CHAPTER 1

STANDARD PROCEDURES

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INTRODUCTION

1.01 The actions taken in Litigation Section when processing *inter partes* cases are similar for each type of proceedings. The following paragraphs set out the standard procedures common to each type of proceedings. These procedures may however vary in detail according to the type of proceedings, for example, in Design Right subsistence proceedings, an applicant may file a further statement in response to the counter-statement. These variations are described in each of the chapters which cover the types of proceedings.

1.02 The flow chart at the end of this chapter provides an overview of the various steps in the process.

INITIAL ACTION

Formal Requirements

1.03 *Inter partes* proceedings are initiated by the filing of a form. For most proceedings under the Patents Act 1977, for example, Patents Form 2/77 should be filed. For opposition proceedings, a Patents Form 15/77 should be filed. For design right proceedings under, for example, section 246 of the Copyright, Designs and Patents Act 1988 (subsistence, term or ownership), Design Right Form 1 should be filed whereas for proceedings under sections 237-9 and sections 247-8 of the Copyright, Designs and Patents Act 1988 (compulsory licences etc), the appropriate form is Design Right Form 3. Reference should be made to the appropriate Act and the relevant Rules with regard to any time limits relating to the commencement of proceedings. An opposition, for example, should be filed within two months of the opposition advertisement in the Journal. In all cases, the form should be accompanied by the appropriate fee (currently £50). If the fee is not present or is subsequently found to be cancelled, then the action is deemed not to have been properly filed. The form should also be accompanied by a statement of case.

1.04 On receipt in Litigation Section, the appropriate form and statement are referred to the B3 officer to carry out a cursory check. The check establishes, for example, that the correct section of the Act has been identified, the filing fee has been paid, a statement is attached and the correct patent number(s), if appropriate, have been quoted. If everything is in order, the B3 minutes the bundle of documents to the A1 to make up the appropriate files and a record card and to enter the details in the register and the section ledger. Since design right is an unregistered right, no register entry is required. If there are minor problems with the documents, for example, the Patents Form 2/77 has not been completed properly, the agent should be contacted, preferably by telephone, and with his/her agreement corrections may be made accordingly. These should be initialled and a record of the telephone call should be put on the open part of the file as well as a copy sent to both parties.

Action by Litigation Assistant (A1)

1.05 On receipt of the form, the statement and any accompanying documentation and the minute sheet, the A1 should enter the details in the ledger and make up the record card and files accordingly. If the proceedings relate, for example, to a granted patent, the patent file should be obtained from NMP and will be retained with the application until the dispute has been resolved. If the proceedings relate to a patent application, the application file should be obtained from the relevant Formalities group. Using the OPTICS function DIS FUL, a print should be obtained relating to the application or granted case. This is used to check, for example, that the name of the patent applicant/proprietor is correct on a reference or application.

1.06 For a European patent application (UK), the A1 should voucher for the file from NMP. If no file exists, then one should be made up (see Chapter 25 Making up of files).

1.07 The reference number from the ledger should be placed on the proceedings files and a free text entry made on OPTICS (see Chapter 25). A further DIS FUL print should be taken and this and the other documents received from the

B3 should be put on the appropriate file. The proceedings files should then be minuted back to the B3 with the patent files for further action.

STATEMENT

What should the statement contain?

1.08 On receipt from the A1 and prior to checking the statement, the B3 should ensure that the files have been made up correctly and that they show the correct representatives, if any. The register print should also be checked to ensure the correct entry has been made. Any errors should be corrected by the B3 or referred back to the A1.

1.09 When undertaking the substantive check of the statement, reference should be made to the appropriate Rules. For a reference under section 8 of the Patents Act 1977, for example, rule 7 of the Patents Rules 1995 states that the statement should set out fully:

- the nature of the question
- the facts upon which the person making the reference relies
- the order or other relief that he is seeking

For an application under section 247 of the Copyright, Designs and Patents Act 1988, for example, the appropriate rule is rule 10 of the Design Right (Proceedings before comptroller) Rules 1989. This states that the statement should set out the terms of the licence that the applicant requires the comptroller to settle and, if known, the name and address of the owner of the design right or, as the case may be, the copyright owner of the design.

1.10 When checking the statement, the B3 should also ensure that any other requirements specified in the rules are complied with (see Chapter 2 for further details).

What happens if the statement does not comply?

1.11 If it appears that the statement is inadequate, the case should be referred to one of the HOs responsible for preliminary litigation matters. Observations may be summarised in a minute together with any recommendations or alternatively, observations and recommendations may be discussed directly with the HO. The B3 will subsequently issue a letter pointing out the defects in the statement and will invite the claimant to file an amended statement.

1.12 This letter will usually express, for example, the ‘preliminary view’ that the statement is inadequate or ‘that the claimant appears to be requesting relief that may not be available’. The letter should point out that any amended statement should be filed within one month of the date of the letter. The letter should be copied to interested parties together with a covering letter.

1.13 If no reply is received to the official letter inviting an amended statement, the case should be referred to the HO for consideration of further action. If the defects are substantial, a second letter could be sent indicating that, in the absence of an amended statement, the Office proposes to strike out the action or treat it as withdrawn.

1.14 If it is found that there are documents referred to in the statement that have not been filed or that foreign documents have been filed without translations and these are the only defects, a letter should be issued to the claimant and again copied to other interested parties as mentioned above. The letter should request that the missing documents are filed in duplicate within one month of the date of the letter, under rules 112 and 113 as appropriate. However if reference is made, for example, to ‘without prejudice’ documents resulting from negotiations between the parties, the case should be referred to the appointing HO as it may not be necessary to request copies of such documentation (for further details, see Patent Hearings Manual).

