

CHAPTER 14

SECTION 72 APPLICATION FOR REVOCATION

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14 APPLICATION FOR REVOCATION

INTRODUCTION

- 14.01 The Court (Patents Court or Patents County Court) or Comptroller may on the application of **any** person order a patent for an invention to be revoked. However, an application on the grounds that the patent was granted to a person who was not entitled to be granted that patent (see section 72(1)(b) and 72(2)) may only be sought by a person who has already satisfied the Court or Comptroller that he himself should have been the sole proprietor or a joint proprietor.
- 14.02 The section provides for the revocation of a GB patent granted under the Patents Act 1977 or a European patent (UK). The procedure for applying for revocation before the Comptroller is set out in rule 75 of the Patents Rules 1995.

What are the grounds for an application?

- 14.03 The application for revocation can be made on (but only on) any of the grounds set out in section 72(1)(a)-(e). They are:-
- (a) the invention is not a patentable invention;
 - (b) that the patent was granted to a person who was not entitled to be granted that patent;
 - (c) the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art;
 - (d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed, or, if the patent was granted on a new application filed under section 8(3), 12 or 37(4) or as mentioned in section 15(4), in the earlier application, as filed;
 - (e) the protection conferred by the patent has been extended by an amendment which should not have been allowed.

INITIAL ACTION

Formal Requirements

14.04 Follow procedures at 1.03 and 1.04.

Action by Litigation Assistant (A1)

14.05 Follow procedures at 1.05 to 1.07

14.06 Using the Optics function REG ENT, a free text entry in relation to an application for revocation under S.72 is made as follows:

‘Application under Section 72 filed on.....’

STATEMENT

What should the statement contain?

14.07 Follow procedures at 1.08 to 1.11

14.08 When undertaking the substantive check of the statement, reference should be made to rule 75(1). This indicates that the statement accompanying an application for revocation should set out fully:

- the grounds of revocation;
- the facts upon which the claimant relies; and
- the relief that he is seeking.

14.09 The first two of these requirements provide that the statement should be sufficiently explicit to allow the proprietor of the patent to be aware of the specific allegations which he will have to answer if he wishes to defend his patent. Thus whilst normally it is not necessary to provide elaborations of technical fact, where prior disclosure or prior use of the invention are alleged, or an argument of obviousness is based thereon, the disclosure or use must be sufficiently identified to allow the proprietor to appreciate the scope of the allegation he is required to meet.

14.10 An objection to the adequacy of the statement should be taken if it contains bald statements such as "it will be shown with reference to prior art that the patent is not novel" and "it will be shown that there was prior use". Such statements do not enable the proprietor to appreciate the scope or merit of the attack on his patent. In such circumstances the statement should be referred to the HO. As stated above, the grounds for revocation are clearly set out in section 72(1). Any other ground for revocation would not be acceptable as such and appropriate action should be taken.

14.11 The final requirement of the rule is that the claimant should indicate the relief being sought. Although it would appear that this is implicit in the application for revocation itself, this is not always so, for example, the claimant might be seeking partial revocation of the patent. Thus although ideally the claimant should state explicitly that the relief sought is "revocation of the patent", if this request is set out in any attached letter or in the body of the statement this will normally suffice.

What happens if the statement does not comply?

14.12 Follow procedures at 1.12 to 1.16.

Revocation under section 72(1)(b) - patent granted to person not entitled

14.13 An application on the ground that the patent was granted to a person who was not so entitled is the only ground that restricts who may apply. Section 72(2) sets out two requirements:

- such an application can only be made by a person found by the Court in an action for a declaration or declarator, or found by the Court or the Comptroller on a reference under section 37 above, to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked; and

- the action may not be made if that action was commenced or that reference was made after the end of the period of two years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

14.14 It was thought that the Act required that the person lodging the application under section 72(1)(b) must first have been determined by the Court or the Comptroller to be entitled to the patent (*Dolphin Showers v Farmiloe* [1989] FSR 1). However, this case was not followed in a more recent case *Henry Brothers (Magherafelt) Limited v Ministry of Defence and Northern Ireland Office* [1997] RPC 693 where the Court held that it "has jurisdiction under section 72(1)(b) to consider the case without any prior declaration or finding under section 37" (at page 711). This has been followed in a recent case before the Office EP 0683925 (*A C Egerton's patent BL 0/170/00*) and sometime ago on GB2171241.

14.15 As to the potential time restriction, this would appear to place an evidential hurdle in front of the claimant. No cases to date have been filed outside the two years so it is unclear how large a hurdle this requirement would present to a potential claimant applying outside the two year period. There is a similar restriction in section 37(5).

