

CHAPTER 6

APPEALS

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6 APPEALS

INTRODUCTION

6.01 If an applicant disagrees with an *ex parte* decision, he can take the matter further by filing an appeal. *Inter partes* decisions can also be appealed.

Rules and appeal periods

6.02 Appeals relating to Patents, Supplementary Protection Certificates (SPCs) and Design Right (subsistence/term/identity) are governed by Part 52 of the Civil Procedure Rules and the Practice Direction relating to Part 52. The statutory appeal period is 28 days with no discretion to direct a different period.

6.03 Appeals relating to Design Right Licence of Right cases are governed by the Registered Designs Appeal Tribunal Rules 1950. The appeals periods are:

- Procedural decisions: 14 days
- Substantive decisions: 6 weeks

6.04 Where a hearing has been held in Scotland and a decision is subsequently issued, different rules apply.

Where should an appeal be filed?

6.05 Appeals relating to patents and SPCs should be filed at the Patents Court, part of the High Court.

6.06 Design Right appeals relating to matters of subsistence, term and identity should be filed at the Chancery Division of the High Court.

6.07 Design Right Licence of Right appeals should be filed with the Registered Designs Appeal Tribunal.

6.08 If a decision is issued following a hearing in Scotland, an appeal may be filed with the Scottish Courts.

Extending the appeal period

6.09 An application to extend the appeal period must be filed directly with the court in all cases except for appeals to the Registered Designs Appeals Tribunal regarding Design Right - Licence of Right. In this case the comptroller may extend the appeal period but the request needs to be made prior to the expiry of the initial appeal period (see annexes 1 and 2).

Names of parties

6.10 The person who files the appeal is known as the appellant. The other side is known as the respondent.

How to file an appeal

6.11 For patents, SPCs and Design Right (subsistence/term/identity), two copies of a completed Notice of Appeal together with a fee of £200 must be filed at the High Court Appeals Office.

6.12 The Notice of Appeals form can be obtained from the:

High Court Appeals Office,

Room WG7

West Green Building

Royal Courts of Justice

Strand, London

WC2A 2LL

Tel: 0207 947 7383

6.13 Design Right Licence of Right appeals are dealt with by the Registered Designs Appeal Tribunal. The contact address is as above.

Additional actions by the appellant

6.14 The appellant needs to send a copy of the Notice of Appeal to all the parties involved in the proceedings, including the comptroller, as soon as practicable and at least within 7 days of filing the appeal

- 6.15 In Design Right Licence of Right appeals, the appellant needs to send a copy of the Notice of Appeal to the comptroller within 2 days of filing the appeal with the Registered Designs Appeal Tribunal.

CHECKLIST OF ACTIONS RELATING TO APPEALS

- 6.16 A full checklist of actions that need to be carried out on receipt of an appeal is to be found at annex 3.

INITIAL ACTIONS ONCE NOTICE OF APPEAL RECEIVED

- 6.17 When you receive a sealed copy of a Notice of Appeal, you need to:

- Send for the proceedings file and/or patents case file if you do not already have this.

Note: The sealed notice of appeal document should contain a date stamp from the High Court worded “Supreme Court of Judicature”.

This signifies that the document has been properly sealed and the appeal is ready to proceed.

- Send an e-mail to the relevant HO to let them know that an appeal has been filed.
- If the appeal is in relation to an *ex parte* case, you need to fax the Notice of Appeal and any supporting documents to Andrew Prior at the Treasury Solicitors [Fax: 0207-210-3119]. This should be done immediately as the Treasury Solicitors will need to instruct Counsel. Counsel will represent us at the appeal.

Note: For *inter partes* appeals it isn't necessary to fax documents to Andrew Prior as the comptroller is rarely represented in *inter partes* matters. Occasionally, however, the HO will direct that Counsel will be required.

- Update the excel hearings spreadsheet to show an appeal has been filed.
- Minute the relevant file(s) as follows to show an appeal has been filed: ‘Appeal to Patents Court filed on(insert date).
- Make a free text register entry in OPTICS (where appropriate) as follows: “Notice of Appeal against decision of the comptroller dated (insert date) lodged with the Patents Court on (insert date)”.
- Advertise the appeal in the Journal. [Full details of Journal entries can be found in Chapter 26]

- Copy the Notice of Appeal and any supporting papers and attach a circulation note (see annex 4). The papers should then be circulated.

