

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 2007 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) 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 the application 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.

EPC 2000 – Central Limitation Process

Following the introduction of the central limitation process, an EP (UK) patent may now be amended centrally at the EPO as well as in each individual contracting state. On receipt of a new s27, the Register Plus website <http://www.epoline.org/portal/public/registerplus> will need to be checked to determine whether there is a request to centrally limit an EP (UK) patent. If so, the applicant should be asked if he wishes a stay in proceedings to allow for conclusion of the process or wishes to proceed. A standard letter is issued offering these options. (see annex 9).

A file note should be added to the proceedings sheet as follows:

Official letter issued to attorney on XX.XX.XX. See copy on file. B/F for 1month (always to a Wednesday).

PECS:- Letter created, locked and imported from PROSE.

File note is created in Microsoft ® Word and imported using manual import (doc code is FILE NOTE-LIT).

DIRECTIONS FOR THE ELECTRONIC DELIVERY OF APPLICATIONS

17.03 Electronic delivery of amendments should be made either by e-mail to lifigationamend@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, 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.

ACTION ON RECEIPT OF THE AMENDMENTS

17.06 The A3 should undertake checks to ensure that all appropriate details are provided.

INITIAL ACTION – A1

17.07 The A3 will request the A1 to:

- make up a Litigation file (see Chapter 25) OR arrange for the application to be indexed and scanned as a PECS case

The A1 will also need to:

- enter the application in the electronic ledger
- make a free text entry on OPTICS using REG ENT – Application for amendment under section 27 filed on xxxxxxxxxx
- make up a movement card for the case (not required if case is a PECS case.)

PECS:- The A1 attaches a request for indexing and scanning to the application and sends it to the Index and Scanning section.

17.08 Where a paper file has been made up, it should be passed back to the Litigation *ex parte* team.

PECS:- The new case will be placed by Index and Scanning in the Ex parte team mailbox to be actioned by a member of the ex parte team.

INITIAL ACTION - FORMALITIES CHECKS - A3 DUTIES

17.09 The A3 carries out formalities checks to ensure that the relevant patent rule has been complied with (rule 35). Once any defects in the application have

been resolved with the applicant, an initial advert is prepared for the Journal. The advert is prepared whether or not formalities are complied with. This advert should be copied to the Journal folder on the H drive and a copy placed in the Journal file. The advert will appear in the Journal 3 weeks from the last Wednesday after the advert is prepared and submitted to Publishing. The case should then 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.

PECS:- Letter created, locked and imported from PROSE.

File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Advert is created and imported using manual import (doc code is ADVERT).

Formalities

17.10 The application for amendment is checked to ensure:

- the applicant's name is on the application, refer to 17.40
- a current address for service is provided in the UK, an EEA state or the Channel Islands,
if the AFS provided does not match the register, refer to 17.41
- documents referred to in the application have been submitted, refer to 17.42
- it identifies the proposed amendments and reasons for the amendment are given, refer to 17.44
- for EP patents, EP opposition period has expired or no opposition pending, refer to 17.47
- the application is correctly applied for as an amendment and not a correction, refer to 17.54
- the patent has been granted, refer to 17.55
- there is no outstanding revocation or infringement action, refer to 17.64
- that any documents given as supporting evidence and not

published in English are accompanied by a translation, refer to 17.68

- patent is not ceased, refer to 17.73
- for EP patents, the specification on file is the latest version - use Register Plus, refer to 17.02
- for EP patents, there are no central limitation proceedings ongoing, refer to 17.02

FORMALITIES COMPLIED WITH

17.11 The following procedure relates to an amendment where all formalities have been complied with. A file note should be added to the proceedings sheet as follows:

Formalities complied with, initial advert prepared for PDJ.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Advert is created and imported using manual import (doc code is ADVERT).

Referring the Application

17.12 Once all formalities have been complied with, the application should be referred to the Deputy Director in charge of the subject matter to which the specification relates. A minute should be added to the proceedings sheet as follows:

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

PECS:- To refer a case to the DD, create, lock and import minute on PROSE (doc code MINUTE-LIT), then create and send a “PSM – s27” message to the DD

Deputy Director's Report For GB & EP (UK) Patents

- 17.13 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.
- 17.14 The reasons for the amendments have to be sufficient and the proprietor is under an obligation to show that they meet all the legal requirements.

