UK Patent and EP(UK) patent xxxxxxx, which are allowable under Section 76.
3. I am satisfied that the proposed amendments prevent there from being two patents in respect of the same invention. I therefore allow the specifications to be amended as proposed, and make no order for revocation of the UK patent.

**(Name)**

Deputy Director / Head of Examination Group acting for the Comptroller

**Annex 9  
Decision 6**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxx should  
be revoked under Section 73(2)

---

**DECISION**

1. An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) xxxxxxx and that revocation of the UK Patent under Section 73(2) might therefore be necessary. The proprietor did not submit observations or proposals for amendment. A hearing was therefore offered in an official letter dated xxxxxxxx, but the proprietor has not asked to be heard.

2. In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(2) are met. I therefore order revocation of the UK patent.

**Appeal**

3. Any appeal must be lodged within 28 days after the date of this decision.

**(Name)**

Deputy Director / Head of Examination Group acting for the Comptroller

## ANNEX 10

### GB/EP

#### **Filenote (Clear Records)**

Section 73(2) initiated on xxx. Amendments allowed on xxx. No order for revocation made. Clear records

|                 |   |
|-----------------|---|
| PDJ             | ✓ |
| LEDGER          | ✓ |
| OPTICS/REGISTER | ✓ |
| O/L ISSUED      | ✓ |

#### **Minute to Publishing**

Please prepare a C spec for the allowed amendments filed under Section 73(2) in the form of replacement page xxx/claims xxx/desc xxx. The description, claims and drawings have been annotated 'C' and 'For publishing purposes' for your information.

The current address for service is as follows:-

The letter reference is as indicated in our letter dated xxXXxx

Name  
Section  
Room number  
Ext

Today's date

Delete as appropriate- (Please note amendments for EP cases will follow the S27 procedure -see Chapter 17)

**ANNEX 11**  
**Letter S73FS2**

**Your reference:**

**Our reference: 1R31/Name/Patent Number**

Date

Dear Sirs

**Patent Number: Number/Proprietor**

**Amendment of the specification of a patent under Section 73(x) of the Patents Act 1977.**

**Reply due by: [\*\*\* within one month]**

I confirm receipt of the replacement [\*\*\*] filed on [\*\*\*].

I am pleased to inform you that your proposed amendments are allowable under section 73(x).

However as the amendments are extensive, the Examiner has requested that the xxx should be amended to bring in order to conform with the amended xxx of the specification.

A clean version of the retyped specification incorporating all agreed amendments should be filed and presented in a way that allows for them to be clearly identified. Please provide replacement specification within one month from the date of this letter, that is by [\*\*\*].

These pages will then be used for publishing purposes and will clearly show the specification in its finally amended form.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**ANNEX 12  
Letter S73FS1**

**Your reference:**

**Our reference:1R31/Name/Patent Number**

Date

Dear Sirs

**Patent Number: Number/Proprietor**

**Amendment of the specification of a patent under Section 73(x) of the Patents Act 1977**

**Date for reply: DD MMM YYYY**

I am pleased to inform you that your proposed amendments are allowable under section 73[x].

I am now in the process of preparing a C specification and write to request that you provide a newly typed specification, incorporating all the amendments. These pages will then be used for publishing purposes and will clearly show the specification in its finally amended form.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**ANNEX 13  
Letter S73EX**

**Your reference:**  
**Our reference:1R31/Name/Patent Number**

Date

Dear Sirs

**Patent Number: Number/Proprietor**

**Patents Act 1977: Action under Section 73(x)**

**Date for reply:**

The examiner [xxx], (tel: 01633 81 xxxx) reports as follows:

If you wish to propose further amendments, you should file a consolidated version and if reasonably possible to do so, file this electronically. The amendments should be presented in a way that allows for them to be clearly identified.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**ANNEX 14  
Letter S73EOT**

**Your reference:**

**Our reference:1R31/Name/Patent Number**

Date

Dear Sirs

**Patent Number: Number/Proprietor**

**Patents Act 1977: Action under Section 73(x)**

**Date for reply: xxx**

I refer to your correspondence dated xxx, requesting an extension of time in which to respond to official letter dated xxx.

The request for an extension of time is allowed. A response to our letter dated xxx is therefore now due by xxx.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**ANNEX 15**  
**Letter S73 EPOREV**

**Your reference:**

**Our reference:1R31/Name/Number**

Date

Dear Sirs

**Patent Number : Patent Proprietor**

**Patent Act 1977: Action under Section 73(\*)**

I refer to your letter dated [\*\*\*] and note that patent EP(UK) [\*\*\*] has been  
entrally revoked by the European Patent Office on [\*\*\*].

As such revocation action under Section 73(x) initiated on [\*\*\*] will be recorded  
as “not proceeded with”.

Yours faithfully

*Your Name*

Litigation Section  
Patents Directorate



**ANNEX 16**  
**Precedent Cases**

| <b>Precedent Section 73(2) Cases</b> |  |                                      |                     |
|--------------------------------------|--|--------------------------------------|---------------------|
| <b>Patent Publication No.</b>        | <b>Patent Title</b>  | <b>Patent Proprietor</b>             | <b>BL Reference</b> |
| GB2386032                            | Method of estimating traffic data  | Parc Technologies Limited            | BL O/109/15         |
| GB2101984                            | Polymer-modified cement mortars and concretes and processes for the production thereof | The Marley Roof Tile Company Limited | BL O/91/93          |

## CHAPTER 23

### SECTION 75

#### AMENDMENT OF PATENT INFRINGEMENT OR REVOCATION PROCEEDINGS BEFORE THE COURT

|  |               |
|--|---------------|
| Introduction   | 23.01 - 23.03 |
| Central Limitation Process – EPC 2000                                      | 23.03         |
| Amendment during proceedings before the Court                              | 23.04         |
| Directions for the electronic delivery of applications                     | 23.05 - 23.07 |
| By email   | 23.06         |
| Setting out amendments   | 23.07         |
| Amendments filed in paper form   | 23.08         |
| Action on receipt for the amendments                                       | 23.09         |
| Consideration of proposals to amend  | 23.10 - 23.12 |
| Notice of opposition   | 23.12         |
| Court directions   | 23.13 - 23.15 |
| Order of Court   | 23.14 - 23.15 |
| Amendments not allowed, patent revoked or patent revoked<br>pending appeal | 23.16 - 23.17 |
| Register entry   | 23.16 - 23.17 |
| Clear Records  | 23.18 - 23.22 |
| Final Journal Advert   | 23.19         |
| Electronic Ledger  | 23.20         |
| Court allows the specification to be amended or appeal allowed             | 23.23         |
| Amendment of the B specification   | 23.23         |
| Clear records  | 23.24 - 23.29 |
| Register entry   | 23.24         |
| Journal Advert   | 23.25         |
| Electronic Ledger  | 23.26         |
| Publishing action for production of the C specification                    | 23.27         |
| Deleted  | 23.29         |

## Annexes

|          |   |
|----------|---|
| Annex 1  | Journal notice  |
| Annex 2  | Table   |
| Annex 3  | S 75a letter  |
| Annex 4  | S 75c letter  |
| Annex 5  | S 75e letter  |
| Annex 6  | Standard Publishing minute                                    |
| Annex 7  | Letter relating to Central Limitation Process                 |
| Annex 8  | Deleted   |
| Annex 9  | Comptrollers Comments Log                                     |
| Annex 10 | Court of Session Journal Notice                               |
| Annex 11 | Letter relating to Comptrollers Comments for Court of Session |
| Annex 12 | Certificate for Advert  |
| Annex 13 | Certificate for Patent Specification and Register Entries     |
| Annex 14 | Letter relating to advertisement of terms of interlocutor     |

## **23 APPLICATION TO AMEND THE SPECIFICATION OF A PATENT UNDER SECTION 75 BEFORE THE COURT**

### **INTRODUCTION**

23.01 This chapter is concerned with the amendment of the specification of a granted patent during proceedings in the Courts of England and Wales and in the Scottish Court of Session. Proceedings in the courts of England and Wales are governed by the Civil Procedure Rules 1998 as amended. Proceedings in Scotland in the Court of Session are governed by rule 55 of the rules of the Court of Session. Amendments may also be filed under section 75 in revocation proceedings before the comptroller (see Chapter 14 for details).

23.02 Amendments to EP and GB patents are processed electronically on PDAX.

If an EP paper case already exists, this is requested from NMP and scanned onto the dossier along with the application for amendment by Index and Scanning section. If no paper file exists, a BDOC is requested and is scanned onto the dossier along with the application for amendment.

23.03 EPC 2000 – Central Limitation Process

Following the introduction of the central limitation process, an EP (UK) patent may now be amended centrally at the EPO as well as in each individual contracting state. On receipt of a new s75, the European Patent Register <https://register.epo.org/regviewer?lng=en> should be checked to determine whether there is a request to centrally limit an EP (UK) patent. And If so, whether the applicant wishes to stay the UK proceedings until conclusion of the EPC process or wishes to proceed. A standard letter is issued. (See Annex 7).

A minute should be prepared as follows:

*Official letter issued to attorney on XX.XX.XX. B/F for 1 month (always to a Wednesday)*

PDAX:- Letter created, locked and imported from PROSE

File note is created in PDAX

## **AMENDMENT DURING PROCEEDINGS BEFORE THE COURT/COURT OF SESSION**

23.04 For proposals to amend under Section 75 before the court, applicants need to file an application notice. The application notice consists of:-

- The prescribed form N244 (or the equivalent information). The form is available on the office website at [www.ipo.gov.uk/n244.rtf](http://www.ipo.gov.uk/n244.rtf)
- Particulars of the amendment
- The grounds for seeking the amendment

All this information must be filed at the court on paper and should also be served on the Comptroller electronically if reasonably possible (see rule 63.10 of the Civil Procedure Rules 1998 as amended). There is a fee payable to the court but not to the Comptroller.

For proposals to amend under Section 75 before the Court of Session, requirements differ, in that a patentee shall give notice of his intention to the comptroller to make an application to the Court of Session for leave to amend the patent under section 75. The application should also include:

- Particulars of the amendment sought

## **DIRECTIONS FOR THE ELECTRONIC DELIVERY OF APPLICATIONS**

23.05 Electronic delivery should be made by email to [litigationamend@ipo.gov.uk](mailto:litigationamend@ipo.gov.uk).

### By email

23.06 The A3 should not accept an email for these purposes at any email address other than that given above. The email should be a plain text message.

The email should be entitled *proposal to amend under s75 before the courts/court of session*

The text may be provided as an attachment to the email.

If the A3 is unable to read the text, the email should be treated as not delivered, and in these circumstances the A3 should contact the applicant with a view to making alternative arrangements.

### Setting out the amendments

23.07 Applicants are encouraged to use conventional word processing features such as markup, coloured text and strikeout/strikethrough to set out the amendments on the original version of the text in a way that makes it easy for the reader to appreciate the changes.

### **AMENDMENTS FILED IN PAPER FORM**

23.08 Any amendments filed in paper format should clearly identify the amendments on a copy of the specification.

### **ACTION ON RECEIPT OF THE AMENDMENTS**

23.09 The A3 should check the following have been provided:

- The particulars of the proposed amendments.
- The grounds on which the amendments are sought. (Not required for Court of Session).
- Whether the applicant will contend that the claims prior to amendment are valid. (Not required for Court of Session).

- If the application for amendment applies to an EP (UK) patent the A3 should ensure that the specification is the latest version using the European Patent Register and check that there are no central amendment proceedings ongoing, refer to 23.03.
- Complete the Journal notice see Annex 1 (Annex 10 for S75 before the Court of Session) and enter the section 75 details on the summary listing noting whether amendments have been filed electronically or in paper format. For s75 before the Court of Session, Publishing should be notified of the format changes due to the additional information required for advertisement.
- Request the name and address details of the solicitor representing the other side to enable them to receive copies of correspondence throughout the proceedings.
- If the question of dispensing advertisement is raised prior to the Court Hearing, the applicant will inform us either in a letter or possibly a draft Court Order. On receipt, the s75 application should be stayed pending the outcome of the Court Hearing.
- Alternatively, the applicant may request that prior to advertisement the Head of Examination Group considers the amendments. In this case, the A3 should refer the amendments to the Head of Examination Group who will then decide whether Comptrollers comments should be issued prior to advertisement and if so, will forward comments in due course. Occasionally, on receipt of the application for amendment, the courts will have already considered the amendments and dispensed with the need for them to be advertised for opposition. The A3 should action any Court Order received, make the appropriate entries on the Register and prepare a final advert for the Patents and Designs Journal.

Advert is created and imported using manual import (doc code is ADVERT).

- When the weekly journal is produced, send electronic amendments to webmaster. The summary listing should accompany the amendments and the A3 should advise webmaster which journal date the notice will appear in (see annex 2).

Webmaster will then arrange a link from the web notice to the full details of the amendment (electronic amendments only). Where the amendments have been filed in paper form only; full details will be available from the Litigation Section upon request.

- Issue S75(a) (see Annex 3) letter advising the applicant when the notice of proposed amendments will be advertised in the Journal. For Court of Session issue S75 (see Annex 11) letter advising the applicant when the notice of the proposed amendments will be advertised in the Journal. Also confirming that a certified copy of the advertisement and marked up copy of the patent specification will be sent once the advertisement is published. The A3 should make a note in the Court work Diary of the date to prepare and issue the certified office copies.

PDAX:- Letter created, locked and imported from PROSE  
File note is created in PDAX

The A3 will then:

- make a free text entry on OPTICS using REG ENT

For amendments filed electronically, the A3 should send the document to the dossier and message the Ex parte team 1 mailbox.

## **CONSIDERATION OF PROPOSALS TO AMEND**

23.10 The A3 should then send the proposals for amendment to the Head of



Examination Group responsible for the subject matter for any comments and to confirm whether the Comptroller wishes to be represented in Court. Before issuing to the Head of Examination Group, the A3 will complete the Comptrollers Comment Log on SharePoint. (see annex 9)

PDAX:- Create a minute in PDAX and send a “PSM – Comptrollers Comments” message to the DD.

- 23.11 Following expiry of the opposition period, the Head of Examination Group will instruct the A3 to issue the Comptrollers comments. This may take the form shown in standard letter S75(c) (see annex 4). This should be sent to the applicant(s) when the Comptroller has no comments to make on the proposed amendments and does not wish to be represented in Court. If the Head of Examination Group wishes to comment on the amendments, he will provide you with the appropriate text. You should not issue the Comptrollers comments until the 14 day period for opposition has passed (or 28 days for S75 before the Court of Session). Make a note on DiaryEX1 of the date the Comptroller’s comments are to be issued.

PDAX:- Letter created, locked and imported from PROSE.  
File note is created in PDAX

#### Actions following Advertisement : Scottish Court of Session

Once the advertisement has appeared in the Patents and Designs Journal and within 35 days of the appearance of the advert, a certified copy of the front page of the Patents & Designs Journal in which the advertisement appeared, and a certified copy of the marked up patent specification and register print-out should be issued to the attorney in accordance with Rule 55.5(4). The A3 should complete the appropriate certificates (see Annexes 12 and 13) and ribbon and seal the relevant one to the marked up specification, register print out and the front page of the relevant Patents and Designs Journal. Both certificates should be signed and dated by an Officer duly authorized to issue certificates on behalf of the Comptroller-General.

### Notice of opposition

23.12 An opponent must file and serve on all parties and the Comptroller a notice opposing the application. The notice must include the grounds relied on. This must be filed within 14 days of the first appearance of the advertisement (Journal notice) or 28 days for s75 before the Court of Session.

The A3 must send the notice of opposition to the Head of Examination Group to ensure that this is taken into consideration before issuing the Comptroller's comments.

PDAX:- Create a minute in PDAX send a "PSM – Opposition filed" message to DD.

### **COURT DIRECTIONS**

23.13 The applicant must apply to the Court in England and Wales for directions within 28 days of the date of the advertisement (Journal notice)

### Order of the Court. (Outcome of proceedings)

23.14 Unless the Court otherwise orders, the applicant must within 7 days serve on the Comptroller any Order of the Court relating to the application.

23.15 The Court Order will state the outcome of the Court proceedings i.e. whether the amendments have been allowed (see 23.18) or refused, whether the proceedings have been stayed, or whether the patent has been

revoked (see 23.16). The Court Order should be referred to the Head of Examination Group for information/confirmation or clarification on how to proceed.

The proprietor may file a second set of amendments. These will require

advertising unless the Court Order dispenses with the requirement for advertisement, in which case the amendments may be referred immediately to the Head of Examination Group for a second Comptroller Comments letter. The Court Order may also direct that these further amendments are allowed and that the patent may be amended. (No OPTICS or ledger entry is required).

PDAX:- Create a minute in PDAX and send a “PSM – Court Order” message to the DD.

### **AMENDMENTS NOT ALLOWED, PATENT REVOKED OR PATENT REVOKED PENDING APPEAL**

#### Register entry

23.16 The A3 should make a register entry using the REG ENT function on OPTICS to reflect the outcome of the Order. Where a patent is revoked by an Order of the Court but the Order has been stayed pending appeal, the patent should not be revoked until either (a) the stay has expired and an appeal has not been filed within the period allowed or (b) where an appeal has been filed, a copy of the Order from the Court of Appeal has been received upholding the earlier decision.

23.17 The A3 should send a standard letter s75e (see annex 5) to the applicants' attorney acknowledging receipt of the Court Order. The applicants should also be informed that the Register has been updated and that an advertisement reflecting the outcome of the decision will appear in the Journal.

PDAX:- Letter created, locked and imported from PROSE.

Advert is created and imported using manual import (doc code is ADVERT).

File note is created in PDAX

### **CLEAR RECORDS**

23.18 A final entry for the Journal should be made (see 23.19), and the electronic ledger updated (23.20). A clear records proforma (see annex 6) should be used as a check list to ensure that all relevant actions have been completed.

### Final Journal Advert

23.19 A final advertisement for the Journal should be prepared as follows:-

#### **Section 75**

#### **Application to amend the Specification of a patent under Section 75 before the Court/Court of Session**

#### **Application refused by Court Order/dismissed by Court Order/Patent Revoked. *(use wording as appropriate)***

| <b>Patent number</b> | <b>PROPRIETORS NAME</b> |
|----------------------|-------------------------|
|                      | <b>TITLE</b>            |

Application to amend under Section 75, refused /dismissed /patent revoked  
*(use wording as appropriate)* by Court Order dated .....

The date the advert is due to appear in the Journal should be entered on the clear records proforma on the dossier.

Advert is created and imported using manual import (doc code is ADVERT).

### Electronic Ledger

23.20 The Sections electronic ledger is found in SharePoint under Ex-parte post grant SharePoint list. Locate the appropriate year and section and enter the outcome of the case (see Journal and register entry), and the date. Highlight the entry to show the case has been completed.

23.21 (Deleted)

23.22 (Deleted)

## **COURT ALLOWS THE SPECIFICATION TO BE AMENDED OR APPEAL HAS BEEN ALLOWED**

### Amendment of the B specification

#### 23.23 For amendments to GB specifications

The description, claims and drawings annotated “P” and “working copy” are copied from PREGRANT into the LITIGATION section of the dossier. The amendments are then applied using the assemble and enhance functions. The amended sections of the specification are annotated “C” and “working copy” along with any copied sections not amended. The references to “P” and “working copy” in the original copied documents are deleted. This enables Publishing Section to extract all the documents required to produce a “C” specification.

#### For amendments to EP specifications

For amendments to EP patents, if the amendments cannot be applied using enhance or assemble, a copy of the BDOC should be printed from the dossier and the amendments applied manually. The amended BDOC should then be scanned onto the dossier by Index and scanning section. A file note is prepared as follows:-

*Amendments applied to BDOC and sent to Index and Scanning*

PDAX:- File note is created in PDAX.

If the amendments are extensive and no replacement specification has been filed, one may be requested from the attorney.

Any replacement specifications should be checked by the A3 to ensure that

the amendments made are in fact the same as those allowed by the Court.  
A file note should be prepared as follows:

*Specification checked - amendments incorporated into retyped specification agree with those advertised and allowed by the Court.*

PDAX:- Letter created, locked and imported from PROSE.  
File note is created in PDAX.

Once the patent is amended or the amended EP BDOC is scanned onto PDAX, the amended patent should be referred to the appropriate Head of Examination Group. A file note should be prepared as follows:-

*Amendments allowed by Court Order dated xxxxxx applied to the B Specification on pages xxxxxx/ amendments in the form of replacement pages xxxxxx/ amendments in the form of replacement specification. (Delete as appropriate). Please confirm that I can now apply your electronic signature to the appropriate certificate.*

PDAX:- Create a minute in PDAX and send a “PSM – s75 and confirm your electronic signature can be added to the appropriate certificate” message to Head of Examination Group.

Once a message is received from the Head of Examination Group, a letter (see annex 5) should be issued by the A3 notifying the applicant that a copy of the C specification will be forwarded in due course by Publishing Section. The appropriate certificate should be dated with the date of the Court Order and a Head of Examination Group electronic signature applied. This should then be pasted into a Word document and imported into the dossier using manual import (doc code CERTIFICATE). The certificates are located on SharePoint .

The following file note should be prepared as follows:

*Amendments allowed on by Court Order dated xxxxxx. O/L issued*

*(insert date). Clear records.*

PDAX:- File note is created in PDAX.

Letter created, locked and imported from PROSE.

### Amendments allowed by the Court of Session

Notification that the amendments are allowed will be in the form of a certified copy of the interlocutor which is the order of the Scottish Courts.

The relevant section that concerns the allowed amendment requires advertising once the certified copy of the interlocutor is received. The necessary information is extracted from the interlocutor and incorporated into the final advert (see 23.25).

Before seeking a certified copy, the attorney may seek advice on the suitability of the interlocutor for publishing purposes. Only information regarding the amendment is required for producing an advert and we may provide an advert template showing the suggested wording required. The final advert should state that the certified copy of the interlocutor is available to view on request.

Advertisement of the terms of the interlocutor should be communicated to the attorney (see Annex 14) along with a request for a replacement specification, if required.

Once the amendment has been advertised as allowed, the specification can be amended as directed by the court (see 23.23). Once the specification has been amended and the certificate authorised, records can be cleared (see 23.24 – 23.29) and the case referred to publishing for production of a C specification.





Advert is created and imported using manual import (doc code is ADVERT).  
File note is created in PDAX.

### Electronic Ledger

23.26 Follow procedure at 23.20; however the outcome will be 'Amendments allowed'.

### Publishing action for production of the C Specification

23.27 For GB cases, if the amendments have been allowed, a request is made to Publishing Section for a C specification. A detailed minute should be prepared for Publishing. (see annex 6) If the C specification was amended, then a C2 is requested.

To refer a case to Publishing, send a "PSM – s75 allowed by Court Order, please see certificate for details of amendment and prepare a C specification" message to the Publishing Team Mailbox.

For EP cases, the corrected BDOC should be annotated "For Publishing Purposes". A detailed minute should be prepared for Publishing. (see annex 6) If the C specification was amended, then a C2 is requested.

23.28 (Deleted)

### Deleted

23.29 (Deleted)





## Annex 2

### Applications for Amendment of Specification

| <b>Sect.</b>                            | <b>PDJ<br/>No. &amp;<br/>Date</b> | <b>Opposition<br/>deadline</b> | <b>Patent No.<br/>and title</b> | <b>Int.<br/>Class</b> | <b>Proprietor<br/>(Court action<br/>number if any<br/>and address<br/>for service)</b> |
|---|-----------------------------------|--------------------------------|---------------------------------|-----------------------|--|
| 27                                      |                                   | <b>4 weeks</b>                 |                                 |                       |  |
| 75<br>Before the<br>Comptroller         |                                   | <b>2 weeks</b>                 |                                 |                       |  |
| 75<br>Before the<br>Court               |                                   | <b>14 days</b>                 |                                 |                       |  |
| 75<br>Before the<br>Court of<br>Session |                                   | <b>28 days</b>                 |                                 |                       |  |

**Annex 3**  
**Letter S75(a)**

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: xxxxxx (Proprietors Name)**

**Application to amend the specification of a patent under Section 75 of the Patents Act 1977**

**Action No xxxx**

Thank you for your letter dated xxxxxx. The notice of proposed amendments will be advertised in the Patents & Designs Journal on xxxxx.

In order to assist the Head of Examination Group in deciding whether to be represented in Court, please let me know whether there are any other Court proceedings pending in respect of this patent and if so whether the other party involved in those proceedings has been notified of the application to amend.

The Comptrollers comments on the proposed amendments will be sent to you after the expiry of the 14 day opposition period.

A copy of this letter has been sent to the other side.

Yours faithfully

*Your name*

Litigation Section

Patents Directorate

**Annex 4**  
**Letter (s75c)**

**Your Reference:**  
**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: xxxxxx (Proprietors Name)**  
**Application to amend the specification of a patent under Section 75 of the**  
**Patents Act 1977**  
**Action No xxxx**

I refer to your application for amendment filed on xxxxxxxx.

The Comptroller has considered the proposed amendments in the context of clarity, added matter and support under sections 14(5) and 76 of the UK Patents Act.

The Comptroller has no comments to make on the proposed amendments and does not wish to be represented in Court unless otherwise directed by the Court.

A copy of this letter has been sent to the other side.

Yours faithfully

*Your name*  
Litigation Section  
Patents Directorate

**Annex 5**  
**Letter s75(e)**

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

Date

Dear Sirs

**Patent number: xxxxxx (Proprietors Name)**

**Application to amend the specification of a patent under Section 75 of the Patents Act 1977**

**Action No xxxx**

Thank you for your letter dated xxxxxxxx .and copy of the Order of the Court dated xxxxxx.

The outcome of the proceedings will be advertised in the Patents and Designs Journal on xxxxx and noted in the patents register.

A copy of this letter has been sent to the other side.

Yours faithfully

*Your name*

Litigation Section

Patents Directorate

## ANNEX 6

### GB/EP

Amendment under s75 before the Court allowed by Court Order dated xxXXxx.

#### Clear Records

|                 |  |
|-----------------|--|
| PDJ             |  |
| SHAREPOINT SITE |  |
| OPTICS/REGISTER |  |
| O/L ISSUED      |  |

#### Publishing

Amendment under s75 before the Court allowed by Court Order dated xxXXxx

Please prepare a C spec for the allowed amendments. The allowed amendment(s) is/are in the form of claims xxx/description pages xxx/replacement pages xxx.

\*For GB cases the claims, description & drawings have been annotated 'C' and 'For publishing purposes' for your information

\*For EP cases the BDOC has been annotated 'C' and 'For publishing purposes' for your information

The current address for service is as follows:-

Attorney's reference : xxXXxx.

Name  
Section  
Room Number  
Ext  
Today's Date



## ANNEX 7

**Your Reference:**

**Our Reference: 1R31/Name/File Reference**

***Date***

*Dear Sirs*

***Patent number: xxxxxx (Proprietors Name)***

***Application to amend the specification of a patent under Section 75 of the Patents Act 1977***

***Latest date for reply xx xx xx***

*I refer to your application for amendment filed on xx. Xxxxx. Xxx .*

*On checking the European Patent Office register, it appears that you have filed an application to centrally limit your patent at the EPO. In these circumstances there are two options available to you*

- a. staying the request until the conclusion of the central limitation process, or
- b. proceeding with the request to amend under Section 75

If the national and central process results in different amended claims, you should be aware that there may be an issue as to which amendment takes precedence.

You should advise me of your decision regarding the above by xx. Xxxxx. xxxx .

A copy of this letter has been sent to the other side.

*Yours faithfully*

Your Name  
*Litigation Section*  
*Patents Directorate*

**ANNEX 8 deleted**



## **ANNEX 10**

### **Section 75**

#### **Before the Court of Session**

If you intend to oppose the amendments lodged under Section 75 before the court, you must **within 28 days** from the appearance of this advertisement, give written notice of that intention to the applicant and to the Deputy Principal Clerk, Court of Session, Parliament House, Parliament Square, Edinburgh, EH1 1RQ.

**Section:** **75 before the Court of Session**

**Patent Number:** GB/EP(UK)XXXXXXXX

**Proceedings:** **Proprietor v Other Party**

**Court of Session**

**Action Number:** xxxx

**Title of Patent:**

**International Classification:** xxxx

**Name of Patent Proprietor:** Proprietor

**Proprietor's address  
for service:** xxxxxxxx

**These amendments may be viewed on our website/For a copy of these amendments phone Litigation Section 01633 813875.**

## ANNEX 11

**Your reference:**

**Our reference: 1R31/Name/File Reference  
Number**

Date

Dear Sirs

**Patent Number : xxxxxx (Proprietors Name)**

**Application to amend the specification of a patent under Section 75 of the  
Patents Act 1977**

**Court Action no. xxxx**

Thank you for your correspondence dated xxxxxx. Notice of the proposed amendments will be advertised in the Patents & Designs Journal on xxxxxx.

The Comptrollers comments on the proposed amendments will be sent to you after the expiry of the 28 day opposition period. A certified copy of both the advertisement and marked up copy of the patent specification showing the amendments sought will be sent once the advertisement is published.

A copy of this letter has been sent to the other side.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

## ANNEX 12

Concept House  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ

I, the undersigned, being an officer duly authorised in accordance with Section 74(1) and (4) of the Deregulation and Contracting Out Act 1994, to sign and issue certificates on behalf of the Comptroller-General, hereby certify that annexed hereto is a true copy of an advertisement published in the:

Patents & Designs Journal No. XXXX on xxXXXXxx

I also certify that subject to the payment of the prescribed renewal fees, the patent will remain in force for a period of twenty years from the date of the filing of the application as shown therein.

In accordance with the Patents (Companies Re-registration) Rules 1982, if a company named in this certificate and any accompanying documents has re-registered under the Companies Act 1980 with the same name as that with which it was registered immediately before re-registration save for the substitution as, or the inclusion as, the last part of the name of the words "public limited company" or their equivalents in Welsh, references to the name of the company in this certificate and any accompanying documents shall be treated as references to the name with which it is so re-registered.

In accordance with the rules, the words "public limited company" may be replaced by p.l.c., plc, P.L.C. or PLC.

Re-registration under the Companies Act does not constitute a new legal entity but merely subjects the company to certain additional company law rules.

Signed

Dated

## ANNEX 13

Concept House  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ

I, the undersigned, being an officer duly authorised in accordance with Section 74(1) and (4) of the Deregulation and Contracting Out Act 1994, to sign and issue certificates on behalf of the Comptroller-General, hereby certify that annexed hereto is a true copy of the entries made to date in the Register of Patents, and Schedule of Amendments sought under Section 75 to amend the patent specification before the Court of Session in respect of the patent which is in force in the United Kingdom.

I also certify that subject to the payment of the prescribed renewal fees, the patent will remain in force for a period of twenty years from the date of the filing of the application as shown therein.

In accordance with the Patents (Companies Re-registration) Rules 1982, if a company named in this certificate and any accompanying documents has re-registered under the Companies Act 1980 with the same name as that with which it was registered immediately before re-registration save for the substitution as, or the inclusion as, the last part of the name of the words "public limited company" or their equivalents in Welsh, references to the name of the company in this certificate and any accompanying documents shall be treated as references to the name with which it is so re-registered.

In accordance with the rules, the words "public limited company" may be replaced by p.l.c., plc, P.L.C. or PLC.

Re-registration under the Companies Act does not constitute a new legal entity but merely subjects the company to certain additional company law rules.

Signed

Dated

## ANNEX 14

Your reference:

Our reference: 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : xxxxxxx (Proprietor Name)**

**Application to amend the specification of a patent under Section 75 of the Patents Act 1977**

**Action No xxxx**

Thank you for your e-mail dated xxXXxx and the copy of the certified Interlocutor dated xxXXxx.

