

CHAPTER 1

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1 STANDARD PROCEDURES

INTRODUCTION

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

INITIAL ACTION

Formal Requirements

1.04 *Inter partes* proceedings are initiated by the filing of a form. For most proceedings under the Patents Act 1977, two copies of Patents Form 2 should be filed. For opposition proceedings, two copies of Patents Form 15 should be filed. Reference should be made to the Act and Rules concerning any time limits restricting the commencement of proceedings. An opposition filed under section 75(2), for example, should be filed within two weeks of the opposition advertisement in the Journal (rule 76(2)(a)). In the case of other oppositions listed in Part 2 of Schedule 3 of the Rules, an opposition needs to be filed within four weeks of the date of the advertisement in the Journal. It is not possible to extend these periods.

1.05 In all cases, the forms should be accompanied by the appropriate fee. If the fee has not been paid or is subsequently cancelled, then the action will be deemed not to have been properly filed. The forms should also be accompanied by two copies of a statement of grounds (rule 76(1)). For proceedings started under section 46(3) by a person other than the proprietor, see Chapter 11 and rule 89.

1.06 On receipt in Litigation Section, the form and accompanying documents should be referred to the B3 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 of grounds has been filed and the correct patent number(s), if appropriate, have been quoted. If everything is in order, the B3 should:

- for cases other than GB cases, check if an LIT number exists; if not generate LIT number
- enter the proceedings in the ledger and excel spreadsheet
- allocate a B2 Case Officer and HO and enter the details in the excel spreadsheet
- minute the bundle of documents to the A1

- request the A1 enters the details in the register, makes up a proceedings file and arranges for the documents to be scanned into PECS

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

If the proceedings have been filed by two or more claimants who are not professionally represented, each of the claimants need to sign the Form 2. This is necessary even though one of the claimants may be shown on the Form as the main contact for the proceedings.

Action by Litigation Assistant (A1)

1.08 The A1 should action the minute from the B3 as follows:

- make a register entry to record the fact that the proceedings have been filed. Where LIT numbers are used, the register entry should record these (see Chapter 25)
- make up a green proceedings file
- check if the application/patent file is a PECS case as, for example, not all GB cases are on PECS
- if the application/patent file is already on PECS, complete an Indexing and Scanning Request Sheet (see annex 3) for each of the documents filed and send to Indexing and Scanning. A list of document codes and messages is included in Chapter 25.

PECS:- Message to be sent to Inter Partes team: User = Case Officer (as allocated by B3); Message = “See new F2” or “See new F15” as appropriate. The message only needs to be included in relation to the form.

- if the application/patent file is not a PECS case, obtain the paper file from NMP using the Litigation ‘Request for File’ Form DDU/P152/green or if the paper file is currently with another section, using Form DDU/P152/yellow. The file should be sent to Indexing and Scanning with the various Indexing and Scanning Request Sheets.
- if a file does not exist, obtain a copy of the patent specification and add this to PECS.

1.09 The proceedings file should be passed to the B3 or B2 for further action.

Action by B3 or B2

1.10 On receipt from the A1 and prior to the substantive check of the statement, the B3 or B2 should ensure that:

- the proceedings file has been made up correctly and shows the correct representatives, if any
- the register print shows the correct entry has been made

Any errors should be corrected or referred back to the A1.

PECS actions : The B2 should:

- update the front cover of the dossier with the appropriate labels – eg Litigation Proceedings.
- complete a ‘Names of Parties’ sheet and import into PECS (doc code is PARTIES). If the details change during the course of the

proceedings, import a new sheet. The previous sheet should be annotated "Details updated on (insert date)" and the entry closed.

Where proceedings refer to more than one patent/patent application.

- annotate the front cover of one of the dossiers to indicate it is the lead file for the proceedings and list the other cases in the proceedings as follows:

Proceedings under section X LEAD FILE

See also: GB XXXXXXXX, GB XXXXXXXX, LITYYNNNN

- make a similar entry on the front cover of each of the other dossiers as follows:

Proceedings under section X

See LEAD FILE GB XXXXXXXX

- import a minute into each of the dossiers under the Litigation procedure tab confirming the various proceedings (doc code is MINUTE-LIT).

