

CHAPTER 9

OPPOSITIONS

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9 OPPOSITIONS

OPPOSITION TO AMENDMENTS MADE UNDER SECTION 27 (For amendments under section 27 see Chapter 17).

- 9.01 Any person may oppose an amendment made under section 27. There is no need for an agent to identify a claimant for whom he is acting (*Sanders Associates' Patent BL 0/89/81*).
- 9.02 Notice of opposition should be given on Patents Form 15/77. This should be filed within two months of the date of advertisement of details of the amendments in the Journal. **This period can not be extended.**
- 9.03 Two copies of Patents Form 15/77 should be filed along with two copies of a statement setting out fully the facts upon which the claimant relies and the relief which he is seeking.
- 9.04 The statement should be filed within 14 days of the receipt of Patents Form 15/77. This period may be extended at the discretion of the comptroller.
- 9.05 If the statement is filed within 14 days of the Patents Form 15/77, the opposition will be deemed to have been filed on the date the Patents Form 15/77 was received. If the statement is filed later than 14 days of the Patents Form 15/77, provided extensions of time have been allowed, the opposition may again be taken to have been filed on the date the Patents Form 15/77 was received.

Serving the notice of opposition (see also Chapters 1 and 2)

9.06 The B3 should send a copy of the Patents Form 15/77 and the supporting statement to the applicant, that is, the defendant in the proceedings. If the defendant wishes to proceed with the application to amend the patent, he will need to file two copies of a counter-statement setting out fully the grounds upon which the opposition is resisted. The defendant will be allowed a period of six weeks to file a counter-statement. (See also paragraph 9.08 evidence rounds.)

Further amendments during opposition proceedings

9.07 If a defendant wishes to offer alternative amendments, he should include them in the counter-statement. He also needs to make it clear whether the offer is a firm one or is conditional upon an adverse finding on the originally requested amendments. The offer may be made in a counter-statement during the evidence rounds. The offer should be referred to the Deputy Director in charge of the subject matter who will direct the subsequent procedure. He will give his prima facie view on admissibility (MOPP 27.13). If the form of amendments differs materially from the original form, they should be advertised for opposition. In any case the claimant is allowed to file a supplementary statement opposing the new amendments. If a form of amendments acceptable to the parties and the office is not arrived at, the matter will need to be decided at a hearing (see MOP 27.29 and 101.28 – 101.46). The Deputy Director may direct that the evidence rounds are gone through first.

Evidence (see also Chapter 3)

9.08 If a counter-statement is filed with no offer of alternative amendments, then the case proceeds to the evidence rounds. As the defendant needs to justify his grounds for filing amendments, the timetable for filing evidence is normally reversed. The defendant files evidence in support of his case, followed by the claimants evidence in support of his case and in answer. Then the defendant files evidence strictly in reply (see 3.03 – 3.03.2).

Withdrawal of opposition

9.09 Where an opposition has been properly filed but the claimant later withdraws the opposition, the comptroller will take account of matters raised in deciding whether discretion to allow the amendments should be exercised.

OPPOSITION TO SECTION 29 SURRENDER OF PATENTS (For surrender under section 29 see Chapter 18)

9.10 Any person may oppose the surrender of a patent under section 29(2).

9.11 Notice of opposition should be given on Patents Form 15/77. This should be filed within two months of the date of the advertisement for opposition in the Journal. **This period can not be extended.**

9.12 Two copies of Patents Form 15/77 should be filed along with two copies of a statement setting out fully the facts upon which the claimant relies and the relief which he is seeking.

9.13 The statement should be filed within 14 days of the receipt of Patents Form 15/77. This period may be extended at the discretion of the comptroller.

9.14 If the statement is filed within 14 days of the Patents Form 15/77, the opposition will be deemed to have been filed on the date the Patents Form 15/77 notice was received. If the statement is filed later than 14 days of the Patents Form 15/77, provided extensions of time have been allowed, the opposition may again be taken to have been filed on the date the Patents Form 15/77 was received.

Serving the notice of opposition (see also Chapters 1 and 2)

9.15 The B3 should send a copy of Patents Form 15/77 and the supporting statement to the proprietor that is the defendant in the proceedings. If the defendant wishes to proceed with the surrender, he will need to file two copies of a counter-statement setting out fully the grounds upon which the opposition is resisted. The defendant will be allowed a period of 6 weeks to file a counter-statement.