The terms of the interlocutor will be advertised in the Patents and Designs Journal dated xxXXxx and the fact of the order will also be noted in the patents register.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate



## CHAPTER 24

### SECTION 117 CORRECTIONS OF ERRORS

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|   |               |
|---|---------------|
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## Annexes

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Annex 2- S117 CPC

Annex 3- S117E

Annex 4- S117D

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Annex 6- S117EXAM

Annex 7- S117 REQSPEC

Annex 8- S117B

Annex 9- S117 ALLOWED

Annex 10- S117 EOTALLW

Annex 11- Initial Advert

Annex 12- Specification Opposition Advert

Annex 13- Bibliograph Opposition Advert

Annex 14- Final Advert Correction allowed

Annex 15- Final Advert Correction refused

Annex 16- Final Advert Correction not proceeded with/withdrawn

Annex 17- Clear records table

Annex 18- Certificates table

Annex 19- Minute to publishing

## 24 CORRECTION OF ERRORS

### INTRODUCTION

- 24.01 Section 117 concerns the correction of errors in specifications and in other documents filed in connection with patents and applications for patents. Prescribed conditions are set out in the Patents Rules 2007. Section 117 relates solely to the correction of errors in documents and not with procedural omissions. Rule 105 relates to corrections to the specification and Rule 49 relates to corrections to the bibliograph. Section 117 does not cover the failure to file a document within a prescribed period or correcting the register or documents filed at the office in connection with the register. This is an action undertaken by Assignments Section under Section 32 and Rule 47.
- 24.02 Corrections to EP and GB patents are processed electronically on PDAX. On filing a request to correct an EP or GB patent, the A3 enters the published patent number into PDAX in order to view the dossier for that patent.
- 24.03 If there is no dossier for the patent, contact Nine Mile Point to see if there is a paper file in existence. If an EP or GB paper case already exists, this is requested from Nine Mile Point and scanned onto the dossier along with the request for correction by Index and Scanning section. If no dossier exists send a request to Index and Scanning to set up a new dossier.
- 24.04 Any person may request the correction of an error in the register or in any document filed at the office in connection with registration. The request needs to be in writing on a Patents Form 20 for all correction requests, with the exception of address corrections where a letter alone would suffice. The Patents Form 20 is usually accompanied with a covering letter from the

Attorney, along with sufficient information to identify the nature of the error and the correction requested. If the comptroller has doubts that an error has occurred, thhe may require evidence to support the request. When a request is filed to correct a specification of a patent, the request will not be granted unless the correction is obvious.

## **FORMALITIES CHECKS – Bibliograph and Specification corrections**

24.05 On receipt of the request for correction under Section 117, the A3 should carry out formalities checks to ensure the requirements of the Patents Rules 2007 have been complied with. In order to make public the request for correction has been applied for at the Office, an initial advertisement for the Journal should be prepared in all cases. Any issues should be resolved via official letter with the applicant before the allowability recommendation is sent to the B2 or Head of Examination Group. Once any defects have been eliminated, the case can be referred to the appropriate Head of Examination Group for corrections to the specification or the B2 Litigation Manager for bibliograph corrections. The dossier should be minuted with any actions taken and the PDAX checklist should be completed in order to show your progress with the correction and manage the dossier efficiently.

### **Has the patent been granted?**

24.06 A request for correction cannot be actioned by Litigation Section until the granted patent has been published in the Journal or the EP Bulletin. The status of the patent should be checked on OPTICS.

### **GB cases**

24.07 Obtain a DIS FUL print from Optics. This will show two dates in connection with the granting of the patent. The first relates to when the applicant was notified by the Formalities Section that the patent was to be granted. The second gives the date when the notice of the grant is published in the Journal.

- 24.08 If the request is filed before the first date i.e. no notification of a grant letter has been sent by Formalities, the request for correction should be referred to the appropriate Formalities Section. Litigation will only deal with post grant correction.
- 24.09 Where the request is filed between the two dates, the applicant should be informed that the request has been filed too early and that the Office will therefore stay the proceedings until the notice of grant has been published in the Journal. The request for correction will be taken to have been filed on the day the notice is published in the Journal and processed by the Litigation section.

### **EP cases**

- 24.10 Similarly to a GB case, obtain a DIS FUL print from OPTICS. This will show the date the patent was published as granted in the EP Bulletin.
- 24.11 If the request is filed before this date, the applicant should be informed that the request has been filed too early and the Office will therefore stay the proceedings. The request for correction will be taken to have been filed on the date that the notice is published in the bulletin and processed by the Litigation Section.

### **Formalities- Bibliograph and Specification**

- 24.12 The initial formalities checks are the same for both bibliograph corrections, to the front cover of the specification and specification corrections, to the main body of the patent specification or the patent granted title. The request for correction is checked to ensure:

- The patent has been granted
- The correction is filed under correction section at number 4 of the Patents Form 20(i)
- Is the individual applying for the correction the applicant/proprietor. If the request is not from the applicant/proprietor, refer the correction to the B2 to investigate who wishes to make the correction.
- The proprietor's name and address is correct as shown on the register  
A current address for service (AFS) is provided in the UK, an EEA state or the Channel Islands. If the AFS provided does not match the register contact the AFS proposed on the F20 as the attorney may be dealing with the correction only rather than being the new AFS.
- Is the F20 signed and dated with a contact name and number for reference.
- EP- Is GB listed as a designated county.
- EP- Has the 9 month opposition period expired. Check there are no opposition proceedings pending.  
EP- Is the patent centrally limited to the EPO.
- EP- check the request has not already been allowed by the EPO
- Is the specification on the dossier the latest version. Check there are no previous corrected specifications e.g. CDOC
- Is the correction clear.
- Is it clear what was originally intended.
- Does the correction go back to the date of filing.
- Does the correction require evidence to support it, eg. the request contains sufficient information to identify the nature of the error and how it occurred
- Does the patent claim priority from another patent, or is part of a larger patent family.
- For corrections to the specification - the request identifies the proposed correction (usually shown in red as a 'marked up copy' of the specification) and reasons for the correction are clearly explained.

- That any documents given as supporting evidence and not published in English are accompanied by a copy of a translation.
- The request is correctly applied for as a 'correction' and not an 'amendment'.
- Check no revocation action or appeals are outstanding

## **FORMALITIES NOT COMPLIED WITH**

24.13 If after the A3 has completed the formalities checks and they have not been complied with, a standard file note can be adapted and added to the dossier.

*“Request for correction under s117 filed on xxxxx Formalities not complied with (brief summary of reason, e.g. EPO opposition period not expired/evidence requested to support correction to the proprietor’s name etc). O/L issued xxxx. Optics updated. Initial advert prepared for PDJ xxxx, dated xxxxx*

*B/F xxxxxxxx (to await reply)*

## **Is the request an Amendment or a Correction**

24.14 The request should be checked to see that the applicant has applied the term “correction” in the correct manner (see Chapter 17 for a description of what constitutes an amendment). If it appears that the application is an amendment rather than a correction, a minute should be sent to the appropriate team in order for them to process the request as an amendment.

## **New attorneys - different address to the register.**

24.15 If the current address for service is different from the attorney supplied on the F20, a Patents Form 51 may be required. However, if the new attorneys



are only authorised to act with regard to the correction only, no Form 51 is necessary. Only correspondence relating to the correction will be sent to the attorney named on the correction request and the address for service on the register will remain the same. However, if the new Attorney are proposed as the new AFS they will need to submit a Form 51 in order for register admin to correct the register and change the name of the AFS below the line.

## **Evidence**

- 24.16 Evidence may be required to establish that the correction offered is what was originally intended. For bibliograph corrections, where a proprietor wishes to correct its name for example, the comptroller may request evidence. Evidence can take the form of a document from the appropriate Companies House registration authority, such as a certificate from Companies House for an incorporated company in the UK, a State Certificate for the USA or an extract from the Handels register for Germany.
- 24.17 If the comptroller is not satisfied with a correction, he may require evidence demonstrating that the applied correction was what was originally intended and goes back to the time of filing. A copy of the applicant's instructions to his Attorney, for example, or sworn evidence, may suffice.
- 24.18 Where insufficient evidence has been filed, or copies of documents referred to on the request have not been supplied, the applicant should be asked to file further evidence or the missing documentation, in accordance with the Patents Rules 2007.
- 24.19 Generally, evidence will not be required to correct a spelling error, transposition of a name or minor clerical or typographical errors. The A3 may proceed to apply the appropriate corrections and send the correction request to the B2 for OPTICS actions and authorisation to apply the electronic signature to the appropriate certificate.
- 24.20 If evidence is required, an official letter is issued.

PDAX:- Letter created and imported from Prose (see Annex 4)  
Minute the dossier appropriately

### **EPC Central Limitation Process**

24.21 A patent may be centrally limited at the EPO. On receipt of a new S117 the European Patent register must be checked to determine whether there is a request to centrally limit the patent (<https://register.epo.org/regviewer>). The applicant will be asked whether they wish to stay the UK proceedings until the conclusion of the central limitation process or whether they wish to proceed. An official letter is created in Prose (Annex 2) and issued to the Attorney. A copy is also uploaded on to the dossier and sent to Proprietor. If a European patent (UK) has already been corrected before the EPO, the comptroller will not consider the request for an identical correction. The A3 will issue Letter (see Annex 1) to the Proprietor. The request for correction under section 117 will be treated as 'not proceeded with'.

PDAX:- Letter created and imported from PROSE

### **EP 9 month opposition period**

24.22 A European patent (UK) has a nine month opposition period during which opposition proceedings may be filed and the patent may be amended or corrected before the EPO as part of such proceedings. The opposition period commences once the patent is mentioned in the European Patent Bulletin as granted. This date can be found on the OPTICS. The opposition period is 9 months from the date of grant. An official letter is issued to the attorney who will have 2 months to respond.

PDAX:- Letter created and imported from PROSE  
Minute created and corrections Diary updated

Opposition Period has not expired and/or opposition proceedings are pending

24.23 Where the opposition period has not yet expired, and/or, opposition proceedings are pending a Letter (see Annex 3) will be issued. The

applicants will be given two options as to how they wish to proceed. The applicant will be given option (a.) and option (b.) as follows:

*a. staying the request until the opposition period has expired or the opposition proceedings have been settled, or*

*b. proceeding with the request to correct under Section 117 on the understanding that the correction may be negated as a result of subsequent amendment before the EPO.*

24.24 An applicant may write to inform the office that they are aware of the situation but wish to proceed regardless. As per our Letter applicants are informed that the corrections may be negated as a result of subsequent correction before the EPO. They will advise us of their choice in proceeding with the request or staying the request until the opposition period has expired.

24.25 Section 117(B) of The Patents Act 1977 provides for an additional automatic extension of two months, for periods specified by the Office. The corrections diary should also be updated.

Response to official letter - opposition period

24.26 The response to the Official letter is scanned onto PDAX by Index and Scanning and then the case is referred to the Head of Examination Group/B2 with one of the following minutes according to the nature of the reply.

If the applicant wishes to stay:

*“Attorneys have replied to Official Letter dated XX.XX.XX and have asked to stay the proceedings till the opposition period has expired or the proceedings have been settled. I shall diary the case until the opposition period has expired or until the opposition proceedings have been settled”.*

*“Correction stayed” and message. Update correction diary.”*

Send “PSM” message to Head of Examination Group/B2.

- 24.27 The EP Register should be checked every 6 months for updates on the opposition proceedings. Once the opposition period has expired, the case should be referred to the Head of Examination Group (for specification corrections)/B2 (for bibliograph corrections) with a minute as follows:

*“Case referred for report under Section 117 of the 1977 Act (see para 117.14 MOPP)”.*

If the applicant wishes to proceed:

*“Attorneys have replied to Official Letter dated XX.XX.XX and have asked to proceed with the correction. Case referred for report under Section 117 of the 1977 Act (see para 117.14 MOPP)”.*

### **Applicant has applied to the EPO for Correction**

- 24.28 Where the request is a correction of bibliograph details and the applicant has already applied to the EPO for the correction, the request should be stayed pending the outcome. If the request is successful, the correction will apply to all designated states and be actioned by our Register Admin Section via tape transfer, this will appear as a below the line entry. The request should be treated as not proceeded with as it has already been allowed at EPO, on the directions of the B2.

## **Outstanding revocation action**

24.29 Whilst revocation action of a patent is still pending, it is for the comptroller to decide whether the application to correct under section 117 is to be stayed or resolved (see MOPP 117.16). The case should be referred to the Head of Examination Group/B2 indicating that there is outstanding revocation action and asking for directions as to how to proceed.

## **Inventorship**

24.30 If a correction request is surrounding inventorship, the proceeding could be processed under S117 as a correction request. However, it may relate to Rule 10(2). Rule 10(2) cases are referred to the B3 as an inter partes case which is relating to a later discovery of an individual's inventorship contribution.

## **Assignment**

24.31 If there is an assignment on a patent it will be dealt with by Register Admin. A Section 32 is filed in order for the patent to be transferred to another proprietor name for example, as a result of the patent being sold. If there is a correction request and an assignment filed on a patent at the same time, the correction will need to be processed first. For example if the correction is to the proprietor name, the name will need to be corrected to show on the register as the correct name, before it can be assigned to a different proprietor name. An assignment does not go back to the date of filing, therefore cannot be changed above the line. An assignment will show below the line on the register as a register entry.

## **Initial Actions**

24.32 There are two initial actions that must be completed on receipt of a correction under S117 request. In all cases where formalities have or have not been complied with, an initial OPTICS entry and an initial advert must be

completed in order to make public that the Office has received a correction request under S117.

### **Initial Advert**

24.33 Prepare an initial advert (see Annex 11)

### **Optics**

24.34 Complete an initial OPTICS entry as follows, using REG ENT facility:

*Request for correction under S117 filed on xx.xx.xxxx.*

### **FORMALITIES COMPLIED WITH**

24.35 After the formalities checks have been carried out and all formalities have been complied with, the A3 can proceed to initial actions. A standard file note can be adapted and added to the dossier:

*Request for correction under s117 filed on xx.xx.xxxx.*

*Formalities complied with. Optics updated. Initial advert prepared for PDJ xxx, dated xxxxxxxx.*

*Referred to B2 for consideration.*

### **Referring the Request**

24.36 Corrections to the bibliograph details should be referred to the B2. A new ADP number should also be obtained from OPTICS and added to the minute to the B2. The minute sheet should be prepared as follows:-

“Allowability Recommendation

ADP: XXXXXXXXX

*Dear.....*

*Please see new correction under S117 filed on xx.xx.xxxx. The request is to*

*correct the Proprietor/Inventors details”*

**From:**

**To:**

*The evidence filed to support the request is in the form of a statutory declaration/ witness statement etc.*

*I consider the evidence supplied to support correction allowable under S117. Case referred for report under MoPP 117.14 and for consideration on whether or not to advertise for opposition.*

*Please update Optics above the line should everything be in order.”*

- 24.37 Corrections to the specification details should be referred to the Head of Examination Group. The minute sheet should be prepared as follows:-

*Case referred for report under S117, for your consideration. Please advise if you require a S117 opposition advert, (MoPP 117.07 refers).*

The Head of Examination Group may consider the corrections and report as to whether further corrections are required. An official letter will be issued in order to provide further corrections. The Head of Examination Group will then consider the additional corrections along with the proposed corrections. (See annex 6)

### **PRIMA FACIE ALLOWABLE**

- 24.38 The report will state whether the correction is considered *prima facie* allowable and will advise whether it needs to be advertised in full. If advertisement is not necessary the B2 should update OPTICS, allowing the correction and then refer the case back to the Ex-Parte Team to produce a certificate, apply the B2's electronic signature (see Annex 18) and clear records (see Annex 17). If the correction is referred to the DD the A3 will apply the correction to the relevant documents.

- 24.39 Where the corrections needs to be advertised, an advert is prepared for the Journal with the heading *Request now open to Opposition* An example of an advert of a bibliograph correction can be seen in (Annex 13). The advert

is placed in the Journal folder on SharePoint and a copy placed in the Journal file. The opposition period will last four weeks from the date of the published advert. Official letter (see Annex 5) and issued to the Attorney. Date advert in PDJ and minute the dossier.

PDAX:-Letter created and imported from PROSE

Advert is created and imported using manual Import (doc code is ADVERT)

- 24.40 If opposition is filed refer to B2. If no opposition is filed proceed to request the B2 to update Optics with the allowed bibliograph details. A minute should be prepared as follows,

*“Opposition advert prepared for PDJ xxxx dated xxxxxx. No opposition has been filed. Please update optics above the line should everything be in order. Please confirm I can now attach your electronic signature to the appropriate certificate and proceed to clear”.*

- 24.41 If no opposition is filed proceed to minute the Head of Examination Group with regard the specification correction. A minute should be prepared as follows,

*“Opposition advert prepared for PDJ xxxx date xxxxxx. No opposition has been filed therefore I have applied the corrections to the specification manually (page reference)/ replacement page(s)/ replacement specification/ using enhance. Please confirm I can now attach your electronic signature to the appropriate certificate”.*

- 24.42 Once the Correction has been authorised the appropriate certificate has to be applied and uploaded on to the dossier.

## **APPLY CORRECTIONS & CERTIFICATES**



- 24.43 On a GB patent, the correction will apply to the front page of the A and B specification. On an EP patent, the correction will apply to the front page of the BDOC only.

For corrections to GB bibliograph details

- 24.44 For GB cases, the Publishing Section of the Clear records sheet should be completed with actions taken. A request is made for an erratum. Publishing Section should be informed of the precise nature of the correction e.g. the original and the corrected name of the proprietor should be given. A detailed minute should be prepared for Publishing (see Annex 19).
- 24.45 For corrections to the bibliograph details on a GB patent, the abstract and the A Pub drawings annotated “P” and “Working Copy” are copied from the Pre-Grant part of the dossier into the Litigation section of the dossier. The publication status is then changed to “C”. This enables Publishing section to extract all the documents required to produce an erratum. It should be noted that the abstract and drawings are required for the electronic publishing process only and will not be corrected as part of the corrections to the bibliograph (see Annexes 17 and 18).
- 24.46 The certificate is completed and the electronic signature applied. This should then be pasted into a Word document and imported into the dossier using manual import (doc code CERT and annotate as ‘correction allowed certificate’).

For corrections to EP bibliograph details

- 24.47 For corrections to the bibliograph details on an EP patent, if the corrections cannot be applied using enhance or assemble, a copy of the front page of the BDOC should be printed from the dossier and the corrections applied manually or using enhance function on PDAX. The corrected front page of the BDOC should then be scanned onto the dossier by Index and Scanning Section.

## **PROPRIETOR NOTIFIED CORRECTION ALLOWED**

24.48 A letter will be issued by the Publication Section to notify the proprietor that the correction is allowed. If there is no publishing action required to the allowed correction, issue letter (see Annex 9).

## **CLEAR RECORDS – CORRECTION TO BIBLIOGRAPHIC DETAILS ALLOWED**

### Case referred to Publishing Section

24.49 For GB cases, the corrected Abstract and Drawings from the Pre-grant part of the dossier on PDAX should be annotated “For Publishing Purposes”. A detailed minute should be prepared for publishing (see Annex 19).

For EP cases, the corrected BDOC should be annotated “For Publishing Purposes”. A detailed minute should be prepared for publishing (see Annex 19).

## **FORMALITIES COMPLIED WITH - CORRECTIONS TO SPECIFICATION**

24.50 The following procedure relates to a correction to the specification where all formalities have been complied with.

### Initial Advert

24.51 Once all formalities have been complied with, an initial advert (see Annex 11) should be prepared for the Journal. The advert should be copied to the Journal folder on SharePoint and a copy placed in the Journal file and a copy should be uploaded on to the dossier.

PDAX:- Advert is created in Word and imported using manual import (Doc code is ADVERT. Annotate Initial advert PDJ xxxx dated xxxxxx).

## Optics

24.52 Complete an initial OPTICS entry as follows:

*“Request for correction under S117 filed on xxxxx”*

## Referring the Request

24.53 The request should be referred to the appropriate Head of Examination Group. Firstly a file note should be added to the dossier to show that the formalities have been complied with. File note should be prepared as follows:

*Request for correction under S117 filed on xxxxx. Formalities complied with. Optics updated. Initial advert prepared for PDJ xxxx dated xxxxxx*

Referred to Head of Examination Group for consideration

24.54 The request should then be referred to the appropriate Head of Examination Group in the form of a minute. When specifying which Head of Examination Group to minute, check OPTICS for the group classification, if there are multiple classifications always use the first one as this is the primary classification.

Minute to Head of Examination Group and (name) the person for the attention of

Message Title: Request for correction

Sub title: S117 Specification correction

Message to Head of Examination Group- To group EXxx and the Head of Examination Group's name

Minute: PSM: S117 Specification correction

24.55 The request will be considered by the Head of Examination Group according to the tests set out in Section 117.07 to 117.09 of the MOPP and the

Rules 2007 i.e. that “the correction is obvious in the sense that it is immediately evident that nothing else could have been intended than what is offered as the correction”. The request is considered against a twofold test:

- is it clear that there is an error, and
- if so, is it clear what is now offered is what was originally intended

24.56 If the correction is allowed, it may be advertised for opposition as the rights of a third party could be adversely affected (see MOPP 117.23); otherwise advertisement for opposition may not be considered necessary.

### OPPOSITION FILED FOLLOWING ADVERTISEMENT

24.57 Notice of opposition should be received on Patents Form 15 and filed within four weeks of the date of the full advertisement in the Journal, of the *prima facie* allowable corrections. This period may not be extended.

24.58 Upon receiving any opposition, the case should be referred to the B2, with an appropriate minute. The opposition initiates *inter partes* proceedings.

*Please see opposition filed on xxxxxx for your consideration*

PDAX:- Create a minute in PDAX and send a “PSM – Opposition filed” message to DD

### **CORRECTION TO SPECIFICATION *PRIMA FACIE* ALLOWABLE**

24.59 The Head of Examination Group’s report will state whether the correction is considered *prima facie* allowable and will advise whether it needs to be advertised in full. If advertisement is not necessary, proceed to correct the specification.

24.60 Where the correction needs to be advertised, an advert is prepared for the Journal with the heading *Request now open to Opposition* An example of

an advert showing a correction of a specification can be seen in Annex 12. The advert should be placed in the Journal folder on SharePoint and a copy placed in the Journal file. A copy also needs to be uploaded on to the dossier.

PDAX:- Advert is created in Word and imported using manual import (doc code is ADVERT Annotated as "Opposition Advert PDJ xxxx dated xxxxxxx."(see annex 12)

24.61 The opposition period will last four weeks from the date of the published advert.

24.62 A standard letter (see Annex 5) is sent to the applicant's attorneys notifying the applicant of the date of the Journal advert and advising of the four week opposition period. A file note on PDAX should be prepared as follows:

*"Correction allowable and advertised for four weeks opposition in PDJxxxx dated xx.xx.xxxx. O/L issued to attorney.  
B/F xx.xx.xxxx (4 weeks from the date of PDJ journal entry and add on a week for filing purposes- Corrections diary)"*

PDAX:- Letter created, locked and imported from PROSE. (Doc Code- Letter- Lit) and annotate as Opposition advert PDJ xxxx dated xxxxxx

24.63 If opposition is filed refer to Head of Examination Group. If no opposition is filed proceed to correct the specification.

Refer the correction back to the Head of Examination Group, minute to be prepared as follows,

*"Opposition advert prepared for PDJ xxxx dated xxxxxx. No opposition has been filed therefore I have applied the corrections to the specification manually/page reference/replacement pages/replacement specification/*

*using enhance. Please confirm that I can now attach your electronic signature to the appropriate certificate.”*

## **APPLY CORRECTIONS AND CERTIFICATE**

24.64 The corrected BDOC should then be scanned onto the dossier via the MFD printer.

### 24.65 For corrections to EP specifications

Apply the corrections to the BDOC specification either using replacement page(s) or replacement specification. If the corrections are minor they may be applied manually or using ENHANCE on PDAX. Once the correction is applied change the BPUB status to “C” and annotate “For Publishing Purposes”. Change the doc code to CDOC. Refer the correction back to the DD to authorise adding the electronic signature

### 24.66 For corrections to GB specifications

The corrections will apply to the BDOC only. Copy the DESC and CLMS identified with a “P” and annotated “Working Copy (WC)” and DRWGS identified with a “P” and annotated “Formal” onto the dossier and move to the Litigation part of the dossier. Apply the corrections to the description, claims or drawings using replacement page(s) or replacement specification. If the corrections are minor they may be applied manually or using ENHANCE on PDAX. Once the correction is applied change the BPUB status to “C” and annotate “For Publishing Purposes”. All documents are annotated “C” and “For Publishing Purposes” even if they haven’t been corrected. Publishing will require all the documents in order to produce a C spec. Refer the correction back to the DD to authorise adding the electronic signature.

24.67 If the corrections are extensive and no replacement page or specification

has been filed, the A3 should request that one is filed see (Annex 7). Any replacement specification should be checked by the A3 to ensure that the corrections made are the same as those allowed by the Head of Examination Group. Clearly mark the replacement pages and annotate as replacement pages and page number.

*“Corrections applied to specification manually on pages xxxxxx/ corrections in the form of replacement pages xxxxxx/ corrections in the form of replacement specification/ using enhance. (Delete as appropriate). Please confirm that I can now apply your electronic signature to the appropriate certificate.”*

Minute- Head of Examination Group- Specify Head of Examination Group.

Message- Head of Examination Group (EXxx) and name

Title- S117 Specification correction applied

## **CASE RETURNED FROM HEAD OF EXAMINATION GROUP WITH AUTHORISATION**

24.68 Once a message is received from the Head of Examination Group, the appropriate certificate (Annex 18) should be dated with the date of clear records (Annex 17) or in the case of a hearing, the date of the decision and a Head of Examination Group electronic signature applied. This should then be pasted into a Word document. and imported into the dossier using manual import (doc code CERT- annotate as Correction allowed certificate).

## **CLEAR RECORDS – CORRECTION TO THE SPECIFICATION ALLOWED**

24.69 Clear records action may be undertaken as follows. A final advert should be prepared for the Journal and the Ex-parte post grant SharePoint list and OPTICS updated appropriately. A minute (Annex 19) is then sent to publishing to inform them of the corrected document.

Final advert

24.70 A final advert should be prepared for the PDJ. This advert should be copied to the Journal folder on SharePoint and a paper copy placed in the Journal file. The advert will appear in the Journal 3 weeks from the first Wednesday after the advert is prepared and submitted to publishing.

PDAX:- Advert is created in Word and imported using manual import (doc code is ADVERT annotated as Final Advert PDJ xxxx dated xxxxxxx) (see Annex 14).

#### Ex-parte post grant SharePoint List

24.71 The relevant entry in the Ex-parte post grant SharePoint list under section 117 should be updated to show the outcome of the request and the date of the clear records action. The entry should be annotated with the appropriate outcome and dated.

#### Optics

24.72 A free text entry should be made on OPTICS using the REG ENT option as follows:-

*Request for correction under Section 117 filed on xxxx allowed on xxxxxx*

#### Case referred to Publishing Section

24.73 For GB cases, a minute should be prepared for publishing (see Annex 19). requesting a C specification. If the C specification was corrected, then a C2 is requested.

24.74 For EP cases, the corrected BDOC should be annotated "For Publishing Purposes". A minute should be prepared for publishing (see Annex 19). If the C specification was corrected, then a C2 is requested.

24.75 To refer a case to Publishing, create a minute in PDAX titled "S117 Correction allowed" and then send a message to Publishing titled "S117 Correction



allowed”.

## **CORRECTION NOT ALLOWABLE**

### Corrections not *prima facie* allowable

24.76 The Head of Examination Group/B2's report will give reasons why any correction or group of corrections are not regarded as allowable. These will be set out in a minute to the A3 who will then copy and paste them in the letter (Annex 8) and sent to the applicant.

24.77 The letter is prepared with a formal heading and should include the Head of Examination Group/B2's report together with his/her name and telephone number as follows:

*With reference to the above, the examiner (xxx ext xxx) reports that  
..... (.insert report)*

24.78 The file should be diaried for 2 months unless otherwise specified by the Head of Examination Group/B2. Diary should also be updated.

PDAX:- Letter created, locked and imported from PROSE.

File note is created in PDAX

24.79 Any further corrections received in response to the official letter should be scanned onto PDAX by Index and Scanning section and annotated with the date the corrections were filed.

24.80 The case should then be referred back to the Head of Examination Group/B2 with the following minute:

*“Attorneys have replied to the official letter dated xxxxxxxx and have stated in their letter dated ..... that ..... (insert summary of letter to help the examiner). For your consideration”*

PDAX:- Create minute in PDAX and send “PSM – s117” message.

24.81 A new report will be produced and sent to the applicant until a set of corrections are considered *prima facie* allowable.

24.82 If an agreement cannot be reached, the Head of Examination Group/B2 will offer a hearing subject to advertisement of the proposed corrections. They will ensure it is clear that the allowability of the corrections have not yet been determined. An appropriate letter will be drafted by the Head of Examination Group/B2 and issued by the A3. If a hearing is subsequently requested, the case should be referred to the Hearings Clerk who will allocate a Hearing Officer.

PDAX:- Letter created, locked and imported from PROSE.

To refer to the Hearing Team, create, a minute in PDAX, send a “PSM – set up hearing” message

#### Correction not proceeded with

24.83 A request may be considered but not proceeded with for the following reasons:

- the applicant fails to file the request correctly
- the request is an amendment rather than a correction
- the applicant fails to respond to official letters
- the correction is allowed by the EPO, and therefore already applies to the European patent (UK)

24.84 If the Head of Examination Group/B2 considers a request should be regarded as not proceeded with, they will import a minute onto PDAX advising that the applicant be informed and the Journal (see annex 15) and Register updated.

24.85 The A3 should issue an official letter to the applicant informing them of the Head of Examination Group/B2's decision. Records are now cleared.

PDAX:- Letter created, locked and imported from PROSE.

#### Withdrawal of a request

24.86 Any request to withdraw should be referred to the Head of Examination Group/B2 for consideration. The minute note should read as follows:

*“Attorneys letter received on xxxxx. The attorneys wish to withdraw the request. For your consideration”*

PDAX:- Create minute in PDAX and send “PSM – S117 Withdrawal” message to Head of Examination Group.

24.87 If the withdrawal is allowed, the applicant should be informed by letter. Records are now cleared.

PDAX:- Letter created, locked and imported from PROSE.  
File note is created in PDAX

#### **CLEAR RECORDS – NOT PROCEEDED WITH/NOT ALLOWED/WITHDRAWN**

24.88 Once the applicant has been informed of the outcome of the request clear records action may be undertaken. An advert should be prepared for the Journal, the Ex parte post grant SharePoint List and OPTICS updated. The dossier should be updated with all actions taken.

#### Final advert

24.89 An advert should be drafted manually corresponding with the decision or directions of the Head of Examination Group/B2 (see Annex 16). The advert should be copied to the Journal folder on SharePoint and place a hard copy in the red journal file.

PDAX:- Advert is created in Word and imported using manual import (doc

code is ADVERT).

### Ex-parte post grant SharePoint List

24.90 The relevant entry in the Ex-parte post grant SharePoint list under section 117 should be updated to show the outcome of the request and the date of the clear records action.

