



Intellectual
Property
Office

Patents hearing manual



Hearings manual

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Introduction

Scope and authority of this manual

- 0.01 This Manual is intended to provide guidance as to the law and procedure concerning patent and design right hearings held in the Patents Directorate (PD) on behalf of the comptroller. It does not provide guidance on matters of substantive patent and design right law. For patents, this is available in the [Manual of Patent Practice \(MoPP\)](#) but there is as yet no corresponding manual covering design right.
- 0.02 The Directorate's Litigation Section plays an important support role in hearings, but their procedures are covered by a separate [Litigation Manual](#) and are only mentioned in this Manual so far as is necessary for completeness.
- 0.03 This Manual embraces both inter partes and ex parte proceedings. The latter are usually more straightforward and give rise to fewer procedural problems, and because of this the emphasis in Chapters 1 to 5 is very much on the former. For convenience, Chapters 1 to 5 are written primarily in terms of proceedings involving two parties, but of course the same principles apply if more than two parties are involved.
- 0.04 Much of the guidance in these chapters is nevertheless relevant to ex parte proceedings. Chapter 6 on these does not purport to be a self-contained guide: instead it highlights the differences between ex parte and inter partes proceedings and matters of particular relevance to the former. It should be read in conjunction with Chapters 1 to 5.
- 0.05 Statements made in this Manual (and also the [Manual of Patent Practice](#) and the [Litigation Manual](#)) have no legal authority. Authority for any action must come from the law, not this Manual. Further, where the legislation gives the comptroller discretion, official guidelines such as this Manual may not fetter him in the exercise of that discretion by purporting to lay down rigid rules which prevent him responding to the merits of each case. Thus it is always open to a hearing officer to decide, in the light of the facts of a particular case and/or the arguments advanced by the parties, that the guidance in this Manual should not be followed.
- 0.06 Indeed, this Manual makes no attempt to provide guidance on all the issues that might arise, or that have arisen in the past. Instead, it tries to point to the basic principles that should be followed. It refers to past cases where these help to establish or clarify general principles. Where it seems helpful to do so, it also gives examples of past cases in which the topic in question has arisen. Whilst these examples are never likely to be on all fours with a case currently under consideration, they may provide pointers as to how questions in this area have been tackled in the past.

Impact of the reform of civil litigation

0.07 Except where modified or superseded by subsequent changes in practice, this Manual reflects the changes which were introduced as a result of the Office's review of its tribunal functions following Lord Woolf's report Access to Justice (see Tribunal Practice Notices [1/2000](#) and [2/2000](#), reproduced at [2000] RPC 587 and 598). Lord Woolf's recommendations are implemented, so far as the courts are concerned, in the [Civil Procedure Rules 1998](#): the relevance of these Rules to proceedings before the Comptroller is explained in Chapter 1.

0.07.1 This manual also reflects changes in case management introduced with the [Patents Rules 2007](#) and those set out in Tribunal Practice Notice [3/2009](#).

Reference material

0.08 Many precedent cases and reference books on intellectual property and other law are available in the Office for the use of hearing officers, and the Office also has access to the Lexis™ database and makes use of public databases such as the [British and Irish Legal Information Institute](#) and the [Courts Service](#). References to "Civil Procedure" (also known as the "White Book") containing comprehensive guidance to the Civil Procedure Rules are to the 2009 edition.

0.09 The meanings of legal terms used in precedent cases will sometimes be found in the glossary at the end of the [Litigation Manual](#). Failing that, they can usually be found in legal textbooks or dictionaries.

0.09.1 Where sources are available, hyperlinks have been provided to reference material. However not all document collections or older references are available in electronic form.

