

## CHAPTER 9

### POST PUBLICATION FORMALITIES EXAMINATION

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## **Action on Return from Publication**

- 9.01 The following checks should be made on the dossier when you receive the “A Published” message from Publication Section;
- a) that the A letter and published specification have been correctly imported;
  - b) those documents open to public inspection should be marked as “YES” in the Public column of the TOC;
  - c) that OLFY annotations have been made where necessary
  - d) that the details on the published specification accurately reflect the information on the register and that all pages have been printed plus amended claims and further search reports if filed. If this is not the case, the details can be corrected for the ‘B’ print - an erratum is not normally issued at this stage unless the agent requests it;
  - e) whether a F10 is on the dossier
  - f) whether it is a Combined Search and Examination case – see 9.26 – 9.29
  - g) whether the case is a Divisional - see 9.30

## **Patents Form 10 not filed**

- 9.02 If a case does not have a F10 filed when it is returned from publication, the applicant has 6 months from the date of publication during which to file the form. 3 weeks before that date a reminder letter (F10R letter) is generated using the POLS system. Details of this and the procedure for terminating the application if the F10 is still not filed can be found at 11.36 et seq. The filing period for the F10 can be extended for 2 months under r.108(2). Further extensions under r.108(3) may be possible and details of procedures relating to this can be found at 10.28 et seq.
- 9.03 Bearing in mind that no further work will be done on the case unless a F10 is filed, any amendments to the specification, claims, or the drawings that have been filed on the application, before or during the publication cycle, are left unactioned until a F10 is filed.

## Patents Form 10 filed

- 9.04 The F10 may have been filed before publication in which case the form is already on the dossier. Cases with a F10 filed after publication need an additional check. The Formalities Examiner should ensure that the F10 has the correct fee. The current fee for all forms can be found in the latest Statutory Instrument relating to fees. The fee paid for the form will be stamped in the top right hand corner by Cashiers Section unless filed electronically or web filed.
- 9.05 The Formalities Examiner should then check that the form has been filed within the prescribed 6 month period from publication. If both of these are satisfactory the F10 filed box can be ticked on the Formalities Post Publication checklist.
- 9.06 If the application contains a priority document that is in a language other than English the Examiner may request under r.9(2) a translation of the document or a declaration to the effect that the application is a complete translation into English of the priority application. Such a translation or declaration must be filed within a period set by the examiner; this will normally be the same as the period set for response to the examination report. See 9.23 – 25.

## OPTICS action for cases ready for substantive examination

- 9.07 A newly filed F10 should be de-logged on OPTICS using the function **RECORD PRE**-grant form. The form number should be put in the first box and the filing date in the last box. The middle box should be left blank. This procedure should be carried out whenever a F10 is filed. This will automatically set the processing status to "Ready for Examination".
- 9.08 If the F10 was already in the dossier (but it is not a CS&E case) the Formalities Examiner should go into the **RECORD PRO**cessing status option and change the status from "A publication" to "Ready for Examination" (if the form has been delogged).

## Amendments

- 9.09 Once the Formalities Examiner has carried out the F10 check and action, the application should be checked for any amendments to the specification that have been filed. These may take a number of forms as outlined below:
- a) voluntary amendments filed with an applicant's letter (such as replacement pages, drawings etc);

- b) amended claims filed that have been added to the specification for publication;
- c) amendments on PCT cases where the IB have sent pages that have been amended in the International phase of the application;

### **Amendments filed with an applicant's letter**

9.10 Once voluntary amendments to the application have been identified the Formalities Examiner should check to ensure that the pages have been filed within the period specified in the last s.18 report. If the amendment has been filed outside this period the Formalities Examiner should check the covering letter to see if an extension under r109 has been requested.

An extension of up to two months is available under this rule if the request is in writing. Amendments filed outside this two month extended period and any amendment filed out of time with no request for extension should be forwarded to the Patent Examiner for consideration of allowability.

9.11 If the amendments have been filed in time they will need to be incorporated to create the working copy of the specification (if not already done before publication). The pages should be checked to see that they comply with r.14 and Schedule 2: for details see 4.80 et seq. The pages should then be incorporated, using the assemble function on Madras, into the specification to create a working copy ensuring that all the pages still run together. This specification should be annotated “Working Copy”

9.12 The superseded description and/or claims should have the annotation “Working Copy” removed.

9.13 If the pages do not comply with r.14 and Schedule 2 they should be incorporated but a note to the examiner should be made as follows:

*Examiner*

*Pages filed with A/L dated ..... do not comply with Schedule 2. Please add the following paragraph to your next report.*

*Replacement pages filed with your letter dated (date of applicants letter) do not comply with the requirements. Please file word for word copies that comply with Rule 14 and Schedule 2 of the Patent Rules 2007.*

9.14 The OPTICS status should be changed using **REC PRO** to

**AMENDMENT**

regardless of whether the amendment is voluntary (i.e. a letter) or a response to an examination report. This ties in with the PAFS action on the case.

