

# CHAPTER 12

## MISCELLANEOUS

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## **Introduction**

- 12.01 This chapter covers those miscellaneous formalities activities that may occur at any stage of the processing of an application and may not have been covered in detail elsewhere in this manual.

## **Correction/Amendment**

- 12.02 Although the ordinary dictionary definitions of these words overlap, they are used in the Act and Rules in quite distinct and specific senses. Correction is the alteration of a document so that it may better express the intention the drafter had at the time of drafting. This includes the case where the person drafting the document has misconstrued their instructions. Where alteration is sought because the drafter has become aware of new facts, or because circumstances have changed, then this is not correction but amendment.
- 12.03 In short, where the document presented at the date of its filing was incorrect then it should be corrected. Where it was correct on its date of filing but the circumstances have now changed, then it should be amended. Section 19 of the Act deals with amendment: Section 117 deals with correction. A written request should normally be used in both cases.

### Correction

- 12.04 If an agent/applicant informs the office that an error was made at the time of filing, it may be possible to correct the application retrospectively to the date of filing by making a written request. Supporting evidence is not normally required unless there is reason to doubt the accuracy or validity of the information supplied.
- 12.05 If the correction request relates to a name then the request must be made on Form 20. Any other part of the Form 1 (e.g. priority details) F9A, F7, or the priority document may be corrected by making a written request. All Form 20s will be routed to Register Admin section in the first instance who will forward any s.117 corrections to Formalities to deal with using the message F20 CORRECTION.
- 12.06 In either case the request is considered by the Assistant Head of Administration or in his/her absence either the person substituting for them or the Head of Administration. A minute should be produced and imported into Madras explaining the background of the correction sought and, if there is any doubt as to the validity of the request, a recommendation as to its allowability. The case should then be forwarded to the Assistant Head of Administration via the Formalities Manager.

- 12.07 If the request relates to an error introduced by the electronic delivery of the application then it can be considered under rule 105(4). However, this does not apply if the error was already present prior to the transmission of the application.
- 12.08 If the correction sought is for the description or drawings (including adding a page or drawing missing from an application as filed (see 5.34 - 39 and 5.48 - 52)) then the Formalities Examiner should import a minute into the dossier to the Patent Examiner dealing with the application. If the request is to correct the erroneous withdrawal of an application see 12.105.
- 12.09 After the request has been considered, the file is normally returned to the Formalities Examiner with instructions for further action, e.g. to add a footnote, or to inform the agent if the correction is allowable. The Assistant Head of Administration will have made the correction on Optics and a corrected the Form1 by using the enhancer or by scanning a corrected version into the dossier. If the correction involves changing a priority (earliest) date then the application's time limits will also need to be changed on Optics. If a request to correct a name has been made other than on Form 20 then a form should be made up in the Office and the applicant/agent advised in the reply letter that future requests must be made using Form 20.
- 12.10 If a Formalities Examiner detects a clerical error in the course of their examination they should refer this to the Formalities Manager for consideration.

#### Amendment

- 12.11 A request to amend F1 should also be made in writing and should be accompanied by a copy of the form clearly identifying the proposed amendment. If only a name (including an agent's change of name) requires alteration, this must be done on F20 which should be dealt with by Register Admin Section. This does not include amendment of the address for service which can be requested by writing to the Office giving the application number and the correct details (r.49(3)).
- 12.12 Provided that F7 has not yet been filed, an applicant may be added, deleted or substituted upon a written request. However, when F7 has already been filed, then the change must be notified under s.30 and actioned by Register Admin Section.
- 12.13 A minute should be imported into the dossier explaining the background of the amendment sought together with a recommendation as to its

allowability. The case should then be forwarded to the Assistant Head of Administration via the Formalities Manager.

- 12.14 After the request has been considered, the file is normally returned to the Formalities Examiner with instruction for any necessary action, i.e. to add a footnote or to inform the Agent whether the amendment is allowable. The Assistant Head of Administration will have made the amendment on Optics and a corrected Form1 scanned into the dossier.
- 12.15 A request made in writing for amendment of the specification should be referred to the Patent Examiner as per 12.08 above.

## Decisions

- 12.16 Section 15A(7) of the Patents Act 1977 permits the Comptroller to refuse an application if any formal requirement has not been met. Those requirements designated as 'formal' in rule 25 are:
- A completed and signed F1 (r.12(1));
  - An application in English or Welsh (r.14(1));
  - The presentational requirements as described in rules 14(2) and (3) (Schedule 2, parts 1, 2 and 3)
- 12.17 At the preliminary examination stage, any formal requirements that have not been met will be notified to the applicant/agent using FL1A (see PFM, Chapter 7). Once the relevant time periods have expired, the Formalities Examiner will send a letter (FL48 -see Annex 12A) to the applicant/agent requesting, within two weeks of the date of the letter either:
- a) the outstanding requirement(s) with a full explanation of why they were not filed on time; or,
  - b) to make observations; or,
  - c) to request the opportunity to present the case to an official at the Office. The case should then be suitably diarised.
- 12.18 If the applicant or agent fails to respond to the official letter or letters, a decision will be issued (see Annex 12D).
- 12.19 The decision informs the applicant that the application will be refused by the Comptroller pointing out that it attracts a period of appeal to the Patents Court of 28 days from the date of the decision.
- 12.20 The decision should detail the relevant facts including the dates of **all** official correspondence relating to the failure to meet the formal requirements.

