

CHAPTER 14

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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).

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).

INITIAL ACTION

Formal Requirements

- 14.04 Follow procedures at 1.04 to 1.07.

Action by Litigation Assistant (A1)

- 14.05 Follow procedures at 1.08 to 1.09.

STATEMENT OF GROUNDS

What should the statement of grounds contain?

- 14.07 Follow procedures at 1.11 to 1.12.

- 14.08 The statement of grounds 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 put forward, the disclosure or use must be sufficiently identified to allow the proprietor to appreciate the scope of the allegation he is required to meet.
- 14.09 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.
- 14.10 The claimant needs to 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?

- 14.11 Follow procedures at 1.13 to 1.18.

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

14.12 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.

14.13 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.

14.14 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). In *Yeda Research v. Rhone-Polenc Rorer* [2007] UKHL 43, an entitlement dispute under section 37, the House of Lords held that where entitlement proceedings had initially been commenced before two years from the date of grant the subsequent amendment of the claimant's statement of grounds still constituted the same proceedings and therefore fell within the two year limitation period.

Serving the Statement of Grounds

14.15 Follow procedures at 1.19 to 1.24.

COUNTER-STATEMENT

14.16 Follow procedures at 1.25 to 1.26.

AMENDMENT

Offer to amend under section 75

14.17 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 favour in allowing amendments to the patent in revocation proceedings.

14.18 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.

- 14.19 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.

EPC 2000 – Central Limitation Process

- 14.20 Following the introduction of the central limitation process, an EP patent may now be amended centrally at the EPO or in each individual contracting state. On receipt of amendments filed under section 75 in proceedings before the comptroller, the online European Patent Register (Register Plus) should be checked to determine whether there is a request to centrally limit the EP patent (see www.epoline.org/portal/public/registerplus). If amendments have been filed centrally, the HO will need to be informed as will the claimant in the proceedings. The defendant (the patent proprietor) may need to be contacted to obtain a copy of the amendments filed. If the amendments could result in different claims, the HO will advise on subsequent procedure, for example, it may, after seeking comments from both sides, be appropriate to stay the revocation proceedings until the central amendment proceedings at the EPO have been completed.

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 “*A 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. The B2 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.

PECS:- If the amendments are included within the body of an email, import the amendments using the “Send to dossier” facility (doc code is AMEN-LIT)
If the amendments are included in an attachment, import using manual import (doc code is AMEN-LIT).

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, a copy of the amendments should be sent to the other side with a letter pointing out that the proceedings will be reviewed and the Office will consider the best way of proceeding with the case.

PECS:- Create letter and import using manual import (doc code is LETTER-LIT).

The HO should be advised that amendments have been filed and the case should then be referred to the Deputy Director in charge of the subject matter concerned for a preliminary report on the amendments. 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 14.23 to 14.24 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.

PECS:- Once imported into PECS, annotate the amendments to show they are new /modified

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 and inform Litigation Section that in the circumstances no action on the amendments is necessary at this stage.

- 14.28 When unconditional amendments have been submitted in a counter-statement they should be advertised for opposition as soon as the procedures described above have been completed unless they are clearly minor and of no substance. The opposition period is two weeks. Where amendments are conditional upon an adverse finding on revocation, they will not normally be advertised immediately but will be considered later in the proceedings as appropriate.

Opposition to amendments

- 14.29 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 14.17) 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 but this will depend on how the HO wishes to conduct the evidence rounds.

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 two weeks from the date of the published advertisement. [Note: The amendments will appear on the Office website].

PECS:- Create minute and import using manual import (doc code is MINUTE-LIT). Send message to *ex parte* team “PSM”.

Create advert and import using manual import (doc code is ADVERT)

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 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. However consideration should be given to any impact on the agreed timetable for filing evidence and the hearing date.

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.

PECS:- A list of doc codes relating to supplementary or amended statements or supplementary or amended counter-statements is to be found in Chapter 25, annex 2.

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.

MANAGEMENT OF PROCEEDINGS

14.35 Follow procedures at 1.28 to 1.40. It will be for the hearing officer to decide whether mediation may be appropriate.

