

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 EPC 2000 – Central Limitation 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 s75, the online European Patent Register (Register Plus) should be checked to determine whether there is a request to centrally limit an EP patent and if so, whether the applicant wishes a stay in proceedings to allow for conclusion of the process or wishes to proceed (see www.epoline.org/portal/public/registerplus). A standard letter is issued offering an option to stay the s75 or proceed (see annex 7).

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

Official letter issued to attorney on XX.XX.XX. See copy on file. B/F for 1month (always to a Wednesday).

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

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

All this information must be filed at 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:

- Check the following have been provided:
 - The particulars of the proposed amendments.
 - The grounds on which the amendments are sought.
 - Whether the applicant will contend that the claims prior to amendment are valid.
 - If the application for amendment applies to an EP (UK) patent the A3 should ensure that the specification is the latest version using Register Plus and check that there are no central amendment proceedings ongoing, refer to 23.03.

- 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.

If the question of dispensing advertisement is raised prior to the Court Hearing, the applicant will inform us either in a letter or possibly a draft

Court Order. On receipt, the s75 application should be stayed pending the outcome of the Court Hearing.

Alternatively, the applicant may request that prior to advertisement the Deputy Director considers the amendments. In this case, the A3 should refer the amendments to the Deputy Director who will then decide whether Comptrollers comments should be issued prior to advertisement and if so, will forward comments in due course.

Sometimes, on receipt of the application for amendment, the courts will have already considered the amendments and dispensed with the need for them to be advertised for opposition. The A3 should action any Court Order received, make the appropriate entries on the Register and prepare a final advert for the Patents and Designs Journal.

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

- 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) (see annex 3) letter advising the applicant when the notice of proposed amendments will be advertised in the Journal. Issue a copy of the S75(a) letter to the other party to the proceedings. (see annex 8)

PECS:- Letter created, locked and imported from PROSE

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

The A3 will request the A1 to:

- make up a Litigation file (see Chapter 25) OR arrange for the application to be indexed and scanned as a PECS case
- make a free text entry on OPTICS using REG ENT
- make up a movement card for the case (not required if case is a PECS case).

PECS:- The A1 attaches a request for indexing and scanning to the application and sends it to the Index and Scanning section. For amendments filed electronically, the A3 should print a paper copy of the amendments before liaising with the A1.

Where a paper file has been made up, it should 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.

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 confirm whether the Comptroller wishes to be represented in Court. (The “Comptroller’s comments”). Before issuing to the Deputy Director, the A3 will complete the Comptrollers Comment Log. (see annex 9)

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

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) (see 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. Issue a copy of the letter to the other party to the proceedings.

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

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

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.

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

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). The Court Order should be referred to the Deputy Director for information/confirmation or clarification on how to proceed.

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

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 (see annex 5) to the applicants' attorney acknowledging receipt of the Court Order and issue a copy to the other party to the proceedings. (see annex 8). 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.

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

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).

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.

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

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).

PECS:- Use the assemble and enhancer function to apply the amendments

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 Publishing Section for a C specification.

PECS:- Create, lock and import a minute from PROSE (doc code is MINUTE-LIT), then create and send a “PSM – s75” message to DD requesting authorisation to apply the certificate. Once a message is received from the DD, the appropriate certificate should be pasted in to a Word document, a DD electronic signature applied and the certificate imported using manual import (doc code is CERTIFICATE).

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

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).

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 reproduced as a C print. 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).

PECS:- Create, lock and import minute from PROSE (doc code MINUTE-LIT), then create and send a "PSM – s75 Amendment" message to the Publishing Team mailbox.

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 1

Printed PDJ Notice

Application for Amendment of Specification now open to Opposition

Section 75 before the court

If you intend to oppose the following amendments, you must **within 14 days** from the appearance of this advertisement, file and serve on all parties and the Comptroller a notice opposing the application. This must include the grounds relied on.

Section 75 before the comptroller and Section 27 amendments

If you intend to oppose the amendments filed under section 75 before the comptroller or amendments filed under section 27, you must **within 4 weeks** of the appearance of the advertisement under section 27 and **within 2 weeks** under section 75, file two copies of Patents Form 15 giving the comptroller notice of opposition to the amendments. You also need to file two copies of a statement setting out fully the facts of your case and the relief that you are seeking.

Section: 75 before the Court

Patent Number: 2345678

Patent Court Action Number: HC 12345

Title of **patent:**

XX

xxx

International classification: xx xxxxxx

Name of patent proprietor: XXX

Patent proprietor's address for:

XX

xx
service

These amendments may be viewed on our website

.....

Section: 75 before the comptroller

Patent Number: 2356487

Title of patent:

XX

x

International classification:

XX

xxx

Name of proprietor:

XX

xxx

For a copy of these amendments, phone Litigation Section (01633 814376)

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 | 4 weeks | 2345678 xxxxxxxxxxxxxxxxxxxxxx x | H04G | xxxxxxxxxxxxxx |
| 75 | 3215 29 Jan 03 | 2 weeks | 2124567 xxxxxxxxxxxxxxxxxxxxxx x | G22F | xxxxxxxxxxxxxx |
| 75 | 3214 22 Jan 03 | 14 days | 2456789 xxxxxxxxxxxxxxxxxxxxxx x | A69B | xxxxxxxxxxxxxx HC 123456 xxxxxxxxxxxx, xxxxxxx, xxxxxxxxxxxxxx |

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.

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

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 considered the proposed amendments in the context of clarity, added matter and support under sections 14(5) and 76 of the UK Patents Act.

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.

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

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 xxxx

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

The outcome of the proceedings will be advertised in the Patents and Designs Journal on xxxxx and noted in the patents register.

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

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]

Deleted

ANNEX 7

c/o

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

Direct Line: 01633 81xxxx
E-mail: xxxxxxi@ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park
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.

Latest date for reply xx xx xx

I refer to your application for amendment filed on xx. Xxxxx. Xxx .

On checking the European Patent Office register, it appears that you have filed an application to centrally limit your patent at the EPO. In these circumstances there are two options available to you

- a. staying the request until the conclusion of the central limitation process, or
- b. proceeding with the request to amend under Section 75

If the national and central process results in different amended claims, you should be aware that there may be an issue as to which amendment takes precedence.

You should advise me of your decision regarding the above by xx. Xxxxx. xxxx .

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

Yours faithfully

Your Name
*Litigation Section
Patents Directorate*

April 2009

ANNEX 8

c/o

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

Direct Line: 01633 81xxxx
E-mail: xxxxxxxx@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 (**.....**)
Action No.

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

Yours faithfully

Your Name
Litigation Section
Patents Directorate

