

CHAPTER 17

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17 APPLICATION TO AMEND THE SPECIFICATION OF A PATENT UNDER SECTION 27

INTRODUCTION

17.01 This section is concerned with the amendment of the specification of a granted patent on an application made by the proprietor of a patent. The detailed provisions are set out in the Patents Rules 1995 and section 27 of the Manual of Patent Practice. Section 76 sets out limits on what may be allowed as an amendment. Sub-section 76(3)(a) & (b) indicate that no amendment of the specification of a patent is allowed under section 27(1), 73 or 75 if it:

- results in the specification disclosing additional matter, or
- extends the protection conferred by the patent.

MAKING AN APPLICATION

17.02 For proposals to amend under section 27, applicants need to file Patents form 11/77 (together with the appropriate fee) in paper form identifying the amendment and stating the reasons for it. If reasonably possible to do so, the proposed amendment and the reasons for it should be set out and delivered to the comptroller electronically.

DIRECTIONS FOR THE ELECTRONIC DELIVERY OF APPLICATIONS

17.03 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.

By e-mail

17.04

- The Office will not accept an e mail for these purposes 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 s27*”
- The text may be provided as an attachment to the e-mail.

If the Office is unable to read the text, the email will be treated as not delivered, and in these circumstances the A3 should contact the applicant with a view to making alternative arrangements.

Setting out the amendments

17.05 Applicants are encouraged to use conventional word processing features such as markup, colored 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.

Action on receipt of the amendments

17.06 (deleted)

17.07 (deleted)

17.08 The A3 should:

- undertake checks to ensure that all appropriate details are provided.
- liaise with the A1 Litigation Assistant who will make up the litigation file (See Chapter 25), enter details in the ledger, make up a movement card and complete the register entry

INITIAL ADVERT

17.09 On receipt of the application to amend from the A3, the A1 enters the application in the ledger and makes up a proceedings file and movement card for the case. The A1 makes a free text entry on OPTICS using REG FIL.

This entry will automatically generate an initial advert for the Patents & Designs Journal (the Journal). The advert will appear in the journal 3 weeks from the first Wednesday after the application is entered on to OPTICS.

17.10 The file should be passed back to the Litigation *ex parte* team.

INITIAL ACTION - FORMALITIES CHECKS - A3 DUTIES

17.11 The A3 carries out formalities checks to ensure that the Patents Rules 1995 have been complied with. Once any defects in the application have been resolved with the applicant, the case should be referred to the appropriate Deputy Director who will report on the proposed amendments. The proceedings sheet should be minuted with any actions taken and copies of official letters sent to the applicant kept in the correspondence section of the file. Checks undertaken include the following:

Patents Form 11/77 and OPTICS checks

17.12 The Patents Form 11/77 is checked to ensure:

- the applicant's name is on the Patents Form
- it is signed by the proprietor or his agent,
- an address for service is provided in the EU (Refer PDN 02/06)
- it clearly identifies the proposed amendments and reasons for the amendment are given (see also the filing of translations) and
- the current fee is paid.

New agents

- 17.13 If new agents have been mentioned on the Patents Form 11/77 and a Patents Form 51/77 for change of agents has not been supplied, the new agents should be contacted and requested to file a Patents Form 51/77.
- 17.14 If the new agents have responsibility to act in all matters related to the patent, a copy of Patents form 51/77 should be made and sent to New Applications Section to update the register. If the original agent's address has changed, no Patents Form 51/77 is required. Either the agent's letter or the Patents Form 11/77 should be copied to New Applications Section in order that they may update the register.

Patents Form not signed

- 17.15 If the Patents Form 11/77 has not been signed but an accompanying letter is, this may be accepted. If there is no accompanying letter, the Patents Form 11/77 should be returned to the applicant (a copy kept on file), with a letter outlining the problem.

Is the application an Amendment or a Correction?

- 17.16 The application should be checked to ensure that the applicant has applied the term "amendment" in the correct manner (see Chapter 24 for a description of what constitutes a correction). If it appears that the application is a correction rather than an amendment, the case should be minuted to the appropriate Deputy Director for consideration.

