

CHAPTER 18

SECTION 29 SURRENDER OF PATENTS

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18 SECTION 29, SURRENDER OF PATENTS

INTRODUCTION

18.01 This section provides for the proprietor to offer to surrender a patent, including a European patent (UK), and for opposition by a third party to an offer to surrender. Procedures are prescribed by the Patents Rules 2007 (see rule 42). It is not necessary for the proprietor to file a form or pay a fee when applying to surrender a patent.

18.02 The offer to surrender should comprise:

- a declaration that no action is pending before the Court for infringement or for revocation of the patent or
- if an action before the Court is pending, full particulars of the action in writing

18.03 If there is an action before the Court for infringement or revocation or no declaration is filed, the appropriate Deputy Director should be consulted.

INITIAL LITIGATION SECTION ACTION - A1 DUTIES

18.04 All offers to surrender are processed electronically on PECS. On receipt of an offer to surrender, the A3 will request the A1 to:

- arrange for the application to be indexed and scanned as a PECS case.
- enter the application in the electronic ledger
- make a free text entry on OPTICS using REG ENT

The A1 attaches a request for index and scan to the application and sends it to the Index and Scanning section.

18.05 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 LITIGATION SECTION ACTION - A3 DUTIES

18.06 Deleted

Formalities Checks

18.07 The offer to surrender should be checked to ensure the following details are present:

- the patent number
- the proprietors full name and address
- the relevant section of the act
- an Address for Service in the UK, an EEA state or the Channel Islands
- signature
- contact name and telephone number

18.08 The A3 should check the relevant details against the OPTICS print. The A3 should also check that no section 72 or section 73(2) action is outstanding and that the A1 has made the relevant section 29 register entry. If an outstanding section 72 action is found, the case should be referred to the Deputy Director of the subject matter. If an outstanding section 73(2) action is found, reference should be made to MOPP 73.09 and 73.11.

The A3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – S29 outstanding revocation” message to the DD.

Initial Journal Advert and Subsequent Action

18.09 Once all the requirements have been met, a Journal advert should be prepared as follows:

Section 29
Surrender of Patent

Offer to Surrender

Any person may give notice of opposition to the surrender of the following patent(s) by filing a Patents Form 15 within four weeks from the date of publication of this Journal.

Patent Number	PROPRIETORS NAME
	Title

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

- 18.10 The proprietor/attorney should be sent a letter (see annex 1) informing them when the advert will appear in the Journal and advising them of the four week opposition period. A file-note should be prepared as follows:-

File Note

Formalities complied with.

O/L issued on XX.XX.XX informing proprietor/attorney of advert in Journal dated XX.XX.XX

B/F XX.XX.XX (This date should be four weeks after the Journal date to the nearest Wednesday)

Letter created, locked and imported from PROSE.

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

OFFER TO SURRENDER ACCEPTED - NO OPPOSITION FILED

- 18.11 Once the opposition period has lapsed, and providing no opposition has been filed, a decision to accept the offer to surrender (see annex 2) should be prepared and authorisation to add the relevant Deputy Directors

signature requested. The unsigned decision should be manually imported onto PECS and annotated accordingly.

The A3 will create, lock and import a Minute on PROSE (doc code is MINUTE LIT) then create and send a “PSM – s29 Please can you authorise the decision.” message to the DD.

18.12 Once the decision has been approved by the DD, it is dated and an electronic DD signature applied.

18.13 A covering letter (see annex 3) should be prepared. The letter and the decision should be sent to the proprietor/attorney.

Letter created, locked and imported from PROSE

18.14 A file note should be prepared as follows:

File Note

Decision issued on xxXXxx. Patent surrendered on xxXXxx (final advert Journal date)

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

CLEAR RECORDS

18.15 To clear records an advert should be prepared for the Journal. The section’s electronic ledger should be updated to show the date of surrender. The surrender also needs to be registered on OPTICS. The clear records template on Word (see Annex 4) should be used as a checklist.

Final Journal Advert

18.16 The following advert should be prepared for the Journal:

Section 29

Surrender of Patent

Offer to Surrender Accepted by the Comptroller

The effective date of the surrender of the patent is the date of this Journal.