AMENDMENTS ARE *PRIMA FACIE* ALLOWABLE

- 17.15 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. If the report states that the amendments are not allowed, refer to 17.74 or are not to be proceeded with, refer to 17.79.

The A3 Litigation Officer should:

- Complete the Journal notice (see annex 6). This will need to be completed if the application is filed electronically or in paper form.
- Complete the summary listing in the Section 27 Journal folder on the H drive indicating whether the amendments have been filed electronically or in paper form.
- Issue S27(a) letter (see annex 3) advising the applicant when the notice of proposed amendments will be advertised in the Journal or S27(b) letter (see annex 4) for EP(UK) cases where EP opposition proceedings are pending. The opposition period lasts four weeks from the date of the published advert in accordance with section 27(5) and rule 75.

PECS:- Advert is created and imported using manual import (doc code is ADVERT).

Letter created, locked and imported from PROSE.

- 17.16 When the weekly entries for the PDJ are compiled, the electronic amendments will be sent to "webmaster". The summary listing table (annex 7) should accompany the amendments and webmaster must be advised of the date of the journal that the "notice" will appear in.
- 17.17 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 Litigation Section upon request. These should be issued by fax or post as appropriate.
- 17.18 A copy of the advert is placed on the patent file, behind the minute sheet and in the Journal file. The date the advert will appear in the Journal should be entered on the front copy of the advert.
- 17.19 A file note recording the action taken should be added to the proceedings sheet as follows:

Official letter sent to attorney on XX.XX.XX, see copy on file. Notice will appear in Journal dated XX.XX.XX. B/F for four weeks and 2 weeks from the date of advert for opposition. (Always to a Wednesday).

Update DairyL.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

- 17.20 If opposition is filed, refer to 17.92. If no opposition is filed proceed to amend the specification.

APPLY AMENDMENTS & CERTIFICATES

- 17.21 Where no opposition has been received or opposition proceedings concluded, the proposed amendments should be made in the original

specification.

- 17.22 The amendments should be applied in red ink where no replacement page or specification has been filed and the amendments are minor. 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 of the specification if the amendments are textual, (this includes any amendments to the Bibliographic page), or the last page of the drawings if the amendment is to the drawing.

PECS:- Use the assemble and enhancer function to apply the amendments.

- 17.23 If the amendments are extensive and no replacement specification has been filed, one may be requested from the attorney. Issue letter S27(f) (see annex 8).

PECS:- Letter created, locked and imported from PROSE.

- 17.24 Any replacement specifications should be checked by the A3 to ensure that the amendments made are in fact the same as those allowed by the Deputy Director. A file note should be added to the proceedings sheet as follows:

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

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

- 17.25 Appropriate certificates should be applied to both the original and the replacement specification.

- 17.26 The file should be referred to the Deputy Director for the certificate to be signed. A minute should be added to the proceedings sheet as follows:

No opposition has been received. The B specification has been amended with the allowed amendments and the certificate is submitted for your signature only/PECS:- Please can you authorise that your electronic signature can be applied to the appropriate certificate.

PECS:- Create, lock and import a minute from PROSE (doc code is MINUTE-LIT), then create and send a “PSM – s27” message to DD

FILE RETURNED FROM DEPUTY DIRECTOR WITH CERTIFICATE SIGNED

17.27 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 with the date of the letter, or in the case of a hearing, the date of the decision.

PECS:- Once a message is received from the DD, the appropriate certificate should be pasted into a Word document, a DD electronic signature applied and the certificate imported using manual import (doc code is CERTIFICATE)

17.28 The following file note should be added to the proceedings sheet as follows:

Amendments allowed on XX.XX.XX (date of clear records). O/L issued (insert date), copy on file. Clear records.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Letter created, locked and imported from PROSE.

CLEAR RECORDS – AMENDMENTS ALLOWED

17.29 Once the applicant has been informed of the outcome of the application,

clear records action may be undertaken. An advert should be prepared for the Journal and the electronic 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. The movement card should be destroyed.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Final advert

17.30 A final advert should be prepared for the PDJ. This advert should be copied to the Journal folder on the H drive and a copy placed in the Journal file. The advert will appear in the Journal 3 weeks from the first Wednesday after the advert is prepared and submitted to publishing.

PECS:- Advert is created and imported using manual import (doc code is ADVERT).

Electronic Ledger

17.31 The relevant entry in the ledger under section 27 should be updated to show the outcome of the application and the date of the clear records action.

