

CHAPTER 5

DECISIONS

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5 DECISIONS

INTRODUCTION

5.01 Decisions are usually written by the HO following an *inter partes* or *ex parte* hearing; occasionally however the HO will give an oral decision at the hearing. Where the part(y)ies agree, the HO may write a decision based on the papers filed. Decisions can be:

- Preliminary; where a preliminary point has been decided in order to progress the case to a substantive hearing
- Interim; where the final decision can only be issued once certain points have been fulfilled following the substantive hearing
- Substantive; where the definitive orders of the comptroller are made.

BL numbers

5.02 Each decision is allocated its own British Library number (BL number). The hearings clerk will allocate the BL number on receipt of the electronic version of the decision.

5.03 The list is available in the form of a spreadsheet and may be found on the 'H' drive under Litigation.

ISSUING A DECISION

HO action

5.04 The HO will:

- Email the decisionsandabstracts email box with the decision and abstract (summary). The hearings clerk needs to check the decisions and abstracts mailbox on a regular basis to see if a decision needs to be issued.
- Request the hearings clerk sends a copy of the decision to the part(y)ies. If an

abstract is not received within five days of receipt of the electronic version of the decision, you need to follow up with the HO.

Hearings Clerk action

Decision

5.05 There is a checklist to follow for issuing inter partes and ex parte decisions (see annex 1.1). You need to:

- Re-open the decision document in Word, insert the appropriate electronic signature, allocate a BL number and provide a date for the decision. The date will be the date the decision is sent to you.
- Save the signed version with the BL number and date in the hearings folder on the H drive
- Enter the BL number and date of the decision in the abstract
- Save the abstract in the hearings folder on the H drive
- Check application / publication number(s) are correctly quoted in the decision and abstract
- Take a print of the decision and obtain further copies as shown below:

Ex parte:

Copy the signed version and pass to the A1 hearings assistant for external distribution (see Circulating Decisions).

Inter partes:

Make two copies and pass one to the A1 hearings assistant and one to the *inter partes* case officer.

Note: If the decision is NOPI, wait until the 28 day consent period has expired. If consent has been received in writing, pass a copy of the decision to the hearings assistant. Set a task in the electronic diary system to ensure this is carried out.

- If the decision is *ex parte* and OPI, add the signed copy to the PECS file – status is OPI.

- If the decision is *inter partes* and OPI, add the signed copy to the PECS file - status is OPI.

Note: Any decisions relating to PECS files that are NOPI should also be shown as NOPI. Once the 28 day consent period has expired, the status may need to be changed to OPI. Set a task in the electronic diary system to ensure this is carried out (see paragraphs 5.12 – 5.14).

PECS:- Once the signature, BL number and date have been added to the decision, import it into PECS using manual import (doc code is DECISION-LIT) If the decision is OPI it should be marked as such [Click on decision to highlight it; right click to bring up additional menu options; click on 'Details...'; click on 'Status'. You can now change the status from 'Public' to 'Not Public']

- Open the decision in the hearings folder on the H drive and delete the signature from the decision.
- Save a copy of this decision.
- If the decision is OPI, send to Webmaster (see paragraph 5.18).
- Add a copy of the unsigned decision to the PECS file
- Once the decision has been published on the website, add the OLF1 annotation to the unsigned version on the PECS file
- Once all actions have been carried out and the decision has been published on the Office website and Ipsum, delete the file from the electronic hearings folder

Letter

5.06 The letter should include the title of the proceedings as follows:

PATENT NUMBER (DEFENDANT'S NAME) ***** SECTION OF ACT***
(CLAIMANT'S NAME) *****

- Select relevant letter from the PROSE database (see annexes)
- Check address of part(y)ies - Refer to proceedings file / PECS FILE / OPTICS

- Check the latest date for filing an appeal as this will need to be included in the letter (see Appeals below)
- Print the letter and sign it
- Copy the letter(s) and place the cop(y)ies in the correspondence part of the proceedings file (*inter partes*) or in the correspondence section of the patent file (*ex parte* cases not on PECS).
- Send the letter and a copy of the decision to the part(y)ies
- Import the letter to the PECS dossier
- Once the decision has been published on the website, add the OLF1 annotation to the letter in order to add it to Ipsum