- 12.21 Once the decision has been prepared, it should be forwarded to the Assistant Head of Administration for approval and signature. If someone is substituting, they can sign the decision but should include the following words after their signature: "substituting as Assistant Head of Administration".
- 12.22 Once this has been done, the covering letter (FL49 - See Annex 12E) should be prepared and the decision dated.
- 12.23 The covering letter and two copies of the decision are issued to the applicant/agent. The original decision must be imported into the dossier with the copy of the covering letter. The case should then be diarised for 5 weeks.
- 12.24 When the diary has matured, the Formalities Examiner should check the DIS FUL register entry on Optics to see if a below the line entry has been made to indicate that an appeal has been lodged. If an appeal has not been lodged a "No appeal lodged" message should be created for the Formalities Manager for termination. Should an appeal have been lodged the application should be referred to Litigation Section by the Formalities Manager. They will assume responsibility for the application during the determination of the appeal.

## **Caveats**

- 12.25 Section 118 of the Act allows for third parties to obtain certain information about patent applications and patents. To obtain this information the third party will file Patents Form 49 and the prescribed fee together with details of the information required. The specific information that can be requested is listed in r.54.
- 12.26 It should be noted that the Caveat request is a confidential contract between the Office and the third party only. As such, the F49 is NOT kept on the dossier or listed on IPSUM and no other party (including the applicant) should be made aware of its existence.
- 12.27 When a F49 is received, the Caveat Officer will import into the dossier a Caveat notice. This will show details of the information requested by the Caveat. A warning label will also be added to the cover of the dossier.
- 12.28 **Any dossier that carries the Caveat warning label should be treated with great care.**
- 12.29 When any action is taken that is the subject of a Caveat request as detailed on the Caveat notice, the Formalities Examiner will minute the dossier and

send a message to the Caveat Officer **as soon as the event/procedure being monitored has occurred.**

12.30 The Caveat Officer will extract the information required. If the Caveat request has been met then it will be cancelled and the relevant notices removed from the dossier.

## Refunds

12.31 There is no provision for **properly** paid fees to be refunded. However it is Office practice to grant ex-gratia refunds in certain circumstances as set out below:

- a) A refund of F9A can take place when an application is withdrawn, refused or the form is withdrawn prior to the issue of the search report;
- b) A refund of the F10 can take place when the application is withdrawn, refused or the applicant/agent requests a refund of the form prior to the issue of the examination report.
- c) A refund of the application fee can take place when the application is withdrawn, refused or the applicant/agent requests a refund prior to the issue of the preliminary examination report.

In the case of a) and b), where the dossier has previously been sent to the examining group, it should be referred back to the examiner to note their records (and claim their points) before the refund is issued.

12.32 A request for a refund of F9A which bases the request on the fact that the case claims priority from an earlier GB case which has been searched, should be refused. In the case of a divisional application, the procedure is as set out in PFM 14.28 in line with r.106(2)(b).

12.33 When a case is referred to the Formalities Examiner for a refund, it should be established whether the refund is to be made to a deposit account, to a credit or debit card or by cheque.

12.34 This information may be determined from the form that is to be refunded. If the cashiers' code on the top of the form begins with 'D' it means the customer has a deposit account with the office and this number can be used to issue the refund letter.

12.35 It may generally be assumed that firms of Chartered Patent Agents/Attorneys hold deposit accounts unless advised otherwise. Non-

account holders are identified by a code that begins with 'C'. The form will also indicate the method of payment used i.e. cheque (chq) or credit/debit card (Visa/Mastercard etc.). Payments made by credit/debit card must be refunded to the same card account.

- 12.36 Once the account status has been established, the Formalities Examiner should create the appropriate letter via PROSE and import it into the dossier on Madras. A message is then created to include the Ledger Heading for the type of form being refunded. - "REFUND LHXXXXX" (A list of Ledger Headings is available) and sent to the Formalities Manager.
- 12.37 The Formalities Manager will check the refund and delete the form from OPTICS (all screens) and annotate the form on Madras "~~XXXX~~ REFUNDED" followed by their initials and the date to show that it has been refunded.
- 12.38 The Formalities Manager should then create a message for the Refunds team mailbox specifying which type of refund it is eg. DEPOSIT ACCOUNT REFUND or CHEQUE REFUND. Finance will then print the letter and issue the refund. They will also create a message to the Formalities Manager and annotate the refund letter on the dossier once the refund is completed so that Formalities can monitor the progress of the refund should there be any customer enquiries.

## **Rule 53 - Confidential Treatment of Documents**

- 12.39 Rule 53 permits the sender to request that the Comptroller treat any document (other than a Patent Form or any document filed in connection with a request for an opinion) as confidential. However, such a request must be filed within fourteen days of the date of filing the document and be supported by reasons (extendable under r.108(1)).
- 12.40 If the request is not supported by reasons, the sender should be telephoned and asked to submit reasons in writing within fourteen days from the date of filing the request (extendable under r.108(1)). A telephone report should be issued and the case suitably diarised.
- 12.41 The document(s) containing the request, reasons and/or confidential information should be given the Doc Code "Confidential" and the Public Status should remain as "No" pending consideration of the request. The document should be annotated "Not Open to Public Inspection". Any document submitted with the r.53(1) request which does not itself contain the request, confidential information and/or supporting reasons, should retain its original Doc Code and be given the normal Public Status

appropriate to that document (i.e. “Yes” if the application has been published).