### OPTICS

24.91 A free text entry should be made on OPTICS indicating the outcome of the request. Using the REG ENT facility, type in wording corresponding to the outcome of the decision e.g.:

*Request for correction under Section 117 filed on xxxxxx not proceeded with/not allowed/withdrawn on xxxxxx.*

### **EXTENSION OF TIME**

24.92 Where official letters have been sent to the applicant for the correction, extension of time requests may be received. These should be referred to the Head of Examination Group/B2 with the following minute:

*The attorney by fax/letter on/dated xxxxxx has requested an extension of time. Please advise whether the request for extension is allowable.*

PDAX:- Create minute in PDAX and send a "PSM – EOT request" message.

24.93 The applicant should be advised of the Head of Examination Group/B2's decision and a note of the action taken added to the dossier.

PDAX:- Letter created and imported from PROSE (annex 10)

File note is created in PDAX

24.94 An extension to the four week opposition period is **not** allowed.

**Annex 1**  
**S117 EP ALLW**

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**  
**Request for correction under Section 117 of the Patents Act 1977**

I am writing to inform you that the correction requested on xx.XX.xx will not proceed, as it has already been allowed by the European Patent Office on xx.XX.xx.

The European Patent Office will contact us in due course and our Patents register will be updated accordingly.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 2**  
**S117 CPC**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

**Latest date for reply**

I refer to your request for correction filed on xxxx

On checking the European Patent Office register, it appears that you have filed an application to centrally limit your patent at the EPO. In these circumstances there are two options available to you

- a. staying the request until the conclusion of the central limitation process, or
- b. proceeding with the request to correct under Section 117

You should advise me of your decision regarding the above by xxxx.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 3**

**S117E**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

**Latest date for reply:**

I refer to your request for correction filed on xxxxxx.

You are advised that the nine month period allowed to oppose the European Patent (UK) has not yet expired. In these circumstances there are two options available to you.

- a. staying the request until the opposition period has expired or the opposition proceedings have been settled, or
- b. proceeding with the request to correct under Section 117 on the understanding that the correction may be negated as a result of subsequent amendment before the EPO.

Please see paragraph 117.11 of The Manual of Patent Practice.

You should advise me of your decision by xxxxxx.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate



**Annex 4**

**S117D**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

**Date for reply:**

I refer to your request under Section 117 filed on xxxxxx to correct the name of the proprietor.

Please note that it will be necessary for you to provide evidence to support your request for correction in order to establish that the correction offered is what was originally intended. Evidence may take the form of an extract from the appropriate companies registration authority, a copy of the original filing instructions sent to the agent, a statutory declaration, or witness statement, as appropriate, to enable us to proceed.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 5**

**S117A**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

I am writing to inform you that your request for correction will be advertised for opposition in the Patents and Designs Journal on xxxxxx.

A four week period from the date of advertisement will be allowed for any opposition to the proposed correction.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 6**  
**S117EXAM**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

**Latest date for reply:**

I refer to your request for correction filed on xxxxxx11 November 2014. The examiner (enter examiner .....Tel 01633 81xxxx) has reported the following:

If you want to propose further corrections, it would be helpful if these could be shown in red ink on a copy of the printed specification. However, if the corrections are simple and not extensive you may submit them in a letter and the examiner will add them to the original proposals.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 7**  
**S117 REQSPEC**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

**Latest date for reply:**

I refer to your request for correction filed on xxxxxx.

In order to correct the specification of the above patent under Section 117, please provide a clean version of the retyped specification/pages [       ] incorporating the allowed corrections.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 8**

**S117B**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

**Date for reply:**

The examiner, [enter examiner] (tel: 01633 81[ext]) reports as follows:

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 9**  
**S117 ALLOWED**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

I am writing to inform you that the request for correction under s117 filed on xxxxxx has been allowed on xxxxxx.

Please note that Publishing Section will not be issuing an erratum as the address details for the inventor/proprietor (*delete as appropriate*) do not appear on the front page of the specification. However, all other records have been updated to show the allowed correction.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 10**  
**117 EOTALLW**

**Your reference:**

**Our reference:** 1R31/Name/File Reference

Date

Dear Sirs

**Patent Number : GB/EP (Proprietors Name)**

**Request for correction under Section 117 of the Patents Act 1977**

**Latest date for reply:**

I refer to your correspondence dated xxxxx, requesting an extension of time in which to respond to the official letter of xxxxxx.

The request for an extension is granted. A response is now due by xxxxxx.

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate

**Annex 11**  
**Initial Advert**

**Section 117**

**Correction of Errors in Patents and Applications**

**Request made for Correction of Error**

In the event that the Comptroller requires notice of the proposed correction to be advertised, details of the proposed correction will be advertised later.

**GB/EP**

PROPRIETOR NAME

Patent title

Request for correction under Section 117  
filed on [enter date]



**Annex 12**  
**Specification Opposition Advert**

**Section 117**

**Correction of Errors in Patents and Applications**

**Request now open to Opposition**

Any person may give notice of opposition to the undermentioned request by filing Patents Form 15 within four weeks from the date of publication of this Journal. If no notice of opposition is received, the correction will be allowed by the Comptroller in the present advertised form.

NB. The paging referred to is that of the printed specification

**GB/EP**

PROPRIETOR NAME

Patent title

The proposed corrections are as follows:

|                |          |         |               |       |
|----------------|----------|---------|---------------|-------|
| <b>Page xx</b> | claim xx | line xx | <i>After</i>  | xxxxx |
|                |          |         | <i>Delete</i> | xxxxx |
|                |          |         | <i>Insert</i> | xxxxx |

**Annex 13**  
**Bibliograph Opposition Advert**

**Section 117**

**Correction of Errors in Patents and Applications**

**Request now open to Opposition**

Any person may give notice of opposition to the undermentioned Request by filing Patents Form 15 within four weeks from the date of publication of this Journal. If no notice of opposition is received, the correction will be allowed by the Comptroller in the present advertised form.

NB. The paging referred to is that of the printed specification

**GB/EP**

PROPRIETOR NAME

Patent title

The proposed corrections are as follows:

|                   |         |               |      |
|-------------------|---------|---------------|------|
| <b>Front Page</b> | Code xx | <i>Delete</i> | xxxx |
|                   |         | <i>Insert</i> | xxxx |

**Annex 14**  
**Final Advert Correction allowed**

**Section 117**

**Correction of Errors in Patents and Applications**

**Correction allowed**

The date included in the entry is the effective date of the correction

**GB/EP**

PROPRIETOR NAME

Patent title

Request for correction under Section 117  
filed on [enter date] allowed on [enter date]

**Annex 15**  
**Final Advert Correction refused**

**Section 117**

**Correction of Errors in Patents and Applications**

**Correction Refused.**

The date included in the entry is the effective date of the correction

**GB/EP**

PROPRIETOR NAME

Patent title

Request for correction under Section 117  
filed on [enter date] refused on [enter date]

## Annex 16

### Final Advert Correction not proceeded with/withdrawn

#### Section 117

#### Correction of Errors in Patents and Applications

#### Correction not proceeded with/ withdrawn

The date included in the entry is the effective date of the correction

**GB/EP**

PROPRIETOR NAME

Patent title

Request for correction under Section 117  
filed on [enter date] not proceeded  
with/withdrawn on [enter date]

## Annex 17

### Clear records table

|  |   |
|--|---|
| <p><b><u>Bibliograph Correction:-</u></b></p> <p><b>EP:-</b></p> <ul style="list-style-type: none"> <li>• Applies to front page of BDOC only</li> <li>• Corrections applied manually or using ENHANCE function on PDAX</li> <li>• Once applied, change BPub status to C</li> <li>• Annotate “For Publishing Purposes”</li> <li>• Provide details of correction to Publishing.</li> <li>• Request erratum for BDOC in minute to Publishing.</li> <li>• Note Publishing will produce a “B9” but always request an erratum</li> </ul>   | <p><b>GB:-</b></p> <ul style="list-style-type: none"> <li>• Applies to ADOC and BDOC</li> <li>• No corrections are applied</li> <li>• In the PRE-GRANT tab locate the Abstract or WIPOFP and APub drawings. The ABST/WIPOFP should be identified with a “P” and annotated “working copy (WC)” and the DRWGS should be identified with a “P” and annotated “Formal”. These documents are then copied to the dossier and moved to the Litigation Tab.</li> <li>• Once copied to Litigation, change the APublication and BPublication status to “C”</li> <li>• Annotate “For Publishing Purposes”</li> <li>• When clearing records, provide details of correction to Publishing.</li> <li>• Request erratum for the ADOC and the BDOC in minute to Publishing.</li> </ul>  |
| <p><b><u>Specification Correction:-</u></b></p> <p><b>EP:-</b></p> <ul style="list-style-type: none"> <li>• Applies to BDOC specification only. If a C spec exists, the correction will apply to the C spec</li> <li>• Corrections applied using replacement pages or replacement specification. In some cases where the correction is minor the corrections may be applied manually or using ENHANCE on PDAX</li> <li>• Replacement pages/specification can be requested from Proprietor</li> <li>• Once applied, change BPub status to C</li> <li>• Annotate “For Publishing Purposes”</li> <li>• Refer to Head of Examination Group to authorise signature for certificate.</li> <li>• When clearing records, provide details of correction to Publishing</li> <li>• Request C spec (or C2 if C spec already exists)</li> </ul> | <p><b>GB:-</b></p> <ul style="list-style-type: none"> <li>• Applies to BDOC only</li> <li>• In the PRE-GRANT tab locate the DESC, DRWGS, and CLAIMS. The DESC and CLAIMS are identified with a “P” and annotated “Working Copy (WC)” and the DRWGS are identified with a “P” and annotated “Formal”. These documents are then copied to the dossier and then moved to the Litigation.</li> <li>• Corrections are applied using replacement pages or replacement specification. In some cases where the correction is minor the corrections may be applied manually or using ENHANCE on PDAX</li> <li>• Replacement pages/specification can be requested from Proprietor</li> <li>• Once corrections are applied, change the BPublication status from “P” to “C”</li> <li>• Annotate “For Publishing Purposes”</li> <li>• Refer to Head of Examination Group to authorise signature for certificate.</li> <li>• When clearing records, in minute to Publishing provide details of correction</li> <li>• Request C spec (or C2 if C spec already exists)</li> </ul> |

**NOTE:- Specification corrections:-**Where correction is advertised for opposition and if no opposition is filed, apply the corrections and refer to back to Head of Examination Group to authorise signature for certificate.

**NOTE:- Bibliograph corrections:-** Where the correction is advertised for opposition and if no opposition is filed, refer case back to B2 to update

**Annex 18**  
**Certificates table**

**Section 117 CORRECTION**

|   |   |
|---|---|
| <p><b>CERTIFICATE 1</b><br/>Changes throughout specification that can be applied using Enhance function (For bibliography corrections apply to A and B doc, because S117 is from <u>filing</u> date of patent, but for specification corrections apply to B Document only).</p> | <p><b>Specification and Bibliograph</b><br/>The correction shown on pages (.for specification insert page numbers and for Bibliograph insert the words “Front page”.....) of this specification, were made under Section 117 of the Patents Act 1977 on .(insert clear records date).....<br/>Electronic Signature<br/><b>For specification:</b>/ Head of Examination Group Acting for the comptroller/<b>For bibliograph:</b>/Litigation Manager</p> |
| <p><b>CERTIFICATE 2</b><br/>Changes limited to several pages of the specification and proprietor has supplied replaced pages(Apply to B Document only).</p>   | <p>The correction in this form of replaced pages ( insert page numbers ) of this specification are made under Section 117 of the Patents Act 1977 on ( insert clear records date )<br/>Electronic signature<br/>Head of Examination Group acting for the comptroller</p>  |
| <p><b>CERTIFICATE 2a</b><br/>Changes to the drawings (Figures) only. Apply to the B Document only).</p>   | <p>The correction of Figures ( insert drawing number) of this specification were made under Section 117 of the Patents Act 1977, on ( insert clear records date )<br/>Electronic signature<br/>Head of Examination Group acting for the comptroller</p>   |
| <p><b>CERTIFICATE 4</b><br/>Changes made are sufficiently extensive to warrant a complete replacement specification. This certificate relates to the “new replacement” specification to show that it now represents the corrections allowed.</p>                                | <p>This specification, filed under Rule 35 is a true copy of the specification as amended under Section 117 of the Patents Act 1977 on ( insert clear records date)<br/>Electronic signature<br/>Head of Examination Group acting for the comptroller</p>   |

**Annex 19**  
**Minute to publishing**

**GB/EP**

Request for correction under s117 to the bibliography details filed on xxxxxx, allowed on xxxxxx.

**Clear Records**

|                   |  |
|-------------------|--|
| PDJ               |  |
| SHAREPOINT LEDGER |  |
| REGISTER          |  |

**Publishing**

**FOR A CORRECTION TO THE BIBLIOGRAPH**

Correction requested on xxxxxx, allowed on xxxxxx.

Please prepare an erratum for the ADOC/BDOC. The allowed correction is to the Proprietor's Name/Address, Inventors Name/Address/State of Incorporation.

Please correct the xxxxxxxx at code (xx) as follows:-

From:-

To:-

The current address for service is as follows:-

Attorney reference

**FOR A CORRECTION TO THE SPECIFICATION:**

Correction requested on xxxxxx, allowed on xxxxxx.

Please prepare a C specification. The corrections are in the form of manuscript changes/replaced pages/replacement specification

Regards  
Name  
Section



## CHAPTER 25

### MAKING UP NEW CASES

|                                   |               |
|-----------------------------------|---------------|
| Patent Cases                      | 25.01 - 25.09 |
| Introduction                      | 25.01         |
| Types of cases                    | 25.02         |
| Initial action                    | 25.03 - 25.05 |
| Inter partes cases                | 25.04         |
| Section 13, 75 and counterclaims  | 25.05         |
| Main patents file, ledger, OPTICS | 25.06 - 25.08 |
| Design Right Cases                | 25.09 - 25.10 |
| European patent files             | 25.11 - 25.14 |
| European patent files not made up | 25.14         |
| Deleted                           | 25.15 – 25.16 |

#### Annexes

|         |                                    |
|---------|------------------------------------|
| Annex 1 | Free text entries for OPTICS       |
| Annex 2 | Document Codes                     |
| Annex 3 | Request for Index & Scanning Sheet |
| Annex 4 | Deleted                            |

## 25 CASE MAKE UP AND ASSOCIATED ACTIONS

### PATENT CASES

#### Introduction

25.01 Messages will be sent to the Litigation Team mailbox by Index & Scanning on a daily basis. The B3 Head of Litigation will allocate the work to the relevant team within Litigation Section. If it relates to a new case the team should record the case details in the SharePoint Lists, place the relevant label on the front cover of the dossier and make the relevant register entry. Where paper copies of documents are received in the office they will be sent to Index and scanning to be scanned into PDAX (see Annexes 2 and 3).

#### Types of cases

25.02 The types of cases are as follows Patents Form 2 and Form 4 – inter partes cases.

- Patents Form 15 – interpartes cases in respect of opposition to amendment (section 27(5)), correction (section 117(2)), surrender (section 29(2)) and cancellation of licence of right (section 47(6)).
- Patents Form 20 – correction (section 117) – A Form 20 may not be filed when a correction has already been allowed at the EPO.
- Patents Form 54 - correction of the translation of a European patent (UK) (Section 80(3)).
- Patents Form 30 - cancellation of licence of right proceedings (section 47).
- Patents Form 16 – restoration cases
- Patents Form 17 – request for an opinion
- No form is required for: (a) request to surrender a patent (section 29); (b) amendment before the court (section 75); (c) a claim or counterclaim for revocation before the court; (d) amendments after grant (section 27); (e) revocation on the comptroller's initiative sections 73(1), 73(2) and 73(1A).

## Initial Action

25.03 On receipt of a message relating to a Patents Form 2 or Patents Form 15 and associated papers, the B3 should update the ledger and message the B2 case officer. Where appropriate, the B2 will obtain the patent file or a copy of the patent specification and will arrange for it to be scanned or imported into PDAX (see 25.04 for further details)

## Inter Partes Cases

25.04 On receipt of the message from the B3, the B2 will:

- Make a register entry to record the fact that proceedings have been filed.
- Obtain the file from NMP (If the patent file is not a PDAX case). The file should be sent to Index & Scanning along with the other documents. If the file is an EP patent which is not at NMP see 25.14 for details.

## Section 13, section 75 before the court, counterclaim for revocation before the court

25.05 An entry should be made in the inter partes SharePoint list for section 13 cases and in the ex-parte post grant SharePoint list for section 72 and section 75 cases before the court.

## Main patents file, Ledger, OPTICS

25.06 The B2 should follow procedures in paragraphs 1.06.

25.07 Using the OPTICS function REG ENT (Menu no. 11), a free text entry is made, eg:

Application for revocation under Section 72 filed on .....

A list of free text entries is included in Annex 1.

If the document filed is a Patents Form 4 then a different procedure is used when using REG ENT on Optics. After the free text entry instead of recording authority in the following screen the Form 4 should be noted together with the date of filing.

- 25.08 When the above actions have been completed, messages on inter partes cases will be sent to the B3/B2 and messages on ex-parte cases sent to the A3's

### **DESIGN RIGHT CASES**

- 25.09 The files are similar to the inter partes files for pre-publication patent applications under section 8 and section 40 because the whole file is NOPI.

**PDAX Action:** Ensure that the public status of each document is set to NOPI

- 25.10 The details of each case will be entered in the Design Right ledger by the B3 and the LIT reference number will be allocated by Index and Scanning.

### **EUROPEAN PATENT FILES**

- 25.11 In order to check whether a European patent file already exists, you should check the patents register (OPTICS). Use the DIS FUL function.

- 25.12 If the patents register shows the entry "file raised", this means that a file has been made up. You should send for the patent file from Nine Mile Point by emailing PDD Filestore.

**PDAX Action:** Arrange for the documents to be scanned into PDAX. (see Annex 3)

25.13 [Deleted]

European Patent Files not made up

25.14 If an EP patent has not been raised, a copy of the granted specification should be electronically imported into PDAX from the espacenet website. Carry out a number search on espacenet and click on the PDF copy of the published 'B' specification. Choose to save the full document to your desktop and then use the manual import function to import it into PDAX (Doc Code – BDOC).

25.15 [Deleted]

25.16 [Deleted]

## Annex 1

### Free text entries for OPTICS

|                      |   |
|----------------------|---|
| <b>Section 8</b>     | “Reference as to entitlement under Section 8 filed on.....”   |
| <b>Section 10</b>    | “Request by joint applicants for directions under Section 10 filed on.....”   |
| <b>Section 12</b>    | “Reference as to entitlement under Section 12 filed on.....”  |
| <b>Section 13(1)</b> | “Application under rule 10(2) for inventor to be mentioned filed on.....”   |
| <b>Section 13(3)</b> | “Application for a person not to be mentioned as inventor under section 13(3) filed on .....”                           |
| <b>Section 27</b>    | “Application to amend specification under section 27 filed on.....”   |
| <b>Section 28</b>    | “Application for restoration filed on .....”<br><br>“Reinstatement under the provision of Rule 107 is being considered” |
| <b>Section 29</b>    | “Offer to surrender under Section 29 filed on.....”   |
| <b>Section 37</b>    | “Reference as to entitlement under Section 37 filed on.....”  |
| <b>Section 40</b>    | “Application by employee for compensation under Section 40 filed on.....”   |
| <b>Section 46(3)</b> | “Application to settle terms of licence of right under Section 46(3) filed on.....”                                     |
| <b>Section 47(1)</b> | “Application by a proprietor to cancel a licence of right under Section 47(1) filed on .....”                           |

|                       |  |
|-----------------------|--|
| <b>Section 48</b>     | “Application concerning compulsory licences under Section 48 filed on.....”  |
| <b>Section 71</b>     | “Application for a declaration of non-infringement under Section 71 filed on.....”                                     |
| <b>Section 72</b>     | “Application for revocation under Section 72 filed on.....”  |
| <b>Section 73(1)</b>  | “Section 73(1) action initiated on.... in view of.....”  |
| <b>Section 73(2)</b>  | “Section 73(2) action initiated on ... in view of EP(UK) .....”  |
| <b>Section 75</b>     | “Application for amendment under Section 75 before the court/before the Comptroller filed on .....”                    |
| <b>Section 80(3)</b>  | “Application to correct a translation under Section 80(3) filed on.....”   |
| <b>Section 117</b>    | “Request for correction under Section 117 filed on.....”   |
| <b>Form 4</b>         | “Confirmation of continuation of proceedings under section(s) ..... filed on .....”                                    |
| <b>OPPOSITIONS</b>    |  |
| <b>Section 27(5)</b>  | “Opposition to amendment under Section 27(5) filed on .....”   |
| <b>Section 29(2)</b>  | “Opposition to surrender under Section 29(2) filed on .....”   |
| <b>Section 47(6)</b>  | “Opposition to the cancellation in the register of a license available as of right under section 47(6) filed on .....” |
| <b>Section 75(2)</b>  | “Opposition to amendment under Section 75(2) filed on .....”   |
| <b>Section 117(2)</b> | “Opposition to a correction filed under Section 117(2) filed on ...”   |

## Annex 2

### INTERPARTES DOCUMENT CODES

|   |  |
|---|--|
| C-STATEMENT<br>C-STAT-ATT<br>C-AMD-STAT<br>C-SUP-STAT<br>SERVE LET<br>DEFECT STAT<br>DEFECT LET | Claimant Statement<br>Claimant's Statement Attachment<br>Claimant's Amended Statement<br>Claimant's Supplementary Statement<br>Serving Letter<br>Defect Statement<br>Defect Letter |
| D-COUNTER ST<br>D-AMD-CSTAT<br>D-SUP-CSTAT<br>D-STAT ATT  | Defendant's Counterstatement<br>Defendant's Amended Counterstatement<br>Defendant's Supplementary Counterstatement<br>Defendant's Statement Attachment                             |
| F4 REQUEST  | Inviting Form 4  |
| TIMETABLE<br>INVITE EVID<br>EVID-IP-S13   | Timetable letter<br>Inviting Evidence<br>S13 Evidence  |
| CLM-EIC<br>CLM-EIR  | Claimant's Evidence in Chief<br>Claimant's Evidence in Reply   |
| DEF-EIC<br>DEF-EIA<br>DEF-EIR   | Defendant's Evidence in Chief<br>Defendant's Evidence in Answer<br>Defendant's Evidence in Reply   |
| REQ COST SUBS<br>D COST SUBS<br>C COST SUBS   | Request Cost Submissions<br>Defendant's Cost Submissions<br>Claimant's Cost Submissions  |
| MISC-INTERP   | Miscellaneous Inter Parts documents  |
| PRELIM REQ<br>REQ SUBS<br>CLM SUBS<br>DEF SUBS<br>PRELIM DEC<br>PRELIM EVAL                     | Preliminary Request<br>Request Submissions<br>Claimant's Submissions<br>Defendant's Submissions<br>Preliminary Decision<br>Preliminary Evaluation                                  |
| HO DIRECT   | Hearing Officer Directions   |



|  |  |
|--|--|
| MED REQUEST<br>EOT REQUEST<br>EOT SUBS<br>EOT ALLOWED<br>EOT REFUSED     | Mediation Request<br><br>Extension of Time Request<br>Extension of Time Submissions<br>Extension of Time Allowed<br>Extension of Time Refused  |
| ADVERT-IP<br>AGNTL-IP<br>LETTER-IP<br>PARTYDET-IP<br>S75AMEND-IPAMEND-IP | Inter Partes Journal Advertisement<br>Inter Partes Agents Letter<br>Internal Contact details Form<br>S75 Amendments<br>Inter Partes Amendments |

### **HEARINGS DOCUMENT CODES**

|            |                             |              |                                      |
|------------|-----------------------------|--------------|--------------------------------------|
| ADVERT     | Advertisement               | GRNDS-APP-IP | Grounds of Appeal – Inter Partes     |
| AGNTL-IP   | Inter Partes Agent's Letter | GRND-APP-LIT | Grounds of Appeal – Ex Parte         |
| AUTH-LIT   | Authorities – Ex Parte      | HEARING-REC  | Recording of hearing                 |
| AUTH-IP    | Authorities – Inter Partes  | HEAR-REC-IP  | Recording of hearing – Inter Partes  |
| BUNDLE-LIT | Bundles – Ex Parte          | HEAR-TRANS   | Transcript of Hearing                |
| BUNDLE-IP  | Bundles – Inter Partes      | HEAR-TRAN-IP | Transcript of Hearing – Inter Partes |
| CNCLLND    | Shorthand cancel London     | HRG CMC      | Hearing CMC Arrangements             |
| CNCLNPT    | Shorthand cancel Newport    | HRG EXP      | Hearing Ex parte Arrangements        |
| CONFLND    | Shorthand confirm London    | HRG OPT      | Hearing Options                      |
| CONFNPT    | Shorthand confirm Newport   |              |                                      |

|              |                                |               |                                     |
|--------------|--------------------------------|---------------|-------------------------------------|
| CRT-ORDER-IP | Court Order – Inter Partes     | INTERCONFHRG  | Inter Partes Hearing Confirmation   |
| CRT-JDGMT-IP | Court Judgement – Inter Partes |               |                                     |
| DEC NOPI     | Decision NOPI                  | JUDICIAL RVW  | Judicial Review                     |
| DEC OPI      | Decision OPI                   | LETTER-IP     | Internal Inter Partes Letter        |
| DEC REDACTED | Decision Redacted              | NTC-OF-APPEAL | Appeal Notice                       |
| DEC SEC13    | Decision Section13             | NTC-OF-AP-IP  | Appeal Notice – Inter Partes        |
| DECISION-LIT | Decision                       |               |                                     |
| DECISION-IP  | Decision – Inter Partes        | REDACTED      | Decision redacted version           |
| DESIGNNOPI   | Decision Design NOPI           | SECTION13     | Decision Sec13                      |
| DESIGNOPI    | Decision Design OPI            | SKEL-ARGS     | Skeleton Arguments                  |
| EMAIL-LIT    | Email                          | TSOL          | Letters from the Treasury Solicitor |
| EVID-LIT     | Evidence                       |               |                                     |
| GLD-LIT      | GLD documents                  |               |                                     |
| GLD-IP       | GLD documents                  |               |                                     |

### **OPINIONS DOCUMENT CODES**

|              |  |
|--------------|--|
| ADVERT       | Advertisement                                      |
| AGNTL-LIT    | Agent's Letter                                     |
| F17          | Request for opinion as to validity or infringement |
| OPIN-OBS     | Observations                                       |
| OPIN-OBS-ATT | Observations                                       |

|              |                                  |
|--------------|----------------------------------|
|              | Attachments                      |
| OPIN-OBS-REP | Observations in Reply            |
| OPIOBSRE-ATT | Observations in Reply Attachment |
| OPIN-REQ     | Opinion Request                  |
| OPIN-REQ-ATT | Opinion Request Attachments      |
| OPIN-WDRL    | Opinion Withdrawn                |

### **EXPARTE DOCUMENT CODES**

|              |                              |             |                            |
|--------------|------------------------------|-------------|----------------------------|
| ADVERT       | Advertisement                | DECISION 5  | S73(1) REVOKED             |
| AGNTL-LIT    | Agent's Letter               | DECISION 6  | S73(2) REVOKED             |
| AMEN-LIT     | Amendments – Lit             | DNL1        | Appeal                     |
| APPEAL       | Notice of Appeal             | DNL2        | No Appeal                  |
| BDOC         | B Pub Front page             | EEA-AFS     | No EEA address for service |
| CORRECT      | Corrections                  | EOT-LIT     | EOT request                |
| CRT-JDGMT    | Court Judgment               | EOT REQUEST | EOT request                |
| CRT-ORDER    | Court Order                  | EOT ALLOWED | EOT allowed                |
| CTRCLM-REV   | Counter-claim for revocation | EOT REFUSED | EOT refused                |
| CDOC         | C Document/Spec              | EVID-LIT    | Evidence                   |
| CERTIFICATE  | Certificate                  | EVID-REQ    | Initial Evidence letter    |
| CONFIDENTIAL | Confidential/                |             |                            |

|              |                               |              |  |
|--------------|-------------------------------|--------------|--|
|              | Offensive material            | EXAM-REP-LIT | Exam Report – Lit  |
| DECISION LIT | Decision                      | F16          | Application to restore a patent                                      |
| DECISION 1A  | S73(1) GB AMENDS              | F20          | Request to correct a name or address                                 |
| DECISION 1   | S73(1) EP & GB AMENDS         | F30          | Cancellation of entry in register regarding availability of licences |
| DECISION 1B  | S73(2) GB AMENDS              |              |  |
| DECISION 1C  | S73(2) EP & GB AMENDS         | F49          | Caveat request   |
| DECISION 2A  | S73(1) OBS                    | FEE-REMIND   | Non payment of renewal fees  |
| DECISION 2   | S73(2) OBS                    | FINALEVI-REQ | Final evidence request   |
| DECISION 3A  | S73(1) CONTENT                |              |  |
| DECISION 3   | S73(2) CONTENT                | FUR-EOT      | Further extension of time letter                                     |
| FUREVID-REQ  | Further evidence letter       | REST ORDER   | Restoration order  |
| GRNDS-INVL   | Grounds of Invalidity         | S117ALLWED   | Correction allowed   |
| LATE-RES     | Late application letter       | S117EOTALLW  | Extension of time allowed  |
| LETTER-LIT   | Letter sent by Litigation     | S117EPC      | Central Limitation process   |
| LICENCE      | Licence                       | S117EPOALLW  | Allowed by EPO   |
| N244         | N244 Court Application Notice | S117 EXAM    | Exam Letter  |
| NTC-OF-APP   | Notice of Appeal              | S117 REQSPEC | Request replacement pages  |
| PRELIM-VIEW  | Preliminary View Letter       | S117A        | S117 date advert letter in PDJ                                       |
|              |                               | S117B        | S117 exam letter   |
|              |                               | S117D        | S117 request for   |

|            |                                     |            |  |
|------------|-------------------------------------|------------|--|
| REV-DEC-1A | S73(1A) GB AMENDS                   |            | evidence                                   |
| REV-DEC-2A | S73(1A) OBS                         | S117E      | EPO opposition outstanding                 |
| REV-DEC-3A | S73(1A) CONTENT                     | S27A(I)    | S27 date advert in PDJ                     |
| REV-DEC-5A | S73(1A) REVOKED                     | S27A(II)   | S27 date advert in PDJ negation            |
| REFUND     | Refund letter                       | S27B       | Amendments allowed.                        |
| REST-01    | Advise                              | S27C       | S27 opposition period outstanding options  |
| REST-03    | Extension of time letter            | S27D       | S27 exam letter                            |
| REST-09    | Minded letter                       | S27E       | S27 EPO already actioned amendment         |
| REST-11    | Offer letter (future fees)          | S27F       | S27 copy fresh spec requested              |
| REST-12    | Offer letter (new2)                 | S72D       | Court order acknowledged & records updated |
| REST-13    | Order cover letter                  | S72E       | Request copy of sealed order               |
| REST-16    | Refusal decision covering letter    | S73 EPAM   | Amendment in EPO Opposition                |
| S27G       | S27 retyped pages of spec requested | S73 EPOREV | Centrally revoked at EPO                   |
| S27H       | S27 extension of time               | S73 EX     | S73 Exam                                   |
| S27I       | S27 How to file                     | S73 FS1    | Request for fresh specification            |
| S27J       | S117 not S27                        | S73 FS2    | Fresh specification conformity             |
| S27K       | SPC PDJ Advert letter               |            |  |
| S27L       | Not proceeded central limitation    |            |  |

|         |   |             |   |
|---------|---|-------------|---|
| S27M    | Not proceeded with                          | S73(1)PL1   | PL1   |
| S27N    | S27 Withdrawal                              | S73(1)PL2   | PL2   |
| S27O    | Amendment refused                           | S73(2)PL3   | PL3   |
|         |   | S73(1)PL4   | PL4   |
|         |   | S73(2)PL5   | PL5   |
| S29A    | Request details of any court action pending | S73(1A)PL6  | PL6   |
|         |   | S73(1A)PL2A | PL2A  |
| S29B    | Date of advert in PDJ                       | S73(1A)PL4A | PL4A  |
|         |   | S75A        | Date advert in PDJ                              |
| S29C    | Patent surrender accepted date              | S75B        | Request update on proceedings                   |
| S29D    | Decision                                    | S75C        | Comptrollers comments                           |
| S47A    | Date of advert in PDJ                       | S75D        | Amend allowed                                   |
| S47B    | Cancellation of LOR confirmed               | S75E        | Court order received & records updated          |
| S72A    | Initial acknowledgment                      | TRANS B     | Acceptance of translation filed                 |
| S72B    | Initial acknowledgment to other side        | TRANS C     | Copy of corrected trans to British Library      |
| S72C    | Request for update                          | TRANS D     | Spec correction allowed & request to file trans |
| S75F    | Applicants notice received records updated  | TRANS E     | Spec correction allowed & noted trans filed.    |
| S75G    | Copy fresh spec requested                   | TRANS F     | Correction allowed and trans will be published  |
| S75H    | Extension of time                           |             |   |
| S80(3)A | Exam letter                                 |             |   |

|              |                       |           |                   |
|--------------|-----------------------|-----------|-------------------|
| S80(3)B      | Translation accepted  | WDRAW-REF | Withdrawal letter |
| S80(3)C      | British Library       |           |                   |
| STATE-OF-RSN | Statement of reasons  |           |                   |
| STDEC        | Statutory Declaration |           |                   |
| TELREP-LIT   | Telephone Report      |           |                   |

### Annex 3

## REQUEST FOR INDEX AND SCAN 1G05

Please provide all of the following information:

|            |                            |
|------------|----------------------------|
| From:      | Insert your name           |
| Section:   | Litigation                 |
| Extension: | Insert your contact number |

|                            |  |
|----------------------------|--|
| Dossier (inc check digit): |  |
| Doc Code:                  |  |
| Doc Date:                  |  |
| Number of Pages:           |  |
| Is this a fax copy?        |  |

|                |                             |
|----------------|-----------------------------|
| Team:          | Insert 'Inter Partes'       |
| User (if any): | Insert name of case officer |
| Message text:  | Example: New F2             |

Does this need to be processed urgently?