PECS:- Import letter from PROSE to the PECS dossier

ORAL DECISIONS

5.07 Occasionally, the HO may make an oral decision at the hearing. If a decision is given orally and a transcript writer hasn't been used, you should liaise with the HO about adding the decision to the website. If a transcript writer has been used, you need to:

- Liaise within the relevant shorthand writer to ensure that the transcript has been received with the timescale agreed. This is usually sent by email.
- On receipt, update the Excel spreadsheet to show the date the transcript has been received and the number of folios.
- Forward the transcript to the HO for him/her to review.
- Liaise with the shorthand writer regarding any corrections

5.08 If the HO is satisfied with the transcript, you need to:

- Send a copy to the parties as the transcript will form a decision in its own right.
- Ensure the parties are aware that any appeal will run from the date the decision was made orally and **not** from the date the paper record is sent out. The shorthand writer will usually afterwards send a bound version of the finalized transcript to be placed on the proceedings/patent file.

- The transcript should then be sent to the webmaster for publication on our website (see paragraph 5.18).
- Add the transcript to the PECS dossier
- Once the transcript has been published on the website as a decision, add the OLF1 annotation

PECS:- Import the emailed transcript using the “Send to Dossier” facility; as the transcript constitutes the decision, it should be referred to as such on PECS (doc code is DECISION-LIT)

ADDITIONAL ACTIONS

Hearings spreadsheet

5.09 You need to update the hearings spreadsheet as follows:

- Insert date decision issued
- Insert date decision circulated (see paragraph 5.15)
- Insert relevant sections of the act.
- Check if the patent is OPI or NOPI by using Optics or viewing the decision itself. Update the column on the spreadsheet if required.

Appeal Period

5.10 You need to action as follows:

- Enter the date the appeal period expires in your electronic diary plus two weeks making sure you identify the case (eg application/patent number and applicant/proprietor).

PECS: Place the plastic wallet containing the hearing arrangement sheets in the folder entitled PECS CASES: AWAITING APPEAL PERIOD.

5.11 Some cases may not need an appeal route because they will have been allowed.

Such cases should be returned to the appropriate officer as advised by the B3 following circulation of the decision.

NOPI DECISIONS

5.12 Decisions that are “Not open to Public Inspection” (NOPI) include those relating to:

- Section 40 of the Patents Act 1977
- Unpublished patent applications
- Design Right cases
- Decisions which contain potentially commercially sensitive material.

5.13 When the decision relates to one of the exceptions, the decision must be issued with the appropriate letter (see annex 5). For ex parte and inter partes decisions that relate to unpublished patent applications, the party(y)ies will be asked to confirm in writing within 28 days whether they consent to the decision being published on our website. Where the applicant is not party to the proceedings we should also write to them and obtain their consent.

If consent is received from all part(y)(ies) concerned, the decision should be added to the website and to Ipsum.

If consent is not received from all parties concerned, the decision should remain NOPI. You should:

- Store the decision in the hearings NOPI folder on the H drive until such time as the patent application is published.
- Send a PECS message to Formalities asking them to inform you when the application has been published. Once published, the decision should be added to the website and Ipsum as usual.

Decisions relating to section 40 inter partes cases and design right cases should be referred to the B3 who will advise how to proceed.

PECS: Import letter from PROSE to PECS dossier

5.14 If the part(y)(ies), or the applicant consent but wish certain parts of the decision to be redacted before publication, check with the HO. If a redacted version of the decision is agreed, you need to:

- Send a copy to the part(y)ies with letter 5(c).
- Add two copies of the redacted version to the PECS dossier – one signed and one unsigned
- Send a copy of the unsigned redacted version to Webmaster
- Once the redacted version has been published on the website, add the OLF1 annotation to the unsigned version on the PECS file
- Inform the hearings assistant and advise that the redacted version is OPI and may be sent to the external contacts listed in annex 4.