Serving the Statement

14.16 Follow procedures at 1.17 to 1.18.

COUNTER-STATEMENT

Contesting an application for revocation

14.17 Follow procedures at 1.19 to 1.23.

AMENDMENT

Offer to amend under section 75

- 14.18 If the proprietor offers in his counter-statement to amend the specification in order to overcome prior art, etc, it should be made clear on what basis the offer is made, that is, whether the offer is firm or is conditional upon an adverse finding on the unamended specification.

Where amendment is offered under section 75 in revocation proceedings, the onus is on the proprietor to establish that the comptroller's discretion should be exercised in his or favour in allowing amendments to the patent in revocation proceedings.

- 14.19 A counter-statement is still required even if, before it is due to be filed, the claimant has indicated that he is willing to withdraw on the condition that certain amendments are made to the specification and the proprietor is agreeable to these amendments. In such a case however it will be sufficient for the counter-statement merely to offer the proposed amendments, stating that the offer is unconditional.

- 14.20 The proposed amendments should be clearly identifiable and should be delivered to the comptroller electronically, if reasonably possible. Any such amendments are made under section 75 and are subject to rule 78.

Directions for the electronic delivery of proposed amendments

- 14.21 Electronic delivery should be made either by e mail to litigationamend@ipo.gov.uk or on an electronic carrier (such as floppy disc or CD-R) delivered to this office and accompanied by an identifying letter.

14.22 Where the proposed amendments are filed electronically

- The office will not accept an e mail at any e mail address other than that given above. The e mail should be a plain text message.
- The e mail should be entitled “*proposal to amend under s75 before the comptroller*”.
- The text may be provided as an attachment to the e mail.

If we are unable to read the text, we should treat it as not delivered, and in these circumstances you should contact the applicant with a view to making alternative arrangements.

14.23 Applicants are encouraged to use conventional word processing features such as markup, coloured text and strikeout/strikethrough to set out the amendments on the original version of the text in a way that makes it easy for the reader to appreciate the changes. If it is not possible to identify the amendments, you should contact the applicant with a view to making alternative arrangements.

Action on receipt of the amendments

14.24 Once the B2 has checked the nature of the proposed amendments and the basis upon which they are offered has been properly indicated, the case should be referred to the Deputy Director in charge of the subject matter concerned for a preliminary report on the amendments, and to report on whether in his opinion they appear to be *prima facie* allowable. At this stage the only questions which need to be considered by the Deputy Director are whether the amendments would add matter or extend the protection conferred by the patent. No attempt should be made to consider whether they meet the alleged ground of invalidity.

- 14.25 Any objection arising out of this preliminary scrutiny of the amendments will be communicated to Litigation Section. The B2 will be advised to write to the proprietor allowing a specified period for reply (normally one month). If the proprietor maintains that the amendments are *prima facie* allowable, both parties should be informed that this has been noted and that the matter will be determined at the substantive hearing.
- 14.26 If new or modified amendments are proposed in reply, they should be consolidated as appropriate with the previous amendments and should be filed electronically if reasonably possible. They should also be presented in a way that clearly identifies them. The procedures outlined in paragraphs 14.24 to 14.25 should be repeated. If the amendments are initially proposed in correspondence, in order to be brought formally into the proceedings, they must be incorporated into or referred to in an amended counter-statement.
- 14.27 If the Deputy Director is satisfied that there is a clear major objection under section 76, this should be reported in a form suitable for incorporation in a letter expressing the objection as a *prima facie* view. To this end such a letter should be issued by the B2 and should open with

“The amendments have been referred to an examiner who has expressed the following *prima facie* view”

If however there are no or only minor objections or there is a reasonable element of doubt, the Deputy Director should report accordingly on the proceedings sheet and inform Litigation Section that in the circumstances no action on the amendments is necessary at this stage.

- 14.28 When amendments have been submitted in a counter-statement they should be advertised as soon as the procedures described above have been completed unless they are clearly minor and of no substance.

Opposition to amendments

14.28 Where the amendments under section 75 in revocation proceedings are opposed there is also a burden on the opponent to establish his or her case, (see 14.18) and so the onus is split.

In such cases the Office will normally, in accordance with the practice of the court, expect the proprietor to file the first round of evidence.

Advertising amendments

14.30 The e-mail or electronic carrier should be forwarded to the A3 who should:

- Complete the Journal notice (annex 1). This should be completed if the amendments have been filed electronically or in paper form.
- Send electronic amendments to "webmaster". The table (annex 2) should accompany the amendments and webmaster must be advised of the date of the journal the "notice" will appear in.

Webmaster will then arrange a link from the journal notice to the full details of the amendment (electronic amendments only). Where the amendments have been filed in paper form only, on request, a copy should be issued by fax or post as appropriate. The period for opposing the amendments is 2 months from the date of the published advertisement.

Note: The amendments will appear on the Office website on the same day that the printed copy of the Journal is published.

Revocation proceedings and amendments under section 75

14.31 The revocation proceedings should usually proceed in parallel with the consideration of the amendments under section 75.