YES

NO

Other instructions:

Include any instructions to annotate.



## **Annex 4 [Deleted]**

## CHAPTER 26

# PREPARATION OF PATENTS AND DESIGNS JOURNAL ENTRIES

|                                      |               |
|--------------------------------------|---------------|
| Introduction                         | 26.01         |
| Litigation Section action            | 26.02         |
| Heading requirements                 | 26.03         |
| Sending to Publishing Section        | 26.04 - 26.05 |
| Sending Summary Listing to Webmaster | 25.06 - 25.07 |
| Completion of Journal                | 26.08 - 26.12 |

### Annexes

- Annex 1 Example of Journal adverts
- Annex 2 Formatting of Adverts
- Annex 3 Checklist for preparing Journal

## **26 PREPARATION OF PATENTS AND DESIGNS JOURNAL ENTRIES**

### **INTRODUCTION**

26.01 Entries for the Journal are compiled by members of Litigation Section. The entries are prepared and saved on SharePoint in the PDJ Live folder, a paper copy is also placed in the Journal folder. They are submitted to the Publication Section by e-mail on a weekly basis. The Journal entries are submitted for publication three weeks in advance.

### **LITIGATION SECTION ACTION**

26.02 Every Tuesday, all entries on SharePoint are checked by one of the A3s for accuracy. The formatting of the entries should be checked against Annex 2 and the content of the entry should be verified using the dossier and patents register.

#### Heading requirements

26.03 All section headings should be checked against Annex 1 to ensure that they are in the correct format. The following in particular should be noted:

- All adverts should be in Arial font.
- All section headings should be in bold type and font size 15.
- All sub headings should be in bold and the first letter of the subheading in capital and remainder in lower case and font size 12
- The patent number should be in bold and in capitals
- The proprietor/applicant name should be in capital letters but not in bold
- The title of the patent/application should be shown. (It should be noted that we do not always have the title of section 12 PCT cases but where this is known, it should be entered).

- The outcome (filed/withdrawn/refused, etc) should be included along with the date of the action.
- Where there is an *inter partes* application/reference, the name of the claimant party should be included.
- (See Annex 2)

#### Sending to Publishing Section

26.04 When the entries have been checked and any necessary corrections have been made, they should be re-checked by another A3.

26.05 Once the entries have been checked and any errors corrected, the electronic version of the Journal should be sent to Publishing Section via e-mail

#### Sending Summary Listing to Webmaster

26.06 The summary listing is completed for S27 and S75 opposition adverts. When the entries in the Journal have been collated and checked, the completed summary listing will be e-mailed to Webmaster by the A3. If any amendments have been filed electronically, they should be retrieved from the “Amendments to be advertised” folder within PDJ Store on SharePoint and sent as an attachment to the e-mail.

26.07 Once the amendments have been attached and sent with the summary listing, they should be moved into the “Amendments advertised” folder within PDJ Store on SharePoint. The summary listing and proposed amendments will then appear on the Web page on the date the Journal is published.

If there are no amendments filed under S27 or S75, an e-mail notifying Webmaster that there are no entries should be sent.

## Completion of Journal

- 26.08 The Journal entries should be sent electronically to the B3 and B2 managers within Litigation.
- 26.09 The compiled Journal should then be archived on SharePoint (see Annex 3 for instructions).
- 26.10 A blank summary listing template should be uploaded to the new Journal folder within SharePoint (see Annex 3 for instructions).
- 26.11 The oldest Journal within SharePoint should be deleted as part of the archiving process (see Annex 3 for instructions).
- 26.12 The Journal file contains a checklist which should be actioned by the A3 responsible for compiling the Journal. When the checklist is complete, the hard copies of the Journal entries can be destroyed. The A3 should update the team information board to indicate that the Journal has changed

## ANNEX 1

### EXAMPLE OF ADVERTS

**SECTION OF ACT**

**SECTION 8 [and 11]**

**HEADING**

**Determination before Grant of UK Entitlement**

**INSERT OPTIONS:**

- 1) Reference under Section 8(1)**
- 2) Authorisation under Section 8(5) to act following UK Entitlement Reference**
- 3) Reference under Section 11(5) concerning a Licence**

**INSERT OPTIONS:**

**Reference filed**

**(Withdrawn/refused/allowed etc)**

**PATENT NUMBER/APPLICANT**

**EP XXXXXXXX**

**INSERT NAME**

**TITLE OF INVENTION**

**INSERT APPROPRIATE DETAILS**

**INITIAL ADVERT ENTRY**

Reference under Section  
8(1)/(5)/11(5) by ....., filed on  
.....

**FINAL ADVERT ENTRY**

Reference under Section  
8(1)/(5)/11(5) by ....., filed on  
..... (refer to OPTICS entry).

.....

**SECTION OF ACT**

**SECTION 10**

**HEADING**

**Request by Joint Applicants for Directions**

**Request under Section 10**

**INSERT OPTIONS:**

**Request filed**

**(Withdrawn/refused/allowed etc)**

**PATENT NUMBER/APPLICANT**

**EP XXXXXXXX**

**INSERT NAME**

**TITLE OF INVENTION**

**INSERT APPROPRIATE DETAILS**

**INITIAL ADVERT ENTRY**

Request under Section 10 by  
....., filed on .....

**FINAL ADVERT ENTRY**

Request under Section 10 by  
....., filed on ..... (refer to  
OPTICS entry).

.....

**SECTION OF ACT**

**SECTION 12**

**HEADING**

**Determination of Foreign Entitlement**

**INSERT OPTIONS:**

- 1) Reference under Section 12(1)**
- 2) Request by Joint Applicants for Directions under Section 12(4)**

**INSERT OPTIONS:**

**(Withdrawn/refused/allowed etc)**

- 1) Reference filed**
- 2) Request filed**

**PATENT NUMBER/APPLICANT**

**EP XXXXXXXX**

**INSERT NAME**

**TITLE OF INVENTION**

**INSERT APPROPRIATE DETAILS**

**INITIAL ADVERT ENTRY**

Reference/Request under Section  
12/12(4) by ....., filed on  
.....

**FINAL ADVERT ENTRY**

Reference/Request under Section  
12/12(4) by ....., filed on  
..... (refer to OPTICS entry).

.....

**SECTION OF ACT**

**SECTION 13**

**HEADING**

**Mention of Inventor**

**INSERT OPTIONS:**

- 1) Application for inventor to be mentioned under rule 10(2)
- 2) Application under Section 13(3) for a person not to be mentioned as inventor

**INSERT OPTIONS:**

(Withdrawn/refused/determined)

**Application Filed**

**PATENT NUMBER/APPLICANT**

**GB XXXXXXX**

**INSERT NAME**

**TITLE OF INVENTION**

**INSERT APPROPRIATE DETAILS**

**INITIAL ADVERT ENTRY**

Application for a person to be mentioned as inventor under Rule 10(2)/not to be mentioned as an inventor under Section 13(3) by ....., filed on .....

**FINAL ADVERT ENTRY**

Application for a person to be mentioned as inventor under Rule 10(2)/not to be mentioned as an inventor under Section 13(3) by ....., filed on ..... (refer to OPTICS entry).

.....

**Application to amend the specification of a patent (under Section 27 and Section 75)**

**Section 27**

**Application Filed**

The details of the amendments proposed, which may now be inspected at the Office, will be advertised later (unless the application is abandoned); the application will then be open to opposition. The date included in the entry is the date of filing of the application.

**GB/EP Patent Number**

**PROPRIETOR NAME**



Title of the patent and date application filed.

## **Application to Amend the Specification of a patent now Open to Opposition**

### **Section 27 amendments and Section 75 before the Comptroller**

If you intend to oppose the amendments filed under section 27 before the Comptroller, you must **within four weeks** of the appearance of the advertisement under section 27 or **within two weeks** under section 75, file two copies of Patents Form 15 giving the comptroller notice of opposition to the amendments. You also need to file two copies of a statement setting out fully the facts of your case and the relief that you are seeking.

### **Section 75 before the Court**

If you intend to oppose the amendments, filed under Section 75 before the court, you must **within 14 days** from the appearance of this advertisement, file and serve on all parties and the comptroller a notice opposing the application. This must include the grounds relied on.

## **SECTION**

**Patent Number**

**Title of patent**

**International classification**

**Name of proprietor**

For a copy of these amendments, phone Litigation Section (01633 814335).

\* These amendments may be viewed on our website. (Delete as applicable)

**Section** **75 before the Comptroller**

**Patent Number**

**Title of patent**

**International classification**

**Name of proprietor**

For a copy of these amendments, phone Litigation Section (01633 813872).

\* These amendments may be viewed on our website. (Delete as applicable)

**Application(s) determined**

**Section 27: Specification amended**

The date included in the entry is the effective date of the amendment.

**GB/EP Patent Number                      PROPRIETOR NAME**

Title of patent and date amendment allowed.

**Section 27: Application to amend withdrawn/not proceeded with/refused**

**GB/EP Patent Number                      PROPRIETOR NAME**

**Title of patent**

Application to amend under section 27 filed on..... withdrawn/not proceeded with/refused on.....

**Section 75 before the Comptroller: Specification amended**

**GB/EP Patent Number                      PROPRIETOR NAME**

**Title of patent**

Specification amended under section 75 filed on..... allowed by decision dated.....

**Section 75 before the Comptroller: Application to amend withdrawn/refused**

**GB/EP Patent Number                      PROPRIETOR NAME**

**Title of the patent**

Application to amend under section 75 filed on..... withdrawn/not proceeded with/refused on.....

**Section 75 before the Court: Specification amended**

**GB/EP Patent Number                      PROPRIETOR NAME**

**Patent title**

Specification amended under Section 75 filed on..... allowed by Court Order dated.....

**Section 75 before the Court: Application dismissed**

**GB/EP Patent Number                      PROPRIETOR NAME**

**Title of patent**

Application to amend under section 75 filed on..... dismissed by Court Order dated.....

**Section 75 before the Court: Patent Revoked**

**GB/EP Patent Number                      PROPRIETOR NAME**

**Title of patent**

Application to amend under Section 75 filed on..... patent revoked by Court Order dated.....

**SECTION OF ACT    SECTION 29**

**HEADING    Surrender of Patent**

**OPTION FOR OFFER TO    Offer to surrender**  
**SURRENDER ADVERT**

Any person may give notice of opposition to the surrender of the undermentioned patent(s) by filing Patents Form 15 within four weeks from the date of publication of this Journal.

**OPTION SURRENDER    Offer to surrender accepted by the Comptroller**  
**ACCEPTED**

The effective date of surrender of the patent is the date of this Journal.

**PATENT NUMBER/APPLICANT                      GB XXXXX                      INSERT NAME**

TITLE OF INVENTION

INSERT APPROPRIATE DETAILS

ENTRY

Application filed on .....

.....

**SECTION OF ACT**

**SECTION 37 [AND 38]**

**HEADING**

**Reference after Grant concerning UK Entitlement**

**INSERT OPTIONS:**

- 1) Reference under Section 37(1)
- 2) Reference under Section 38(5) concerning a Licence

**INSERT OPTIONS:**

**Reference filed**

**(Withdrawn/refused/allowed etc)**

**PATENT NUMBER/APPLICANT**

**EP XXXXXXXX**

**INSERT NAME**

**TITLE OF INVENTION**

**INSERT APPROPRIATE DETAILS**

**INITIAL ADVERT ENTRY**

Reference under Section 37/38(5)  
by ....., filed on .....

**FINAL ADVERT ENTRY**

Reference under Section 37/38(5)  
by....., filed on ..... (refer  
to OPTICS entry).

.....

**SECTION OF ACT**

**SECTION 40**

**HEADING**

**Application by Employee for Compensation**

**INSERT OPTIONS:**

**Application filed**

**(Withdrawn/refused/allowed etc)**

**PATENT NUMBER/APPLICANT**

**EP XXXXXXXX**

**INSERT NAME**

TITLE OF INVENTION

INSERT APPROPRIATE DETAILS

**INITIAL ADVERT ENTRY**

Application filed under Section 40 by  
....., filed on .....

**FINAL ADVERT ENTRY**

Application filed under Section 40 by  
....., filed on ..... (refer to  
OPTICS entry).

.....

**SECTION OF ACT**

**SECTION 46**

**OPTION FOR 46(1)**

**Licences of Right**

**INSERT OPTIONS**  
**(Withdrawn/refused/allowed)**

**Application filed**

**OPTION FOR 46(3)**

**Application under Section 46(3) to settle Terms of a  
Licence of Right**

**INSERT OPTIONS**  
**(Settled by decision/refused by  
decision/withdrawn)**

**Application filed**

**PATENT NUMBER/APPLICANT**

**EP XXXXXXXX**

**INSERT NAME**

TITLE OF INVENTION

INSERT APPROPRIATE DETAILS

INITIAL ADVERT ENTRY

Application filed under Section  
46(1)/(3) on .....

FINAL ADVERT ENTRY

Application filed under Section  
46(1)/(3) filed on ..... (refer to  
OPTICS entry)

.....

**SECTION OF ACT**

**SECTION 47**

**HEADING**

**Cancellation of Entry on the Register of a Licence of  
Right**

**OPTION INITIAL ADVERT 47(1)**

**Application under Section 47(1) by a Proprietor to cancel an Entry**

Any person may give notice of opposition to the undermentioned Application by filing Patents Form 15 within four weeks from the date of publication of this Journal

**OPTION INITIAL ADVERT 47(3)**

**Application under Section 47(3) by a Third Party to cancel an Entry**

**OPTION FOR FINAL ADVERT**

**Cancellation of Entry**

Notice is hereby given that the entry on the Register "Licences of Right" upon the undermentioned patent was cancelled on.....

**INSERT OPTIONS  
(refused)**

**Application withdrawn**

PATENT NUMBER/APPLICANT  
TITLE OF INVENTION

EP XXXXXXXX

INSERT NAME  
INSERT APPROPRIATE DETAILS

**INITIAL ADVERT ENTRY**

Cancellation of Entry on the Register of a Licence of Right filed on.....

FINAL ADVERT ENTRY IF  
CANCELLATION NOT ALLOWED

Cancellation of Entry on the Register of a Licence of Right filed on.....(refer to OPTICS entry)

.....

**SECTION OF ACT**

**SECTION 48**

**HEADING**

**Application concerning Compulsory Licences etc**

**INSERT OPTIONS:  
(Withdrawn/refused/allowed)**

**Application filed**

**OPTION FOR OPPOSITION ADVERT    Application now open to Opposition**

Application has been made by.....for an order for a licence to be granted to them [him/her] in respect of the undermentioned patent. Any person may give notice of opposition to the Application by filing Patents Form No. 15 within four weeks from the date of publication of this Journal.

PATENT NUMBER/APPLICANT

EP XXXXXXXX

INSERT NAME

TITLE OF INVENTION

INSERT APPROPRIATE DETAILS

INITIAL ADVERT ENTRY

Application filed under Section 48 by  
....., filed on .....

FINAL ADVERT ENTRY

Application filed under Section 48 by  
....., filed on ..... (refer to  
OPTICS entry).

.....

**SECTION OF ACT**

**SECTION 71**

**HEADING**

**Application for a Declaration of Non-infringement**

**INSERT OPTIONS:**

- 1) Application filed**
- 2) Case decided by the Comptroller**

**Application granted/withdrawn**

PATENT NUMBER/APPLICANT

EP XXXXXXXX

INSERT NAME

TITLE OF INVENTION

INSERT APPROPRIATE DETAILS

INITIAL ADVERT ENTRY

Application filed under Section 71 by  
....., filed on .....

FINAL ADVERT ENTRY

Application filed under Section 71 by  
....., filed on ..... (refer to  
OPTICS entry).

.....

**SECTION OF ACT**

**SECTION 72**

**HEADING**

**Application for Revocation**

**OPTION REVOCATION BEFORE  
COMPTROLLER**

**Case decided by the Comptroller**

- 1) Patent revoked**
- 2) Application refused [;no Order for Revocation made]**
- 3) Application withdrawn [;no Order for Revocation made]**

.....

**SECTION OF ACT**

**SECTION 73**

**HEADING**

**Revocation on the Comptroller=s Initiative**

**INSERT OPTIONS:**

- 1) Specification amended under Section 73(1)/73(2)**
- 2) Revocation under Section 73(1)/73(2) not proceeded with**
- 3) Patent revoked under Section 73(1)/73(2)**

**PATENT NUMBER/APPLICANT**

**EP XXXXXXXX**

**INSERT NAME**

**TITLE OF INVENTION**

**INSERT APPROPRIATE DETAILS**

**FINAL ADVERT ENTRY OPTIONS:**

- 1) Specification amended under Section 73(1)/73(2) on .....**
- 2) Revocation under Section 73(1)/73(2) not proceeded with from .....**
- 3) Patent revoked under Section 73(1)/73(2) on .....**

.....

**SECTION OF ACT**

**SECTION 117**

**HEADING**

**Correction of Errors in Patents and Applications**



**OPTION FOR INITIAL ADVERT**

**Request made for Correction of Error**

In the event that the Comptroller requires notice of the proposed correction to be advertised in accordance with Rule 75(1) then details of the proposed correction will be advertised later.

**OPTION FOR OPPOSITION ADVERT**

**Request now open to Opposition**

Any person may give notice of opposition to (any of) the undermentioned request(s) by filing Patents Form 15 within four weeks from the date of publication of this Journal. If no notice of opposition is received, the correction will be allowed by the Comptroller in the present advertised form.

NB. The paging referred to is that of the printed specification.

**OPTION FOR OPPOSITION FILED**

**Opposition filed**

**INSERT OPTIONS FOR FINAL ADVERT**

**1) Case decided by the Comptroller**

**Correction allowed**

The date included in the entry is the effective date of the correction

**2) Request withdrawn**

**3) Correction refused**

**PATENT NUMBER/APPLICANT**

**EPXXXXXX**

**INSERT NAME**

**TITLE OF INVENTION**

**INSERT APPROPRIATE DETAILS**

**INITIAL ADVERT ENTRY**

Request for correction under Section 117 filed on .....

**FULL ADVERT ENTRY**

**INSERT APPROPRIATE**

(INVITING OPPOSITION)

CORRECTIONS

OPPOSITION FILED ADVERT ENTRY

Opposition under Section 117(2) by  
..... filed on .....

FINAL ADVERT ENTRY

Request for correction under Section  
117 filed on ..... allowed on .....

INSERT OPTIONS

.....

## Annex 2

### FORMATTING OF ADVERTS

|                      |   |
|----------------------|---|
| <b>HEADING</b>       | Bold and Section in Lower Case – Font <b>Always Arial</b> size 15   |
| <b>SUBHEADING</b>    | Bold and first letter of the subheading in capital and the remainder in lower case – Font size 12   |
| <b>PATENT NUMBER</b> | Bold and in capitals  |
| <b>PROPRIETOR</b>    | Capitals but not in bold  |
| <b>TITLE</b>         | First letter in capital but remainder of the title in lower case. Any abbreviations, for example, chemical, in capitals   |
| <b>DATES</b>         | Format should be full date eg 27 October 2009 not 27.10.09 or 27 Oct 09   |
| <b>SPACING</b>       | There should be 2 carriage returns between the headings and the patent number and between the proprietors name, the title and the date. Ensure everything is lined up in block. There should be 3 tab spaces after the patent number for body of advert (see example below) |

## Section 117

### Correction of Errors in Patents and Applications

#### Case decided by the Comptroller

#### Corrections Allowed

EPxxxxxx

PROPRIETORS NAME

TITLE

Request for correction under Section 117 filed on XXXXXXXX allowed on XXXXXXXX

INTERPARTES CASES

An interpartes advert may differ from the format above, however the font type and size is still the same

## Annex 3

### **Desknotes: To be used with the PDJ checklist**

#### **Library on SharePoint – PDJ LIVE**

##### **Check formatting, headings & sequential numbering;**

- Main headings            Arial Bold 15 font
- Sub headings            Arial Bold 12
- Patent numbers        Arial Bold and Capitals 12 font
- Remaining text        Arial 12 font
- Dates                    Arial and typed in full.

##### **Send electronic version to Publishing**

- Once the PDJ is ready for sending to publishing;
- create an email
- click attach file
- scroll to Y Drive
- select PDJ then highlight all entries and click insert into the email. (Do not insert the summary listing).
- Check all adverts have copied over to the email and send the email to Publishing, copying the email to B2.

##### **Send Summary Listing S27 & S75 to Webmaster**

- Check the content of the Summary Listing against the opposition advert.
- If there are any blank rows on the Summary Listing (there are blank rows when there are no amendments for that section of the Act) delete the row.
- Create a new email
- click attach file
- Scroll to Y Drive – PDJ then insert the Summary Listing.
- If there are any electronic amendments, click attach file. Scroll to Y Drive, PDJ Store then insert the amendments

##### **Send email to advise if no entries for Summary Listing**

- If there are no Summary Listings send an email to Webmaster informing them that there are no Summary Listings.

### **Archive weekly entry on SharePoint**

- Click on the Site Actions tab
- View All Site Content
- PDJ Store Workflow
- Run PDJ Workflow
- Workflows
- Copy Items to PDJ Store
- Start.
- Then go to PDJ Store to check that all the adverts have moved over.

### **Copy blank summary listing template from PDJ Store into PDJ Live to create new PDJ**

- Go to PDJ Store, then Template and open "S27 and S75 Webmaster Summary Listing Blank Template". To save the Summary Listing to PDJ Live, scroll to Y Drive and save in PDJ as document.
- Check PDJ Live to confirm summary listing has saved in PDJ Live.

### **Delete oldest PDJ in PDJ Store**

- In order to only store PDJ's from the previous three months, delete the oldest PDJ in PDJ store by ticking each advert. Choose the delete document button.

### **Move any electronic amendments into amendments advertised**

- On SharePoint in PDJ Store locate the amendment sent to Webmaster in the "Amendments to be advertised" folder. Click edit properties. In the PDJ Number row it should read Amendments to be advertised, delete "to be". This will move the amendment from the "Amendments to be advertised" folder into the "Amendments advertised" folder.

## CHAPTER 27

### CLEAR RECORDS

|   |               |
|---|---------------|
| Introduction  | 27.01         |
| Standard Procedures – <i>Ex parte</i> proceedings     | 27.02 - 27.07 |
| Register entry  | 27.02         |
| Journal entry   | 27.03         |
| Electronic Ledger and spreadsheet                     | 27.04 – 27.05 |
| Publishing action                                     | 27.06 – 27.07 |
| Clear records from <i>inter partes</i> proceedings    | 27.08 - 27.14 |
| Register entry  | 27.09         |
| Journal entry   | 27.10         |
| Electronic Ledger and spreadsheet                     | 27.11         |
| Publishing action                                     | 27.12 – 27.14 |
| <i>Inter Partes</i> Proceedings – Other Clear Records | 27.15         |
| Deleted   | 27.16         |
| Multiple files  | 27.17         |

## 27 CLEAR RECORDS

### INTRODUCTION

27.01 Clear records are the final actions taken when case work proceedings are complete. EP and GB patents are cleared electronically on PDAX (Patents Document Access Exchange Management System).

### STANDARD PROCEDURES – *EX PARTE* PROCEEDINGS

#### Register entry

27.02 Update as appropriate by using OPTICS (see *ex parte* Chapters 17 – 24).

#### Journal entry

27.03 Compile a final advert for the Patent and Designs Journal. The wording is normally in line with the corresponding register entry (see Chapter 26). The advert is manually imported into PDAX.

#### Sharepoint Lists

27.04 Complete the result box e.g. allowed, not proceeded with, or revoked.

27.05 Deleted.

#### Publishing action

27.06 For Sections 27, 75 and 117 proceedings you should inform Publishing Section of the changes required to the A, B and C printed specification as appropriate. For example you may want to correct bibliographic details for the applicant or inventor or there may be technical changes required to the specification.

The A3 will create, a minute in PDAX, then create and send a “PSM – Amendment/Correction allowed – please prepare a C specification, and issue an official letter accordingly” message to Publishing Section

27.07 Deleted

### ***INTER PARTES PROCEEDINGS – CLEAR RECORDS AFTER ISSUE OF AN OFFICE DECISION.***

27.08 An Office decision is issued following a hearing or where the proceedings have been decided on the papers. The A3 Hearing Clerk will pass a copy of the decision to the B3 with clear records proforma.

#### Register entry

27.09 The B3 will make an entry on the register reflecting the outcome of the proceedings if necessary. The B3 will also amend the register if appropriate, for example if a proprietor or inventor needs to be added or removed.

#### Journal entry

27.10 A Journal entry is made in the Patent Journal. To ensure consistency the wording should be taken from the register entry made by the B3. The advert is manually imported into PDAX.

#### Electronic Ledger and spreadsheet

27.11 The Inter Partes SharePoint list should be updated to reflect the result of the proceedings and the date of the decision. The front cover of the dossier is labelled Precedent.



## Publishing action

27.12 In order for the A and B patent specification to reflect the outcome of proceedings (see 27.08 above) Publishing Section should be requested to make the necessary changes. This will usually be done by the addition of an addendum slip or in the case of amendment, the request for a C specification.

The A3 will create a minute in PDAX, then create and send a “PSM – Amendment/Correction allowed – please prepare a C specification and send an official letter accordingly” message to Publishing Section

27.13 Deleted.

27.14 Deleted.

## ***INTER PARTES PROCEEDINGS – OTHER CLEAR RECORDS.***

27.15 Where a case has been withdrawn, the B2 should update the register using Revocation Section menu - free text entry. The journal entry and Inter Partes SharePoint list should be completed. However there will be no need for any publishing action to be taken. The front cover of the dossier is labelled Precedent.

## **DELETED**

27.16 Deleted

## **MULTIPLE FILES**

27.17 There may be a number of patent files linked to a case. Where this occurs each patent file should be cross – referenced to the other on the front cover of the dossier.

## CHAPTER 28

# RESTORATIONS

|   |               |
|---|---------------|
| Introduction                                  | 28.01- 28.04  |
| A3 Initial actions                            | 28.05         |
| Evidence                                      | 28.06         |
| Extension of time requests                    | 28.07         |
| Restorations Manager Initial check            | 28.08 - 28.12 |
| Examination of the application                | 28.13 - 28.18 |
| Managing the application                      | 28.19 - 28.20 |
| Issuing the Offer to Restore Letter           | 28.21         |
| Drafting an Order                             | 28.22 - 28.25 |
| Further evidence received                     | 28.26 - 28.30 |
| Various Stages of Refusal                     | 28.31 - 28.39 |
| Withdrawal of the application for restoration | 28.40 - 28.46 |
| Refunds                                       | 28.47 - 28.52 |
| Request for confidentiality of documents      | 28.53 - 28.60 |
| Rule 107 Request to Reinstate the application | 28.61 - 28.72 |

### Annexes

|          |   |
|----------|---|
| Annex 1  | Restoration advice letter                               |
| Annex 1a | Restoration Procedure Sheet                             |
| Annex 1b | Letter to request evidence                              |
| Annex 2  | Letter to respond to a late application for restoration |
| Annex 3  | Offer to Restore Letter                                 |
| Annex 3b | Fee Reminder Letter                                     |
| Annex 4  | Minded Letter   |
| Annex 5  | Further evidence request letter                         |

- Annex 6 Order to Restore
- Annex 7 Preliminary View Letter
- Annex 8 Refusal Decision
- Annex 8a Covering letter for refusal decision
- Annex 9 Withdrawal Letter
- Annex 10 First Third Party Terms Letter
- Annex 11 Third Party Terms Reminder Letter
- Annex 12 Second Third Party Terms Letter
- Annex 13 Extension of Time Letter
- Annex 14 Further Extension of Time Letter

## 28 RESTORATIONS

### INTRODUCTION

- 28.01 If a GB or EP (UK) patent has ceased due to failure to pay the relevant renewal fees, an application for restoration of the patent may be filed under section 28 (see rule 40). An application can be filed, for example either by a patent attorney acting on behalf of the patent proprietor or may be filed by the proprietor themselves, that is, the applicant for restoration. The applicant may be one or more joint proprietors, or anyone who would have been entitled to the patent if it had not ceased.
- 28.02 An application must be filed by the end of the 13th month from the last day it was possible to pay the renewal fee on the patent, i.e. 6 months from the date the patent ceased. The 6 months following the renewal date is sometimes referred to as the grace period and is the period in which the patent can be renewed with payment of a surcharge. An application to restore a patent that ceased on 20 August 2008 must therefore be filed by 31 March 2010.
- 28.03 To make an application, an applicant needs to file patents Form 16 with the appropriate fee. The form should be accompanied by evidence supporting the application. The letter shown in Annex 1 should be issued to applicants enquiring about restoration.
- 28.04 The applicant no longer has to provide the office with a sworn statement. Evidence is now acceptable in any written format. There is no provision in the Act or Rules that provides for third parties to oppose an application for restoration

### A3 Initial Actions

28.05 On receipt of Patents Form 16, the A3 should check:

- Whether the form has been filed within the 13 month period allowed. The period begins at the end of the 9 month period allowed for paying your renewal fees. If the application has been filed late or the fee has only been partially paid, a minute should be sent to the Restorations Manager pointing this out.
- Whether the application for restoration has been made by the proprietor or any other person entitled to the patent. If restoration has been applied for by someone else the A3 should write to the applicant requesting an assignment or change of name certificate, so we can update our register to the new owner.
- Whether the address for service details on the Patents Form 16 match those currently on the register. If the applicant has entered 'YES' in box 6 of the Form 16 and they are not currently the address for service, the A3 should send Register Admin a minute to update the register accordingly. Sometimes the proprietor will use a different agent to registered address for service just for the purpose of processing the restoration request. If this is the case, or the applicant has entered 'NO' in box 6 of the Form 16 do not refer the case to Register Admin as the applicant still wants to keep his registered address for service. Care must be taken when issuing letters on these types of cases.
- Whether evidence has been filed. If no evidence has been received issue the letter at Annex 1b requesting evidence. Diary the case in Diary R for two months to await the evidence.

