

CHAPTER 16

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16 COMPLEX PROBLEMS

DISCLOSURE

16.01 Rule 103(3) provides the comptroller with the powers of a High Court judge in relation to disclosure, other than the power to punish summarily for contempt of court.

Initial Request between the Parties

16.02 Normally a party seeking disclosure will first approach the other side privately (ie not through the Office) in the hope of reaching agreement on the matter. If a request for disclosure comes to us, this is usually because, though admittedly not always, the parties have not been able to reach agreement.

16.03 On receipt of a request, the other side should be asked for their comments on the matter before the request is referred to the HO. A period of two weeks should be allowed for this. The period for the counter-statement or next round of evidence (whichever applies) should be stayed until the disclosure issue is resolved, subject to comments from the parties.

16.04 If the disclosure issue is resolved, the period for the counter-statement or evidence is resumed (usually a period of one month being allowed).

16.05 If the disclosure issue is not resolved, the HO can be asked to decide the matter.

Request to the Comptroller

16.06 The details of the request for disclosure should be filed together with the views of the other side. The parties should indicate whether they wish the HO to decide the matter on the papers or wish to be heard in the matter. The matter is then referred to the HO.

Decision by the Hearing Officer

- 16.07 See Patent Hearings Manual paragraphs 3.44 - 3.48 concerning the criteria that HOs will use in exercising their discretion relating to the ordering of disclosure.
- 16.08 The HO may order that a list of documents which are or have been in a party's possession be made available to the other side. When the party concerned has provided such a list, the documents may be inspected by and copies supplied to the other party. The HO will lay down a timetable for these stages and for the resumption of the proceedings.

STAY

Parallel Proceedings before the Court or EPO

- 16.09 A stay in *inter partes* proceedings may be requested if there are parallel proceedings in the Court or before the EPO.
- 16.10 The party requesting the stay should file the details of the request including reasons. The views of the other side should be canvassed. Additionally, the parties should indicate whether they wish the HO to decide the matter on the papers or wish to be heard in the matter. The matter is then referred to the HO.
- 16.11 The HO will decide the matter taking all the circumstances of the case into account - see Patent Hearings Manual paragraphs 2.73 - 2.76.

Stay of Court proceedings

- 16.12 Court proceedings may be stayed pending the outcome of proceedings before the Office eg under section 71 and 72 (*Hawker Siddeley Dynamics Engineering Ltd v Real Time Development Ltd* [1983] RPC 395).

Parallel EPC Proceedings before a Competent Authority of another State

16.13 Any reference under section 12 for an EP patent application will be stayed if proceedings before a competent authority of another state, which is a party to the EPC, are already in being (see section 82(7) and MOPP 82.06).

Parallel proceedings before the Comptroller

16.14 Entitlement proceedings before the comptroller may be stayed pending revocation proceedings also before the comptroller (see *Raychem Ltd v Caradon MK Electric* - section 37; *Loblite v Caradon MK Electric* - section 72).

16.15 The HO may stay revocation proceedings at the request of the claimants pending consideration of amendments requested by the proprietors (MOPP 72.13).

16.16 Opposition to surrender under section 29 may be stayed pending section 72 proceedings (MOPP 29.06).

DECLINE TO DEAL

16.17 The comptroller has discretion under section 8(7) and similarly under section 12(2) and 37(8) and 72(7) to decline to deal with a question if it appears to him that it involves matters which “would more properly be determined by the court”. In such a case any person entitled to do so may, within 28 days after the comptroller’s decision, apply to the court to determine the question.

16.18 See Patent Hearings Manual paragraphs 2.83 - 2.88 for further details.

CONFIDENTIALITY (Rule 94(1))

- 16.19 The comptroller has discretion to direct that a document other than a patent form, or any part of a document, be treated as confidential, when so requested by the person filing the document or any party to the proceedings to which it relates. The request must be made within fourteen days of the filing or sending (extendable at the discretion of the comptroller) and reasons must be given. If only part of a document contains confidential matter, for example financial figures, then confidentiality will not be accorded to the whole document. The document, with the confidential matter removed, ie the redacted version, will be open to public inspection.
- 16.20 Since the public are generally entitled to inspect documents relating to a patent, or application for a patent after 'A' publication, a request for confidentiality should not be granted unless it is considered justified for the reasons given.