The claimant should be allowed:-

- a specified period (normally one month) in which, if he wishes, to amend his statement or file a supplementary statement in respect of the amendments (*Dust Suppression Ltd's Application* [1976] FSR 438)
- six weeks in which to file evidence in chief under rule 75(4)

The Comptroller may however stay the revocation proceedings at the request of the claimant pending consideration of the amendments. Similarly, if the amendments are opposed, the Comptroller may stay the revocation proceedings pending a resolution of the opposition or may leave the opposition to be decided in the revocation proceedings.

Amendment of the application, the statement or the counter-statement

14.32 Amendment of the application for revocation, the statement or the counter-statement is allowable with the leave of the HO acting for the Comptroller; for example a new claimant for revocation may be added or substituted or a new ground or further facts may be introduced (see Chapter 2 and MOPP 72.14).

Admission of new grounds

14.33 Where the Comptroller decides to admit a new ground, a supplementary or amended statement should be filed. The proprietor should then be given the opportunity to file a supplementary or amended counter-statement in reply. Unless the new ground is not contested or evidence relevant to the new ground has already been filed, each party should be given a specified period (which may run concurrently with any other period set) in which to file further evidence in support of or in response to this new ground.

Reference to the Hearing Officer

14.34 At the discretion of the B2, the case may be referred to the HO at any point in the proceedings when complex problems arise (eg disagreement between the parties concerning extension of time; disclosure; request by a party for a preliminary hearing (see also Chapter 16).

EVIDENCE ROUNDS

14.35 Follow procedures at 1.24 to 1.29.

WITHDRAWAL OF APPLICATION

14.36 In addition to the normal procedure on withdrawal of the application for revocation by the claimants, consideration of the application in the public interest will be given by the relevant Deputy Director for that subject matter (see Chapter 16).

OFFER TO SURRENDER (see Chapter 18)

[Full description - MOPP 72.36 - 39]

DECISION

14.37 Follow procedures at 1.30 to 1.31.

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

14.38 If the patent has been revoked:

- use REG ENT free text and type a register entry as follows:
"In a decision of the Comptroller dated day/month (in words)/20**, the patent was ordered to be revoked. The appeal period terminates on day/month (in words)/20**."

The status of the case should be amended (see below). Two weeks after the termination of the appeal period, the Hearings Clerk will refer the decision again to the B3. A further register entry should be made on OPTICS as follows:

14.39 a) If no appeal has been received:

- use REG ENT free text to make the following entry:
“Following a decision of the Comptroller dated day/month (in words)/20**, no appeal has been received. The patent is thus revoked”.

14.40 b) If an appeal has been received:

- use REG ENT free text to make the following entry:
“In a decision of the Comptroller dated day/month (in words)/20**, an appeal has been received. [*Additional text* - Revocation stayed pending the appeal].

The status of the patent should be changed back. Where the decision states that the revocation should be stayed pending the outcome of the appeal, this should be included in the register entry (see above). The Hearings Clerk will inform the B3 of the outcome of any appeal in due course so that this can be recorded in the register.

14.41 If the patent is not revoked because of amendment:

- use REG ENT free text and type the following entry:
"In a decision of the Comptroller dated day/month(in words)/20**, following amendment, no order for revocation was made."

14.42 If the patent is found not to be invalid:

- use REG ENT free text and type the following entry:
"In a decision of the Comptroller dated day/month(in words)/20**, no order for revocation was made."

Updating the register (B3 action) - amending the status following revocation

14.43 When updating the status of a patent on the register to show it has been revoked:

- use OPTICS function CHA CAS
- From screen CHA CAS 1, select option 2 'Bibliographic and Register Information'
- From screen CHA CAS 24, select option 3 'Status Information, including Renewal and Licence Information'
- On CHA CAS 28, enter code 07 in 'Reason not in Force' box. For 'Date not in Force', enter date of decision or date of Court Order (if appropriate)
- To check if the status has changed to show the patent has been revoked, use OPTICS function DIS FUL

Clear Records (B3 action)

14.44 Read through the decision. Complete the "Clear Records Pro-forma" and pass this to the appropriate Case Officer for further action.

ANNEX 2

Applications for Amendment of Specification

Sect.	PDJ No. & Date	Opposition deadline	Patent No. and title	Int. Classi	Proprietor (Court action number if any and address for service)
27	3216 5 Feb 03	2 months	2345678 xxxxxxxxxxxxxxxxxxxxxx x	H04G	xxxxxxxxxxxxxx
75	3215 29 Jan 03	2 months	2124567 xxxxxxxxxxxxxxxxxxxxxx x	G22F	xxxxxxxxxxxxxx
75	3214 22 Jan 03	14 days	2456789 xxxxxxxxxxxxxxxxxxxxxx x	A69B	xxxxxxxxxxxxxx HC 123456 xxxxxxxxxxxx, xxxxxxx, xxxxxxxxxxxxxx