

CHAPTER 4

HEARINGS

Introduction	4.01 - 4.16
What is a hearing?	4.01 - 4.03
Types of hearings	4.04 - 4.11
<i>Ex parte</i> hearings	4.05
<i>Inter partes</i> hearings	4.06
Case Management Conference	4.07
Pre-hearing Reviews	4.08
Is it always necessary to have a hearing?	4.09 - 4.11
<i>Ex parte</i> cases	4.09
<i>Inter partes</i> cases	4.10
Case Management Conferences and Pre-hearing Reviews	4.11
Where are hearings held?	4.12 - 4.16
<i>Ex parte</i> hearings	4.13
<i>Inter partes</i> hearings	4.14
Case Management Conferences and Pre-hearing Reviews	4.15 - 4.16
Arranging an <i>ex parte</i> hearing	4.17 - 4.24
Initial actions for PECS cases	4.18
Initial actions for paper based cases	4.19
Arranging a date for an <i>ex parte</i> hearing	4.20
Action where <i>ex parte</i> hearing in London	4.21
Action where <i>ex parte</i> hearing in Newport	4.22
Additional actions for hearings in London and Newport	4.23
Action where <i>ex parte</i> hearing in Newport by video conference	4.24
Arranging an <i>inter parte</i> hearing	4.25 - 4.31
Action where <i>inter partes</i> hearing in London	4.26

Action where <i>inter partes</i> hearing in Newport	4.27
Action where <i>inter partes</i> hearing by video conference	4.28
<i>Inter partes</i> hearing – Cross-examination by video- link	4.29
<i>Inter partes</i> hearing – Held at an alternative location	4.30
Action taken following receipt of evidence	4.31
Action to be taken four weeks prior to hearing	4.32 - 4.33
Proceedings files	4.34
Action two days before the hearing	4.35
<i>Ex parte</i> and <i>inter partes</i> hearings	4.35
On the day of the hearing	4.36 - 4.37
If <i>ex parte</i> and <i>inter partes</i> hearing in Newport	4.36
If <i>ex parte</i> and <i>inter partes</i> hearing in London	4.37
Hearings no longer required/postponed	4.38 - 4.39
Hearings list	4.40 - 4.42
Skeleton arguments	4.43 - 4.45
<i>Inter partes</i> hearings	4.44
<i>Ex parte</i> hearings	4.45
Authorities	4.46 - 4.49
Bundles	4.50 - 4.51
<i>Inter partes</i> hearings	4.50
<i>Ex parte</i> hearings	4.51
Mail	4.52
Transcripts	4.53
General	4.54

Annexes

Annex 1	Lifecycle of a patent application
Annex 2	The compliance period and hearings
Annex 3	Hearings arrangement sheet
Annex 4	Hearings Checklist
Annex 5	<i>Ex parte</i> hearing - London
Annex 6	<i>Ex parte</i> hearing - Newport
Annex 7	<i>Inter partes</i> letter concerning cross-examination

- Annex 8 *Inter partes* letter concerning skeleton arguments/ authorities/ bundles/ next day transcripts
- Annex 9 Hearing Details Pro-forma
- Annex 10 Courtroom booking
- Annex 11 List of Hearings Rooms
- Annex 12 Cancellation checklist
- Annex 13 Weekly hearings list
- Annex 14 Case Management Conferences/Pre-hearing reviews/Preliminary hearing

4 HEARINGS

INTRODUCTION

What is a hearing?

- 4.01 Sometimes, while looking into a patent application or granted patent, an examiner might object to certain things about it. A patent applicant will always be given a chance to overcome these objections, but that may not always be easy. Before making any decision that might adversely affect the applicant, where there is an element of discretion, the applicant is entitled to ask for “a hearing” (see section 101 of Patents Act 1977).
- 4.02 A hearing is a way of taking things forward. It gives the applicant the chance to explain his or her case in person to one of our senior officers known as a “hearing officer”. The hearing officer is independent and will look at all sides of the argument before making the final decision about the case. If the applicant doesn’t agree with the decision, he can file an appeal (see Chapter 6).
- 4.03 Sometimes two or more opposing parties may be in dispute over a patent or patent application. If this happens, we might be able to help settle the dispute, but obviously the parties would need to tell us about it. They may not always agree with what we say. If we can’t overcome these differences, either of those involved may ask us for a hearing. Both sides will be invited to attend the hearing. The hearing officer will listen to both sides of the argument and will give a written decision. If one side does not agree with the decision, they can file an appeal (see Chapter 6).

Types of hearings

- 4.04 There are generally two types of hearings – *ex parte* and *inter partes*. There is no fee to pay in relation to either of these. As well as arranging hearings, the hearings clerks may also be involved in arranging Case Management Conferences (CMCs) and Pre-hearing Reviews.

Ex parte hearings

4.05 This is the name given to hearings held between a single party (either private individuals or firms) and the Office. An *ex parte* hearing may be held prior to the comptroller exercising his discretion adversely (see annex 1 and section 101 of the Patents Act 1977); so, for example:

- where an applicant is in disagreement with an examiner about whether his application meets the requirements of the Act and is patentable, he may request a hearing OR
- where an applicant is in disagreement with a case officer concerning whether his granted patent should be restored, he may request a hearing.

Where an *ex parte* hearing has been requested near the end of the Rule 30 compliance period, extensions are available to the applicant (see annex 2 for further details). These are dealt with by the relevant Formalities group.

Inter partes hearings

4.06 These are hearings held between two parties who are in dispute over something to do with their patents. *Inter partes* hearings may be:

- Substantive - an example would be the main hearing held to decide the proceedings
- Preliminary hearings - these may be held to sort out problems that arise within the proceedings. They may be held at the request of either party or at the suggestion of the Office with the agreement of the HO. The procedure for preparing a preliminary hearing is similar to that for the substantive hearing. However it is important that the parties are informed in writing of the exact issue to be determined and what documents need to be supplied (see annex 14).

PECS:- Generate appropriate letter to applicant using PROSE and import to

dossier.

Case Management Conference

4.07 The HO has the power to call a Case Management Conference (CMC) to help clarify the issues or give directions on the future conduct of a case. A conference may be called at any stage in the proceedings, including straight after the filing of a counter-statement. It will probably be unnecessary for the parties to supply the vast number of documents for the CMC as required by the Civil Procedures Rules (see paragraphs 4.8 and 4.9 of the Practice Direction to Part 63). When arranging a CMC, you should liaise with the B2 Case Officer and HO. You will need to write to the parties using a suitable form of the letter template at annex 14.

