

CHAPTER 19

SECTION 47 CANCELLATION OF LICENCE OF RIGHT

| | |
|--|---------------|
| Introduction | 19.01 |
| Application by proprietor | 19.02 - 19.21 |
| Action by Litigation Assistant A1 | 19.03 - 19.05 |
| Action by Litigation Officer A3 | 19.06 - 19.10 |
| Opposition filed | 19.11 - 19.12 |
| No opposition filed | 19.13 |
| Cancellation of the licence of right | 19.14 - 19.16 |
| Clear records | 19.17 - 19.21 |
| Application by other persons | 19.22 - 19.31 |
| Action by Litigation Assistant A1 | 19.24 |
| Action by Litigation Officer A3 | 19.25 - 19.27 |
| Proprietor opposes the application | 19.28 |
| No opposition filed | 19.29 |
| Cancellation of the licence of right allowed | 19.30 - 19.31 |

Annexes

| | |
|---------|------------------------------|
| Annex 1 | Initial advert (Proprietor). |
| Annex 2 | S 47a letter |
| Annex 3 | S 47b letter |
| Annex 4 | Final advert |
| Annex 5 | Initial advert (Third Party) |

19 SECTION 47 CANCELLATION OF LICENCE OF RIGHT

INTRODUCTION

19.01 This section provides for the cancellation of an entry made originally in the register under section 46 i.e. that licences under a patent are to be available as of right. It also provides for opposition to the cancellation (see Section 47 of the MOPP).

Patents Act 1977

Section 47(1)

At any time after an entry has been made under section 46 in respect of a patent, the proprietor of the patent may apply to the comptroller for cancellation of the entry.

APPLICATION BY PROPRIETOR

19.02 An entry in the Register that licences under a patent are available as of right, allows renewal fees to be paid at 50% of the total fees. The proprietor of the patent may apply for the cancellation of the “licence of right” (LOR) entry at any time after it has been made. However, if that endorsement is cancelled those reduced fees have to be made up. An application should be made on Patents Form 30/77 and should be accompanied by the back fees payable, as prescribed in section 47(2).

Section 47(2)

Where such an application is made and the balance paid of all the renewal fees which would have been payable if the entry had not been made, the comptroller may cancel the entry, if satisfied that there is no existing licence under the patent or that all licencees under the patent consent to the application.

Action by Litigation Assistant A1

19.03 On receipt of a Patents Form 30/77, the A1 should enter the application in the electronic ledger and make up a movement card. The A1 will make an entry on the register using REG ENT as follows:

“Application by the proprietor to cancel Licence of Right entry under Section 47(1) filed on XX.XX.XX”

19.04 To obtain a European patent (UK) file, follow procedures in Chapter 25.

19.05 The form and patent file should then be passed to the ex parte team.

Action by Litigation Officer A3

19.06 The A3 should carry out the following checks on the Patents Form 30/77:

- The Applicant under section 47(1) is the proprietor
- The Patents Form 30/77 is signed
- The form includes a declaration that there is no existing licence under the patent or that all licensees consent to the application.
- That the address for service matches the Register. If not request a Patents Form 51/77 in order for this to be updated.

19.07 (Deleted)

19.08 The A3 should prepare an initial advert (see annex 1) for the Patents and Designs Journal (PDJ). The advert informs third parties that an application has been made by the proprietor and gives any third parties two months to file an opposition on Patents Form 15/77 should they wish to do so.

19.09 The A3 should issue letter reference s47a (see annex 2) which advises the proprietor of the date when the advert is going to be published in the Journal and the opposition period.

19.10 The A3 should make a file note as follows:

File Note

Formalities complied with, initial advert generated. Official letter issued, copy on file.

The A3 should diary (b/f) the file for two months from the date of advert to await any opposition. DiaryL should be updated.

Opposition filed

19.11 Notice of opposition should be filed on Patents Form 15/77 within two months of the advert in the Journal. The two month opposition period is not extendable. A statement should also be filed within 14 days of the Patents Form 15/77. However this period may be extended.

19.12 If an opposition is filed, the case will be referred to the B3, with an appropriate file note. It will then be processed as an *inter partes* case.

No opposition filed

19.13 Where no opposition is filed, the A3 should refer the file to the Renewal Section to calculate and process the back payment of renewal fees . The A3 should write a note to Renewal Section as follows:

File Note

An application to cancel an entry in the Register that licences under patent are available as of right for patent number was filed The application was advertised on XX.XX.XX for opposition and no opposition has been received. The file is now referred to you in order to calculate and request payment of the back fees.

Once the fees have been recorded on the renewal screens please refer the case back to me.

Cancellation of the licence of right

19.14 When the file is returned from Renewals Section, the A3 should check the OPTICS - DIS HIS screen to ensure that the back fee payments have been recorded. A printout of the screen should be placed on the file and the file referred to the B3 with the following minute note:

Head of Litigation (name)

An application to cancel an entry in the register that licences under the patent are available as of right, for patent number.....was filed on XX.XX.XX. The back dated fees have been paid, please see OPTICS - DIS HIS printout. The file is now referred to you to cancel the LOR.

19.15 The B3 will then make the appropriate register entry by carrying out the following OPTICS action, and, will cancel the LOR.

