



Intellectual
Property
Office

Patents: Deciding Disputes

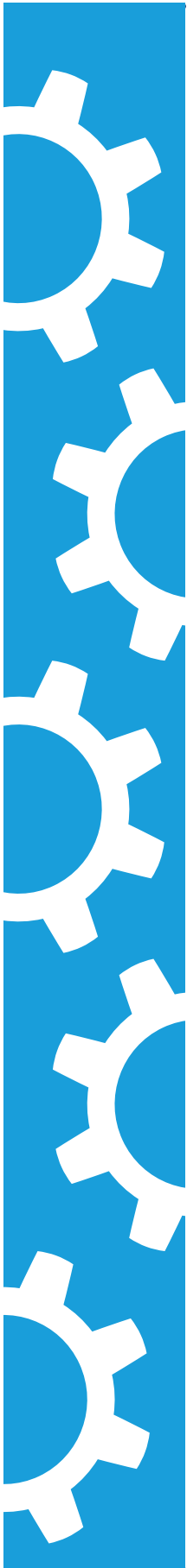




This booklet outlines procedural requirements and other matters about patents. It is not an in-depth guide and does not include many details which may be relevant in particular circumstances. You should get independent professional advice about any matters covered by the booklet and should not try to rely on this booklet alone.

All information contained in this document was correct at the time of going to print, and is available in alternative formats on request. For further information please visit our website at:- www.ipo.gov.uk or contact us on:- 0300 300 2000





Content

Chapter 1	Introduction	2
Chapter 2	Starting Proceedings	5
Chapter 3	Evidence	9
Chapter 4	The Hearing	12
Chapter 5	Appealing against an office decision	15
Chapter 6	Conclusion	17
Chapter 7	Examples of documents	18

Introduction

- 1.1 This booklet is about the Comptroller's role in resolving **disputes between different parties (sides)**. It sets out what you need to do if you want to start proceedings in the Office, or if someone starts proceedings against you. Although in proceedings before the Comptroller you can represent yourself, we advise you to employ a patent attorney or solicitor because many proceedings are complicated. We cannot recommend attorneys or solicitors to you or give you legal advice because we must stay unbiased. If you want to contact the Chartered Institute of Patent Attorneys or find a solicitor, contact details are included in Chapter 6.

Is there a different way of resolving a dispute with another person?

- 1.2 Yes. Resolving your dispute through litigation should be your last resort. It is always better to avoid litigation if you possibly can, by either trying very hard to resolve the dispute amicably or, if that fails, trying alternative dispute resolution procedures such as arbitration or mediation. If you resort to litigation, it will take up a great deal of your time, involve a lot of stress and cost you quite a lot of money, most of which you will not recover even if you are successful. Remember too that normally only one side wins at litigation and it might not be you, but if you negotiate, you stand a chance of coming up with a deal that allows both sides to win.
- 1.3 If you want to try alternative dispute resolution, the Legal Services Commission has published a useful leaflet called 'Alternatives to Court'. The leaflet is available on the Community Legal Service Direct website at www.communitylegaladvice.org.uk/en/legalhelp/leaflet23_1.jsp. You can also get a paper copy by phoning 0845 3000 343.
- 1.4 Mediation is particularly appropriate for disputes about ownership and licences. It is more flexible than litigation because it opens the door to a wider range of solutions. It allows opposing parties to talk about their dispute and, hopefully, come to an agreement without the need for a court hearing. The mediator's job is not to reach a decision on the dispute but to help the parties work out possible solutions to it.

Information on mediation as a form of alternative dispute resolution and our mediation service can be found on our website at: <http://www.ipo.gov.uk/types/patent/p-dispute/p-mediation.htm>. For more information phone 01633 811010.

If you are involved in a dispute with someone else about infringement of a patent/ supplementary protection certificate (SPC) or the validity of a patent/SPC and want to try and resolve this without getting involved in full legal proceedings, you might want to consider asking us for an opinion. An opinion is an independent assessment of the main issues in a dispute, prepared by one of our senior patent examiners and is based on papers you and anyone else involved send us. An opinion is useful as it may well help you settle the dispute. Information on opinions can be found on our website at: <http://www.ipo.gov.uk/types/patent/p-dispute/p-opinion.htm>.

If you still want to go ahead with litigation, please read the rest of this booklet.

What sort of disputes can the Comptroller decide on?

1.5 Under the Patents Act 1977, the Comptroller can decide on most disputes about patents. The Comptroller can also decide certain matters relating to supplementary protection certificates. In many ways the Comptroller's powers are like those of a judge in the courts. The most common disputes on which the Comptroller decides are in the areas of ownership, licences and technical issues. Below are some common examples.