PECS:- Generate appropriate letter to applicant using PROSE and import to dossier.

Pre hearing Reviews

4.08 These may be called by the HO so he can give directions on the management of the hearing. A review is unlikely to be necessary unless the proceedings are complex.

PECS:- Generate appropriate letter to applicant using PROSE and import to dossier.

Is it always necessary to have a hearing?

Ex parte cases

4.09 No. It is open to a patent applicant for example, to ask that a decision be made by a HO based on the papers he has filed.

Inter partes cases

- 4.10 No. Again it is open to the parties involved in the dispute to ask that a HO make a decision on the case based on the papers filed. However both sides involved in the dispute must agree to this – if they don't, then a hearing will probably be required.

Case Management Conferences and Pre-hearing Reviews

- 4.11 Case Management Conferences (CMCs) have become more common, though Pre-hearing reviews are still rare. Both may be called at the request of the HO.

Where are hearings held?

- 4.12 Hearings may be held anywhere in the UK, but are normally held at one of our Offices.

Ex parte hearings

- 4.13 These are usually held at our Newport Office. They may also be held by telephone or video conference link.

Inter partes hearings

- 4.14 The Office holds hearings in Scotland if all parties consent and the Office considers it appropriate. Where the parties consent and the HO is satisfied that the circumstances justify it, in particular that it will result in an overall saving in time and cost, a hearing may be held at locations other than Newport, London and Scotland. Preliminary hearings are usually held by video conference link though they may also be held at our London Office.

Case Management Conferences and Pre-hearing Reviews

- 4.15 These may be conducted by video conference, telephone, or the parties may appear in person before the HO. You should consult the HO about how he wishes to run the CMC / Pre-hearing Review before seeking agreement from the parties.
- 4.16 When arranging a hearing/CMC/ Pre-hearing Review, you need to check with the party(ies) where they would like this held. Any dispute over venue should be referred to the HO. However you should note that where counsel is involved, London will probably be the preferred venue.

ARRANGING AN *EX PARTE* HEARING

- 4.17 Most requests to arrange an *ex parte* hearing will relate to cases on PECS. The examiner will send a message to the Hearings Mailbox requesting that a hearing be arranged.

Initial actions

- 4.18 You will need to:
- Check the Hearings mailbox daily and allocate any messages to your personal mailbox. To view a message before assigning it, press the function key F2. A dialogue box will appear. Enter the case number and press Open. To view the message, click on TOC (Table of Contents) and then the message you wish to view
 - Insert basic information relating to the hearing in the *ex parte* Excel spreadsheet.
 - Allocate a HO. Check the *ex parte* rota within the Excel spreadsheet to ensure an even distribution of work amongst HOs.
 - Obtain a Hearing Arrangement Sheet and Hearings Checklist from the 'H' drive and complete as appropriate for each case. The sheets should be stored in the

Hearings Clerk file and should be updated as details are confirmed (see annexes 3 and 4).

- Inform the HO that a case has been allocated to him/her. Create a minute using PROSE and import this into the PECS case dossier. Create and send a message to the HO. Message = "PSM Hearing allocated to you".
- Check the excel spreadsheet to see whether the applicant has any outstanding cases awaiting decision. If so, consult the HO on the case for advice on further action. This will ensure consistency on decisions containing the same subject matter.

4.19 Deleted

Target for above actions is five days from receipt of the message from examiner

Arranging a date for an *ex parte* hearing

4.20 A hearing should preferably be held within a month of the notification that the applicant requires a hearing. You need to:

- Check HO diary and make a note of any dates he/she is not available.
- Contact party(applicant//representative) by telephone and ask for a range of provisional dates.
- Check who will be attending.
- Check if the party requires any special arrangements to be made.
- Check if the party intends to use counsel.
- You need to ensure that the HO/HA/party/representatives (attorney, counsel) all agree to the proposed date and venue. If counsel is appointed, you need to agree the date for the hearing with the relevant counsel's clerk.
- Once a date and venue have been agreed, you should enter this information in the *ex parte* Excel spreadsheet and the paper diary.
- Update the Hearing Arrangement Sheet/Hearings Checklist particularly if counsel are involved.

When setting a date, you should generally give the party at least 14 days notice of when the hearing will be held. It is possible however for the comptroller to exercise discretion and set a shorter period.

Action where an *ex parte* hearing is to be held in London

4.21 If an *ex parte* hearing is to be held in London, you should:

- Contact the London Hearings Clerk to book a room.
- Telephone the party/representative to confirm (a) the date and venue and (b) any special arrangements that have been made and confirm these details in writing (see annex 5).
- Confirm by email room booking with London hearings clerk (see annex 10) and who will be attending the hearing.
- Check with HO whether an observer is to be appointed. This is highly unlikely for *ex parte* hearings in London.

PECS:- Generate letter to applicant using PROSE and import to dossier (letter code is EXPARTELND)

Import emails using the “Send to dossier” button

Action where an *ex parte* hearing is to be held in Newport

4.22 If an *ex parte* hearing is to be held in Newport, you should:

- Book a conference /meeting room if appropriate using the electronic appointment system. We now have a dedicated patents hearing room in 1G21, so this should be checked first for availability.
- Telephone the party/representative to confirm (a) the date and venue and (b) any special arrangements that have been made.

- Check if the party/representative is to arrive by car. If so ask for the names of those arriving by car and the car registration number.
- Contact Accommodation Section to book parking bays.
- Confirm all the details including parking bay information in a letter to the party/representative (see annex 6).
- Check with HO whether an observer is to attend the hearing. If this is the case and one hasn't been appointed by the HO, contact the next examiner on the list under H /Litigation/Assistants and Observers to find someone who is able to attend the hearing. Once the observer has been agreed, update the list.
- Provide Accommodation Section with a list of those due to attend the hearing. Accommodation Section will inform Reception.
- Arrange for Accommodation Section to place 'Quiet please. Hearing in progress' signs outside the hearing room.