Corrections and suggestions

0.10 We welcome corrections to the information contained in this Manual, and also suggestions for improvement and information on broken or missing links. They should be addressed to the Editor:

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Chapter 1

Basic legal principles

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The Comptroller's tribunal role

- 1.01 The comptroller is an administrative official having regulatory functions in respect of certain types of intellectual property. However, the comptroller also has a tribunal role in respect of patent disputes under the [Patents Act 1977](#) and design right disputes under the [Copyright, Designs and Patents Act 1988](#).
- 1.02 In practice, the powers of the comptroller sitting as a tribunal to settle disputes are exercised not by the comptroller in person but by officers authorised to act for him. Full details of the authorisation - ie who is authorised to do what - are set out in paragraph 130.05 of the [Manual of Patent Practice](#). This authorisation refers to some officers by their span within the Office's grading structure rather than by a formal job title, and these (eg B3, C2) are used in this Manual where appropriate (C2 includes Senior Patent Examiners).
- 1.03 The comptroller is listed as a tribunal under direct supervision of the Administrative Justice and Tribunals Council (formerly the Council on Tribunals) in [Schedule 1 Part 1 of the Tribunals and Inquiries Act 1992](#) (as amended by the Tribunals Courts and Enforcement Act 2007). (See Chapter 8 for further information about the Council).

Jurisdiction

- 1.04 For any issue, the legislation may prescribe that jurisdiction lies with the comptroller, the courts or both.

Jurisdiction of the comptroller

- 1.05 In addition to the comptroller's responsibility for resolving matters arising from the search and examination and grant of applications for patents; in the following matters he has first instance jurisdiction, ie proceedings must in general be launched before him, not the court:

For patents, proceedings under sections [8](#), [12](#), [13](#) or [37](#) of the 1977 Act (entitlement and inventorship), sections [27-29](#) (post-grant amendment, restoration and surrender), sections [46-53](#) (licences of right and compulsory licences) and section [117](#) (correction).

For design right, proceedings under [section 246](#) of the 1988 Act (subsistence, term or ownership) and sections [237-9](#), [247-8](#) (compulsory licences etc).

- 1.06 In the following matters there is concurrent jurisdiction at the choice of the plaintiff, ie proceedings can be brought in the first instance before either the court or the comptroller:

For patents, proceedings under [section 40](#) (employee compensation), [section 71](#) (declaration of non-infringement) and [section 72](#) (revocation).

1.07 Finally, for the following the comptroller only has jurisdiction if both sides agree that the matter should be brought before the comptroller rather than the court (though the comptroller does not have the same powers as the court):

- For patents, proceedings under [section 61\(3\)](#) of the 1977 Act (infringement).

1.07.1 The Patents Act 2004 introduced new [sections 74A](#) and [74B](#) to the Patents Act 1977, governing the provision of non-binding opinions on validity and infringement by the Office, and reviews of opinions. The comptroller has jurisdiction to conduct reviews under [section 74B](#). In [DLP Limited \[2007\] EWHC 2669 \(Pat\)](#), Kitchen J confirmed that the hearing officer's role in conducting a review of an opinion was simply to review whether the opinion issued by the examiner was one that could reasonably have been reached in the circumstances, and the hearing officer should only set the examiner's opinion aside if the examiner has made an error of principle or has reached a conclusion that is clearly wrong.

Jurisdiction of the courts

1.08 In addition to its inherent jurisdiction (eg to make declarations), the court has jurisdiction:

- when the Patents Act 1977 or Copyright, Designs and Patents Act 1988 gives it jurisdiction
- when the comptroller declines to deal with an issue - see Chapter 2.

"Court" is defined in [section 130\(1\)](#) of the Patents Act 1977 and [252\(6\)](#) of the Copyright, Designs and Patents Act 1988. In England and Wales, under [rule 63](#) of the Civil Procedure Rules 1998 and [Practice Direction 63](#), patent claims go to the Patents Court, a part of the Chancery Division of the High Court, or to a Patents County Court, and design right claims go to the Chancery Division, a Patents County Court or to those county courts (listed in Practice Direction 63) where there is a Chancery District registry. A Patents County Court is a county court designated as such under [section 287\(1\)](#) of the 1988 Act: the only court so designated at present (under the Patents County Court (Designation and Jurisdiction) Order 1994) is the Central London County Court. In Scotland the "court" is the Court of Session.

1.09 The High Court (or, rarely, the Court of Session) also hears most appeals from decisions of the comptroller. Appeals from decisions on some aspects of design right are heard by the Registered Designs Appeal Tribunal rather than the High Court, though this tribunal normally consists of a High Court judge. For more information, see Chapter 7.

