

## **Section 21: Observations by third party on patentability**

21.01 Rule 33 is relevant to this section.

### **Section 21(1)**

*Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations, and the comptroller shall consider the observations in accordance with rules.*

r.33(1) 21.02 Any written communication relating to an application (whether sent by conventional or electronic mail) which is received from any person other than the applicant or the agent responsible for the application should be forwarded to the examiner dealing with the case. Where the application is a PECS dossier, the Formalities Examiner should send the appropriate PECS message to the substantive examiner and insert the appropriate warning label on the dossier cover. The examiner should see that the communication is acknowledged and is copied to the applicant, but acknowledgement by letter is not necessary where the dedicated email address is used (see 21.02.1) since a reply is sent automatically from this address. Although s.21 refers to observations on patentability, i.e. bearing on whether or not the invention fulfils the conditions of s.1(1), in practice it is generally desirable to send to the applicant a copy of any letter received from a third party informant which purports to relate to an application, so that he may have prior notice of a document which may be laid open to public inspection. The same procedure applies if observations are filed prematurely (i.e. before s.16 publication of the application in question). When premature observations relate to patentability, the applicant should be informed that the observations will be treated as having been filed under s.21 if and when the application is published. If termination action has been taken or is appropriate when any such letter is received, receipt should be acknowledged and the letter should merely be copied to the applicant and placed on the file open to public inspection.

s.124A(3) 21.02.1 Directions made under section 124A prescribing the form and manner in which observations under section 21 may be submitted using electronic media came into force on 25 May 2005. These Directions were published in PDJ No. 6056 on 15 June 2005 and are reprinted in full in the "Relevant Official Notices and Directions" section of this Manual. The Directions require observations to be sent by email to address [section21@ipo.gov.uk](mailto:section21@ipo.gov.uk) or to be delivered on digital media. Observations sent electronically to any other address may be treated as not filed, but should not generally be treated in this way if they comply with the other conditions in these Directions and are successfully received at an email address within the Office. Observations received at the dedicated email address will be acknowledged by an automatic email reply. This email mentions that if the observations can be treated as made under section 21, they will be forwarded to the examiner for consideration, placed on the open part of the file, and a copy sent to the applicant.

[ The case examiner should acknowledge the communication (unless it is anonymous or a reply has been sent from the dedicated email address for receiving section 21 observations) and send a copy to the applicant. If Form 10 has been filed and the application is awaiting examination the file should be kept in the examining group. If however Form 10, or a response to a report under s.18, is awaited, the file should be returned to the relevant formalities group for storage (paper cases only).

[ Anonymous observations should so far as possible be treated the same as those from named informants. When copying the observations to the applicant, the examiner may add a sentence pointing out that they were filed anonymously.

[ Provided that the observations bear, at least in part, on patentability and have been

received in the Office after s.16 publication but before the date of issue of the grant letter, EL18 (which also includes information regarding s.21 observations) should be sent to the informant unless an email reply has been sent from the dedicated section 21 email address and EL23 (or ELC23, see 21.06) to the applicant. If the observations do not relate to patentability (or, regardless of whether they relate to patentability, are received when termination action has been taken or is appropriate) EL18B should be sent to the informant and EL23C to the applicant, but EL18B should not be sent if the dedicated section 21 email address has been used. (For the case where observations have been received on or after the date of a (first or final) report under s.18(4), see 21.15, and 21.16).

[ If observations relating to patentability are filed before s.16 publication of the application in question, EL18 should be modified using the text of EL18A. At the same time, the observations should be copied to the applicant using EL23B. If the observations do not relate to patentability (or, regardless of whether or not they relate to patentability, are received when termination action has been taken or is appropriate) EL18B should be sent to the informant (unless the dedicated section 21 email address has been used) and EL23C to the applicant together with a copy of the observations.

[ Any observations going to matters other than patentability should be referred by Examiners to their senior officer. It may be appropriate to bring another relevant section of the Act to the attention of the informant, eg s.8 if the observations appear to relate to entitlement, but care is necessary to avoid any implication that the Office requires the party to take action under that section or guarantees the outcome of any such action. ]

21.02.2 Observations on patentability filed in relation to one application can, where appropriate, be considered in relation to any other application relating to the same invention. In particular, where observations filed on an earlier application from which a later application claims priority appear relevant to the later application because it relates to the same invention, the applicant should be so advised, and the observations should be copied to the applicant if not previously copied. If the earlier application is unpublished, the observations may nevertheless be copied onto the open file of the later application.

r.33(2)  
r.51(2)(d)

21.03 If however observations filed by a third party informant contain libellous or obscene matter, the text both as communicated and as placed on the open file, should have the offending remarks omitted. The informant's observations should merely be acknowledged, while the letter sent to the applicant should be modified to indicate that some non-relevant matter has been deleted from the enclosed copy of the observations.

