

CHAPTER 2

STATEMENTS OF CASE

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2 STATEMENTS 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 patent proceedings, for example, the form should be accompanied by a statement of grounds (see rule 76(1) and paragraph 2.04 below for further details). The defendant must, if he wishes to contest proceedings, respond by filing a counter-statement (rule 77(5)). Taken together the statement of grounds and the counter-statement, which are sometimes described generally as 'statements of case', show the facts that are in dispute. Both the statement and counter-statement should be supplied in duplicate. One copy will be scanned electronically to the electronic case file. The other copy will be sent to Litigation Section to serve.

STATEMENT OF GROUNDS

What should it look like?

2.02 Statements of case come in a wide variety of styles. However they should comply with the requirements of Part 1 of Schedule 2 of the Patent Rules 2007. This requires that they should be filed on A4 matt white paper which should be free from tears, folds or similar damage and its contents must be suitable for reproduction. Frames (lines surrounding matter) should not be used. In accordance with rule 4(4), statements of case should only use one side of each sheet of paper. In practice, a statement of grounds and a counter-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 of grounds contain?

2.03 The requirements for the statement of grounds in patent *inter partes*

proceedings are set out in rule 76(4).

2.04 The statement of grounds needs to include:

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

and needs to be verified by a statement of truth.

2.05 See also Patent Hearings Manual Chapter 2.

When should the statement be filed?

2.06 The statement should be filed at the same time as Patents Form 2 or Patents Form 15 except where proceedings have been started under section 46(3) by a person other than the patent proprietor (see Chapter 11). On receipt in the Office, the form and accompanying documents will be scanned to the Office's electronic case management system and an electronic dossier (case file) will be created and a message sent to the A1. The A1 will review the dossier and amend the document codes as appropriate (see Chapter 1 and list of document codes included in Chapter 25).

Statements in a foreign language

2.07 If a statement of grounds is filed in a foreign language, a translation will be required (see rule 82(1)(b)).

Copies of Documents referred to

- 2.08 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 79(1) and (2)). However, if the document referred to has been published by the Office or is kept at the Office, this rule does not apply (see rule 79(3)). If any document or part of a document referred to is in a foreign language, a translation of that document should also be supplied (see rule 82(1)(b)). Some documents may be alluded to rather than referred to e.g "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

- 2.09 Office practice is to scrutinise the statement to ensure that formal requirements have been met. Any defects should be brought to the attention of the party filing the statement. They should be invited to file an amended statement and/or form usually within one month. The papers should be served on the other side (see rule 77) together with a copy of the Office letter inviting amendment, but the party(ies) should not be invited to file a counter-statement in the matter until the formal defects in the statement have been resolved.

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- 2.10 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. Providing rule 79(3) does not apply, the party filing the statement can be given 14 days in which to supply copies to the Office. In such circumstances the time period for the filing of the counter-statement can begin

and run concurrently.

- 2.11 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 the relief sought is not *prima facie* available, the party should be informed that it would appear that the relief sought might not be available and they should be given an opportunity to amend the statement of grounds. The content of a statement of grounds is a matter for the claimant who 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

- 2.12 A person who wishes to oppose or object to what is sought in a statement of grounds must file a counter-statement setting out fully the grounds of his opposition or objection. As with the statement of grounds, the counter-statement should be supplied in duplicate (see rule 77(6)).
- 2.13 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?

- 2.14 In the counter-statement, the defendant must state:
- which of the allegations he denies and why (and if an alternative version

- of events is to be put forward, what that version is)
- 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

and he needs to include a statement of truth (see rule 78(1)).

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

- 2.15 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, Litigation Section should point 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 of the period for doing so.

When should the counter-statement be filed?

- 2.16 In proceedings, the statement will be filed when the proceedings are initiated. A copy along with Patents Form 2 will be sent to the relevant parties by the B3/B2 (rule 77(4)). The parties will be invited to file a counter-statement within six weeks of the date of the official letter.
- 2.17 The B2 should check that the counter-statement is filed within the prescribed period including any extension and that the counter-statement meets formalities requirements.

Copies of Documents referred to

- 2.18 Where a document, other than a document published by the comptroller or kept at the Office, is referred to in the counter-statement, two copies of the

document must be filed (see rule 79)). If the document is in a foreign language it should be accompanied by a translation (see rule 82(1)(b)).

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

- 2.19 The period for filing a counter-statement may be extended at the comptroller's discretion (see rule 108).
- 2.20 If there is no dispute relating to the extension of time request, the B2 should consider the reasons for the request and if reasonable, may grant the extension.
- 2.21 Where repeated or extended extensions of time are requested, the B2 should seek the advice of the HO before allowing such an extension.
- 2.22 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.

Serving the counter-statement

- 2.23 If the counter-statement is in order, a copy should be sent to the claimant with a letter pointing out that if he wishes to continue the proceedings, he must file Patents Form 4 and pay the appropriate fee within a specified period (see annex 5a in Chapter 1). On receipt of the form and fee, both parties should be advised that the proceedings are to be reviewed and we will consider the best way of proceeding with the case (see annexes 6a and 6b in Chapter 1).

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Subsequent procedure

2.24 The case should then be referred to the allocated HO along with recommendations as to how the proceedings should subsequently be managed (see Chapter 1 paragraph 1.29). The B2 may also bring any additional issues concerning the proceedings to the attention of the HO.

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Create and send message to HO. Message = PSM

2.25 On receipt of the case from the HO, the B2 should write to the parties as directed (see 1.32 and 1.35). If the proceedings appear complex, a letter may be issued directing that a Case Management Conference will be convened as soon as possible to determine how the case should proceed (see annexes 7, 8 and 9 in Chapter 1).

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Counter-statement in section 72 Revocation proceedings

2.26 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 of grounds, 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.**

2.27 If the proprietor does offer to amend the claims such amendments are made under section 75 and are subject to rule 35 and the rules set out in Part 7.

- 2.28 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.
- 2.29 For further details and procedures see sections 72 and 75 of the MOPP and Chapter 14 of this Manual.

AMENDMENT OF STATEMENT OF CASE

- 2.30 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 (or counter-statement). On receipt of a request, the matter should be referred to the HO for consideration as a number of factors will need to be taken into account.
- 2.31 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.