- 1.10 Under [section 99](#) of the Patents Act 1977, in the exercise of its jurisdiction under that Act or any treaty or convention, the court has all of the powers of the comptroller. There is a similar provision in [section 251\(3\)](#) of the Copyright, Designs and Patents Act 1988 which applies when the comptroller declines to deal with a question relating to subsistence, term or ownership of design right.

Jurisdiction between different States: the Brussels and Lugano Conventions

- 1.11 It is unusual for the Brussels Convention (but see below about its replacement by an EC Regulation) or the Lugano Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters to rear their heads in proceedings before the comptroller, but they do occasionally, and hearing officers should therefore be aware of what they are.
- 1.12 The [Brussels Convention](#) was originally agreed by what were then the European Economic Community member states in 1968, and was given effect in the UK by the Civil Jurisdictions and Judgments Act 1982. The [Lugano Convention](#) 1989 extended the same arrangements to European Free Trade Association countries outside the European Union and was given effect in the UK by the [Civil Jurisdictions and Judgments Act 1991](#).
- 1.13 The Brussels Convention lays down rules as to the appropriate jurisdiction for actions between parties which could be heard in several different countries. The general principle ([Article 2](#)) is that a defendant can be sued in the courts of his or her domicile, subject to certain exceptions, such as when there are co-defendants ([Article 6\(1\)](#)). There is, though, an exclusion relating to registered intellectual property rights contained in [Article 16\(4\)](#). This reserves jurisdiction in proceedings concerned with registration or validity of patents, trade marks, designs or other similar rights required to be deposited or registered. Jurisdiction lies with the courts of the Contracting State in which the deposit or registration has been applied for, has taken place or is under the terms of an international convention deemed to have taken place. The Brussels Convention also provides for a judgment given in one Contracting State to be recognised in others without further proceedings, subject to certain conditions being met.
- 1.14 The likeliest patent situation in which the Brussels or Lugano Conventions may be met is where a European patent is concerned and parallel actions are under way in other European countries. Such a situation arose in [Allergan Inc v Merz Pharma GmbH & Co. KGaA BL O/271/06](#).
- 1.15 The interpretation and effect of the Brussels Convention, and especially of [Article 16\(4\)](#), have been the subject of a number of court cases in the United Kingdom and elsewhere. A fuller treatment of the significance of the Brussels and Lugano Conventions in intellectual property proceedings is given, for example, in chapter 10 of the Encyclopaedia of United Kingdom

and European Patent Law (published by Sweet & Maxwell), and see also Vol 2 section 5 of "Civil Procedure".

- 1.16 The Brussels Convention was largely replaced as from 1 March 2002 by [European Council Regulation 44/2001](#). However, the Convention remains effective to regulate some jurisdictions, particularly those with Denmark and other States since the Regulation does not apply to Denmark (see recitals 5, 19, 21 and 22). The Regulation and Convention have broadly similar aims, and in particular [Articles 2](#) and [6\(1\)](#) of the Regulation are substantially identical to the Articles of the same numbers in the Brussels Convention. [Article 22\(4\)](#) of the Regulation corresponds broadly to [Article 16\(4\)](#), although there are some changes. Save as regards the recognition and enforcement of judgments, the Regulation only applies to proceedings instituted after 1 March 2002.