The A3 should also:

- Redact the letter filed, by removing any personal signatures or personal e-mail addresses and update the status of each document to identify it as either open to public inspection (OPI) or not open to public inspection (NOPI).
- Enter the details of the application in the Exparte Post Grant SharePoint List, allocate a case reference number.

- Update OPTICS using the REG FIL option – menu 11. There is no need to suppress the Journal entry  
PDAX ACTION:– Use OPTICS Prints DIS FUL and DIS HIS to complete a restoration procedure sheet (See Annex 1a). Create a file note and place the restoration procedure sheet on Pdex minute.
- If the application relates to an EP patent, obtain a copy of the patent specification and import into PDAX (See 25.14). If the application relates to a GB case, Index and Scanning will retrieve the file from NMP and scan it into PDAX if it is not already scanned on to the dossier.
- Send a message on PDAX to the Restorations Manager entitled ‘New Case – PDJ (date)’. This message will let the Manager know what date the application for restoration will appear in the Patents Journal and the ten day target for examining the evidence will begin from then.

### Evidence

28.06 If evidence is filed later than the Patents Form 16 the A3 should:

- Redact the covering letter, removing any personal signatures or personal e-mail addresses.
- Update the Exparte Post Grant SharePoint List.
- Send a message on PDAX to the Restorations Manager entitled ‘New Docs’

If the document is filed directly by fax to Litigation Section the A3 should import the document into PDAX and send a message to the Restorations Manager.

### Extension of Time for filing evidence

28.07 Under rule 109 of the Patents Rules 2007 applicants for restoration may apply in writing for an automatic EOT of two months for filing evidence. They will need to apply before the two month extended period has expired. When a request of this nature is received the A3 can issue the standard letter allowing an automatic extension of two months (See Annex 13). Any further requests for EOTs need to provide reasons why more time is required and

are at the discretion of the comptroller. When requests of this nature arrive the A3 should seek the advice of the Restorations Manager before issuing a response (See Annex 14).

### Restorations Manager Initial Check

28.08 Deleted

28.09 Deleted

28.10 Deleted

28.11 If the application for restoration has not been filed on time, write to the applicant explaining they have missed the deadline (see Annex 2).

28.12 Where the office has made an error that prevented the proprietor from paying the renewal fees or applying for restoration on time, they may be able to apply for re-instatement of their application under rule 107 (see 28.61 to 28.72).

### Examination of the application

28.13 Having analysed the evidence provided, the Restorations Manager will decide whether restoration should be allowed. They will also redact any personal or sensitive information found in the evidence so that redacted copies of the documents can appear on IPSUM.

28.14 The applicant for restoration no longer has to provide the office with sworn evidence. Although the majority of applicants still send in witness statements, it is permissible for them to file their evidence in any written format.

28.15 When analysing the evidence it must be determined whether the failure to make the renewal payment was **unintentional**. **The proprietor must prove that at some point when the fee was due to be paid (from 3 months**

**before the annual renewal date until the end of the sixth month following the renewal date) they intended to make the payment.**

28.16 If the application for restoration is allowed summarise the decision in a minute. The minute should also instruct the A3 to issue the 'Offer to Restore' Letter (see 28.21 and Annex 3).

PDAX ACTION:– Create a minute in PDAX and message the A3

28.17 If the Restorations Manager decides not to allow the application for restoration, they will write a brief summary of the decision in a minute and instruct the A3 to issue a 'Minded' letter to the applicant informing them that we are minded to refuse the application. A month should be given to allow comments (see Annex 4).The A3 should diary the application for 1 month to await a reply.

PDAX ACTION:– Create a minute in PDAX and message the A3

28.18 If further evidence is required, the A3 should write to the applicant giving them 2 months to file any further documents (see Annex 5). The Restorations Manager should create a minute in PDAX stating the evidence they require. They should then message the A3 to issue the standard letter and diary the application for two months to await a response.

PDAX ACTION:– Create a minute in PDAX and message the A3

### Managing the application

28.19 On receipt of a message from the Restorations Manager the A3 should issue the relevant letter and import a copy into PDAX, update the Exparte Post Grant SharePoint List, enter the relevant diary date in Diary R and enter a minute on PDAX showing what you have done.

28.20 The A3 should check the diary dates on a regular basis. If the diary date has matured and no correspondence has been received the A3 should issue a minded letter (see 28.17).



If the applicant files a response before the diary expires send a message on PDAX to the Restorations Manager informing them that further documents have been received.

### Issuing the Offer to Restore Letter (Annex 3)

28.21 Once the Restorations Manager has decided to allow restoration the A3 will need to issue the 'offer to restore letter'.

- The A3 should take an OPTICS print (PRI RES)

This will show any fees due on this patent and will help in generating the offer letter. If any future fees are due use the Prose letter REST-11, if not use REST-12.

- Generate the offer letter using PROSE: When drawing up the letter, an automatic calculator will appear on screen. The OPTICS PRI RES report will show the details of unpaid fees. The starting year will be the 1<sup>st</sup> unpaid payment year. Fill in the details and then OK it. Issue a copy of the letter to the applicant.

PDAX ACTION:– Import the letter into PDAX

- Diary the application for 2 months. The proprietor can apply for a two month extension so the A3 should issue a reminder letter (Annex 3b) if no fees are received within the initial 2 month period. A diary should be made for two weeks after the expiry of this extended period.
- If the fees are not paid within 4 months, the application should be refused. The A3 should minute the Restorations Manager to inform them that the fees have not been paid and a refusal decision (Annex 8) needs to be issued.
- Once the refusal decision has been prepared and authorised by the B3 the Restorations Manager will send a copy of the decision to the A3 who will

issue it along with the letter (Annex 8a). The A3 will update OPTICS using REG RES – by entering the date of the Form 16, REFUSED, and the date of the decision. The A3 will then update the Exparte Post Grant SharePoint List and the case will be cleared.

### Drafting an Order

28.22 When renewal payments arrive the A3 will receive a PDAX message and a minute from Renewals section.

28.23 Using Word the A3 will compile an Order, including the Head of Litigation's electronic signature (Annex 6) allowing restoration. The A3 will ensure that any assignments or change of names are documented in the Order.

28.24 The A3 will issue a copy of the order to the applicant using the accompanying letter on PROSE – (REST 13). Make the relevant register entry (REC RES), clear the case records on the Exparte Post Grant SharePoint List and minute the file to Renewals Section for them to complete their actions.

PDAX ACTION:– Import a copy of the Order and send a message to RENEWALS section entitled PSM (date)

28.25 Once Renewals have completed their actions they will close the PDAX dossier down.

### Further evidence received

28.26 On receipt of further evidence from the applicant, the A3 should redact any signatures or personal e-mail addresses and message the Restorations Manager entitled 'New Docs'.

28.27 Deleted

28.28 Deleted

28.29 If further evidence is again required, the Restorations Manager will instruct the A3 to write again to the applicant. The A3 should diary the case for two months to await these documents.

28.30 If restoration is allowed on the basis of the new evidence filed, then follow the procedures in 28.16. If restoration is refused on the basis of the new evidence, a minded letter should be issued (see 28.17).

#### Various Stages of Refusal

28.31 As mentioned in 28.17 the application may be refused. In each instance, the minded letter needs to be issued stating the reasons for refusal.

28.32 If no further evidence is filed or the evidence still does not satisfy the Restorations Manager that restoration is allowable, a preliminary view letter should be issued by the A3 (see Annex 7). If a request for a Hearing is not filed in response to the preliminary view letter, a Refusal decision should be drafted and sent to the B3 for authorisation before being issued to the applicant by the A3 (see Annex 8). A covering letter (see Annex 8a) giving the applicant details of how to file an appeal should accompany the decision. The A3 should update OPTICS using REG RES to record the refusal and clear the case by updating the Exparte Post Grant SharePoint List.

PDAX ACTION:– Import both letters and the Refusal decision into PDAX

28.33 If the applicant requests a hearing, the A3 should minute the Hearings Clerk who will make the necessary arrangements.

PDAX ACTION:– Create a minute and send a message to the Hearings Clerk entitled PSM (date)

- 28.34 Following the Hearing a decision will be issued by the Hearings Clerk.  
PDAX ACTION:– The Hearings Clerk will import a copy of the decision into PDAX
- 28.35 The B3 will update OPTICS with the decision of the Hearing Officer and return the file to the A3 for further processing.
- 28.36 If the application is allowed the A3 should issue the offer to restore letter (see 28.21).
- 28.37 If the restoration is refused the Restorations Manager should update OPTICS using (REG RES) – **Register Restoration Decision** – by entering the filing date of the Form 16, REFUSED (upper case used) and today's date. The A3 should then clear the case by updating the Exparte Post Grant SharePoint List.
- 28.38 Deleted
- 28.39 Deleted

#### Withdrawal of the Application for Restoration

- 28.40 Withdrawal can occur at any point in the restoration process, but can only be instigated by the applicant or their agent.
- 28.41 When a request to withdraw is received an official letter should be sent to the applicant by the A3 confirming the application has been withdrawn (see Annex 9).  
PDAX ACTION:– Import the letter into PDAX
- 28.42 The date of withdrawal is the filing date of the applicant's/agent's correspondence.

28.43 The A3 will update OPTICS using (REG RES) – **Register Restoration Decision** – by entering the date of the Form 16, WITHDRAWN (using upper case), and the date which is the filing date of applicants/agents letter.

28.44 Deleted

28.45 Deleted

28.46 The A3 can now clear the case by updating the Exparte Post Grant SharePoint List.

### Refunds

28.47 The A3 will follow standard procedures when issuing refunds on applications for restoration.

28.48 Deleted

28.49 Deleted

28.50 Deleted

28.51 Deleted

28.52 Deleted

### Request for Confidentiality of Documents

28.53 Under rule 53 of the Patents Rules 2007, a request may be made to treat documents as confidential. This request must be made within 14 days of the document being filed.

28.54 Deleted

PDAX ACTION:– Ensure that all confidential documents that are scanned are set Not Open to Public Inspection and are annotated CONFIDENTIAL

28.55 On receipt of the request the Restorations Manager may be inclined to issue a holding reply. The Restorations Manager will then minute the file to the C2 with a recommendation concerning the request.

PDAX ACTION:- Create a minute in PDAX and generate relevant messages

28.56 Once a decision on the request has been taken by the C2, a minute will be placed on PDAX and sent to the Restorations Manager for action.

PDAX ACTION:– The C2 should create a minute in PDAX and send message entitled PSM (date) to the Restorations Manager

28.57 If the request is refused, the Restorations Manager will write to the applicant to inform them giving a period of one month for reply. The documents should be kept NOPI until this time period has elapsed.

PDAX ACTION:– Import the letter and create a minute in PDAX and diary the application for one month.

28.58 If no reply is received from the applicant, then the documents should be moved to the open part of the file.

PDAX ACTION:– Ensure that each document status is changed to Open to Public Inspection and the annotations of CONFIDENTIAL are removed

28.59 If further information is filed by the applicant, then the Restorations Manager should send the application to the C2 for further consideration of the refusal.

28.60 Where the C2 is in agreement that the documents should be kept confidential the following actions should be taken:

- COMPLETE DOCUMENTS

Each document should be annotated:

**This document has been made confidential under Rule 53 of the Patents Rules 2007**

The public status of these documents MUST always be set to NO as they are not open to public inspection.

**PART DOCUMENTS**

The original document should be duplicated.

The original document should then be annotated and its public status set to NO as is the case with complete documents.

The copy document with the relevant confidential extract deleted should be annotated:

**Part of the original document has been made confidential under Rule 53 of the Patents Rules 2007**

The copy document, with the confidential extract deleted, may be placed OPI.

[PDAX ACTION – Import the copy document into PDAX and set its status as Open to Public Inspection. Annotate the document to say that part of the document has been made confidential]]

- A confirmatory letter should be issued by the Restorations Manager confirming that the request for confidentiality has been allowed.

PDAX ACTION:– Import the letter into PDAX

Rule 107 Request to Re-instate the Application

28.61 If the Office has made an error when informing the applicant of the deadline for paying their renewal fees, then they may apply for re-instatement rather than restoration of their patent.

28.62 The applicant should write outlining the error they believe the Office has made. The Restorations Manager should investigate the sequence of events leading to the ceasing of the patent.

PDAX ACTION:– Arrange for letter to be added to PDAX

28.63 Once we are satisfied that re-instatement is applicable, a PDJ entry should be made immediately to close the 3<sup>rd</sup> Party Window and the 3<sup>rd</sup> Party Terms letter (see Annex 10) should be issued to the address for service.

PDAX ACTION:– Import the letter into PDAX

28.64 Make an entry on OPTICS (REG ENT) stating that a request for re-instatement is being considered.

28.65 The A3 should update the Exparte Post Grant SharePoint List to show re-instatement has been agreed by the office and diary the application for two months to await a response to the 3<sup>rd</sup> Party Terms Letter.

28.66 If no response is received to this letter, a further letter will be issued (see Annex 11) allowing a month for reply but warning that reinstatement will be withdrawn if no response is made. The A3 will wait a further 2 weeks to allow the proprietor to comply or request a hearing. If no response is received the A3 will update OPTICS and produce an advert for the PDJ to show the reinstatement has been withdrawn.

PDAX ACTION:– Ensure all letters are imported into PDAX

28.67 On receipt of a reply to the 3<sup>rd</sup> Party Terms letter, the Restorations Manager will check that acceptance is unequivocal. The A3 should check the minute from Renewals to ensure the correct fees have been paid.

PDAX ACTION:– Ensure that the letter is scanned into PDAX

28.68 The Restorations Manager should prepare the second 3<sup>rd</sup> Party terms letter (see Annex 12) to confirm the proprietor's agreement to the re-instatement of the patent. If there are monies outstanding edit the letter to include a reply date of 2 months in which to file these fees.

PDAX ACTION:– Import the letter into PDAX

28.69 Once all the outstanding fees have been paid, the Restorations Manager should make a free text entry on OPTICS (REG ENT) to update the register



stating that a request for re-instatement has been allowed. An email should also be sent to Publishing containing details of the PDJ entry to be placed in the next available journal.

PDAX ACTION:- Minute Renewals section to update Optics and issue renewal certificate

28.70 Deleted

28.71 The Restorations Manager should ensure that the patent is placed back 'in force' on OPTICS. Use the CHA CAS function, choose number 2 'bibliographic and register info' and then option 3 'status information'. The Restorations Manager will then delete the information out of the 'reason not in force' and the 'date not in force' boxes and press return. The patent will then be back in force.

28.72 Deleted

## ANNEX 1

**Your reference:**

**Our reference:**

Date

Dear Sirs

**Ceased Patent Number:**

**Advice on Filing an Application for Restoration under Section 28 of the Patents Act 1977**

### Filing your application

1. In response to your enquiry of **(DATE)** regarding the possibility of restoring the above ceased patent, I enclose copies of the relevant section of the Patents Act 1977 and rules governing procedure from the Patents Rules 2007. I also enclose our leaflets Restoring your Patent and Evidence.
2. An application for restoration must be filed within 19 months from the ceasing date. In this case, the last date on which such an application may be filed within the period allowed is **(DATE)**. To file an application what you need to do is complete Patents Form 16 and send this to us with the fee (£135). You should also send us evidence to support your application.
3. You should also tell us, if you can, what happened to the official overdue reminder (PREN5) issued to you on **(DATE)**. (Any evidence sent to the Office in a language other than English or Welsh should be accompanied by a translation which is verified as accurate).

### Third Party Terms

4. Once a Form 16 is received, the application is published in the Patents and Designs Journal - this usually occurs within four weeks of receipt. Section 28A (4) to (6) of the act gives protection to third parties who take steps to work an invention which is the subject of a lapsed patent before notice of an application for restoration is published. They are free to continue what they have started without infringing the restored patent, but they are prevented from licensing others to work the invention. However, this protection does not apply to steps taken during the six months period of grace under section 25(4) in which late renewal is still possible.
5. Once you have filed your application for restoration and it has been advertised

in the Patents & Designs Journal, these third party rights are suspended. This means that from that date no-one can then take steps to work your invention without your permission. If your application is subsequently refused, third party rights will be reinstated; if the application is allowed, they will remain suspended.

6. Section 28(3) of the Act states that restoration can only be offered if the proprietor of the patent can satisfy the Comptroller that failure to pay the renewal fee was an unintentional act.
7. The evidence which you supply may not in itself be sufficient to allow the Comptroller to reach a view on your application. If this is the case, you may be asked, to provide further evidence. When all the evidence has been presented and assessed the Comptroller will either reject the application, with the offer of a hearing, or will make an offer of restoration. The terms of that offer will be that all outstanding renewal fees are paid. The offer will also be subject to such terms as the office considers appropriate.
8. It is always advisable to consult a patent attorney, or solicitor familiar with patent matters, before deciding whether to proceed with an application. The Office can inform you about procedural matters but cannot give advice on a specific case as this would compromise our decision making role.
9. If you would like further information, please contact me.

Yours faithfully

**(NAME)**  
Patent Restorations Officer

ANNEX 1a

**(Case Officers Name)**

Ref: **XXX/XX**

**Application for restoration of lapsed patent**

Filing date of 16: XXXXXX

Patent No: XXXXXXXX

Applicant: XXXXXXXXXXXXXXXXXXXXX

Attorney: XXXXXXXXXXXXXXXXXXXX

Date of Lapse: XXXXXX

Year of lapse: XX

Pren 5 issued on: XXXXXX

Cea1 issued on: XXXXXX

Application for restoration due by: XXXXXX

Application to restore advertised in Journal number: **XXXX** Dated:  
XXXXXX

**(Your Name)**

(Date)

**ANNEX 1b**

**Your reference:**  
**Our reference**

(Date)

Dear Sirs

**Patents Act 1977: Patents Rules 2007**  
**Application for Restoration of Patent No. XXXXXXXXXXXX**

1. Thank you for your application to restore the above patent. In order for the application to be considered further you must file written evidence explaining why the renewal fee was not paid within the prescribed period (XXXXXXXXXXXX to XXXXXXXXXXXX).
2. Section 28(3) of the Act states that restoration can only be offered if the comptroller is satisfied that the failure of the proprietor to pay the renewal fee was 'unintentional'.
3. The evidence which you supply in the first instance may not, in itself be sufficient to allow the comptroller to reach a view on your application. You may be asked therefore to provide further evidence to elaborate on the information that you have provided. You may also be asked to provide information in respect of other matters that appear relevant to the assessment being undertaken. When all the evidence has been presented and assessed, the Comptroller will either reject the application with the offer of a hearing, or will make an offer of restoration. The terms of that offer will be that all outstanding renewal fees are paid.
4. A period of **two months from the date of this letter (XXXXXXXXXX)** is allowed for your response.
5. If you require any further information, please contact me.

Yours faithfully

XXXXXXXXXXXXXXXXXXXXX  
Patent Restorations Officer

## ANNEX 2

**Your reference**  
**Our reference**

(Date)

Dear Sirs

**Patents Act 1977: Patents Rules 2007**  
**Application for Restoration of Patent No. XXXXXXXXXXXXXXX**

1. Thank you for your application to restore the above patent. However, your application has been filed outside the period set out in rule 40(1) of the Patents Rules 2007.

2. For restoration to be considered, your application should have been filed by XXXXXXXXXXXXXXX, that is, 13 months from the last day it was possible for you to pay your renewal fee.

3. Unfortunately as this date has passed, there is no other way of restoring the patent as rule 40(1) is not extendable.

4. A period of one month from the date of this letter is allowed for any comments you wish to make or for you to request a hearing in front of a senior officer regarding this matter. If nothing further is received from you within this period I will arrange for a refund of the £135 fee that you have paid.

Yours faithfully

XXXXXXXXXXXXXXXXXXXXX  
Patent Restorations Officer

## ANNEX 3

**Your reference:**  
**Our reference:**

(Date)

Dear Sirs

**Ceased Patent No: XXXXXXXXX**  
**Application for Restoration under Section 28 of the Patents Act 1977**

1. Your application for restoration of the above patent has been allowed subject to payment of the outstanding renewal fees for the Nth year(s). The fees required, on separate Patent Form 12's, are £xx for the Nth year, and £xx for the Nth year, making the total due £xxx. The above fees should be received by us by (insert date of issue of letter plus two months).
2. You should note that an Order for restoration gives certain rights to third parties in accordance with the terms prescribed under Section 28A of the Patents Act 1977.
3. Section 28A (4) to (6) gives protection to third parties who take steps to work an invention which is the subject of a lapsed patent before notice of an application for restoration is published. They are free not only to continue what they have started without infringing the restored patent, but also to pass their right to work the invention to others (but not to license others to work the invention). However, this protection does not apply to steps taken during the six months period of grace under section 25(4) in which late renewal is still possible.
4. Applying the contents of section 28A(4) to this patent, you should note that from XXXXXXXXX until XXXXXXXXX protection for third parties will apply.

Yours faithfully

XXXXXXXXXXXX  
Patents Restorations Officer

## ANNEX 3b

**Your reference:**

**Our reference:**

(Date)

Dear Sir(s)

### REMINDER

**Ceased Patent No: XXXXXXXXX**

**Application for restoration under Section 28 of the Patents Act 1977**

1. My letter dated XXXXXX informed you that your application for restoration of patent number (patent number) had been allowed subject to payment of the outstanding renewal fees of £XXX
2. You were asked to pay this fee by (DATE); however it would appear that you have not done so.
3. If you still intend to pay the outstanding renewal fee, it is possible for us to grant you an extension of a further two months in which to do so. If you would like us to do this, you need to put your request in writing and send it to us as a matter of urgency.
4. The consequences of failing to request an extension of time and paying the outstanding fee are set out below.

### **Failure to request an extension and pay the renewal fee**

5. If you do not request an extension of time and do not pay the outstanding fee, your application for restoration will be refused by an official decision. This means that we will be unable to accept any subsequent payment of the renewal fee.
6. Should you still wish to pay the fee, you will need to file an appeal at the Patents Court. An appeal may cost you a lot of money and take up a great deal of your time. Costs, which may be large, are also normally awarded against the unsuccessful party.
7. You should note that no further reminder will be issued by the Office. However should you require any additional information relating to restoration of patent number XXXXXXXXX, please contact me.

Yours sincerely

XXXXXXXXXXXXXXXXXX

Patent Restorations Officer



## ANNEX 4

**Your reference**  
**Our reference**

(Date)

Dear Sirs

**Patents Act 1977: Patents Rules 2007**  
**Application for Restoration of Patent No**  
**XXXXXXXXXXXXXX**

1. I refer to the evidence filed in support of your application for restoration of (patent number). The evidence has been considered but it is the preliminary view of the Office that the application should be refused.
2. For restoration to be allowed, the applicant has to show that failure to pay the renewal fee was unintentional. The evidence filed shows XXXXXXXXXXXXXXXXXXXX. Thus the failure to pay the renewal fee was as a result of a conscious decision, and the decision could not be said to be unintentional.
3. I should advise you that this view is based upon the evidence provided so far. It may be that you feel that other factors need to be considered. If this is the case, please send us any further evidence within one month of the date of this letter.
4. If you require any further information, please contact me.

Yours faithfully

XXXXXXXXXXXXXXXXXX  
Patent Restorations Officer



## ANNEX 6

**PATENTS ACT 1977**

(MONTH & YEAR)

APPLICANT

(APPLICANT NAME)

ISSUE

Whether Patent (NUMBER) should be restored  
under Section 28

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### ORDER TO RESTORE

- 1 Patent number (NUMBER), filed on (FILING DATE), ceased to have effect on (DATE PATENT CEASED) through failure to pay the renewal fee for the (YEAR MISSED) year by that date or during the six months allowed under section 25(4) upon payment of the prescribed additional fees. On (DATE APP FOR RESTORATION WAS FILED), (APPLICANT NAME) applied to have this patent restored.
  
- 2 Having examined the evidence filed in support of the application, I am satisfied that restoration should be allowed. All fees required by Rule 36(4) of the Patents Rules 2007 have now been paid. I therefore order that the patent shall be restored under section 28.

**XXXXXXXXXXXXXXXXXX**

Restoration Manager  
Acting for the Comptroller

## ANNEX 7

Your reference

Our reference

(Date)

Dear Sirs

**Patents Act 1977: Patents Rules 2007**  
**Application for Restoration of Patent No. XXXXXXXX**

1. I refer to my letter of (DATE) in connection with the above mentioned restoration application. In that letter I advised you that it was the preliminary view of the Office that the application for restoration should be refused. You were invited to submit any additional evidence which might add weight to your argument by (DATE).
2. That deadline has now passed and no further evidence has been submitted. Accordingly, I am writing to confirm that, for the reasons given in my letter of (DATE) (copy attached) a sufficient case for restoration has not been made out.
3. This is a preliminary view. However, the application for restoration will be finally refused unless, within one month of the date of this letter, a formal request is made to this Office for a hearing. A hearing is your chance to present oral arguments in person to one of our senior officers known as a hearing officer. The hearing officer will consider the arguments carefully and will issue a formal decision which is appealable to the Patents Court. If you would like the Office to arrange a hearing you should let me know before (DATE).
4. Please contact me if you would like to discuss any matters raised in this letter.

Yours faithfully

XXXXXXXXXXXXXXXXXXXXX  
Patent Restorations Officer

**ANNEX 8**

**PATENTS ACT 1977**

BL Number  
(DATE)

APPLICANT XXXXXXXXXXXXXXXX

ISSUE Whether patent number  
XXXXXXXXXXXX should be restored under  
section 28(3)

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**DECISION**

- 1 The renewal fee in respect of the X<sup>th</sup> year of the patent fell due on (DATE). The renewal fee was not paid by that date or during the six months allowed under section 25(4) of the Patents Act 1977 upon payment of the prescribed additional fees. The patent therefore lapsed on (DATE).
- 2 The patent was originally filed in the name of XXXXXXXXXXXXXXXX. It was assigned to XXXXXXXXXXXXXXXX by virtue of an assignment dated (DATE). On (DATE), XXXXXXXXXXXXXXXX filed an application for restoration of the patent.
- 3 In an official letter dated (DATE), the Office set out its preliminary view that the application should be refused. The Office took the view that the evidence filed indicated that the patent proprietor ..... etc. As such, the failure to pay the renewal fee could not be said to be unintentional.
- 4 The applicant for restoration filed further evidence on (DATE). Having considered the additional evidence filed, the Office maintained its preliminary view in a letter dated (DATE). The applicant was also informed that the application for restoration would be refused unless a hearing was requested.
- 5 No response has been received from the proprietor. Consequently I now refuse the application for restoration as I consider that the requirements laid down in section 28(3) of the Patents Act 1977 have not been met.

March 2016

## **Appeal**

- 6 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

**XXXXXXXXXXXXXXXXXX**  
B3 Head of Litigation Section  
Acting for the Comptroller

## ANNEX 8a

**Your reference:**

**Our reference:**

Date

Dear Sirs

**Patent Number : GB/EPXXXXXX (Proprietor)**

**Reference under Section XXX of the Patents Act 1977**

1. Please find enclosed a copy of a decision dated xxXXxx.
2. As the decision has been in your favour, the application has been remitted to the examiner or other relevant case officer who will be in contact with you as required.

OR

2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).
3. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the current fee within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
4. Once you have filed your appeal, you must send a copy of the sealed Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

A letter in identical terms is being sent to the other side.(delete as required)

Yours faithfully

Name (Hearings Clerk)  
Litigation Section  
Patents Directorate

## ANNEX 9

**Your reference**

**Our reference**

(Date)

Dear Sirs

**Ceased Patent No: XXXXXXXX**

**Application for Restoration under Section 28 of the Patents Act 1977**

1. Further to your letter dated XXXXXXXX, I can confirm that your application for restoration has been withdrawn.

Yours faithfully

XXXXXXXXXXXXXXXXXX  
Patent Restorations Officer



## ANNEX 10

**Your reference**  
**Our reference**

(Date)

Dear Sirs

**Patents Act 1977: Patents Rules 2007**  
**Patent No XXXXXXXXX**

1. I refer to your application for re-instatement of the above patent.
2. I have investigated the circumstances in which your patent lapsed and have identified an error in Office procedure in that XXXXXXXXXXXXXXXXXXXXXXXX. Because of this error you did not receive our renewal reminder letter in time for you to renew your patent.
3. Please accept my sincere apologies for this error. However, I am pleased to advise you that the comptroller is prepared, to exercise discretion under rule 107 of the Patents Rules 2007 and will reinstate the patent subject to the following.
4. The patent was advertised as ceased, in the Patents Designs Journal (PDJ) on XXXXXXXXXX, consequently the terms set out below are considered necessary.
  - (i) If between XXXXXXXXXX (i.e. the date on which the patent was announced as ceased in the PDJ) and XXXXXXXXXX (i.e. the date on which an application for restoration was announced in the PDJ, a person-
    - (a) began in good faith to do an act which would constitute an infringement of the patent if it had not been treated as ceased by virtue of Section 25(3) of the Act, or.
    - (b) made in good faith effective and serious preparations to do such an act.he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding the re-instatement of the patents; but this does not extend to granting a licence to another person to do the act.
  - (ii) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by sub-paragraph (i) above may –
    - (a) authorise the doing of that act by any partners of his for the time being in that business, and

- (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations made.
- (iii) Where a product is disposed of to another in the exercise of the right conferred by sub-paragraph (i) or (ii) above, that other and any other person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.
- (iv) The above provisions apply in relation to the use of a patent for the services of the Crown as they apply in relation to the infringement of the patent.
5. If you accept the terms, you should inform us in writing within **two months of the date of this letter, that is by (DATE)**.
6. If you do not accept the terms, you should request a hearing. This gives you the chance to explain your case in person to one of our senior officers known as a "hearing officer". The hearing officer is independent and will look at all sides of the argument before making the final decision about the case.
7. **You also need to pay the outstanding renewal fee of £XXX for the X<sup>th</sup> year.** Please note that it is now also possible to pay the X<sup>th</sup> year renewal fee of £XXX which is due on XXXXXXXXXXXX. I have enclosed two copies of a Form 12 with this letter should you wish to make both payments at this time.
8. If you would like to discuss any of the points in this letter, please contact me.

Yours faithfully

XXXXXXXXXXXXX  
Patent Restorations Manager

## ANNEX 11

**Your reference**  
**Our reference**

(Date)

Dear Sirs

**Patents Act 1977: Patents Rules 2007**  
**Patent No XXXXXXXXXX**

1. Please find attached a copy of the letter sent to you on XXXXXXXXXX. As you will have noticed, the deadline for responding has now passed and we have yet to hear from you regarding this matter.
2. Please file a response by XXXXXXXXXX otherwise the reinstatement of your application will be refused.