12.42 In addition, if a covering letter refers both to the confidential request and to other non confidential matters, Formalities should create a 'censored' (redacted) version of the letter that has the confidentiality request and any associated details removed. This 'censored' document should retain the normal Doc Code and be given the normal Public Status for that document (e.g. 'Yes' if the application is published). This 'censored' version may be created at the time of receipt or at the time of confirmation of confidential treatment of the other matter (see 12.45).

12.43 In a few cases, the r.53(1) request may appear in a letter which also contains some or all of the confidential information/supporting reasons to which the r.53(1) request relates. In those cases, the procedure at 12.41 should be followed. If the Formalities Examiner is in any doubt, the matter must be referred to the Formalities Manager for guidance.

12.44 When all of the required documentation has been received and placed on the appropriate part of the dossier, the case should be referred to either the Head of Administration or Deputy Director, depending on the circumstances of the case, for consideration of the request. The message should read “PSM R53”

12.45 If the request for confidential treatment is allowed, the Head of Administration or Deputy Director will direct the Formalities Examiner to carry out the following:

- a) Inform the sender in writing accordingly;
- b) Amend the annotation to “R53 Confidential NOPI” for each of the documents which have been accorded confidential treatment.
- c) Ensure the status is “No” in the “public” column on the table of contents in the dossier.

The copy of the Official letter which informs the sender that the r.53(1) request has been allowed should be set as “Yes” in the public column if the application has been published unless specifically directed otherwise.

12.46 If the request for confidential treatment is **not** allowed, the Head of Administration or Deputy Director will direct the Formalities Examiner to carry out the following:

- a) Inform the sender in writing accordingly;

- b) Change the Doc Code from “Confidential” back to the original Doc Code and remove the “Not Open to Public Inspection” annotation
- c) Set the Public Status to the relevant status for the original document (i.e. “Yes” if the application is published).

12.47 It is possible for a document to be accorded confidential treatment for a limited period only. In such a case, the Formalities Examiner will be instructed to action the case as above and also to diary the case for return to the Head of Administration/Deputy Director for the position to be reviewed.

12.48 Upon maturity of that period, if it is decided not to continue confidential treatment of a document, it will be necessary to inform the sender accordingly in writing. Instructions will be given for the Formalities Examiner to issue a letter, cancel the r.53 direction on the relevant document(s) and update the status (if necessary), the document code and annotation.

12.49 A direction under r.53 may be reviewed if a request for the information is received under the Freedom of Information (FOI) Act. If the need for confidentiality is deemed to be no longer valid eg because of the passing of time or change of circumstances, the direction may be revoked under r.53(6). Such requests should be directed to the Head of Administration or the FOI Officer.

12.50 Action cannot be taken under r.53 in respect of any Patents Form with the exception of Form 7 when the inventor has requested his name and address details be kept confidential (see 3.26 – 3.39). Any requests of this nature must be referred to the Head of Administration.

### **Rule 107 - Correction of Irregularities**

12.51 Other than by r.108, 109 (see Chapter 10) and 111 (see 12.61) the only means by which time limits can be extended is under r.107. This allows the Comptroller to exercise discretion to correct irregularities and extend time periods when the reason for the failure to comply with any limitation as to time or periods specified was caused, wholly or in part, by an error, default or omission on the part of the Office.

12.52 **Determination as to whether r.107 can be brought into play to extend time limits is complicated and the outcome of such consideration cannot be preconceived. Accordingly, the Formalities**

**Examiner/Manager must discuss any such instances with the Head of Administration.**

- 12.53 On receipt of a request under r.107 or where it is clear that there has been an error or omission on the part of the office, the Formalities Examiner should minute the dossier and send a message to the Head of Administration via the Formalities Manager explaining the facts surrounding the request and indicating whether they agree with it or recommending that rule 107 be exercised.
- 12.54 If the request is allowed, the Head of Administration will minute the dossier back to the Formalities Examiner/Manager requesting a letter be issued to the agent/applicant, and giving an appropriate form of wording to use.
- 12.55 Where a withdrawn application is reinstated under rule 107, 3<sup>rd</sup> party terms should be considered (see 10.63) except in cases where the applicant has done everything which was required of him and the irregularity is wholly the fault of the office. (e.g. Form 10 filed in time but not actioned and application withdrawn in error). This stems from the judgement of Pumfrey J allowing an appeal by Eveready Battery Company Inc. in the Patents Court on 18th May 2000.

**Rule 110 & 111 Postal Interruptions and Delays**

- 12.56 Under normal circumstances the filing date of a document is the date it is received by the Office in the normal course of business. Where any document (other than a new patent application not claiming priority) sent by post is received at the Office on a non-working day, it is treated as having been received on the next working day. Therefore, any time limit expiring on such a non-working day will be automatically extended to the next available working day.
- 12.57 Rule 110 states that the Comptroller is empowered to certify that there is a general interruption to the UK postal service or that there is an event or circumstance causing an interruption to the normal operation of the Office (eg. a certificate was issued following the London bombings on 7<sup>th</sup> July 2005, other examples may include strikes or adverse weather conditions). This provides for an automatic adjustment of time limits affected.
- 12.58 When there is such a disruption, the Comptroller may issue a certificate (see Annex 12F). The effects of the certificate can be retrospective, prospective, or both as the situation may require. The issue of such a certificate means that any period prescribed by the Act or Rules for doing or filing anything ending on a day on which there is a certified postal or

other interruption, the period in which that thing may be done or filed is extended to the first day after the end of the period of interruption.