PECS:- Import letter from PROSE to PECS dossier

Import redacted version of decision (doc code is DECISION-LIT; annotate 'Redacted version').

The status of the redacted version should be shown as OPI. The status of the original version should remain as NOPI

CIRCULATING DECISIONS

Internal

Electronic version

5.15 The A3 Hearings Clerk should:

- Circulate the decision by email (see annex 3).
- If the decision is NOPI ensure this is also entered on the spreadsheet.
- When the decision becomes OPI, update the spreadsheet to reflect this.

Target is two days from the receipt of the electronic version of the decision.

Paper version

5.16 The A1 Hearings Assistant should:

- Circulate to the B3 with a Clear Records Pro Forma. The B3 will update OPTICS and advise any other actions that need to be taken.

External

5.17 You need to:

- Provide the A1 with a copy of a paper version of the decision and ask the A1 to send a copy to each of the contacts shown in annex 4. If the decision is NOPI, this action should be carried out when the decision becomes OPI (see NOPI Decisions above).

PUTTING DECISIONS AND ABSTRACTS ON THE OFFICE WEB SITE

5.18 All OPI decisions should be published on the Office's website. You need to carry out the following actions:

- Forward the **unsigned** electronic version of the decision by email to webmaster (the internet team) and request that they add this to the patents decision database
- Enter the information from the abstract in the Patents Database Maintenance Application (see annex 6). The abstract will appear on the Office's website the following day.

Note: Action the abstract the day after the paper version of the decision has been issued otherwise it will appear on the database before the part(y)ies have received it

The target date for both actions is two days from the date of receipt – but the decision must be OPI .

Check the next day to see whether the decision and abstract has been placed on the external website correctly. E-mail webmaster if there are any problems, or simply to confirm that the documents have been published correctly.

NOTE: If the decision is originally NOPI remember to carry out this procedure when it becomes OPI.

BUNDLES

5.19 For some *inter partes* hearings, bundles consisting of copies of all the papers that might be needed at the hearing, are produced by the parties (see Chapter 4 for more information on bundles). These bundles are offered back to the parties. You should take the following action:

- When issuing the decision, edit the letter as appropriate.
- Unless we receive a request to return the bundles to the party, you should destroy them once the appeal period has expired

Note: Bundles are **not** to be confused with the original evidence filed in the proceedings. This will always stay with the case.

APPEALS

5.20 The appeal periods are as follows:

- Patents: 28 days from the date of the decision
- Design right: 6 weeks from the date of the decision (substantive decision)
- Design right: 14 days from the date of the decision (procedural decision)

For decisions issued following a hearing in Scotland, you should check the appeal period with the hearing officer.

If no appeal is filed

5.21 After the appeal period has expired, and if no appeal has been lodged, you need to take the following action:

Inter partes cases

- Ensure all correspondence relating to the hearing has been added to the PECS file.
- Any other papers should be added in date order.
- Any correspondence that is subject to a confidentiality direction should be shown as such (see case officer).
- Send the case to the relevant case officer informing him/her that the appeal period has expired and no appeal has been lodged

The case officer will review the proceedings and may advise the *ex parte* team about any subsequent action they may need to take e.g. clearing the case and closing the proceedings. In most instances the B2 case officer will clear the case.

PECS: - Create and send message to Case Officer. Message = No appeal filed

Ex parte cases

- Follow instructions on file from the HO if any are given.
- Return the file to the manager of the formalities section from which it originated. Instructions will have been provided by the B3 (see Clear Records Pro Forma)
- Mark the excel spreadsheet to show the case has been cleared.