Note: The HO for the case should be first on the list. He/she will give you any additional instructions as appropriate. When the papers are returned to the section, you need to check if any additional instructions have been added and action as appropriate.

- Tag the Notice of Appeal and any supporting papers with an ID label, add the filing date and file the papers on the relevant file:

Ex parte appeals: The patents file on top of the decision

Inter partes appeals: The proceedings file on top of the decision

BRIEFING COUNSEL

6.18 In *ex parte* cases, the comptroller will be represented by Counsel, instructed by the Treasury Solicitors.

6.19 In general, the comptroller will not wish to be represented in appeals relating to *inter partes* cases, though he may be represented in exceptional circumstances.

6.20 If Counsel is to be briefed, then he will need to see a copy of the documents on the patents file. You should:

- Check with Treasury Solicitors when they would like copies of the relevant documents sent to them (Tel: 020 7210 3411).
- Contact the HO and ask whether he will be attending the appeal and which documents should be sent to the Treasury Solicitors
- Make a copy of the documents
- Place documents in order, starting with the Notice of Appeal then the Office decision. These should be followed in descending date order by the most recent document (the last usually being the patent specification)
- Tag and number the documents starting with the earliest and place in a binder. Document 1 should be the bottom document. The top document should be an Explanatory Memorandum provided by the HO followed by the Notice of Appeal.
- Tag and number the documents in the patent / proceedings file in line with those in the binder. The Explanatory Memorandum is NOPI.

- Type a list of the documents and include a head note indicating the nature of the case (see annex 5).
- Place a copy of the list on the patent / proceedings file, and on the binder
- Label the binder with the case details
- Send the binder with a letter (see annex 6) to the Treasury Solicitors

Note: Inform Dispatch Section you wish to send a binder. They will advise you of the appropriate postal service. If next day delivery is required, you need to inform Dispatch.

The binder should be addressed to:

Andrew Prior
 The Treasury Solicitors
 Queen Anne's Chambers
 28 Broadway
 LONDON
 SW1H 9JS

- 6.21 If Counsel is not to be briefed, the patent file/proceedings file should be stored on the Appeals shelf in Litigation Section to await the Court date.

AWAITING THE APPEAL DATE

The Office is usually informed of the date of the appeal by the Patents Court. Occasionally the office is informed by the Treasury Solicitor. However you need to:

- Monitor the date of appeal by checking the Court Service website. The address is:
www.hmcourts.service.gov.uk – click on “Court Hearings” – click on “Patents Court Diary” – click on “Diary Section 1”
- Contact the court for information. Our contact at the Patents Court is Doug Bell.
 E-mail: doug.bell@courtservice.gsi.gov.uk
 Tel: 0207 947 7345

It is probably better to e-mail the court as the clerks are very busy and are rarely available to answer telephone calls.

ONCE THE DATE OF THE APPEAL IS KNOWN

6.23 Initially a window of three days may be allocated by the court for the hearing of the appeal. You need to:

- Inform the HO and HA and any other interested party in the Office once the window is known
- Liaise with the court on a regular basis to obtain a firm date for the appeal. Check the listings on the Court Service web site or telephone Chancery Listings (Tel: 0207 947 7383). The exact courtroom and time may not be known until the day before the appeal but once they are known, you'll need to inform the HO and HA and any other interested party in the Office

Note: The time of the appeal may be found on the Court Service website. The court room number will depend on who is hearing the case

- Update the hearings spreadsheet with the appeal date
- Minute the patent/proceedings file as follows: "Appeal to be held on(insert date)".
- Enter date of appeal in your electronic diary.
- Enter reminder in electronic diary to send patent file to Harmsworth House.
- Before sending the file, check it is in order and mark and label all NOPI documents.
- Send the file to the Hearings Clerk at Harmsworth House with a minute explaining the case has been appealed and that the file should be taken to the High Court at least one day before the appeal is to be heard
- Check with the High Court whether bundles have been filed. If they haven't, contact Andrew Prior at the Treasury Solicitors and inform him.

AFTER THE APPEAL HEARING

6.24 Following the appeal hearing, you should:

- Diary case for one month to await the return of the file from the Court and a copy of the Court Judgment and Court Order.