OPTICS entry

17.32 A free text entry should be made on OPTICS indicating the outcome of the application. Use the REG ENT OPTION as follows:-

Application for amendment under Section 27 filed on XX.XX.XX allowed on XX.XX.XX.

17.33 The DIS FUL facility on OPTICS should then be used to print a copy of the register entry. This should be placed on file.

File referred to Publishing Section/NMP

- 17.34 If the amendments have been allowed, a request is made to Publishing Section for a 'C' specification. If the C specification was amended, then a C2 is requested.
- 17.35 (Deleted).
- 17.36 (Deleted).
- 17.37 (Deleted).
- 17.38 The Clear Records sheet should be attached to the proceedings file and the proceedings file placed at the back of the main patent file.
- 17.39 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.

PECS:- Create, lock and import a minute from PROSE (doc code is MINUTE-LIT), giving details of the amendments, then create and send a "PSM – Amendment allowed" message to the Publishing Team Mailbox.

FORMALITIES NOT COMPLIED WITH

Applicant does not match registered proprietor

- 17.40 The application should be cross-referenced with the OPTICS - DIS FUL printout (front of proceedings file). Where there is a discrepancy, the attorneys should be contacted to check proprietorship.

New attorneys

- 17.41 If new attorneys have been mentioned on the application, a Patents Form

51 is required. However, if they are only authorized to act with regard to the amendment, no form is necessary. Only correspondence relating to the amendment will be sent to the attorney named on the request and the address for service on the register will remain the same.

Copies of documents

17.42 Copies of any documents referred to in the application, 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 82 (1) (a) of the relevant patent rules, before the application is referred to the Deputy Director. A period of one month should be given for reply.

17.43 The Patent Rules provide an additional automatic extension of two months for periods not specified in the rules. This may be applied for retrospectively. As a result, the case should be diaried for one month and a further two months from the date of the letter. The movement sheet on the front of the file should be marked with the (B/F) date. DiaryL should also be updated.

PECS:- Letter created, locked and imported from PROSE.

File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Proposed amendments identified and reasons for amendment given

17.44 The A3 should check that the amendments proposed have been identified and the reasons for amendment have been given before referring the application to the Deputy Director. If these have not been supplied, the attorney must be contacted and requested to file the necessary documents.

EP opposition period

17.45 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. To determine the status of opposition proceedings a print is obtained from the EP on-line register.

- 17.46 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 27.05.1). Therefore action under section 27 with regard to those amendments is not necessary.

Opposition Period has not expired and/or opposition proceedings are pending

- 17.47 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. An applicant may write to inform us that he is aware of the situation but wishes to proceed regardless. Applicants are usually aware that the amendments may be negated as a result of subsequent amendment before the EPO. The file should be referred to the Deputy Director and should contain the following minute note:

Although the opposition period has not yet expired/the opposition proceedings are pending (delete as appropriate), the attorneys state in their letter dated XX.XX.XX, that they wish to proceed regardless. Case referred for report under Section 27 of the 1977 Act.

PECS:- Create, lock and import minute from PROSE (doc code is MINUTE-LIT), then send a "PSM – s27" message to DD

- 17.48 Where the applicant has not sent us a letter acknowledging that the

opposition period has not yet expired and/or opposition proceedings are pending, a standard letter s27c (see annex 1) is issued giving the applicant the option of either:

staying the request until the opposition period has expired or the opposition proceedings have been settled

or

proceeding with the request under Section 27 on the understanding that the desired amendment may be negated as a result of the subsequent amendment before the EPO.

17.49 The minute sheet should contain the following file note:

Official letter issued to attorney on XX.XX.XX. See copy on file. B/F for 1month (always to a Wednesday).

17.50 Section 117(B) of The Patent Act 1977 provides for an additional automatic extension of two months for periods specified by the Office. This may be applied for retrospectively. As a result, the case should be diaried for one month and a further two months from the date of the letter. The movement sheet on the front of the file should be marked with the (B/F) date. DiaryL should also be updated.

PECS:- Letter created, locked and imported from PROSE.

File note is created and imported using manual import (doc code is FILE NOTE-LIT).

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

Attorneys 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.XX.XX.XX

PECS:- A request for index and scanning is attached to the letter and sent to the Index and Scanning Section. When placed by Index and Scanning in the Ex-parte mailbox, a member of the ex-parte team will create, lock and import minute from PROSE (doc code MINUTE-LIT), then send a “PSM - Amendment stayed” message to DD

On return from the Deputy Director, B/F the case until the expiry date of the opposition period, or until the opposition proceedings have been settled. During this period, an Official Letter should be issued every 6 months requesting updates on the proceedings. Update DiaryL. 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 para 27.07 MOPP).