1.15 If an amended statement or documents have been requested but are not received in the Office within the period specified, a follow-up letter should be issued giving a further 14 days for the supply of the documents. Again in the absence of a further reply, the HO should be consulted.

Serving the Statement

1.16 If everything is in order or put in order following Office correspondence, the B3 will send a copy of the statement and form to the patent applicant/proprietor and all interested parties. The letter should indicate that the statement is served and give a period of six weeks for a counter-statement to be filed in duplicate setting out the grounds on which the reference/application is contested. The case is then allocated to a Case Officer (B2). The letter serving the statement refers to the name of the Case Officer and asks that future correspondence be marked for his/her attention (see also Mediation). A copy of the letter should be sent to the claimant for information; however see below. A HO is also allocated to the case by the B3.

Section 118 and rule 95 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 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.

1.17 The files should be minuted to the B2 highlighting any peculiarities of the case. The B2 should be instructed to arrange an advert in the Journal and to B/F for six weeks to await the counter-statement.

COUNTER-STATEMENT

Contesting the proceedings

1.18 If any person who is sent a copy of the appropriate documentation wishes to oppose the proceedings, he must file, within six weeks of the date that the documents are sent to him, a counter-statement (in duplicate) setting out fully the grounds of his opposition. The period for the filing of the counter-statement is extensible at the discretion of the comptroller (see for example rule 110(1) of the Patents Rules 1995).

1.19 In the counter-statement, the defendant should reply in a reasonable manner to each of the grounds set out by the claimant by way of admission or denial and should assert any facts on which he intends to rely. What is not denied or "not admitted" may be regarded as admitted. Provided that a ground is replied to, the defendant is not required to argue with every point of detail advanced by the claimant.

1.20 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 eg that any documents referred to are enclosed (see paragraph 1.14 in relation to 'without prejudice' documents). If all is in order, prior to serving it, the case should be referred to the allocated HO. On return from the HO, the B2 may serve the counter-statement and set a period of six weeks for the claimant's evidence in chief.

Failure to file a counter-statement

1.21 Failure to file a counter-statement (except where the claimant has withdrawn unconditionally) will lead to the proceedings being treated as unopposed and the defendant will forfeit the right to take any further part in them (see Chapter 16). 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.

1.22 If, on this basis, such a reference is successful, then a decision will be issued accordingly. 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 opinion and offered a hearing before the reference is dismissed by a decision of the HO.

EVIDENCE ROUNDS

1.23 The first and third rounds of evidence are usually filed by the person who did NOT file a counter-statement but see also Chapter 3. Thus the claimant is invited to file evidence in support of his case within six weeks of the sending of the copy of the counter-statement. He must also send a copy of the evidence to the defendant.

1.24 If the defendant wishes to file evidence in support of his case, he must do so within six weeks of the sending of the claimant's evidence and must send a copy to the claimant. Within six weeks of the sending of the defendant's evidence, the claimant may if he wishes file evidence strictly in reply to the defendant's evidence. A copy must be sent to the defendant.

1.25 Each six week period for filing evidence is extensible at the discretion of the comptroller (see, for example, Chapter 16, item 5).

<u>Non-filing of claimant's/defendant's evidence (see Chapter 16)</u>

1.26 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.

1.27 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.

<u>Format of evidence (see Chapter 3)</u>

1.28 Evidence must be in the form of an affidavit, statutory declaration or witness statement or, if the comptroller thinks fit, it may instead or in addition 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.

DECISION

1.29 Once a decision is issued following the substantive hearing, a copy is sent on circulation by the A3 to all staff in the Section for information. The B3 officer receives a separate "Clear Records Pro-Forma" along with a paper copy of the decision. The B3 updates the register, if appropriate, with the result of the decision and completes the pro-forma. This advises the B2s of any subsequent action they should take. If the case is to be cleared, the B2 will forward it to the A3 ex parte team.

<u>A3 Action</u>

1.30 On receipt of the case from the B2, A3 should carry out 'clear records action' eg the file movement card and the ledger should be updated with the outcome of the decision. Journal entries should be arranged and if appropriate, arrangements should be made to update the A &/or B specification front pages. If the front page of a patent specification needs amending, the A3 will liaise with Publishing Section re the issue of new front pages and erratum slips. The patents file and the proceedings files will be sent to Publishing as appropriate ie after any appeal period has passed. Whether or not this action is necessary, the final action is to send the case to the appropriate destination. Firstly the Litigation Section green file should be placed inside the patent file and any evidence placed in boxes and labelled. Granted GB patents, EP applications and granted patents are sent to NMP and stored in the Precedent Store. GB patent application files should be returned to the appropriate Formalities Unit. Design right proceeding files should be sent to the Precedent Store at NMP.

EXCHANGE OF INFORMATION - PATENTS COUNTY COURT (PCC)

1.31 Following discussions with the Patents County Court, where parties have filed proceedings at the Office and have informed the Office that there are proceedings in the PCC, the Court 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.

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

MEDIATION

1.33 When serving the statement in *inter partes* proceedings, where appropriate, reference should be made to mediation as an alternative means of resolving the dispute. Information about the Office's Mediation Service should be sent to the parties.

1.34 Correspondence should include the following paragraph:

"Mediation

You may like to consider the advantages of mediation as a means of resolving this dispute. It seems to me that it may be a better option than continuing with these proceedings. There is further information in the leaflet enclosed, and on our website at the following address:

http://www.ipo.gov.uk/patent/p-manage/p-useenforce/p-useenforce-dispute/p- useenforce-dispute-mediation.htm

If all the parties to these proceedings agree to mediate, you should inform the Office and we will then stay the proceedings until the mediation has been completed".

Annex 1

STANDARD FLOW FOR *INTER PARTES* PROCEEDINGS