- 12.59 In accordance with r.110(3), where a priority date is claimed and the period of 12 months following the date of the priority application ends on a day when there is a certified postal or other interruption, the claim for priority will be valid provided the declaration is made on, or before the first filing day after the expiration of the interruption.
- 12.60 Where it is necessary to apply the provisions of r.110(1) or (3), the case should be referred to the Head of Administration via the Formalities Manager. Disputes concerning filing dates which do not clearly fall under either rule 107 or rule 110 should be referred to the Head of Receiving Section in Finance.
- 12.61 Rule 111 allows the Comptroller to extend a time period where failure to do something under the Act or Rules was wholly or mainly attributable to a delay in, or failure of, a communication service. This could relate to either out going or incoming correspondence and includes post, electronic communications and courier. Any requests for an extension of time under rule 111 should be referred to the Head of Administration for consideration.
- 12.61a If an applicant or agent reports that correspondence sent to them by the Office has failed to arrive or that correspondence intended for someone else has been delivered to them in error then a 'lost correspondence' report should be made to the Head of Administration who maintains a record of such instances for data security purposes.

## **Returning documents to the Applicant**

- 12.62 There are various reasons for returning documents to the agent/applicant:
- a) Documents that have clearly been filed in error;
  - b) Supporting documents when an application has been withdrawn prior to early publication, e.g. priority documents, translations or formal drawings (providing informal drawings are already on file);
  - c) Priority documents or translations when the claim to priority has been removed prior to early publication;
  - d) Under the circumstances described in paragraphs 4.46- 4.52 PFM.

It should be noted that documents cannot be returned once early publication has taken place except when clearly filed in error.

- 12.63 Documents returned to an agent/applicant should have any official date stamps cancelled and initialled. In some cases, documents may be refiled later in the life of the application or, in the case of priority documents, translations or drawings, on another application. It is therefore important that the date of refiling is clear and can be distinguished from the earlier cancelled date.

## Diary Dates

- 12.64 Cases are diarised to await the filing of a document or action by Formalities staff or the Patent Examiner. Examples of this are: awaiting the filing of claims when F9A has been previously filed and, awaiting the possible filing of a divisional application or further amendments before grant.
- 12.65 An electronic diary system is available via the E Mail system. Any member of staff wishing to record a diary request should enter the file number against the relevant date for its retrieval on the PD Diary. Patent Examiners should simply enter the examining group after the number; Formalities staff should enter the Formalities group after the number. e.g. GB0806807.6 - EX01 or GB1006807.6 F5
- 12.66 Nominated individuals hold full access rights to the electronic diary and they are available to provide any further guidance required on use of the diary.
- 12.67 The designated diary officer (normally the Formalities Support Officer) will check for maturing diaries on a daily basis for dates at least 3 days in advance.
- 12.68 Subject to local arrangements, when a case is being referred to a patent examiner and there is an active diary on the case, the diary entry should not be cancelled. Instead, the case should be minuted along the following lines:

*"Examiner*

*Please note that this case has been diaried for..... If as a result of the current action you no longer require the case on the above date, you should cancel the diary entry. If you do not wish the diary to be cancelled, no further action is required and the diary will be allowed to mature and actioned in the usual manner."*

## Deceased Applicants

- 12.69 If an applicant dies the application may proceed in the name of the personal representative. If the Office becomes aware of the death of an applicant before a patent is granted but the application has not been assigned to another party by the time it is in order for grant and a personal representative has been appointed, the patent should be granted in the name of the personal representative.
- 12.70 The Formalities Examiner should forward the dossier to Register Admin Section who will advise of the requirements to record/register the new applicant and request the probate or letters of administration, to confirm the personal representative.
- 12.71 However, if a personal representative has not been appointed by the time the application is in order for grant, the patent should be granted in the name of the deceased applicant. (see also 2.32)

## Assignments

- 12.72 Requests for the substitution of the applicant(s) under s.30 of the Act are dealt with by Register Admin Section and are made on F21. When such a request has been made, but certain requirements are outstanding, Register Admin Section will note the dossier:

*"Section 30 (1977 Act) Application filed ....."*

A message will be sent to Formalities for further action if appropriate.

- 12.73 If the application has not been published, every effort should be made to complete the assignment action before the application is sent for early publication. If this is not possible, Register Admin Section should be notified for the action to be completed as soon as the case has been published and consideration be given to any erratum action that may be necessary.

- 12.74 Where substitution of the applicant is allowed under s.30, Optics will be updated only
- a) If the assignment is effected before early publication the relevant footnote should be entered onto Optics (Box 13) - "This print reflects an assignment of the application under the provisions of section 30 of the Patents Act 1977."
  - b) When the assignment is effected after early publication Register Admin Section will take the necessary action with

regard to the Patent Register. However, a check of the OPTICS details and the F1 should be made.

## Inter-partes Cases

12.75 An inter-partes case is one in which the Comptroller has been asked to adjudicate between the conflicting submissions of two or more people who each claim an interest in a patent or patent application. Such cases are dealt with by Litigation Section whether or not the application has reached the grant stage, and all letters relating to the dispute are kept by them in a separate inter-partes file.

12.76 Letters on inter-partes matters are likely to refer to one or more of the following sections of the Act:

- *Section 8* - Relating to disputes before grant concerning entitlement to patents.
- *Section 10* - Relating to disputes between joint applicants about the handling of their applications.
- *Section 12* - Disputes concerning questions of entitlement to foreign and convention patents.
- *Section 13* - Disputes concerning an individual's right to be mentioned as inventor or co-inventor.