Note: If the file is required earlier, contact Chancery Listings (Tel: 0207 947 7383) and arrange for it to be collected by one of the London Hearings Clerk.

- Place the Court Judgment and Court Order on the patents file (OPI) and pass immediately to the HO.
- On return from the HO, action any other instructions and circulate the Court Judgment and Court Order (see annex 8). Even if the appeal has been withdrawn, the papers must still be circulated. When the file reaches the B3, she will review the Order and will make an appropriate register entry on OPTICS.
- Prepare a Journal advert based on the register entry by the B3 (see annex 9).

6.25 The Court Judgment may grant a party leave to appeal to the Court of Appeal. However, if leave to appeal is not granted, a party may still approach the Court of Appeal directly and request leave to appeal.

6.26 Only when you are able to conclude that no appeal has been filed, should the case proceed to the clear records stage. (See Chapter 5 & Chapter 27)

COURT OF APPEAL

6.27 If an appeal has been refused, the appellant may wish to take matter further. For patent cases, this may mean filing an appeal at the Court of Appeal. Permission to appeal must be obtained either from the Patents Court judge. If he refuses to grant leave to appeal, the appellant may apply directly to the Court of Appeal for permission to appeal. For design right cases, leave to appeal from the decision of the High Court must be obtained from the Court of Appeal.

6.28 When a Notice of Appeal to the Court of Appeal is received, you should:

- Update the excel hearings spreadsheet to show an appeal has been filed at the Court of Appeal
- Minute the relevant file(s) as follows to show an appeal has been filed: 'Appeal to the Court of Appeal filed on(insert date).
- Make a free text register entry in OPTICS (where appropriate) as follows: "Notice of Appeal against decision of the High Court dated (insert date) lodged with the Court of Appeal on (insert date)".

- Advertise the appeal in the Journal. [Full details of Journal entries can be found in Chapter 26]
- Copy the Notice of Appeal and any supporting papers and attach a circulation note (see annex 4) and circulate as before.
- Contact the parties or the Registry at the Court of Appeal (Tel: 0207 947 7882) to obtain a date for the Court of Appeal hearing since we will not always be told unless we are a party to the proceedings
- Check the file at monthly intervals and record the state of play on the minute sheet
- Inform all interested parties in the Office of any developments
- Liaise with the Court of Appeal as to procedure

6.29 The patent file will not be required by the Court of Appeal so should be kept in Litigation Section.

6.30 On receipt of the Judgment and Order from the Court of Appeal, follow the procedures outlined above for appeals to the High Court (see 6. nnnn-6.m 2)

6.31 The Court Judgment may grant a party leave to appeal to the House of Lords. However, if leave to appeal is not granted, a party may still approach the House of Lords directly and request leave to appeal.

6.32 Only when you are able to conclude that no appeal has been filed, should the case proceed to the clear records stage. (See Chapter 5 & Chapter 27)

APPEAL TO THE COURT OF APPEAL AGAINST AN ORDER OF THE HIGH COURT FOR REVOCATION OF A PATENT (CPR PART 52 PD PARAGRAPH 21.2

6.33 Where an appeal lies to the Court of Appeal from an Order for revocation of a patent, the appellant must send a copy of the Notice of the Appeal to the other side (the respondent) and also to the comptroller. If the respondent decides not to oppose the appeal or to attend the appeal hearing, he must serve a notice of that decision (together with the other papers in the Appeal) on the comptroller.

6.34 On receipt of the Notice, you should:

- Contact the HO and enquire whether he will be attending the appeal hearing
- Within 14 days of receipt of the Notice, send a letter to the appellant advising him whether the comptroller will be attending the hearing (see annex 7)

6.35 The comptroller may attend the appeal hearing and oppose the appeal in any

Case where he has written to the appellant informing him that he will be attending the appeal and in any other case (including a case where the respondent withdraws his opposition to the appeal during the hearing) if the Court of Appeal directs or permits.

HOUSE OF LORDS

6.36 The procedure will be similar to that for Court of Appeal hearings, except that all contact will be made with the Offices of the House of Lords (Tel. 0207 219 3111) and normally the HO and Hearing Assistant will attend the sitting. **(NB. A special pass will be needed to gain access to the House of Lords).**

JUDICIAL REVIEW

6.37 Judicial review is another route by which decisions of the comptroller can be challenged. It is dealt with in the High Court. Applications for judicial review require leave of the court. The court will not normally grant leave where there is another avenue of appeal.