Confidential evidence on a restricted basis

- 16.20.1 Sometimes a party will go further and seek to submit evidence it does not want the other side to see. Any party to the proceedings has a right to see all the evidence before the comptroller on which the other party relies, so there can be no question of the hearing officer admitting evidence that one party has not seen. However in suitable cases it may be sufficient to grant access to the confidential evidence on a restricted basis, eg to allow the document to be seen only by the other party's legal representatives and/or by an independent expert, or to require strict undertakings on confidentiality. See Chapter 3 of the Patent Hearings Manual.

Treatment of the rule 94(1) request

- 16.21 Rule 94(1) permits the sender to request that the comptroller treat any document, other than a patent form, as confidential. However, such a request must be supported by reasons filed within fourteen days of the date of filing of the request (extendable under rule 110(1)).

- 16.22 If the request is not supported by reasons, the sender should be telephoned and asked to submit detailed reasons in writing within fourteen days from the date of filing the request (extendable under rule 110(1)). A telephone report should be issued and the case suitably diarised.
- 16.23 The document(s) containing the confidential information should be placed on the "not open" part of the proceedings file pending consideration of the request. However, any document which is submitted with the rule 94(1) request including the accompanying letter should remain on the "open" part of the file (eg a letter that simply contains the rule 94(1) request).
- 16.24 In a few cases, the rule 94(1) request may appear in a letter which also contains some or all of the confidential information/supporting reasons to which the rule 94(1) request relates. In those cases, the letter should be placed on the "not open" part of the file. It will be necessary for the person to request that this letter is also to be treated as confidential.
- 16.25 When all of the required documentation has been received and placed on the appropriate part of the file, the case should be referred to the HO for consideration of the request.
- 16.26 If the request for confidential treatment is allowed, the HO will direct the following:
- (a) Inform the sender in writing accordingly;
 - (b) Endorse the front of each of the documents which have been accorded confidential treatment with the stamp below.

This document is to be treated as confidential by direction of the comptroller under Rule 94(1) of the Patents Rules 1995 dated -----

- (c) Place the documents which have been accorded confidential treatment into an envelope and stamp the envelope "not open to public inspection".
- (d) Place the envelope on the "not open" part of the proceedings file.
- (e) If confidentiality is allowed for only certain parts of a document, the full document will be treated as above. The redacted version will be treated as Open to Public Inspection.

16.27 The copy of the official letter which informs the sender that the rule 94(1) request has been allowed should be placed on the "open part" of the file.

16.28 It is possible for a document to be accorded confidential treatment for a limited period only. Where this applies, the action should be taken as above but the case should be diarised for return to the HO for the position to be reviewed.

16.29 Upon maturity of that period, if it is decided not to continue confidential treatment of a document, it will be necessary to inform the sender accordingly. Instructions will be given for the B2 to issue a letter, cancelling the 94(1) stamp on the relevant document(s) and placing them on the "open part" of the file.

EXTENSION OF TIME (EOT)

16.30 The six week period allowed under the relevant rules for the filing of documents, should be sufficient in most cases; however if difficulties arise, extensions of time may be requested under rule 110(1). The request should be made in writing and specify the length of extension requested and the reasons for the request. Without an explanation, the Office cannot exercise discretion to extent the limit, even if the extension is small and even if the other party would not be adversely affected by it.

- 16.31 Before allowing an extension of time, the comptroller must be satisfied it would be reasonable to do so, having regard to the need to deal with cases expeditiously and fairly ie any extension should not be longer than is necessary and the effect on each party of allowing or not allowing the extension should be considered. To this end, the other side's views should be canvassed either in writing or by telephone, before a decision on whether to allow the extension is made. If they agree to the request, the B2 officer may allow the extension.
- 16.32 If the other side does not agree to the EOT in part or whole, a number of approaches can be taken:
- a) If they disagree with any EOT, they should be contacted by telephone:
 - i) A compromise EOT should be attempted, usually for half the original request. This will require consent to the compromise from the requesting party, by telephone.
 - ii) To an agent or party who cannot make up his mind we can suggest that he agrees to this EOT but to no further EOT. This frequently meets with success.
 - iii) It may be expedient at times particularly to unrepresented parties to point out that an agreement to the EOT may be advisable on the grounds that later in the proceedings the roles may be reversed- he may be requesting an EOT- and the reaction from the other party may be influenced by the reaction at this juncture.
 - iv) It may need to be said that if there is no agreement between the parties the matter may be decided on the papers or at a preliminary hearing, and, additionally, that the Office tries to avoid such hearings on the grounds of costs and time.

b) If the other side agrees to an EOT which is less than that requested, the requesting party should be contacted by telephone and asked whether:

i) They agree to the reduced EOT.

ii) If there is no agreement, ask if they are willing to propose a compromise. The other side should then be contacted by telephone and proceed as in **a), i) - iv)** above.