PECS:- Create a file note as follows: "No appeal filed" (doc code is FILENOTE-LIT)

Create a minute and send message as instructed by B3 (doc code is MINUTE-LIT; Message = PSM)

If an appeal is filed

5.22 See Chapter 6

MONITORING DECISIONS

5.23 In order to monitor decisions by HOs, Divisional Directors are sent each week a report generated from the hearings spreadsheet. To produce the report, you should:

- Open the spreadsheet on the H drive in the Litigation folder
- Leaving this open, open the Exception Report folder and click on the HER file
- Click on the button 'enable macros'
- Click on the update circle. This will generate the exception report for both *inter partes* and *ex parte* cases. The reports will show in the *inter partes* and *ex parte* tabs on the bottom row of the spreadsheet.
- Exit the HER file and open the Exception Report file
- Send the report by e-mail to each of the Hearing Officers and cc to the B3 manager of Litigation Section and Director of Patents ((File/send to mail recipient as attachment)

DECISION & ABSTRACTS – Annex 1.1	
Open Decision in word	
Go into the BL spreadsheet and allocate a BL number	
Insert the BL number on the Decision	
Add date the Decision in issued	
Add the HO signature to the Decision (insert/picture from file/litigation/hearings/HO sigs)	
Minute the dossier with date issued (if NOPI state on minute)	
Print a copy of the Decision with the signature on and make copies (A1 – if NOPI do not give to A1 until it is made OPI) – PUT SIGNED COPY ON DOSSIER	
IF OPI CHANGE STATUS	
Delete the signature and save the Decision on the H drive, litigation, hearings – and put the company name/BL number as heading (file name)(if decision is NOPI drag into the folder in hearings folder marked NOPI-do not circ or send to webmaster)	
Compose appropriate letter to go out with the decision	
Open the Abstract in word	
Add the BL number and date	
Save on the H drive, litigation, hearing – put Company name/BL number and abstract as file name (if NOPI in folder marked NOPI)	
New mail to webmaster – click on the paperclip to attach the saved copy of the decision / NOT signed (do not send if NOPI)	
New mail to circulate – click on the paperclip to attach the decision and abstract /NOT signed (do not circ if NOPI)	
Update spreadsheet with date and section of act – in column OPI/NOPI check on optics and put status in column	
Set task to put the abstract on the database – not NOPI	
Set task for appeal period (mark task NOPI to action in 28 days plus 2 weeks)	
1 - Next day – put abstract on Decision database (2nd day)	
2 - CHECK DECISION/SUMMARY ON WEB (3rd day) & inform webmaster that everything looks ok	
3 - PUT AN UNSIGNED COPY OF THE DECISION ON THE DOSSIER (grey out sig) AND MARK OLF (3rd day) (make sure all letters and docs are marked OLF)	
Delete the Decision and abstract before dragging into the cabinet	

If the decision is a Section 13 – send a pecc message to Ex Parte team to clear the case.

ANNEX 1(a) (*patents ex parte*)

c/o

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

Direct Line: 01633 814341
Email: *****
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
internet: www.ipso.gov.uk

Your Reference:
Our Reference: 3Y31/name/file reference

Date

Dear Sir

Title in bold

1. Please find enclosed a copy of a decision dated *****.
2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).
3. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee (currently £200) **within the time period specified in the decision**. The latest date for appeal is therefore *****. Any request for an extension to the appeal period identified in the decision must be made to the court.
4. Once you have filed your appeal at the court, you must send a copy to the Notice of Appeal to the Comptroller as soon as practicable and no later than 7 days from the date of filing.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Name
Litigation Section
Patents Directorate

ANNEX 1(b) (patents - inter partes)

c/o

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

Direct Line: 01633 814341
Email: *****
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
internet: www.ipo.gov.uk

Your Reference:
Our Reference: Room 3Y31/name/file reference

Date

Dear Sir

Title in bold

1. Please find enclosed a copy of a decision dated *****.
2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).
3. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee (currently £200) **within in the time period specified in the decision.** The latest date for appeal is therefore *****. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
4. Once you have filed your appeal, you must send a copy of the Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

[Bundles] (*optional delete as necessary*)

6. I note that you produced bundles for use at the hearing. If you would like these returned to you please inform me before the end of the appeal period, otherwise, the bundles will be destroyed.

A letter in identical terms is being sent to the other side.