Human rights and principles of natural justice

- 1.17 Hearing officers must always keep in mind the human rights enshrined in the [European Convention on Human Rights](#). While the UK ratified the Convention as early as 1951, the [Human Rights Act 1998](#) went one step further by incorporating Convention rights into UK law with effect from 2 October 2000. Under [section 6](#) of the 1998 Act it is unlawful for the comptroller to act in a way which is incompatible with any Convention right unless compelled to do so by primary legislation. Under [section 2\(1\)](#) of the 1998 Act the comptroller must, in interpreting those rights, take account of case law of the European Court of Human Rights and other Strasbourg organs, although it is not mandatory to follow it, and a judgment of the House of Lords which conflicts with a subsequent Strasbourg decision should still be followed (see [Kay v London Borough of Lambeth \[2006\] UKHL 10](#), [2006] 2 WLR 570, upholding the decision of the Court of Appeal in [Leeds City Council v Price \[2005\] EWCA Civ 289](#), [2005] 3 All ER 573). Convention rights can be invoked by companies (where appropriate) as well as by private individuals.
- 1.18 Of the Convention rights, the most important so far as hearings before the comptroller are concerned is the right to a fair trial. This is set out in Article 6 of the Convention as follows:
1. *In the determination of his civil rights and obligations or of any criminal charge against him, everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law. Judgment shall be pronounced publicly but the press and public may be excluded from all or part of the trial in the interests of morals, public order or national security in a democratic society, where the interests of juveniles or the protection of the private life of the parties so require, or to the extent strictly necessary in the opinion of the court in special circumstances where publicity would prejudice the interests of justice.*

2. *Everyone charged with a criminal offence shall be presumed innocent until proved guilty according to law.*
3. *Everyone charged with a criminal offence has the following minimum rights:*
 - (a) *to be informed promptly, in a language which he understands and in detail, of the nature and cause of the accusation against him;*
 - (b) *to have adequate time and facilities for the preparation of his defence;*
 - (c) *to defend himself in person or through legal assistance of his own choosing or, if he has not sufficient means to pay for legal assistance, to be given it free when the interests of justice so require;*
 - (d) *to examine or have examined witnesses against him and to obtain the attendance and examination of witnesses on his behalf under the same conditions as witnesses against him;*
 - (e) *to have the free assistance of an interpreter if he cannot understand or speak the language used in court.*

1.19 Article 6(1) is relevant because it applies to civil proceedings. Articles 6(2) and (3) refer to criminal proceedings, but should not be ignored as the specific rights mentioned could be viewed as part of the more generally applicable right to a fair trial under Article 6(1): the provisions of Article 6(3) in particular echo the principles of natural justice set out below. However it is important to note that, as explained by the House of Lords in [R \(Kehoe\) v Secretary of State for Work and Pensions \[2005\] UKHL 48](#), [2005] 3 WLR 252, Article 6 does not require particular substantive rights to be accorded under national law: its function is to guarantee certain procedural safeguards in the exercise of rights accorded by national law.

1.20 The following principles flow from Article 6 and its case law

- a) Right of effective access to justice. Case law has held that Article 6(1) inherently provides the right of access to a court. This must be effective in the sense that a person must be able to present his or her case properly and satisfactorily. The imposition of formal and procedural requirements is not of itself a denial of the right (see [Wilson v First County Trust \[2003\] UKHL 40](#), [2003] 4 All ER 97 and [R \(Lester\) v London Rent Assessment Committee \[2003\] EWCA Civ 319](#), [2003] 1 WLR 1449, but it is likely that any attempt to compel a party to submit to alternative dispute resolution procedures against its will would be such a denial (see [Halsey v Milton Keynes General NHS Trust \[2004\] EWCA Civ 576](#), [2004] 1 WLR 3002). The imposition of time limits or fees on litigants will not be a restriction on access provided that they are reasonable. An important point is that access must be judged by looking at the whole process and seeing what options for appeal exist: even though a tribunal may not fully comply with Article 6(1) a litigant

may secure his rights if he can appeal to a court that does comply and has full jurisdiction. This principle was confirmed in a patent case by the European Court of Human Rights: see paragraph 78 of *British American Tobacco v The Netherlands* [1996] 21 EHRR 409. It was also central to the House of Lords judgment in *R (Alconbury Developments Ltd) v Secretary of State for the Environment, Transport and the Regions* [2001] UKHL 23, [2001] 2 WLR 1389. From the comptroller's tribunal there exists a full right of appeal to a court that may be assumed to comply with Article 6(1). It would thus appear that the Convention and the Human Rights Act do not require procedures before the comptroller to comply with Article 6. Nevertheless we should do everything possible to observe the principles that flow from Article 6 so that public confidence in the comptroller's tribunal is maintained.