Ownership

- **Entitlement** - disputes about who owns a patent or is entitled to apply for a patent.
- **Inventorship** - applications to add someone's name to, or remove it from, the record of inventors named on the patent application and the granted patent.
- **Compensation** - applications from employees who want compensation for inventions they made but which belong to their employers.
- **Joint applicant disputes** - disputes between joint applicants about how a patent application in their names will go ahead.

Technical issues

- **Revocation** - applications to have a patent revoked (cancelled) because it is not valid.
- **Amendment or correction of a patent** - an opposition (objection) by another person to an application by the owner of the patent to amend it or correct it.
- **Declarations of 'non-infringement'** - applications asking the Comptroller to confirm that a certain activity does not or would not 'infringe' a particular patent. Certain activities, such as making or selling of products covered by a patent, will infringe that patent if they are carried out without the permission of the patent owner.
- **Infringement** - the Comptroller can decide on infringement, but only if the owner of the patent and the person who has allegedly infringed the patent agree that the matter should be referred to the Comptroller. The Comptroller's powers on infringement proceedings are limited and because of this it is usual for civil actions for infringement to be brought in the Patents Court or the Patents County Court.
- **Surrender** - an opposition (objection) by another person to an application by the owner of the patent to surrender it.

Licences

- **Applications to decide on the terms of licences** which can be given under a patent - where the owner of the patent and the person who wants a licence cannot agree terms.
- **Applications for a compulsory licence under a patent** - requests that the patent owner be forced to grant a licence.

How will proceedings before the Comptroller be conducted?

- 1.6 In proceedings before the Comptroller, each side will have the chance to put their case fully and should do so in a reasonable way. If you make a false statement on purpose (whether in evidence or otherwise) which is relevant to the proceedings, you may be prosecuted. Although disputes may become complicated, our aim is to keep procedures as simple as possible while still dealing with cases quickly and fairly.
- 1.7 The Comptroller cannot decide on all disputes personally. Decisions are made by hearing officers who are senior officers of the Office authorised to act on behalf of the Comptroller.

What help will I receive from you if I decide to start proceedings before the Comptroller?

- 1.8 We cannot help you to prepare your specific case because we have to be strictly independent to resolve the dispute. However, we can provide advice on the procedures that will be followed. You may contact us by e-mail, fax, phone or post. Our details are at the back of this booklet.
- 1.9 We have also included on our website our 'Patent Hearings Manual' and 'Litigation Section Manual'. Although the main aim of these is to provide guidance to our staff, you may want to use them. The 'Patent Hearings Manual' provides valuable guidance on legal principles and the way cases should be conducted. The 'Litigation Section Manual' provides guidance to staff in the Litigation Section of the Patents Directorate. Among other things, it contains detailed, up-to-date instructions on the practice and procedures staff will follow in the formal examination and processing of statements and evidence filed in proceedings before the Comptroller. Our website address is www.ipo.gov.uk

Starting Proceedings

How do I start proceedings in the Office?

2.1 The main rules relating to proceedings are to be found in Part 7 of the Patents Rules 2007. Most disputes will follow the procedures set out in Part 7 and will have the following in common.

2.2 First, you will have to file a 'statement of grounds' with the correct Patents Form. You should use Patents Form 2 unless you are filing an opposition or filing an application or request under the provisions of the Medicinal Regulation and Plant Protection Regulation. To file an opposition, for example opposing an application to amend a patent, you should use Patents Form 15. To file a request to review the lapse of a supplementary protection certificate, for example, you should use Patents Form SP3. At the same time as filing the form, you will need to pay an initial fee of £50. You will need to pay a further fee of £350 later on. To find out more, contact the address given at the end of this booklet.

2.3 The statement of grounds is important as it forms the basis of your case. It should set out the following.

- The matter in issue

You will need to set out the matter in issue in detail but concisely. Taking revocation, for example, you would need to set out fully the grounds (reasons) on which you are claiming the patent is invalid and should be revoked.

- The facts which you rely on

You should fully set out the facts which you rely on in support of your case. In most cases you will need to file evidence to prove these facts at a later date.

- The remedy sought, that is, what you would like the Comptroller to do

You should make sure that you say what orders (remedy) you want the Comptroller to provide. It is also normal to ask for costs to be awarded.

If you do not provide enough information in your statement of grounds, we may challenge it. Until the statement of grounds is in order, the proceedings will not go any further.

2.4 You should confirm the accuracy and truth of all the matter contained in your statement of grounds by adding a statement of truth as follows.

"I confirm that the information contained in this statement of case is true to the best of my knowledge and belief."

2.5 You should sign and date your statement. If the statement of grounds is found to be inaccurate or untrue, and if you do not have a good explanation why, the hearing officer will take this into account when making an award of costs. An example of a statement of grounds is included at the end of this booklet.