PECS;- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then send a “PSM – s27” message to DD

If the applicant wishes to proceed:

17.53 A minute note should be added to the proceeding sheet as follows:

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

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then send a “PSM – s27” message to DD

Is the application an Amendment or a Correction?

17.54 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.

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then send a “PSM – s27” message to DD

Has the patent been granted?

17.55 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

17.56 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.

17.57 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).

PECS:- To refer to Formalities, create, lock and import a minute from PROSE (doc code is MINUTE-LIT), then send a “PSM – Amendment” message to the relevant Formalities Team Mailbox

17.58 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.

17.59 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.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Letter created, locked and imported from PROSE

EP cases

17.60 An application to amend under section 27 cannot take place until the fact that the patent has been granted is published. This date affects all provisions of the Act from section 25(1) onwards.

17.61 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.

17.62 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.

17.63 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. Update DiaryL.

Outstanding Revocation or Infringement Action

- 17.64 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.
- 17.65 To check proceedings against a GB or EP (UK) patent, you should check the below the line entries from the OPTICS - DIS FUL printout (front of proceedings file) and any correspondence concerning the patent.
- 17.66 Where a European patent (UK) is undergoing opposition proceedings before the EPO, amendment may still proceed under section 27 (see paragraph 17.47).
- 17.67 If the applicant wishes to stay the proceedings until court action has been finalised, the file should be put in the B/F run until the Court action is completed. When the Court action has been completed, the application may proceed as long as all formalities are complied with. A minute 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.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Letter created, locked and imported from PROSE

Non-English Documents & Translations

- 17.68 Any documents filed as supporting evidence and not published in English should be accompanied by a copy of a translation in accordance with rule 113
- 17.69 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 (the filing of a translation) has been filed.
- 17.70 If a translation has been filed, the EP file in question should be requested from NMP. The translation and accompanying Patents Form 54 will be found in the main EP file.
- 17.71 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. 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 one month.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Letter created, locked and imported from PROSE

- 17.72 The Patents Rules provide an additional automatic extension of two months for periods not specified in the rules. This may be applied for retrospectively. as a result, the case should be diared for one month and a further two months from the date of the letter. The movement sheet on the front of the file should be marked with the (B/F) date. DiaryL should also be updated.

Patent Ceased

- 17.73 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.

PROBLEMS ARISING FROM REFERRAL OF AMENDMENTS TO THE DEPUTY DIRECTOR

Amendments not *prima facie* allowable

- 17.74 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 any amendments which he/she considers should also be submitted. An e-mailed version of the report 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.
- 17.75 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 and a further 2 months for a reply (see annex 2).
- 17.76 Section 117(B) of The Patents Act 1977 provides for an additional automatic extension of two months for periods specified by the Office. This may be applied for retrospectively. As a result, the case should be diaried for 2 months and a further 2 months from the date of the letter. The movement

sheet on the front of the file should be marked with the (B/F) date. DiaryL should also be updated.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Letter created, locked and imported from PROSE

- 17.77 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:

Attorneys 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.

PECS:- Create, lock and import a minute from PROSE (doc code is MINUTE-LIT), then send a “PSM – Response to report” message to DD

- 17.78 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.

- 17.79 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.

PECS:- Advert is created and imported using manual import (doc code is ADVERT).

Letter created, locked and imported from PROSE.

File note is created and imported using manual import (doc code is FILE NOTE-LIT).

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

PECS:- To refer to the hearing team, create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – set up hearing” message

If the applicants accepts the Deputy Director’s decision, records can be cleared, refer to 17.87

Amendments not proceeded with

17.80 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.

17.81 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. 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.

17.82 The A3 should issue an official letter to the applicant informing him of the Deputy Director’s decision. The wording may be supplied by the Deputy Director.

PECS:- Letter created, locked and imported from PROSE.

File note is created and imported using manual import (doc code is FILE NOTE-LIT).

The next action involves clearing records, refer to 17.87

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 (see 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:

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

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then send a “PSM – s27 withdrawal” message to DD

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 Directors’ decision.

PECS:- Letter created, locked and imported from PROSE.

File note is created and imported using manual import (doc code is FILE NOTE-LIT).