PECS:- Generate letter to applicant using PROSE and import to dossier
 Import emails using the "Send to dossier" button

Additional actions where *ex parte* hearing in London or Newport

4.23 You should also carry out the following actions:

- Enter the date of the hearing in HO/HA/Office representative/observer's electronic calendars, blocking out the whole day as appropriate.
- Send an appointment to each member of the hearings team. If necessary import a copy from your calendar into the PECS dossier. Once imported annotate the appointment document with the date it was created.
- Arrange shorthand writer. Contact by telephone and send confirmation including details pro forma by email (see annex 9). HO may decide to record the hearing using a digital recording device rather than using a shorthand writer. However, always ensure a shorthand writer is booked unless the HO informs you this isn't necessary.
- Enter the hearing details on the hearing list and in the electronic diary
- Update Excel spreadsheet, hearings folder and hearings list on the website (hearings

relating to unpublished patent applications should NOT be advertised on the website).

PECS:- Generate letter to applicant using PROSE and import to dossier (Letter code is CONFLND or CONFNPT)

Import emails using the “Send to dossier” button

Action where hearing in Newport by video conference

4.24 Where the hearing is by video conference, you should:

- Book the video conference facility (telephone IT Helpdesk (ext 3999).
- Contact the London Hearings Clerk and request they book the video conference facility at their end. (Although a video conference link will usually be with Bloomsbury Street, the Office may link with other facilities if need be).
- Telephone the party/representative) to confirm (a) the date and venue and (b) any special arrangements that have been made and confirm all the details in writing (see annex 5). Amend letter so that it refers clearly to the fact that the hearing will take place by video conference).
- Confirm the video conference link by email with London hearings clerk (see annex 10 - amend as appropriate) and advise who will be attending the hearing.
- Check with HO whether an observer will be attending the video conference hearing. If this is the case and one hasn't been appointed by the HO, ask the HO to review the list and choose an observer (see the list under H /Litigation/Assistants and Observers). Once the observer has been agreed, update the list.
- Contact Accommodation Section and place 'Quiet please. Hearing in progress' signs outside the video conference room.
- Enter the date of the hearing in HO/HA/Office representative/observer's electronic calendars.
- Send an appointment to each member of the hearings team. If necessary import a copy from your calendar into the PECS dossier. Once imported annotate the appointment document with the date it was created.

- Arrange shorthand writer. Contact by telephone and send confirmation including hearing details pro forma by email (see annex 9). The transcript writer should attend the same venue as the HO, that is, Newport.
- Update the hearing details on the hearing list on the website (Note: hearings related to unpublished patent application should NOT be advertised on the website) and the desk diary.
- Update Excel spreadsheet and hearings folder.

PECS:- Generate letter to applicant using PROSE and import to dossier
 Import emails using the “Send to dossier” facility

ARRANGING AN *INTER PARTES* HEARING

4.25 You will be informed by the B2 of the agreed date and venue for the substantive hearing. You should carry out the following initial actions:

- Enter the date of the hearing and names of parties in the HO electronic calendar. Also enter in the paper diary
- Enter the date of the hearing in the Hearings spreadsheet
- Send an appointment to each member of the hearings team. If necessary import a copy from your calendar into the PECS dossier. Once imported annotate the appointment document with the date it was created.
- Ask the HO to allocate a HA and add their name to the hearings spreadsheet and send an appointment for the hearing to the HA with the names of the parties.
- Check with HO whether observer has been appointed. If not, ask the HO to review the list and choose an observer (see the list under H /Litigation/Assistants and Observers). Once the observer has been agreed, update the list and send them an appointment for the hearing.
- E-mail webmaster in order to update the website hearings list (hearings relating to unpublished patent applications should not be advertised on the website.)
- Obtain a Hearing Arrangement Sheet and Hearings Checklist from the ‘H’ drive and complete as appropriate for each case (see annexes 3 and 4). Store in the Hearings

Clerk file.

- Add file note to PECS case and import to dossier (doc code is FILENOTE-LIT)

Action where *inter partes* hearing held in London

4.26 If an *inter partes* hearing is to be held in London, you should also:

- Contact the London Hearings Clerks to establish whether a courtroom is available. The courtroom should be booked provisionally for 3 - 4 days as at this stage you probably won't know for definite how long the hearing is expected. However in all but the most exceptional cases, hearings will be concluded in 2 days or less. You should also book two retiring rooms for use by the parties as these may be needed should cross-examination occur. If the parties have confirmed the hearing is likely to last more than one day, you should book a separate room for use by the shorthand writer.
[Substantive hearings will generally be held in the main courtrooms, but a number of other rooms are available. These may be more suitable for smaller hearings (see annex 11)].
- Contact Trade Marks Hearings Clerk if TMD have already booked the main courtroom. They may be willing to change rooms.
- Complete the main hearing courtroom booking proforma and send by email to the London hearings clerk. At this stage you will not know for sure who will be attending the hearing. This information will need to be added at a later date (see annex 10)
- Mark the electronic diary with a prompt a few days before the hearing in order to send any paper copies of documents if needed to London in good time for the hearing.

Action where *inter partes* hearing held in Newport

4.27 If an *inter partes* hearing is to be held in Newport, you should also:

- Book a conference room using the electronic appointment system.

Action where *inter partes* hearing by video conference

4.28 If the video conference link is required, you should:

- Telephone IT Helpdesk (ext 3999). Often the video link will be convened with Bloomsbury Street so it will be necessary to liaise with the London Hearings Clerks so they can book the conferencing facility their end.

Note: TMD block book the video conference room every Thursday so you should try to avoid this day if possible.

- Confirm the video conference link by email with the London Hearings Clerk as appropriate.
- Complete the main hearing courtroom booking proforma and send by email to the London hearings clerk. At this stage you will not know for sure who will be attending the hearing. This information will need to be added at a later date (see annex 10).

Inter partes hearing - Cross-examination by video link

4.29 Sometimes it is not feasible or sensible for a witness to attend a hearing in person to be cross-examined. In these circumstances, the hearing officer can allow cross-examination to be carried out using the video conferencing link. It is up to the party whose witness it is to make the necessary arrangements. They will need to book video conferencing facilities at the remote end and give us details in good time so that those in Bloomsbury Street or Newport can check the communication link and make sure it works satisfactorily. It is essential that where one party is located at a remote site and the other party is located in the presence of the HO, that all relevant people are clearly visible on the video link. This will ensure that the person at the remote site can see that the hearing is being conducted fairly.

Inter partes hearing - Held at an alternative location

4.30 Where a hearing is to be held at a location other than Newport, London and

Scotland, you should liaise with the parties and the HO concerning a suitable venue. Where appropriate, you should also undertake the actions listed above.