16.33 If an agreement is reached, the agreement and means of achieving it and any conditions should be put in a letter and sent to both parties.

16.34 If an agreement cannot be reached, the HO should be informed. The HO will then decide the matter, either on the papers if both sides agree or at a preliminary hearing if requested.

TERMINATION/WITHDRAWAL OF GB PATENT APPLICATIONS BEFORE PUBLICATION

16.35 In an entitlement dispute, it is not appropriate for the Office to take any irrevocable action which might be to the detriment of the claimants should they subsequently be found to be entitled to the patent application. In section 8 entitlement proceedings, it is important that the relevant Formalities Group be informed of the proceedings so that an application is not terminated/withdrawn without the matter being referred back to Litigation Section. The procedure outlined below should be followed.

Warning to the relevant Formalities Group

16.36 When the B2 is appointed for a section 8 entitlement in respect of a GB patent application which has not been published, the following actions should be taken by the B2:

- Before the Patent application file is sent back to the relevant Formalities Group, a small blue card is placed on the front of the file shell and an A4 blue card at the end of the minutes sheets. The blue cards read “Warning - there is a separate *inter partes* folder for this case. Do not take any action to terminate this case without consulting Litigation Section”.
- At the same time, a minute should be placed on the main file addressed to the Formalities Manager informing him/her of the section 8 proceedings and asking that the file be referred to the B2 before any termination/withdrawal action is taken pre-publication.

Action by Formalities Group

16.37 If, before publication, termination action is due or a request to withdraw the patent application has been made, the Formalities Manager will contact the B2. The B2 officer should then refer the case to the HO for appropriate action.

16.38 Until the entitlement action is completed, the Office should avoid taking any action to terminate the application, because the relief under section 8 (2) and (3) would not then be available. The only relief available (under section 8(1)) would be a declaration concerning entitlement of the invention. In this situation section 8(3) does not allow the filing of a new application to be treated as filed on the filing date of the earlier application.

NO COUNTER-STATEMENT/EVIDENCE FILED

No counter-statement

- 16.39 If no counter-statement has been filed, the application/reference is deemed to be unopposed (see MOPP 72.09).
- 16.40 It is possible that the defendant did not receive the original official letter or the counter-statement has been sent but has not yet reached the file. Consequently, in order to ensure that the defendant is not disadvantaged, an official letter should be issued inviting comments from the parties (see annex 1).
- 16.41 If a counter-statement is filed in response to the official letter, then the claimant should be informed of the preliminary view that the counter-statement be allowed and that the period for filing the evidence-in-chief will be set, subject to any comments within 14 days. If adverse comments are filed, the case should be referred to the appointing HO for further procedure.
- 16.42 If no counter-statement is filed in response to the official letter or the defendant states that he/she does not intend to file a counter-statement, the defendants will forfeit the right to take any further part in the proceedings:
- In section 72 revocation cases (see MOPP 72.09) the HO is then asked to consider whether each specific fact as it is set out in the statement is conceded, except insofar as it is contradicted by other documents available to him. If on this basis it is determined that a ground has been made out, then the patent will be revoked. However, if it is the preliminary view of the Office that no ground has been made out, then the claimant should be informed of this view and offered a hearing before the application is dismissed.

- For all other cases, the HO is asked to consider the case. Again he will largely follow the practice as laid down in MOPP 72.09. He will give such directions as he sees fit. He may require that the claimant files evidence concerning specific points raised in his case before coming to a final decision.

No evidence

a) First round of evidence

16.43 If the claimant fails to file their evidence-in-chief, an official letter should be sent stating the following:

- The Office notes that the claimant has not filed evidence.
- Under rules (7(5), 75(5), etc), if the claimant fails to file evidence-in-chief, the period for the defendant to file his/her evidence will be set, starting on the date of expiry of the period set for the claimant's evidence.

