

CHAPTER 9

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9 OPPOSITIONS

SECTION 27(5) OPPOSITION TO AMENDMENT OF SPECIFICATION AFTER GRANT (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 attorney 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. This should be filed within four weeks 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 should be filed along with two copies of a statement of grounds setting out fully the facts and grounds on which the claimant relies and the remedy which he is seeking.
- 9.04 The statement of grounds needs to be verified by a statement of truth.
- 9.05 Deleted.

PECS:- A1 to follow procedures at 1.08. Message = "See new F15".

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

- 9.06 The B3/B2 should send a copy of the Patents Form 15 and the supporting statement to the applicant applying for the amendment. In the proceedings he will be known as the defendant. (See also procedures set out at 1.19 to 1.24).

Counter-statement

- 9.07 Follow procedures at 1.25 to 1.26.

Management of proceedings

9.08 If a counter-statement is filed with no offer of alternative amendments, then follow the procedures at 1.28 to 1.40.

Evidence rounds

9.09 Follow procedures at 1.41 to 1.53 (see also Chapter 3)

Further amendments during opposition proceedings

9.10 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 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 27.14). If the form of amendments differ materially from the original form, they should be advertised for opposition. The claimant will be 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 MOPP section 27). The Deputy Director may direct that the evidence rounds are completed first, in which case refer to Chapters 1 and 3.

PECS:- Minute is created and imported using manual import (doc code is MINUTE-LIT)

Create and send message to DD. Message = PSM

Advert is created in Word and imported using manual import (doc code is ADVERT)

Supplementary statement is scanned into PECS (doc code is STATE-SUP)

Withdrawal of opposition

9.11 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 to exercise discretion to allow the amendments.

SECTION 29(2) OPPOSITION TO SURRENDER OF PATENT (For surrender under section 29 see Chapter 18)

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

9.13 Notice of opposition should be given on Patents Form 15. This should be filed within four weeks of the date of the advertisement for opposition in the Journal. **This period can not be extended.**

9.14 Two copies of Patents Form 15 should be filed along with two copies of a statement setting out fully the facts and grounds on which the claimant relies and the remedy which he is seeking.

9.15 The statement of grounds needs to be verified by a statement of truth.

PECS:- A1 to follow procedures at 1.08. Message is "See new F15"

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

9.16 The B3 should send a copy of Patents Form 15 and the supporting statement to the patent proprietor. In the proceedings he will be known as the defendant.

Counter-statement

9.17 Follow procedures at 1.25 to 1.26.

Management of proceedings

9.18 Follow procedures at 1.28 to 1.40.

Evidence rounds

9.19 Follow procedures at 1.41 to 1.53.

Revocation v Surrender

9.20 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).

SECTION 47(6) OPPOSITION TO CANCELLATION OF LICENCE AVAILABLE AS OF RIGHT (where the application was made by the proprietor of the patent)

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

9.22 Where the application for cancellation is by the proprietor of the patent under section 47(1), any person may make such an opposition. Where the application is under section 47(3), only the proprietor of the patent in question may oppose the cancellation (section 47(6)).

9.23 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. This should be filed within four weeks of the date of advertisement in the Journal. **This period can not be extended.**

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

9.25 The statement of grounds needs to be verified by a statement of truth.

PECS:- A1 to follow procedures at 1.08. Message is “See new F15”

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

9.26 The B3 should send a copy of the Patents Form 15 and the supporting statement to the applicant for cancellation. In the proceedings he will be known as the defendant. (See also procedures set out at 1.19 to 1.24).

Counter-statement

9.27 Follow procedures at 1.25 to 1.26.

Management of proceedings

9.28 Follow procedures at 1.28 to 1.40.

Evidence rounds

9.29 Follow procedures at 1.41 to 1.53.

SECTION 117(2) OPPOSITION TO CORRECTION OF ERROR IN GRANTED PATENT (For correction of errors in patents and specifications see Chapter 24)

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

9.31 Notice of opposition should be given on Patents Form 15. This should be filed within four weeks of the date of advertisement of details of the correction in the Journal. **This period can not be extended.**

9.32 Two copies of Patents Form 15 should be filed along with two copies of a statement of grounds setting out fully the facts and grounds on which the claimant relies and the remedy which he is seeking.

9.33 The statement of grounds 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)).

PECS:- A1 to follow procedures at 1.08. Message is “See new F15”

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

9.34 The B3 should send a copy of the Patents Form15 and the supporting statement to the applicant applying for the correction. In the proceedings he will be known as the defendant. (See also procedures set out at 1.19 to 1.24).

Counter-statement

9.35 Follow procedures at 1.25 to 1.26.

Management of proceedings

9.36 Follow procedures at 1.28 to 1.40.

Evidence rounds

9.37 Follow procedures at 1.41 to 1.53.

Withdrawal of opposition

9.38 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.