Action following receipt of evidence

4.31 The B2 case officer will send you a PECS message either after the second round of evidence has been received if filed sequentially OR after the first round if filed simultaneously, advising that you should now finalise further arrangements for the hearing. You should:

- Write to the parties to establish whether they are to be represented by counsel, whether cross-examination will be necessary and whether any special arrangements need to be made for the hearing (see annex 7 – parties allowed six weeks to file response).

Action any response accordingly. If there is to be no cross-examination, for example, you should inform the HO and cancel the booking of retiring rooms for the parties.

PECS: Generate appropriate letter to applicant using PROSE and import to dossier

ACTION TO BE TAKEN FOUR WEEKS PRIOR TO THE HEARING

4.32 Four weeks prior to the hearing you should:

- Send the letter at annex 8 to the parties requesting skeleton arguments and information about any precedents to be referred to at the hearing.
- Book the transcript writer. Contact by telephone and send confirmation including hearing details pro forma by email (see annex 9)

PECS:- Generate appropriate letter to applicant using PROSE and import to

dossier.

4.33 Action any response accordingly. You should now know who will be attending the hearing. Add this information to the main hearing courtroom booking proforma (see annex 10) and email the updated version to the London Hearings Clerk. You should also advise if any special arrangements need to be made.

PECS:- See 4.35 for receipt of skeleton arguments. The A1 should complete an Indexing and Scanning Request Sheet for any letters received other than skeleton arguments (doc code is AGNTL-LIT; Team is Hearings; User is Hearings Clerk; Message = "See Letter")

PROCEEDINGS FILES

4.34 You will have already marked the electronic diary to prompt you a few days before the hearing (see 4.26). You should check with the HO if there is any action to take with regards to the PECS file.

ACTION TWO DAYS BEFORE THE HEARING

Ex parte and inter partes hearings

4.35 The day before the hearing, you should:

- Where skeleton arguments have not been provided, contact the parties to clarify the situation. When skeleton arguments are received, pass them immediately to the HO and HA [skeleton arguments are usually supplied for *inter partes* hearings]
- Obtain copies of any authorities referred to in the skeleton arguments - refer to HO if necessary. If the hearing is in London, this will not be necessary. Instead inform the London Hearing Clerk and he will ensure the authorities are available for the HO
- If authorities are not provided, telephone the attorney/Counsel/applicant and ask if

authorities are to be referred to during the hearing and what they are. If we do not hold them, ask that they supply us with a copy.

- Ensure the London Hearings Clerk is aware of all those attending the hearing in London.

PECS:- A1 to photocopy skeleton arguments and pass the original directly to the hearings clerk. The A1 should then attach a request for indexing and scanning to the photocopy and should send to Index and Scanning Section (doc code is SKEL-ARGS; team is Hearings; annotate "Skeleton Arguments").

ON THE DAY OF THE HEARING

If *ex parte* and *inter partes* hearing in Newport

4.36 If the hearing is in Newport, you need to:

- Check with reception that the names of those attending are in the diary and that the hearing clerk's name is given as the person to be contacted when the party or representative arrives. The Hearings Clerk will need to escort the party and/or their representative to the hearing room.
- Check the hearing room is set out correctly and that the swearing in books and cards kept in Litigation Section are in place (if required) and water is available, etc.
- Place 'Quiet please. Hearing in progress' signs outside the room (if necessary contact Accommodation Section)..
- If the hearing is via the video link, check the video room before the start of the hearing and make sure everything is prepared and that the equipment is working.
- Check with the HO that there is nothing he/she requires you to do.
- When the shorthand writer arrives, escort him/her to the room.
- When the parties arrive, escort them to the room.
- Contact the HO to inform him/her that the parties have arrived.
- The HO may wish to be announced – check with HO. If this is necessary, open the door and say "the Hearing Officer". There is no need for those present to stand.

The HO will enter and then you can leave.

- When the hearing is over, you may be required to escort all parties back to Reception.

If *ex parte* and *inter partes* hearing in London

4.37 Generally there will be no further action for you to take. However where:

- Skeleton arguments arrive a) after working hours the day before the hearing or b) on the day of the hearing, you need to fax or email copies to the London Hearings Clerk who will then distribute to the HO and HA on arrival.

PECS:- A1 to photocopy skeleton arguments and pass the original directly to the hearings clerk. The A1 should then attach a request for indexing and scanning to the photocopy and should send to Index and Scanning Section (doc code is SKEL-ARGS; team is Hearings; annotate "Skeleton Arguments").

HEARINGS NO LONGER REQUIRED/POSTPONED

4.38 If a hearing is no longer required you need to refer to the Cancellation checklist (see annex 12) and carry out the following action:

- Inform the HO, HA, office representative, observer, shorthand writer and any other interested parties immediately
- Update the excel hearings spreadsheet
- Add file note to PECS file.

PECS: Create file note and import to dossier (doc code is FILENOTE-LIT)

4.39 If a party wishes to postpone the hearing, you should:

- Contact the HO and obtain agreement to this. If the hearing was due to be held in

relation to an *inter partes* case, the HO will usually ask you to seek the views of the other side before confirming the hearing may be re-arranged.

- If the postponement is allowed, advise all parties and cancel the shorthand writer and the room booking. If appropriate, contact the London Hearings Clerk.
- Update the excel hearings spreadsheet
- Add file note to PECS file.

PECS:- Create file note and import to dossier (doc code is FILENOTE-LIT)

HEARINGS LIST (see annex 13)

4.40 The external hearings list shows details of hearings arranged, ie the date, time, and location as well as the name of the HO and those attending the hearing. The list should be placed on the Office's website. Any updates should be sent to the web team as soon as possible.

4.41 The internal hearings list contains additional details ie the names of the HA, Office representative and observers as well as details of the transcript writer. When the list is updated, send a copy to:

- The Head of Litigation Section
- London Hearings Clerk.
- All staff in the Hearings Team
- Webmaster

4.42 The list should be sent to internal customers electronically. A paper copy of the list should be placed on the notice board in Litigation Section.

SKELETON ARGUMENTS

4.43 A skeleton argument is an outline of the submissions a party proposes to make at a hearing.

Inter partes hearings

- 4.44 See annex 8. Parties are expected to provide skeleton arguments preferably by email.