6.38 The initial procedures are generally similar to those for *ex parte* appeals. When a notice is received, you should:

- Notify the relevant HO immediately and enquire whether the documents received should be faxed to the Treasury Solicitor.
- Update the excel spreadsheet to show that a judicial review has been filed
- Make a register entry and prepare and arrange an advert for the Journal
- Ensure you take regular instruction from the HO

6.39 When the review is finalized, you should:

- Update the excel hearings spreadsheet with the outcome
- Make a register entry and prepare and arrange an advert for the Journal. The B3 will advise.

ANNEX 1
(Design Right - Licence of Right Only)

c/o

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

Direct Line: 01633 81****
E-mail: xxxxxx.xxxxxx@ 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: Rm 3Y31/name/file reference

Date

Dear Sir

.....: **Application by** under **Section 247 of the Copyright, Designs and Patents Act 1988**

1. In reply to your letter of the, the Office is prepared to grant an extension of to lodge an appeal against the Office Decision dated.....
2. The period for appeal, taking into account the extension, now expires on
3. Except with leave of the Registered Designs Appeal Tribunal, no further extension may be granted.
4. A copy of this letter, together with yours, has been sent to the Registered Designs Appeal Tribunal.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 2
(Design Right - Licence of Right Only)

Registered Designs Appeal Tribunal
Royal Courts of Justice
The Strand
LONDON
WC2A 2LL

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

Dear Sir

Reference..... under Section by

1. I refer to the decision of the comptroller dated and the enclosed letters relating to the matter of an appeal to the decision.
2. An extension has been granted until for the to lodge their appeal with the Registered Designs Appeal Tribunal.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

Enc.

ANNEX 3

APPEALS CHECKLIST

URGENT ACTION

Notice of Appeal received		
1	Is the notice properly sealed? No – appellant contacted Yes – file located, copied and put on file	
2	Has the notice been filed in time? No – court/appellant contacted Yes – continue	
3	Emailed HO with details	
4	If inter partes has HO given direction to instruct counsel? No – go to 6 Yes – continue	
5	All ex parte & in rare inter partes cases Notice of appeal & supporting docs faxed same day to Andrew Prior	
6	NOPI folder for Tsols correspondence made & inserted in main file (after minute sheets)	
7	Details recorded on spreadsheet	
8	File/proceedings file & Hearings folder minuted	
9	Optics checked for decision entry & updated with appeal lodged	
10	PDJ notice prepared	
11	Circulated copy (notice of appeal & decision)	
12	Action taken from HO minute/instruction	
13	Is counsel to be briefed? No – put file on appeals shelf & go to 21 Yes – continue	
Briefing Counsel		
14	Parts of file copied as instructed by HO	
15	Documents placed in order	
16	Documents & proceedings file labeled	
17	Documents listed	
18	Documents placed in binder and binder labeled	
19	Covering letter (Annex 5 of manual) prepared & copy put on patent file	
20	Letter & binder sent to Andrew Prior	
Obtaining Hearing Date		
21	Monitor court website or email court for date of appeal hearing	

Date of Appeal Known	
22	HO, HA & other interested parties informed & calendars updated
23	Spreadsheet updated
24	File/proceedings file & Hearings folder minuted
25	Electronic diary updated with the appeal date
26	Appropriate arrangements made for attendee(s)
	If routine inter partes go to 31 If ex parte continue
27	Reminder put in the electronic diary to send file
28	File checked
29	File sent to Harmsworth House
30	Have bundles been submitted? No – contacted Andrew Prior Yes - no action
31	Courtroom & time obtained, attendees informed
After the Appeal Hearing	
32	File received
33	Judgement/order received copied & put on file
34	Spreadsheet updated
35	Circulated
36	Optics updated
37	PDJ notice prepared
38	Action taken from HO minute/instruction
39	Notice of Appeal to the Court of Appeal received? No – clear records Yes – continue
Court of Appeal	
40	Notice copied & put on file
41	Spreadsheet updated
42	Circulated
43	Optics updated
44	PDJ notice prepared
45	Date obtained
46	HO , HA & other interested parties informed
47	Appropriate arrangements made for attendee(s)
After the Court of Appeal Hearing	
48	Judgement/order received copied & put on file
49	Spreadsheet updated
50	Circulated
51	Optics updated by B3
52	PDJ notice prepared
53	Action taken from HO minute/instruction
54	Appeal to the House of Lords No – clear records Yes – continue