The claimant should be invited to submit comments within 14 days (see annex 2).

16.44 If evidence-in-chief is filed in response to the official letter, then the defendant should be informed of the preliminary view that the evidence be allowed. The period for the defendant to file his/her evidence may be re-set, subject to comments within 14 days. If adverse comments are filed, the case should be referred to the HO for his consideration.

b) Second round of evidence

16.45 If the defendant fails to file evidence, an official letter should be sent stating that the Office notes that the defendant has not filed evidence and that therefore there is no evidence for the claimant to file evidence in reply to. The defendant should be invited to comment on the proposal that the Office should now commence arrangements for the substantive hearing. The claimant should be sent a similar letter inviting him to also comment on the Office proposal.

16.46 If evidence is filed in response to the official letter, then the claimant should be informed of the preliminary view that the evidence be allowed and that the period for filing the evidence-in-reply will be set, subject to any comments within 14 days. If adverse comments are filed, the case should be referred to the HO for his consideration.

c) Third round of evidence

16.47 If the claimant fails to file evidence-in-reply, an official letter should be sent stating that the Office notes that the claimant has not filed evidence and presumes that they do not intend to file any subject to comments; the Office will continue the arrangements for the substantive hearing. The defendant should be sent a similar letter inviting him to also submit comments on the proposal. If adverse comments are filed, the case should be referred to the HO for his consideration.

DUTY TO COPY TO OTHER SIDE

Fundamental principle of practice

16.48 In *inter partes* proceedings, there is a fundamental principle of practice whereby each party has a duty to copy to the other side any correspondence filed by them at the Office. This duty is laid down in *VNU Business Publications B.V. v Ziff Davis (UK) Limited* [1992] RPC 269, a case concerned with copyright, where it was held that:

‘There is a general principle that a properly interested party must have the right to see all the information put before the judge, to comment on it, to challenge it and if needs be to combat it, and to try to establish by contrary evidence that it is wrong. It cannot be withheld from him in whole or in part’

- 16.49 In the Patents Rules 1995 and the Registered Designs Rules 1995, this duty is clearly stated with regard to evidence. However, with regard to Statements of Case (previously known as Pleadings), this duty is excluded; the Office copies the Statement of Case to the other side.
- 16.50 In the Design Right (proceedings before comptroller) Rules 1989, this duty is clearly stated with regard to the counter-statement, though the Office is obliged initially to send a copy of any statement filed to the other side. With regard to evidence, in that the comptroller may give such directions as she thinks fit, the parties are requested to copy the documentation filed at the Office to the other side.

Correspondence

- 16.51 Correspondence received in the Office from one party may already have been copied to the other side. If this is the case, such correspondence will usually indicate this by use of the abbreviation 'cc' followed by the name of the other side's agent. In such a case, there would be no need for the Office to copy such a letter to the other side.
- 16.52 If it is not clear that the correspondence has been copied to the other side, then the correspondence should be forwarded as soon as possible under an official letter. If no action needs to be taken by the other side, it may be sufficient for the letter merely to state that the correspondence (give details eg date and from whom) is enclosed for information purposes.

Evidence

- 16.53 The Patent Rules 1995 states explicitly that evidence must be copied to the other side. If one of the parties complains that evidence has not been forwarded to him, then the other side will be contacted by the Office and asked to send a copy of the evidence to that party. However, if the evidence is not large in volume and in order not to delay the proceedings, a copy will be sent by the Office by post or fax.

16.54 A letter should then be issued changing the period of time in which the other party's evidence should be filed.

16.55 Although the Design Right (Proceedings before comptroller) Rules 1989 do not expressly refer to the fact that evidence needs to be copied to the other side, the comptroller will direct that it is as a matter of procedure.

Unpublished patent applications

16.56 Section 118 and rule 95 do not authorise us to inform a claimant of a patent applicant's address for service in respect of unpublished patent applications. Consequently, the following procedure should be followed:

- The patent applicant should be contacted and asked if he is willing for us to disclose his address for service.
- If he is unwilling for us to do so, then any letter heading indicating the address for service of the patent applicant should be blanked out when copying correspondence to the claimant.

UNCONTESTED ENTITLEMENT CASES

16.57 If in any entitlement proceedings under sections 8, 12 or 37, no counter-statement is filed after due warning has been given to the defendants (**see *No filing of counter-statement*** above), the reference is treated as uncontested.

