

CHAPTER 2

STATEMENT OF CASE

Introduction	2.01
Statement	2.02 - 2.13
What should the statement look like?	2.02
What should the statement contain?	2.03 - 2.06
When should the statement be filed?	2.07
Can the time period for filing a statement be extended?	2.08
Statement in foreign language	2.09
Copies of documents referred to	2.10
Error in statements	2.11 - 2.13
Counter-statement	2.14 - 2.32
Introduction	2.14 - 2.15
What should the counter-statement contain?	2.16 - 2.17
When should the counter-statement be filed?	2.18 - 2.20
Can the time period for filing a counter-statement be extended?	2.21 - 2.25
Subsequent action	2.26 - 2.27
Copies of documents referred to	2.28
Counter-statements in section 72 (revocation) action	2.29 - 2.32
Amendment of statement of case	2.33 - 2.34

2 STATEMENT OF CASE

INTRODUCTION

- 2.01 To initiate *inter partes* proceedings, the claimant files a form under one or more sections of the relevant act. In most instances, the form should be accompanied by a statement setting out the issues which the claimant wants the comptroller to resolve, the facts on which he relies and the order (or 'relief') he would like the comptroller to give. The defendant must, if he wishes to contest proceedings, respond by filing a counter-statement. Together these two statements of case should identify the substantive issues to be determined. The statement and counter-statement do not need to be sworn or attested and need not be signed or dated. However, each statement should preferably be verified on behalf of the relevant party by a statement confirming the accuracy and truth of its contents. Both the statement and counter-statement should be supplied in duplicate.

STATEMENT

What should it look like?

- 2.02 Statements come in a wide variety of styles. Rule 21 of the Patents Rules 1995 as amended, for example, requires that any statement should comply with the requirements of rule 20(1) and (4); that is a statement should be in English and should be on A4 paper which is pliable and strong. A statement should also only use one side of the paper. In practice the statement will be acceptable providing it is legible and clear. Typescript or handwritten are both acceptable although typescript is obviously easier to read.

What should a statement contain?

- 2.03 The detailed requirements for the statement are prescribed by the appropriate rules and differ slightly according to the Act under which they are filed, as well

as the section of the Act. A detailed analysis of the requirements relevant to each section can be found in the commentary relating to the individual sections.

- 2.04 In some proceedings, eg section 46(3) of the Patents Act 1977, application for a licence of right and application to settle the terms of a licence of right available by virtue of section 237 of the Copyright, Designs and Patents Act 1988, the matter in issue is implicit in the relief sought. However, in most proceedings the matters in issue need to be set out explicitly. This includes an application under section 71 of the Patents Act 1977 (application for a declaration of non-infringement).
- 2.05 The statement is also generally required to set out fully the **facts** (as distinct from the evidence to be relied upon) which are to be proved in **evidence** (see *Roussel-Uclaf (Clemence and Le Martret's) Patent* [1987] RPC 109) and also set out the order or other relief sought.
- 2.06 See also Patent Hearings Manual Chapter 2.

When should the statement be filed?

- 2.07 In most proceedings the relevant rule requires that the statement must be filed at the same time as the relevant form. The proceedings are not, therefore, properly launched until the requirement is met. However, there are exceptions.
- (a) In patent opposition proceedings, for example, under such sections as 27, 29, 47 and 117, rule 107 provides that the statement may be filed up to 14 days after the relevant Form 15/77 has been filed.
- (b) Licence of right proceedings are also different in that, when a third party applies under section 46(3) for the settlement of the terms of a licence of right, the proprietor then has six weeks from the date the documents are sent to him, in which to file a statement setting out the grounds of his objection. (See also Design Right LOR).

Can the time period for filing a statement be extended?

- 2.08 The time period for filing a statement can be extended, retrospectively if necessary, at the comptroller's discretion under rule 110(1). If there is no dispute relating to the extension of time request, it can be granted by the B3. If there is a dispute the matter should be referred to the HO for advice.

Statements in a Foreign Language

- 2.09 If the statement is in a language other than English, it should be accompanied by a translation.

Copies of Documents referred to

- 2.10 Copies of any documents such as letters, reports, agreements, terms of employment etc referred to in the statement should also be supplied in duplicate (see rule 112). If any document or part of a document referred to is in a foreign language, a translation of that document should also be supplied. Some documents may be alluded to rather than referred to eg "the patent was assigned to the referrer" or "by virtue of deed of assignment dated 12.02.1998 the patent was assigned to". In such cases, a copy of the assignment should be requested.

Errors in statements

- 2.11 Office practice is to scrutinise the statement to ensure that formal requirements have been met. Any defects are brought to the attention of the party filing the statement and they are invited to file an amended statement and/or form usually within one month. The papers are served on the other side together with a copy of the Office letter inviting amendment, but the party on which the

papers are served are informed that they are not invited to file a counter-statement in the matter until the formal defects in the statement have been resolved.