Counter-statement and Evidence (see also Chapters 1, 2 and 3)

9.16 The periods of six weeks for filing the counter-statement and evidence may be extended or reduced at the discretion of the comptroller.

Revocation v Surrender

9.17 If proceedings under section 72 to revoke the patent are pending before the comptroller, any opposition to surrender will normally be stayed pending the outcome of the revocation action (see MOPP section 72).

OPPOSITION TO SECTION 47 CANCELLATION OF ENTRY MADE UNDER SECTION 46 (For cancellation of entry made under section 46 see Chapter 11)

9.18 Applications under section 47(1) or (3) for cancellation of a “licences of right” entry in the patents register may be opposed.

- 9.19 Where the application for cancellation is by the proprietor of the patent under section 47(1), any person may make such an opposition. Previously under the provision of the 1949 Act (section 36(5)(a)) only “any person interested” could oppose. Where the application is under section 47(3) only the proprietor of the patent in question may oppose the cancellation (section 46(6)).
- 9.20 Every application under section 47(1) or (3) is advertised in the Journal. Notice of opposition to the cancellation of an entry should be given on Patents Form 15/77 within 2 months of the date of advertisement in the Journal. **This period can not be extended.**
- 9.21 Two copies of Patents Form 15/77 should be filed along with two copies of a statement setting out fully the facts upon which the claimant relies and the relief which he is seeking. The statement should be filed within 14 days of the receipt of Patents Form 15/77. This period may be extended at the discretion of the comptroller.
- 9.22 If the statement is filed within 14 days of the Patents Form 15/77, the opposition will be deemed to have been filed on the date the Patents Form 15/77 notice was received. If the statement is filed later than 14 days of the Patents Form 15/77, provided extensions of time have been allowed, the opposition may again be taken to have been filed on the date the Form 15/77 was received.

Serving the notice of opposition (see also Chapters 1 and 2)

- 9.23 The B3 should send a copy of the Patents Form 15/77 and the supporting statement to the applicant for cancellation that is the defendant in the proceedings. If the defendant wishes to proceed with the application to cancel, he will need to file two copies of a counter-statement setting out fully the grounds upon which the opposition is resisted. The defendant will be allowed a period of six weeks to file a counter-statement.

Counter-statement and Evidence (see also Chapters 1, 2 and 3)

9.24 The periods of six weeks for filing the counter-statement and evidence may be extended or reduced at the discretion of the comptroller.

OPPOSITION TO SECTION 117 CORRECTION OF ERRORS IN PATENTS AND SPECIFICATIONS (For correction of errors in patents and specifications see Chapter 24)

9.25 Where the comptroller is requested to correct such an error or mistake, any person may oppose the request.

9.26 (Deleted)

9.27 The notice of opposition should be on Patents Form 15/77 which should be filed within two months of advertisement for opposition of the correction in the Journal. **This period can not be extended.**

9.28 Two copies of Patents Form 15/77 should be filed along with two copies of a statement setting out fully the facts upon which the claimant relies and the relief which he is seeking. The statement should be filed within 14 days of receipt of the Patents Form 15/77. This period may be extended at the discretion of the comptroller.

9.29 If the statement is filed within 14 days of the Patents Form 15/77 notice, the opposition will be deemed to have been filed on the date the Patents Form 15/77 notice was received. If the statement is filed later than 14 days of the Patents Form 15/77, provided extensions of time have been allowed, the opposition may again be taken to have been filed on the date the Patents Form 15/77 was received.

9.30 The notice of opposition and supporting statement must be directed solely to the allowability of the correction. In particular, the validity of the patent may not be put at issue (section 74(2)).

Serving the notice of opposition (see also Chapter 1)

9.31 The B3 should send a copy of the Patents Form15/77 and the supporting statement to the applicant for correction, that is the defendant in the proceedings. If the defendant wishes to proceed with the application for correction, he will need to file two copies of a counter-statement setting out fully the grounds upon which the opposition is resisted. The defendant will be allowed a period of six weeks to file a counter-statement.

9.31.1 Where an opposition has been properly filed, but the claimant subsequently withdraws the opposition, the comptroller will take account of matters raised in deciding whether the correction is allowable. If no agreement is reached with the applicant, an ex parte hearing is held.

Counter-statement and Evidence (see also Chapters 1, 2 and 3)

9.32 The periods of six weeks for filing the counter-statement and evidence may be extended or reduced at the discretion of the comptroller.