

## CHAPTER 22

<p style="text-align: center;"><b>REVOCATION ON THE COMPTROLLER'S INITIATIVE SECTION 73(2)</b></p>
--

Introduction	22.01
Action by Litigation Assistant A1	22.02 - 22.03
Action by Litigation Officer A3	22.04 - 22.07
Response to Official Letter PL3	22.08 - 22.19
No objection to revocation	22.08
Disagreement that the parties are in conflict	22.09
Wish to allow the patent to lapse or be surrendered	22.10 - 22.11
Amendments allowed instead of revocation	22.12 - 22.19
No Response to Official Letter PL3:- Official Letter PL5	22.20 - 22.28
Request for a hearing in response to PL5	22.22
No Response to Official Letter PL5	22.23 - 22.25
Clearing records	22.26 - 22.28
Extensions of time	22.29 - 22.31
Annexes	
Annex 1	PL3
Annex 2	PL5
Annex 3	DNL1 (Appeal period)
Annex 4	DNL1 (No appeal period)
Annex 5	Decision 3 (Agree to revocation)
Annex 6	Decision 2 (Observations allowed)
Annex 7	Decision 1 (Amendments allowed)
Annex 8	Decision 1a (Amendment to GB & EP)
Annex 9	Decision 6 (No reply to PL3 or PL5)

## **22 SECTION 73(2) REVOCATION ON THE COMPTROLLER'S INITIATIVE**

### **INTRODUCTION**

22.01 This section relates to the revocation of patents on the Comptroller's initiative under section 73(2). The procedure within the Office is prescribed by rule 77.

### **ACTION BY LITIGATION ASSISTANT A1**

22.02. A patent examiner will send the patent file to Litigation Section asking for revocation action to commence in respect of the patent. The examiner will specify the European patent to be cited.

22.03 The details of the case should be entered on 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(2) 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**

22.04 An EPIDOS print relating to the European patent (UK) should be obtained via the EPO-line in order to 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.

If the European patent (UK) has lapsed since grant, revocation action should continue (see MOPP Section 73). If an opposition to the European patent (UK) has been filed, the file should be returned to the originating examiner with a minute note to that effect.

22.05 You should first check that the GB patent is in force by using the Optics

function DIS FUL.

If the patent is not in force, return the file to the originating examiner with a print of the entry.

If the patent is still in force, obtain a print of the entry and place this on file.

- 22.06 An Official Letter PL3 (Annex 1) should be issued to the patentee allowing three months for a response. Use the OPTICS function DIS FUL to check the address for service as this may have changed since the patent was originally filed. A file note should be made on the minute sheet as follows:

*PL3 issued on (insert date of PL3). B/F to ..... (insert date - 3 months from date of PL3, 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 PL3 should be placed on file.

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

*“Section 73(2) action taken on (date of PL3), in view of EP(UK).....”.*

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

## **RESPONSE TO OFFICIAL LETTER PL3**

### No objection to revocation

- 22.08 If a response is received to the PL3 that states that the patentee has no objection to the revocation of the patent, the letter should be placed on file and a decision 3 (Annex 5) 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 3) and the original retained on file for reference.

For issuing decision and clearing records see 22.25 – 22.28

Disagreement that the patents are in conflict

22.09 The patentee may reply that he disagrees with the examiner's view that the GB patent and the European patent (UK) 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 a suitable file note. If the examiner allows the patentee's submissions, decision 2 (Annex 6) 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 4) and the original decision retained on file for reference.

An OPTICS entry should be made to show that revocation has not taken place. Using REG ENT on OPTICS, a free text entry should be made as follows:

*Section 73(2) action taken on (date of PL3) in view of EP (UK) .....not proceeded with on (date of decision)"*

The electronic ledger should be updated by entering against the file reference number No order for revocation on (date of decision) and the date of clearing the file. The 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 showing that:-

Revocation under section 73(2) not proceeded with.

If on the other hand the submissions are not allowed, the examiner will provide instructions as to how we should proceed.

#### Patent to lapse or to be surrendered

22.10 The patentee may state that he is either:

- allowing the patent to lapse due to non-payment of renewal fees, or
- that he proposes to surrender the patent

It would appear that neither of these options is *prima facie* allowable because both patents would have been granted for a period of time. The MOPP Section 73.09 indicates that once revocation action has started, it should normally continue even though the patent may have lapsed or an offer to surrender has been made. In such a case, the file should be returned to the originating examiner with a suitable minute. The examiner will usually ask for a letter to be issued to the patentee pointing out these facts and giving twenty eight days to request a hearing.

22.11 The patentee may submit proposals to amend the patent in order to remove any conflict (see below).

#### Amendments allowed instead of revocation

22.12 When proposals for amendment of a GB patent are received in response to revocation action under section 73(2), the proposals should be placed on the file and sent to the originating examiner. The examiner will reply after he has considered whether the proposed amendments are acceptable or not. If they are not acceptable, the examiner will issue further instructions as to what action should be taken.

22.13 If the proposals for amendment are acceptable, the B specification of the

patent should be amended in red and the specification certificated in red ink. Decision 1 (Annex 7) should be prepared and tabbed with Office decision label and the file forwarded to the Deputy Director who will sign both the certificate and the decision.

22.14 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.

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

22.16 An OPTICS entry should then be made. From the menu select item 7 - amendments allowed - type in the file number and then select item 4 - under Section 73 - this will prompt you to insert the date of the decision. When prompted use A3 (upper case letters) as authority for the entry. Obtain a DIS FUL print for the file from OPTICS and file this at the front of the file.