When can I file an opposition?

- 2.6 An application, for example, to amend or correct a patent will be advertised in the Patents and Designs Journal. This is published on our website at: <http://www.ipo.gov.uk/types/patent/p-os/p-journal.htm>. In most cases you will need to file your opposition within four weeks of the date of the advertisement, but sometimes we will give a shorter period.

Are there any other requirements?

- 2.7 You should file two copies of the statement of grounds and Patents Form. You also need to file two copies of any documents mentioned in the statement unless we have published these or we keep them at the Office. We will send a copy of the statement, Patents Form and any other documents filed to the patent applicant or patent proprietor. We will also send copies to anyone else who we believe may have an interest in the case, such as a licensee. We will ask them to send us a counter-statement if they wish to object to the case made in the statement of grounds and we will set a period of time for them to do so.
- 2.8 If you are the person starting the proceedings, you will be known as the 'claimant'. If you are objecting to proceedings started by someone else, you will be known as the 'defendant'.

What do I do if there are proceedings against me?

- 2.9 If you want to dispute the claim, we will normally allow you six weeks to file a counter-statement. For some proceedings, we will give a shorter time. You should file two copies of the counter-statement.

This should say clearly:

- which allegations in the statement you deny and why (if you plan to send in a different version of events, you should include this also);
 - which allegations you cannot admit to or deny but need the other side to prove; and
 - which of the allegations in the statement you admit to.
- 2.10 We will assume you agree with any facts that you do not dispute. You should confirm the accuracy and truth of the matter contained in your counter-statement by adding a statement of truth as set out in paragraph 2.4. You should sign and date the counter-statement. An example of a counter-statement is included at the end of this booklet. You should send us two copies of the counter-statement and two copies of any documents you refer to in the counter-statement.

What will happen if there are proceedings against me and I don't file a counter-statement?

- 2.1 If you do not file a counter-statement, we will treat you as supporting the claimant's case and you will lose the right to take any further part in the proceedings. The Comptroller will decide the matter based on information contained in the statement of grounds.

Can the statement of grounds or counter- statement be amended?

- 2.12 Yes, but only if the Comptroller agrees. The amendment may take the form of a replacement statement of grounds or counter-statement, or a supplementary (supporting) statement of grounds or counter-statement, and will need to be filed in duplicate (that is, you have to send two identical copies).

What happens once the Office has received a counter-statement?

- 2.13 We will send a copy of the counter-statement to the claimant (the person who started the proceedings) and will inform him that if he wishes to continue the proceedings, he will need to file Patents Form 4 and pay a fee of £350. We will allow the claimant a period of two weeks to file the form and pay the fee. If the claimant does not do so, we will take it that he wishes to withdraw the proceedings.
- 2.14 If the form and fee are filed, we will then review the statement and counter-statement and will consider the best way of proceeding with the case. The statement of grounds and counter-statement are sometimes described generally as 'statements of case'. They show the facts that are in dispute.

What happens next?

- 2.15 As part of the review, we will adopt a flexible approach which may involve consideration of the following:
- Mediation. Where it seems to us that the dispute may be settled by means of alternative dispute resolution, such as mediation, we will write to you and the other side and will advise you both to consider mediation. If you are not prepared to try mediation, you may be asked to explain why
 - Preliminary Evaluation. We will let you and the other side know if we intend to issue a Preliminary Evaluation. A Preliminary Evaluation may, for example, set out our preliminary views of the issues in dispute or it may highlight questions both sides need to address. We may issue a Preliminary Evaluation at this early stage in the proceedings or may do so later on, for example, after you and the other side have filed your evidence.
 - Case Management Conference. If we need to clarify the issues in dispute or settle any preliminary matters at this early stage, we may contact you and the other side to arrange a Case Management Conference. We will set a date for the Conference and will give both sides 14 days notice. We may invite you and the other side to attend in person or may hold the Case Management Conference by video or telephone. If we consider it appropriate, we may hold a Case Management Conference at any time during the proceedings.

What will happen to the proceedings if both sides agree to mediate?

- 2.16 If you and the other side agree to try mediation, the proceedings will continue. If you or the other side would like us to suspend proceedings until the outcome of the mediation is known, you will need to ask us. You can find out more about mediation from our web site at: <http://www.ipo.gov.uk/types/patent/p-dispute/p-mediation.htm>

Can you tell me more about Preliminary Evaluations?