- b) Independent tribunal established by law. Hearing officers in inter partes proceedings act independently of the administrative functions of the Office. In deciding the case, they must concern themselves only with the judicial questions before them and must act in accordance with the rules of natural justice set out in paragraphs 1.23 to 1.27 below. Where ex parte proceedings are concerned, the hearing officer also acts judiciously and in accordance with the rules of natural justice, but it should be recognised that he is acting partly in an administrative capacity which does not purport to be entirely independent of the process before. The fact that litigants have full rights of appeal to the courts, as noted above in relation to the Alconbury case, ensures that parties' rights in relation to the Human Rights Act are preserved.
- c) Fair hearing, impartial tribunal. The requirement for a fair hearing will usually be met if the principles of natural justice set out below are observed, but a further aspect of a fair hearing is considered to be the provision of the reasons on which a decision is based. Whilst it may not be necessary to deal with every argument raised and the reasons can be briefly stated, the reasons should nevertheless be intelligible and adequate, and should enable the reader to understand why the matter was decided as it was (see *South Bucks District Council v Porter (No 2)* [2004] UKHL 33, [2004] 1 WLR 1953). This will be necessary so that the appellant is in a position to exercise any right of appeal (see *English v Emery Reimbold and Strick Ltd* [2002] EWCA Civ 605, [2002] 3 All ER 385). A related point taken in *Markem Corporation v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 was that the trial judge had apparently disbelieved certain witnesses on matters when they had not been challenged on them at trial: the Court of Appeal held that if the evidence of a witness was to be disbelieved he must be given a fair opportunity to deal with the matter in cross-examination. Impartiality goes to the absence of prejudice and bias on the part of the tribunal, and that applies from both a subjective as well as an objective point of view. From a subjective viewpoint, therefore, appearances are again important, the test being how a fair minded observer would view the position (see eg *Lawal v Northern Spirit Ltd* [2003] UKHL 35, [2003] 1 RLR 538; *R (PD) v West Midlands and North West Mental Health*

[Review Tribunal \[2004\] EWCA Civ 311](#); and [In re Medicaments and related classes of goods No.2 \[2001\] 1 WLR 700](#)). A hearing officer should withdraw from a case where there may be a legitimate doubt as to impartiality.

- d) Public hearing and public judgment. In the spirit of openness, tribunal proceedings should be heard in public, ie the public should not be excluded, unless there are special circumstances that justify holding all or part of the hearing in private. Equally, unless there are special circumstances decisions should be available to the public. Exceptions to these principles may sometimes need to be made in Office proceedings because some of the evidence is confidential or because the dispute relates to an unpublished patent application. For more information, see Chapter 4 ('Admitting the public'), Chapter 5 ('Issuing decisions' and 'Confidential material') and Chapter 6 ('Offering and arranging the hearing').
- e) Hearing within a reasonable time. The objective here is to avoid excessive procedural delays and long periods of uncertainty or insecurity, and it is the responsibility of States to organise their legal systems accordingly (see [Mitchell v United Kingdom \(European Court of Human Rights, No 44808/98\)](#), The Times 28 December 2002 - the sixth judgment in this report) What is "excessive" varies from case to case as there is no absolute time limit, and it is the time from the initiation of proceedings to their final determination that is to be considered: in Mitchell procedural delays including 30 months to fix a trial date and protracted enforcement proceedings thereafter were held to be in breach of Article 6(1). Hearing workloads should thus be managed so that significant backlogs and delays do not build up at any point. Parties also have a right to a decision within a reasonable time, and it is the view of the Administrative Justice and Tribunals Council that the right to a hearing within a reasonable time also applies to the issue of the written decision.

However, in [Oystertec Plc's Patent \[2002\] EWHC 2324 \(Pat\)](#), [\[2003\] RPC 29](#) the Patents Court held that the requirement of Article 6(1) for a fair and public hearing (see principles (c) and (d) above) did not require an applicant for revocation under [section 72\(1\)](#) of the Patents Act 1977 to disclose the name of a client or principal for whom he might be acting.