16.58 The case should be referred to the HO who will then consider it as if each specific fact set out in the statement were conceded, except insofar as it is contradicted by other documents which are available to the HO.

16.59 The HO may give such directions as he sees fit, including provision of evidence.

16.60 If he is satisfied that the entitlement should be awarded to the claimant, he will issue a decision on an *ex parte* basis.

PARALLEL PROCEEDINGS/CONSOLIDATION OF SUBSEQUENT REFERENCES/APPLICATIONS

Parallel proceedings

16.61 There are instances where it may be appropriate for *inter partes* proceedings to run in parallel, for example, where a number of parties oppose a patent proprietors' application to amend a granted patent. In these instances, either the HO or the parties will suggest that consideration should be given to running the proceedings in parallel.

16.62 Where agreement is given by the parties, an official letter will be issued noting the agreement of parallel proceedings, a copy of which should be placed on the open part of the file.

16.63 The same periods of time for filing evidence will then be set for all of the parties who are involved in those particular proceedings.

Consolidation of proceedings

16.64 Where a subsequent reference/application is filed involving the same parties as one currently before the Office, a request may be made for consolidation of the proceedings. The proceedings may be, for example, for the same section of the act in respect of different patents or for different sections of the act in respect of the same patent.

16.65 The evidence filed in both sets of proceedings ie the earlier, and later case, will then cover both (or more) sets of proceedings which will save the need for duplication of evidence.

16.66 Where a request is received, the view of each party should be sought prior to submitting the matter to the HO for consideration. The HO will give the request due consideration ie he will consider, for example, the stage reached in the earlier proceedings.

16.67 Where the request is allowed, an official letter will then be issued to the parties to confirm that the proceedings are going to be consolidated or declined. The letter will normally clarify any matters outstanding and any time periods which should be met.

Un-consolidation of proceedings/parallel proceedings

16.68 At any time it may be decided that the proceedings should run independently. This may occur if a reference/application has been withdrawn or if the evidence rounds have been delayed in one of the proceedings for any reason.

16.69 Where we “un-consolidate” proceedings, the case will be referred to the HO for him to take note. A letter will then be issued to the parties confirming which proceedings are now running independently.

DETERMINATION AFTER GRANT OF ENTITLEMENT REFERENCE MADE BEFORE GRANT

16.70 This section deals with the situation where a reference to the comptroller made under section 8 has not been disposed of when the patent application in question is in order for grant. Section 8 provides for the determination of questions of entitlement to a patent for an invention prior to grant but is not applicable once grant has occurred. By virtue of section 9 section 37 will then apply to the determination of such questions.

16.71 When a Patent application is in order for grant, it proceeds to grant in the normal way, notwithstanding the existence of an unresolved entitlement question under section 8.

- 16.72 On the grant of the patent, the B2 should send a letter along the following lines to the claimant and should copy this to the other side:

“Patent application number..... has now been granted. By virtue of section 9 of the Patents Act 1977, we will treat the entitlement reference you have made under section 8 as though it had been made under section 37. This may affect the relief available to you if you are successful, but should not otherwise affect the course of the proceedings. Unless I hear from you or the defendant to the contrary, I shall assume you are both happy to defer dealing with the question of relief until the substantive hearing.”

FURTHER ROUNDS OF EVIDENCE

Evidence strictly in reply

- 16.73 The Patent Rules 1995 set down procedures to be followed with regard to the filing of evidence. In general, the procedures are the same for most *inter partes* proceedings in that the claimant initially files evidence in support of his case; the defendant then files his evidence; in the final stage the claimant is given the opportunity to file further evidence confined to matters strictly in reply. Any further rounds of evidence are at the discretion of the comptroller (see, for example, rule 75(6)).
- 16.74 The B2s do not carry out checks to ensure that any evidence filed is strictly in reply. As such, the onus is put on the defendant. A request to file further evidence will be received from the defendant and tends to be based on a claim that not all of the evidence filed was strictly in reply. The claimant (eg referrer, applicants) is contacted by the B2 and is invited to comment on this claim within a defined period. On receipt of comments, the case is referred to the HO for a *prima facie* view. If no comments are received, the case is still referred to the HO as only he can decide on subsequent procedure. If the parties disagree, a preliminary hearing may be required. The HO may direct that one or more further rounds of evidence will be allowed.