Yours faithfully

Name
Litigation Section
Patents Directorate.

Annex 1(c)
Supplementary Protection Certificates (SPCs)

Address

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

Direct Line: 01633 814341
Email: *****
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
internet: www.ipos.gov.uk

Your Reference:
Our Reference: 3Y31/name/file reference

Date

Dear Sir

Supplementary Protection Certificates: Council Regulation (EEC) No 1768/92
Application No:

1. Please find enclosed a copy of a decision dated *****.
2. Regulation 5 of the Patents (Supplementary Protection Certificate for Medicinal Products) Regulations 1992 extends the existing provisions of the Patents Acts 1949 and 1977 to certificates. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details of which may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).
3. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee (currently £200) **within in the time period specified in the decision**. The latest date for appeal is therefore *****. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
4. Once you have filed your appeal, you must send a copy of the Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Name
Litigation Section
Patents Directorate.

ANNEX 1(d)

PCT – Judicial Review Cover Letter

Patents Directorate

Address

Concept House
Cardiff Road, Newport
South Wales, NP10 8QQ

Direct Line: 01633 814341

E-Mail: *****

Switchboard: 01633 814000

Fax: 01633 814491

Minicom: 08459 222250

DX: 722540/41 Cleppa Park 3

Your reference:
Our reference:

Date

Dear Sirs

Patent Number :

1. Please find enclosed a copy of a decision dated 2010.
2. The decision has been made by the Intellectual Property Office in its capacity as a receiving Office under the Patent Co-operation Treaty. This means that there is no route of appeal available to you under the UK's patents legislation (the Patents Act 1977).
3. However, the Office's decision is open to judicial review by the Administrative Court. The procedure for judicial review is governed by Part 54 of the Civil Procedure Rules and the associated Practice Direction 54. If you decide to apply for judicial review, a claim form must be filed at the court in the appropriate format. You can find detailed guidance on the process of applying for judicial review on the website of HM Courts Service, at <http://hmcourts-service.gov.uk/cms/1220.htm>.
4. Please note that an application for judicial review must be filed promptly and in any event no later than three months after the Office's decision was issued. The court does have the power to extend this period, but will only do so if it satisfied there are very good reasons for doing so.

Yours faithfully

(Hearings Clerk)
Litigation Section
Patents Directorate

ANNEX 1(e)
(Patents - inter partes Court of Session)

Address

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

Direct Line: 01633 814341
E-Mail: *****
Switchboard: 0300 300 2000
Fax: 01633 814491
Minicom: 0300 0200 015
DX: 722540/41 Cleppa Park 3

Your reference:

Our reference: 3Y31/Name

Date

Dear Sirs

Patent Number :

Reference under Section of the Patents Act 1977

1. Please find enclosed a copy of a decision dated
2. The Patents Act 1977 gives you the right to appeal to the Court of Session against the decision if you wish to do so. The procedure for appeal is governed by the Rules of the Court of Session 1994. Further details may be obtained from the Court of Session, Parliament House, Parliament Square, Edinburgh, EH1 1RQ (telephone number 0131 240 6711).
3. If you wish to appeal this decision you must do so by **6 weeks from date of decision**. Any request for an extension to the appeal period identified in the decision must be made to the court.
4. Once you have filed your appeal, you must inform the office and any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

A letter in identical terms is being sent to the other side.

Yours faithfully

Name (Hearings Clerk)
Litigation Section
Patents Directorate

ANNEX 2
Design Right (Subsistence, Term & Identity, Licence of Right)

c/o

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

Direct Line: 01633 814341
Email: *****
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: www.ipo.gov.uk

Your Reference:
Our Reference: 3Y31/name/file reference

Date

Dear Sir

Title in bold

1. Please find enclosed a copy of a decision dated *****.
2. Decisions are normally made available for public inspection in full. If you are unhappy about any part of the decision being made public in this way (eg because it refers to commercially-confidential information) please let me know **within 28 days from the date of this letter**, explaining your concerns. If the hearing officer accepts your concerns, the decision will be made public in a suitably edited form.
3. The Copyright, Designs and Patents Act 1998 (as amended) gives you the right to appeal to the Chancery Division (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).
4. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee (currently £200) **within in the time period specified in the decision**. The latest date for appeal is therefore *****. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
5. Once you have filed your appeal, you must send a copy of the Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

6. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

[Bundles] (*optional delete as necessary*)

7. I note that you produced bundles for use at the hearing. If you would like these returned to you please inform me before the end of the appeal period, otherwise, the bundles will be destroyed.