Copies of documents

17.17 Copies of any documents referred to on the Patents Form 11/77 or accompanying letter, but not supplied, should be obtained. If any of the documents referred to are not available in the Office, the applicant should be asked to supply copies in accordance with rule 106 of the Patents Rules 1995, before the application is referred to the Deputy Director. A period of 1 month should be given for reply.

17.18 (deleted)

Applicant does not match registered proprietor

17.19 The Patents Form 11/77 should be cross-referenced with the OPTICS - DIS FUL printout (front of proceedings file). Where there is a discrepancy, the agents should be contacted to check proprietorship. If the applicant under section 27 is confirmed as the legal owner, subject to all other formalities being complied with, the application may proceed.

A file note should record the action taken as follows:

The ownership of the patent has changed from to confirmed by, evidence for which has been asked for by official letter issued on XX.XX.XX Copy on file.

Non-English Documents & Translations

17.20 Any documents filed as supporting evidence and not published in English should be accompanied by a copy of a translation in accordance with the Patents Rules 1995.

- 17.21 Where a non-English European patent (UK) is cited in evidence, and there is no accompanying translation, a check should be made to see whether under section 77(6) a translation of the published specification has previously been filed. Check OPTICS -DIS FUL printout or the DIS FOR (DISPLAY FORMS HISTORY) screen (No 10 from the Common Enquiry Menu) and check if a Patents Form 54/77 (the filing of a translation) has been filed.
- 17.22 If a translation has been filed, the EP file in question should be requested from NMP. The translation and accompanying Patents Form 54/77 will be found in the main EP file.
- 17.23 If no translation has been filed, the applicant should be requested to file a copy of a translation of the cited specification and/or the non-English documents in accordance with the Patents Rules 1995. This should be done before the application is referred to the Deputy Director. A period of one month is given for reply. A file note of action taken is added to the proceedings sheet, and B/F for 1 month.

Fee

- 17.24 If the fee has not been paid and the agent has a deposit account, arrangements should be made for the fee to be placed on the Patents Form 11/77. If the agent does not have a deposit account, the fee should be requested.

Has the patent been granted?

- 17.25 An application to amend under section 27 cannot be actioned by Litigation Section until the granted patent has been published in the Journal or the EP Bulletin. The status of the patent should be checked on OPTICS.

GB cases

- 17.26 Using DIS FUL, a printout should be obtained. This will show two dates in connection with the granting of the patent. The first relates to when the applicant was notified by the Formalities Section that the patent was to be granted. The second gives the date when the notice of the grant is published in the Journal.
- 17.27 If an application to amend is filed before the first date is recorded on OPTICS, the application should be referred to the relevant Formalities Section for amendment under section 19 (General Power To Amend Before Grant).
- 17.28 Where an application is filed between the two dates, the applicant should be informed that they have filed too early and the Office will therefore stay the proceedings until the notice of grant has been published in the Journal. The application will then be considered to be filed on the day the notice is published in the Journal. The applicant should also be informed of any other defects in the application.
- 17.29 The file is then B/F until the date of the Journal containing the notice of grant. A file note of action taken is added to the proceedings sheet and a copy of any letter sent should be filed in the correspondence part of the file.

EP cases

- 17.30 Application to amend under section 27 cannot take place until the granting of the patent has been published. This date affects all provisions of the Act from 25(1) onwards.
- 17.31 An application to amend a European patent (UK) can not be considered until the date on which its grant is mentioned in the European Patent Bulletin. The OPTICS - DIS FUL printout (front of proceedings' sheets), will show the date on which the patent will take effect, i.e. the publication date.

- 17.32 If an application is filed before this date, the applicant should be informed that they have filed too early and the Office will therefore stay the proceedings until the patent has been mentioned in the EP Bulletin. The application will then be considered to have been filed on that date. The applicant should also be informed of any other defects in their application.
- 17.33 The file is then B/F till the date of the Bulletin mentioning the patent. A file note of action taken is added to the proceedings sheet, and a copy of any letter sent should be filed in the correspondence part of the file.

EP opposition period

- 17.34 An EP patent has a nine month opposition period during which opposition proceedings may be taken out and the patent may be amended before the EPO as part of the proceedings. The opposition period begins once the patent is mentioned in the European Patent Bulletin. This date can be found on the OPTICS - DIS FUL printout.
- 17.35 To determine the status of opposition proceedings a print is obtained from the EP on-line register.
- 17.36 If an EP patent which designates the UK is amended during opposition proceedings before the EPO, and the EPO's decision is that the patent should be maintained in the amended form, the amendments automatically apply to the European patent (UK) (MOPP 21.05.1). Therefore action under section 27 with regard to those amendments is not necessary and the fee should be refunded.