Evidence during the substantive hearing stage

- 16.75 At any stage during the arrangements for a substantive hearing, one party may seek leave to file additional evidence out-of-time. The HO should be contacted for directions in the matter. He will consider the admissibility of such evidence and may direct that the other side be allowed to file further evidence in reply.
- 16.76 Oral evidence may be given at the substantive hearing at the discretion of the HO.

ADDING, STRIKING OUT OR SUBSTITUTING PARTIES

- 16.77 Generally, in proceedings before the comptroller, it is possible to add or substitute a party. When such a request is made, the comments of the other party should be obtained. The HO should then be asked to consider the request.
- 16.78 Where one of several claimants wishes to withdraw from the proceedings or the defendants believe that one of the claimants has no cause of action, the HO may strike out that party.
- 16.79 If a party is struck out, the statement or counter-statement should be amended as appropriate. Amendment of any relevant form will also be necessary.
- 16.80 If any party is added or substituted in proceedings, then they may either amend the submitted statement or counter-statement or be given the opportunity to file a further statement or counter-statement.
- 16.81 Any new party must be given the opportunity to play a full part in the subsequent proceedings.

WITHDRAWAL OF APPLICATION/REFERENCE

16.82 In *inter partes* proceedings, the Office may be advised at any time throughout the proceedings that an application/reference is to be withdrawn. This is normally due to the parties concerned having reached a settlement and it will therefore not be applicable for the application/reference to proceed before the comptroller. The following action should be taken in all *inter partes* cases with the exception of section 72 applications for revocation:

Letter of withdrawal is received from the claimant and refers to the matter of costs being waived by both parties

16.83 The B2 will forward the file to the HO asking him to note the withdrawal with a recommendation to write to both parties noting the withdrawal and stating that, in the absence of comments within 14 days, the Office proposes to treat the matter as withdrawn leaving no matters outstanding. Any outstanding issues will be dealt with by the B2 and may need to be raised with the HO. In the absence of comments, the B2 will issue a further letter informing the parties that the Office is treating the matter as withdrawn. The file is then passed to the Litigation Officer (A3) for clear records. If a letter of withdrawal is received from the defendant it will be necessary to obtain a letter of withdrawal from the claimant before taking action on the withdrawal.

Letter of withdrawal is received but does not mention costs

16.84 The B2 will forward the file to the HO asking him to note the withdrawal, advise him that there has been no mention of costs and recommend that we write to both parties stating that in the absence of comments within 14 days, the Office proposes to treat the matter as withdrawn leaving no matters outstanding. Any outstanding issues will be dealt with by the B2 and may need to be raised with the HO. In the absence of comments, the B2 will issue a further letter informing the parties that the office is treating the matter as withdrawn. The file is then passed to the A3 for clear records.

Letter of withdrawal is received from both parties and both confirm that the matter of costs has been resolved

16.85 The B2 will forward the file to the HO with a recommendation that a letter is issued noting that the matter is withdrawn leaving no matters outstanding.

Action by Hearings Clerk

16.86 If the withdrawal offer is received after arrangements for the substantive hearing have begun, the Hearings Clerk (A3) is responsible for actioning the withdrawal.
Clear records

16.87 The A3 will complete a register entry on OPTICS and an entry for the Journal noting that the application/reference has been withdrawn. The register entry should be made using a free text entry (use REG ENT):

Application/reference under section..... withdrawn on.....

The Journal entry should be made under the appropriate section:

Patent number..... Name.....

Title of invention

Application/reference under section withdrawn on.....

The section record card will be noted and the file will be sent to NMP, if the patent is granted, or to the relevant Formalities Group, if the patent application has not been granted.

Withdrawal of claimant in section 72 proceedings

(For revocation of Patents refer to Chapter 14)

Conditions of withdrawal

16.88 A withdrawal by the claimant may be unconditional or it may be conditional on amendments which have been submitted by the proprietor being allowed. If it is not clear whether an offer to withdraw is conditional or unconditional, or what the conditions of withdrawal are, the B2 should seek clarification from the claimant.