Where proceedings are filed under various sections of the Act

- annotate the front cover of the dossier as follows:

Section 37 entitlement 01.10.08

Section 72 revocation 01.10.08

The substantive check of the statement of grounds may then be carried out.

Status of proceedings

At all stages during the processing of the case, the B2 should note the status of the proceedings. The current status and any key date should be recorded on the front cover of the PECS dossier. Only the current status should be shown. Any previous entries should be deleted. The paper proceedings file may also be used to record status information.

STATEMENT OF GROUNDS

What should the statement of grounds contain?

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

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

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

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

What happens if the statement of grounds does not comply?

1.13 If it appears that the statement of grounds is inadequate, the B3/B2 should seek to resolve the matter. If appropriate, the B3/B2 may

discuss observations and recommendations with a HO. The B3/B2 should subsequently issue a letter pointing out the defects and should invite the claimant to file an amended statement.

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

PECS:- Letter is created in Microsoft ® Word and imported using manual import (doc code is LETTER-LIT)

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

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

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

- if it is clear from the statement of grounds that the parties would have access to the missing documents/translations, formally serve the proceedings OR

- write to the claimant to request that the missing documents are filed in duplicate (see rule 79(2)) and set a time period of not more than one month for a response. The letter should be copied to all interested parties. They should not be invited to file a counter-statement at this time.

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

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

1.18 If the claimant does not respond to the official letter, the proceedings should be referred to a HO.

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

Serving the Statement of Grounds

1.19 If everything is in order or put in order then the B3/B2 should send a copy of the form, the statement of grounds and any other documents filed by the claimant to the patent applicant/proprietor and all those who it appears are likely to have an interest in the case (see annex 4). In determining who to notify, the B3/B2 should consider those named in the Register of Patents in relation to the patent or patent application, parties named in the statement, and any other persons who it appears are likely to have an interest in the case (rules 77(1) – (7)). The letter should:

- indicate that proceedings have started

- set a date for the filing of a counter-statement
- request the counter-statement be filed in duplicate
- request that any correspondence filed should be marked for the attention of the Case Officer

1.20 If the form and documents have already been sent, the letter should advise that the proceedings have formally started and request a counter-statement.

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

1.21 Section 118 and rule 55 does not authorise us to inform a claimant of a patent applicant's address for service in respect of unpublished patent applications. Consequently, before copying any correspondence sent to a patent applicant who is not a claimant, the following procedures should be followed:

1.22 The patent applicant should be contacted and asked if he is willing for us to disclose his address for service.

1.23 If he is unwilling for us to do so, then we must ensure that we blank out any letter heading indicating the address for service of the patent applicant when copying correspondence to the claimant.

1.24 If the case has been dealt with by the B3, he/she should then:

- send the case to the allocated B2 Case Officer
- highlight any issues that have arisen / are outstanding
- request the B2 to arrange a Journal advert
- request the B2 to diary the case to await a counter-statement.

PECS:- Minute is created and imported using manual import (doc code is MINUTE-LIT)

Create and send message to B2 Case Officer. Message = PSM
Advert is created and imported using manual import (doc code is ADVERT)

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

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

PECS:- Advert is created and imported using manual import (doc code is ADVERT)

COUNTER-STATEMENT

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

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

- which of the allegations in the statement of grounds he denies
- which of the allegations he is unable to admit or deny, but which he requires the claimant to prove

- which of the allegations he admits

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

PECS:- The A1 should complete an Indexing and Scanning Request Sheet for each of the documents filed and send to Indexing and Scanning. The B2 Case Officer may advise on the document codes to be used.

Message to be sent to Inter Partes team: User = Case Officer;
Message = "See letter" or "See counter-statement".