17.37 Where the EPO opposition period has not expired or when EPO opposition proceedings are pending, amendments can proceed under section 27. This is due to the fact that opposition proceedings may take some time to resolve, in which time the European patent (UK) may be invalidated due to infringement or revocation in the UK before the Office or the courts, before the EP opposition amendments are allowed. Therefore the application may proceed provided the applicant indicates that he wishes to proceed regardless in reply to a standard letter (see Annex 1), in the knowledge that the amendments may be negated as a result of subsequent amendment before the EPO.

Non-English European patents (UK), Documents & Translations

17.38 An application to amend a European patent (UK) specification published in French or German, should be accompanied by a translation of the part of the specification to be amended and the amendments themselves in accordance with the Patents Rules 1995.

17.39 If no translation accompanies the application, a check should be made to see if a translation of the specification has been previously filed with Patents Form 54/77. If it has, it will be found in the main EP file. Check OPTICS - DIS FUL printout or the DISPLAY FORMS HISTORY (DIS FOR) screen (No 10 from the Common Enquiry Menu) to check if a Patents Form 54/77 (the filing of a translation) has been previously filed and the translation possibly mislaid.

17.40 If no translation has been filed, the applicant should be informed in a letter of the requirement to file a copy of a translation of the part of the specification which is to be amended and of the amendments proposed in accordance with rule 40(6). The applicant should also be informed of any other defects in their application. A period of one month is given for reply. This action should be carried out before the application is referred to the Deputy Director. A file note of the action taken should be made on the proceedings sheet and the file B/F for 1 month.

17.41 (deleted)

17.42 (deleted)

17.43 (deleted)

REQUESTING DEPUTY DIRECTOR'S REPORT ON THE AMENDMENTS

GB and European patent (UK) cases

17.44 Following the formalities check, for a GB case or for a EP(UK) case (where opposition period has expired without opposition proceedings being filed) the application should be referred to the Deputy Director in charge of the subject matter to which the specification relates. The minute sheet should contain the following note:

FILE NOTE

Formalities complied with, initial advert generated for PDJ.

DEPUTY DIRECTOR

Case referred for report under section 27 of the 1977 Act (see MOPP 27.07)

17.45 (deleted)

17.46 (deleted)

17.47 (deleted)

17.48 (deleted)

17.49 (deleted)

17.50 (deleted)

RESPONSE TO OFFICIAL LETTER - OPPOSITION PERIOD

17.51 The response to the Official letter should be placed on file and the file then referred to the Deputy Director with one of the following minutes according to the nature of the reply:

If the applicant wishes to stay

17.52 *Agents have replied to Official Letter dated XX.XX.XX and have asked to stay the proceedings until the opposition period has expired or the proceedings have been settled. See A/L dated.*

On return from the Deputy Director, the case will be B/F until the expiry date of opposition period, or until opposition proceedings have been settled. During this period, an Official Letter should be issued every 6 months requesting updates on the proceedings. Once the proceedings and expiry date have passed, the case should be referred to the Deputy Director with a minute note as follows:

Case referred for report under section 27 of the 1977 Act (see MOPP 27.07).

If the applicant wishes to proceed

17.53 *A minute note should be entered on the proceeding sheet as follows:*

Agents have replied to Official Letter dated XX.XX.XX and have asked to proceed regardless. See agents' letter dated XX.XX.XX Case referred for report under Section 27 of the 1977 Act (see MOPP 27.07).

FORMALITIES PROBLEMS

Proceedings in which the validity of the patent may be put at issue

17.54 Where the validity of the patent may be put at issue (see section 72), and proceedings are pending before the court or Comptroller, e.g. revocation or infringement action, an application under section 27 is not allowed. This is in accordance with section 27(2). In such circumstances the applicant should be informed that while proceedings are pending, (until the period of appeal has expired and any appeal has been determined) amendment can only be made under section 75.

