

CHAPTER 23

SECTION 75

AMENDMENT OF PATENT IN INFRINGEMENT OR REVOCATION PROCEEDINGS BEFORE THE COURT

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23 APPLICATION TO AMEND THE SPECIFICATION OF A PATENT UNDER SECTION 75 BEFORE THE COURT

INTRODUCTION

23.01 This chapter is concerned with the amendment of the specification of a granted patent during proceedings in the Courts of England and Wales. Proceedings in the court are governed by the Civil Procedure Rules 1998 as amended. For proceedings in Scotland in the Court of Session, see rule 55 of the rules of the Court of Session for procedural requirements.

23.02 Amendments may also be filed under section 75 in revocation proceedings before the comptroller (see Chapter 14 for details).

23.03 Deleted

AMENDMENT DURING PROCEEDINGS BEFORE THE COURT

23.04 For proposals to amend under Section 75 before the court, applicants need to file an "application notice". The application notice consists of:-

- The prescribed form N244 (or the equivalent information) is available on the office website at www.ipo.gov.uk/n244.rtf
- Particulars of the amendment
- The grounds for seeking the amendment

All of this must go to the court on paper, and should also be served on the Comptroller electronically if reasonably possible (see rule 63.10 of the Civil Procedure Rules 1998 as amended). There is a fee payable to the court but not to the Comptroller.

DIRECTIONS FOR THE ELECTRONIC DELIVERY OF APPLICATIONS

23.05 Electronic delivery should be made either by e mail to litigationamend@ipo.gov.uk or on an electronic carrier (such as floppy disc or CD-R) delivered to this office and accompanied by an identifying letter.

By e mail

23.06

- The A3 should not accept an e mail for these purposes at any e mail address other than that given above. The e mail should be a plain text message.
- The e mail should be entitled "*proposal to amend under s75 before the courts*".
- The text may be provided as an attachment to the e mail.

If the A3 is unable to read the text, the e mail should be treated as not delivered, and in these circumstances the A3 should contact the applicant with a view to making alternative arrangements.

Setting out the amendments

23.07 Applicants are encouraged to use conventional word processing features such as markup, coloured text and strikeout/strikethrough to set out the amendments on the original version of the text in a way that makes it easy for the reader to appreciate the changes.

AMENDMENTS FILED IN PAPER FORM

23.08 Any amendments filed in paper format should clearly identify the amendments on a copy of the specification.

ACTION ON RECEIPT OF THE AMENDMENTS

23.09 The A3 should:-

- Undertake checks to ensure that the following has been provided:
The particulars of the proposed amendments, the grounds on which the amendments are sought and whether the applicant will contend that the claims prior to amendment are valid.
- Complete the Journal notice (see annex 1) and enter the section 75 details on the summary listing noting whether amendments have been filed electronically or in paper format. Occasionally the court will dispense with the need to advertise. In this case diary the case until the order is received. Once the order is received, refer to the DD for Comptrollers comments.
- When the weekly journal is produced, send electronic amendments to "webmaster". The table should accompany the amendments and the A3 should advise webmaster which journal date the "notice" will appear in (see annex 2).

Webmaster will then arrange a link from the web notice to the full details of the amendment (electronic amendments only). Where the amendments have been filed in paper form only, full details will be available from the Litigation Section upon request.

- Issue S75(a) (annex 3) letter advising the applicant when the notice of proposed amendments will be advertised in the Journal.
- Liaise with the A1 who will make up a litigation file (see chapter 25) and movement card, enter details in the ledger and complete the register entry. The A1 will also obtain the main patent file. If the amendments were filed electronically the A3 should print a paper copy of the amendments before liaising with the A1.

CONSIDERATION OF PROPOSALS TO AMEND

- 23.10 The A3 should then send the proposals for amendment to the Deputy Director responsible for the subject matter of the amendments for any comments and to advise if the Comptroller wishes to be represented in Court. (The “Comptroller’s comments”)
- 23.11 The Deputy Director will instruct the A3 to issue the “ Comptroller’s comments”. This may take the form shown in standard letter S75(c) (annex 4). This should be sent to the applicant(s) when the Comptroller has no comments to make on the proposed amendments and does not wish to be represented in Court. If the Deputy Director wishes to comment on the amendments, he will provide you with the appropriate text. You should not issue the “Comptroller’s comments” until the 14 day period for opposition has passed. Make a note on DiaryL of the date the Comptroller’s comments are to be issued.