They can be identified by checking the "*your ref*" part of the letter. The reference will be the room number followed by the Litigation Case Officer's initials e.g. 3Y31/ABC

12.77 **Formalities Examiners should not attempt to deal with any correspondence relating to inter-partes matters. If you are in any doubt the document should be referred to the Head of Litigation Section.**

12.78 In cases where Litigation Section has already raised their parallel file to handle inter-partes correspondence, they will attach a label to the dossier cover and import a warning sheet into the TOC. The sheet carries the following statement: "Warning - Do not take any action to terminate this case without consulting Litigation Section".

12.79 Where these notices have been placed on file, only the letter and any enclosures are required by Litigation Section. If there are no notices attached to the dossier, it may be the letter is the first notice of inter-partes

action the Office has received. In this case, Litigation section should be informed.

- 12.80 Where a letter is received which does not mention any of the sections of the Act listed above, but the content suggests an inter-partes matter, the letter should be referred to Litigation section immediately.

## **Allocation**

- 12.81 Each day, new application dossiers are sent to the Formalities units' Madras mailboxes, from Indexing and Scanning who have received them from Security Section. Before a new application can be processed or moved on to the search stage, it has to be allocated to a Formalities and Examining group. This is normally done by the Formalities Manager.
- 12.82 This is done by allocating the case to a particular subject matter heading and then to the examining group responsible for that heading. To achieve this, the Formalities Manager gleans identifying phrases or words from the description and claims and searches the ECLA key using electronic search tools such as Esp@cenet.
- 12.83 From this the heading can be identified and the group can be found via the allocating sheet. As each examining group has a Formalities group linked to it, this will enable the proper home to be found for the case.
- 12.84 Cases on which an application fee has been paid and a Form 9A has been filed are 'fine allocated' to both a heading and group. Cases without a F9 are only 'rough allocated' according to end digit. Should a member of staff need to, identify the unit to deal with such a Pre-F9 case he/she can consult the Admin staffing lists which show which unit deals with the relevant end digit.
- 12.85 OPTICS function REC ALL is used to record the Group and Heading as appropriate. The same function is used to update the details following transfer of a case to a different group or heading.

## **Section 21 (Third Party) Observations**

- 12.86 Section 21 of the Act states that **after** an application has been published, but before a patent is granted, any third party may make observations in writing as to whether an application is patentable. A dedicated e-mail address exists for this purpose - [section21@ipo.gov.uk](mailto:section21@ipo.gov.uk)
- 12.87 This means that if a third party can provide evidence that an application is not novel or lacks inventive step then the Office will consider this information during the substantive examination of the application whilst

determining whether to grant a patent. Such observations may be filed before early publication and will be acknowledged immediately but will not be dealt with formally until the application has been published.

- 12.88 When a letter or e-mail is received from a third party stating that it contains observations in accordance with s.21 (or in the case of a private individual it appears so), the Formalities Examiner should ensure the documents have the Doc Code TPOBS and select the Third Party Observations label on the front cover of the dossier. The letter should be checked for personal data and redacted if necessary; an OLF1 annotation should be applied to the version to be displayed on IPSUM. The dossier should then be minuted and a standard message S21 OBS sent to the patent examiner. (See FGN 01/11)
- 12.88a If the first s.18 report is not due the examiner will write to both the applicant and the third party advising the applicant of the 'observations' and acknowledging receipt to the third party. If the observations contain any offensive or libellous material the examiner should redact it. Care should be taken to issue the **redacted** copy to the applicant and not the original.
- 12.89 It should be noted that the filing of observations under s.21 does not make that person a party to the proceedings and therefore no information beyond that allowed by s.118 should be given to that party.

### **Evidence (r.87)**

- 12.90 In legal proceedings the office may invite or require an applicant to provide evidence to support their request for reinstatement, extension of time or late filing of a document etc.
- 12.91 Evidence is information given by an individual to establish a fact or point. It should be based on what the person giving the evidence has seen or heard or what action they may have taken. It may be in the form of a statutory declaration, affidavit or witness statement or in some other form such as a letter giving reasons for the error/late filing. It is for the applicant to provide whatever evidence he believes will best support his case.

The applicant may be asked to present his evidence in the form of a Witness Statement if this would assist us in making a decision or add further weight but if he refuses then the matter will be decided on the basis of the evidence provided.

If a hearing is appointed then once the case has been referred to the Hearing Officer, Rule 87 will apply and any further evidence submitted should normally be in the form of Witness Statement unless the Hearing Officer directs otherwise.

- 12.92 An affidavit or statutory declaration is a written statement made upon oath and signed in the presence of a notary public (solicitor, JP etc). The affidavit or declaration should be on good quality white A4 paper and the original, not a copy should be filed at the Office. If the declaration or affidavit is filed in a language other than English, it should be accompanied by a translation.
- 12.93 A witness statement is a written statement signed and dated (in accordance with the Civil Procedures Rules (notably rule 32.8 and the associated Practice Directions)) by a person and which contains the evidence that person would be allowed to give orally. It must include a 'statement of truth' by the witness that he believes the facts in it to be true. A useful A5 size guide entitled "*Evidence*" can be obtained from Litigation Section or from the Office website.

### **Supplementary Protection Certificates (SPCs)**

- 12.94 A Supplementary Protection Certificate extends the protection conferred by the basic patent beyond the normal 20 year term for a maximum period of five years. It is only available for medicinal or plant protection products which have suffered delays before being authorised for marketing in the EC. All SPC enquiries should be directed to the SPC Officer in Formalities or his/her deputy. If neither is available then the enquiry should be routed to one of the SPC examiners in Examining Group EX06 or ultimately the Group Deputy Director.

