

CHAPTER 21

<p style="text-align: center;">REVOCATION ON THE COMPTROLLER'S INITIATIVE SECTION 73(1)</p>
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Introduction	21.01
Action by Litigation Assistant A1	21.02 - 21.03
Action by Litigation Officer A3	21.04 - 21.06
Central Limitation Process – EPC 2000	21.04
EP (UK) citations	21.06
Response to Official Letter PL1/PL2	21.07 - 21.18
No objection to revocation	21.07 - 21.08
Disagreement that the patents are in conflict	21.09 - 21.10
Amendments allowed instead of revocation	21.11 - 21.18
No response to Official letter PL1/PL2	21.19 - 21.24
Request for a hearing in response to Official letter PL4	21.20
No response to Official letter PL4	21.21 - 21.24
Clear Records	21.25 - 21.27
Extensions of time	21.28 - 21.30

Annexes

Annex 1	S73 (1) (PL1)
Annex 2	S73 (1) (PL2)
Annex 3	S73 (1) (PL4)
Annex 4	DNL1 (Appeal period)
Annex 5	DNL1 (No appeal period)
Annex 6	Decision 3a (Agree to revocation)
Annex 7	Decision 2a (Observations allowed)
Annex 8	Decision 1a (Amendments allowed)
Annex 9	Decision 5 (No reply to PL2 or PL4)

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).

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. The file should be passed to the ex-parte team.

PECS:- For cases already on PECS, the examiner will send a message to the Litigation mailbox to issue a PL2

For cases not yet on PECS, the A3 will request the A1 to:

- Arrange for the application to be indexed and scanned as a PECS case or if a EP (UK) patent, make up a Litigation file.

The A1 will also need to:

- enter the application in the electronic ledger, the filing date is the date the file is received in the section
- make up a movement card for the case (not required for PECS cases).

PECS:- The A1 attaches a request for index and scanning to the application and sends it to the Index and Scanning section.

21.03 Where a paper file has been made up, 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 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

ACTION BY LITIGATION OFFICER A3

21.04 An EPIDOS print relating to the European patent (UK) should be obtained via the Online European Patent Register (www.epoline.org/portal/public/registerplus) (Register Plus). You should check that:

- a) the opposition period of 9 months has elapsed since the grant of the patent
- b) there is no opposition to the grant of the European patent (UK)
- c) the European patent (UK) has designated GB status
- d) the specification on file is the latest version using Register Plus and there are no central limitation proceedings ongoing. If proceedings are ongoing, proceed as follows:-

EPC 2000 – Central Amendment Process

Following the introduction of the central limitation process, an EP patent may now be amended centrally at the EPO or in each individual contracting state. On receipt of a new S73(1), the online European Patent Register should be checked to determine whether there is a request to centrally limit an EP (UK) patent. If so, you need to obtain a copy of the amendments filed at the EPO and forward these to the examiner. The examiner will consider whether the amendments, if allowed, remove the conflict. If so, the examiner may stay the S73(1) action pending the outcome of the central amendment. If the amendment is not allowed or does not remove the conflict, the s73(1) action may proceed.

A minute should be added to the proceedings sheet and sent to the examiner as follows:

On checking the EPO register, it appears that an application has been filed to amend the patent centrally at the EPO. The amendments are attached for you to decide whether, if allowed, these amendments remove the conflict. If so, please confirm that you wish to stay the s73(1) action pending the outcome of the centrally filed amendment. The register will be checked regularly to monitor the progress of the amendment. If the amendment does not remove the conflict, please confirm that you wish to proceed with the s73(1) action.

If the case is a PECS case, the minute should read as follows:

Please see the centrally filed amendment at the EPO on the EPO register and advise on how you wish to proceed.

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM - S73(1) Central amendment filed” message to the examiner.

The A3 should also check that any 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 two 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 proceedings sheet as follows:

PL2 issued on(insert date of PL2), B/F to(insert date - 4 months from date of PL2, and always to the nearest Wednesday).

Section 117(B) of the Patents Act 1977 provides for an additional automatic extension of two months for periods specified by the Office. This may be applied retrospectively. As a result, the case should be diaried for 2 months and 2 months from the date of the PL2 letter. 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.

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

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

- 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 (see 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.