- 2.17 The main aim of a Preliminary Evaluation is to help you and the other side focus on the issues in dispute. It may also assist in the efficient conduct of the proceedings. A Preliminary Evaluation is not an official decision. This means that you and the other side will not be able to appeal it. When awarding costs in proceedings, we will consider whether you and the other side have acted unreasonably in the light of a Preliminary Evaluation. If you continue to pursue certain aspects of a case, for example, after the Preliminary Evaluation has notified you that these are irrelevant to the final outcome, we may consider you have acted unreasonably. You can find out more about Preliminary Evaluations from our web site at: <http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn.htm> (see Tribunal Practice Notice 3/2009).

What happens next?

- 2.18 If we decide to issue a Preliminary Evaluation early on in the proceedings, we will let you and the other side know. We will issue the Preliminary Evaluation as soon as possible. When we issue the Preliminary Evaluation, we will also invite you and the other side to file evidence and to agree a hearing date with each other. The agreed date should fall within a window of time proposed by us. The window may be 1 – 2 months depending on how the proceedings have progressed. We will let you know if the agreed date is acceptable.
- 2.19 If we do not intend to issue a Preliminary Evaluation early on in the proceedings, we will let you know. Unless there are any other considerations, at the same time we will invite you and the other side to file your evidence and to agree a date for the hearing.
- 2.20 Following the evidence rounds, if we consider, for example, that it may assist you and the other side at the hearing, we may issue a Preliminary Evaluation or may issue a further Preliminary Evaluation. Both sides will have time to consider the Preliminary Evaluation before the hearing.
- 2.21 At the hearing, you and the other side will have the chance to present your case in person to one of the Comptroller's hearing officers who will assess the cases of both sides and come to a decision. Or, if you both agree, the matter may be decided on the written documents that both sides have provided. In either case, we will issue a written decision.

Evidence

What is evidence?

- 3.1 You have claimed in your ‘statement of grounds’ that such-and-such happened, and your opponent has claimed that something different happened in his counter-statement. You must now provide convincing material to show that your version is right or that your opponent’s version is wrong. That material is your ‘evidence’.

Example 1: You claim that you made the invention in January. To prove it, you might include in your evidence a dated invoice for some parts that you had to buy to make a prototype, a dated advertising leaflet you produced to market the invention, and a declaration from an independent person that you discussed the invention with them on a certain date.

Example 2: Your opponent claims that you were employed by them in January when you made the invention. To disprove this, you might include in your evidence a letter from them offering you the job with a start date of February, or a declaration from your previous employer that you were still working for them throughout January.

When should I file my evidence?

- 3.2 We will write to you to let you know when you should file your evidence. The usual procedure involves three rounds of evidence, each of six weeks.

- If you are the claimant you will be invited to file your main evidence first.
- If you are the defendant you then file your main evidence. You may also file evidence in response to the claimant’s evidence.
- If you are the claimant, you may then respond to the defendant’s evidence by filing evidence strictly in reply to the defendant’s evidence.

We will also consider whether an alternative approach involving the simultaneous exchange of evidence by both sides is appropriate. This procedure will involve two rounds of evidence, each of six weeks.

- Both sides will file their main evidence
- Both sides will file evidence strictly in reply

Once the evidence rounds are complete, both sides will only be able to file new evidence if the Comptroller agrees.

What should my evidence be about?

- 3.3 You only need to provide evidence to support facts that are in dispute. You do not need to provide evidence to prove facts that the other side has already admitted to.

- 3.4 Your evidence should be concerned with proving facts, and not with the argument about what can be concluded from those facts. You will already have given your outline argument in your statement of grounds or counter-statement. You will have an opportunity to put your arguments more fully when it comes to the hearing.

I've heard of the term 'burden of proof'. What does this mean?

- 3.5 The general rule is that the person who alleges something must prove it unless the other side admits to it. Normally the burden of proof is on the person who starts the proceedings. He or she needs to put forward his or her particular case. For example, in revocation proceedings the burden of proof lies with the person applying for revocation. Similarly, in entitlement proceedings, it is for the claimant (the person claiming ownership) to prove his or her case.

What form does evidence take?

- 3.6 Evidence is usually given in the form of written statements, known as 'witness statements', about the facts by individual people. A document such as the invoice mentioned in Example 1 in paragraph 3.1 cannot be put in as evidence on its own because it needs a statement from someone to explain what the document is supposed to be. The invoice would be put in as an 'exhibit' to the statement.

Example: The witness statement might say: "On 8 January I bought a widget to construct a prototype of my invention. I attach as exhibit 1 the invoice for the purchase of that widget."

- 3.7 Anyone who has given evidence may have to go to the hearing so they can be cross-examined on what they have said, although often this will not be necessary.

Who should give evidence?