Yours faithfully

XXXXXXXXXXXXX  
Patent Restorations Manager

## ANNEX 12

**Your reference:**  
**Our reference**

(Date)

Dear Sirs

**Patents Act 1977: Patents Rules 2007**  
**Patent No XXXXXXXXXX**

1. Thank you for your letter of XXXXXXXXXX confirming you have accepted the terms for re-instatement of the patent set out in my earlier letter of XXXXXXXXXX. These terms are set out again below:
  2. As the patent was advertised as *ceased*, in the Patents Designs Journal (PDJ) on XXXXXXXXXX, consequently the terms set out below are considered necessary.
- (v) If between XXXXXXXXXX (i.e. the date on which the patent was announced as ceased in the PDJ) and XXXXXXXXXX (i.e. the date on which an application for restoration was announced in the PDJ), a person-

(c) began in good faith to do an act which would constitute an infringement of the patent if it had not been treated as ceased by virtue of Section 25(3) of the Act, or.

(d) made in good faith effective and serious preparations to do such an act.

he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding the re-instatement of the patents; but this does not extend to granting a licence to another person to do the act.

- (vi) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by sub-paragraph (i) above may –

(c) authorise the doing of that act by any partners of his for the time being in that business, and

(d) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations made.

- (vii) Where a product is disposed of to another in the exercise of the right

conferred by sub-paragraph (i) or (ii) above, that other and any other person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

- (viii) The above provisions apply in relation to the use of a patent for the services of the Crown as they apply in relation to the infringement of the patent.
- 3. I will now arrange for the patent to be reinstated on the Register of Patents and the X<sup>th</sup> and X<sup>th</sup> year annuities to be processed.
- 4. If you would like to discuss any of the points in this letter, please contact me.

Yours faithfully

XXXXXXXXXXXXX  
Patent Restorations Manager

## ANNEX 13

**Your reference**  
**Our reference**

(DATE)

Dear Sir

**Ceased Patent No: EPXXXXXXX**  
**Application for Restoration under Section 28 of the Patents Act 1977**

**Latest date for reply: xxXXxx**

1. Thank you for your email/letter dated xxXXxx. I am pleased to confirm that under rule 109 of the Patents Rules 2007 a further extension of two months has been granted to file evidence.
2. Please file the requested evidence by xxXXxx.

Yours faithfully

Name  
Patents Restorations Officer

## ANNEX 14

**Our reference:**  
**Your reference:**

(Date)

Dear Sir

**Ceased Patent No: EPXXXXXXX**  
**Application for Restoration under Section 28 of the Patents Act 1977**

**Latest date for reply: xxXXxx**

1. With regards to our recent telephone conversation on xxXXxx in which you requested a further extension of time, I am pleased to confirm that a further extension of time has been granted to file evidence.
2. Please file the requested evidence by xxXXxx.

Yours faithfully

Name  
Patents Restorations Officer

## CHAPTER 29

### SECTION 74A REQUESTS FOR OPINIONS

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## Annexes

### Annex 1 Opinions letters

## **29 REQUEST FOR AN OPINION UNDER SECTION 74A**

### **INTRODUCTION**

29.01 This section is concerned with requests for opinions made under section 74A of the Patents Act 1977. A request can be made for a non binding opinion relating to infringement or validity of a granted patent or a Supplementary Protection Certificate under section 74A(1). The request can be made by any person and the detailed provisions are set out in The Patents Rules 2007 Part 8, section 74A of the Manual of Patent Practice and the Opinions Service Manual. An opinion is usually issued no more than 3 months after a request is made.

### **MAKING A REQUEST**

29.02 For requests for an opinion under section 74A the requester should file Patents Form 17 together with a £200 fee. If the opinion is requested in respect of more than one patent or Supplementary Protection Certificate (SPC), then a separate Patents Form 17 will be required for each patent/SPC number. It is possible to request an opinion where a patent has expired or has been surrendered.

### **DELIVERY OF REQUESTS**

29.03 Requests should be delivered in paper format to the office accompanied by the relevant fee.

29.04 Where a request is filed by email, no action should be taken until the original documentation with fee receipt is received.

## INITIAL ACTIONS

### A3 Duties - Initial actions

29.05 On receipt of a request for an opinion the A3 should:

- Arrange for the Form 17 and supporting documentation to be forwarded to the electronic dossier. If the case is not electronic the A3 should, in the case of a GB patent, request the file from NMP and refer the case to Index and Scanning using the “Request for Index & Scanning” sheet. If the request for opinion relates to an EP case where an existing EP paper case already exists, this is requested from NMP and scanned onto the dossier along with the request to Index and Scanning section. If no paper file exists, a BDOC can be imported from espacenet using:

[http://worldwide.espacenet.com/singleLineSearch?locale=en\\_EP](http://worldwide.espacenet.com/singleLineSearch?locale=en_EP)

The document is then imported onto the dossier along with the request for opinion.

If the request relates to a Supplementary Protection Certificate, the SPC file will be retrieved from the SPC section and the front cover of the file will be marked to show that an opinion request has been filed. The dossier for the patent upon which the SPC is based will be used for the purposes of the opinion request. Patents Form 17 will be sent to Index and Scanning section along with supporting documentation for scanning to the relevant EP or GB dossier.

## A3 Duties – Formalities checks

29.06 Upon receipt the A3 carries out formalities checks to ensure that the relevant patent rule has been complied with (rule 93).

The request for an opinion is checked by the A3 to ensure:

- The correct fee (currently £200) has been received.
- The patent or SPC number quoted on Form 17 corresponds with that referred to in supporting documents. If the request relates to an EP patent (or an EP patent forms the basis of an SPC request), Optics is to be checked to ensure that the EP patent designates GB.
- The Supplementary Protection Certificate has not expired (SPC's are granted for up to 5 years duration, the SPC file should therefore be checked to ensure the SPC has not expired).
- Requester contact details are clearly stated
- Form 17 proprietor details quoted are as shown on OPTICS register
- Supporting documents should be checked and clearly specify the grounds for the request.
- Current address for service is provided in the UK, an EEA state or the Channel Islands,
- Documents referred to in the supporting statement have been submitted
- Form 17 has been signed
- All documents have been filed in duplicate (including Patents Form 17), one set to be retained in Litigation section
- Identify whether any documents filed are copyright protected
- For Infringement requests, details of potential infringers have been included eg. contact details etc

- Check pre-grant part of the dossier/SPC file for any caveat that may be filed and require action. If caveat filed, notify the caveat section/SPC section.

## **FORMALITIES NOT COMPLIED WITH**

### Fee not paid

29.07 If the fee (currently £200) has not been paid the A3 will contact Finance to check whether the fee has still not been received and then contact the requester by telephone or letter to advise that the request cannot proceed until payment is made and receipt confirmed. An appropriate minute should be made on PDAX.

### Patents Form 17 not signed

29.08 Where the Patents Form 17 is not signed but an accompanying letter has been signed, this can be accepted. However, if there is no accompanying letter the Form should be returned for signature or a signed copy requested. An appropriate minute should be imported into dossier.

### Patents Form 17 details incomplete/incorrect

29.09 Should any details on the Form 17 be incorrect, the A3 should telephone the requester and explain the nature of the query. Form details can be corrected with the consent of the requester using the Enhance function in PDAX.

### Copies of documents

29.10 Copies of any documents referred to in the request, but not supplied, should be obtained. If any of the documents referred to are not available in the Office, the applicant should be asked to supply copies in accordance with rule 93(4) of the Patent Rules 2007, before the request can proceed.

### Documents supplied copyright protected

29.11 Where the requester has referred to and supplied documents with the request which appear to be potentially copyright protected, the documents should be assessed to ascertain their status. Should they be deemed to be copyright protected, they should be marked as NOPI on the dossier. It should be noted that generally websites requiring subscription for access will be considered copyright protected. Copies of the copyrighted documents provided by the requester are sent to the interested parties, however they will not appear on IPSUM. The copyright proforma sheet will be prepared highlighting the relevant links or documents which will be available on IPSUM.

### **REFERRING THE REQUEST**

29.12 The A3 refers the request for an opinion to the Senior Opinions examiner/SPC examiner and should also advise of any previous opinion issued in respect of the patent/SPC in question.

The Senior Opinions examiner/SPC examiner will advise whether the opinion request is in order to proceed and will identify the opinions examiner and mentor allocated to deal with the request.

### **FORMALITIES COMPLIED WITH – REQUEST PROCEEDING**

#### Additional actions – A3 Duties

29.13 Once all formalities have been complied with, the A3 will undertake the following additional actions:

- Ensure that any physical exhibit(s) filed with the opinion request are entered onto the PDAX dossier, annotating the Opinion Request as “A physical exhibit held in 1R31”. The exhibit(s)

should also be recorded on Litigation section using the Opinion exhibits log book.

- Access the Opinions database to request a new opinion record. The database will automatically generate the new case number and the A3 will enter the examiner's and Mentor's names.
- Enter the relevant details of each party by selecting the relevant role from the drop down menu. Parties to include all licensees listed on the Patent register and any caveatees (as detailed on the front cover of the dossier).
- Print out the Litigation Opinion card from the Opinions database
- Collate the initial opinions advert and save in Opinions Administration on SharePoint . The advert should be sent to Webmaster for uploading to the Opinions webpage.
- Access OPTICS and enter opinion request using REG ENT.

For a request relating to a patent:

"Request for an opinion under section 74A filed on...(date)..."

For a request relating to a SPC:

"Request for an opinion under section 74A in respect of SPC/XXXX/XXX filed on...(date)..."

- Access the dossier and ensure all relevant redaction has been applied in order to appear on IPSUM. It should be noted that documents will appear on IPSUM provided:

Correct document codes are used:

OPIN-REQ – Opinion Request

OPIN-REQ-ATT – Opinion Attachment

OLFI annotation has been applied and documents are set as 'public'

Black and white copies of any colour documents have been scanned to dossier and the black and white copy annotated OLFI and redacted for IPSUM purposes.

- Update the Current Situation on Live Opinions summary table.

## **OBSERVATIONS**

### Inviting Observations

29.14 A copy of the request for an opinion is sent to various interested parties who are then invited to file observations within the set time period (4 weeks) should they wish. The opinion request is sent to the following parties:

- the proprietor of the patent/SPC (if they are not the requester)
- any holder of a licence or sub licence (refer to OPTICS)
- any person who has requested a caveat relating to an opinion request (refer to front cover of dossier for caveatee details)
- any parties identified by the requester who the requester is aware may have an interest
- any person who appears to be likely to have an interest in the question upon which the opinion is sought (refer to request documentation and check OPTICS)

It should be noted that Exclusive licensees and non-exclusive licensees should be treated in the same way as patent proprietors. Any exclusive licensee and non-exclusive licensee should be sent copies of any documents sent to the patent proprietor. They will also have the right to file observations in reply. In very rare instances it will be possible to have more than one exclusive licensee on the same patent.

Extra care must be taken where details of more than one licensee will have been entered on the Register. The wording of some letters will need to be altered to show that more than one licensee is involved. Refer to the Senior Opinions examiner for guidance.

29.15 To invite the parties to file observations, the A3 should:



- Access the Opinions database to generate the relevant letters depending upon the status of the parties in accordance with the list of letters shown in Annex 1 as follows:
- Letter OL1a, b, or c will be issued to the requester.
- Letter OL2a, b, or c to the other parties.
- A copy of the Patents Form 17, statement and any attachments to the statement should be sent to anyone invited to file observations. The A3 should ensure that the documentation has been redacted accordingly (account details; personal signatures etc)
- The A3 will import all letters generated to the PDAX dossier and prepare the dossier for IPSUM.
- Where the request relates to an SPC, the A3 will amend the letter headings as appropriate.

#### Referring the case to the opinions examiner

29.16 An Outlook task will be set for the opinions examiner and mentor indicating the date the opinion is due to be issued.

#### Observations Filed

29.17 Observations can be filed electronically via email to [opinions@ipo.gov.uk](mailto:opinions@ipo.gov.uk) and should be copied to the requester and any exclusive licensee. Upon receipt of observations the A3 will undertake the following actions to acknowledge receipt of observations:

- Where observations are filed electronically, forward the email and attachments to the opinions examiner and transfer the email and attachments to the dossier.
- Update the Opinions record card to show observations received.
- Update the current Opinions summary table.
- Redact and prepare the dossier for IPSUM

29.18 The A3 will acknowledge receipt of observations and invite observations in reply as follows:

- Access the opinions database and locate the record of the party who has filed observations. On this record, change the status of the party to “Observer”.
- Using the Opinions database generate the relevant letters depending upon the status of the parties in accordance with the list of letters shown in Annex 1.
- Letter OL03a, b, or c will be issued to the observer.
- Letter OL04a, b, c or d will be issued to invite observations in reply, together with a copy of the OL03a, b or c. The proprietor and requester should both be invited to file observations in reply (if the proprietor is not the requester).
- The A3 will import all letters generated to the PDAX dossier using suitable annotation and doc code ‘LETTER-LIT’.
- Prepare the dossier for IPSUM.
- Doc Codes: OPIN-OBS for Opinion Observations and OPIN-OBS-ATT for Observation attachments
- Where the request relates to an SPC, the A3 will amend the letter headings as appropriate.

It is essential that where the observer is the proprietor, the A3 accesses the opinions database to identify the record for this party **to alter the status back to “Proprietor”**. This will ensure correct content of subsequent letters and/or opinion to this party.

#### No observations filed

29.19 In the event that no observations are filed the A3 will undertake the following actions:

- Email the examiner to advise no observations filed and that he can now proceed to prepare the opinion and transfer mail to PDAX dossier.
- Mark the Opinions record card “No observations filed” and date and initial.
- Update the current Opinions summary table.

29.20 It should be noted that where no observations have been filed, observations in reply are not applicable and the opinion examiner can proceed to prepare the opinion.

## **OBSERVATIONS IN REPLY**

29.21 Any person to whom observations are sent are eligible to file observations strictly in reply. When several interested parties have been identified during proceedings, it is therefore possible to receive more than one set of observations in reply. Observations in reply can be filed electronically via email to [opinions@ipo.gov.uk](mailto:opinions@ipo.gov.uk) and should be copied to the proprietor, requester and any exclusive licensee. The A3 will undertake a daily check to ensure timely referral of any correspondence upon receipt. As this is the final stage of observations it is essential that when observations in reply are filed they should be sent to the opinions examiner **without delay** to ensure sufficient time is allowed for the examiner to prepare the opinion.

### Observations in reply filed

29.22 Upon receipt of observations in reply the A3 will undertake the following actions:

- Where observations in reply are filed electronically forward the email and attachments and blank opinions template to the opinions examiner and transfer the email and attachments to the dossier.

- Update the Opinions record card to show observations in reply received.
- Update the current Opinions summary table.
- Prepare the dossier to appear on IPSUM Doc Codes: OPIN-OBS-REP for Observations in Reply and OPIOBSRE-ATT for Observations in Reply attachments

29.23 The A3 will acknowledge receipt of observations in reply as follows:

- Letter OL05 will be issued to acknowledge receipt of observations in reply to the sender.
- The A3 will import letter generated to the PDAX dossier using Doc Code LETTER-LIT and prepare the dossier to appear on IPSUM
- Where the request relates to an SPC, the A3 will amend the letter headings as appropriate

Note: Observations in reply are not served to any other party (the party filing the observations in reply is required to copy the proprietor and any exclusive licensee)

#### Referring observations in reply to the opinions examiner

29.24 An email is sent to the Opinions examiner to let them know that Observations in reply have been filed and that they can proceed to prepare the Opinion.

#### No observations in reply filed

29.25 At the expiry of the two weeks period for filing observations in reply, the opinion examiner will be looking to issue the opinion within six weeks. It is essential therefore to ensure that where no observations in reply are filed the examiner is notified without delay. The A3 should therefore take the following action:

- Email the opinion examiner to advise that no observations in reply have been filed and transfer the email to the dossier.
- Update the Opinions record card to show that no observations in reply have been filed.
- Update the current Opinions summary table.

The A3 should issue a reminder email to the Opinions examiner 2-3 days prior to the due date.

## **OPINION ISSUE**

29.26 The opinions examiner will prepare the opinion using a word template. The opinions examiner will send the opinion by email or PDAX message to litigation section requesting issue and will confirm whether OL20 or OL21 is appropriate to accompany the opinion.

## **A3 ACTIONS UPON RECEIPT OF OPINION**

29.27 On receipt of confirmation email from the examiner, the A3 should undertake the following actions:

- Insert today's date on the opinion
- Save an unsigned copy of the document to SharePoint in both PDF and Word formats. This version will be used for internal circulation.
- Apply the opinion examiner's electronic signature
- Save a signed copy of the document to SharePoint in both PDF and Word format. This version will be used for circulation to the requester, proprietor and any observers.
- Enter date of opinion issue on opinion database
- Generate either OL20 or OL21 as directed by the opinions examiner for issue with the signed PDF hard copy of the opinion.
- Where the request relates to an SPC the A3 will amend the letter headings as appropriate

- Update OPTICS with a free text entry to read as follows:  
For a request relating to a patent:  
“Request for an opinion under section 74A filed on...(date)....issued on ....(date).”  
  
For a request relating to an SPC:  
“Request for an opinion under section 74A in respect of SPC/XXXX/XXX filed on...(date)..issued on (date).”
- Update the opinions record card to show date opinion issued.
- Produce final website advert to advise outcome of opinion request and send to Webmaster with unsigned PDF version of opinion document.
- Circulate the unsigned PDF opinion document to the Opinions group by email (see current circulation list). There is a copy available on SharePoint.
- Create a file note for the dossier to show all records cleared.
- Upload the final website advert to PDAX dossier (doc code: ADVERT) together with the OL20 or OL21 letters (doc code: LETTER-LIT). The unsigned opinion should be uploaded to the dossier using doc code OPINION-LIT.
- Update the dossier so that all documentation appears on IPSUM.
- Update the Current Situation on Live Opinions summary table.
- For patent opinion requests ONLY where an opinion has been issued which concludes that the patent clearly lacked novelty or inventive step revocation action under Section 73(1A) may be initiated following the expiry of the Section 74B Opinion Review period. (See Chapter 32 for procedures to be followed). Set a suitable diary date if applicable.

## **PRELIMINARY REFUSAL OF A REQUEST FOR AN OPINION**

29.28 The Senior Opinions examiner/SPC examiner may wish to issue a preliminary view that the request for an opinion is refused, under certain

circumstances, for example when the issue in question has been decided before. This view may be taken prior to or following, the placement of the website initial advertisement notifying that the request has been filed.

29.29 The Senior Opinions examiner/SPC examiner will advise the A3 of the Office's preliminary view to refuse the request giving the reasons for this view. The requester will be given a date to provide comments regarding the preliminary view and the opportunity to ask to be heard on the matter.

The A3 will undertake the following actions:

- Access the Opinions database to generate opinion record.
- Issue letter OL06a or b as appropriate inserting the text setting out the reasons for the view as provided by Senior Opinions examiner.
- If appropriate, send letter OL06c with a copy of OL06a to the proprietor (unless they are the requester) advising them of the preliminary view.
- If requested by The Senior Opinions examiner/SPC examiner, compose a refund letter and send this to the Head of Litigation for approval. The letter is then sent to Finance, who will arrange a refund of the £200 filed with Patents Form 17.
- The A3 will import letters generated to the PDAX dossier via Manual Import and prepare the dossier for IPSUM
- Where the request relates to an SPC the A3 will amend the letter headings as appropriate.

29.30 Any correspondence arising from the requester should be referred to the Senior Opinions examiner/SPC examiner. It is possible that the Senior Opinions examiner/SPC examiner may wish to issue a response to the correspondence received by the requester. The requester may ask to be heard on the matter and in this event the A3 should notify the Senior Opinions examiner/SPC examiner and liaise with the Litigation Manager (Opinions) and Litigation Section Hearings Clerk accordingly so that

arrangements can be made.

- 29.31 It should be noted that in cases where a request includes several grounds the Senior Opinions examiner/SPC examiner may issue a preliminary refusal in relation to only one of the areas. Where this is the case the content of letters should be checked carefully before issue.

## **DECISION ISSUED – REQUEST REFUSED**

- 29.32 Following a hearing or decision on the papers, the Litigation Section Hearings Clerk will issue any Office decision arising which refuses a request for an opinion. The Hearings Clerk will import the decision and cover letter to the PDAX dossier. The Hearings Clerk will diary the expiry of the appeal period and will notify the A3 Opinions/ex parte Clerk accordingly.

The A3 will undertake the following actions following the expiry of the appeal period:

- Issue OL07 to the patent proprietor for information unless the proprietor is the requester, in which case, he will have received the correspondence from the Hearings Clerk.
- Where the request relates to a SPC the A3 will amend the letter headings as appropriate.
- Update OPTICS to read:

*“In a decision of the comptroller dated XX Xxxx the request for opinion filed on XX Xxxx was refused.”*

- If requested by the Senior Opinions examiner/SPC examiner, create a refund letter on Word and send to Head of Litigation to authorise. The letter is then sent to Finance Section who then arranges a refund of the £200 fee filed with Patents Form 17.
- Arrange for an opinion refused advert to be placed on the website.
- Arrange for a link from the web advert to the Office refusal



decision.

- The A3 will import letter generated to the PDAX dossier and prepare dossier for IPSUM
- Where the request relates to a SPC the A3 will amend the letter headings as appropriate.

29.33 Where the refusal decision is issued following the placement of the initial website advertisement notifying that the request has been filed, the following additional action will be required to be undertaken by the A3:

- Issue OL07 to any party who has been contacted in connection with the opinion request, or who has filed observations.
- The A3 will import letters generated to the PDAX dossier and prepare dossier for IPSUM
- Where the request relates to a SPC the A3 will amend the letter headings as appropriate.

## **OPINION REQUEST WITHDRAWN BY REQUESTER**

29.34 A request for an opinion can be withdrawn by the requester at any time during the process.

The A3 will undertake the following actions upon receipt of the withdrawal letter:

- Import letter of withdrawal of request to the PDAX dossier using Doc Code OPIN-WDRL.
- Issue OL08a to the requester and letter OL08b to the patent proprietor where the patent proprietor is not the requester.
- Where the request relates to an SPC the A3 will amend the letter headings as appropriate.
- Arrange for the withdrawal advert to be placed on the website.
- Update OPTICS register to read as follows:

*“Request for an opinion filed on xxXXxx withdrawn on xxXXxx”*

- Inform the allocated examiner of the withdrawal and cancel the task
- Generate a file note stating that the opinion has been withdrawn and the date.
- The A3 will import letter generated to the PDAX dossier and prepare dossier for IPSUM

29.35 Where the withdrawal is received following the placement of the initial website advertisement notifying that the request has been filed the procedures to be followed are as shown in 29.34 with the following changes:

- Issue OL09a to the requester (and not OL08).
- Issue OL09b to any party who has been contacted previously in connection with the opinion request or has filed observations. Where the request relates to an SPC the A3 will amend the letter headings as appropriate

## **CAVEATS**

29.36 Where an individual has filed a caveat relating to a patent whilst an SPC opinion request is ongoing, the caveatee may have requested that they are notified if and when a request for an opinion is filed and/or information regarding the period for filing observations. Where a caveat exists it will be shown on PDAX dossier/SPC file. Where a caveat request has been filed the A3 should undertake the following action:

- Contact the Caveat Clerk in Formalities/access the SPC file to obtain details of the caveat request.
- Where the request is in connection with the opinion, the A3 should send the appropriate details in agreement with the Formalities group/SPC section.
- The caveatee’s details should be recorded as “Other” (a potential interested party) in the Opinions database.
- Should the caveatee subsequently file observations, the database

entry should be updated to show the new role as “observer”.

## **EXTENSIONS OF TIME**

29.37 Requests for extensions to time periods for filing either observations or observations in reply may be received. Where a request is received, it should be made in writing indicating the reasons for the request. The request should be brought to the attention of the examiner or Senior Opinions examiner/SPC examiner without delay. The examiner will consider the request and if the extension of time is allowed the A3 should undertake the following actions:

- On the opinions database, edit all party details to include the allowed extension of time on observations and observations in reply (input as appropriate).
- Issue letters OL10a-b or OL11a-b as appropriate.
- Where the request relates to an SPC the A3 will amend the letter headings as appropriate.
- Where the observer is the proprietor, access the opinions database to identify the record for this party to alter the status back to “proprietor”. Update the Opinions record card with the new dates.
- The A3 will import the extension of time request letter to the PDAX dossier and prepare the dossier for IPSUM. A file note is also created on PDAX.
- Update the Current Situation on Live Opinions summary table.

29.38 It should be noted that if an extension of time is granted for the filing of observations, the same extension of time must be applied to the date for filing observations in reply, to ensure the observer in reply has a full two weeks. However, the opinion due date remains unaltered.

29.39 Where the request for an extension of time is refused the A3 will:

- Issue letters OL12a and OL12b.
- Where the request relates to an SPC the A3 will amend the letter headings as appropriate.
- The A3 will import the request for extension letter and the refusal letters generated to the PDAX dossier and prepare the dossier for IPSUM. A filenote should be created on the dossier.

## REQUEST FOR COPIES OF AN OPINION REQUEST

29.40 Parties may contact the office to seek copies of documents filed in connection with an opinion request upon viewing the initial website advertisement. Should any such requests be received, the A3 will ensure copies of Patents Form 17, accompanying statement and any supporting documents are sent to those making the request. This request for copies should be dealt with as a matter of **urgency** and the documents issued together with cover letter OL02b advising the party of the deadline for filing observations. There is no Patents Form or fee required for this. The A3 will add the party's details to the opinions database record for the opinion, as a potential interested party.

Where the request relates to an SPC the A3 will amend the letter headings as appropriate.

## REFERENCE

### Letters

29.41 Standard opinion letter templates are available for reference on SharePoint/OpinionsAdministration/letters. Annex 1 outlines letters used throughout the various stages of the opinions process.

## Website Adverts

29.42 Updates are sent to Webmaster for the opinion request to be advertised on the website the same day. Templates are available on SharePoint /Opinionsadministration/advert and are as follows.

### **WEB PAGE UPDATE (Date) (Updates highlighted in Red)**

#### **Initial advert**

| <b>Opinion number</b> | <b>Patent/SPC number, title &amp; owner</b>                   | <b>Requester &amp; request date</b> | <b>Issue (Infringement and/or Validity)</b>                    | <b>Observations deadline</b> | <b>Outcome</b> |
|-----------------------|---|-------------------------------------|--|------------------------------|----------------|
| xx/14                 | GB/EP (SPC number)<br><br>Patent title<br><br>Proprietor name | Requester<br><br>Date               | Infringement<br><br>Validity<br><br>Or Infringement & Validity | date                         |                |

#### **Final advert**

| <b>Opinion number</b> | <b>Patent/SPC number, title &amp; owner</b>                   | <b>Requester &amp; request date</b> | <b>Issue (Infringement and/or Validity)</b>                    | <b>Observations deadline</b> | <b>Outcome</b>      |
|-----------------------|---|-------------------------------------|--|------------------------------|---------------------|
| xx/14                 | GB/EP (SPC number)<br><br>Patent title<br><br>Proprietor name | Requester<br><br>Date               | Infringement<br><br>Validity<br><br>Or Infringement & Validity | date                         | Opinion issued date |

\*\* PDF Copies of Final Opinions attached to email.

# ANNEX 1

## OPINION LETTERS

| DOC CODE | TITLE                                    | MERGE DATA  | TO BE SENT TO |      |          |              |          |          |          |          |        |
|----------|--|---|---------------|------|----------|--------------|----------|----------|----------|----------|--------|
|          |  |   | Req           | Prop | Req/Prop | Req/Exc. Lic | Caveatee | Exc. Lic | Licensee | Observer | Others |
| OL01     | Initial Letter to Req                    |   | ✓             |      |          |              |          |          |          |          |        |
| OL01b    | Initial Letter to req/prop               |   |               |      | ✓        |              |          |          |          |          |        |
| OL01c    | Initial letter to req/exc.lic            |   |               |      |          | ✓            |          |          |          |          |        |
| OL02a    | Invite obs - proprietor                  |   |               | ✓    |          |              |          |          |          |          |        |
| OL02b    | Invite obs - others                      |   |               |      |          |              | ✓        |          | ✓        |          | ✓      |
| OL02c    | Invite obs - exc.lic                     |   |               |      |          |              |          | ✓        |          |          |        |
| OL03a    | Obs filed - confirm Receipt              |   |               |      |          |              |          |          |          | ✓        |        |
| OL03b    | Obs filed/prop - confirm receipt         |   |               | ✓    |          |              |          |          |          |          |        |
| OL03c    | Obs filed/ex. licensee confirm receipt   |   |               |      |          |              |          | ✓        |          |          |        |
| OL04a    | Invite obs in reply - requester          | Selected observer's name                                | ✓             |      |          |              |          |          |          |          |        |
| OL04b    | Invite obs in reply - req/prop           | Selected observer's name                                |               |      | ✓        |              |          |          |          |          |        |
| OL04c    | Invite obs in reply - req/exc. licensee  | Selected observer's name                                |               |      |          | ✓            |          |          |          |          |        |
| OL04d    | Invite obs in reply - proprietor         | Selected observer's name                                |               | ✓    |          |              |          |          |          |          |        |
| OL04e    | Invite obs in reply - exclusive licensee | Selected observer's name                                |               |      |          |              |          | ✓        |          |          |        |
| OL05     | Observations - in - reply filed          | Select recipient on merge                               | ✓             | ✓    | ✓        | ✓            |          | ✓        |          |          |        |
| OL06a    | Refusal-prelim view - requester          | Latest date - Hearing request<br>Free text (HO Refusal) | ✓             |      | ✓        | ✓            |          |          |          |          |        |

| DOC CODE | TITLE   | MERGE DATA   | TO BE SENT TO |      |          |              |          |          |          |          |        |   |
|----------|---|--|---------------|------|----------|--------------|----------|----------|----------|----------|--------|---|
|          |   |  | Req           | Prop | Req/Prop | Req/Exc. Lic | Caveatee | Exc. Lic | Licensee | Observer | Others |   |
| OL06b    | Refusal – prelim view – req/prop (No exc.lic) | Latest date – Hearing request<br><br>Free text (HO Refusal)                    |               | ✓    |          |              |          | ✓        | ✓        | ✓        | ✓      | ✓ |
| OL06c    | Refusal – prelim view – copy letter           |  |               | ✓    |          |              |          | ✓        | ✓        | ✓        | ✓      | ✓ |
| OL07     | Refusal Decision issued – inform others       | Refusal Decision<br>BL number  |               | ✓    |          |              |          | ✓        | ✓        | ✓        | ✓      | ✓ |
| OL08a    | Withdrawal – pre-advert                       | Date withdrawal request<br><br>Optional paragraph                              | ✓             |      | ✓        | ✓            |          |          |          |          |        |   |
| OL08b    | Withdrawal – pre-advert copy                  |  |               | ✓    |          |              |          |          | ✓        |          |        |   |
| OL09a    | Withdrawal – post advert                      | Date withdrawal request<br><br>Optional paragraph                              | ✓             |      | ✓        | ✓            |          |          |          |          |        |   |
| OL09b    | Withdrawal– post advert copy                  |  |               | ✓    |          |              |          | ✓        | ✓        | ✓        | ✓      | ✓ |
| OL10a    | EOT allowed - obs                             | Latest date – observation's<br><br>Select paragraph 2 or 3                     |               | ✓    |          |              |          | ✓        | ✓        | ✓        | ✓      | ✓ |
| OL10b    | EOT allowed –obs copy                         | Latest date – Obs in-rep<br><br>Optional paragraph 2 -referring to HO comments | ✓             | ✓    | ✓        | ✓            |          |          | ✓        |          |        |   |
| OL11a    | EOT allowed – obs in reply                    | Latest date – Obs in-rep<br><br>Para 3 Optional text re copies                 | ✓             | ✓    | ✓        | ✓            |          |          | ✓        |          |        |   |
| OL11b    | EOT allowed -obs in reply - copy              | Latest date – obs in-rep<br><br>Optional para 2 referring to HO comment        | ✓             | ✓    | ✓        | ✓            |          |          | ✓        |          |        |   |

| DOC CODE | TITLE                             | MERGE DATA  | TO BE SENT TO |      |          |             |          |          |          |          |        |  |
|----------|-----------------------------------|---|---------------|------|----------|-------------|----------|----------|----------|----------|--------|--|
|          |                                   |   | Req           | Prop | Req/Prop | Req/Exc.Lic | Caveatee | Exc. Lic | Licensee | Observer | Others |  |
| OL12a    | EOT refused - observer            | Latest date – Hearing request<br><br>Para 1 insert text (HO Refusal)<br>or<br>Para 3 optional text    |               |      |          |             |          |          |          |          | ✓      |  |
| OL12b    | EOT refused – observer copy       | Selected Observer/ 's name  | ✓             | ✓    | ✓        | ✓           |          |          | ✓        |          |        |  |
| OL13a    | EOT – refused – obs in rep        | Latest date –<br><br>Hearing request<br>Para 1 insert text (HO Refusal)<br>or<br>Para 3 optional text | ✓             | ✓    | ✓        | ✓           |          |          | ✓        |          |        |  |
| OL13b    | EOT refused – obs in reply - copy | Insert name of person requesting EOT  | ✓             | ✓    | ✓        | ✓           |          |          | ✓        |          |        |  |
|          |                                   |   |               |      |          |             |          |          |          |          |        |  |
| OL20     | examiner's opinion letter         |   | ✓             | ✓    | ✓        | ✓           |          |          | ✓        |          | ✓      |  |
| OL21     | examiner's review offer letter    |   | ✓             | ✓    | ✓        | ✓           |          |          | ✓        |          | ✓      |  |
| Opinion  | examiner's Opinion                | Date of opinion automatically notified and entered  | ✓             | ✓    | ✓        | ✓           |          |          | ✓        |          | ✓      |  |



## CHAPTER 30

### SECTION 74B REVIEWS OF OPINIONS

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## **30 APPLICATION FOR A REVIEW OF AN OPINION - SECTION 74B**

### **INTRODUCTION**

30.01 Section 74B of the Patents Act 1977 provides for a review of an opinion. An application may be filed by the patent proprietor or an exclusive licensee.

