

A GLOSSARY OF LEGAL TERMS and ABBREVIATIONS COMMONLY USED IN THE IP AREA

Ab initio	[From the beginning].
AC	Appeal Cases.
ADR	Alternative Dispute Resolution - methods of resolving disputes otherwise than through the normal trial process. See also entries under 'Arbitration', 'Early neutral evaluation', 'Med-arb' and 'Mediation' below.
Affidavit	A written statement made upon oath or affirmation and signed in the presence of a person who is authorised to administer oaths (normally a solicitor). Authority: Civil Procedure Rules - Practice Direction 32.
Alternative Dispute Resolution	See entry under 'ADR' above.
Amendments	Alterations sought to specifications or other documents because the drafter has become aware of new facts, circumstances have changed or because he has changed his mind.
Anton Pillar Order	See entry under 'Search Order' below.
Arbitration	An alternative method of resolving disputes between parties. The right of Appeal from a decision of the arbitrator is limited by the Arbitration Act 1979. (See also entry under 'ADR' above).
Appeal: Patents	Not all decisions of the Comptroller are subject to appeal. In relation to patents, where decisions are open to appeal, appeal may be to the Patents Court (part of the High Court) or (if the proceedings are held in Scotland) to the (Outer) Court of Session. Further appeals, with leave, may lie to the Court of Appeal and the House of Lords. In

Scotland, any appeal from the Outer Court of Session lies to the Inner Court of Session. (See section 97 of the Patents Act 1977).

Appeal: Designs

Under section 28 of the Registered Designs Act 1949, appeals from the decisions of the Registrar lie to the Registered Designs Appeal Tribunal. In relation to design right, under section 251 of the Copyright, Designs and Patents Act 1988, appeals on decisions under section 246 of the Act lie to the High Court or Court of Session. Appeals under sections 247 and 248 lie with the Registered Designs Appeal Tribunal by virtue of section 249.

Assignment

The transfer or assignment of intellectual property rights from the owner of such rights to another person or legal organisation.

Burden of proof

The obligation of proving facts. In general, the burden (onus) lies on the claimant (plaintiff).

Caveat

A request for information filed on PF47/77 in accordance with Patents Rule 92.

CCR

County Court Rules.

CDPD

Chancery Division Practice Direction.

Certiorari

See entry under Quashing Orders

Civil Procedure Rules

See entry under 'CPR' below.

Claim

A document forming part of the Statement of Case. The Patents Rules 1995, the Registered Designs Rules 1995, and the Design Right Rules 1989, for example, set out detailed requirements regarding the content of such documents. Within the Rules, the term 'Statement' = 'Claim'.

Claimant	The name, under the Civil Procedure Rules, given to the party filing proceedings - ie making a claim.
Claim form	Under the Civil Procedure Rules, the name given to a Writ/Summons. A claim form is used to commence proceedings in the High Court or the County Court irrespective of the nature of the claim. (For Appeals to Patent Court from the Comptroller see 'Notice of Appeal' below).
CLR	Commonwealth (of Australia) Law Reports.
CMLR	Common Market Law Reports.
Compulsory licence	Applications from a third party, may be made to the Comptroller to order, for example, the grant of a licence under a patent or to make an entry in the register making licences under a patent available as of right. Any such application must be made on one of the grounds set out in section 48(3) of the Patents Act 1977. Applications may be made after 3 years from the date when notice of grant appears in the Journal, though this period can be altered. In relation to design right, compulsory licences are available in the last 5 years of the design right.
Consideration	In relation to transferring rights in or under a patent, a clause relating to the amount paid for the rights in the patent.
Corrections	Alterations sought to a specification or other document so that it better expresses the intention the drafter had at the time of drafting.
Costs	In proceedings before the Comptroller, costs made be awarded in respect of <i>inter partes</i> proceedings under the provisions of the Patents Acts 1949 & 1977, the Registered Designs Act 1949,

the Trade Marks Acts 1938 & 1994 and the Copyright, Designs and Patents Act 1988. The usual practice is to award a contribution to costs guided by a scale published in the various Office Journals and not to award full costs; however, Hearing Officers have a wide discretion when awarding costs. (See also entry under 'Security for costs').

Counter-Claim

A document filed in response to a Claim). The document sets out fully the grounds of opposition or objection ie which allegations in the Claim the opponent disputes and which he does not. The counter-claim forms part of the Statement of Case. In Office proceedings, the counter-claim is known as counter-statement.

Counter-statement

See entry under 'Counter-Claim' above.

CPC

Community Patent Convention.

CPR

Civil Procedure Rules - rules for proceedings in the High Court and County Courts.

Damages

A sum of money awarded by the Court as compensation to the claimant.