#### PECS Dossiers

When the Formalities Examiner notices potentially offensive or libellous material in a document filed, they should apply the appropriate document code, and not set it as open to public inspection, if it is received after s.16 publication. The Formalities Examiner should import a minute drawing the examiner's attention to the potentially offensive material and send the appropriate PECS message to the examiner. Where the case requires another action (e.g. search, exam or amendment) the standard message for that action should be sent as normal.

The examiner should consult their Deputy Director when faced with such material and where the Deputy Director is in agreement, the offensive or libellous material should not be open to public inspection. The examiner should print out a copy of the document, blank out the potentially offensive or libellous material, and send it to index and scanning with a completed pro forma. The completed pro forma should indicate the relevant document code, the document date (which should be the same as the original document) and the confirmation message(s) required (message and recipient mailbox). If the case has been published, one of these confirmation messages should be the standard message used to ask Formalities to set the document status to 'OPI'. The other confirmation message should be for the

examiner so that they can check and 'Set Handle' the imported document. The original document code should be left and kept on the active part of the file.

If the examiner does not think that the highlighted material is offensive or libellous, and may therefore be open to public inspection, they should write a minute to formalities asking them to reinstate the original document code, remove any annotation in the TOC, and set the public status to 'Yes' if the application has already been s.16 published. The appropriate PECS message should then be sent to the appropriate formalities group.

If potentially offensive or libellous material is noticed by an examiner, they should immediately ask formalities to change the document code to ensure its status is set as 'not open to public inspection'.

After the offensive or libellous material is censored or after it is determined that there is no offensive or libellous material present, it is then the examiner's responsibility to remove the warning label from the cover. This will indicate to the London Front Office and to Cashier Section that all OPI documents on file may be inspected by the public if requested.

If the warning label has not been removed and a request to inspect the file is made, the relevant examiner will be contacted before any OPI documents are made public.

#### Paper cases

The formalities examiner fixes a Third Party Observations warning label on the front of the shell, to prevent release of the file for public inspection until the case examiner has inspected and, if necessary, edited the observations. (It is the responsibility of the case examiner to remove the label when he has completed such inspection and editing.) Censored copies for placing on the open file and for sending to the applicant should be produced by temporarily masking the offensive parts and photocopying. The original letter should be placed, adjacent the internal papers, in an A4 envelope clearly marked "Not open to public inspection". ]

r.33(3)

21.04 The 2007 Rules make specific provision with regard to the copying of documents referred to in the informant's letter. In general, documents referred to in observations should be copied to the applicant unless the document is clearly readily available to the applicant or photocopying is impractical. However, it is at the comptroller's discretion whether to send the applicant a copy of any document received from the third party and referred to in the observations. If other materials (eg samples) have been sent with the letter the applicant should be informed that they are available for inspection in the Office.

[ If a copy of a document sent with an informant's letter is requested under rule 48 (using Form 23), it should be supplied. ]

21.05 Documents or other materials which are filed by the informant under s.21 must normally remain on the open file of the application in question. Hence if a third party informant sends such material to the Office with a view to its being used in this way, but requests that the material be returned to him in due course, he should be informed that either the material must remain on file or that it will be returned to him without being considered under s.21. Having regard to the terms of r.33 it would appear that the observations should be sent to the applicant irrespective of any request under r.53 that the observations, or parts thereof, be treated as confidential. It may however be possible for parts of the observations to be treated as confidential to the extent that they are not laid open to public inspection on the file. In considering any such request under r.53, the examiner should consider the issue of public interest, whereby objections to patentability should only be made on the basis of documents which are open to public inspection.