30.02 An application for a review needs to be filed before the end of the period of three months beginning with the date on which the opinion has been issued.

30.03 An application may be made on the following grounds only:

- That the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent; or
- That, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent (rule 98(5)).

30.04 An application for a review may not be filed or if filed, may not be continued, if the issue raised by the review has been decided in other relevant proceedings.

### **INITIAL ACTION**

#### Formal Requirements

30.05 The application must be made on Patents Form 2 accompanied by the appropriate fee together with a statement in duplicate setting out fully the grounds on which the review is sought (rule 98(3)). The statement should contain details of any proceedings of which the applicant is aware which may be relevant to the question of whether the application for a review may be brought or continued if the issue raised by the review has been decided in other proceedings.

30.06 On receipt, the form and accompanying documents will be scanned to the Office's electronic case management system and an electronic dossier (case file) will be created. An electronic message will be sent to the Litigation Mailbox. The B3 will carry out an initial check of the case. The check establishes, for example, that the correct section of the Act has been identified, the filing fee has been paid, a statement of grounds has been filed and the correct patent number(s), if appropriate, have been quoted. If these formalities requirements have been met, the B3 should :

- enter the proceedings on the inter partes SharePoint list
- allocate a B2 Case Officer and HO and enter the details in the excel spreadsheet
- advise the A3 Opinions Officer that a review has been filed and provide details accordingly. The A3 will update the opinions record card accordingly.
- The B3 will undertake an analysis of the application for review to determine whether it can be served.
- The B3 will complete the website advert template as shown in (Annex 1) to be sent to webmaster for the advert to appear on the following Wednesday. This will provide interested parties with the opportunity to oppose the review or file a statement in support of the application. The period for opposing a review is either (a) four weeks of the date of the advertisement on the website or (b) if it expires later, two months from the date the opinion was issued.

## **STATEMENT OF GROUNDS**

### What should the statement of grounds contain?

30.07 The statement should contain details of any proceedings of which the applicant is aware and which may be relevant to the question of whether the application for a review may be filed.

30.08 When checking the statement of grounds, reference should be made to the provisions of rule 98(5) (see paragraph 30.03 above).

#### What happens if the statement does not comply?

30.09 Where the statement does not comply, the B3 will contact the applicant for review outlining the defect and will provide a period of time for the applicant to respond. Where the defect is minor, for example, a document referred to in the statement is not attached, the applicant will be asked to provide the document within a period of not more than one month. Defects which are substantial, for example, where the statement appears to be inadequate or does not comply with the provisions of rule 98(5), may be referred to the Hearing Officer for consideration.

#### Serving the application for review

30.10 When the B3 is satisfied that the application is in order, the application will be served (see Annex 2). In accordance with rule 99(1) of the Patents Rules 2007, a copy of Patents Form 2, the statement and any other documents filed, will be sent to:

- The requester of the opinion (if different from the applicant for review)
- Any party who filed observations in connection with the original request for an opinion under section 74A

The requester and any observers will be invited to file a statement in support of the application, or a counter statement opposing it (rule 99(3)) within either four weeks from the date of advertisement or two months from the date the opinion was issued, whichever is the later.

If the applicant for the review was the original requester of the opinion and no observations were filed in relation to the opinion, the B3 should issue the letter (Annex 3).

30.11 The B3 should then minute the B2 and request the B2 carries out the following actions:

- Diaries the case to await a counter statement or statement
- Updates the front cover of the dossier with the appropriate label e.g “Litigation Proceedings” and “Review of Opinions”.
- Update OPTICS to record the fact that the application for review has been filed using REC OPI function.

## **STATEMENT/COUNTER-STATEMENT**

### Where a statement/counter- statement is filed

30.12 Any person who files a statement or counter- statement becomes a party to the proceedings. Upon receipt of either a statement supporting the application for a review or a counter-statement opposing it, the B2 will undertake a check to ensure it has been filed within the time period specified. The B2 should also carry out the following actions:

- Update the inter partes SharePoint list to record the date the statement/counter-statement is filed.
- Ensure the document has been correctly scanned to the dossier with the appropriate document code and any documents referred to are attached.
- Send a copy of the statement/counter-statement to the other parties in the review advising that the proceedings will now be reviewed by the Hearing Officer to determine the subsequent procedure (see Annex 4).
- Refer the documents filed to the Hearing Officer

### Where no statement/counter- statement is filed

30.13 Where a statement/counter-statement is not filed, the B2 should inform the Hearing Officer accordingly and write to the applicant for the review advising that no statement counter-statement has been filed (Annex 5) and that the proceedings will now be reviewed to consider the best way forward.

## **EVIDENCE ROUNDS**

### Filing of evidence

30.14 The B2 should seek advice from the Hearing Officer as to the subsequent procedure. Evidence rounds may not always be necessary for reviews of opinions but if evidence is required, the Hearing Officer may direct either simultaneous or sequential filing of evidence. The B2 will issue a letter accordingly (see Chapter 1). Alternatively, the Hearing Officer may decide to proceed to a hearing or decision on the papers.

### Format of evidence

30.15 If evidence is required, it should be in the form of a witness statement.

## **HEARING OR DECISION ON PAPERS**

30.16 If evidence is not required, the party(ies) will be invited to attend a hearing or will be given the option of having the matter decided on the basis of the papers filed. The B2 will issue a letter accordingly to establish requirements (see Annex 6).

30.17 If any of the party(ies) wishes a hearing, the B2 will advise the Hearing Officer and will liaise with the Hearings Clerk who will make the necessary arrangements (see Chapter 4).

## **DECISION**

30.18 The outcome of the proceedings will be either that the opinion is set aside in whole or in part, or, no reason has been shown for the opinion to be set aside. A copy of the decision will be sent to the applicant for the review and any party who has filed a statement or counter-statement by the Hearings Clerk (see Chapter 5). The decision will also be published on the website.

30.19 The B3 will update the register to reflect the outcome of the decision and will arrange for the advertisement of the review on the website to be updated to show a decision has been issued.

## **APPEAL**

30.20 There is no appeal to the courts against a decision to set aside an opinion, except where the appeal relates to a part of the opinion that is not set aside (see rule 100(3)). Therefore, it is not possible for the courts to consider the issue of whether to reinstate a non-binding opinion. Only the patent proprietor or exclusive licensee has the right to appeal under rule 100(3).

30.21 Once the decision has been issued and any appeal period has expired, the B2 will clear all records as follows:

- Update the inter partes SharePoint list
- Ensure the dossier contains all documents including minutes
- Add 'Precedent' label to the dossier
- Produce a clear records file note for the dossier
- Advise the A3 Opinions Officer the review has been completed so the opinions record card may be updated

## Annex 1

| Date opinion issued & opinion number | Date application fore review advertised | Patent number & title | Name of applicant | Name of patent owner | Deadline for filing statement or counter-statement | Outcome |
|--------------------------------------|---|-----------------------|-------------------|----------------------|--|---------|
|                                      |   |                       |                   |                      |  |         |



## Annex 2

Requester and/or  
Observer

**Your Reference:**  
**Our Reference: Rm No./Name/GB/EPnumber**

Date

Dear Sirs

**Latest date for response:**

**Patent Number: GB/EPxxxxxxx (Patent proprietor); Application for a review of an opinion (opinion No. xx/xx) filed under section 74B of the Patents Act 1977**

1. Please find enclosed copies of the following documents relating to an application for a review of Opinion No. xx by xxxxxxxxxxxx:

Patents Form 2  
Statement  
Accompanying documents

2. These documents have been sent to you in accordance with rule 99(1)(b) of the Patents Rules 2007. The Patents Rules are available to view on our website at:

<https://www.gov.uk/government/publications/the-patents-rules-2007-and-patents-fees-rules-2007>

3. Also enclosed, for information, is a copy of a letter sent today to xxxxxx, the applicant for the review.

### **Supporting or contesting the application**

4. The application is due to be advertised on our web site on, ..... (insert date). If you wish to support or contest the application, you need to file two copies of a statement or counter-statement within ..... (insert as appropriate - four weeks of the date of the advertisement / two months of the date the opinion was issued). Your response should be filed by ..... (insert date).

5. By filing a statement supporting the application or a counter-statement contesting it, you will become a party to the review proceedings (see rule 99(3)).

**Subsequent procedure**

6. We will send a copy of any statement or counter-statement filed by you to the applicant for the review.

7. We will then give directions as to the subsequent procedure. It may be appropriate, for example, to invite evidence or alternatively, we may be able to proceed straight to a hearing. If both sides agree, the matter may also be decided on the basis of the papers filed.

**Additional information**

8. If you require any additional information on reviews of opinions, see our website at:

(insert web address)

Further information may also be found in the Opinions Manual available at:

(insert web address)

9. Any correspondence filed in connection with the application should be addressed for the attention of ..... (insert name of case Officer) (Telephone: ..... (insert number)).

10. A letter in identical terms has been sent today to .....

11. A copy of this letter has been sent today to .....

Yours faithfully

Insert Name  
Litigation Section  
Patents Directorate

Enc: Patents Form 2  
Statement  
Etc

## Annex 3

Applicant for review

**Your Reference:**

**Our Reference: Rm No./Name/GB/EPnumber**

Date

Dear Sirs

**Patent Number: GB/EPxxxxxxx (Patent proprietor): Application for a review of an opinion (opinion No. xx/xx) filed under section 74B of the Patents Act 1977**

1. I refer to your application for a review of an opinion under section 74B of the Patents Act 1977.

2. Your application will be advertised on our web site on ..... (insert date). Anyone who wishes to support your application or to contest it will then have a period of ..... (insert as appropriate - four weeks / two months) in which to file a statement or counter-statement. We will send a copy of the statement or counter-statement to you for information.

3. At the end of the ..... (insert as appropriate - four week period/ two month period), your application will be referred to a hearing officer for consideration.

4. Any further correspondence in connection with this matter should be addressed for the attention of .....(insert name of Case Officer) (Telephone: ..... (insert number)).

Yours faithfully

Insert name  
Litigation Section  
Patents Directorate

## Annex 4

Applicant for review  
Any other parties

**Your Reference:**  
**Our Reference: Rm No./Name/GB/EPnumber**

Date

Dear Sirs

**Patent Number: GB/EPxxxxxxx (Patent proprietor): Application for a review of an opinion (opinion No. xx/xx) filed under section 74B of the Patents Act 1977**

1. Please find enclosed, a statement/counter-statement filed in connection with the above proceedings.
2. The proceedings will now be reviewed and the Office will consider the best way of proceeding with the case. I will contact you again about this matter as soon as possible.
3. A copy of this letter has been sent today to xxxxxxxxxx (party filing statement or counter statement).

Yours faithfully

Insert name  
Litigation Section  
Patents Directorate

## Annex 5

Applicant for review

**Your Reference:**

**Our Reference: Rm No./Name/GB/EPnumber**

Date

Dear Sirs,

**Patent Number: GB/EPxxxxxxx (Patent proprietor): Application for a review of an opinion (opinion No. xx/xx) filed under section 74B of the Patents Act 1977**

1. The Office advertised your application for a review of an opinion on ..... (insert date). Anyone wishing to support or contest your application had ..... (insert period - four weeks / two month) in which to file a statement or counter-statement.
2. The Office has not received a statement or counter-statement to support or contest your application. Consequently, your application will now be reviewed and the Office will consider the best way of proceedings with the case.
3. I will contact you again about this matter as soon as possible.

Yours faithfully,

Insert name  
Litigation Section  
Patents Directorate

## Annex 6

Applicant for review

Other parties

**Your Reference:**

**Our Reference: Rm No./Name/GB/EPnumber**

Date

Dear Sirs

**Latest date for response:**

**Patent Number: GB/EPxxxxxxx (Patent proprietor): Application for a review of an opinion (opinion No. xx/xx) filed under section 74B of the Patents Act 1977**

1. I refer to the above proceedings which have now been reviewed.

Insert as appropriate

2. The parties are advised that they may now request a decision on the basis of the papers filed or may choose to attend a hearing.

OR

2. You are advised that you may now request a decision on the papers filed or may choose to attend a hearing.

3. Please inform me **within 14 days of the date of this letter (by xx xxxxx xxxx)** whether you wish to be heard, or request a decision on the basis of the papers.

Insert if appropriate

4. A letter in identical terms has been sent today to the other side.

Yours faithfully

Insert name  
Litigation Section  
Patents Directorate

## CHAPTER 31

### MISCELLANEOUS

|  |               |
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| Reporting Lost Correspondence          | 31.01 - 31.02 |
| IPSUM – Inspection of Documents Online | 31.03 - 31.10 |

## **31 MISCELLANEOUS**

### **REPORTING LOST CORRESPONDENCE**

31.01 Under rule 110, the comptroller is empowered to certify any day where there is a general interruption or subsequent dislocation in the UK postal services as an interrupted day; any time limits expiring on such an interrupted day are automatically extended to the next day which is not an interrupted day. Under rule 111, the comptroller may extend any period of time specified on the Act or Rules, in a particular case of failure to meet that time period, where he is satisfied that the failure was wholly or mainly attributable to a failure or delay in a communication service.

31.02 Any instance where correctly addressed correspondence sent by the Office is reported to us as never having arrived at its intended destination should be reported for information security monitoring purposes to the Head of Administration (F1 – F3). The following information should be included:

- The application /patent/reference number
- The date the loss was reported to the Office
- The original date of the lost correspondence
- Details of who the correspondence was sent to
- The date the matter was rectified, that is, when a copy of the lost correspondence was re-sent.

### **IPSUM - INSPECTION OF DOCUMENTS**

31.03 Ipsum is the Office's online document inspection service. Following its launch, certain documents are available free of charge on the IPO's website for all patent applications published after 1 January 2008.

31.04 To add litigation section documents to Ipsum, they should be annotated 'OLFI'.

31.05 Documents that are to be added but contain personal information (other than



names or physical addresses) need to be redacted so that the personal information cannot be viewed. Any information considered sensitive, should also be redacted.

31.06 To redact information, you should use the Enhance function (grey) within the PDAX dossier. Once this has been actioned, the 'OLFI' annotation may be added.

31.07 A patent applicant or proprietor, or a third party, may request that a document or entire file relating to an application or granted patent which is open to inspection via Ipsum be removed from the system. If this is requested, the document or file should be taken off Ipsum as soon as possible. The Office will then consider the request and decide what action should be taken in respect of online availability of the document or file.

31.08 To remove an entire file from Ipsum, you need to contact the IT Helpdesk.

31.09 To remove an individual document from Ipsum, you should annotate it as "NOPIE" and then save the PDAX dossier.

31.10 In both cases, the following actions should be carried out:

- A minute should be added to the dossier explaining why the document or dossier has been taken down and outlining any issues that should be considered before the dossier or document is returned to Ipsum.
- The cover label 'NOPIE' should be added to the front cover of the PDAX dossier
- An entry should be made in the 'NOPIE' excel spreadsheet at x:\IPSUM Guidance Notes\NOPIE spreadsheet.

## CHAPTER 32

|   |
|---|
| <p style="text-align: center;"><b>REVOCATION ON THE COMPTROLLER'S<br/>INITIATIVE<br/>SECTION 73(1A)</b></p> |
|---|

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- Annex 13 S73 EPOREV Centrally revoked at EPO

# SECTION 73(1A) REVOCATION ON THE COMPTROLLER'S INITIATIVE

## INTRODUCTION

32.01 This section relates to the revocation of patents on the Comptroller's initiative under Section 73(1A). Where an opinion has been issued which concludes that the patent in question lacked novelty or inventive step, then if the patent is clearly invalid, revocation action under section 73(1A) may be initiated. The patent cannot be revoked until either the period for requesting a review of the opinion, which is three months from the date of the opinion, has expired and no review has been requested or if a review has been requested, until after the decision on the review is made or, if there is an appeal against that decision, the appeal is determined and that decision and any appeal has upheld the opinion. However, action under section 73(1A) may be initiated during the period for requesting a review. Action should not be initiated if a review has already been requested.

### Action by Litigation Officer A3

32.02 Once the opinion has been issued, the A3 will commence formality checks as follows:

If the opinion relates to a EP(UK) patent

32.03 A print relating to the European patent (UK) should be obtained via the Online European Patent Register <https://register.epo.org/espacenet/regviewer> (Register Plus). The A3 will check that:

- the 9 month EP opposition period has expired
- no opposition to the grant of the patent has been filed
- there are no opposition proceedings ongoing
- the patent designates GB
- there are no ongoing requests for central revocation of the patent

under EPC Article 105a. (This allows the proprietor to request that their patent is revoked in all contracting States in which the patent is in force.)

- there are no ongoing requests for central limitation of the patent (This allows the proprietor to request that their patent is amended in all contracting States in which the patent is in force). The latest version of the patent specification can be downloaded from Register Plus and imported into the dossier.

If amendment proceedings are ongoing, the A3 will proceed as follows:

The A3 will obtain a copy of the amendments filed at the EPO and this should be forwarded to the appropriate group head (who handles the relevant subject matter), as per the minute below. The group head will consider whether the amendments, if allowed, mean that action under section 73(1A) is no longer justified. If so, they may choose to stay the S73(1A) action pending the outcome of the central amendment. If the amendment is not allowed or does not overcome the validity objection the S73(1A) action may proceed.

A minute should be prepared and referred to the group head as follows:

*“Deputy Director / Head of Examination Group (Name)”*

*“Please see Opinion number (--/--) issued on (date). However on checking the EPO register, it appears that an application has been filed to amend the patent centrally at the EPO. The amendments are available to view on the dossier. Please consider, if allowed, whether these amendments remove the validity objection. If so, please confirm that you wish to stay the S73(1A) action pending the outcome of the centrally filed amendment. The register will be checked regularly to monitor the progress of the amendment. If the amendment does not overcome the validity objection, please confirm whether you wish to proceed with the S73(1A) action. If you do wish to proceed with section 73(1A) action, please specify which disclosures should be cited in our*

*communication to the proprietor.*

The A3 will create a minute on PDAX, then send a “PSM - S73(1A) Central amendment filed” message to the group head.

The A3 should set a deadline for response one month from the date that the minute is issued.

If an opposition to the European patent (UK) has been filed, the case should be referred to the appropriate group head (who handles the relevant subject matter) with the following minute:

*“On checking the EPO register, it appears that opposition proceedings are pending before the EPO. Please confirm whether you wish to stay the S73(1A) action pending the outcome of the proceedings. The register will be checked regularly to monitor the progress of the proceedings.*

The A3 will create a minute on PDAX, then send a “PSM - S73(1A) EP Opposition proceedings pending” message to the group head.

The A3 should set a deadline for response one month from the date that the minute is issued.

Note: If the European patent (UK) has lapsed since grant, revocation action should continue (see MOPP Section 73).

If the opinion relates to a GB patent

- 32.04 The A3 will check that the patent is in force and is not surrendered by using the OPTICS function DIS FUL. If the patent is not in force, the case will be referred as follows:

The A3 will create a minute on PDAX as follows:

*“On checking Optics it appears that the patent is not in force/has been surrendered. Please advise how you wish to proceed”.*

The A3 will then send a “PSM - S73(1A) Patent not in force surrendered” message to the group head (who handles the relevant subject matter).

### **Formalities complied with - referral to Head of Examination Group**

32.05 The A3 will create a PDAX minute to the group head of the subject matter of the patent and request confirmation of whether or not section 73(1A) action should be initiated using the following minute:

*Deputy Director / Head of Examination Group (Name)*

*“Please see Opinion number (--/--) issued on (date). Please advise whether action under*

*section 73(1A) to revoke the patent should be initiated.*

*If you do wish to proceed with section 73(1A) action, please specify which disclosures should be cited in our communication to the proprietor.”*

The A3 will create the minute on PDAX and then send a “PSM - S73(1A) for consideration” message to the group head.

The A3 should set a deadline for response one month from the date that the minute is issued.

### **Response from Head of Examination Group**

No Revocation action to be initiated

32.06 Where the group head responds by indicating that revocation action is not to be initiated, a report will be provided for the dossier. Upon receipt of the report, the A3 will ensure it is placed on PDAX. The A3 will also need to:

- enter the case details on the S73(1A) tab on the Exparte Post Grant SharePoint List and mark the relevant column to show action has been considered but has not been proceeded with.
- Issue letter PL6 (Annex 1B) to proprietor

A file note should be prepared as follows:

*PL6 issued on ..... (insert date of PL6),*

- An OPTICS free text entry should be made using the function REG ENT. The entry should read:

*“No action to be initiated under section 73(1A).”*

Revocation action to be initiated

32.07 Where the group head responds to confirm that action under Section 73(1A) should be initiated the A3 will:

- Issue Official Letter PL2A (Annex 1) to the proprietor allowing 1 month for a response.
- A file note should be prepared as follows:

*PL2A issued on ..... (insert date of PL2A), B/F to .....(insert reply date)*

- An OPTICS free text entry should be made using the function REG ENT. The entry should read:

*“Section 73(1A) initiated on (date of PL2A).”*

- A S73(1A) entry should be made on the Exparte Post Grant SharePoint List.

The Head of Examination Group should confirm in their minute that they are content for the case not to be referred back to them in the event that the proprietor fails to reply.



## RESPONSE TO OFFICIAL LETTER PL2A

32.08 The proprietor may respond to the initiation of revocation action by:

- advising that he has no objection to the revocation (he is content for the patent to be revoked).
- advising that he has applied to revoke/limit the patent centrally at the EPO
- filing observations/comments for the group head's consideration
- filing amendments to the patent
- advising that he intends to offer to surrender the patent
- advising that he intends to allow the patent to lapse through non payment of renewal fees

The A3 will undertake the following action as appropriate:

### No objection to revocation

32.09 If a response is received to the PL2A letter stating that the patentee has no objection to the revocation of the patent, a Decision REV-DEC-3A (see Annex 4) should then be prepared for the Head of Examination Group.

The A3 will create a minute on PDAX, then send a "PSM – Dec 3a to authorise" message to the group head.

Once authorisation is received from the group head, an electronic signature can be applied to the decision. The decision should be dated and issued to the patentee with official letter DNL1 (see Annex 2). A file note should be prepared as follows:

*Decision issued on ..... (date of Decision). Patent revoked.  
Clear records.*

Letter created, locked and imported from PROSE.

File note is created on PDAX.

Decisions are created using Word templates and applying the electronic signature of the relevant group head. Electronic signatures can be located on SharePoint.

(For clearing records see 32.27-32.29 below)

Patentee advises he has applied to centrally revoke the patent

- 32.10 A response may be received advising that the patentee has applied to centrally revoke at the European Patent Office. In this circumstance, no action under Section 73(1A) will be necessary. Once confirmation is received that the EP patent has been centrally revoked, the A3 will notify the appropriate group head.

Once the group head has agreed that the patent has been centrally revoked and action under Section 73(1A) is no longer required the A3 will issue letter S73 EPOREV (see Annex 13) and clear records (For clearing records see 32.12)

Observations/comments filed in response for consideration by the Head of Examination Group

- 32.11 The patentee may disagree with the group head's view that the patent is not valid and will file their observations for consideration. The observations are referred to the originating group head with a suitable minute. If the group head allows the submissions, Decision REV-DEC-2A (see Annex 5) should be prepared for their authorisation. The A3 will create a minute on PDAX, then send a "PSM – Dec 2a to authorise" message to the group head. Once authorisation is received from the group head, an electronic signature can

be applied to the decision. The decision should be dated and issued to the patentee with official letter DNL2 (see Annex 3). A file note should be prepared as follows:

*Revocation action under S73(1A) not proceeded with on (date of clear records)*

Letter created, locked and imported from PROSE.

File note is created on PDAX

Decisions are created using Word templates and applying the electronic signature of the relevant group head. Electronic signatures can be located on SharePoint.

### **Observations not allowed**

If the observations are not allowed, the group head will issue further instructions as to how you should proceed in an examination report. This report is then included in an exam letter (Annex 11). The proprietor should also be provided with the opportunity to file amendments to overcome S73(1A) validity objection.

If no agreement can be reached, a hearing should be offered to be taken by a Deputy Director (DD). If the DD decides, as a result of the hearing, that the patent should be revoked, they should issue a reasoned decision to that effect and instruct the A3 accordingly.

### **32.12 Clear records – Revocation not proceeded with**

An OPTICS and journal entry should be prepared to reflect the fact that revocation has not taken place. Using REG ENT on OPTICS, a free text entry should be made as follows:

*Section 73(1A) initiated on (date of PL2A) not proceeded with on (date of decision)*

The Ex Parte SharePoint list should be updated by entering against the file reference number: not proceeded with on (insert date of decision) and the date of clear records.

A Journal entry should be prepared as follows:-

Revocation action under Section 73(1A) not proceeded with on  
(date of decision).

Advert is created in Word, imported on PDAX using manual import (doc code is ADVERT) and is uploaded to the weekly PDJ Live on SharePoint.

#### Amendments allowed instead of revocation

- 32.13 The patentee may submit proposals to amend the patent in order to remove the validity objection.
- 32.14 When proposals for amendment of a patent are received in response to revocation action under Section 73(1A), the amendments should be referred to the appropriate Head of Examination Group as below:

The A3 will create a minute on PDAX, then send a “PSM – S73(1A) Amendments filed” message.

The group head will consider whether the proposed amendments are acceptable or not. If they are not acceptable, they will issue further instructions as to what action should be taken in an examination report. This report is then included in an exam letter. The proprietor should be provided with a further opportunity to file amendments to overcome S73(1A) objection. (see Annex 11).

If no agreement can be reached, a hearing should be offered to be taken by a Deputy Director (DD). If the DD decides, as a result of the hearing, that

the patent should be revoked, they should issue a reasoned decision to that effect.

- 32.15 If the proposals for amendment are prima facie allowable but are extensive, the Head of Examination Group may request that amendments are made throughout the whole specification in order to achieve consistency within the specification in order to conform. The A3 is then instructed by the group head to issue an S73FS2 letter to proprietor to request further amendments. (see Annex 9).

If the proposals for amendment are deemed acceptable by the group head, but require a freshly typed specification in order for publishing to produce a C spec, letter S73FS1 is issued (see Annex 10).

If the proposals for amendment are acceptable, use the 'assemble' and 'enhance' functions to apply the amendments to the B specification. The description, claims and drawings annotated "P" and "working copy" are copied from PREGRANT into the LITIGATION section of the dossier. The amendments are then applied using the 'enhance' and 'assemble' functions.

In order to identify the amended sections of the specification, they are annotated "C" and "For publishing purposes" along with the sections not amended.

The references to "P" and "working copy" of the **copied** documents are deleted. This enables publishing section to extract all the documents required to produce a "C" spec. Decision REV-DEC-1A (see Annex 6) should be prepared for the appropriate group head.

Certificates and decisions are created using Word templates and applying the electronic signature of the relevant group head. Certificates and electronic signatures can be located on SharePoint.

Create a minute on PDAX, then send a "PSM – S73(1A) Dec 1A and CERT

to authorise” message to the group head.

Once authorisation is received from the group head, an electronic signature can be applied to the decision and certificate. The certificate is imported using manual import (doc code is CERTIFICATE).

- 32.16 The decision and certificate should be dated and the decision issued to the patentee together with Official Letter DNL2 (see Annex 3). A file note is prepared as follows:-

*Decision issued on (date of decision). Patent amended. Clear records.*

Letter created, locked and imported from PROSE.

File note is created on PDAX.

- 32.17 **Clear records – Amendments allowed- no order for revocation made**

An OPTICS entry should be made as follows:

*From the Revocation Section menu select item 7 – amendments allowed – type in the file number and then select item 4 – under Section 73 which will prompt you to insert the date of the decision. When prompted, use A3 as authority for the entry.*

*Specification amended under Section 73(1A), on (date of decision).*

Advert is created in Word and imported using manual import on PDAX (doc code is ADVERT) and is uploaded to the weekly PDJ Live on SharePoint.

- 32.19 The Exparte Post Grant SharePoint List should be updated by entering against the file reference number, Patent amended on (date of decision) and the date of clear records.

- 32.20 Following this, the case can be referred to Publishing Section for the

amended specification to be published.

The A3 will create a detailed minute on PDAX (see Annex 8), then send a “PSM – S73(1A) Produce C Spec and see CERT” message to the Publishing Team mailbox.

#### Amending an EP(UK) patent

- 32.21 If the EP(UK) patent is being amended in order to remove the validity objection, amendments will be considered under Section 27. On expiry of the S27 advert opposition period, prepare Decision REV-DEC-1A (see Annex 6). For full procedures on amendment under S27 see Chapter 17.

#### Patent to lapse or be surrendered

- 32.22 The patentee may state that he is either:
- allowing the patent to lapse due to non-payment of renewal fees, or
  - that he proposes to surrender the patent

It would appear that neither of these options is *prima facie* allowable. MOPP Section 73.09 indicates that once revocation action has started, it should normally continue even though the patent may have lapsed or an offer to surrender has been made. The case should be referred to the originating group head with a suitable minute. The group head will usually ask for a letter to be issued to the patentee pointing out these facts and offering a hearing.

The A3 will create minute on PDAX, then send a “PSM - S73(1A) request to lapse/surrender” message to the group head.

#### **NO RESPONSE TO OFFICIAL LETTER PL2A**

- 32.23 If, after the one month period allowed for response to Official Letter

PL2A, no reply has been received, the A3 should issue Decision Form 5A (Annex 7), having ensured that the group head specified in their original minute that the case does not need to be referred back to them if no response is received.