Ex parte hearings

- 4.45 Where the applicant is represented by an attorney, skeleton arguments may also be provided for *ex parte* hearings. Where they are filed, it is advisable to take instructions from the HO.

AUTHORITIES

- 4.46 These are precedent cases/decisions that a party may refer to in the course of a hearing. They are usually Reported Patent Cases or Fleet Street Reports. Copies of both can be found in room 3Y31 or electronically with the online services of Westlaw and Bailii. In both *inter partes* and *ex parte* proceedings, the party(ies) involved should inform the Hearings Clerk at least 48 hours prior to the hearing if they intend to refer to any authorities and should provide a list of these (see also letter confirming hearing date in *inter partes* proceedings annex 8).

- 4.47 Generally the London Hearings Clerk will be responsible for providing authorities for hearings in London. The Newport Hearings Clerk should provide the London Hearings clerk with skeleton arguments containing authorities or a separate list of authorities.

- 4.48 The Newport Hearings Clerk should review the authorities listed to determine whether any unusual authorities are quoted. If they are, the Newport Hearings Clerks should seek to obtain copies.

- 4.49 Authorities will generally be provided close to the date of the hearing, however, if

a party wants to refer to a new document at the hearing (other than a decision or court judgment) generally 14 days notice should be provided to the comptroller and any relevant party to the proceedings. The comptroller however has discretion on this matter and may, for example, reduce this period.

BUNDLES

Inter partes hearings

4.50 Occasionally bundles consisting of copies of all the papers filed in the proceedings are produced. It is the responsibility of the claimants' representative to compile them. Copies should be provided to the other side in good time so that both parties can use them effectively during the hearing. At least two copies should be supplied to the Office (one for the Hearing Officer and one for the shorthand writer), and a further copy should be produced for use by any witnesses who are due to be cross-examined. If there is to be cross-examination and bundles are not used, the parties still need to ensure between them that they have a spare set of all documents for the witness. In *inter partes* proceedings, the parties should be instructed to send bundles directly to the hearings venue, ie generally our London Office at Bloomsbury Street.

Ex parte hearings

4.51 It is rare for a party to provide bundles at *ex parte* hearings.

MAIL

4.52 Any correspondence relating to the hearing should be brought to the attention of the HO/HA/Office representative and the file minuted accordingly. The original document should be placed on the proceedings file/patent file and a copy of the correspondence, if relating to the hearing, filed on the hearings folder.

PECS: The A1 should complete an indexing and scanning request and send to

Index and Scanning Section (doc code is AGNTL-LIT; team is Hearings; Message is "See letter")

TRANSCRIPTS

4.53 The transcript of the hearing will generally be sent by email. You need to:

- Update the excel spreadsheet with the date the transcript is received
- Convert the transcript to PDF format and save it to the folder entitled 'hearings transcripts' on the 'H' drive.
- Send a copy by email to the HO.

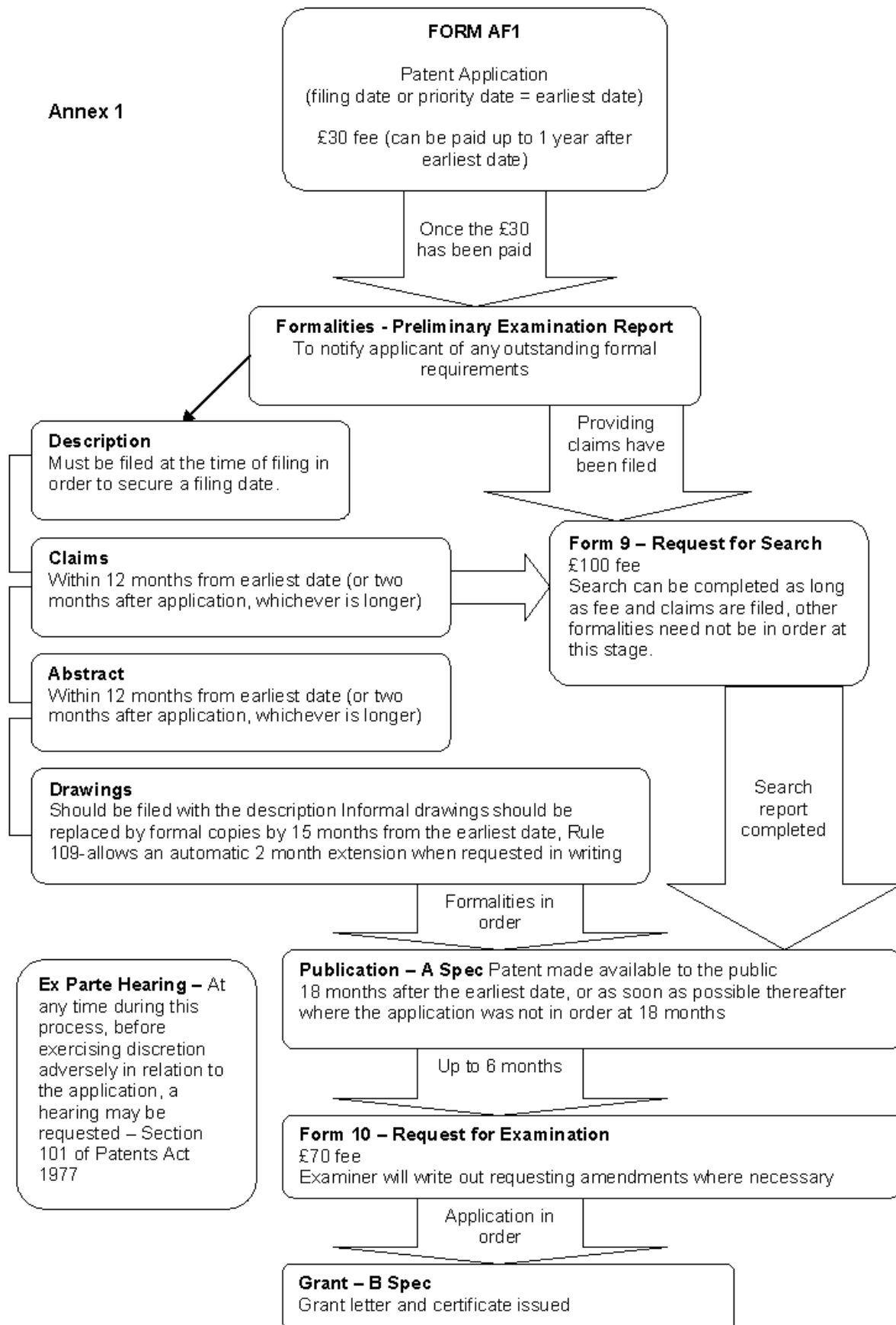
PECS: Import electronic version of transcript using the "Send to dossier" email facility (doc code is HEAR-TRANS). Set status of document as NOPI or OPI.