- 17.55 To check proceedings against a GB or EP (UK) patent, you should check below the line entries from the OPTICS - DIS FUL printout (front of proceedings file) and any correspondence concerning the patent.
- 17.56 Where a European patent (UK) is undergoing opposition proceedings before the EPO, amendment may still proceed under section 27 (see paragraph 17.42).
- 17.57 Much relies on the applicant making full disclosure.
- 17.58 If the applicant wishes to stay the proceedings until court action has been finalised, the file B/F should be put in. When the Court action has been completed, the application may proceed as long as all formalities are complied with. A file note of action taken should be made on the proceedings sheet and a copy of any official letter sent to the applicant should be placed on the correspondence part of the file.

A Ceased Patent

- 17.59 A ceased patent may also be amended, though this would be a matter for the Deputy Director to consider. Providing all the formalities have been complied with or resolved, the application should be referred to the appropriate Deputy Director for consideration as usual.

DEPUTY DIRECTOR'S REPORT FOR BOTH EUROPEAN PATENTS (UK) & GB CASES

- 17.60 The amendments must comply with section 76(3) i.e. - amendments must not add matter, nor must they extend the protection conferred by the patent. They are also a matter for the discretion of the Comptroller.

17.61 The reasons for the amendments have to be sufficient and the proprietor is under an obligation to show the utmost good faith when seeking amendments. The actions of the proprietor are also taken into account and in the absence of a satisfactory explanation to any apparent delay in seeking amendment, the amendment may be judged not allowed.

Amendments not *prima facie* allowable

17.62 The Deputy Director will report giving reasons why any amendment or group of amendments are not regarded as *prima facie* allowable. He/she will advise on the minute sheet on any amendments which he/she considers should also be submitted. An e-mailed version may be sent by the Deputy Director for incorporation into a letter. The applicant may also be given the option of withdrawing all proposed amendments or to proceed with amendments that appear to be *prima facie* allowable.

17.63 The A3 should draft a letter inserting the Deputy Director's report together with his name and telephone number e.g. - "*I refer to your application for amendment filed on XX.XX.XX, the examiner (Mr/Mrs Tel) has reported the following:.....*" (see Annex 2) If no reply date is noted by the Deputy Director, a period of 2 months should be specified. A copy of the letter should be put on file and the file B/F for 2 months for a reply (See annex 2).

17.64 Any further amendments received in response to the Official letter, should be placed on file and referred back to the Deputy Director with the following minute note:

Agents have replied to the official letter dated XX.XX.XX and have stated in their letter dated XX.XX.XX that For your consideration, please.

17.65 The Deputy Director will produce a new report and again a letter should be prepared and issued by the A3. This action continues until a set of amendments are produced that appear to be *prima facie* allowable, the amendments will then be advertised.

17.66 If an agreement cannot be reached, a hearing will be offered subject to advertisement of the proposed amendments. The advert should state clearly that the allowability of the amendments has not yet been determined. An appropriate letter will be drafted by the Deputy Director. A copy of the letter should be put on file and a note of the action taken recorded on the minute sheet.

If a hearing is requested, the case should be referred to the Liaison Officer/Hearings Clerk.

Amendments appear to be *prima facie* allowable

17.67 The Deputy Director will report that he/she considers that the amendments appear to be *prima facie* allowable, that they are to be advertised, and that the applicant is to be informed.

The A3 Litigation Officer should:

- Complete the Journal notice (annex 6). This will need to be completed if the application is filed electronically or in paper form.
- Send electronic amendments to "webmaster". The table (annex 7) 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, full details will be available from the Litigation Section upon request. These should be issued by fax or post as appropriate.

- Issue S27(a) letter (annex 3) advising the applicant when the notice of proposed amendments will be advertised in the Journal (see Annex 4 for EP(UK) cases where EP opposition proceedings are pending). The opposition period lasts 2 months from the date of the published advert in accordance with section 27(5) and the Patents Rules 1995.

17.68 A copy of the advert is kept on file, behind the minute sheets. The date of the Journal containing the advert should be entered on the front of the copy of the advert.

17.69 A minute note should be added on the proceedings sheet as follows:

Official letter sent to agent on XX.XX.XX, see copy on file. Full advert will appear in Journal dated XX.XX.XX. B/F for 2 months from the date of advert for opposition.

If opposition is received, see Opposition Received section below.

If no opposition is received, see No Opposition Received section below.