1.21 Other Articles of the Convention that could conceivably be raised in proceedings before the comptroller are:

- Article 8: The right to respect for one's private and family life, home and correspondence, though this is a qualified, not an absolute, right (ie the Article permits interference with this right in certain circumstances). As explained in [Anufrijeva v Southwark London Borough Council \[2003\] EWCA Civ 1406](#), [2004] 2 WLR 603, for maladministration to constitute a breach of Article 8 there must be an

element of culpability, and an isolated act of even significant carelessness is unlikely to suffice.

- First Protocol, Article 1: The right to peaceful enjoyment of possessions, though again this is a qualified right and does not include rights in a patent application or trade mark application (see the decisions of the European Court of Human Rights in [British American Tobacco v The Netherlands \[1996\] 21 EHRR 409](#) and [Anheuser-Busch Inc v Portugal \[2005\] ECHR 686, \[2007\] ECHR 40](#)). The former case was followed in [Anderson's Application BL O/297/02](#) where the hearing officer declined to exercise discretion to allow the late filing of a divisional application.
- Article 14: Prohibition on discrimination. This prohibition only applies in connection with the enjoyment of other Convention rights - it is not in itself a ban on discrimination in other ways.

1.22 [Deleted]

1.23 The principles of natural justice have developed in the UK under common law. If a hearing is conducted in accordance with these principles it is likely to be a "fair hearing" in the meaning of Article 6 of the Convention. The principles may be summarised as follows:

- (1) no party may act as a judge in his or her own cause;
- (2) a party must know, in detail, the case he or she has to answer;
- (3) all interested parties must have an opportunity to be fully heard and/or represented on all relevant matters affecting their interests;
- (4) no decision may be arrived at before the admissible evidence and representations have all been fully heard and thoroughly considered; and
- (5) the decision must be arrived at in good faith and in accordance with the law, and not for some ulterior, albeit well meaning, motive such as general administrative convenience, sometimes in the guise of "policy".

The hearing officer should take care to act at all times in accordance with these principles.

1.24 Points (2)-(4) are all embodied, to some degree, in the Act and Rules. For example, for inter partes proceedings the relevant rules embody points (2) and (4) by spelling out the need for statement, counter-statement and evidence stages. Similarly, point (3) is reflected in eg [section 101](#) of the Patents Act 1977.

1.24.1 The power of the comptroller in entitlement disputes to make such order as he thinks fit was reinforced by the judgment of the House of Lords in [Yeda](#)

[Research and Development Company Limited v Rhone-Poulenc Rorer International Holdings Inc and others \[2007\] UKHL 43](#) overturning the judgment of the Court of Appeal and allowing the pleadings to be amended to allege sole, rather than joint, ownership. Hoffmann LJ said in paragraph 43:

I would agree with the hearing officer that rule 100 gave him a very broad discretion which he has to exercise in accordance with what appears to be fair and just in the particular circumstances of the case. The effect of the reference was that the question of entitlement was squarely before the comptroller and he would have had jurisdiction, even if the statement had not been amended, to make orders which in his opinion reflected what he considered to be the relative contributions of the parties to the invention.*

* This relates to former rule numbering. Correction of a document would now be available under either section 117 or [rule 107](#) depending on the circumstances.

- 1.25 To comply with points (2) and (3), all parties should be aware of all the documents which the hearing officer will be considering. That means each party must copy everything they send to the Office to the other side, and Litigation Section will make sure this is done. Further, the hearing officer should ask Litigation Section to notify the parties beforehand of any precedent cases or legislative provision which have not been referred to by any party but on which he/she wishes to be addressed. Similarly, in reaching a decision, the hearing officer should stick to the arguments and facts presented by the parties and not base a decision on facts or arguments on which he or she has not been addressed. Where a relevant precedent is handed down after a hearing, the hearing officer should not include it in the decision without giving the parties an opportunity to address him/her on it (see [Silver Spring Mineral Water Co Ltd's Trade Mark Application \[2003\] RPC 21](#)).
- 1.25.1 Where for any reason a document cannot be copied to the other side, the document should not be shown to the hearing officer and the party submitting it should be told that the hearing officer has not and will not see it.
- 1.26 As regards (4), all of the evidence on which one party relies must be available as of right to every other party to the proceedings or his or her legal representative.
- 1.27 To comply with (5), hearing officers must not allow themselves to be influenced by, for example, the wish of some other part of the Office to have a ruling that will avoid administrative problems, or the wish of the Office's policy department to interpret legislation in a particular way to meet government policy objectives. Indeed, it is precisely to prevent the latter that the comptroller is answerable direct to Parliament, and not to departmental ministers, for the way he administers the various Acts and Rules.