[ Documents filed with a letter containing observations under s.21 should be put on the open part of the file. If necessary on a paper case, the documents may be put in a separate envelope (not the envelope provided for copies of documents cited as a result of the s.17 search), which should be located on the open part of the file and

marked with a reference to the letter with which the documents were filed. Documents or samples which cannot be readily accommodated on the file should be placed in a box file or other suitable container and a minute imported into the dossier stating where the box file is stored. If the application is a paper case the box file should be strapped to the shell, and an appropriate reference be made on the open file. The shell must not be put in the box file. ]

21.06 The action specified in paragraph 21.02 should be taken without delay, unless substantive examination is imminent, in which case the observations should be considered by the examiner and a copy sent to the applicant at the same time as the report under s.18. Where the observations are received after the issue of a report under s.18(3), they should be copied at once to the applicant; it is up to the examiner to decide whether to accompany them by a further report under s.18(3) taking account of the observations (see 18.50), or whether to defer such action until a reply is received to the outstanding report. Where late-filed observations give rise to a report under s.18(3), the compliance period may be extended as described in 20.02.1.

[ When sending the copy of the observations to the applicant at the same time as the report under s.18, ELC23 should be incorporated in the covering letter to the s.18 report instead of sending EL23. ]

r.33(4)  
r.33(5)

21.07 Observations on patentability which are received before a report under s.18(4) has been issued should be considered by the examiner, who must make up his own mind whether on the balance of probabilities they support a sustainable objection. For example, he should consider any alleged prior art in exactly the same way as he would if it had been found in the course of the search under s.17. If the date at which any alleged prior art was published, used or otherwise made available to the public is not given or cannot be established (eg by following the procedure in 21.13 if it is felt that the informant is likely to be aware of the date), no objection should be raised. If an objection does arise the examiner should normally express this in a report under s.18(3) in his own words, rather than as a commentary on the observations. If however an examiner fully agrees with well-argued observations he may raise an objection of lack of novelty or inventive step by formally citing the relevant documents and then drawing the applicant's attention to the supporting argument as set out in the observations. If, in the examiner's view, no objection arises, no comment on the observations is necessary. If the application is in order for grant, the applicant should be informed that it will not be sent for grant for two months (in order to enable him to file voluntary amendments) unless he requests that it be sent earlier.

[ When a substantive examiner makes a formal objection based on material provided by a third party, the matter should not be dropped unless the applicant makes a response sufficient to counter the objection. While in general no comment on the observations should be made when the examiner is not raising an objection arising out of them, if it becomes necessary to refer to the observations, for example because of a specific query from the applicant, a comment that the observations have been taken into account in framing the s.18(3) report may be made. Reasons for not raising objections should be briefly recorded as a minute. ]

21.08 S.21 requires the informant to state reasons for his observations. If no reasons are (explicitly) stated the observations should nevertheless be acknowledged, be put on the open file, and the applicant sent a copy. The examiner should also consider the observations, which may be constituted, for example, merely by a list of specifications, and act upon them as he considers appropriate. If reasons for the "observations" are not stated the examiner should not ask the third party for any.

21.09 When the documents referred to by a third party are numerous and/or lengthy the examiner should do his best to identify those portions likely to be relevant to novelty or obviousness. Exceptionally, if the examiner is unable to identify the relevant passages, the third party may be requested to do so, but, if he does not, the matter should not be pursued with him.

21.10 If a communication giving the results of a search in another Office is received from a foreign agent apparently acting for the applicant in another country, it should be acknowledged and copied to the applicant. The contents of the communication should be treated as in paragraphs 17.44 and 17.46.

[ EL18B and EL23C should be used. ]

21.11 When any document of which the Office is informed by a third party has been formally cited (as distinct from the applicant being merely notified of it under r.33(1)), then it should be included in the search report on the front page of the printed specification (see 18.85).

[ Any document cited (formally or otherwise) which was not listed on the A document should be recorded as soon as possible on OPTICS and on the internal search report (see 17.105, 18.11 and OPTICS Manual (Patents) (5.4.2-5.4.6)). When a document previously merely notified is subsequently formally cited, the substantive examiner should send the applicant a copy of it together with the relevant s.18 report. ]

21.12 An allegation of prior use received from a third party should be treated as described in paragraph 18.24.

21.13 If an applicant denies material facts contained in observations made under s.21, for example an allegation of prior use or prior publication, and it is thought probable that the informant could provide evidence to substantiate his allegation, then it is possible to invite him to do so. This procedure may also be used if an examiner considers that s.21 observations give insufficient information to justify action on novelty or obviousness grounds but that there is a strong probability that further information could be provided by the informant enabling the objection to be made. The informant would also be approached for evidence or information concerning the date of publication of a highly relevant document which he has supplied. However such action should not be taken unless the information already available provides a clear indication both of the need for the further information and also of the likelihood that the third party will be in a position to supply it. Moreover, any such invitation to the informant should not be a direct request for evidence or information; it should instead be indicated that an objection cannot be raised or pursued unless such material is available. Applicants must accept that the onus is on them to demonstrate that they are entitled to grant but care should always be taken not to take any action which could imply that the informant is a party to the proceedings (see 21.18-21.19). If an allegation by the informant is supported by an affidavit or statutory declaration, then any denial by the applicant should also be sworn.