- 3.8 You will usually want to make a witness statement yourself, though do remember it should be about the facts, not the arguments. You will, though, strengthen your case if you can also supply witness statements from other people, preferably people who do not have a personal interest in your case.
- 3.9 A witness statement will be most convincing if the person concerned has direct experience of what they are writing about, for example, things they have seen, or documents they have written. Evidence about what someone else has seen, said or written will always tend to carry less weight.

How should I write a witness statement?

- 3.10 You should start with a title which identifies the proceedings. You should then give your name, address and occupation. If you are giving evidence in a professional or business role, you can give your working address, your position and the name of your firm or employer instead of giving your home address. Your evidence should be written in the first person (for example, 'I') and each paragraph should be numbered.
- 3.11 The statement must be signed and dated by the maker and contain a statement of truth, for example, "I confirm that the information contained in this statement is true to the best of my knowledge and belief." The witness must also sign any exhibit mentioned in the statement.

You can find an example of a witness statement at the end of this booklet.

Are there any more rules about how I must present my evidence?

- 3.12 You should file original witness statements. We cannot accept copies. You should present your evidence on good-quality A4 paper, typed on one side of the paper only, and it should be easy to read. If possible, you should bind the evidence securely in a way which does not make it difficult to file, otherwise each page should have on it your initials. You should number the pages in order, and all numbers including dates should be in figures. The evidence should follow the sequence of events in date order as far as possible, with each paragraph just dealing with a different part of the subject. Any exhibits should be numbered. If at a later stage you file a second witness statement with more exhibits, continue the numbering where you left off so that you don't end up having two exhibits with the same number.

Does evidence have to be written in English?

- 3.13 If you want to file evidence in a foreign language, you may do so though you may also need to file with it a translation into English.

Can I ask for the documents I have presented to be treated as confidential?

- 3.14 In general, we do not treat documents as confidential. However, if you want us to keep any document confidential, you must ask us to do this within 14 days of filing it. You must also say why you want us to keep the document confidential.
- 3.15 If we agree, we will not make the document available to the public. However, we will still have to send a copy to anyone else who is involved with the proceedings, or to their legal representative.

What happens about arranging the hearing?

- 3.16 We will contact you and the other side to make arrangements for the hearing. If you want to be represented at the hearing by a patent attorney, solicitor or barrister, it will be up to you to find a representative who is able to appear on that date. We will contact you to confirm details and will ask if you want to cross-examine any of the other side's witnesses. If you do, you will need to give their names to us and the other side.

4

The Hearing

What is a hearing?

- 4.1 A hearing is an opportunity for each side to present their case in person to a hearing officer. Unless there are exceptional circumstances, a hearing will last no longer than 2 days and will generally be concluded within 1 day. If a number of witnesses need to be cross-examined, for example, the hearing may last 2 days. Main hearings usually take place at our London Office at 21 Bloomsbury Street, London, WC1B 3HF. However, we can also hold hearings in Scotland if all the parties agree or can hold them at our Office in Newport, South Wales. If both sides agree that a hearing should be held in a different location, and we are satisfied that circumstances justify this, we will hold hearings at other locations. We are also able to hold hearings through a video-conference link. We do not charge a fee for a hearing.
- 4.2 We may hold preliminary hearings at any stage before the main hearing to decide, for example, procedural matters such as a request to suspend proceedings. When arranging a preliminary hearing, we will specify a period in which the hearing should take place and will normally give both sides 14 days to tell us about the date they have agreed on.

Can I represent myself at a hearing?

- 4.3 Yes. Whether the other side is represented or not, you can present your own case at a hearing. However, we advise you to employ a representative such as a patent attorney or solicitor. We cannot recommend attorneys or solicitors to you or give you legal advice because we must stay unbiased.

What will happen at a hearing?

- 4.4 Hearings follow certain formal procedures, but since hearing officers are not officers of the court, they will not be dressed in wig and gown. When you arrive, the hearings clerk will show you and the other side to the hearing room. Once you and the other side are ready to begin, the hearing officer will enter.
- 4.5 If you are not professionally represented at the hearing, the hearing officer will explain the procedures that will be followed and will advise you of your rights. Throughout the hearing you should address the hearing officer and not the other side. You and the other side will each have a chance to put your case to the hearing officer. This will include cross-examining witnesses if previously requested.
- 4.6 Usually, if you started the proceedings you will be asked to present your case first. You should go through your arguments, showing how they are supported by the evidence. You will also need to deal with the other side's counterarguments, for example, by showing that they are irrelevant or that they are not supported by the evidence. The other side will then be asked to present their case, putting their own arguments and showing why they consider your arguments to be wrong. Finally, you will be asked to reply to the other side's arguments. Your reply is an opportunity to deal with any points raised by the other side which you could not deal with when you first presented your case. You will not be allowed to raise fresh points at this stage.

