

CHAPTER 19

SECTION 47 CANCELLATION OF LICENCE OF RIGHT

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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 repaid. An application should be made on Patents Form 30 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 All cancellations of LOR are processed electronically on Madras.

On receipt of a Patents Form 30, 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

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

19.05 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.

Action by Litigation Officer A3

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

- The Applicant under section 47(1) is the proprietor
- The Patents Form 30 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 in order for this to be updated.
- Address for Service provided in the UK, an EEA state or the Channel Islands.

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 four weeks to

file an opposition on Patents Form 15 should they wish to do so.

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

- 19.09 The A3 should issue letter 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.

Letter created, locked and imported from PROSE

- 19.10 The A3 should prepare a file note as follows:

File Note

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

The A3 should update DiaryL.

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

Opposition filed

- 19.11 Notice of opposition should be filed on Patents Form 15 within four weeks of the advert in the Journal. The four week opposition period is not extendable.

- 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.

The A3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – s47 Opposition filed” message to the

B3.

No opposition filed

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

Renewals Section

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 case 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.

The A3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM - Calculate/Record back fees” message to the Renewals Team mailbox..

Cancellation of the licence of right

19.14 When the case is referred back from Renewals Section, the A3 should check the OPTICS - DIS HIS screen to ensure that the back fee payments have been recorded. A minute should be prepared for the B3 as follows:-

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. Please cancel the LOR.

The A3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – s47 Cancel LOR” message to the B3.

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 “Suppress 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 send a message 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).

The B3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – LOR cancelled” message to Ex-parte Team mailbox.

19.16 Once the B3 has cancelled the LOR, the A3 should issue letter s47b (see annex 3) to the proprietor confirming the cancellation.

Letter created, locked and imported from PROSE.

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 (see annex 4) and the electronic ledger updated with the date of the cancellation. The clear records template in Word should be used. This should be completed to indicate that all actions have been finalized.

19.18 (Deleted)

19.19 (Deleted)

19.20 (Deleted)

19.21 (Deleted)

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

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 within two months of the relevant entry being made in the register (rule 43(4)); this period cannot be extended. The application should be accompanied by a statement (see rule 76(4)).

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

19.23 (Deleted)

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 xxXXxx”

Action by Litigation Officer A3

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

- The Patents Form 2 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.

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

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.

Letter created, locked and imported from PROSE

Proprietor Opposes the Application

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

The A3 will create, lock and import minute from PROSE (doc code MINUTE-

LIT), then create and send a “PSM – s47 Opposition filed” message to the B3.

No Opposition filed

- 19.29 Where no opposition is received, the case 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).

The A3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – s47” message to the B3.

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.

The A3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – s47” message to the A3.

Letter created, locked and imported from PROSE.

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

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

The A3 will create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – S47 Cancel LOR” message to B3.

The B3 will then create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – s47 LOR cancelled” message to Ex-parte Team mailbox.

Letter created, locked and imported from PROSE.

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

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

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 within four weeks 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 xxXXxx

ANNEX 2

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 number: xxxxxxxx (*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

I am writing to inform you that your application to cancel an entry in the register will be advertised for opposition in the Patents and Designs Journal on xxXXxx,

A four week 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: 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 number: xxxxxxxx (*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

I am writing to inform you that your application to cancel an entry in the register was advertised in the Patents and Designs Journal on xxXXxx and no opposition was filed within the four week period.

The Licence of Right entry on the Patents Register was therefore cancelled on xxXXxx.

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 xxXXxx.

<i>Patent Number</i>	<i>PROPRIETORS NAME</i>
	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 within four weeks 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 xxXXxx