### **Withdrawal**

- 12.95 The withdrawal of applications is the responsibility of the Formalities Manager. All documents with a document code of "WDRL" received in the Formalities Group team mailbox must be checked by the Formalities Manager to ensure that all letters requesting withdrawal are immediately and correctly identified.

Once a withdrawal letter is identified the Formalities Manager must ensure that where possible the withdrawal is carried out the same day. The Optics action to terminate the case should be carried out by the Formalities Manager or deputy.

If it is not possible to action the withdrawal on the same day the Formalities Manager should ensure that the Optics status of the application is such that it cannot enter the publication cycle. This is to ensure that we do not inadvertently publish a withdrawn application.

A withdrawal request for a case already in the publication cycle should be passed to the Publication Liaison Officer immediately. The PLO will deal with the withdrawal in accordance with the procedures set out in 8.70 – 88.

- 12.96 An application for a patent may be withdrawn at any time before a patent is granted. Any request for withdrawal must be clear, unqualified and made by an authorised person. In the case of unrepresented joint applicants, all the applicants must authorise the withdrawal. Any withdrawal request received in the Office that does not meet these requirements will not be acted upon.
- 12.97 However, if a withdrawal request does meet the requirements, then its effect is immediate upon receipt in the Office (except as in 12.101). When an unequivocal request for withdrawal has been actioned the applicant/agent will be informed using the PROSE Confirmation of Withdrawal letter (see Annex 12G). This letter should not be issued until after the Optics action to terminate the case has been done.
- 12.98 The request should use the words "*withdrawal*" or "*withdrawn*" and express a clear and positive intent to terminate the application. A statement such as 'the applicant is no longer interested in prosecuting the application' or is 'abandoning' it, is not sufficient. For example, an applicant may state that he does not intend to file F10; such an indication is not binding on him, and he may change his mind and file the request within the prescribed period. Similarly, an applicant may indicate that he does not intend to reply to a report issued under s.18(3). In such cases, the file should be stored until the relevant periods have expired and the application is then treated as having been withdrawn or refused.
- 12.99 If the applicant or agent has indicated that he does not intend to proceed, but has not unequivocally and in writing withdrawn the application, and some course of action by the Office, such as search, early publication, substantive examination or grant, is pending, he should be asked to indicate in writing his clear intentions. If no clear withdrawal is forthcoming the application will proceed.
- 12.100 If the applicant or agent indicates over the telephone that he wishes to withdraw an application, he should be told to express his intention in writing. If no letter is received the request will not be acted on.

- 12.101 If a letter of withdrawal and a retraction of the request are filed on the same day the withdrawal will be deemed to be unclear and will not be acted upon.
- 12.102 If at any time the applicant or agent purports to affect a conditional withdrawal, he should be requested to file an unqualified statement of withdrawal, failing which the application is regarded as still in being.
- 12.103 If the applicant or agent's request for withdrawal is conditional upon the application not being published and it is too late to prevent publication, and it appears likely that it was only intended to withdraw if publication could be prevented, the Formalities Examiner should contact the applicant or agent and request clear instructions.
- 12.104 Whenever an application is withdrawn after Search, the Formalities Examiner should prepare the withdrawal letter using Prose and import into the dossier. One copy should be printed and issued. The action log will need to be noted concerning the termination. They should then create a message to the Formalities Manager for termination. The Formalities Manager will terminate the application on OPTICS using REC PRO. The effective date of the withdrawal should be entered and not the date the OPTICS action is done.

## **Resuscitation**

- 12.105 If an application is withdrawn in error, s.14(10) allows the error to be corrected under s.117 and the application to be 'resuscitated'. A written request to correct should be made and should be accompanied by supporting documentation or explanation to show why/how the error occurred.
- 12.106 Any requests to correct an erroneous withdrawal should be minuted to the (Assistant) Head of Administration. If the withdrawal occurred **before** publication the (Assistant) Head of Administration should reverse the termination on Optics using CHA CAS. An erratum notice should be sent to Publishing section for inclusion in the next available Patents Journal (See Annex 12B) and the applicant/agent informed that the correction has been allowed.
- 12.107 If the request to resuscitate relates to an application which has been published and its withdrawal has been advertised then 3<sup>rd</sup> party terms will apply as set out in s.117A. Any correction to an erroneous withdrawal which is allowed on a published case must be made by Order (s.117(4)). A 'Resuscitation Order' is available in PROSE (see Annex 12C).

- 12.108 The (Assistant) Head of Administration will reverse the termination using CHA CAS and send an erratum notice for the next available Patents Journal (see Annex 12B). The applicant/agent should be informed that the correction will be advertised as allowed and informed that 3<sup>rd</sup> party terms will apply.

## **Withdrawal of applications by e-mail**

- 12.109 An application may be withdrawn by sending an e-mail message to the office. The procedure outlined above in paragraphs 12.94 - 12.104 will still apply for withdrawal requests received by e-mail. Only the medium through which the withdrawal request is delivered will be different.
- 12.110 Directions under section 124A of the Act were made by the Comptroller and these directions give us the legal authority to receive this type of e-mail correspondence. The directions can be found in Annex 12H.
- 12.111 All email withdrawal requests should be sent to:

[withdraw@ipo.gov.uk](mailto:withdraw@ipo.gov.uk)

Any e-mail messages sent to other Office email addresses should be forwarded to the Head of Administration or a PLO.