Public interest

16.89 Where an claimant serves notice of withdrawal from revocation proceedings before the comptroller which have been properly launched, an examiner considers whether the comptroller should accept the notice without qualification or whether there are questions remaining that the comptroller should further consider in the public interest. If the claimant for revocation seeks to withdraw, the B2 should arrange for the file to be sent to the HO's assistant if one has been appointed, or otherwise to the Deputy Director in charge of the subject matter. The proceedings are concluded by a formal decision of a HO on whether or not the patent is revoked in the public interest. (See MOPP 72.26-72.27).

Clear records - updating the register

16.90 If as a result of a decision of the comptroller, a patent is revoked, the B3 officer will change the status of the patent to revoked and will arrange for a register entry to be made reflecting the result of the decision. The register entry will also refer to the appeal period (see Chapter 14). The A3 will prepare a Journal entry reflecting the result of the decision.

16.91 Once the appeal period has expired, the B3 officer will make a further entry in the register to reflect the fact that an appeal has not been lodged. A further Journal advert will be also be prepared by the A3. If an appeal is lodged, then this will be actioned by the Hearings Clerk.

Surrender

- 16.92 In revocation proceedings, the proprietor may at any time offer to surrender his patent (see Chapter 18 and MOPP 29.01). An offer to surrender during revocation proceedings will not automatically terminate those proceedings.
- 16.93 Where an offer to surrender has been filed in section 72 proceedings, the file should be referred to the Deputy Director dealing with the application. He/she will advise if the application to surrender can be considered and if so will request that an appropriate entry for the Journal be made (see Chapter 18 and MOPP 72.36-37, 29.01). The matter will be considered as though no counter-statement had been filed. If on this basis at least one ground for revocation has been made out (and the 2 month opposition period has expired) the parties will be informed that a decision will be issued to revoke the patent and refuse the surrender unless objection is raised by either party within one month. If no grounds for revocation have been made out the offer to surrender will be accepted.

SECURITY FOR COSTS

- 16.94 In many proceedings, where a claimant neither resides nor carries on business in a state that is part to the Brussels Convention, the comptroller can require them to give security for costs under, for example, section 107(4) of the Patents Act 1977 or rule 22(2) of the Design Right (Proceedings before comptroller) Rules 1989, before allowing the proceedings to continue.

16.95 Unless the defendant in proceedings makes a request for security for costs, there is no need to pursue the matter. If a request is made, the matter may be referred to a Hearing Officer as he or she may need to advise on the appropriate level of security. Instead of a standard amount such as £900 (as previously) the award should be determined, after consideration of argument and, if necessary evidence, wholly on a case by case basis appropriate to the estimated costs likely to be awarded at it's conclusion (see TPN 2/2000 - paragraph 16). A party can make payment to his/her solicitor to hold for the paying party (see Civil Procedure Rules 25.12.8 for further information on the manner of payment). The Office also operates an account in the name of third parties in which money can be held. This may be relevant where security for costs is ordered and the party is a private applicant.

ANNEX 1

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

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E-mail: xxxxxx@ ipo.gov.uk
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Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:

Our Reference: Rm 3Y31/ Name/File Reference

Date

Dear Sirs

Patent No *** (*****): *** under Section *** of the Patents Act 1977 by *******

In the above proceedings, it is noted that the defendants have not filed a counter-statement, under Rule ***** of the Patents Rules 1995, in the period set by the official letter dated ****.

Subject to comments from either party within 14 days from the date of this letter, the Office will treat the case as unopposed. If the case is so treated, the Office will issue further instructions.

It is possible for the defendants to file a request for a retrospective extension of time for filing the counterstatement. However I can not guarantee that the extension request will be granted. Any extension request will require detailed reasons regarding why the extension is needed.

A letter in identical terms is being sent to the other side.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 2

c/o

**Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ**

Case Officer: Telephone number
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Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:

Our Reference: Room 3Y31/ Name/File Reference

Date

Dear Sirs

Patent No *** (*****): *** under Section *** of the Patents Act 1977 by *******

In the above proceedings, it is noted that the claimants have not filed any evidence-in-chief, under Rule 75(4) of the Patents Rules, in the period set by the official letter *****.

Subject to comments from either party within 14 days from the date of this letter, the Office proposes that, in accordance with Rule *****, the defendants should file evidence in support of their case within six weeks of the date of this letter. Such evidence should be copied direct to the claimants.

The proprietors' evidence is therefore due **by *******.

A letter in identical terms is being sent to the other side.

Yours faithfully

Your Name
Litigation Section
Patents Directorate