

CHAPTER 21

<p style="text-align: center;">REVOCATION ON THE COMPTROLLER'S INITIATIVE SECTION 73(1)</p>
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21 SECTION 73(1) REVOCATION ON THE COMPTROLLER'S INITIATIVE

INTRODUCTION

21.01 This section relates to the revocation of patents on the Comptroller's initiative under section 73(1). The procedure within the Office is prescribed by rule 77.

ACTION BY LITIGATION ASSISTANT A1

21.02 A patent examiner will send the patent file to Litigation Section asking for revocation action to commence in respect of the patent. The examiner may cite, for example, a published GB application or a published European patent (UK) application as being in conflict with the relevant GB patent.

21.03 The details of the case should be entered in the electronic ledger by the A1. A movement card should be made up. The filing date is the date the file is received in the section. S73(1) and the reference number should be written in red in a prominent position on the front of the file. The file should then be passed to the A3.

ACTION BY LITIGATION OFFICER A3

21.04 The A3 should first check that the GB patent the examiner wishes to revoke is in force by using the OPTICS function DIS FUL. If it is, Official Letter PL2 (Annex 2) should be issued to the patentee allowing three months for a response. The OPTICS DIS FUL function should be used to check the address for service, as this may have changed since the patent was originally filed.

A file note should then be made on the minute sheet as follows:

PL2 issued on(insert date of PL2), B/F to(insert date - 3 months from date of PL2, and always to the nearest Monday).

The movement sheet on the front of the file should be marked with the B/F date. DiaryL should also be updated. A copy of the PL2 should be placed on the file.

- 21.05 An OPTICS free text entry should be made using the function REG ENT. The entry should read:

*Section 73(1) action taken on (date of PL2) in view of EP******

A DIS FUL print should be obtained and filed at the front of the file.

EP(UK) citations

- 21.06 If the examiner cites a published European patent (UK) application, the A3 should proceed as above except:

- a check should be made to ensure that the citation designates GB on either the OPTICS DIS FUL print-out or the EPOLINE (European Register) print-out.
- a PL1 letter (Annex 1) should be issued **if** the citation is a European patent (UK) application which was originally cited before grant but then deferred as a citation because the priority document was not available. If you have any doubts about this, you should consult the appropriate examiner

RESPONSE TO OFFICIAL LETTER PL1/PL2

No objection to revocation

- 21.07 If a response is received to either PL1 or PL2 that states that the patentee has no objection to the revocation of the patent, the letter should be placed on file and a decision 3a (Annex 6) prepared for the appropriate Deputy Director to sign. Once the decision has been signed, a copy should be issued to the patentee with official letter DNL1 (Annex 4) and the original

decision retained on file for reference. The minute sheet should be updated see 21.23 and records cleared.

For clearing records see 21.25 – 21.27

21.08 [DELETED]

Disagreement that the patents are in conflict

21.09 The patentee may reply that he disagrees with the examiner's view that the patents are in conflict. In such circumstances, evidence will usually be provided to support this view. The letter and evidence should be placed on file and the file then sent to the originating examiner with an appropriate minute. If the examiner allows the submissions, decision 2a (Annex 7) should be prepared for the Deputy Director to sign. Once the decision has been signed a copy should be issued to the patentee with official letter DNL1 (Annex 5) and the original decision retained on file for reference.

An OPTICS and journal entry should be prepared to reflect the fact that revocation has not taken place. Using REG ENT on OPTICS, a free text entry should be made as follows:

*Section 73(1) action taken on (date of PL1/2) in view of
not proceeded with on (date of decision)*

The electronic ledger should be updated by entering against the file reference number, Not proceeded with on (date of decision) and the date of clearing the file. The file movement card should be destroyed.

The DIS FUL function on OPTICS should be used to print a copy of the register and this should be placed at the front of the file. The front movement sheet of the file should be marked up NMP, file to store.

A Journal entry should be made as follows:-

Revocation under section 73(1) not proceeded with on (date of decision).

If the submissions are not allowed, the examiner will issue further instructions.

21.10 [DELETED]

Amendments allowed instead of revocation

21.11 The patentee may submit proposals to amend the patent in order to remove any conflict.

21.12 When proposals for amendment of a GB patent are received in response to revocation action under section 73(1), the proposals should be placed on file and should be sent to the originating examiner. The examiner will consider whether the proposed amendments are acceptable or not. If they are not, the examiner will issue instructions as to what action should be taken.

21.13 If the proposals for amendment are acceptable, the B specification of the patent should be amended in red and the certificate applied. Decision 1a (Annex 8) should be prepared and the file forwarded to the appropriate Deputy Director who will sign both the certificate and decision.

21.14 Once the decision has been signed, a copy should be issued to the patentee together with Official Letter DNL1 (Annex 5) and the original decision retained on file for reference.