Amendments not proceeded with

17.70 The Deputy Director will give reasons why he/she considers the application should be regarded as not proceeded with. He/she will minute the proceedings sheet advising that the applicant be informed of the decision and will instruct if a refund is to be given. An additional free text register entry may be made to record why the application is to be regarded as not proceeded with. Suitable wording may be provided by the Deputy Director.

- 17.71 An official letter should be issued to the applicant informing them of the decision. The wording may be taken from the report supplied by the Deputy Director. The A3 should write in red ink in the top right hand corner of the Patents Form 11/77:

Application not proceeded with (date of clear records)

The next action undertaken involves clearing records (see Clear Records Section below).

OPPOSITION FILED

- 17.72 Notice of opposition should be filed on Patents Form 15/77 within 2 months of the date of the full advertisement of the proposed amendments in the Journal. This period may not be extended.
- 17.73 The opposition should be referred to the B3, with an appropriate file note. It will then be processed as an *inter partes* case.

NO OPPOSITION RECEIVED/OPPOSITION PROCEEDINGS CONCLUDED AND AMENDMENTS ALLOWED

- 17.74 Where no opposition has been received or opposition proceedings concluded, the proposed amendments should be made in the original specification.
- 17.75 The amendments, if not extensive, may be entered on the 'B' Spec by the A3. The A3 should tab the 'B' Spec in the main file and also the page where the certificate is to be attached. This will be the last text page if the amendments are textual, (this includes any amendments to the Bibliographic page), or the last page of the drawings if allowable amendments to drawings are included. Where the allowable amendments appear in a letter or on the Patents Form 11/77, these should also be tagged.

- 17.76 If an English translation has been filed for a European patent (UK), the amendments should be entered on the translation and an appropriate certificate attached.
- 17.77 If the amendments are extensive or are difficult to prepare for either a GB or a European patent (UK) specification, the applicant may be called upon to provide within a specified period, usually 2 months, a new (re-typed) specification with the amendments included as per the Patents Rules 1995.

A letter should be sent to the applicant as follows:

With reference to the above, I write to inform you that an opposition has not been filed. However the amendments are considered extensive and in accordance with Rule 40(8) a retyped specification, incorporating all agreed amendments should be filed in duplicate within two months from the date of this letter.

The file should then be B/F for that period.

- 17.78 On receipt of an amended specification, this should be checked to ensure that the amendments made are the same as those allowed by the Deputy Director. A file note should be added as follows:

Specification checked - amendments incorporated into retyped specification agree with those advertised and allowed.

- 17.79 One of the supplied specifications should be marked "new" and attached to the original specification, BEHIND the front page of the 'B' specification in the main file and in front of the main body of the 'B' spec. The second copy should be marked "duplicate New" and should be placed on the OPI Litigation file behind the Patents Form 11/77.

APPLYING CERTIFICATES

17.80 The A3 should apply the appropriate certificates to both the unamended and amended specifications. The certificates should be placed on the last text page of the specification/translation i.e. the last text page if the amendments are textual or the last page of the drawings if allowable amendments to drawings are included.

'B' spec amended and certificate added

17.81 The file should be referred to the Deputy Director for the certificate to be signed. The proceedings sheets should contain the following minute note:

No opposition has been received. The B specification has been amended with the allowed amendments and the certificate is submitted for your signature only.

File returned from Deputy Director with certificate signed

17.82 On return from the Deputy Director, a letter (see annex 5) should be drafted to notify the applicant that the advertised amendments have been allowed and a copy of the 'C' specification will be forwarded in due course. The certificate should be dated the same as the letter, or in the case of a hearing, the date of the decision. The A3 should write in red ink in the top right hand corner of the Patents Form 11/77:

Amendments requested were allowed on (date of letter or decision of hearing)

The following minute should be entered on the proceedings sheet:

Amendments Allowed.

Agents advised of allowability of amendments on XX.XX.XX by stock letter, copy on file. Clear records.

The next action involves clearing records (see Clear Records section below).

WITHDRAWAL OF AN APPLICATION

17.83 An application cannot be withdrawn once the applicant has been given notice that the amendments are allowable. The notice is taken as the date the official letter 27b (annex 5) is issued. Before this letter is issued the applicant may withdraw his application to amend but only at the discretion of the Deputy Director.