GENERAL

4.54 Remember:

- **Cases awaiting hearing dates to be confirmed should be checked on a regular basis**
- **Always keep relevant people informed**
- **Always import a file note for a PECS case**
- **Always check whether the excel spreadsheet needs updating**
- **Remember to book (and cancel where appropriate) the shorthand writer**
- **Phone the relevant shorthand writer if there is a delay in obtaining the transcript**
- **Where relevant make available the appropriate Holy Book for the swearing of witnesses. Both Newport and London have a selection of bibles and the Koran. The Hearings Clerk should check prior to the hearing whether those giving oral testimony wish to swear or affirm.**

Annex 1



Annex 2

The compliance period and hearings

The compliance period for putting a patent application in order ends the later of **4 ½ years from the filing/priority date** or **12 months from the issue of the first report** under s 18(3).

The compliance period may be extended in 2 month tranches.

r108(2) allows an as of right extension of 2 months and must be requested using form 52 and by paying a fee of £135 before the end of two months from the compliance period

r108(3) allows further discretionary two month extensions and must be requested using form 52 and by paying a fee of £135 before the expiry of 2 months after the previously extended period. Evidence must be filed to support the request – each discretionary extension is likely to require more robust evidence than the previous discretionary extension allowed.

If the end of the compliance period is imminent and a hearing is necessary then ideally the hearing should be held before the end of the compliance period (or any extended period). A period of less than the minimum of 14 days notice usually given is appropriate if this means that the hearing could be conducted before the end of the compliance period.

Hearing before end of compliance period

If the hearing is conducted and the decision issued before the end of the period then the applicant still has an opportunity to amend his application after an adverse decision.

Hearing before the end of two months after the compliance period

If the hearing results in an adverse decision and the applicant wishes to amend his patent accordingly, he must apply for a two month automatic extension under rule 108(2) using form 52 and paying £135. Amendments should then be made before expiry of the extended compliance period unless it is further extended.

Hearing after the end of two months after the compliance period

If the compliance period has not been extended under rule 108(2) then under rule 108(7) no further extension to the compliance period is allowed under rule 108(3) and amendments following an adverse decision will generally **not** be possible.

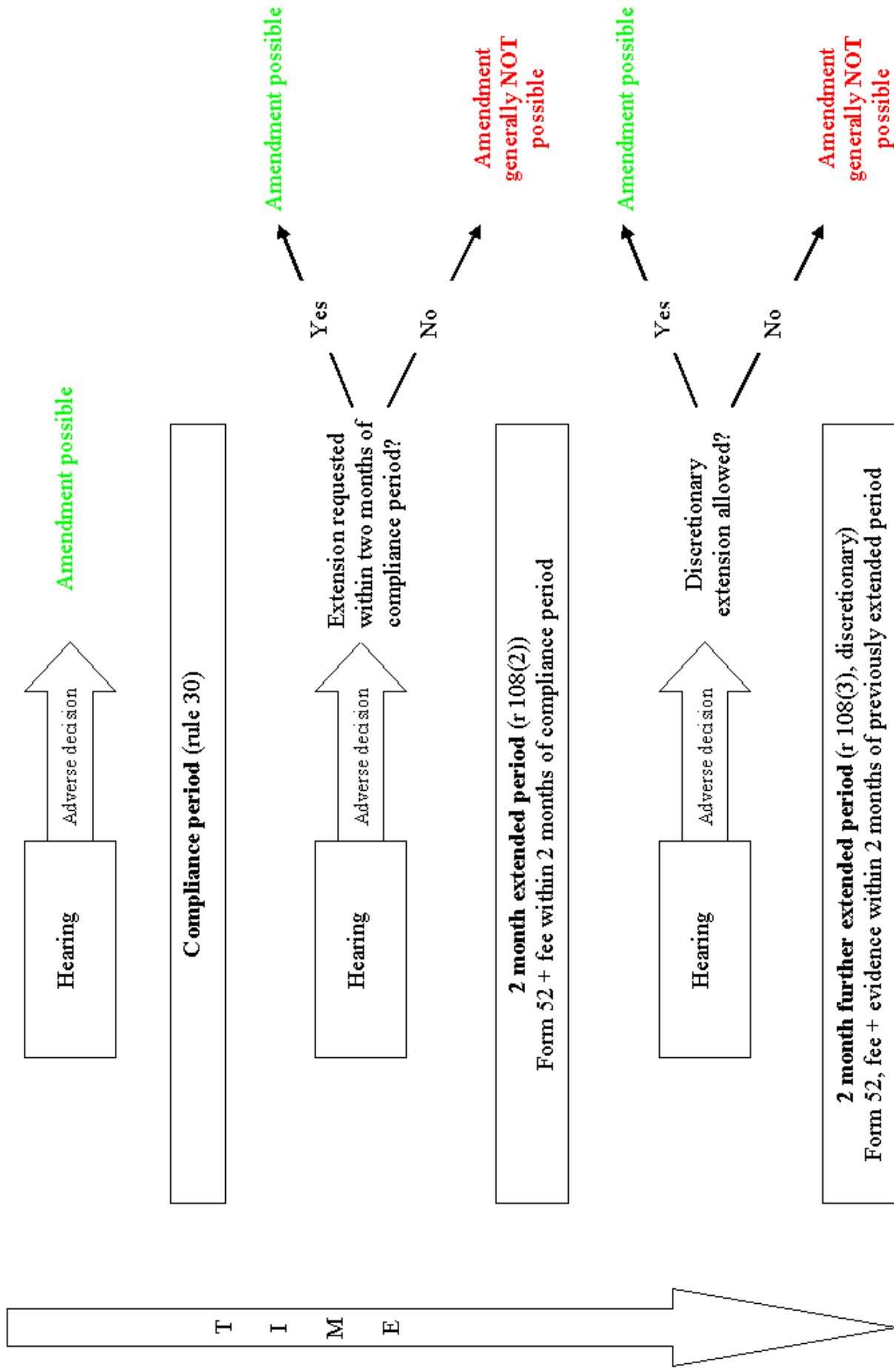
If the compliance period has previously been extended (under rule 108(2) or 108(3)) then a discretionary extension of two months is potentially available. This must be

requested on form 52, paying the fee of £135 and providing evidence supporting the request, all within two months of the previously extended period. Amendment following an adverse decision can then be effected. If the discretionary extension is not allowed then amendment is **not** generally possible.