21.15 An OPTICS entry should then be made. From the Revocation Section menu select item 7 – amendments allowed – type in the file number and then select item 4 – under Section 73 which will prompt you to insert the

date of the decision. When prompted, use A3 as authority for the entry. Obtain a DIS FUL print from OPTICS and file this at the front of the file.

- 21.16 A Journal entry under the following heading should then be prepared in order to advertise the amendments:

Specification amended under Section 73(1), on (date of decision).

The minute sheet should be updated with the following note:

Decision issued on (date of decision). Patent amended.

The electronic ledger should be updated by entering against the file reference number, *Patent amended on (date of decision)* and the date of clearing the file. The file movement card should be destroyed.

- 21.18 Following this, the file should be sent to Publishing Section for the amended specification to be published. After Publishing has completed their action they will send the file back to Litigation Section for checking purposes. Then the file should be sent to NMP for storage.

NO RESPONSE TO OFFICIAL LETTER PL1/PL2

- 21.19 If, after the three month period allowed for response to the Official Letters PL1/PL2, no reply has been received, Official Letter PL4 (Annex 3) offering a hearing should be issued, specifying a 21 day period for reply. The Patent Rules provide an additional automatic extension of two months for periods not specified in the rules. This may be applied for retrospectively. As a result, the case should be diared for 21 days and 2 months from the date of the PL4 letter. DiaryL should also be updated. A copy of the PL4 should be placed on file.

The file minute sheet should be updated as follows:

No reply received to PL1/PL2 issued on (date of PL1/2) PL4 issued on (date of PL4) B/F to

Request for a hearing to Official letter PL4

21.20 The patentee may reply that he would like a hearing. If this is the case, a hearing will need to be arranged by the Hearing Team. Following the hearing, a decision will be written by the hearing officer and issued. If the patent is revoked see 21.24 – 21.27.

If the patent is not revoked see 21.09 (2nd paragraph onwards).

No Response to Official Letter PL4

21.21 If no response is received and the B/F period has expired, decision 5 (Annex 9) should be prepared and forwarded to the Deputy Director with the following note on the minute sheet:

No reply has been received to (insert PL1/PL2 as appropriate) or PL4. Decision 5 prepared and forwarded for your signature.

21.22 [DELETED]

21.23 Once the decision has been signed a copy should be issued to the patentee together with Official Letter DNL1 (Annex 4) and the original decision retained on file for reference.

21.24 The following file note should be written on the minute sheet:

Decision issued on (date of Decision). Patent revoked.

Clear Records

21.25 OPTICS should be updated by selecting item 16 from the Revocations Section menu – Register Revocation. The DIS FUL function on OPTICS should be used to print a current copy of the register and this should be placed at the front of the file. The front movement sheet of the file should be marked up *NMP, File to store*. If, when registering the revocation of the

patent, it is found that the patent has lapsed, the case should be referred to the B3, who will change the status of the patent so that it can be revoked.

A Journal entry should be made under the following heading as indicated:

SECTION 73

Revocation on the Comptroller's Initiative

Patent revoked under Section 73(1)

Patent Number	PROPRIETOR'S NAME
	Title

21.27 The electronic ledger should be updated by entering Patent revoked on (date of decision) against the file reference number and date of clearing the file. The file movement card should be destroyed.

EXTENSIONS OF TIME

21.28 Occasionally an extension of time request may be received. Each request should be referred to the originating examiner, who will consider it on its respective merits. It should be remembered that section 73 cases are *ex parte*. Therefore no other parties are involved or need to be consulted.

21.29 Most of the requests for extensions of time relate to proposed amendments. In such cases, extensions have been granted for periods of one to three months.

21.30 Once an extension of time has been granted, this should be confirmed in writing and a new deadline for a response set. A suitable minute should be made on the file and a copy of the EOT confirmation letter placed on file.

Annex 1
Letter S73(1) PL1

c/o

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

Direct Line: 01633 81xxxx
E-mail: *****@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: Room 3Y31/Name/File reference

Date

Dear Sirs

Patent number: xxxxxxx (Proprietors Name)
Patents Act 1977: Action under Section 73(1)

Latest date for reply. Xx. Xxxx xx

When the examination report of xx Xxxx xx was issued, the actual priority date of the relevant disclosure in xxxx could not be determined because the priority document(s) (was /were) not available.

The examiner (xxxxx tel xxxxxx) has now considered the priority document(s) and is of the view that the relevant disclosure has an earlier priority date than the invention of claims xxxxxx. This invention is therefore not new.

By xxxxx you should either propose amendments to meet this objection or make observations on it. If you do not, the patent may be revoked.

If you want to propose amendments, it would be helpful if these could be shown in red ink on a copy of the printed specification. However, if the amendments are simple and not extensive you may submit them in a letter. You may not however amend your patent in a way which adds matter or extends the protection conferred by the patent.

No amendment will be needed if you can show that the priority date of your invention is not later than the priority date of the cited disclosure.