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

*Specification amended under Section 73(2), on (date of decision)*

22.18 A 'clear records' stamp and publications request should be completed. You need to ensure that the correct instructions are given to Publishing Section regarding the action that should be taken. The minute sheet should be updated with the following note:

*Decision issued on (date of decision). Patent amended. Clear records.*

22.19 Following this, the file can be sent to Publishing Section for the amended specification to be published. From there, the file will be sent back to

Litigation Section for checking purposes, the file should then be sent to NMP for storage.

If both the GB and the EP patents require amendment in order to remove any conflict, the GB patent is amended under s73(2) and the European patent is amended under s27. The amendment under s73(2) is stayed pending the expiry of the s27 opposition period. For procedures on amendment under s27 see Chapter 17

### **NO RESPONSE TO OFFICIAL LETTER PL3: OFFICIAL LETTER PL5**

22.20 If, after the two month period allowed for response to the Official Letter PL3, no reply has been received, Official Letter PL5 (Annex 2) offering a hearing should be issued, specifying a 21 days 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 retrospectively. As a result, the case should be diaried for 21 days and 2 months from the date of the PL5 letter.

22.21 The file minute sheet should be updated as follows:

*No reply received to PL3. PL5 issued on (date of PL5) B/F to .....*

### **Request for a hearing in response to PL5**

22.22 If in response to the PL5 letter a hearing is requested, this will need to be arranged by the Hearings Team. Following the hearing, a decision will be written by the hearing officer and issued by the Hearings Team. If the patent is revoked see 22.24 – 22.28. If the patent is not revoked see 22.09.

### **No Response to Official Letter PL5**

22.23 If no response has been received to the PL5 letter, decision 6 (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 either PL3 or PL5. Decision 6 prepared and forwarded for your signature.*

22.24 Once the decision has been signed, a copy should be issued to the patentee with Official letter DNL1 (Annex 3) and the original decision retained for reference.

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

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

### Clearing Records

22.26 OPTICS needs to be updated by selecting item 16 from the menu - Register Revocation. 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*. If, when registering the revocation of the patent, it is found that the patent has lapsed, it should be referred to the B3 who will change the status of the patent so that it can be revoked.

22.27 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(2)**

**Patent Number**                      PROPRIETOR'S NAME

Title

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

### **EXTENSIONS OF TIME**

22.29 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.

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

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

**Annex 1  
Letter S73(2) PL3**

\*\*\*\*\*

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(2)**

**Latest date for reply. xx. Xxxx xx**

The examiner ( xxxxxx tel xxxxxx) considers that this patent has been granted for the same invention as European Patent (UK) No. xxxxxxx having the same priority date.

By xxxxx you should either propose amendments to the UK patent in order to meet this objection or make observations on it. If you do not the UK 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.

Yours faithfully

Your name  
Litigation Section  
Patents Directorate

October 2007

**Annex 2  
Letter S73(2) PL5**

\*\*\*\*\*

c/o

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

**Direct Line:** 01633 814334  
**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(2)**

**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 patent had been granted for the same invention as European Patent (UK) No xxxxxxxx . 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

October 2007

|  
**Annex 3**  
**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(2)**

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

|  
**Annex 4**

October 2007

**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

### Decision 3

Date

### PATENTS ACT 1977

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent No. GB/EP xxxxxxxx should  
be revoked under Section 73(2)

---

### DECISION

- 1 An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) No. xxxxxxxx, and that revocation of the UK patent under Section 73(2) might therefore be necessary. In reply, the proprietors in their letter dated xxxxxxxx advised (insert appropriate wording such as: that they are content for the revocation of the patent.)
- 2 I am satisfied that the conditions of Section 73(2) 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

## Decision 2

Date

### PATENTS ACT 1977

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent No. GB/EP xxxxxxxx should  
be revoked under Section 73(2)

---

### DECISION

1. The Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) No. xxxxxxxx, and that revocation of the UK Patent under Section 73(2) might therefore be necessary.
2. The proprietors contested the examiner's view in their (agent's) letter dated xxxxxxxx. 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

## Decision 1

Date

### PATENTS ACT 1977

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent No. GB/EP xxxxxxxx should  
be revoked under Section 73(2)

---

### DECISION

1. An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) No. xxxxxxxx, and that revocation of the UK Patent under Section 73(2) might therefore be necessary.
2. The proprietors submitted proposals for amendment of the specification, which are allowable under Section 76.
3. I am satisfied that the proposed amendments prevent there from being two patents in respect of the same invention. 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

**Decision 1a**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent No. GB/EPxxxxxxx should  
be revoked under Section 73(2)

---

**DECISION**

1. An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) No. xxxxxxx B1, and that revocation of the UK Patent under Section 73(2) might therefore be necessary.
2. The proprietors submitted proposals for amendment of both the UK Patent and European patent (UK) No. xxxxxxx specifications, which are allowable under Section 76.
3. I am satisfied that the proposed amendments prevent there from being two patents in respect of the same invention. I therefore allow the specifications to be amended as proposed, and make no order for revocation of the UK patent.

**(Name of DD)**

Deputy Director acting for the Comptroller

**Decision 6**

Date

**PATENTS ACT 1977**

PROPRIETOR

\*\*\*\*\*

ISSUE

Whether Patent No. GB xxxxxxxx should be  
revoked under Section 73(2)

---

**DECISION**

1. An Official letter dated xxxxxxxx explained that the above UK patent appeared to be for the same invention as European patent (UK) No xxxxxxxx and that revocation of the UK Patent under Section 73(2) might therefore be necessary. The proprietors did not submit observations or proposals for amendment. A hearing was therefore offered in an Official letter dated xxxxxxxx, but the proprietors have not asked to be heard.
2. In the absence of any argument to the contrary, I am satisfied that the conditions of Section 73(2) 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