- 1.28 It also follows from these principles that the hearing officer must always maintain an open mind until the evidence and arguments have been assessed. Care should always be taken both before and during the hearing not to suggest that the hearing officer has in any way prejudged the matter before him or her, and for this reason the hearing officer should make clear when issuing a Preliminary Evaluation (see Chapter 2) or in expressing any other preliminary view, that the matter is still to be determined. In the case of a preliminary evaluation it is considered helpful for the hearing officer to give a guide as to the way he or she is thinking - always subject to whatever further arguments may be made - in order to help the parties focus on key arguments and avoid unnecessary work. Also, there is generally no objection to Litigation Section expressing a preliminary view of the Office in respect of procedural matters where this is likely to be of assistance to the parties provided that this is done in such a way that it does not commit the hearing officer. They will normally consult the hearing officer or his/her assistant before expressing such a view.
- 1.29 Further, although in ex parte cases it may be acceptable for the examiner, formalities examiner or hearing officer to indicate what evidence would be necessary to establish a fact, greater care is necessary in inter partes cases so as not to prejudice the hearing officer's impartiality. By and large it is for each party to decide what evidence to file, and the hearing officer should not generally interfere with this. However, where a Preliminary Evaluation issues before the evidence rounds, it will often indicate what evidence the hearing officer considers would be relevant. Also, if the case is going off the rails and a case management conference (see Chapter 2) is called, it may be appropriate for the hearing officer, having heard the parties, to give some guidance on the evidence that is needed.

Freedom of information

- 1.30 Although the [Freedom of Information Act 2000](#) confers a general right of access to information held by public authorities, [Part II](#) of the Act lists a number of categories of information which are exempt from the general right of disclosure. In practice, information in most documents arising in connection with inter partes or ex parte proceedings before the comptroller, if held only because of those proceedings and if not already open to public inspection, is likely to fall within the absolute exemption for court records conferred by [section 32\(1\)](#), having regard to the definition of "court" in [section 32\(4\)](#) as including "any tribunal or body exercising the judicial power of the State". The exemption covers documents: filed with, or otherwise placed in the custody of, a court; served upon, or by, a public authority; or created by a court or a member of the administrative staff of a court for the purposes of proceedings in a particular cause or matter. The Act does not therefore provide a vehicle for litigants to gain access to hearing officers' notes and other internal documents relating to the proceedings which are not already open to public inspection.

- 1.31 [Section 32\(2\)](#) creates an absolute exemption for information in documents placed in the custody of, or created by, a person conducting an inquiry or arbitration. This section may also come into play in relation to proceedings before the comptroller, particularly ex parte proceedings, in view of the definition of "inquiry" in [section 32\(4\)](#) as "any inquiry or hearing held under any provision contained in, or made under, an enactment", and the obligation of the comptroller under [section 101](#) of the Patents Act 1977 to offer a hearing before adversely exercising any discretionary power.
- 1.32 In general, documents retained in the Office on precedent files (see Chapter 8) will become "historical records" under [section 62](#) of the Act 30 years after their date of creation. Information in them cannot then be exempt under the provisions of [section 32](#).
- 1.33 If the hearing officer receives a request under the Act relating to proceedings before the comptroller, he or she should under [section 10](#) of the Act arrange for a reply to be sent to the applicant within 20 working days of receipt of the request by the Office. If the request relates to exempt information within [section 32](#), there is no duty even to confirm or deny that the information exists, and under section 17 the reply should be in the form of a notice identifying the exemption and why it applies, if that is not otherwise apparent. Before releasing any documents which are not open to public inspection, for the time being the matter should be discussed with both a Divisional Director and the Office's Freedom of Information liaison officer.