- 12.112 A designated PLO will be responsible for reading the messages, importing a copy of the email into the dossier, actioning them or creating a message to the relevant unit for action. Before carrying out any of these actions the PLO should satisfy themselves that the person who sent the e-mail is party to the application and is therefore eligible to withdraw the application. The sender of the e-mail should identify themselves in the body of the e-mail. If the sender of the e-mail cannot be identified the message should be forwarded to the Formalities Manager for further action.
- 12.113 Once an e-mail message has been received at the above address an e-mail acknowledgement should be issued. The content of the e-mail acknowledgement will depend upon how and when the e-mail message will be actioned.
- 12.114 If an e-mail withdrawal request is received and the application is not in the 'A' or 'B' publication cycles the following return message can be sent:

“Thank you for your e-mail (reproduced below) which was received in this Office on ..... You will shortly receive a written response on paper from this Office, sent to the address for

service for the application, confirming the action we have taken in response to your request”.

This e-mail response should include a copy of the original e-mail. Import a copy of the reply into the dossier and create a message to the relevant team mailbox.

- 12.115 If the e-mail message withdraws an application which is in the ‘A’ or ‘B’ publication cycles the PLO responsible for reading the messages should carry out the procedure outlined in paragraphs 8.76 - 8.83. Once this procedure has been carried out the following return email message should be sent:

“Thank you for your e-mail (reproduced below) which was received in this Office on ..... The application has been withdrawn/not been withdrawn and the application will/will not be published. You will shortly receive a written response on paper from this Office, sent to the address for service for the application, confirming the action we have taken in response to your request”

If the application has **not** been withdrawn the e-mail should give a reason why this is the case e.g. that the request to withdraw was received after the PPC date.

- 12.116 All applications that are withdrawn by e-mail should have a confirmatory letter sent to the address for service of the application as per 12.104 above. A copy should be imported into the dossier.

A. N. Other  
%An Agent  
Any Street  
Any Town  
Any Place  
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  
Request for formal drawings**

The formal drawings requested by DD/MM/YYYY have not been filed.

Your patent application will be refused unless by **DD/MM/YYYY**:

- i) you file the requested formal drawings with a full explanation of why they were not filed on time; or
- ii) you make observations relating to the above requirement; or
- iii) you request the opportunity to present your case, in person if you choose, to a senior official at the Office.

If your application is refused, it will not proceed any further and no patent will be granted on it.

Yours faithfully

Formalities Examiner

September 2011

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†Use of E-mail: Please note that e-mail should be used for correspondence only.

**Applications Terminated before Publication**

Patent application GB\*\*\*\*\*.\* was announced as terminated (before publication in journal number \*\*\*\* dated DD/MM/YYYY. The application was withdrawn in error and has been resuscitated under the provisions of section 117(1).

**Applications Terminated after Publication**

Patent application GB\*\*\*\*\*.\* (GB\*\*\*\*\*.) was announced as terminated (after publication) in journal number \*\*\*\* dated DD/MM/YYYY. The application was withdrawn in error and has been resuscitated under the provisions of section 117(1) subject to the conditions of section 117A.

**PATENTS ACT 1977**

Date

APPLICANT                      A. N. Other

ISSUE                      Whether Patent Application  
                                    GB \*\*\*\*\*.\* should be  
                                    resuscitated under Section 117.

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**ORDER TO RESUSCITATE**

- 1      Patent application number GB \*\*\*\*\*.\*, filed on DD/MM/YYYY was withdrawn on DD/MM/YYYY at the request of A. N. Other. On DD/MM/YYYY A. N. Other requested a correction of the withdrawal under section 117.
- 2      Having examined the evidence filed in support of the request, I am satisfied that correction of the erroneous withdrawal should be allowed. I therefore order that the application be resuscitated.
- 3      Anything done in relation to the application between its withdrawal and resuscitation is treated as valid. Third parties have the rights provided by section 117A.

Head of Administration  
Acting for the Comptroller

September 2011



Annex 12E

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Place  
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  
Notice of issue of decision**

I enclose 2 copies of a decision dated DD/MM/YYYY.

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). If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the following address:

The High Court Appeals Office  
Room WG07, West Green Building  
Royal Courts of Justice  
Strand  
London  
WC2A 2LL  
(Telephone number \*\*\*\*\*)

Two copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee (currently £100) **within the time period specified in the decision**. The latest date for appeal is therefore **DD/MM/YYYY**. Any request for an extension to the appeal period identified in the decision must be made to the court.

Once you have filed your appeal, you must send a copy of the Notice of Appeal to this Office as soon as practicable and no later than 7 days from the date of filing the appeal.

Yours faithfully

Formalities Examiner

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†Use of E-mail: Please note that e-mail should be used for correspondence only.

September 2011

**COPY OF NOTICE ISSUED 7<sup>th</sup> July 2005**

**Patents Act 1977**  
**Trade Marks Act 1994**  
**Registered Designs Act 1949**

Pursuant to rule 111(1) of the Patents Rules 1995, rule 67(1) of the Trade Marks Rules 2000 and rule 76(1) of the Registered Designs Rules 1995, I hereby certify that there is an event or circumstances causing an interruption in the normal operation of the Office from (and including) 7 July 2005 until further notice.

Roger Walker  
Divisional Director  
Patents Directorate

The following notice was issued on 8 July 2005 on behalf of the Comptroller-General of Patents, Designs and Trade Marks:

Pursuant to the certificate issued on 7 July 2005, I hereby give notice that the normal operation of the Office will resume from midnight at the end of 8 July 2005.