A letter in identical terms is being sent to the other side.

Yours faithfully

Name
Litigation Section
Patents Directorate.

ANNEX 3

Annex 3 has been removed and can be found with the Hearings Clerk in paper format.

ANNEX 4

Annex 4 has been removed and can be found with the Litigation Assistant in paper format.

ANNEX 5(a) (Not Open to Public Inspection ex parte)

c/o

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

Direct Line: 01633 814341
Email: *****
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
internet: www.ipso.gov.uk

Your Reference:
Our Reference: 3Y31/name/file reference

Date

Dear Sir

Title in bold

1. Please find enclosed a copy of a decision dated *****.
2. Decisions are normally made available for public inspection in full on our website. However, because this decision relates to an unpublished patent application, you are asked to let us know in writing **within 28 days of the date of this letter** whether you consent to us publishing the decision on our website. If nothing is received in writing from you, the decision will remain Not Open to Public Inspection until the patent application is published.
3. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).
4. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee (currently £200) **within in the time period specified in the decision. The latest date for appeal is therefore *****. Any request for an extension to the appeal period identified in the decision must be made to the court.**
5. Once you have filed your appeal, you must send a copy of the Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

6. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Name
Litigation Section
Patents Directorate

ANNEX 5(b) (Not Open to Public Inspection: inter partes)

c/o

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

Direct Line: 01633 814341
Email: *****
witchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
internet: www.ipso.gov.uk

Your Reference:
Our Reference: 3Y31/name/file reference

Date

Dear Sir

Title in bold

1. Please find enclosed a copy of a decision dated *****.

Insert – for unpublished patent applications:

2. Decisions are normally made available for public inspection in full on our website. However, because this decision relates to an unpublished patent application, you are asked to let us know in writing **within 28 days of the date of this letter** whether you consent to us publishing the decision on our website. If nothing is received in writing from you, the decision will remain Not Open to Public Inspection until the patent application is published.

Or

2. Decisions are normally made available for public inspection in full on our website. If you are unhappy about any part of the decision being made public in this way (eg because it refers to commercially-confidential information) please let me know **within 28 days from the date of this letter**, explaining your concerns. If the hearing officer accepts your concerns, the decision will be made public in a suitably edited form.

3. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).

4. Three copies of the Notice of Appeal must be lodged with the High Court Appeals

Office (address above) together with the fee (currently £200) **within in the time period specified in the decision**. The latest date for appeal is therefore *****. **Any request for an extension to the appeal period identified in the decision must be made to the court.**

5. Once you have filed your appeal, you must send a copy of the Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

6. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

[Bundles] (*optional delete as necessary*)

7. I note that you produced bundles for use at the hearing. If you would like these returned to you please inform me before the end of the appeal period, otherwise, the bundles will be destroyed.

A letter in identical terms is being sent to the other side.

Yours faithfully

Name
Litigation Section
Patents Directorate.

ANNEX 5(c) (redacted)

c/o

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

Direct Line: 01633 814341
Email: *****
Switchboard 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
internet: www.ipo.gov.uk

Your Reference:
Our Reference: 3Y31/name/file reference

Date

Dear Sir

Title in bold

1. Please find enclosed a copy of a decision dated *****.
2. This version is Open to Public Inspection, since it contains none of the sensitive information contained within the Not Open to Public Inspection version.

Yours faithfully

Name
Litigation Section
Patents Directorate.