De minimis non curat lex

[The law does not concern itself with trifles]. Small departures from the law may be overlooked if not significant.

Decisions

The exercise in writing or orally by the Comptroller of any discretion vested in him by, for example, the Patents Act 1977 and the Patents Rules 2007.

Declaration of non-infringement

Request made under section 71 of the Patents Act 1977 for a declaration that an act does not or a proposed act would not constitute an infringement of a patent.

Deponent

The name given to a person who makes a deposition (ie affidavit) under oath.

Disclosure	Usually in the form of a request, this relates to the making available of relevant documents believed to be in the possession of the other party in <i>inter partes</i> proceedings.
Early neutral evaluation	An alternative method of resolving disputes between parties. A neutral evaluator who has legal or other expertise will hear the core evidence from the parties or their legal representative at an early stage in the case. Having listened to the basic evidence, the evaluator will offer a frank assessment of the strengths and weaknesses of the case in the hope that this will lead to a settlement between the parties without further litigation. (See also entry under 'ADR' above).
ECFI	European Court of First Instance.
Entitlement	An <i>inter partes</i> proceeding relating to who owns a patent or an application for a patent.
EOT	Extension of time - a request made to extend a time period that has been set by the Office
EPC	European Patent Convention. At present the Convention has 34 Contracting States.
EP application	An application for a patent under the EPC. By means of one application, it is possible to obtain patent protection for an invention in any of the Contracting States by designating that particular state.
EPO	European Patent Office
EPOR	European Patent Office Law Reports.
Evidence	Information in the form of personal testimony, documents or objects filed in

support of the issue in question.

Ex nunc

[From now] Example: The amendment of a patent application is governed by section 19 of the Patents Act 1977 and takes effect *ex nunc*, ie from the time the amendment is made.

Ex Parte Proceedings

Refers to proceedings between one party eg an applicant for a patent, and the Comptroller.

Ex tunc

From then] Example: The correction of an application or the specification of a patent or of any document filed in connection therewith is governed by section 117 of the Patents Act 1977 and takes effect *ex tunc*, ie the document is deemed always to have been in the state in which it is after the correction.

Exclusive licence

A licence that allows, for example, only one person to use a patent ie means that the patent owner no longer has the right to use the patent although he may still collect royalties on the use of the patent.

Exhibit

Document or object included as part of the written evidence in proceedings before the comptroller.

Freezing injunction

Issued by the courts, this allows for the freezing of a defendant's assets to prevent disposal. It can be used to freeze assets worldwide (previously known as Mareva Injunction).

Generalia specialibus non derogant

[General things do not derogate from special things]. A principle of statutory interpretation that states that if a matter falls under a specific provision and a general provision it shall be governed by the specific provision.

Hearsay evidence

Evidence as to what someone else has seen, said or written.

HO	Hearing Officer
In camera	Parts of Hearings held before the Comptroller may, at his discretion, not be open to the public. In addition, certain proceedings are not open to public inspection.
Infringement	Any act, as defined within intellectual property legislation, carried out by a third party that falls within the scope of the intellectual property rights owned by another and is performed without the authorisation of the owner of those rights.
Injunction	A court order prohibiting a person from doing something or requiring a person to do something.
<i>Inter Partes</i> proceedings	Proceedings between two or more parties. Examples in relation to patents include entitlement and revocation proceedings; for design right such proceedings may relate to the subsistence of design right or the term of the design right.
Judicial Precedent	A previous judicial decision or proceeding that may be relied upon.
Judicial Review	Order 53 of the Rules of the Supreme Court introduced a comprehensive system of judicial review. A statutory basis for this procedure also appears in s 31 of the Supreme Court Act 1981. Where no right of appeal is given, it may be possible to challenge the decision of an inferior court or public tribunal by recourse to the supervisory jurisdiction of the High Court. This means that generally only decisions of the Comptroller in respect of which no appeal is available, decisions under the PCT and decisions of the RDAT are likely to be subject to judicial review. An application may cover all the remedies available - certiorari, mandamus,

prohibition, declaration and injunction. In practice, only certiorari and mandamus are likely to be relevant to proceedings before the Comptroller, although prohibition could also be so.

Jurat

The final statement signed by a person who is authorised to administer oaths indicating when the affidavit or statutory declaration was sworn, affirmed or declared.

Licence

The means by which the owner of a patent grants permission to another to manufacture use or sell the invention protected by his patent whilst at the same time retaining ownership. In return, the owner receives payments known as 'royalties'.

Licence of Right

See entry under 'LOR' below.

Locus standi

[A place of standing]. A right to be heard in court or other proceeding where there is a sufficient interest.