STATEMENTS OF CASE

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

MANAGEMENT OF PROCEEDINGS

Serving the counter-statement and initial recommendation

- 1.28 The B2 should check that the counter-statement has been filed within the prescribed period, including any extension allowed (see Chapter 2 and Chapter 16) and that it complies with the required formalities. If all is in order, a copy of the counter-statement should be sent to the other side with a letter pointing out that the proceedings will now be reviewed and we will consider the best way of proceeding with the case. A letter in identical terms should also be sent to the defendant (see annexes 5 and 6).

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

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

- Mediation: whether the issues and circumstances of the proceedings indicate that the matter could be suitable for settlement by alternative dispute resolution, such as mediation. In general, most cases will be suitable for mediation.
- Case Management Conference: whether the issues need further clarification and whether a Case Management Conference could be helpful

The B2 should also seek advice on:

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

PECS:- Minute to HO (if appropriate) and import using manual import (doc code is MINUTE-LIT)

Create and send message to HO. Message = PSM

Case Management Conference

1.30 A CMC may be held at any time during the proceedings. If a CMC is to be held, the parties should be informed (see annex 7 for suitable paragraphs). The proceedings should be referred to the hearings clerk who will then make the appropriate arrangements. The parties may be invited to attend a CMC at the Office or alternatively the CMC may be conducted by video or telephone. The parties' legal representatives

will normally be expected to attend but it is not necessary for the parties themselves to attend unless they wish to do so.

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

PECS:- Minute is created and imported using manual import (doc code is MINUTE-LIT)

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

Letter is created and imported using manual import (doc code is LETTER-LIT)

Preliminary Evaluation

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

Issuing early Preliminary Evaluation

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

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

1.33 On receipt of the Preliminary Evaluation from the HO, the B2 should add the Preliminary Evaluation to the PECS file and write to the parties as follows:

- enclose the Preliminary Evaluation
- inform the parties how evidence rounds are to be conducted (see Chapter 3)
- invite the parties to file evidence and set out timetable
- advise the parties that where they both appoint expert witnesses to file evidence, the witnesses may need to file a joint statement of agreed and disputed matters if the HO considers this is likely to save time
- invite the parties to agree a hearing date within a specified window. The window may be between 1 – 2 months depending on how the proceedings have progressed; however the agreed date should be no later than nine months from the date the counter-statement is sent by the Office to the claimant. The aim is to conclude proceedings within 12 months of the date a counter-statement is filed.

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

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

Preliminary Evaluation imported (doc code is PRELIM EVAL)

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

Preliminary Evaluation not issued

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

- encourage mediation

- advise parties Preliminary Evaluation is not to be issued at this time
- inform the parties how evidence rounds are to be conducted (see Chapter 3)
- invite the parties to file evidence and set out timetable
- advise the parties that where they appoint expert witnesses to file evidence, the witnesses may need to file joint statement of agreed and disputed matters if the HO considers this is likely to save time
- invite the parties to agree a hearing date within a specified window which allows 4 weeks after the final evidence round has been completed for the parties to consider any Preliminary Evaluation issued after the evidence rounds. The agreed date should be no later than nine months from the date the counter-statement is sent by the Office to the claimant. The aim is to conclude proceedings within 12 months of the date a counter-statement is filed.

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

Actioning response from the parties

1.36 The response from the parties should specify the agreed date for the hearing. The response may also confirm whether or not the parties have agreed to mediate. On receipt, the B2 should:

- confirm the agreed hearing date with the HO. If the parties have been unable to agree a date, the Office should set a date after consulting the parties, the hearings clerk and the HO
- advise the hearings clerk of any agreed date so that he/she may contact the parties concerning the arrangements for the hearing.
- liaise with A1 and arrange for the response to be added to PECS

- issue letter to the parties (see annex 11):-
 - advise parties whether or not hearing date agreed is acceptable
 - advise parties that the hearings clerk will be in contact in due course concerning arrangements for the hearing
 - confirm that the Office notes the parties have agreed to mediate
 - confirm whether the proceedings are to continue OR whether they have been suspended pending the outcome of the mediation

PECS:- The A1 should complete an Indexing and Scanning Request Sheet for any response filed and send to Indexing and Scanning. The B2 Case Officer may advise on the document codes to be used.