Yours faithfully

Your name
Litigation Section
Patents Directorate

**Annex 2
Letter S73(1) PL2**

c/o

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

Direct Line: 01633 81xxxx
E-mail: *****@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: Room 3Y31/Name/File reference

Date

Dear Sirs

Patent number: xxxxxxx (Proprietors Name)
Patents Act 1977: Action under Section 73(1)

Latest date for reply. Xx. Xxxx xx

The examiner (xxxxxxx tel xxxx) considers that the invention of claim(s) is not new because it has already been disclosed in xxxxxxx.

By xxxxx you should either propose amendments to the UK patent to meet this objection or make observations on it. If you do not, the UK patent may be revoked. Alternatively, you may reply advising that you are content with the revocation.

If you want to propose amendments, it would be helpful if these could be shown in red ink on a copy of the printed specification. However, if the amendments are simple and not extensive you may submit them in a letter. You may not however amend your patent in a way which adds matter or extends the protection conferred by the patent.

Yours faithfully

Your name
Litigation Section
Patents Directorate

**Annex 3
Letter S73(1) PL4**

c/o

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

Direct Line: 01633 81xxxx
E-mail: *****@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: Room 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: xxxxxxxx (*Proprietors Name*)
Patents Act 1977: Action under Section 73(1)

Latest date for reply. Xx. Xxxx xx

Our letter of xx Xxxx xx invited you to propose amendments or to make observations in response to an objection that the invention of claims xxxx had been disclosed in xxxxx and was therefore not new. However no reply has been received.

We will now consider whether your patent should be revoked. If you want to be heard before the Comptroller decides the matter you should ask by xxxxx for a hearing to be appointed.

Yours faithfully

Your name
Litigation Section
Patents Directorate

**Annex 4
Letter DNL1**

c/o

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

Direct Line: 01633 81xxxx
Email: *****@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: Room 3Y31/Name/File Reference

Date

Dear Sirs

Action under Section 73(1)

1. Please find enclosed a copy of a decision dated xxxxxx.
2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by the Practice Direction to Part 52 of the Civil Procedure Rules, 1998 (as amended). If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG07, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).
3. Two copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee (currently £200) **within the time period specified in the decision**. The latest date for appeal is therefore xxxxxx. Any request for an extension to the appeal period identified in the decision must be made to the court.
4. Once you have filed your appeal at the court, you must send a copy to the Notice of Appeal to the Comptroller as soon as practicable and no later than 7 days from the date of filing.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Your name
Litigation Section
Patents Directorate

October 2007

**Annex 5
Letter DNL1**

c/o

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

Direct Line: 01633 81xxxx
Email: *****@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: Room 3Y31/Name/File Reference

Date

Dear Sir

Patent Number: xxxxxx (Proprietors Name)

Please find enclosed a copy of a decision dated xxxxxxxx.

Yours faithfully

Your name
Litigation Section
Patents Directorate

Annex 6
Decision 3a

Date

PATENTS ACT 1977

PROPRIETOR

ISSUE

Whether Patent Number GB***** should be
revoked under Section 73(1)

DECISION

- 1 An Official letter dated xxxxxxxx explained that the invention of claims ***** of the above patent did not appear new in the light of EP***** and that revocation of the UK Patent under Section 73(1) might therefore be necessary.

In reply, the proprietor, in a letter dated xxxxxxxx, advised that they were content with the revocation of the UK patent.

- 2 In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(1) are met. I therefore order revocation of the UK patent.

Appeal

- 3 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

(Name of DD)

Deputy Director acting for the Comptroller

Annex 7
Decision 2a

Date

PATENTS ACT 1977

PROPRIETOR

ISSUE

Whether Patent Number GB xxxxxxxx should
be revoked under Section 73()

DECISION

- 4 An Official letter dated xxxxxxxx explained that the invention of claims ***** of the above patent did not appear new in the light of EP***** and that revocation of the UK Patent under Section 73(1) might therefore be necessary.

- 5 The proprietors contested the examiner's view in their agent's letter dated xxxxxxxxx. I have considered their observations and I make no order for revocation of the UK patent.

(Name of DD)

Deputy Director acting for the Comptroller

Annex 9

Decision 5

Date

PATENTS ACT 1977

PROPRIETOR

ISSUE

Whether Patent Number GB***** should be
revoked under Section 73(1)

DECISION

- 9 An Official letter dated xxxxxxxx explained that the invention of claims ***** of the above patent did not appear new in the light of EP***** and that revocation of the UK Patent under Section 73(1) might therefore be necessary. The proprietor did not submit observations or proposals for amendment. A hearing was therefore offered in an Official letter dated xxxxxxxx but the proprietor has not asked to be heard.
- 10 In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(1) are met. I therefore order revocation of the UK patent.

Appeal

- 11 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

(Name of DD)

Deputy Director acting for the Comptroller