[ The Deputy Director should be consulted before approaching the third party. A request for further information or evidence should invite a response within a specified period (eg two months); if no response is received within this period the matter should not be pursued. ]

#### **ACTION AFTER ISSUE OF A REPORT UNDER S.18(4)**

r.33(5)  
r.107

21.14 Observations from a third party can be considered by the examiner only if they have been received in the Office before a report (whether first or final) under s.18(4) has been issued. If they were received before the issue of such a report but too late to prevent its issue, and they give rise to a fresh objection, the report may be rescinded and action taken on the observations (see 18.89). If in this case the examiner instead concludes that no fresh objection arises from the observations, he should inform the applicant that they have been considered but no objection will be raised, and the report should not be rescinded. Action may also be taken if the report under s.18(4) has been rescinded for another reason

[ If the case has been sent for grant, the publication liaison officer of the relevant division should be contacted immediately. See also 18.89. If, however, the case has not been sent for grant, cancellation does not arise. EL23A should be sent to the applicant to communicate the observations when no objection results. ]

r.33(1) 21.15 If the observations were received in the Office on or after the date of issue of a first report under s.18(4), then (unless the report is rendered nugatory by the applicant filing, under r.31(4)(a) amendments which are not allowable (see 19.18)), the third party should be informed that, because of the terms of r.33(5), the observations cannot be considered by the examiner. However, it is not necessary to inform the third party in this instance if the observations have been sent to the dedicated email address (see 21.02 and 21.02.1). If the observations were received in the Office after the end of the compliance period but before issue of a first report under s.18(4) the third party should be similarly informed. (Although the observations may need to be considered if the compliance period is subsequently extended.) In both cases the observations should be copied to the applicant in the usual way. It is up to him to decide whether to amend the specification (but see 21.17). The applicant should be informed that grant will be delayed for two months (for the purpose of giving him time to decide whether to submit voluntary amendments) unless he requests that it be granted earlier.

[ EL18B, should be sent to the informant and EL23C to the applicant. ]

21.16 If the observations were received in the Office on or after the date of issue of the grant letter (see 18.86), then the informant must be told that, since they were received after grant, they cannot be taken into consideration under s.21 but that they will be open to public inspection under s.118(1). However, a written acknowledgement should not be sent to the informant where a reply email has already been sent from the section 21 dedicated email address (see 21.02 and 21.02.1). A copy of the observations should be sent to the applicant "for information" (see 21.02). Any letter from the applicant commenting on the observations will also be placed on the open file.

[ EL18B, suitably amplified, should be sent to the informant and EL23C to the applicant.

[ Third parties contemplating filing s.21 observations sometimes enquire about the likely date of issue of the grant letter. They are not entitled to this information and should merely be advised to file the observations as soon as possible. ]

21.17 Where observations received too late to be acted upon by the examiner (see 21.15, 21.16) indicate that the invention may lack novelty by reason of a document forming part of the state of the art by virtue of s.2(3), then proceedings under s.73(1) may need to be initiated after grant (see 73.02-73.03). It is desirable that the applicant be warned of this possibility.

### **Section 21(2)**

*It is hereby declared that a person does not become a party to any proceedings under this Act before the comptroller by reason only that he makes observations under this section.*

21.18 The receipt of the communication from the third party should be acknowledged (see 21.02 and 21.02.1), and, in a case where the observations have been received too late to be considered by the examiner (see 21.15-21.17), the third party should be informed of this fact. Beyond this, he has no right to be kept informed of the progress of the application, or of the reason for action taken (or not taken) by the examiner. If he attempts to discuss the matter directly with the examiner he should be told that, by virtue of s.21(2), he has no status in the proceedings.

21.19 An informant can find out whether his observations have been acted upon by consulting the open file. If he is not satisfied with any action taken he may always supplement his observations. If, either in these circumstances or before making any observations a third party enquires as to the manner in which, for example, an allegation of prior use should be communicated to the Office he should be told that the form of observations made under s.21 is entirely a matter for the informant.