Message to be sent to Inter Partes team: User = Case Officer;
Message = "See letter"

B2 to create and import letter to parties using manual import (doc code is LETTER-LIT)

1.37 If the HO is not available on the suggested hearing date, consideration may be given to transferring the case to another HO so that the parties' agreed hearing date can be accommodated. In such a case, the B3 should be asked to allocate another HO and should update the excel spreadsheet and revise the *inter partes* HO rota table.

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

Failure to file a counter-statement

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

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

PECS: Minute is created and imported using manual import (doc code is MINUTE-LIT)

Create and send message to HO. Message = "PSM"

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

PECS:- Minute is created and imported using manual import (doc code is MINUTE-LIT); Message = "PSM"

Decision is imported using manual import (doc code is DECISION)

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

PECS:- Minute is created and imported using manual import (doc code is MINUTE-LIT)

Create and send message to HO. Message = PSM

Letter created and imported using manual import (doc code is LETTER-LIT)

EVIDENCE ROUNDS

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

Evidence filed sequentially

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

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

Evidence filed simultaneously

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

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

Format of evidence (see Chapter 3)

1.44 Evidence must be in the form of a witness statement, affidavit or statutory declaration 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.

Expert witness evidence

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

Action on receipt of evidence

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

- refer this to the HO.
- check following the second round of evidence if filed sequentially or the final round if filed simultaneously, whether a Preliminary Evaluation is to be issued prior to the hearing (see 1.31)
- check following receipt of final evidence whether it is necessary to request a joint statement from expert witnesses (see 1.45)
- issue letter to the parties (see annex 13): -
 - acknowledge receipt of evidence
 - remind parties to copy to other side if not clear this has been actioned
 - confirm the date for the next evidence round
 - advise parties where appropriate that a Preliminary Evaluation will be issued prior to the hearing

- request parties file a joint statement from their expert witnesses. Set deadline of 1-2 weeks prior to hearing
- check if the HO would like paper version of the evidence added to the PECS file at this stage. If so, pass to A1 for action. If not, file claimant's evidence in a green binder and the defendant's evidence in a blue binder. Complete cover sheet and annotate as appropriate.
- refer to hearings clerk following second round of evidence if filed sequentially or the first round if filed simultaneously in order for arrangements for the hearing to be confirmed.

PECS:- Letter created and imported using manual import (doc code is LETTER-LIT)

The A1 should complete a separate Indexing and Scanning Request Sheet for each piece of evidence added to the PECS file. Each witness statement received, for example, should be indexed separately and annotated to show who has filed it. Each exhibit should also be scanned and indexed separately and annotated accordingly. The B2 Case Officer may advise.

Physical exhibits should be taken to the manager of Indexing and Scanning to be recorded on PECS. The physical exhibit should be retained by the B2 until the proceedings have been finalised. It should then be returned to Indexing and Scanning for appropriate storage.

Message to be sent to Inter Partes team: User = Case Officer;
Message = "See evidence".

If evidence is not added to the PECS file at this stage, the B2 should annotate the front cover to show that evidence has been filed eg 'Evidence received – see CO'

Issuing later Preliminary Evaluation

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

PECS:- Letter is created and imported using manual import (doc code is LETTER-LIT)

Preliminary Evaluation imported (doc code is PRELIM EVAL)

Receipt of joint statement from expert witnesses

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

- refer this to the HO
- acknowledge receipt
- check if the HO would like the paper version added to the PECS file at this stage. If so, pass to A1 to action. If not, file on evidence binder and label accordingly.

PECS:- The A1 should complete an Indexing and Scanning Request Sheet for the agreed statement. The B2 Case Officer may advise on the document code and annotation to be used

Message to be sent to Inter Partes team: User = Case Officer;
Message = "See statement".