- 9.15 If replacement drawings are filed, the Formalities Examiner will need to establish what drawings were filed at the date of filing and whether any formal drawings were filed later. There are two situations to consider. In both cases the two new sets of replacement drawings should be incorporated and annotated to read “Formal”
- 9.16 If the original drawings filed were formal or any drawings subsequently filed were formal the annotation “Formal” should be removed from the TOC.

The new formal drawings will become “Formal”

### **Amended claims added to the specification for publication;**

- 9.17 Where amended claims have been published alongside the existing claims they will have the code “ACLMS” in the TOC. The code should be changed to CLMS and annotated “Working Copy” and the annotation removed from the claims originally filed.

### **Amendments on PCT s89 cases**

- 9.18 Amendments received from the IB in relation to PCT applications can be received at any time pre or post publication. They can be received with the International Search Report, the International Preliminary Examination Report, a Notification of Change of Name or Address, or on their own. The s.89 and Post Publication checklist should confirm if any such amendments have been filed. It is important that they are identified or the substantive examination will be carried out on an out of date specification. The new and superseded pages should be handled as 9.10 above.

### **Urgent Amendments**

- 9.19 It is important that all letters and amendments are examined as soon as they are received in the Formalities Group so that those requiring urgent attention are actioned without delay. Letters and other documents may be filed which have been marked "Urgent" by the Agent/Applicant. All such letters and documents should be examined by the Formalities Manager to ascertain the degree of, and reason for the urgency, and dealt with accordingly. If an accelerated examination has been carried out then any subsequent amendments filed should also be treated as URGENT.

## **Amendments and the expiry of the Section 20 Period**

9.20 Particular note should be taken of any letters or amendments filed on applications nearing the end of the s.20 compliance period (4 years 6 months from the earliest declared priority date, or date of filing where there is no claim to priority; or 12 months from the date the first report under s.18 is sent, whichever expires the later).

Special action should be taken on all cases where less than four months remain of the s.20 compliance period.

9.21 The dossier cover should have the “Compliance Date Imminent” label added and all messages should be preceded with “**URGENT**”.

9.22 Documents must be actioned within 24 hours.

## **Translation of the Priority Document**

9.23 If the application contains a priority document that is in a language other than English or Welsh the Examiner may, if he needs a translation, request that the applicant files one, or a declaration to the effect that the application is a complete translation into English or Welsh of the priority application. A suitable declaration can be found in paragraph 6.55.

9.24 Where a translation is requested, the Examiner will set a period by which it should be filed and set a diary date for response. This will normally be the same period as that set for response to the examination report. Where no translation or declaration is filed the priority claim will be disregarded. When the Diary date matures the case should be forwarded to the Examiner stating that the translation/declaration has not been filed. The Examiner may ask Formalities to remove the claim to priority as per 6.64.

9.25 Where a translation or declaration is filed in response to the Examiner’s request the application should be forwarded to him/her for further consideration.

## **Combined Search and Examination Cases**

9.26 Following publication, the dossier is checked as in paragraph 9.01 a) and also to see whether any amendments have been filed in response to the Combined Search and Examination report which was issued prior to publication. If amendments have been filed, these will now need to be incorporated if not already done. If there is more than one set of amendments in the correspondence section, they should be used to create a

new working specification using the earliest filing first. The new and superseded pages should be handled as 9.10 et seq above.

- 9.27 When the pages have been incorporated the Action Log should be updated and a message sent to the examiner via the ESO.
- 9.28 The Amended Pages/Claims filed box and the Pages Incorporated box on the Formalities Post Publication Checklist should also be ticked. The OPTICS processing status will then need to be changed using **RECORD PROCESSING** status to "Amendment".
- 9.29 If there are no amendments to the application no further action is necessary. The application will await a response to the CS&E report or the maturation of a diary made by the Patent Examiner when the CS&E report was issued. The Formalities Examiner will not need to worry about OPTICS processing statuses as they have been set automatically. Once the Formalities Examiner has completed the post publication check, they should update the Action Log.

### **Divisional Cases**

- 9.30 A full post publication check should be carried out on a divisional application as for a CS&E case see 9.26 - 9.29 above and the application forwarded to the Patent Examiner as appropriate.

### **Grant Checks**

- 9.31 When the Patent Examiner is satisfied that the application complies with the Patents Act and Rules, the application will be forwarded for grant. It is important at this stage that ALL details are up-to-date and correct and that all relevant documents can be viewed on IPSUM.
- 9.32 The formalities check is similar to the check for s16 'A' publication. The Formalities Examiner should use the **PRINT FRONT** page option on OPTICS, over type the "A" with a "B" to obtain a 'B' print and use this to check the details on the dossier. The processing status should be checked using **DISPLAY PROCESSING** status to ensure that the application is set 'Ready for Grant'. **DIS FOR** should be checked to ensure no F21 has been filed for an assignment.
- 9.33 If a F21 has been filed to register an assignment (this can be checked by selecting TOC and ALL), a message should be sent to Register Admin Section where staff will complete the necessary action. If Register Admin cannot complete their action within 24 hours they will contact the applicant/agent and ask if they want the case to be granted or delayed for

one month. If the applicant/agent chooses the latter, the application should be set back to "No Longer Ready for Grant" with a diary action.