Appealing an adverse decision

If an appeal is filed following an adverse decision then the compliance period may be extended to allow for the appeal process. See PD Legal for more information.

Hearings and the compliance period. A timeline of possible scenarios



Annex 3

HEARING ARRANGEMENT SHEET	DATE SET -
----------------------------------	-------------------

PATENT NO

SECTION.....

REFERENCE

Patentee

Referrer

Attorneys

Attorneys.....

Telephone

Telephone

Fax

Fax

Contact/ref

Contact/ref.....

Contact name.....

Contact name.....

Counsel.....

Counsel.....

Clerk

Clerk

Telephone

Telephone

Attendees

Attendees

.....

.....

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.....

.....

.....

.....

HO

HA.....

Room

Room.....

Ext

ROOM NUMBER -

CO.....

TIME -

Room.....

BAY No's -

Ext.....

T/W confirmed -

Annex 4

HEARINGS CHECKLIST

AJTC Administrative Justice and Tribunals Council

	<i>EX PARTE</i>	<i>INTER PARTES</i>
FILE RECEIVED		
DATE HEARING REQUEST TO EXAMINER RECEIVED/ DATE WHEN OFFICE OFFERS HEARING - <i>ex parte</i> (AJTC)		
DATE REQUEST FOR PRELIMINARY HEARING/CMC RECEIVED - <i>inter partes</i> (AJTC)		
DATE LAST EVIDENCE FILED - <i>inter partes</i> (AJTC)		
FILE SENT TO HEARING ASSISTANT/LIT. MANAGER		
INITIAL LETTER ISSUED		
PARTIES CONTACTED REGARDING DATE		
HEARING DATE - <i>ex parte & inter partes</i> (AJTC)		
PARTIES INFORMED		
HEARING OFFICER INFORMED		
HEARING ASSISTANT INFORMED		
COURT ROOM BOOKED		
SHORTHAND WRITER BOOKED		
OBSERVER APPOINTED		
DIARY MARKED MANUAL & ELECTRONIC		
WEEKLY HEARINGS LIST		

LIST OF ATTENDEES		
AUTHORITIES CHECKED		
FILE SENT TO HEARING		
TRANSCRIPT RECEIVED		
DECISION ISSUED - <i>ex parte</i> & <i>inter partes</i> (AJTC)		
DECISION APPEALED		

Annex 5 (ex Parte: London)

c/o

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

Direct Line: 01633 81****
Email: *****@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/file reference

Date

Dear Sir

Title in bold

- 1) I am pleased to inform you that the hearing will take place on ***** (**day of the week, date**) at ***** (**time**). The hearing will be held at 13 Bloomsbury Street, London, WC1B 3SS. Please report to reception shortly before the hearing is due to start.
- 2) For security purposes, please let me have a list of all those attending as soon as possible and confirm whether they require any special arrangements to be made for the hearing.
- 3) If you intend to refer to any precedents at the hearing, please let me know what they are **at least 24 hours before the hearing** (tel no. 01633 81****) so that I can obtain copies for the hearing officer to read before the hearing. If the precedent is old or obscure, I may have to ask you to supply a copy.
- 4) Until the hearing, any further correspondence should be marked "**URGENT HEARING - FOR THE IMMEDIATE ATTENTION OF "NAME" ROOM 3Y31, CONCEPT HOUSE.**"

Yours faithfully

Name (Hearings Clerk)
Litigation Section,
Patents Directorate

Annex 6 (ex parte: Newport)

c/o

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

Direct Line: 01633 81****
Email: *****@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/file reference

Date

Dear Sir

Title in bold

- 1) I am pleased to inform you that the hearing will take place on ***** (**day of the week, date**) at ***** (**time**). The hearing will be held at Cardiff Road, Newport, South Wales NP10 8QQ. [Insert car parking info if appropriate – ‘Parking Bay has been reserved for you’]. Please report to reception shortly before the scheduled start.
- 2) For security purposes, please let me have a list of all those attending as soon as possible, and confirm whether they require any special arrangements to be made for the hearing.
- 3) If you intend to refer to any precedents at the hearing, please let me know what they are **at least 48 hours before the hearing** (tel no. 01633 81****) so that I can obtain copies for the hearing officer to read before the hearing. If the precedent is old or obscure, I may have to ask you to supply a copy.
- 4) Until the hearing, any further correspondence should be marked "**URGENT HEARING - FOR THE IMMEDIATE ATTENTION OF "NAME" ROOM 3Y31, CONCEPT HOUSE.**"

Yours faithfully

Name (Hearings Clerk)
Litigation Section,
Patents Directorate

Annex 7

c/o

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

Direct Line: 01633 81****
Email: *****@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/file reference

Date

Dear Sir

Title in bold

Latest date for reply : *****

1) The hearing in the above proceedings is due to take place on(day of week, date) at (time) and is scheduled to last day(s). The hearing will be held at 21 Bloomsbury Street, London, WC1B 3SS.

Arrangements for the Hearing and Cross-Examination

2) You may wish to be represented at the hearing either by a patent attorney, Counsel (a barrister) or another representative.

You should do the following by ***** - (six weeks from date of letter)

- (a) Select your Counsel or other representative and tell us and the other side.
- (b) Tell your own Counsel or representative
 - i) the date of the hearing if you have not already done so
 - ii) that the case is shortly to be ready for the hearing
 - iii) the name and details of the other party's Counsel or representative.

It is essential that you attend to the selection of your representative in good time and that each representative is informed as quickly as possible of each other's name and contact details.

- (c) Inform me if cross-examination is being sought, provide an explanation of why it is

needed and indicate how long it is expected to last. You should also provide me with the names of the witnesses you wish to cross-examine. When cross-examination takes place at a hearing, where possible, retiring rooms will be provided for each party. If you do not require this facility please let me know. You should also let me know if cross-examination is not required.

(d) Inform me if anyone attending the hearing from your side has a disability which requires us to make special arrangements.