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

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

RESPONSE TO OFFICIAL LETTER PL1/PL2

No objection to revocation

21.07 If a response is received to the PL1 or PL2 stating that the patentee has no objection to the revocation of the patent, the letter should be placed on file and a decision 3a (see 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 (see annex 4) and the original decision retained on file for reference. The proceedings sheet should be updated see 21.24 and records cleared.

PECS: Certificates and decisions are created using Word templates and applying electronic signatures of DD's.

Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a "PSM – Decision to sign" message.

Once authorisation is received from the DD, an electronic signature can be applied to the decision.

Letter created, locked and imported from PROSE.

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

For clearing records see 21.25 – 21.27

21.08 [DELETED]

Disagreement that the patents are in conflict

21.09 The patentee may disagree 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 examiner with an appropriate minute. If the examiner allows the submissions, decision 2a (see 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 DNLI (see annex 5) and the original decision retained on file for reference.

PECS:- Certificates and decisions are created using Word templates and applying electronic signatures of DD's.

Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a "PSM – Decision to sign" message.

Electronic signature is applied after authorisation has been obtained from the DD.

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 (insert 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 prepared 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.

PECS:- 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).

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 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.

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – Amendments filed” message to DD.

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 (see annex 8) should be prepared and the file forwarded to the appropriate Deputy Director who will sign both the certificate and decision.

PECS:- Use the assemble and enhancer function to apply the amendments. Certificates and decisions are created using Word templates and applying electronic signatures of DD's.

Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – Decision and certificate to sign” message to DD. Once a message is received from the DD, the appropriate certificate should be pasted into a Word document, a DD electronic signature applied to the decision and certificate and the certificate imported using manual import (doc code is CERTIFICATE).

21.14 Once the decision has been signed, a copy should be issued to the

patentee together with Official Letter DNL1 (see annex 5) and the original decision retained on file for reference.

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

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

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 should be prepared as follows:

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

A file note is added to the proceedings sheet as follows:-

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

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

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

21.17 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.

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-

LIT), then create and send a “PSM – S73(1)” message to the Publishing team mailbox.

NO RESPONSE TO OFFICIAL LETTER PL1/PL2

21.19 If, after the two 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. Section 117(B) of The Patents Act 1977 provides for an additional automatic extension of two months for periods specified by the Office. 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.

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

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

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

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

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 Hearings 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.

PECS:- To refer to the hearing team, create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a “PSM – set up hearing message to the hearings mailbox.

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 (see annex 9) should be prepared and forwarded to the Deputy Director with the following minute:

No reply has been received to (insert PL1/PL2 as appropriate) or PL4. Decision 5 prepared and forwarded for your signature/PECS:- Please can you authorise that the decision can be signed.

PECS:- Certificates and decisions are created using Word templates and applying electronic signatures of DD's.

Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a "PSM – Decision to sign" message to the DD.

Once authorization is received from the DD, an electronic signature can be applied to the decision

21.22 [DELETED]

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

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

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

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

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

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.

- 21.26 A Journal entry should be prepared 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 against the file reference number, Patent revoked on (date of decision) and date of clearing the file. The file movement card should be destroyed.

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

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

EXTENSIONS OF TIME

- 21.28 Occasionally an extension of time request may be received. Each request should be referred to the 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.

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a "PSM – Extension of time request" message to

DD.

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 file note should be made on the file and a copy of the EOT confirmation letter placed on file.

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

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

**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 xxxxxxx. 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.

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 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

April 2009

**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: xxxxxxx (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 xxxxxxxx should
be revoked under Section 73(1)

DECISION

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

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(1)

DECISION

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

2. The proprietors contested the examiner's view in their attorney'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 8
Decision 1a

Date

PATENTS ACT 1977

PROPRIETOR

ISSUE

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

DECISION

1. An Official letter dated xxxxxxxx explained that the invention of claims xxxxxxxx of the above patent did not appear new in the light of GBxxxxxxx and that revocation of the UK Patent under Section 73(1) might therefore be necessary.
2. The proprietor submitted proposals for amendment of the specification, which are allowable under Section 76.
3. I am satisfied that the proposed amendments distinguish the claimed invention from the cited disclosure. I therefore allow the specification to be amended as proposed, and 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 xxxxxxxx should
be revoked under Section 73(1)

DECISION

1. An Official letter dated xxxxxxxx explained that the invention of claims xxxxxxxx of the above patent did not appear new in the light of EPxxxxxxx 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.
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