The decision should be dated and issued to the patentee with official letter DNL1 (see Annex 2). A file note should be prepared as follows:

*Decision 5A issued on ..... (date of Decision). Patent revoked.  
Clear records.*

Letter created, locked and imported from PROSE.

File note is created on PDAX.

Decisions are created using Word templates and applying the electronic signature of the relevant group head. Electronic signatures can be located on SharePoint.

(For clearing records see 32.27-32.29 below)

Request for a hearing in response to Official letter PL2A

- 32.24 The patentee may reply that he would like a hearing. If this is the case, a hearing will need to be arranged by the Hearings Team. The Hearing will be taken by a Deputy Director. Following the hearing, a decision will be written by the hearing officer and issued. If the patent is revoked, see 32.27-32.29 for clear records action.

To refer to the hearing team, create a minute on PDAX, then send a “PSM – set up hearing” message to the PD Hearings mailbox.

The Hearings Clerk will diary the expiry of the appeal period and will notify the A3 accordingly.

The A3 will then clear records following the expiry of the appeal period.



## **Clear records – Patent Revoked**

32.25 An OPTICS entry should then be made from the Revocation Section menu, select item 16 – Register Revocation – type in the patent number, select the section of the act, insert the date of the decision and use A3 as authority for the entry. If, when registering the revocation of the patent, it is found that the patent has lapsed, the case should be referred to the B3, who will change the status of the patent so that it can be revoked.

32.26 A Journal entry should be prepared under the following heading as indicated:

*(S73 final advert – Patent revoked)*

### **Section 73**

#### **Revocation on the Comptroller's Initiative**

#### **Patent revoked under Section 73(1A)**

**Patent Number**

PROPRIETOR'S NAME

Title

Patent Revoked on (date of  
Decision)

PDJ Advert is created and imported using manual import on PDAX (doc code - ADVERT) and is uploaded to the weekly PDJ Live on SharePoint.

32.27 The case will be updated on the S73(1A) tab of the Exparte Post Grant SharePoint List on SharePoint by recording the revocation and clear records dates against the file reference number.

Clear records file note is created on PDAX.

## EXTENSIONS OF TIME

32.28 Under S117B(2) of the Manual of Patent Practice an automatic two month extension of time must be applied for in writing (by letter, fax or email).

32.29 Where an automatic extension of time has been applied, any further EOT must be applied for before the expiry of the end of the extended period and must be applied for in writing specifying reasons for the request. Further extensions are at the comptroller's discretion and may be subject to conditions.

The request should be referred to the originating group head, who will consider it on its respective merits. It should be remembered that Section 73 cases are *ex parte*. Therefore no other parties are involved or need to be consulted.

The A3 will create a minute on PDAX, then send a "PSM – S73(1A) Extension of time request" message to the group head.

32.30 Once an extension of time has been granted, this should be confirmed in writing and a new deadline for a response set. (see Annex 12)

Letter created, locked and imported from PROSE.

File note is created on PDAX.

**Annex 1**  
**Letter S73(1A) PL2A**

**Your Reference:**  
**Our Reference: 1R31/Name/Patent**  
Date

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)**  
**Patents Act 1977: Action under Section 73(1A)**

**Latest date for reply: xx XXX xx**

The invention of claim(s) is considered to be not new or does not involve an inventive step because of disclosures in [xxxxx].

By xxxxx you should either propose amendments to the patent to meet this objection or make observations on it. If you do not, the patent may be revoked. Alternatively, you may reply advising that you are content with the revocation or (delete as appropriate) you have made a request for revocation at the European Patent Office under Article 105a.

(delete as appropriate)

We note from the Register entry for this patent that an exclusive licence has been recorded to [xxx] on [xxx].

We note from the Register entry for this patent that a security agreement has been filed between [xxx] and [xxx] on [xxx].

If you want to propose amendments, it would be helpful if these could be shown in red ink on a copy of the printed specification. However, if the amendments are simple and not extensive you may submit them in a letter. You may not, however, amend your patent in a way which adds matter or extends the protection conferred by the patent.

If you want to be heard before the Comptroller decides the matter, you should ask by DD MM YYYY for a hearing to be appointed.

Yours faithfully

*Your name*  
Litigation Section

Patents Directorate

**Annex 1B  
Letter S73(1A) PL6**

**Your Reference:  
Our Reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent number: xxxxxxx (Proprietors Name)  
Patents Act 1977: Action under Section 73(1A)**

Section 73(1) allows the comptroller to initiate revocation proceedings against a patent following the issuing of an opinion that concludes that a patent is invalid. Action under section 73(1A) however is only brought where the patent is considered to be clearly invalid. Whilst opinion [insert opinion number] did conclude that your patent was invalid the comptroller does not consider it appropriate to initiate revocation proceedings against your patent

You should note that the decision not to initiate action under section 73(1A) does not alter or set aside the conclusion in the opinion. You may still wish to amend your patent.

[Delete if represented]

[You should consider the opinion carefully before taking any action in respect of your patent. We would also strongly advise you to seek professional advice]

Yours faithfully

*Your name*  
Litigation Section  
Patents Directorate

**Annex 2  
Letter DNL1**

**Your Reference:**  
**Our Reference: 1R31/Name/Patent**

Date

Dear Sirs

**Action under Section 73(1A)**

1. Please find enclosed a copy of a decision dated
2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from H M Courts & Tribunal Service, Royal Courts of Justice Group, Chancery Appeals Office, 7 The Rolls Building, Fetter Lane, London, EC4A 1NL (telephone 020 7947 6890/6294/6243).
3. Two copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee **within the time period specified in the decision**. The latest date for appeal is therefore xxxxxx. Any request for an extension to the appeal period identified in the decision must be made to the court.
4. Once you have filed your appeal at the court, you must send a copy to the Notice of Appeal to the Comptroller as soon as practicable and no later than 7 days from the date of filing.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Your name  
Litigation Section  
Patents Directorate

**Annex 3  
Letter DNL2**

**Your Reference:  
Our Reference: 1R31/Name/Patent**

Date

Dear Sir

**Patent Number: xxxxxxxx (Proprietors Name)**

**Action under Section 73(1A)**

Please find enclosed a copy of a decision dated [xxx].

Yours faithfully

Your name  
Litigation Section  
Patents Directorate

**Annex 4**  
**Decision 3A**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB/EP xxxxxxx  
should be revoked under Section 73(1A)

---

**DECISION**

- 1 An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent was not new or did not involve an inventive step and that revocation of the UK Patent under Section 73(1A) might therefore be necessary. The proprietor, in a letter dated [xxx], advised that they were content with the revocation of the UK patent.
- 2 In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(1A) are met. I therefore order revocation of the UK patent.

**Appeal**

- 3 Any appeal must be lodged within 28 days after the date of this decision.

**(Name)**

Deputy Director / Head of Examining Group acting for the Comptroller

**Annex 5**  
**Decision 2A**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE                      Whether Patent Number GB xxxxxxxx should  
   be revoked under Section 73(1A)

**DECISION**

1. An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent was not new or did not involve an inventive step and that revocation of the UK Patent under Section 73(1A) might therefore be necessary.
  
2. The proprietors contested this view in their letter dated [xxx]. I have considered their observations and I make no order for revocation of the UK patent.

**(Name)**

Deputy Director / Head of Examining Group acting for the Comptroller



**Annex 6**  
**Decision 1A**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxxxx should  
be revoked under Section 73(1A)

---

**DECISION**

1. An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent was not new or did not involve an inventive step and that revocation of the UK Patent under Section 73(1A) might therefore be necessary.
2. The proprietor submitted proposals for amendment of the specification, which are allowable under Section 76.
3. I am satisfied that the proposed amendments distinguish the claimed invention from the cited disclosure. I therefore allow the specification to be amended as proposed, and make no order for revocation of the UK patent.

**(Name)**

Deputy Director / Head of Examining Group acting for the Comptroller

**Annex 7**

**Decision 5A**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent Number GB xxxxxxxx should  
be revoked under Section 73(1A)

---

**DECISION**

1. An Official letter dated [xxx] explained that the invention of claims [xxx] of the above patent was not new or did not involve an inventive step and that revocation of the UK Patent under Section 73(1A) might therefore be necessary. The proprietor did not submit observations or proposals for amendment. A hearing was also offered but the proprietor has not asked to be heard.
2. In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(1A) are met. I therefore order revocation of the UK patent.

**Appeal**

3. Any appeal must be lodged within 28 days after the date of this decision.

**(Name)**

Deputy Director / Head of Examining Group acting for the Comptroller

## Annex 8

### GB/EP

#### Filenote

Section 73(1A) initiated on xxxxxx. Amendments filed on ddmmyyyy have been allowed. No order for revocation made under S73(1A). Clear records

|                 |   |
|-----------------|---|
| PDJ             | ✓ |
| LEDGER          | ✓ |
| OPTICS/REGISTER | ✓ |
| O/L ISSUED      | ✓ |

#### **Minute to Publishing**

Please prepare a C spec for the allowed amendments filed under Section 73(1A) in the form of replacement page xxx/claims xxx/desc xxx. The description, claims and drawings have been annotated 'C' and 'For publishing purposes' for your information.

The current address for service is as follows:-

The letter reference is as indicated in our letter dated xxXXxx

Name

Section

Room number

Ext

Today's date

Delete as appropriate- (Please note publishing of amendments for EP cases will follow the S27 procedure -see Chapter 17)

**Annex 9  
Letter S73FS2**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number : Number Proprietor**

**Amendment of the specification of a patent under Section 73(x) of the Patents Act 1977.**

**Reply due by: [\*\*\*within one month]**

I confirm receipt of the replacement [xxx] filed on [xxx].

I am pleased to inform you that your proposed amendments are allowable under section 73[x].

However as the amendments are extensive, you are requested that the [xxx] should be amended to bring in order to conform with the amended [xxx] of the specification.

A clean version of the retyped specification incorporating all agreed amendments should be filed and presented in a way that allows for them to be clearly identified. Please provide replacement specification within one month from the date of this letter, that is by [xxx].

These pages will then be used for publishing purposes and will clearly show the specification in its finally amended form.

Yours faithfully

**Name**

Litigation Section  
Patents Directorate

**Annex 10  
Letter S73FS1**

**Your reference:  
Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number : (xxx) Proprietor**

**Amendment of the specification of a patent under Section 73(x) of the Patents Act 1977.**

I am pleased to inform you that your proposed amendments are allowable under section 73[x].

I am now in the process of preparing a C specification and write to request that you provide a newly typed specification, incorporating all the amendments. These pages will then be used for publishing purposes and will clearly show the specification in its finally amended form.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

**Annex 11  
Letter S73EX**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number : (xxx) [Proprietor]**

**Patents Act 1977: Action under Section 73(x)**

**Date for reply:**

[The amendments you filed on XXX are not considered acceptable because...]

If you wish to propose further amendments, you should file a consolidated version and if reasonably possible to do so, file this electronically. The amendments should be presented in a way that allows for them to be clearly identified.

Yours faithfully

Name  
Litigation Section  
Patents Directorate

**Annex 12  
Letter S73EOT**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number: (xxxx) (Proprietor)**

**Patents Act 1977: Action under Section 73(x)**

**Date for reply: xxx**

I refer to your correspondence dated xxx, requesting an extension of time in which to respond to official letter dated xxx.

The request for an extension of time is allowed. A response to our letter dated [xxx] is therefore now due by xxx.

Yours faithfully

xxx  
Litigation Section  
Patents Directorate

**Annex 13**  
**Letter S73 EPOREV**

**Your reference:**

**Our reference: 1R31/Name/Patent**

Date

Dear Sirs

**Patent Number : Patent Proprietor**

**Patent Act 1977: Action under Section 73(x)**

I refer to your letter dated [\*\*\*] and note that patent EP(UK) [\*\*\*] has been centrally revoked by the European Patent Office on \*\*\*.

As such we will no longer be proceeding with the revocation action under Section 73(x) initiated on [\*\*\*].

Yours faithfully

Your Name  
Litigation Section  
Patents Directorate



# **A GLOSSARY OF LEGAL TERMS and ABBREVIATIONS COMMONLY USED IN THE IP AREA**

|                                       |  |
|---------------------------------------|--|
| <b>Ab initio</b>                      | [From the beginning].  |
| <b>AC</b>                             | Appeal Cases.  |
| <b>ADR</b>                            | Alternative Dispute Resolution - methods of resolving disputes otherwise than through the normal trial process. See also entries under Arbitration, Early neutral evaluation, Med-arb and Mediation below.   |
| <b>Affidavit</b>                      | A written statement made upon oath or affirmation and signed in the presence of a person who is authorised to administer oaths (normally a solicitor). Authority: Civil Procedure Rules - Practice Direction 32.   |
| <b>Alternative Dispute Resolution</b> | See entry under ADR above.   |
| <b>Amendments</b>                     | Alterations sought to specifications or other documents because the drafter has become aware of new facts, circumstances have changed or because he has changed his mind.  |
| <b>Anton Pillar Order</b>             | See entry under Search Order below.  |
| <b>Arbitration</b>                    | An alternative method of resolving disputes between parties. The right of Appeal from a decision of the arbitrator is limited by the Arbitration Act 1979. (See also entry under ADR above).   |
| <b>Appeal: Patents</b>                | Not all decisions of the Comptroller are subject to appeal. In relation to patents, where decisions are open to appeal, appeal may be to the Patents Court (part of the High Court) or (if the proceedings are held in Scotland) to the (Outer) Court of Session. Further appeals, with leave, may lie to the Court of Appeal and the House of Lords. In |

Scotland, any appeal from the Outer Court of Session lies to the Inner Court of Session. (See section 97 of the Patents Act 1977).

**Appeal: Designs**

Under section 28 of the Registered Designs Act 1949, appeals from the decisions of the Registrar lie to the Registered Designs Appeal Tribunal. In relation to design right, under section 251 of the Copyright, Designs and Patents Act 1988, appeals on decisions under section 246 of the Act lie to the High Court or Court of Session. Appeals under sections 247 and 248 lie with the Registered Designs Appeal Tribunal by virtue of section 249.

**Assignment**

The transfer or assignment of intellectual property rights from the owner of such rights to another person or legal organisation.

**Burden of proof**

The obligation of proving facts. In general, the burden (onus) lies on the claimant (plaintiff).

**Caveat**

A request for information filed on PF47/77 in accordance with Patents Rule 92.

**CCR**

County Court Rules.

**CDPD**

Chancery Division Practice Direction.

**Certiorari**

See entry under Quashing Orders

**Civil Procedure Rules**

See entry under CPR below.

**Claim**

A document forming part of the Statement of Case. The Patents Rules 1995, the Registered Designs Rules 1995, and the Design Right Rules 1989, for example, set out detailed requirements regarding the content of such documents. Within the Rules, the term 'Statement' = 'Claim'.

|                           |   |
|---------------------------|---|
| <b>Claimant</b>           | The name, under the Civil Procedure Rules, given to the party filing proceedings - ie making a claim.   |
| <b>Claim form</b>         | Under the Civil Procedure Rules, the name given to a Writ/Summons. A claim form is used to commence proceedings in the High Court or the County Court irrespective of the nature of the claim. (For Appeals to Patent Court from the Comptroller see Notice of Appeal below).   |
| <b>CLR</b>                | Commonwealth (of Australia) Law Reports.  |
| <b>CMLR</b>               | Common Market Law Reports.  |
| <b>Compulsory licence</b> | Applications from a third party, may be made to the Comptroller to order, for example, the grant of a licence under a patent or to make an entry in the register making licences under a patent available as of right. Any such application must be made on one of the grounds set out in section 48(3) of the Patents Act 1977. Applications may be made after 3 years from the date when notice of grant appears in the Journal, though this period can be altered. In relation to design right, compulsory licences are available in the last 5 years of the design right. |
| <b>Consideration</b>      | In relation to transferring rights in or under a patent, a clause relating to the amount paid for the rights in the patent.   |
| <b>Corrections</b>        | Alterations sought to a specification or other document so that it better expresses the intention the drafter had at the time of drafting.  |
| <b>Costs</b>              | In proceedings before the Comptroller, costs made be awarded in respect of <i>inter partes</i> proceedings under the provisions of the Patents Acts 1949 & 1977, the Registered Designs Act 1949,   |

the Trade Marks Acts 1938 & 1994 and the Copyright, Designs and Patents Act 1988. The usual practice is to award a contribution to costs guided by a scale published in the various Office Journals and not to award full costs; however, Hearing Officers have a wide discretion when awarding costs. (See also entry under Security for costs).

**Counter-Claim**

A document filed in response to a Claim). The document sets out fully the grounds of opposition or objection ie which allegations in the Claim the opponent disputes and which he does not. The counter-claim forms part of the Statement of Case. In Office proceedings, the counter-claim is known as counter-statement.

**Counter-statement**

See entry under Counter-Claim above.

**CPC**

Community Patent Convention.

**CPR**

Civil Procedure Rules - rules for proceedings in the High Court and County Courts.

**Damages**

A sum of money awarded by the Court as compensation to the claimant.

**De minimis non curat lex**

[The law does not concern itself with trifles]. Small departures from the law may be overlooked if not significant.

**Decisions**

The exercise in writing or orally by the Comptroller of any discretion vested in him by, for example, the Patents Act 1977 and the Patents Rules 2007.

**Declaration of non-infringement**

Request made under section 71 of the Patents Act 1977 for a declaration that an act does not or a proposed act would not constitute an infringement of a patent.

**Deponent**

The name given to a person who makes a deposition (ie affidavit) under oath.

|                                 |  |
|---------------------------------|--|
| <b>Disclosure</b>               | Usually in the form of a request, this relates to the making available of relevant documents believed to be in the possession of the other party in <i>inter partes</i> proceedings.   |
| <b>Early neutral evaluation</b> | An alternative method of resolving disputes between parties. A neutral evaluator who has legal or other expertise will hear the core evidence from the parties or their legal representative at an early stage in the case. Having listened to the basic evidence, the evaluator will offer a frank assessment of the strengths and weaknesses of the case in the hope that this will lead to a settlement between the parties without further litigation. (See also entry under ADR above). |
| <b>ECFI</b>                     | European Court of First Instance.  |
| <b>Entitlement</b>              | An <i>inter partes</i> proceeding relating to who owns a patent or an application for a patent.  |
| <b>EOT</b>                      | Extension of time - a request made to extend a time period that has been set by the Office   |
| <b>EPC</b>                      | European Patent Convention. At present the Convention has 34 Contracting States.   |
| <b>EP application</b>           | An application for a patent under the EPC. By means of one application, it is possible to obtain patent protection for an invention in any of the Contracting States by designating that particular state.   |
| <b>EPO</b>                      | European Patent Office   |
| <b>EPOR</b>                     | European Patent Office Law Reports.  |
| <b>Evidence</b>                 | Information in the form of personal testimony, documents or objects filed in   |

support of the issue in question.

**Ex nunc**

[From now] Example: The amendment of a patent application is governed by section 19 of the Patents Act 1977 and takes effect *ex nunc*, ie from the time the amendment is made.

**Ex Parte Proceedings**

Refers to proceedings between one party eg an applicant for a patent, and the Comptroller.

**Ex tunc**

From then] Example: The correction of an application or the specification of a patent or of any document filed in connection therewith is governed by section 117 of the Patents Act 1977 and takes effect *ex tunc*, ie the document is deemed always to have been in the state in which it is after the correction.

**Exclusive licence**

A licence that allows, for example, only one person to use a patent ie means that the patent owner no longer has the right to use the patent although he may still collect royalties on the use of the patent.

**Exhibit**

Document or object included as part of the written evidence in proceedings before the comptroller.

**Freezing injunction**

Issued by the courts, this allows for the freezing of a defendant's assets to prevent disposal. It can be used to freeze assets worldwide (previously known as Mareva Injunction).

**Generalia specialibus non derogant**

[General things do not derogate from special things]. A principle of statutory interpretation that states that if a matter falls under a specific provision and a general provision it shall be governed by the specific provision.

**Hearsay evidence**

Evidence as to what someone else has seen, said or written.

|  |   |
|--|---|
| <b>HO</b>                              | Hearing Officer   |
| <b>In camera</b>                       | Parts of Hearings held before the Comptroller may, at his discretion, not be open to the public. In addition, certain proceedings are not open to public inspection.  |
| <b>Infringement</b>                    | Any act, as defined within intellectual property legislation, carried out by a third party that falls within the scope of the intellectual property rights owned by another and is performed without the authorisation of the owner of those rights.  |
| <b>Injunction</b>                      | A court order prohibiting a person from doing something or requiring a person to do something.  |
| <b><i>Inter Partes</i> proceedings</b> | Proceedings between two or more parties. Examples in relation to patents include entitlement and revocation proceedings; for design right such proceedings may relate to the subsistence of design right or the term of the design right.   |
| <b>Judicial Precedent</b>              | A previous judicial decision or proceeding that may be relied upon.   |
| <b>Judicial Review</b>                 | Order 53 of the Rules of the Supreme Court introduced a comprehensive system of judicial review. A statutory basis for this procedure also appears in s 31 of the Supreme Court Act 1981. Where no right of appeal is given, it may be possible to challenge the decision of an inferior court or public tribunal by recourse to the supervisory jurisdiction of the High Court. This means that generally only decisions of the Comptroller in respect of which no appeal is available, decisions under the PCT and decisions of the RDAT are likely to be subject to judicial review. An application may cover all the remedies available - certiorari, mandamus, |

prohibition, declaration and injunction. In practice, only certiorari and mandamus are likely to be relevant to proceedings before the Comptroller, although prohibition could also be so.

**Jurat**

The final statement signed by a person who is authorised to administer oaths indicating when the affidavit or statutory declaration was sworn, affirmed or declared.

**Licence**

The means by which the owner of a patent grants permission to another to manufacture use or sell the invention protected by his patent whilst at the same time retaining ownership. In return, the owner receives payments known as royalties.

**Licence of Right**

See entry under LOR below.

**Locus standi**

[A place of standing]. A right to be heard in court or other proceeding where there is a sufficient interest.

**LOR**

Licence of Right - section 46 of Patents Act 1977. The patent owner may apply to the Office for an entry to be made in the Register that licences, under the patent, are available >of right=. This means that the patent owner then cannot refuse to licence the invention and that he pays renewal fees at half the usual rate. The terms of such licences may be settled by the Comptroller if the parties cannot agree. For Design Right, under section 237 of the Copyright, Designs and Patents Act 1988, a third party is entitled as of right to a licence to do in the last 5 years of the design right term anything which would otherwise infringe the design right. The terms of such licences may be settled by the Comptroller if the parties cannot agree. See also licence, compulsory licence, non-exclusive licence, exclusive licence.



|                                  |   |
|----------------------------------|---|
| <b>Mandamus</b>                  | [we command] In connection with judicial review, one of the remedies available - to issue an order of the court requiring an inferior tribunal to do something it has previously unlawfully refused to do.  |
| <b>Manual of Patent Practice</b> | Office manual covering procedures and practice in relation to the Patents Act 1977, Patents Rules 2007 and precedents.  |
| <b>Mareva Injunction</b>         | See entry under >Freezing injunction=above.   |
| <b>Med-arb</b>                   | An alternative method of resolving disputes. This is a hybrid process that begins with traditional mediation. However, if the mediation does not result in the dispute being resolved within a given period of time, the process will end with a binding arbitration. (See also entry under ADR above). |
| <b>Mediation</b>                 | An alternative method of resolving disputes between parties. A mediator is appointed to help both parties reach an acceptable solution. (See also entry under ADR above).   |
| <b>MOPP</b>                      | See entry under >Manual of Patent Practice above.   |
| <b>Names of parties</b>          | See table at end of glossary.   |
| <b>NMP</b>                       | Nine Mile Point. The Offices warehouse facilities for the storage of files.   |
| <b>Non-exclusive licence</b>     | A licence that allows, for example, both the patent owner and the licensee to use the patent. It also allows the patent owner to agree licences with more than one person.  |
| <b>NOPI</b>                      | Not open for Public Inspection.   |

**Notice of Appeal**

Appeals to the Patent Court from the Comptroller must be in the form of a Notice of Appeal.

**Obiter dictum**

[A saying by the way]. Something said by the judge, whilst giving judgement, that is not essential to the decision. Therefore not binding as a precedent.

**OPI**

Open for Public Inspection. In relation to a patents file, for example, that part which members of the public can inspect as from the date of A publication of the application.

**Open for public inspection**

See entry under OPI above.

**Opponent**

Name given to person opposing opposition proceedings

**Part 36 offer**

Under the CPR, applies to either party and thus applies to the Claimant where the relief sought is a payment and in all other instances where the relief sought is not in respect of payment. The Rules provide that the offer must be in writing and can relate to the whole claim or part of a claim. A Claimant, for example in a patent matter, can put in a Part 36 Offer stating that he will accept in compromise of the proceedings, undertakings of a specified nature and , X in respect of damages.

**Part 36 payments**

Under the CPR, relates to payments into court in settlement of a money claim. The money claim may be all or part of the claim. The Defendant, if he wishes to avail himself of the Part 36 process, must actually pay the money into court in settlement of the money claim - it is not sufficient merely to offer to pay a sum in compromise of the money claim.

**Particulars of case**

Term used in CPR. They may be included in the claim form or may be

serve separately when starting proceedings. Part 16 of the CPR sets out what the particulars of case must include.

**Patent Co-operation Treaty**

See entry under PCT below.

**PCC**

Patents County Court.

**PCT**

Patent Co-operation Treaty. This is administered by the World Intellectual Property Organisation (WIPO), a UN organisation based in Geneva. The Treaty has at present 133 Contracting States.

**PCT application or filing**

An application filed under the PCT. By means of one application it is possible to obtain protection for an invention in any of the Contracting States by designating that state in the application.

**PD**

Practice Direction supplementing a Civil Procedure Rule.

**PDJ**

Patents & Designs Journal.

**PLT**

Patent Law Treaty. A treaty to harmonise formal requirements being negotiated under WIPO auspices.

**Practice form**

Form to be used for a particular purpose in court proceedings, the form and the purpose being specified by a Civil Procedure Rules Practice Direction.

**Pre-action protocol**

Statements of understanding between legal practitioners and others about pre-action practice and which are approved by a relevant Civil Procedure Rules Practice Direction.

**Precedent**

A previous decision or proceeding which may be relied upon.

**Preliminary hearing**

A hearing appointed to decide a point of procedure, usually in *inter partes*

proceedings.

**Pre-hearing review**

See entry under >PHR= below.

**Priority Date**

The priority gained by virtue of Article 4 of the Paris Convention. When applicants file an application in any Convention country, they can then file subsequent applications in any of the other Convention countries (including the country where first filed) and claim the earlier date of the first filed application providing the scope of the later application is not wider than the original and providing the later filed application is made within 12 months of the original in relation to patents and 6 months in relation to registered designs.

**Priority Document**

A document which establishes a priority date.

**Prima facie**

[Of first appearance; on the face of it] - based on a first impression.

**Privilege**

The right of a party to refuse to disclose a document or produce a document or to refuse to answer questions on the ground of some special interest recognised by law.

**Prohibition**

In connection with judicial review, one of the remedies available - to prevent some allegedly unlawful/arbitrary action from taking place.

**PHR**

Pre-hearing review. The purpose of this is to ensure that all the issues raised at the case management conference have been dealt with and to give any final directions considered necessary in relation to the hearing.

**Quashing Orders**

A remedy available under judicial review that quashes the ultra vires decision as if it were never made.(previously known as certiorari).

|                           |   |
|---------------------------|---|
| <b>Ratio decidendi</b>    | [The reason (or ground) for a judicial decision]. Usually a statement of law applied to the problems of a particular case. In essence, the principle upon which a case is decided.  |
| <b>RDAT</b>               | Registered Designs Appeal Tribunal.   |
| <b>Restoration</b>        | The proceedings by which a patent which has lapsed through failure to pay renewal fees may be restored.   |
| <b>Revocation</b>         | A request to have, for example, a patent revoked (ended) because it is not valid.   |
| <b>Royalties</b>          | The name given to the payments made by a licensee to the owner of a patent - the licensor.  |
| <b>RPCs</b>               | Reports of Patent, Design and Trade Mark Cases.   |
| <b>RSC</b>                | Rules of the Supreme Court. (The White Book).   |
| <b>Search Order</b>       | Previously known as an Anton Pillar Order taking its name from the first case that developed the concept (Anton Pillar V Manufacturing Processes, Limited [1976] Ch 55. Issued by the High Court, the order allows premises to be searched and infringing material seized. Safeguards exist to prevent abuse.   |
| <b>Security for costs</b> | Where a claimant neither resides nor carries on business in a state that is party to the Brussels Convention, the Comptroller can, in many proceedings, require them to give security for costs, for example, under section 107(4) of the Patents Act 1977 and rule 22(2) of the Design Right (Proceedings before the Comptroller) Rules 1989, before allowing the proceedings to continue. |

**SI**

Statutory Instrument.

**SPC**

Supplementary Protection Certificate (for medicinal and plant protection products). The certificate is intended to compensate a patentee for the loss of effective protection arising out of the time taken to obtain regulatory approval to place on the market as either a medicinal or plant protection product a product which is protected by a patent (the basic patent). The basic patent may protect the product as such, a process to obtain the product or an application of the product. A certificate takes effect at the end of the lawful term of the basic patent but does not extend the term of the patent itself. It extends the protection conferred by the patent in respect of the product covered by the authorization to place the corresponding medicinal or plant protection product on the market, and any use of the product as a medicinal or plant protection product that has been authorized before expiry of the certificate. Subject to the payment of renewal fees, the term of a certificate is equal to the period which elapsed between the filing date of the patent and the date of first authorization in the EC reduced by a period of 5 years. The term of a certificate may not exceed 5 years.

**Statement**

See entry under Claim above.

**Statutory Declaration**

A written declaration agreed in the presence of a Justice of the Peace or a person who is authorised to administer oaths, but not made upon oath or affirmation. (Statutory Declaration Act 1835).

**Statement of Case**

The statement and the counter-statement filed in *inter partes* proceedings are each a statement of case. Taken together, these documents

indicate the facts that are in dispute between the parties and the relief sought.

**Statement of Truth**

All statements of case, witness statements and applications to the court must contain a statement by the parties that they believe the facts they have set out to be true which must be signed.

**Stay**

A stay imposes a halt on proceedings. Within the courts, although proceedings may be stayed, any steps allowed by the Civil Procedure Rules or the terms of the stay, may be taken. Proceedings may continue once a stay is lifted.

**Subpoena**

A writ is a document which requires a person to do or to refrain from doing something. The Comptroller does not have authorisation to issue writs though under Rule 86 of the Patents Rules 2007, the Comptroller in relation to the giving of evidence, the attendance of witnesses and the disclosure and production of documents, has all the powers of a High Court judge other than to punish summarily for contempt of court.

**Substantive Hearing**

The final hearing in *inter partes* proceedings following which the Comptroller will issue a decision on the main matter in dispute.

**Supplementary Protection Certificate**

See entry under SPC above.

**Summons**

See entry under Claim form above.

**Tribunals**

Bodies outside the hierarchy of the courts with administrative or judicial functions. The Office is a Tribunal, monitored by the Council on Tribunals established in 1958.

**Third party terms**

Conditions placed on the reinstatement of an application or patent which are

designed to protect a third party who may have started to work the invention.

**TRIPS**

Trade Related Aspects of Intellectual Property Matters. (Part of GATT - General Agreement on Tariffs and Trade).

**Ultra vires**

[Beyond the powers]. Term relates generally to the excess of legal powers or authority. (A ground for judicial review).

**Witness statement**

A signed written statement equivalent to the oral evidence which that witness would, if called, give in evidence at the hearing.

**Writ**

See entry under Claim form above.



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