

CHAPTER 20

CLAIM/COUNTERCLAIM FOR REVOCATION

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20 CLAIM/COUNTERCLAIM FOR REVOCATION

RECEIPT OF CLAIM FOR REVOCATION

20.01 The claim/counterclaim for revocation will normally be received together with the grounds of invalidity and an accompanying letter.

20.02 Once the claim/counterclaim for revocation is received in Litigation Section, it is passed to the ex-parte team to action as soon as possible. A free text entry is recorded on Optics as follows:-

Claim/Counterclaim for revocation lodged at the Patents Court on (insert date) (insert Action No).

A Journal entry is then prepared as follows:-

Claim/counterclaim for revocation lodged at the Patents Court on (insert date) (insert Action No.).

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

20.03 EP & GB patents are processed electronically on PECS (Patent Electronic Case System). If one does not already exist, an EP patent is allocated an EP Lit number which is used to create a dossier on PECS. The A1 enters the EP Lit number on the ledger and on Optics as a free text entry. The A3 then sends out a letter (see annexes 1 and 2) acknowledging receipt of the claim/counterclaim and letting the parties know that the claim/counterclaim has been recorded on the Office Register and advertised in the Journal. The letter is copied to the other parties to the proceedings, e.g. proprietor and any other interested parties.

Letter created, locked and imported from PROSE

A file note is then prepared noting all the actions completed.

The A3 will then request the A1 to:

- for EP cases, if no dossier exists on PECS allocate an EP Lit number
- for GB cases, if no dossier exists, call for the file from NMP. If there is no file for the EP, call for a BDOC and allocate an EP Lit number.
- arrange for the application (and file/BDOC, if necessary) to be indexed and scanned as a PECS case
- enter the application in the electronic ledger

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

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.

The case is then entered on DiaryL, setting a six month diary date.

If more than one claim or counterclaim for revocation is filed for the same patent but by another party, each claim or counterclaim should be recorded in the interest of clarity. In this scenario, the A3 should ensure that the register and the Journal advert clearly indicate the details of the party filing the action, e.g. filed by second defendant.

FOLLOW-UP PROCEDURE

20.04 At approximately six monthly intervals, a follow-up letter (see annex 3) should be sent by the A3, asking for any further progress.

Letter created, locked and imported from PROSE

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

NOTIFICATION OF THE OUTCOME OF THE CLAIM/COUNTERCLAIM

20.05 Notification of the outcome of the claim/counterclaim usually comes in the

form of a letter (often from the successful party). This is not sufficient to record the outcome and it will therefore be necessary to contact the party and ask for them to supply you with a copy of the sealed Court Order.

- 20.06 On receipt of a copy of the sealed Court Order, the A3 should record the outcome of the court proceedings on OPTICS. The outcome should also be advertised in the next available Journal. The entries may read for example as follows:

In an Order of the High Court dated (insert High Court number), the patent was revoked.

In an Order of the High Court dated (insert High Court number), the proceedings were stayed.

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

A letter should be issued by the A3 acknowledging receipt of the Court Order. This should be copied to the other party involved in the proceedings. For clear records see 20.15 – 20.19.

Letter created, locked and imported from PROSE.

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

STAYS

- 20.07 An Order revoking the patent may also contain an Order granting leave to appeal to the Court of Appeal. If this is the case any action may be stayed for 28 days. If an appeal is lodged, the stay may continue until such time as the appeal has been determined. **NB** If the Order contains notification of a stay it is important that this is included in any notice for the register and Journal since the stay will be suspending the order to revoke. Note on occasion some orders for stays will be Tomlin Orders and in this situation

the stay will discontinue the proceedings in the Court. Where such an Order is received, reference should be made to the B3 before records are cleared.

Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – Tomlin Order” message to B3.

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).

APPEAL TO THE COURT OF APPEAL AGAINST AN ORDER FOR REVOCATION

20.08 If an appeal is made to the Court of Appeal, the appellant must serve that appeal on the Comptroller. A Journal advert and OPTICS entry should be made accordingly. (For further details and any further appeal to the House of Lords see Chapter 6 on appeals).

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).

20.09 If the respondent decides not to oppose the appeal, or not to attend the appeal hearing, he must immediately inform both the Office and the appellant. He must also provide the Office with copies of the Claim for Revocation, any Statements of Claim and any written evidence filed with the claim.

20.10 The A3 should inform the appropriate Divisional Director of the appeal as soon as possible, as the Office must then advise the appellant whether or not a representative of the Office will attend the appeal. This should be within 14 days of receiving the notice of appeal. (Note: the appropriate Divisional Director will depend on the subject matter of the patent

concerned.)

Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – Appeal lodged” message to the DD.

20.11 [DELETED]

20.12 If the respondent withdraws his opposition to the appeal during the hearing the Court of Appeal may direct or permit the Office attend the hearing and to oppose the appeal. These circumstances rarely occur.

20.13 The A3 will need to find out when the appeal will be heard either by contacting the Court of Appeal directly or asking the appellants to let us know when they are informed.

20.14 The A3 must then inform the Office representative of the date by sending an appointment.

Letter created, locked and imported from PROSE.

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

CLEAR RECORDS

20.15 A Journal entry is prepared and OPTICS is updated to reflect the outcome of the proceedings as follows:-

Claim/Counterclaim for revocation lodged at the Patents Court on (insert date), revoked/stayed/dismitted by court order dated (insert date) (Insert Action No.)

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

20.16 The A3 should issue a letter to the parties acknowledging receipt of the

Court Order and notifying them that the register has been updated and a Journal entry prepared.

Letter created, locked and imported from PROSE.

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

20.17 The ledger is updated to show the outcome of the proceedings.

Amendments Allowed

20.18 If amendments under s75 have been allowed and the claim/counterclaim for revocation dismissed, both proceedings can be completed by referring to the Deputy Director of the patent subject matter concerned (refer to chapter 23 for s75 proceedings).

Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – Amendments allowed/Claim/Counterclaim dismissed” message to DD.

20.19 The A3 should update the register and prepare a Journal entry as follows:-

Claim/Counterclaim for revocation lodged at the Patents Court on (insert date) dismissed by Court Order allowing amendments on (insert date of Court Order) (Action No.)

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).

A separate advert will be required for the s75.

The case should then be referred to Publishing Section.

Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – Amendments allowed” message to the Publishing Team mailbox.

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 Number (.....)
Claim for Revocation by (HC - -.....)

I refer to your letter dated and acknowledge receipt of the copy of the Claim for Revocation and the Particulars of Objections in respect of the above patent.

Notice of the Claim has been recorded on the Register (a copy is enclosed) and your letter and enclosures have been placed on the part of the patents file open to public inspection. I have also arranged for an entry to appear in the Patents and Designs Journal.

Could you please let me know the outcome of these proceedings as soon as possible.

A copy of this letter has been sent to the proprietors for information.

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: xxxxxxxxxxxxxx
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: www.ipa.gov.uk

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

Date

Dear Sirs

Patent Number (**.....**)
Action No.

Please find enclosed a copy of a letter sent to the xxxxxxxxx

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 (.....)
Claim for Revocation by (HC - -.....)

I refer to the above Claim for Revocation and note that the last communication from you regarding this matter was your letter dated

Could you please advise me in writing of any further developments in the above proceedings within one month from the date of this letter. Your response should be filed by(insert date)

A copy of this letter has been sent to the other side.

Yours faithfully

Your Name
Litigation Section
Patents Directorate