17.86 If a withdrawal is allowed, the applicant should again be informed of the Deputy Director’s decision.

PECS:- Letter created, locked and imported from PROSE.

File note is created and imported using manual import (doc code is FILE NOTE-LIT).

The next action involves clearing records, refer to 17.87

CLEAR RECORDS – NOT ALLOWED/NOT PROCEEDED WITH/WITHDRAWN

17.87 Once the applicant has been informed of the outcome of the application, clear records action may be undertaken. An advert should be prepared for the Journal and the electronic ledger and OPTICS updated. The movement card can be destroyed. The proceedings sheet should be updated with all the actions taken.

PECS:- File note is created and imported using manual import (doc code is FILE NOTE-LIT).

Final advert

17.88 An advert should be drafted manually corresponding with the decision or directions of the Deputy Director. The advert should be copied to the Journal folder on the H drive and a copy placed in the Journal file.

PECS:- Advert is created and imported using manual import (doc code is ADVERT).

Electronic Ledger

17.89 The relevant entry in the electronic ledger under section 27 should be updated to show the outcome of the application and the date of the clear records action.

OPTICS entry

17.90 A free text entry should be made on OPTICS indicating the outcome of the

application. Use the REG ENT option as follows:-

Application for amendment under Section 27 filed on XX.XX.XX not proceeded with/not allowed/withdrawn on XX.XX.XX.

The DIS FUL facility on OPTICS should then be used to print a copy of the register entry. This should be placed on file.

File sent to NMP for storage

- 17.91 Where the amendments have not been allowed, not proceeded with or have been withdrawn or in circumstances where it is not necessary to issue a 'C' print, the file should be sent straight to NMP. The Clear Records sheet is attached to the proceedings file with the reference to Publishing Section removed and the proceedings file placed at the back of the main file. A minute on the front movement sheet of the file refers the file to NMP for storage.

OPPOSITION FILED

- 17.92 Notice of opposition should be filed on Patents Form 15 within four weeks of the date of the notice of the proposed amendments in the Journal. This period may not be extended.
- 17.93 The opposition should be referred to the B3, with an appropriate minute. It will then be processed as an *inter partes* case.

PECS:- To refer to B3, create, lock and import minute from PROSE (doc code MINUTE-LIT), then send a "PSM – Opposition filed" message

EXTENSION OF TIME

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

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

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then send a “PSM – EOT request” message to DD

- 17.95 The applicant should be advised of the Deputy Director’s decision and a note of the action taken entered on the proceedings sheet.

PECS:- Letter created, locked and imported from PROSE.
File note is created and imported using manual import (doc code is FILE NOTE-LIT).

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

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 .

You are advised that 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 advise me of your decision regarding the above by 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
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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 (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. The amendments should be presented in a way that allows for them to be identified.

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
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: 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

A four week period from the date of advertisement will be allowed for any opposition to the proposed amendment.

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
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: 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.

A four week period from the date of the advertisement will be allowed for any opposition to the proposed amendment.

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
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 xxxxxxxx (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 08	four weeks	2345678 XXXXXXXXXXXXXXXXXXXX	H04G	XXXXXXXXXXXXX X
75	3215 29 Jan 08	two weeks	2124567 XXXXXXXXXXXXXXXXXXXX	G22F	XXXXXXXXXXXXX
75	3214 22 Jan 08	14 days	2456789 XXXXXXXXXXXXXXXXXXXX	A69B	XXXXXXXXXXXXX HC 123456 XXXXXXXXXXXX, XXXXXXXXXX, XXXXXXXXXXXXX

ANNEX 8

c/o

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

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

Your Ref:

Our Ref:

Date

Dear Sirs,

Patent number:EP (Proprietor Name)

Application to amend the specification of a patent under Section 27 of the Patents Act 1977.

No opposition has been filed in connection with the above application. However, the amendments are extensive and, in accordance with rule 35(6), a clean version of the retyped specification incorporating all agreed amendments should be filed within one month from the date of this letter.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 9

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
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 .

On checking the European Patent Office register, it appears that you have filed an application to centrally limit your patent at the EPO. In these circumstances there are two options available to you

- a. staying the request until the conclusion of the central limitation process, or
- b. proceeding with the request to amend under Section 27

If the national and central process results in different amended claims, you should be aware that there may be an issue as to which amendment takes precedence.

You should advise me of your decision regarding the above by xx. Xxxxx. xxxx .

Yours faithfully

Your Name
Litigation Section
Patents Directorate