

## 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 On receipt of an offer to surrender, 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
- make up a movement card for the case (not required if case is a PECS case)

**PECS:-** The A1 attaches a request for index and scan to the application and

sends it to the Index and Scanning section.

18.05 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 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 DIS FUL OPTICS print on file. 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.

**PECS:-** 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.

<b>Patent Number</b>	PROPRIETORS NAME
	Title

**PECS:-** 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 copy of this letter should be put on the correspondence part of the file and a file note added to the proceedings sheet 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)

The B/F date should also be put on the front cover of the file. The file

should then be put in the B/F run. DiaryL should 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).

### **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 sent to the Deputy Director of the group to which the subject-matter of the patent belongs for his/her signature.

**PECS:-** 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 When the file is returned, the decision should be dated.

**PECS:-**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. A copy of the letter should be placed on the correspondence part of the file with the **original** decision. The **original** letter and a **copy** of the decision should be sent to the proprietor/attorney.

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

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

File Note

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

**PECS:-** 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. A clear records sheet (see annex 4) should be used as a check list. The file is then sent to NMP for storage.

### 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.

<b>Patent Number</b>	PROPRIETORS NAME
	Title

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

**PECS:-** 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.

### Movement Card

18.18 The movement card should be destroyed.

### 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

A DIS FUL print should be placed on the file.

### NMP

18.20 Having cleared all records, the proceedings file should be inserted at the back of the main patent file and sent to NMP.

### **OPPOSITION FILED**

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

**PECS:-** 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

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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>

**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 xx Xxx xxxx, will be advertised in the Patents and Designs Journal to be published on xx Xxx xxxx.

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 *xx Xxx xxxx*, 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

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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>

**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 xx Xxx xxxx. A notice of acceptance will be published in the Patents and Designs Journal on xx Xxx xxxx.

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	xx Xxx xxxx
OJP	√ (xx Xxx xxxx)
RECORD (LEDGER) BOOK	√
MOVEMENT CARD	√
OPTICS	√

### 2. NMP

File to store