Physical exhibits for PECS cases

1.49 Where a physical exhibit is filed in evidence, the B2 should take this to the Head of Index and Scanning. A Non Scan code will be imported by Indexing and Scanning with an appropriate annotation. The front cover of the dossier will be amended to show the existence of a 'model'. The physical exhibit should be retained by the B2. Once proceedings are

concluded however, the exhibit should be sent to the Head of Index and Scanning so that records can be updated and the exhibit stored appropriately.

Non-filing of evidence (see Chapter 16)

Sequential

1.50 Where evidence is to be filed sequentially, if the claimant informs the Office that he does not wish to file evidence, the B2 should direct that the period allowed for the defendant to file evidence should begin immediately.

1.51 If the defendant informs the Office that he does not intend to file evidence, the B2 should inform the claimant that as there is no evidence to reply to, the third round of evidence will not take place.

Simultaneous

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

1.53 If the claimant files main evidence but the defendant informs the Office that he does not wish to do so, the B2 should inform the claimant and should invite the defendant to file evidence strictly in reply.

DECISION

1.54 Following the substantive hearing, a decision is issued. Occasionally a decision on the papers may be issued. The decision will be circulated to HOs and Litigation Section for information. The hearings clerk will manually import the decision into PECS.

1.55 The hearings clerk will send a copy of the decision to the B3 with a “Clear Records Pro-Forma” along with a paper copy of the decision. On receipt, the B3 should update the register, if appropriate, with the result of the decision and should send the pro forma to the B2. The pro forma advises the B2s of any subsequent action they should take, including clearing the case.

Clear records action

1.56 On receipt of the decision and pro forma from the B3 and once the appeal period has expired, the B2 should arrange for ‘clear records action’ to be carried out as follows:

- update the electronic ledger with the outcome of the decision.
- arrange Journal entries and if appropriate, make arrangements to update the A &/or B specification front pages. If the front page of a patent specification needs amending, the B2 needs to liaise with the ex parte team regarding publishing requirements for either a new front page erratum or amended specification. The patent file and the proceedings files will need to be sent to Publishing after the appeal period has passed.
- update the Precedent Store Ledger as appropriate
- send a PECS message to Formalities if the proceedings relate to a GB patent application

PECS:- File note is created to record all ‘clear record’ actions have been carried out and proceedings have been concluded. Import file note using manual import (doc code is FILE NOTE-LIT).

Add ‘Precedent’ label to front cover of dossier where a decision has been issued

Advert is created in Word and imported using manual import (doc code is ADVERT)

EXCHANGE OF INFORMATION - PATENTS COUNTY COURT (PCC)