2.12 Occasionally the only defect will be that a document referred to has not been supplied. This may be a document that will be in the possession of the other side already and so the party filing the statement can be given 14 days in which to supply a copy to the Office and to the other side direct. In such circumstances the time period for the filing of the counter-statement can begin and run concurrently.

2.13 Common errors include failure to supply copies of documents and translations where appropriate, failure to identify the relevant section or sections of the Patents Act and seeking relief that is not available. If relief is sought that is not *prima facie* available, the party should be informed that it would appear that the relief sought might not be available from the comptroller and they should be given an opportunity to amend. However, the content of statements is a matter for the party and they may ask the comptroller to consider other or alternative relief. Statements can often be rambling and disjointed but if the general message is there then they should be served and the counter-statement invited.

THE COUNTER-STATEMENT

Introduction

2.14 A person who wishes to oppose or object to what is sought in a statement must generally file a counter-statement setting out fully the grounds of his opposition or objection. Counter-statements are not sworn or attested and need not be signed or dated. However, as with the statement, preferably the counter-statement should contain a statement confirming the accuracy and truth of its content. A party opposing a claim must set out fully the grounds of his opposition or objection. Counter-statements should be supplied in duplicate.

- 2.15 The basic purpose of the counter-statement is to identify those allegations which are in dispute and those which are not. In particular, it must reply in a reasonable manner to each of the grounds in issue in the statement by way of admission, denial or (in the case of revocation) an offer to amend.

What should a Counter-statement contain?

- 2.16 In the counter-statement, the defendant must state:
- which of the allegations in the statement are denied and why (and if an alternative version of events is to be put forward, what that version is)
 - which of the allegations in the statement are not admitted or denied but which the claimant is required to prove
 - which of the allegations is admitted

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

- 2.17 Where there is any doubt as to the position of a potential defendant (eg where objections have been raised in a letter rather than a counter-statement, or opposition has been filed in respect of a section 37 reference but not a concurrent section 13 application (Brockhouse plc's Patent), Litigation Section will query the position pointing out that, if no counter-statement is filed, the proceedings will be treated as uncontested. If the potential defendant does wish to oppose or object, then he or she should file a counter-statement and, if necessary, request an extension under rule 110(1) of the period for doing so.

When should the counter-statement be filed?

- 2.18 In proceedings, the statement will be filed when the proceedings are initiated. A copy will be sent by the Office, to the relevant parties as set out in the rules, and the other parties will be informed in the accompanying official letter that they have a period of six weeks from the date of the letter in which to file a counter-statement contesting the application.
- 2.19 In the case of a request for a direction that a hearing be held in Scotland, a period of one month is allowed under Rule 108(4)) for filing a counter-statement.
- 2.20 The B2 should check that the counter-statement is filed within the prescribed period including any extension.

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

- 2.21 The period for filing such counter-statements may be extended retrospectively, if necessary, at the comptroller's discretion under rule 110(1).
- 2.22 If there is no dispute relating to the extension of time request, it may be granted by the B2. If there is a dispute, the matter should be referred to the HO dealing with preliminary matters.
- 2.23 Deleted
- 2.24 Where repeated or extended extensions of time are requested, the B2 will seek the advice of the HO allocated to deal with preliminary matters before allowing such an extension.
- 2.25 Where, exceptionally, no agreement can be reached, the HO will need to decide the matter formally either at a preliminary hearing or with the agreement of the parties on the papers.

Subsequent action

- 2.26 If the counter-statement is in order, it should be copied to the party initiating the proceedings. A letter should accompany the counter-statement inviting the filing of the claimant's evidence in chief. A period of six weeks is usually given in which the party initiating the proceedings may file their evidence in chief.
- 2.27 Prior to this, if the B2 considers that there are issues that need to be brought to the attention of the HO dealing with preliminary matters, then the case may be referred as appropriate.

Copies of Documents referred to

- 2.28 Where a document, other than a published GB patent specification or application, is referred to in the counter-statement, a copy of the document must be sent to the Office and the other party. If the document is in a foreign language it should be accompanied by a translation. Where the comptroller is satisfied that a party is unable to produce or file any document referred to, a dispensation may be granted. (MOPP 72.21 Rule 112).

Counter-statement in section 72 Revocation proceedings

- 2.29 In revocation proceedings, if the proprietor wishes to contest the application, he must file, within six weeks of the sending of the copies of the application and statement, a counter-statement in duplicate setting out fully the grounds upon which the application is contested. **Care should be taken when checking counter-statements in section 72 proceedings to establish if the proprietor is offering to amend the patent claims.**
- 2.30 If the proprietor does offer to amend the claims such amendments are made under section 75 and are subject to rule 78 procedure.

- 2.31 It should be made clear within the counter-statement on what basis the offer to amend is made, that is, whether the offer is firm or is conditional upon an adverse finding on the unamended specification.
- 2.32 For further details and procedures see section 72 of the MOPP and Chapter 14 of this Manual.

Amendment of statement of case

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