Notice of opposition

- 23.12 An opponent must file and serve on all parties and the Comptroller a notice opposing the application. The notice must include the grounds relied on. This must be filed within 14 days of the first appearance of the advertisement (Journal notice).
- The A3 must send the notice of opposition to the Deputy Director to ensure that this is taken into consideration before issuing the Comptroller’s comments.

COURT DIRECTIONS

- 23.13 The applicant must apply to the Court for directions within 28 days of the date of the advertisement (Journal notice)

Order of the Court. (Outcome of proceedings)

- 23.14 Unless the Court otherwise orders, the applicant must within 7 days serve on the Comptroller any Order of the Court relating to the application.

23.15 The Court Order will state the outcome of the Court proceedings ie whether the amendments have been allowed (see 23.18) or refused, whether the proceedings have been stayed, or whether the patent has been revoked (see 23.16).

AMENDMENTS NOT ALLOWED, PATENT REVOKED OR PATENT REVOKED PENDING APPEAL

Register entry

23.16 The A3 should make a register entry using the REG ENT function on OPTICS to reflect the outcome of the Order. Where a patent is revoked by an Order of the Court but the Order has been stayed pending appeal, the patent should not be revoked until either (a) the stay has expired and an appeal has not been filed within the period allowed or (b) where an appeal has been filed, a copy of the Order from the Court of Appeal has been received upholding the earlier decision.

23.17 The A3 should send a standard letter s75e (annex 5) to the applicants' agents acknowledging receipt of the Court Order. The applicants should also be informed that the Register has been updated and that an advertisement reflecting the outcome of the decision will appear in the Journal.

CLEAR RECORDS (A3 action)

23.18 The A3 should check that an OPTICS DIS FUL print has been placed on file which records the outcome of the court decision. A final entry for the Journal should be made (see 23.19), and the electronic ledger updated (23.20). A clear records sheet (see annex 6) should be used as a check list to ensure that all relevant actions have been completed. The file should then be sent to NMP for storage.

Final Journal Advert

23.19 A final advertisement for the Journal should be prepared as follows:-

Section 75

**Application to amend the Specification of a patent under Section 75
Application refused by Court Order/dismissed by Court Order/Patent
Revoked. *(use wording as appropriate)***

Patent number	PROPRIETORS NAME
	TITLE

Application to amend under Section 75, refused /dismissed /patent revoked
(use wording as appropriate) by Court Order dated

The date the advert is due to appear in the Journal should be written on the
clear records sheet.

Electronic Ledger

23.20 The Section's electronic ledger is found in Excel on the 'H' drive under
Litigation/Ledgers. Locate the appropriate year and section and enter the
outcome of the case (see Journal and register entry), and the date. Highlight
the entry to show the case has been completed.

Movement Card

23.21 Retrieve the card from the "live" card drawer and destroy.

Storage

23.22 All records are now cleared. The A3 should place the proceedings file at the
back of the main patent file and send both files to NMP for storage.

COURT ALLOWS THE SPECIFICATION TO BE AMENDED OR APPEAL HAS BEEN ALLOWED

Register entry

23.23 If the Court allows the amendments, a register entry will be made to this effect by the A3. The A3 should then arrange for the B Specification to be amended and should provide instructions to Publication Section so they can produce a C specification.

Amendment of the B specification

23.24 The A3 should arrange for either:-

- The file copy of the “B” specification to be amended in red.
- Replacement pages to be incorporated into the original “B” specification.
OR
- Where a fresh specification has been supplied, for the original specification to be attached to the amended specification by ribbon and seal. (The original specification is not cancelled).

The appropriate Section 75 certificate(s) should be applied to the specification. Where a fresh specification has been supplied the A3 must place certificates on the original and amended specification. The A3 should then send the file to the Deputy Director of the relevant examination group with an appropriate minute. When the file has been returned with the certificate signed the A3 will need to clear records including sending the file to the Publishing Section for a C specification.