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

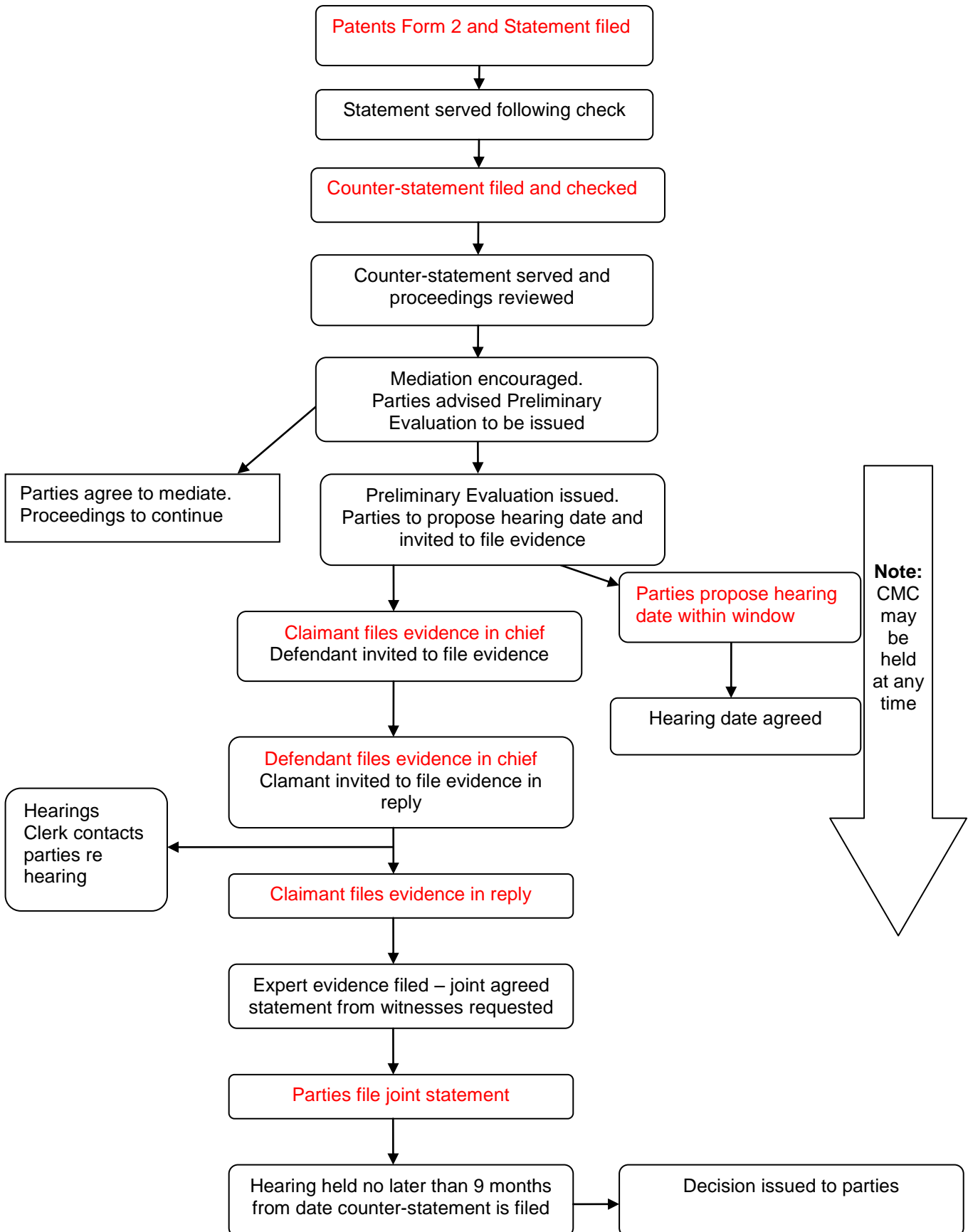
- the nature of the proceedings before the comptroller
- the parties involved and their addresses
- the patent number(s)
- the date the proceedings were filed
- the Patents County Court reference number(s) if provided