LOR

Licence of Right - section 46 of Patents Act 1977. The patent owner may apply to the Office for an entry to be made in the Register that licences, under the patent, are available 'of right'. This means that the patent owner then cannot refuse to licence the invention and that he pays renewal fees at half the usual rate. The terms of such licences may be settled by the Comptroller if the parties cannot agree. For Design Right, under section 237 of the Copyright, Designs and Patents Act 1988, a third party is entitled as of right to a licence to do in the last 5 years of the design right term anything which would otherwise infringe the design right. The terms of such licences may be settled by the Comptroller if the parties cannot agree. See also 'licence', 'compulsory licence', 'non-exclusive licence', 'exclusive

licence’.

Mandamus

[we command] In connection with judicial review, one of the remedies available - to issue an order of the court requiring an inferior tribunal to do something it has previously unlawfully refused to do.

Manual of Patent Practice

Office manual covering procedures and practice in relation to the Patents Act 1977, Patents Rules 2007 and precedents.

Mareva Injunction

See entry under ‘Freezing injunction’ above.

Med-arb

An alternative method of resolving disputes. This is a hybrid process that begins with traditional mediation. However, if the mediation does not result in the dispute being resolved within a given period of time, the process will end with a binding arbitration. (See also entry under ‘ADR’ above).

Mediation

An alternative method of resolving disputes between parties. A mediator is appointed to help both parties reach an acceptable solution. (See also entry under ‘ADR’ above).

MOPP

See entry under ‘Manual of Patent Practice’ above.

Names of parties

See table at end of glossary.

NMP

Nine Mile Point. The Office’s warehouse facilities for the storage of files.

Non-exclusive licence

A licence that allows, for example, both the patent owner and the licensee to use the patent. It also allows the patent owner to agree licences with more than one person.

NOPI	Not open for Public Inspection.
Notice of Appeal	Appeals to the Patent Court from the Comptroller must be in the form of a Notice of Appeal.
Obiter dictum	[A saying by the way]. Something said by the judge, whilst giving judgement, that is not essential to the decision. Therefore not binding as a precedent.
OPI	Open for Public Inspection. In relation to a patents file, for example, that part which members of the public can inspect as from the date of 'A' publication of the application.
Open for public inspection	See entry under 'OPI' above.
Opponent	Name given to person opposing opposition proceedings
Part 36 offer	Under the CPR, applies to either party and thus applies to the Claimant where the relief sought is a payment and in all other instances where the relief sought is not in respect of payment. The Rules provide that the offer must be in writing and can relate to the whole claim or part of a claim. A Claimant, for example in a patent matter, can put in a Part 36 Offer stating that he will accept in compromise of the proceedings, undertakings of a specified nature and £X in respect of damages.
Part 36 payments	Under the CPR, relates to payments into court in settlement of a money claim. The money claim may be all or part of the claim. The Defendant, if he wishes to avail himself of the Part 36 process, must actually pay the money into court in settlement of the money claim - it is not sufficient merely to offer to pay a sum in compromise of the money claim.

Particulars of case	Term used in CPR. They may be included in the claim form or may be served separately when starting proceedings. Part 16 of the CPR sets out what the particulars of case must include.
Patent Co-operation Treaty	See entry under 'PCT' below.
PCC	Patents County Court.
PCT	Patent Co-operation Treaty. This is administered by the World Intellectual Property Organisation (WIPO), a UN organisation based in Geneva. The Treaty has at present 133 Contracting States.
PCT application or filing	An application filed under the PCT. By means of one application it is possible to obtain protection for an invention in any of the Contracting States by designating that state in the application.
PD	Practice Direction supplementing a Civil Procedure Rule.
PDJ	Patents & Designs Journal.
PLT	Patent Law Treaty. A treaty to harmonise formal requirements being negotiated under WIPO auspices.
Practice form	Form to be used for a particular purpose in court proceedings, the form and the purpose being specified by a Civil Procedure Rules Practice Direction.
Pre-action protocol	Statements of understanding between legal practitioners and others about pre-action practice and which are approved by a relevant Civil Procedure Rules Practice Direction.
Precedent	A previous decision or proceeding which may be relied upon.

Preliminary hearing	A hearing appointed to decide a point of procedure, usually in <i>inter partes</i> proceedings.
Pre-hearing review	See entry under 'PHR' below.
Priority Date	The priority gained by virtue of Article 4 of the Paris Convention. When applicants file an application in any Convention country, they can then file subsequent applications in any of the other Convention countries (including the country where first filed) and claim the earlier date of the first filed application providing the scope of the later application is not wider than the original and providing the later filed application is made within 12 months of the original in relation to patents and 6 months in relation to registered designs.
Priority Document	A document which establishes a priority date.
Prima facie	[Of first appearance; on the face of it] - based on a first impression.
Privilege	The right of a party to refuse to disclose a document or produce a document or to refuse to answer questions on the ground of some special interest recognised by law.
Prohibition	In connection with judicial review, one of the remedies available - to prevent some allegedly unlawful/arbitrary action from taking place.
PHR	Pre-hearing review. The purpose of this is to ensure that all the issues raised at the case management conference have been dealt with and to give any final directions considered necessary in relation to the hearing.
Quashing Orders	A remedy available under judicial review that quashes the ultra vires

decision as if it were never made.(previously known as certiorari).