- 4.7 If it was the other side who started the proceedings, the roles will be reversed and you will be asked to present your case after the other side have presented theirs. If any witnesses are to be cross-examined, that will normally be done when the first side is presenting their case.
- 4.8 At the end of the hearing, you should wait until the hearing officer has left the room before you leave.

Can the matter be decided without a hearing?

- 4.9 Yes. If both sides agree, the hearing officer can decide both preliminary matters and the main proceedings by using the papers that both sides have filed.

What happens next?

- 4.10 If a preliminary hearing has been held, generally the hearing officer will tell you and the other side about his or her decision immediately. If, on the other hand, a main hearing has been held, the hearing officer will issue a written decision as soon as possible. The hearings clerk will send a copy of the decision to you and the other side. We will also publish the decision on our website at www.ipo.gov.uk/patent/p-decisionmaking/p-challenge/p-challenge-decision-results.htm

What powers does a hearing officer have?

- 4.11 A hearing officer can only do things that the Patents Act 1977 gives him or her powers to do. A hearing officer cannot, for example, make a particular order if the law doesn't give him or her the authority to do so. In reaching a decision, a hearing officer will interpret and apply the law. He or she cannot change the law or twist it in any way to suit a particular case. However, a hearing officer does have various general powers to regulate the proceedings and in certain circumstances may use their own judgment when issuing, for example, directions on the managements of the proceedings. This doesn't mean that hearing officers can do what they like. They still have to act in a reasonable and fair way.

How long does the whole process take, from starting proceedings to getting a decision from the Comptroller?

- 4.12 In the interests of justice, we must give both sides an adequate opportunity to make their case, prepare their evidence and prepare for the hearing, and for the hearing officer to write the decision. The aim will be to finish proceedings and issue a decision within 10 months of the date Patents Form 4 is filed. However, sometimes progress is not smooth. In such cases, the hearing officer will actively manage the case to ensure that it stays on track. In doing so, the hearing officer will be looking to ensure that each case is dealt with fairly.
- 4.13 If the proceedings are of particular public interest or if both sides ask us to speed up the proceedings, the hearing officer will consider shortening, for example, certain periods, such as the filing of the counter- statement. In exceptional circumstances, they may also shorten the 14-day period we give to the sides to agree a date for a preliminary hearing.

Through these types of measures, hearing officers will try to do all they can to speed up the proceedings.

What about my costs? Will the hearing officer award me costs if my case is successful?

- 4.14 It is usual for parties to ask for their costs as part of the relief they are seeking in their statement of case. It is for the hearing officer to decide whether an award for costs should be made depending on the circumstances of the case. If you win, you may get costs awarded to you, but if you lose, you may have to pay costs to the other side. In general, any costs awarded are not meant to compensate people for their actual costs. We have issued an updated scale of costs and have published it on our website at <http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn/p-tpn-2007/p-tpn-42007.htm> or, you can get a copy from the address given at the end of this booklet.



5

Appealing against an office decision

Can I appeal against an Office decision?

- 5.1 Yes. If you do not agree with the Comptroller's decision, you can appeal to the Patents Court of England and Wales. However, you must do so within the time specified in the decision (this will be 28 days from the date of the decision). If you need this period extended, you will need to apply to the court for an extension. You will need to say why you need the extension and include the reasons for the delay.
- 5.2 Different rules apply if the hearing was held in Scotland. We can provide more details if you ask.

How do I go about filing an appeal?

- 5.3 For appeals to the Patents Court, you must make a notice of appeal on the correct form and file it with the appropriate fee (currently £200). You can get more details from:

High Court Appeals Office
Room WG07, West Green Building
Royal Courts of Justice
Strand
London, WC2A 2LL.
(Phone: 020 7947 7383)
- 5.4 You must send three copies of the notice of appeal to the High Court Appeals Office with the fee. You must also send a copy to the Comptroller as soon as possible and no later than seven days of sending it to the Appeals Office.
- 5.5 If you are the person making the appeal, you will be known in the proceedings as the 'appellant'. The other side will be known as the 'respondent'.

How will the appeal be conducted?

- 5.6 The appeal will be limited to a review of the Comptroller's decision. You cannot put forward any new evidence at the appeal except with permission of the court.

Can I represent myself?

- 5.7 Yes, you may represent yourself, or a patent attorney, solicitor or barrister may act for you.

What if my appeal is unsuccessful?

- 5.8 If your appeal is unsuccessful, the court may order you to pay the other side's full costs, including the costs of any representative, for example, a solicitor or counsel. This could be very expensive.
- 5.9 You may be granted permission to appeal to the Court of Appeal. If your appeal is heard and is unsuccessful, you may be granted permission to appeal to the Supreme Court, though this is very rare. In appeals to the Court of Appeal and the Supreme Court, it is usual for both sides to be represented by a barrister.
- 5.10 You will only be granted permission to appeal if the court believes your appeal has a chance of success.