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

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

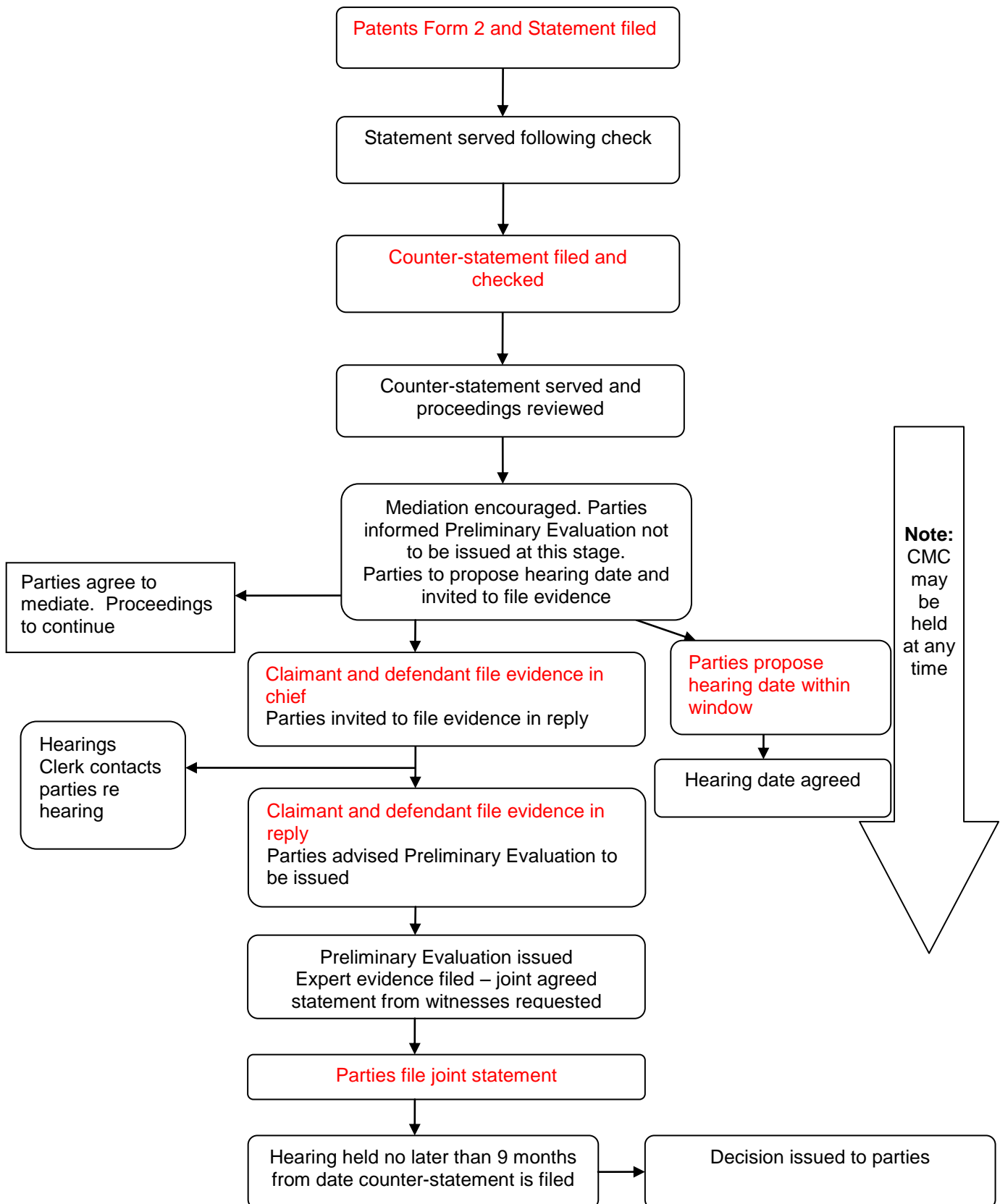
Annex 1

Preliminary Evaluation issued after counter-statement filed
(Note: evidence filed sequentially)



Annex 2

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



Annex 3

REQUEST FOR INDEX AND SCAN GY19

Please provide all of the following information:

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

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

Send message (if any) to:

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

Does this need to be processed urgently?

YES

NO

Other instructions:

Include any instructions to annotate

Annex 4

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81xxxx
E-mail: xxxxxxx@ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: http://www.ipo.gov.uk

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sirs

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

Title

1. Please find enclosed the following:

[insert list of documents enclosed]

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

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

2. The documents have been sent to you as you are considered likely to have an interest in these proceedings - see rule 77(2) of the Patents Rules 2007. The Patents Rules are available on our website at www.ipo.gov.uk (go to: >IP Professional home page>Patent law and practice>Patent law).

Counter-statement

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

4. If you do not file a counter-statement, we will take it that you support the

claimant's case (see rule 77(9)). However we will not treat you as a party to these proceedings and will not send you copies of any other documents filed in connection with this matter.

Additional information

- | 5. Further information relating to proceedings before the comptroller may be found in the enclosed booklet entitled 'Patents: deciding disputes'. Alternatively, please contact me (Telephone: +44 (0)1633 81xxxx).
- | 6. A copy of this letter has been sent today to the claimant for information.