CLEAR RECORDS

Journal advert

23.25 A final advertisement for the Journal should be prepared by the A3 as follows:-

Section 75

Application to amend the Specification of a patent under Section 75 Specification amended

Patent number	PROPRIETORS NAME
	TITLE

Application to amend under Section 75 allowed by Court Order
dated.....

Electronic Ledger

23.26 Follow procedure at 23.20; however the outcome will be 'Amendments allowed'.

Publishing action for production of the C Specification

23.27 If the amendments are minor, Publishing Section will incorporate them in a schedule on the back of the front page of the specification. This will be produced as a C page. Alternatively where a full amended specification or replacement pages have been filed the specification will be copied and distributed with a C front page. The A3 should advise Publishing which action they should take (see annex 6).

Movement Card

23.28 Retrieve the card from the "live" card drawer and destroy.

Storage

23.29 Once the file is returned from Publishing, the A3 should send the file to NMP for storage (see 23.22 above).

Annex 2

Applications for Amendment of Specification

Sect.	PDJ No. & Date	Opposition deadline	Patent No. and title	Int. Classi	Proprietor (Court action number if any and address for service)
27	3216 5 Feb 03	2 months	2345678 xxxxxxxxxxxxxxxxxxxxx x	H04G	xxxxxxxxxxxxxxx
75	3215 29 Jan 03	2 months	2124567 xxxxxxxxxxxxxxxxxxxxx x	G22F	xxxxxxxxxxxxxxx
75	3214 22 Jan 03	14 days	2456789 xxxxxxxxxxxxxxxxxxxxx x	A69B	xxxxxxxxxxxxxxx HC 123456 xxxxxxxxxxxxx, xxxxxxxxxx, xxxxxxxxxxxxxxx

Annex 3
Letter S75(a)

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: 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: xxxxxx (Proprietors Name)
Application to amend the specification of a patent under Section 75 of the Patents Act 1977.
Action No xxxx

Thank you for your letter dated xxxxxx. The notice of proposed amendments will be advertised in the Patents & Designs Journal on xxxxx.

In order to assist the Comptroller in deciding whether to be represented in Court, please let me know whether there are any other Court proceedings pending in respect of this patent and if so whether the other party involved in those proceedings has been notified of the application to amend.

The Comptroller's comments on the proposed amendments will be sent to you after the expiry of the 14 day opposition period.

Yours faithfully

Your name
Litigation Section
Patents Directorate

Annex 4
Letter (s75c)

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: 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: xxxxxx (Proprietors Name)
Application to amend the specification of a patent under Section 75 of the Patents Act 1977.
Action No xxxx

I refer to your application for amendment filed on xxxxxxxx.

The Comptroller has no comments to make on the proposed amendments and does not wish to be represented in Court unless otherwise directed by the Court.

Yours faithfully

Your name
Litigation Section
Patents Directorate

Annex 5
Letter s75(e)

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: 3Y31/Name/File Reference

Date

Dear Sirs

Patent number: xxxxxx (Proprietors Name)
Application to amend the specification of a patent under Section 75 of the Patents Act 1977.
Action No xxxxx

Thank you for your letter dated xxxxxxxx and copy of the Order of the Court dated xxxxxxxx.

The outcome of the proceedings will be advertised in the Patents and Designs Journal on xxxxxx and the fact of the order will also be noted in the patents register.

Yours faithfully

Your name
Litigation Section
Patents Directorate

ANNEX 6

1. **Clear records.** Patent number GB/EP

DATE	
JOURNAL	<i>Insert date</i>
RECORD BOOK	√
MOVEMENT CARD	√
OPTICS	√

Records cleared by

Your name Room: Ext:

(date)

2. **Publishing Section**

Please prepare a C specification.

[You must advise Publishing Section which section the proceedings relate to. You should also state whether a schedule of amendments, replacement pages or a complete specification is to be produced. You must also provide the date of the relevant Order Court as this will be the effective date the amendments were allowed by the Court]

The bibliographic details should be as for the B specification except:

[Note any changes here eg

Agent/address for service details:

Please amend address for service as follows:

(Insert address here)]