17.84 Any application to withdraw is referred to the Deputy Director for his consideration with a minute attached as follows:

Agents' letter received on XX.XX.XX. The applicant has advised they wish to withdraw the application. For your consideration, please.

17.85 If a withdrawal is refused and the proposed amendments do not cure the specific defect identified and alternative amendments have not been submitted, the application to amend must also be refused. A register entry reflecting the fact that both the withdrawal and the application itself has been refused should be made. Suitable wording for the additional register entry concerning the refusal to allow the withdrawal should be provided by the Deputy Director. The applicant should also be notified of the Deputy Director's decision.

17.86 If a withdrawal is allowed, the applicant should again be informed of the Deputy Director's decision. In the top right hand corner of the Patents Form 11/77, the following should be written in **red ink**:

Application withdrawn on (date of clear records)

The next action involves clearing records (see Clear Records section below).

AMENDMENTS NOT PROCEEDED WITH

17.87 An application may be considered not proceeded with in the following circumstances:

- the applicant fails to file the application correctly
- the application is a correction rather than an amendment
- the applicant fails to respond to official letters
- an EP patent has been amended during Opposition Proceedings before the EPO. Since the amendments automatically apply to the European patent (UK), action under section 27 is not necessary. The fee on the Patents Form 11/77 should then be refunded.

17.88 If the Deputy Director considers an application to amend should be regarded as not proceeded with, he/she will minute the proceedings sheet requesting that the applicant be informed and the Journal and register updated. Where the European patent (UK) has been amended before the EPO, he/she will indicate that a refund should be given, see Refund Section. An additional free text entry to the register may be requested by the Deputy Director in order to record the reason for the application not proceeding. He/she may provide suitable wording.

17.89 The A3 should issue an official letter to the applicant informing him of the Deputy Directors' decision. The wording may be supplied by the Deputy Director. In the top right hand corner of the Patents Form 11/77, the following should be written in **red ink**:

Application not proceeded with (date of clear records)

The next action involves clearing records (see Clear Records section below).

EXTENSION OF TIME

- 17.90 A request for an extension of time should be referred to the Deputy Director with the following minute note:

The agent by phone/fax/letter on/dated XX.XX.XX has requested an extension of time. Please advise on action to be taken.

The applicant should be advised of the Deputy Directors' decision and a note of the action taken entered on the proceedings sheet.

- 17.91 With regard to extension of time requests relating to an opposition to an amendment, please refer to Chapter 9.

CLEAR RECORDS

- 17.92 Once the applicant has been informed of the outcome of the application and the Patents Form 11/77 has been noted, clear records action may be undertaken. An advert should be prepared for the Journal and the ledger and OPTICS all updated. A 'clear records' sheet is used as a check list and to inform Publishing Section of the actions to be taken.

Final advert

- 17.93 A final advert should be prepared for the PDJ. This advert will appear in the Journal 3 weeks from the first Wednesday after the advert is prepared and submitted to publishing.

Movement card

- 17.94 The movement card should be destroyed.

Ledger book

17.95 The relevant entry in the ledger under section 27 should be updated to show the outcome of the application and the date of the decision.

OPTICS entry

17.96 Where the application has not been proceeded with, or has been withdrawn, refused or allowed a free text entry using the command REG ENT should be made reflecting the outcome of the application.

17.97 (deleted)

17.98 (deleted)

17.99 (deleted)

File referred to Publishing Section/NMP

17.100 If the amendment has been allowed, the Publication Section details on the Clear Records sheet should be completed with the actions to be taken. You should alert Publication Section to any changes of bibliographic data shown on DIS FUL on OPTICS which are not on the front page of the "B" Specification. This is done when ticking the box for a "C" Specification.

17.101 The Clear Records sheet should be attached to the proceedings file and the proceedings file placed at the back of the main patent file.

17.102 Where the amendments are allowed, the file should be sent to Publishing Section with a minute on the proceedings sheet of the main file referring to the Proceedings file and the Clear Records sheet. Once Publishing Section have actioned the file, it will be sent to NMP.

17.103 Where the amendments have not been allowed, the file should be sent to NMP by Litigation Section.

ANNEX 1

c/o

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

Direct Line: 01633 81xxxx
E-mail: xxxxxxi@ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your Reference:
Our Reference: 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: xxxxxx (Proprietors Name)
Application to amend the specification of a patent under Section 27 of the Patents Act 1977.