EVIDENCE ROUNDS

14.36 Follow procedures at 1.41 to 1.53.

WITHDRAWAL OF APPLICATION

14.37 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). When Litigation Section receives notification of withdrawal from the claimant the B2 case officer should establish whether the withdrawal

is unconditional or conditional on any amendments proposed by the proprietor being allowed. If this matter is unclear the B2 case officer should contact the claimant in order to resolve the matter and ask them for a response in writing. The B2 should refer the proceedings to the hearing officer's assistant, if one has been appointed, or otherwise the deputy director in charge of the subject matter, to determine whether an action is necessary in the public interest. The proceedings are concluded by formal office decision. A hearing officer may issue the decision or alternatively they may instruct the B2 case officer to prepare a decision. There are a variety of scenarios that may arise dependent on whether the withdrawal request is conditional or unconditional and whether the office deems it necessary to pursue the proceedings in the public interest. [Full description – MOPP. 72.24 – 72.34]. The B2 case officer will select the relevant decision (See Annex 3) and refer draft to the hearing officer for approval.

PECS: When approval is received, the B2 case officer should apply the relevant electronic signature (available from H drive) and issue decision with letter (See Chapter 5 Annex 1b). Decision and letter to be manually imported to dossier together with appropriate file note. In cases where the hearing officer accepts the withdrawal, but does not wish to issue a formal decision, a file note should be made accordingly.

OFFER TO SURRENDER (see Chapter 18)

[Full description - MOPP 72.36 - 39]

DECISION

14.38 Follow procedures at 1.54 to 1.56.

Amendments offered as a result of decision

- 14.39 Sometimes when a patent has been found to be invalid, the patent proprietor may be given the opportunity to file amendments. In such a case, the hearing officer will specify a time period for doing so in his decision.
- 14.40 On receipt of the amendments, the B2 case officer should arrange for an entry in the Register to show that amendments have been filed under section 75.
- 14.41 The amendments should be sent to the hearing officer for consideration. The hearing officer, for example, may invite further amendments if those originally filed are not found to be acceptable.
- 14.42 The hearing officer will advise whether the amendments need to be advertised for opposition. This may not always be necessary and depends on the nature of the amendments.
- 14.43 Following directions from the hearing officer, the B2 case officer should copy the amendments to the claimant as the revocation proceedings are in effect still on-going, and if appropriate, arrange to advertise for opposition purposes. The B2 should inform both parties of the Journal advert details.

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

- 14.44 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, on instruction from the B3, the Hearings Clerk should inform the B3 whether an appeal has been filed. A further register entry should be made on OPTICS as follows:

14.45 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”.

14.46 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 need to inform the B3 of the outcome of any appeal in due course so that this can be recorded in the register.

14.47 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."

14.48 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

14.49 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)

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

PECS:- See 1.56 for actions

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 08	4 weeks	2345678 xxxxxxxxxxxxxxxxxxxxx x	H04G	xxxxxxxxxxxxx
75	3215 29 Jan 08	2 weeks	2124567 xxxxxxxxxxxxxxxxxxxxx x	G22F	xxxxxxxxxxxxx
75	3214 22 Jan 08	14 days	2456789 xxxxxxxxxxxxxxxxxxxxx x	A69B	xxxxxxxxxxxxx HC 123456 xxxxxxxxxxx, xxxxxxxxx, xxxxxxxxxxxxx

Annex 3 Decision Forms

Decision Form B

(Applicant for revocation under Section 72 has withdrawn unconditionally and there are no amendments)

The applicants for revocation now state that they no longer wish to pursue the application. Having considered the objections raised by the applicants, I decide to make no order for revocation of the patent.

Decision Form D

(Applicant for revocation under Section 72 has withdrawn conditionally on amendments being accepted)

In order to meet the issues raised, the proprietors have submitted proposals for amendment of the specification. The proposed amendments are shown in a copy of the printed specification annexed to this decision and the applicants for revocation have expressed their willingness to withdraw their application on the basis of these amendments. The amendments have been advertised and no notice of opposition to them has been filed.

The amendments are such as may lawfully be made in these proceedings. Having now considered the objections raised by the applicants for revocation, I decide to allow the specification to be amended in the manner shown in the said copy of the printed specification and make no order for revocation of the patent.

Decision Form G

(Specification has been amended following an unconditional withdrawal by the applicant for revocation under Section 72)

The applicants for revocation now state that they no longer wish to pursue the application.

In order to meet the issues raised, the proprietors have submitted proposals for amendment of the specification. The proposed amendments are shown in a copy of the printed specification annexed to this decision. The amendments have been advertised and no notice of opposition to them has been filed.

The amendments are such as may lawfully be made in these proceedings. Having now considered the objections raised by the applicants for revocation, I decide to allow the specification to be amended in the manner shown in the said copy of the printed specification and make no order for the revocation of the patent.