

CHAPTER 13

SECTION 71

DECLARATION AS TO NON INFRINGEMENT

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13 DECLARATION AS TO NON-INFRINGEMENT

INTRODUCTION

13.01 This section provides for the making of a declaration that an act does not, or a proposed act would not, constitute an infringement of a granted patent. The procedure within the Office is prescribed within The Patents Rules 1995.

13.02 Before an application can be made under section 71 the person seeking the declaration must-

(a) apply in writing to the proprietor for a written acknowledgement to the effect of the declaration claimed and must furnish him with full particulars in writing of the act in question section 71(a); and

(b) confirm that the proprietor has refused or failed to give any such acknowledgement.

13.03 If the proprietor refuses or does not give the acknowledgement sought, then an application for a declaration may be made to the Comptroller.

13.04 Where proceedings are pending in the court under any of sections 58, 61, 69, 70, 71 or 72, no proceedings may be instigated before the comptroller under section 71 without the leave of the court. However court proceedings for infringement of a patent may be stayed pending the outcome of proceedings under sections 71 and 72 before the comptroller.

INITIAL ACTION

Formal requirements

13.05 Follow procedures at 1.03 to 1.04.

Action by Litigation Assistant (A1)

13.06 Follow procedures at 1.05 to 1.07.

13.07 Using the Optics function REG ENT, a free text entry in relation to an application for a declaration as to non-infringement under section 71 is made as follows:

“Application under Section 71 filed on.....”

STATEMENT

What should the statement contain?

13.08 Follow procedures at 1.08 to 1.10

13.09 When undertaking the substantive check of the statement, reference should be made to the appropriate patent rules. The statement accompanying the application for example should indicate:

- that subparagraphs (a) and (b) of section 71 have been complied with;
- the facts upon which the claimant relies;
- the relief that he is seeking.

13.10 It is not always easy to establish that the requirements of section 71(1)(a) have been complied with and this can often result in a delay with the case. It is important that the claimant gives precise and complete information in relation to the article, process, etc which is alleged not to infringe the patent. However the provision is satisfied by providing a sample of the alleged non- infringing article providing that its inspection by competent persons will make clear all aspects of the device material to the question of infringement. Also a description to be read in conjunction with a detailed drawing will suffice.

13.11 Although implicit in the application, the relief sought should be stated explicitly in the statement in order to assist the HO at a later date.

What happens if the statement does not comply?

13.12 Follow procedures at 1.11 to 1.15

Serving the statement

13.13 Follow procedures at 1.16 -1.17 and 1.33 - 1.34

COUNTER-STATEMENT

13.14 Follow procedures at 1.18 to 1.22.

EVIDENCE ROUNDS

13.15 Follow procedures at 1.23 to 1.28.

DECISION

13.16 Follow procedures at 1.29 to 1.30.

Updating the register (B3 action) - free text entries (below the line)

13.17 If the application has been allowed:

- use REG ENT free text and type in a register entry as follows:

“In a decision of the comptroller dated day, month, year, the application under section 71 for a declaration of non-infringement filed on day, month, year, was allowed”.

13.18 If the application has not been properly launched:

- use REG ENT free text and type in a register entry as follows:

“In a decision of the comptroller dated day, month, year, the application under section 71 filed on day, month, year was deemed not to have been properly launched”.

13.19 If the application has been refused:

- use REG ENT free text and type in a register entry as follows:

“In a decision of the Comptroller dated day, month, year, the application under section 71 filed on day, month, year, was refused”.