Sean Dennehey  
Director of Patents

**Explanatory Note**

The interruption to normal operation lasts for the whole of 7 and 8 July 2005. Normal operation therefore restarts at 00:01 on Saturday 9 July 2005. This means that a time period specified in any relevant Acts or Rules, which expires on 7 or 8 July, is extended until Monday 11 July (since Saturday is, for all relevant purposes, an excluded day).

This does not mean that anything filed on Monday 11 July is automatically treated as having been filed on 7 or 8 July. For example, a UK patent application filed on Monday will not be deemed to have a filing date of 7 or 8 July. Similarly, the extension of time periods does not apply to patent applications filed with the Office under the Patent Co-operation Treaty or the European Patent Convention. Nor does it apply to community or international trade mark applications filed with the Office.

Despite the interruption to the normal operation of the London office, the Office remains open for business with no disruption either to Concept House or to our electronic platforms for customers who are registered. Similarly our [electronic webform for Trade Mark applications](#) is still available. Our fax filing facility also remains available (+44 (0)1633 814444).

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Place  
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  
Withdrawal of Patent Application under Section 14(9)**

Thank you for your letter dated DD/MM/YYYY.

I confirm that your patent application number GB \*\*\*\*\*.\* has been withdrawn as requested. The application will be advertised as being withdrawn in the Patents Journal.

The withdrawal is effective from DD/MM/YYYY.

If your withdrawal letter states that the withdrawal was done “without leaving any rights outstanding” (or words to that effect), then you can disregard the following paragraphs.

Unless you have explicitly given them up, some rights remain outstanding in the withdrawn application (in particular, the right to request correction of the withdrawal if it was done in error). Also, if you file a later application for the same subject matter, you can still claim priority from the withdrawn application.

September 2011

## Annex 12G

However, if you file a later application for the same subject matter and you want that later application itself to give rise to a priority right, then any “outstanding rights” on the withdrawn application must explicitly have been given up by the time the later application is filed. Also, the withdrawn application must not have been used as the basis for a priority claim in a later application.

Yours faithfully

Formalities Examiner

September 2011

## **Directions under Section 124A of the Patents Act 1977**

### **Withdrawal of Patent Applications by email**

1. These directions prescribe the form and manner in which email messages should be delivered to the Office to withdraw patent applications. If an email message to withdraw a patent application is delivered to the Office in a form or a manner which does not comply with these directions the Office may treat the message as not having been delivered.

#### **The email address to use**

2. The Office will accept requests to withdraw patent applications in accordance with Section 14(9) of the Act sent by email message to the following email address:

[withdraw@ipo.gov.uk](mailto:withdraw@ipo.gov.uk)

3. An email message withdrawing an application received at this address will be regarded as having the same effect as a written withdrawal on paper. The Office will only guarantee to accept requests to withdraw patent applications received at [withdraw@ipo.gov.uk](mailto:withdraw@ipo.gov.uk). No other proceedings under the Act or any other correspondence relating to business carried out by the Office should be sent to this address.

#### **Form of email required**

4. An email message sent to withdraw a patent application should be titled:

“Withdrawal of patent application number GBYYXXXXX.X”

5. The text of the email message should contain a statement of withdrawal that is not ambiguous or conditional. Such a statement could read:

“I withdraw patent application number GBYYXXXXX.X”

6. The email message should also contain some indication that the person withdrawing the application is authorised to do so, eg. that the person sending the email message is the applicant or the agent for the application.

7. The email message should contain no attachments and the request to withdraw the application should not be contained in an attachment. The request should be made in the body of the message.

8. The email should be a plain text email message (RFC822-compliant). We will not accept MS-TNEF/RTF format messages or HTML format messages. We will not accept messages that are encrypted or digitally signed.

## **Other matters**

9. The Office will interpret withdrawal requests made by email in the same way as we currently interpret written requests on paper and the procedures laid out in paragraphs 14.199-14.208 of the *Manual of Patent Practice* and paragraphs 12.95-12.104 of the *Patents Formalities Manual* will still apply. Both these manuals are available on the Office website, [www.ipo.gov.uk](http://www.ipo.gov.uk).

10. We will only act on the email in the form that it is received in the Office. We will bear no responsibility for email lost in transit or email that is corrupted in transit. The Office will inform the sender of a corrupted message that the message was not legible if the identification of the sender can be determined.

11. As part of our standard virus prevention procedures it is possible for internet email messages not to be forwarded automatically to the recipient on their receipt in the Office, and for them to await manual intervention before delivery. This may introduce an unavoidable delay in the time taken to deliver the message.

12. The time and date of receipt of the email message will be taken as the time/date stamp the message receives when it enters our internal email system. This will not be the exact date/time it was sent or the exact date/time it was received by our external server.

13. The Office will send a return email message confirming receipt of the withdrawal request. You should not assume the Office has definitely received your request until you receive the return message. The Office will subsequently confirm the withdrawal of the application in writing to the address for service for the application, as it does for other withdrawals.

## **Withdrawing applications by email before publication**

14. If an application is to be withdrawn by email in time to prevent publication, the email message must be received by this Office up to 23.59 on the day before preparations for publication are complete. Confirmation of receipt may however take place after that time. If the email message is received after that time, it will be too late to prevent publication.

## **Date of introduction of the new service**

15. Email withdrawals in accordance with these directions may be made from 8 July 2003.