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 5

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81****
E-mail: *****@.ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

1. Please find enclosed, in accordance with rule 80(1)(a) of the Patents Rules 2007, a copy of the defendant's counter-statement. Also enclosed is a copy of an official letter sent today to the defendant.

2. The proceedings will now be reviewed and the Office will consider the best way of proceeding with the case. I will contact you again about this matter as soon as possible.

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

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 6

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81****
E-mail: *****@.ipo.gov.uk
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Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

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

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 7

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81****
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Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

Case Management Conference

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

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

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

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

[Insert appropriate paragraph]

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

[or]

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

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

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

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

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 8

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81****
E-mail: *****@.ipo.gov.uk
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Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

Mediation

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

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

<http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-dispute/p-mediation.htm>

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

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

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

Preliminary Evaluation

Either:

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

www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn/p-tpn-2009/p-tpn-32009.htm

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

Yours faithfully

Name
Litigation Section
Patents Directorate

Or:

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

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

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

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

www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn/p-tpn-2009/p-tpn-32009.htm

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

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 9

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81****
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Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

Latest date to supply hearing date:

Claimant to file evidence by:

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

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

Evidence

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

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

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

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

Expert witnesses

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

Hearing Date

6. You should now agree a mutually convenient date for the hearing with the other side. In all but the most exceptional cases, the parties should note that it is expected that the hearing will be concluded in two days or less. The agreed hearing date should be within the period to

7. The period set provides for completion of the evidence rounds, for the parties to consider any Preliminary Evaluation issued after the evidence rounds have been completed and for expert witnesses to provide a joint statement of agreed and disputed matters if required.

8. We will let you know whether the date is acceptable.

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

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

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

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 10

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81****
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Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

Latest date for response:

Date for filing of evidence:

Mediation

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

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

<http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-dispute/p-mediation.htm>

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

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

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

Preliminary Evaluation

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

Evidence

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

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

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

Expert witnesses

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

Hearing Date

9. You should now agree a mutually convenient date for the hearing with the other side. In all but the most exceptional cases, the parties should note that it is expected that the hearing will be concluded in two days or less. The agreed hearing date should be within the period to

10. The period set provides for completion of the evidence rounds, for the parties to consider any Preliminary Evaluation issued after the evidence rounds have been completed and for expert witnesses to provide a joint statement of agreed and disputed matters if required.

11. We will let you know whether the date is acceptable.

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

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

.

| 14. A letter in identical terms has been sent today to the other side.

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 11

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81****
E-mail: *****@.ipo.gov.uk
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Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

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

Hearing date

2. The hearing date agreed by the parties is acceptable. Consequently the hearing will be held on The hearings clerk will contact both sides in due course concerning arrangements for the hearing.

Mediation

Either:

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

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

Or:

3. I note that the parties have agreed to mediate and have requested that the proceedings be stayed pending the outcome of the mediation.
4. Both sides should note that the proceedings are now stayed.
5. Both sides are asked to inform the Office on a monthly basis of the progress of the mediation, including the dates of the mediation activities. An outline of the results of those activities should also be provided.
6. A letter in identical terms has been sent today to the other side.

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 12

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Direct Line: 01633 81****
E-mail: *****@.ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

1. I refer to the official letter dated and note that you have not filed a counter-statement.

2. In view of this, you are not considered to be a party to these proceedings. Any further documents filed by the claimant in connection with the matter will not be sent to you.

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

Yours faithfully

Name
Litigation Section
Patents Directorate

Annex 13

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

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

Your Reference:
Our Reference: 3Y31/name/number ref

Date

Dear Sir

Title in bold

Edit as appropriate

Evidence received from claimant [filed sequentially]

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

Evidence received from defendant [filed sequentially]

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

Exchange of evidence [filed simultaneously]

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

Evidence in reply received [filed simultaneously]

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

Preliminary Evaluation

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

[see also annex 8 and edit as appropriate]

Expert evidence filed – joint statement requested

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

Insert as appropriate

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

Yours faithfully

Name
Litigation Section
Patents Directorate