Latest date for reply xx xx xx

I refer to your application for amendment filed on xx. Xxxxx. Xxx.

The nine month period allowed to oppose the European Patent (UK) has not yet expired. In these circumstances there are two options available to you

- a. staying the request until the opposition period has expired or the opposition proceedings have been settled, or
- b. proceeding with the request to amend under Section 27 on the understanding that the amendment may be negated as a result of subsequent amendment before the EPO.

Please see paragraph 27.05.1 of The Manual of Patent Practice.

You should let me know what action you wish to take xx. Xxxxx. xxxx .

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 2

c/o

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

Direct Line: 01633 81xxxx
E-mail: xxxxxx@ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: [Http://www.ipo.gov.uk](http://www.ipo.gov.uk)

Your Reference:
Our Reference: 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: GB xxxxxxx (Proprietors Name)
Application to amend the specification of a patent under Section 27 of the Patents Act 1977.

Latest date for reply: xx.Xxxxxx.xxxx

I refer to your application for amendment filed on xx.Xxxxxx.xxxx. The examiner (Examiner's Name, Tel 01633 81xxxx) has reported the following:

If you would like to propose further amendments, you should file a consolidated version on paper and if reasonably possible to do so, electronically. Electronic delivery should be made by email to litigationamend@ipo.gov.uk or on an electronic carrier (such as a floppy disc or a CD-R) delivered to this Office and accompanied by an identifying letter. The amendments should be presented in a way that clearly identifies them. When delivered electronically the conventional word processing features such as mark up, coloured text and strikeout/strikethrough should be used to set out the amendments on the original version of the text.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 3

c/o

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

Direct Line: 01633 81xxxx
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Internet: [Http://www.ipo.gov.uk](http://www.ipo.gov.uk)

Your Reference:
Our Reference: 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: EP xxxxxxx (Proprietors Name)
Application to amend the specification of a patent under Section 27 of the Patents Act 1977.

Notice of your application to amend will be advertised for opposition in the Patents and Designs Journal on xx. Xxxxxx xxxx. * As the proposed amendments have been filed electronically, they will also appear on our website from xx. Xxxxxx .xxxx

The opposition period will run for two months from the date of advertisement.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

*Text here is optional but should be included if amendments filed electronically.

ANNEX 4

c/o

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

Direct Line: 01633 81xxxx
E-mail: xxxxxx@ipo.gov.uk
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Internet: [Http://www.ipo.gov.uk](http://www.ipo.gov.uk)

Your Reference:
Our Reference: 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: EP xxxxxxx (Proprietors Name)
Application to amend the specification of a patent under Section 27 of the Patents Act 1977.

Notice of your application to amend will be advertised for opposition in the Patents and Designs Journal on xx. Xxxxxx xxxx. *As the proposed amendments have been filed electronically, they will also appear on our website from xx Xxxxxx xxxx.

The opposition period will run for two months from the date of the advertisement.

The amendment appears *prima facie* allowable subject to any opposition, but may be negated as a result of any subsequent amendment before the EPO.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

*Text here is optional but should be included if amendments filed electronically.

ANNEX 5

c/o

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

Direct Line: 01633 81xxxx
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](http://www.ipo.gov.uk)

Your Reference:
Our Reference: 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: GB xxxxxxx (Proprietor's Name)
Application to amend the specification of a patent under Section 27 of the Patents Act 1977.

I am pleased to inform you that the amendment requested on xx. Xxxxxx .xxxx has been allowed.

The amendment will be published as a C specification. A copy of this will be sent to you by our Publishing Section (Tel No. 01633 814876) in due course.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 7

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 XXXXXXXXXXXXXXXXXXXX	H04G	XXXXXXXXXXXXXX X
75	3215 29 Jan 03	2 months	2124567 XXXXXXXXXXXXXXXXXXXX	G22F	XXXXXXXXXXXXXXXX
75	3214 22 Jan 03	14 days	2456789 XXXXXXXXXXXXXXXXXXXX	A69B	XXXXXXXXXXXXXXXX HC 123456 XXXXXXXXXXXX, XXXXXXXXXX, XXXXXXXXXXXXXXXX