ANNEX 6

PATENTS DATABASE MAINTENANCE APPLICATION

TO ADD NEW DECISION RECORD:

Open the Patents Database Maintenance Application

Click on icon - 'Add a new decision record' – top left hand corner underneath the word 'File'

A dialogue box will appear entitled 'New Decision Record'

Enter the BL number for the new decision record in the box eg O/307/06 and press OK

A New Decision Record will appear

Minimise the application so that it appears on the tool bar at the bottom of your screen

Go to the 'decisionsandabstracts' email box and open the abstract (summary) provided by the hearing officer or his assistant. You need to enter this information in the New Decision Record.

TO COMPLETE FOUR MAIN DIALOGUE BOXES:

Decision Date

Make a note of the decision date.

Maximise the New Decision Record by clicking on it.

Click on the arrow within the Decision date dialogue box. A drop down menu will appear. The default is to the current month but clicking on the left hand button will take you back a month and clicking on the right hand button will take you forward a month. Click on the date you want and it will appear automatically in the Decision Date box.

Hearing Officer

Re-open the summary in the 'decisionsandabstracts' box and make a note of the Hearing Officer.

Maximise the New Decision Record.

The Hearing Officer dialogue box has a drop down menu. Click on the arrow button

in the box and the drop down menu will appear. Choose a Hearing Officer by left clicking on a name.

Hearing Type

Re-open the summary in the 'decisionsandabstracts' box and make a note of the hearing type – either inter partes or ex parte.

Maximise the New Decision Record.

The Hearing Type dialogue box has a drop down menu. Click on the arrow button in the box and the menu appears. Choose ex parte or inter partes by left clicking with mouse.

Party/Parties

Re-open the summary in the 'decisionsandabstracts' box and copy the party/parties name(s).

Maximise the New Decision Record.

Left click in the Party/Parties dialogue box and paste in the names.

TO COMPLETE TABBED BOXES:

Application/Patents Nos:

Re-open the summary in the 'decisionsandabstracts' box and copy the application / patent number. If there is more than one, you'll need to copy each separately.

Maximise the New Decision Record.

Left click in main Application / Patent Nos box, then right click.

A new dialogue box will appear with the word **New** highlighted in bold.

Left click and a further dialogue box appear entitled 'New Application/Patent'. Paste the number into the box – use keyboard command Ctrl and V. Click OK. The number will then appear in the main Application/Patent Nos dialogue box.

Provisions discussed

Re-open the summary in the 'decisionsandabstracts' box and copy the relevant information.

Maximise the New Decision Record.

Paste the information into the box.

Related decisions

These may refer to an Office decision or a decision of the Court.

Re-open the summary in the 'decisionsandabstracts' box and copy the decision number. If there is more than one, you'll need to copy each separately. [For Office decisions, there is no need to include the letters 'BL'].

Maximise the New Decision Record.

Left click in Related Decisions dialogue box.

Left click again and the word **New** highlighted in bold will appear. Left click on this. You now have the option of either adding the BL number of an Office decision or a decision of the Court.

Left click on the option you want and a new dialogue box will appear. Click in the relevant box and paste the number into the box.

Press OK.

The relevant number now appears in the main Related decisions box.

Keyword

Re-open the summary in the 'decisionsandabstracts' box and make a note of each of the keywords.

Maximise the New Decision Record.

From the Available Keywords list, highlight the one you want to add, then click on the '<' button. The word will then appear under the hearing Selected Keywords. Repeat the process for each word.

Note:

If you select an incorrect word, you can delete it. Highlight the word and click on the '>' button. The word will be deleted from the 'Selected keywords' list and will one again appear in the Available Keywords list.

Concerning rights in

Re-open the summary in the 'decisionsandabstracts' box and copy the application / patent number.

Maximise the New Decision Record.

Paste the number into the box - use keyboard command Ctrl and V.

Summary

Re-open the summary in the 'decisionsandabstracts' box and copy all the summary.

Maximise the New Decision Record.

Paste the summary into the box.

TO FINISH OR TO CLOSE RECORD

Click on the OK button – next to the Cancel button

Close the application as usual