6

Conclusion

All this sounds very straightforward. Is it really that easy?

- 6.1 No, not always. Proceedings before the Comptroller, as in the courts, may become complicated and result in procedural difficulties. However, we will do our best to make sure that the proceedings run as smoothly as possible.

Can I get legal aid?

- 6.2 You cannot get legal aid in proceedings before the Comptroller or the court.

Where can I go from here?

- 6.3 If you would like more information on procedures, please contact us. If you would like, however, to discuss the merits of your case, you should contact a solicitor or patent attorney.

For a list of solicitors in your area, you should check your local phone book or contact:

The Law Society
113 Chancery Lane
London
WC2A 1PL

Phone: 020 7242 1222
Fax: 020 7831 0344
E-mail: contact@lawsociety.org.uk
Website: www.lawsociety.org.uk

For a list of attorneys in your area, contact:

The Chartered Institute of Patent Attorneys
95 Chancery Lane
London
WC2A 1DT.

Phone: 020 7405 9450
Fax: 020 7430 0471
E-mail: mail@cipa.org.uk
Website: www.cipa.org.uk

7

Examples of documents

Examples of a statement of grounds and counter-statement

These are very simple examples. Most statements of grounds and counter-statements will need to be more detailed.

Heading to identify the sides and the proceedings. Other formats are acceptable (for example, see the example of a counter-statement).

Between

Williams & Sons

Claimant

and

George Jones

Defendant

Proceedings

Reference under section 8 of the Patents Act 1977 in connection with patent application number GB 3245678

Identify this document

Statement

Set out the matter in issue.

1. This reference is being made by Williams & Sons, the liquidators of the company Nuts Limited, in connection with patent application number GB 3245678. We claim that we are the rightful owners of the patent application filed by Mr George Jones in March 2003 and that ownership of the application should be transferred to us.
2. In 2001, Mr George Jones, a design engineer, and Mr John Smith, an accountant, set up a company called Nuts Limited. The company made chopping machines for the peanut market. The machines were designed by Mr Jones.
3. Both Mr Smith and Mr Jones were employed by Nuts Limited. Mr Jones was employed as the company's managing director. He had overall responsibility for new ideas and design within the company. His duties were confirmed in a contract of employment dated 1 March 2003.
4. The invention described and claimed in patent application number GB 3245678 was devised by Mr Jones during the latter part of 2002. Mr Jones made a number of prototypes of the invention and tested these at the company before eventually finalising the invention.
5. At the beginning of March 2003, Mr Jones filed a patent application for the invention which relates to a new cashew-nut chopping machine. The application was filed in his name and not that of the company; though at this time Mr Jones was still working for the company Nuts Limited. The company started to make the invention described in the patent application towards the end of 2003.
6. In September 2004, Mr Jones transferred his rights in the patent application to Nuts Limited in return for 8000 shares in the company. This and any transfer since has not been recorded at the Patent Office.

Number the paragraphs.

Set out the facts of your case.

You should send us two copies of the document mentioned.

7. During 2005, Nuts Limited got into financial difficulties. At a meeting of the Board of Nuts Limited held on 5 July 2005, it was agreed that Williams & Sons should be appointed liquidators of the company and we were duly appointed on 12 July 2005.
8. We claim that as successors in title for the company Nuts Limited, we are entitled to be granted a patent for the invention described in patent application number GB 3245678 because of section 39(1)(b) of the Patents Act 1977. This says that an invention made by an employee belongs to the employer if the employee's responsibilities were such that he or she had a special obligation to look after the employer's interests. As a director of the company, Mr Jones had such an obligation.
9. In view of the facts set out above, we would like the following relief.
 - a. That the Comptroller confirms Williams & Sons, as liquidators of the company Nuts Limited, are entitled to the grant of patent application number GB 3245678 and that the application should be transferred to us and go ahead in our name.
 - b. That an award of costs be made in our favour.

Set out the relief you are claiming

Statement of truth.

I confirm that the information contained in this statement of case is true to the best of my knowledge and belief.

Signature:

Date:

Heading. See the example of a statement for another acceptable format.

In the matter of patent application number GB 3245678 in the name of George Jones and a reference by Williams & Sons under Section 8 of the Patents Act 1977.

Counter-statement

State which allegations you deny and why.

1. This counter-statement is made on behalf of Mr George Jones. Paragraph 1 of the statement is denied. Mr Jones is the rightful owner of patent application number GB 3245678 under an assignment dated 5 July 2005.

State which allegations you admit to.