- 9.34 Since the application can be more than four years old, it is possible that the Agents may have changed address. The address on the F1 for the agents should be checked against the last correspondence on file. If the address on the F1 is different but the address on the 'B' print is correct then the Form 1 should be annotated "AFS change". Otherwise an up-to-date ADP number with the correct address should be obtained and the address on OPTICS updated using **REG**ister **NAME**/address case change.
- 9.35 Inventors names, priority details and applicants' details should be checked and any discrepancy corrected: normally by sending a message to Indexing and Scanning.
- 9.36 The grant title on page 1 of the specification should be checked against the 'B' print and any discrepancies pointed out to the Patent Examiner for correction. The application will then await the grant picklist.
- 9.37 **Once a case has entered the 'B' publication (grant) cycle it is not normally possible to withdraw it unless the office has made an error. In such cases advice should be sought and agreement at Divisional Director level will be necessary before the PLO can take action to remove a case from the cycle.**
- 9.38 If an error (such as no s.18(4) report having been sent) is discovered during the course of the 'B' publication cycle the Examiner should contact the agent immediately to establish if it is necessary to remove the case from publication to resolve the matter. If there are no outstanding issues or matters can be dealt with quickly by correspondence it may be possible to allow grant to continue and no withdrawal action will be needed.

## **Cases granted in error**

- 9.39 If an application has been sent to grant by the Office in error then the Publication Liaison Officer should initiate remedial action either to remove the case from the B cycle or to rescind the grant.
- If the case is still in the early stages of the B cycle it may be more sensible to simply withdraw it from the B cycle.
- However, if the 'B' letter has been issued and the case is near the end of the publication cycle then it may be advisable to delay action until the 'B' publication date has passed. In these circumstances Publishing Section should be advised to retain the Certificate of Grant.

The PLO in consultation with the Head of Admin, Publishing Manager and Patent Examiner will decide on the best course of action.

9.40 If or when the B Publication date has passed then the grant must be rescinded and the Publication Liaison Officer should carry out the follow corrective action:

- make the following free text entry in the Register –

“The grant of patent GB\*\*\*\*\* on (date of publication in the Patents Journal) has been rescinded under r.107(3)(a).”

- place the following erratum in the Patents Journal

“The grant of patent GB\*\*\*\*\* announced in the Patents Journal No. [\*\*\*\*] on [Date] was inadvertent and has been rescinded under r.107(3)(a). The patent will be re-granted in due course.”

- delete all relevant information on Optics to remove all ‘B’ publication cycle data and inform the Patents Deputy IT User Manager.
- a letter should be issued to the agent advising that the application was granted in error and that the grant certificate if issued should be returned to the Office. (see example letter at Annex 9A which should be amended as necessary to suit the circumstances of the case)
- the Notification of Grant letter and ‘B’ Document should be closed and annotated with the word “RESCINDED”.

9.41 Once the above action has been completed the application should be referred back to the Examiner or closed to await further action.

9.42 The application should not be re-granted until the date originally set for ‘B’ publication has passed. If a Certificate of Grant was issued the application should not be re-granted until it has been returned by the agent.

**Annex 9A**

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
Cardiff Road, Newport  
South Wales  
NP10 8QQ  
United Kingdom

**Direct line:** 01633 81\*\*\*\*  
**†E-mail:** \*\*\*\*\*@ipo.gov.uk  
**Switchboard:** 01633 814000  
**Minicom:** 08459 222250  
**Fax:** 01633 814444  
DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: xxx**  
**Application number: GB \*\*\*\*\*.\***

Date

Dear Sirs

**Patents Act 1977: Patent Rules 2007**

In your letter dated DD/MM/YYYY you stated your intention to file a divisional application on patent application number GB\*\*\*\*\*.\* (GB\*\*\*\*\*). Unfortunately this point was overlooked and the application proceeded to grant in error. The grant letter was subsequently issued on DD/MM/YYYY and the B specification published on DD/MM/YYYY. The divisional application was filed on DD/MM/YYYY and allocated the patent application number GB\*\*\*\*\*.\*.

As the grant letter was issued prior to the filing of the divisional application number GB\*\*\*\*\*.\* the conditions set out in section 15(9) of the Act have not been met. However, it is the Office's practice to delay grant when a divisional is foreshadowed and this practice was not adhered to in this case.

Therefore the Comptroller has exercised discretion under rule 107(3) to rescind the grant of patent application number GB\*\*\*\*\*.\* (GB\*\*\*\*\*) and thereby allow the filing of patent application number GB\*\*\*\*\*.\* on DD/MM/YYYY. Patent application number GB\*\*\*\*\*.\* (GB\*\*\*\*\*) will be re-granted in due course but first I will require the return of the certificate of grant and the B specification issued on DD/MM/YYYY.

Yours faithfully

Formalities Examiner

September 2011