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

Yours faithfully

Name (Hearings Clerk)
Litigation Section,
Patents Directorate

Annex 8

c/o

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

Direct Line: 01633 81****
Email: *****@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/file reference

Date

Dear Sirs

Title in bold

1. As you are aware, the ***** hearing in the above proceedings will take place as previously agreed on ***** **(day of week, date) at **** (time)**. The hearing will be held at 13 Bloomsbury Street, London, WC1B 3SS. Please report to reception shortly before the hearing is due to start.

2. For security purposes, please let me have a list of all those attending from your side as soon as possible, and confirm whether they require any special arrangements to be made for the hearing.

Skeleton arguments

3. You are expected to provide a skeleton argument (an outline of the arguments you intend to present at the hearing) at least **2 working days before the hearing**; however it would be helpful to provide this sooner where possible.

4. You should send a copy of your arguments to the other side in sufficient time before the hearing to enable them to properly consider them.

5. A skeleton argument should concisely summarise the party's submissions on the law and any relevant authorities, the issues that need to be resolved by the hearing officer and how the evidence supports its case. It should be as brief as the nature of

the issues allows. It should rarely need to exceed 20 double-spaced A4 pages, and will often be much shorter than this.

Authorities

6. If you intend to refer to any precedents (authorities) at the hearing, please let me know what they are **at least 2 working days before the hearing** (tel no. 01633 81****) so that I can obtain copies for the hearing officer. If a precedent is old or obscure, I may have to ask you to supply a copy.

Bundles

7. If you intend to supply bundles for the hearing then please forward them to: the Hearings Clerk, Intellectual Property Office, 13 Bloomsbury Street, London, WC1B 3SS.

Next day transcripts

8. Where the hearing extends to more than one day, if you require next day transcripts you will need to contact the shorthand writer directly to make arrangements independently on the matter. Please contact me at least **2 working days before the hearing** and I will provide you with the contact details for the shorthand writer.

9. Any further correspondence relating to this hearing should be marked

"URGENT HEARING - FOR THE IMMEDIATE ATTENTION OF (INSERT NAME)

ROOM 3Y31, CONCEPT HOUSE."

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

Yours faithfully

Name (Hearings Clerk)
Litigation Section
Patents Directorate

Annex 9

HEARING DETAILS PRO FORMA

To be sent to shorthand writers when confirming hearing booking

Date of hearing:	Insert date
Patent numbers(s):	Insert number
Name of party/parties:	Insert name(s)
Contact details:	Insert contact details – e.g. name of agent and firm
Tel number:	Insert telephone number
Case reference:	Insert case reference
Hearing Officer:	Insert name of HO
Hearing Assistant:	Insert name of HA

Annex 10

TO: London Hearings clerks {SEND BY EMAIL}

RE: MAIN HEARING COURT ROOM BOOKING

Please note the following:

DATE:.

TIME:

LOCATION

NAME OF PARTY(IES)

HEARING OFFICER:

HEARING ASSISTANT:

PATENT NO:

PATENT NAME:

NAMES OF PEOPLE ATTENDING/CONTACT NAME & TELEPHONE NUMBER:

Annex 11

HEARINGS ROOMS – BLOOMSBURY STREET

ROOM	CAPACITY	TYPE	FACILITIES
.04	TBC	Hearing Room Conference Room	TBC
2.03	TBC	Hearing Room Conference Room	TBC
2.02	TBC	Hearing Room Conference Room	TBC
2.05	TBC	Retiring Room	TBC
2.06	TBC	Retiring Room	TBC
2.16	TBC	Video Conf. Room	TBC
2.17	TBC	Video Conf. Room	TBC

Annex 12

CANCELLATION CHECKLIST

	EX PARTE	INTER PARTES
Paper Decision		
Complete Withdrawal		
Postponed/Reinstated		
Verbal		
Fax		
Letter confirmation		
Hearing Officer informed		
Hearing Assistant informed		
Case Examiner informed		
Court room (Accommodation) cancelled		
IT (videolink) cancelled		
London Hearings Clerk contacted ie : <i>Inter Partes</i>		
Short hand writer telephoned/letter issued		
Diary & Excel updated		
Files sent on		
Record Cards		
Hearings file amalgamated		
Delete details from Hearings list published on the website		

Annex 13

Send by email:

TO:

Head of Litigation Section
Hearings Team Manager Hearings Clerk London

cc.Hearings Team

Intranet Editor

RE: WEEKLY HEARINGS LIST

Please find attached a list of hearings that have been appointed for the week commencing
.....

Annex 14
(Case management Conference/Pre-hearing Review/Preliminary Hearing)

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

Date

Dear Sir

Title in bold

1. I am pleased to inform you that the *case management conference/pre-hearing review/preliminary hearing* in the above proceedings will take place on ***** **(day of week, date) at **** (time)**. It will be held at*****. Please report to reception shortly before the hearing is due to start.

2. The *case management conference/pre-hearing review/preliminary hearing* has been arranged to..... [Hearing Officer to supply information]. If there are any other issues that you want to raise, you should notify me and the other side as soon as possible.

3. For security purposes, please let me have a list of all those attending from your side as soon as possible, and confirm whether they require any special arrangements to be made for the hearing. [I am pleased to confirm the following arrangements have so far been made] - *add as appropriate*.

Skeleton Arguments and Authorities

[Check with the HO which of the following three paragraphs should be included.]

4. You are expected to provide a skeleton argument (an outline of the argument you intend to present at the hearing) at least **2 working days before the hearing**; however it would be helpful to provide this sooner where possible You should send a copy of your arguments to the other side in sufficient time before the hearing to enable them to

properly consider them. If you intend to refer to any precedents at the hearing, please let me know what they are **at least 24 hours before the hearing** (tel no. 01633 81****) so that I can obtain copies for the hearing officer. If a precedent is old or obscure, I may have to ask you to supply a copy.

or

You do not need to supply any [other] documents specifically for this hearing/case management conference/pre-hearing review.

or

It would be helpful if you would supply [*HO to supply this information*] by"

5. Any further correspondence relating to this hearing should be marked "**URGENT HEARING - FOR THE IMMEDIATE ATTENTION OF "NAME" ROOM 3Y31, CONCEPT HOUSE.**"

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

Yours faithfully

Name (Hearings Clerk)
Litigation Section,
Patents Directorate