House of Lords	
55	As above 40 – 53 NOTE: HO & HA will normally attend so arrange passes
Judicial Review - refer to Litigation Manual	

ANNEX 4

APPEAL LODGED

Name of part(y)ies:

Patent Number(s):

A notice of Appeal was lodged with the Patents Court on against the decision of the Hearing Officer dated

The Appeal will be heard on

OR

AMEND as appropriate

The Appeal date needs to be confirmed

1) HO Rm number

Please advise by email if Counsel is to be briefed and if so, please provide an Explanatory Memorandum

2) Divisional Director Rm Number

3) Divisional Director Rm Number

4) Divisional Director Rm Number

5) B3 Rm Number

6) C2 Rm Number

7) Litigation Section Manager Rm Number

8) Hearings Team Rm Number

ANNEX 5

Patent Application Number GB ((name).....)

A notice of appeal against the decision dated, whereby the comptroller refused the application under Section of the..... Act....., was lodged with the Court on The date of the appeal hearing has not yet been finalised.

Please find enclosed the following documents for reference:

An explanatory memorandum prepared by the Patent Office for the comptroller's Counsel and the associated pages of the Manual of Patent Practice.

A numbered set of papers for Counsel relating to the proceedings .

(NB The following is an example of the sort of documents that might be included)

1. Official letter dated 1 February 2006.
3. Official letter dated 25 February 2006.
4. Letter from Mr Aaaaaa received 2 March 2006.
7. Official letter to Mr Aaaaaa dated 15 March 2006.
8. Letter from Mr Aaaaaa received 22 March 2006.
9. Official letter dated 23 March 2006.
12. Letter from Mr Aaaaaa received 5 May 2006.
13. Official letter to Mr Aaaaaa dated 12 May 2006.
14. Letter from Mr Aaaaaa dated 14 May 2006.
15. Official letter to Mr Aaaaaa dated 20 May 2006.
24. Office decision dated 29 June 2006 and transcript of hearing dated 1 June 2006
25. Notice of appeal dated 5 July 2006.
26. Explanatory Memorandum dated 29 July 2006 and accompanying background information

ANNEX 6

Mr A Prior
c/o The Treasury Solicitor
Queen Anne's Chambers
28 Broadway
LONDON

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

Direct Line: 01633 xxxxxx
E-mail: xxxxxxxx@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

Dear Mr Prior

Appeal -.....

1. Please find a copy of the papers relating to the above appeal.
2. The Hearing Officer/examiner (xxxxxxx) would like to draw your attention to:
(xxxxxxxxxxxxxxxxxxxx).
3. xxxxxxxx will be attending the hearing for the Office.

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****
E-mail: xxxxx.xxxx@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/Your Reference

Dear Sirs

Patent number.....

1. Thank you for your letter dated
2. The Comptroller will/will not be attending the appeal hearing (*Delete as appropriate*)

Yours faithfully

Name
Litigation Section
Patents Directorate

ANNEX 8

APPEAL HEARD

The Appeal was heard on in the
regarding the decision of the Hearing Officer dated Please see
copy of Order/Judgement attached.

- 1) HO: Room:
- 2) B3 Room:
(Action Register Entry)
- 3) Hearings team Room
(Action Journal Advert, hearings spreadsheet)
- 4) HA: Room:
- 5) Divisional Director (if not HO) Room:
- 6) Divisional Director (if not HO) Room:
- 7) Divisional Director (if not HO) Room:
- 8) Deputy Director (inter partes team) Room:
- 9) Deputy Director (inter partes team) Room:
- 10) Deputy Director (inter partes team) Room:
- 11) Deputy Director (inter partes team) Room:
- 12) Editor MOPP Room:
- 13) Litigation Manager Room:
- 14) Hearings Team Room:

ANNEX 9

Appeals to the Patents Court

Appeal Dismissed

GB *****

**In an Order of the Court dated....., the appeal against the decision of the
Comptroller datedwas dismissed**