Patent Number	PROPRIETORS NAME
	Title

The date of the Journal advert should be entered on the clear records template (see annex 4). This date is important as it is the effective date of the surrender.

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

Electronic Ledger

18.17 Update electronic ledger with the date the surrender was accepted (date of PDJ) and the date of clear records.

18.18 (Deleted)

OPTICS Entry

18.19 OPTICS should be updated to show that the patent has been surrendered and is therefore no longer in force.

- Select option 17 on the Main Revocations Section Menu
- Type in the patent number
- Enter the filing date of the offer to surrender and the date the surrender offer has been accepted (final advert Journal date)
- The entry will then appear for you to check, if correct enter Y, if

incorrect enter N and repeat the above

18.20 (Deleted)

OPPOSITION FILED

18.21 If an opposition is filed on Patents Form 15, the case should be referred to the B3. The case will then become an *inter partes* case, and will be subject to Part 7 of the Patent Rules 2007.

The A3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – S29 Opposition filed” message to B3.

ANNEX 1

c/o

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

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

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

Date

Dear Sirs

**PATENT NO GB xxxxxxxx (PROPRIETOR'S NAME)
OFFER TO SURRENDER UNDER SECTION 29(1)**

I write to inform you that your offer to surrender filed on xxXXxx, will be advertised in the Patents and Designs Journal to be published on xxXXxx.

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

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 2

Date

PATENTS ACT 1977

PROPRIETOR	<i>Proprietor's Name</i>	
ISSUE	Acceptance of offer to surrender Patent No. GB/EPxxxxxxx under Section 29	

DECISION

- 1 *Proprietor's Name*, the patentees of Patent Number *GB/EP xxxxxxx*, granted on *xx Xxx xxxx*, gave notice to the Comptroller on *xxXXxx*, of an offer to surrender the patent. In accordance with Rule 75 of the Patents Rules 2007, the offer was advertised in the Patents and Designs Journal on *xx Xxx xxxx*. No notice of opposition was given within the four week period prescribed by Rule 76(2) (b).
- 2 I therefore accept the said offer. In accordance with Section 29(3), the patent will cease to have effect from the date when the notice of this acceptance is advertised in the Patents and Designs Journal, namely

Name of Deputy Director

Deputy Director, acting for the Comptroller

ANNEX 3

c/o

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

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

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

Date

Dear Sirs

**PATENT NO GB xxxxxxxx (PROPRIETOR'S NAME)
OFFER TO SURRENDER UNDER SECTION 29(1)**

Please find enclosed acceptance of your offer to surrender the above patent filed on xxXXxx. A notice of acceptance will be published in the Patents and Designs Journal on xxXXxx.

The patent will be surrendered and will cease to have effect as from the date the notice of the acceptance is published in the Journal.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 4

Reference **GB xxxxxxxx**

1. Clear Records

DATE	xxXXxx
PDJ	xxXXxx
ELECTRONIC LEDGER	
OPTICS	
O/L ISSUED	

ANNEX 5

c/o

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

Direct Line: 01633 81xxxx

E-mail: xxxxxxxxxxxx

Switchboard: 01633 814000

Fax: 01633 814491

Minicom: 08459 222250

DX: 722540/41 Cleppa Park 3

Internet: www.ipo.gov.uk

Your Reference:

Our Reference: 3Y31/Name/File Reference

Date

Dear Sirs

**PATENT NO GB xxxxxxxx (*PROPRIETOR'S NAME*)
OFFER TO SURRENDER UNDER SECTION 29(1)**

Thank you for your letter dated xxXXxx requesting the above patent be abandoned/withdrawn/not validated. Unfortunately this is not an option we can offer, but you may take the following action:

The proprietor can apply to surrender the patent under Section 29 of the Patents Act. In order to do this they must provide:

- (a) A declaration that no infringement or revocation action relating to the patent is pending before the court;
- (b) If such action is pending, full particulars of the action in writing.

Alternatively, the proprietor may discontinue paying any renewal fees, allowing the patent to lapse.

Please reply on how you intend to proceed by no later than xxXXxx.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

December 2010