- From OPTICS main menu choose option 12 Revocations Section Menu.
- From Revocations Section menu choose option 12 Register Licences Of Right.
- From screen REG LIC Ø enter publication/application number.
- From screen REG LIC 1 enter "2" in the selection field, today's date in Date of Decision field, B3 in authority for Register Entry field.
- From screen REG LIC 2, enter "y" in "Register Entry correct?" field and "y" in "Supress PDJ Entry?" field. The PDJ entry needs to be suppressed as otherwise an incorrect entry will automatically be generated in the PDJ.
- Press "Enter" to record and exit.

The B3 should then minute the file back to the A3 confirming that the LOR entry has been cancelled and that a manual entry in the Journal needs to be

prepared (see 19.18).

- 19.16 On return of the file from the B3, the A3 should issue letter reference s47b (see annex 3) to the proprietor confirming the cancellation. The tear off slip on the Patents Form 30/77 should be completed, stamped and enclosed with the letter.

Clear records

- 19.17 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 (Annex 4), the electronic ledger updated with the date of the cancellation and movement card destroyed. A clear records stamp should be used on the minute sheet. This should be completed to indicate that all actions have been finalized. The file is then sent to NMP to store.

19.18 (Deleted)

19.19 (Deleted)

19.20 (Deleted)

19.21 (Deleted)

APPLICATION BY OTHER PERSONS

- 19.22 The comptroller makes a licence of right entry only if he is satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent. There is an opportunity, after an entry that licences are available as of right has been made, for cancellation to be applied for by persons other than the proprietor, for example an exclusive licensee, and/or others who claim that the proprietor was at the time of the entry precluded by a contract from granting licences.

An application by such a person should be made on Patents Form 2/77 within two months of the relevant entry being made in the register; this period cannot be extended. The application should be accompanied by a statement setting

out the nature of the claimant's interest. The statement can be filed at the same time as the Patents Form 2/77 or within 14 days of filing the application. (This 14 day period is extendable).

19.23 (Delete)

Action by Litigation Assistant A1

19.24 See 19.03 for procedures. The register entry should read

“Application by any person to cancel Licence of Right entry under Section 47(3) filed on XX.XX.XX”

Action by Litigation Officer A3

19.25 The A3 should carry out the following check on the Patents Form 2/77:

- The Patents Form 2/77 is signed and the fee has been paid.

19.26 The A3 should prepare an initial advert referring to section 47(3) (see annex 5) for the Journal.

19.27 The A3 should send a copy of the application and statement to the proprietor and confirm that the application is to be advertised in the Journal for opposition. The claimant should also be notified of the date that the application is advertised.

Proprietor Opposes the Application

19.28 Where the proprietor opposes the application by filing a Patents Form 15/77, the file should be referred to the B3, with a file note. The case will now proceed as an *inter partes* case.

No Opposition filed

19.29 Where no opposition is received, the file should be referred to the B3 to consider whether the proprietor is and was precluded by a contract in which the claimant is interested from granting licences under the patent (see section 47 of the MOPP).

Cancellation of the licence of right allowed

19.30 The B3 will report whether the application may be allowed. The A3 should inform the proprietor of the cancellation and set a period in which the back payment of renewal fees should be paid. If the fees are not paid, the patent will cease to have effect, the effective date being the date that the A3 sets for the payment to be made.

19.31 When payment of the back fees has been made, the A3 should send the file to the B3 who will then cancel the LOR entry (See 19.15 for action). On return of the file the A3 should advise the claimant and proprietor of the cancellation. Then clear records action may be undertaken (see 19.17).

ANNEX 1

INITIAL ADVERT

SECTION 47

Cancellation of Entry on the Register of a Licence of Right

Application under Section 47(1) by a Proprietor to cancel an Entry

Any person may give notice of opposition to the undermentioned Application by filing Patents Form 15/77 within two months from the date of publication of this Journal

Patent Number *PROPRIETOR'S NAME*

Title

Cancellation of entry on the Register of a Licence of Right filed on
XXxxxxXXXX

ANNEX 2

c/o

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

Direct Line: 01633 81xxxx
E-mail: xxxxxxxx@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: xxxxxxx (Proprietors Name)
Application to cancel an entry in the register that licences under the patent are available as of right under Section 47 of the Patents Act 1977

Your application to cancel an entry in the register will be advertised for opposition in the Patents and Designs Journal on xx.Xxxxx.xxxx,

A two month period from the date of advertisement will be allowed for the filing of any opposition to the proposed cancellation.

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: xxxxxxxx@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: xxxxxxx (Proprietors Name)

Application to cancel an entry in the register that licences under the patent are available as of right under Section 47 of the Patents Act 1977

Confirmation of cancellation

Your application to cancel an entry in the register was advertised in the Patents and Designs Journal on xx.Xxxxxx.xxxx and no opposition was filed within the two month period.

The application was therefore cancelled on xx.Xxxxxx.xxxx.

Yours faithfully

Your Name
Litigation Section
Patents Directorate

ANNEX 4

FINAL ADVERT

SECTION 47

Cancellation of Entry on the Register of a Licence of Right

Cancellation of Entry

Notice is hereby given that the Licence of Right entry on the Register for the following patent was cancelled on xxxxxxxxxxxxxxxx.

Patent Number *PROPRIETORS NAME*

Title

ANNEX 5

INITIAL ADVERT

SECTION 47

Cancellation of entry on the Register of a Licence of Right

Application under Section 47(3) by a Third Party to cancel an Entry

Any person may give notice of opposition to the following Application by filing Patents Form 15/77 within two months of the date of publication of this Journal

Patent Number *PROPRIETORS NAME*

Title

Cancellation of entry on the Register of a Licence of Right filed on
xxxxxxxxxxxxxxxx