Ratio decidendi

[The reason (or ground) for a judicial decision]. Usually a statement of law applied to the problems of a particular case. In essence, the principle upon which a case is decided.

RDAT

Registered Designs Appeal Tribunal.

Restoration

The proceedings by which a patent which has lapsed through failure to pay renewal fees may be restored.

Revocation

A request to have, for example, a patent revoked (ended) because it is not valid.

Royalties

The name given to the payments made by a licensee to the owner of a patent - the licensor.

RPCs

Reports of Patent, Design and Trade Mark Cases.

RSC

Rules of the Supreme Court. ("The White Book").

Search Order

Previously known as an 'Anton Pillar Order' taking its name from the first case that developed the concept (Anton Pillar V Manufacturing Processes, Limited [1976] Ch 55. Issued by the High Court, the order allows premises to be searched and infringing material seized. Safeguards exist to prevent abuse.

Security for costs

Where a claimant neither resides nor carries on business in a state that is party to the Brussels Convention, the Comptroller can, in many proceedings, require them to give security for costs, for example, under section 107(4) of the Patents Act 1977 and rule 22(2) of the Design Right (Proceedings before the Comptroller) Rules 1989, before

allowing the proceedings to continue.

SI

Statutory Instrument.

SPC

Supplementary Protection Certificate (for medicinal and plant protection products). The certificate is intended to compensate a patentee for the loss of effective protection arising out of the time taken to obtain regulatory approval to place on the market as either a medicinal or plant protection product a product which is protected by a patent ('the basic patent'). The basic patent may protect the product as such, a process to obtain the product or an application of the product. A certificate takes effect at the end of the lawful term of the basic patent but does not extend the term of the patent itself. It extends the protection conferred by the patent in respect of the product covered by the authorization to place the corresponding medicinal or plant protection product on the market, and any use of the product as a medicinal or plant protection product that has been authorized before expiry of the certificate. Subject to the payment of renewal fees, the term of a certificate is equal to the period which elapsed between the filing date of the patent and the date of first authorization in the EC reduced by a period of 5 years. The term of a certificate may not exceed 5 years.

Statement

See entry under 'Claim' above.

Statutory Declaration

A written declaration agreed in the presence of a Justice of the Peace or a person who is authorised to administer oaths, but not made upon oath or affirmation. (Statutory Declaration Act 1835).

Statement of Case

The statement and the counter-statement filed in *inter partes*

proceedings are each a statement of case. Taken together, these documents indicate the facts that are in dispute between the parties and the relief sought.

Statement of Truth

All statements of case, witness statements and applications to the court must contain a statement by the parties that they believe the facts they have set out to be true which must be signed.

Stay

A stay imposes a halt on proceedings. Within the courts, although proceedings may be stayed, any steps allowed by the Civil Procedure Rules or the terms of the stay, may be taken. Proceedings may continue once a stay is lifted.

Subpoena

A writ is a document which requires a person to do or to refrain from doing something. The Comptroller does not have authorisation to issue writs though under Rule 86 of the Patents Rules 2007, the Comptroller in relation to the giving of evidence, the attendance of witnesses and the disclosure and production of documents, has all the powers of a High Court judge other than to punish summarily for contempt of court.

Substantive Hearing

The final hearing in *inter partes* proceedings following which the Comptroller will issue a decision on the main matter in dispute.

Supplementary Protection Certificate

See entry under 'SPC' above.

Summons

See entry under 'Claim form' above.

Tribunals

Bodies outside the hierarchy of the courts with administrative or judicial functions. The Office is a Tribunal, monitored by the Council on Tribunals established in 1958.

Third party terms

Conditions placed on the reinstatement of an application or patent which are designed to protect a third party who may have started to work the invention.

TRIPS

Trade Related Aspects of Intellectual Property Matters. (Part of GATT - General Agreement on Tariffs and Trade).

Ultra vires

[Beyond the powers]. Term relates generally to the excess of legal powers or authority. (A ground for judicial review).

Witness statement

A signed written statement equivalent to the oral evidence which that witness would, if called, give in evidence at the hearing.

Writ

See entry under 'Claim form' above.