2. Paragraph 2 of the statement is admitted.

3. Paragraph 3 of the statement is not admitted. While Mr Jones had an interest in the company as a shareholder, he does not remember signing a formal contract of employment and he did not receive a regular salary from the company. As a result, he does not consider himself to have been an employee. The defendant is not able to say whether Mr Smith was employed by the company. If the claimants want to rely on this, they must prove it.

4. Paragraph 4 of the statement is admitted.

5. Paragraph 5 of the statement is not admitted. It is denied that Mr Jones was working for Nuts Limited at the time he filed the patent application. Also, the company did not start making the new cashew-nut chopping machines until later in 2004.

6. Paragraph 6 is admitted to the extent that Mr Jones initially transferred his rights to Nuts Limited. However, this depended on a deal to buy 1000 machines going through. At a board meeting of Nuts Limited that Mr Jones took part in on 5 July 2005, the Board took the view that as the terms of the deal had not been fulfilled, the assignment of the patent application to Nuts Limited was not valid. The Board agreed to the re-assignment of the patent application to Mr Jones.

7. Paragraph 7 is admitted. Although the minutes of the Board meeting show that there was agreement that Williams & Sons should be appointed as liquidators of the company, they were not, in fact, appointed until 12 July 2005, seven days after the re-assignment of the patent application to Mr Jones.

Set out the relief you are claiming.

8. In view of the re-assignment of the patent application to Mr Jones, he is the rightful owner of the application. He asks the Comptroller to refuse the reference under section 8 and confirm that the patent application belongs to him. He would also like an order of costs in his favour.

Statement of truth.

I confirm that the information contained in this statement of case is true to the best of my knowledge and belief.

Signature:

Date:

Example of a witness statement

This is a very simple example. Most witness statements will need to be longer.

Between

Williams & Sons

Claimant

and

George Jones

Defendant

Proceedings

Reference under section 8 of the Patents Act 1977 in
connection with patent application number GB 3245678

Witness statement of George Jones

I, George Jones of 9 Grove Road, Manchester, a self-employed inventor, state the following.

1. I am a mechanical engineer with over 30 years' experience in the field of design engineering. Exhibit GJ1 sets out my educational qualifications and my employment details.
2. I formed the company Nuts Limited with Mr John Smith in 2001. I was introduced to Mr Smith by a friend who was aware of my interest in setting up a company to manufacture chopping machines for the peanut market.
3. I had an interest in the company as a shareholder but I did not receive a regular salary from the company. When I filed my patent application, I was not an employee of the company.
4. Although the company was initially successful, owing to the terms of a financial deal not being fulfilled, the Board of Nuts Limited agreed to appoint Williams & Sons as liquidators of the company at a board meeting held on 5 July 2005.
5. At the meeting, the Board also agreed that although I had transferred my rights in patent application number GB 3245678 to Nuts Limited, because the terms of the financial deal had not been met, the transfer should be treated as not valid. It was confirmed that ownership of the application should stay with me. Exhibit GJ2 is a draft copy of the minutes taken by my secretary, Sandra Black, at the meeting.

I confirm that the information contained in this witness statement is true to the best of my knowledge and belief.

Signature:

Date:

Example of an exhibit

In the matter of patent application number GB 3245678 in the name of George Jones and an application under Section 8 of the Patents Act 1977

Exhibit

This is the exhibit 'GJ1' referred to in my witness statement.

Signature:

Date:

Note: The document containing details of Mr Jones's educational qualifications and employment details would be attached to this cover sheet.

A separate cover sheet would be needed for the draft copy of the minutes of the board meeting, held on 5 July 2005, called exhibit 'GJ2'.

If you have any questions about anything in this booklet, please write to:

Litigation Section
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ.

Phone: 01633 814736
Fax: 01633 814491
E-mail: Litigation@ipo.gov.uk

You can also get more information on our role as a tribunal on our website at <http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn.htm>.

Please keep this booklet with your other patent papers in case you need it in the future. You can also get the following leaflets from us which may also be relevant.

- Restoring your patent.
- Registering transactions which affect the rights in your patent.
- Registering licences under your patent.
- Keeping your patent in force.

If you would like any of these leaflets, please fax, phone, e-mail or write to:

Central Enquiry Unit
Concept House
Cardiff Road
Newport
South Wales NP10 8QQ.

Phone: 08459 500505 (local rate)
Fax: 01633 817777
E-mail: enquiries@ipo.gov.uk



Concept House
Cardiff Road
Newport
NP10 8QQ

Tel: 0300 300 2000
Fax: 01633 817 777

www.ipo.gov.uk

For copies in alternative formats please
contact our Information Centre.

**When you no longer need this booklet,
please recycle it.**

Revised: August 2014

WS0002-08/14