Constraints and powers

- 1.34 The hearing officer must ensure that he or she acts only within the powers of the comptroller as set down in the Act and Rules. Nevertheless, the hearing officer does have some power to regulate procedures in ways that go beyond what is expressly set out in the Act and Rules. As Pumfrey J said in [Pharmedica GmbH's Trade Mark Application \[2000\] RPC 536](#) (sometimes known as the "Friskies" case) at p541:

Notwithstanding the fact that the registrar is, like the County Court, a tribunal which is established by statute, I have no doubt that the Registrar has the power to regulate the procedure before him in such a way that he neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon him.

- 1.35 Pumfrey J based this on what Lord Donaldson said in *Langley v North West Water Authority* [1991] 3 All ER 610:

Although there is no statutory authority for making local practice directions, none is needed because every court has inherent jurisdiction to regulate its own procedures, save in so far as any such direction is inconsistent with statute law or statutory rules of court.

- 1.35.1 An inherent power cannot be used to bypass the constraints on an express power (see the patent case [Rhone-Poulenc Rorer International Holdings Inc v Yeda Research and Development Co Ltd \[2006\] EWHC 160 \(Ch\), \[2006\] RPC 24](#) at paragraphs 45 - 46 which presumably still holds although the overall outcome was overturned on appeal by the House of Lords).
- 1.36 Pumfrey J also observed that for these purposes there is no distinction between the jurisdiction of the County Court and that of the Registrar of Trade Marks. Clearly, although this was a trade marks case, the same principles must apply to patent and design right proceedings.
- 1.37 The hearing officer must also act only within the authority conferred on an official of his or her grade or post (see MoPP paragraph 130.05).
- 1.38 The hearing officer can never change, or decline to accept, the law in reaching a decision - the hearing officer must interpret and apply the law as it is enacted. For example, a hearing officer cannot make an order which he or she thinks is appropriate in the circumstances but for which there is no vires under the Act or Rules.
- 1.39 Further, the hearing officer must not twist the law simply to suit the case in hand. Thus, as stated by Lord Diplock in [E's Application \[1983\] RPC 231](#) at page 253:

..... no tribunal and no court of law has any discretion to vary the meaning of the words of primary or secondary legislation from case to case in order to meet what the tribunal or the court happens to think is the justice of the particular case. Tempting though it may sound, to do so is the negation of the rule of the law. If there are cases in which the application of the Patents Rules leads to injustice, the cure is for the Secretary of State to amend the Rules. If what is thought to be the injustice results from the terms of the Act itself, the remedy is for Parliament to amend the Act.

Exercise of discretion

- 1.40 The legislation often gives the comptroller discretion. However, that does not mean the comptroller has the power to do what he likes, because discretion must be exercised judicially on reasonable grounds and never in an arbitrary way - see "Rawhide" Trade Mark [1962] RPC133.
- 1.41 Situations in which discretion may need to be exercised in inter partes proceedings commonly include requests to extend the time for various acts to be done, to postpone a hearing, to amend a statement of case or to file additional evidence. There must be explanation, and not merely argument, before the comptroller on which the exercise of discretion can be based. This principle was underlined by the Court of Appeal in *Savill v Southend Health Authority* [1995] WLR 1254, a decision on extension of time which reviewed a number of earlier authorities and ended up relying on the principles laid

down by the Privy Council in *Ratnam v Cumarasamy* [1965] 1 WLR 8. In the latter, their Lordships said:

The rules of court must prima facie be obeyed, and in order to justify a court in extending the time during which some step in procedure requires to be taken there must be some material upon which the court can exercise its discretion. If the law were otherwise, a party in breach would have an unqualified right to an extension of time which would defeat the purpose of the rules, which is to provide a time table for the conduct of litigation.

- 1.42 In some circumstances evidence may be necessary - see eg [Coal Industry \(Patents\) Ltd's Patent \[1994\] RPC 661](#) - although it should not routinely be asked for in the light of the matters discussed below.
- 1.43 Although the [Civil Procedure Rules 1998](#) are not binding on the comptroller, some guidance as to the general principles to be applied are to be found in the commentary in "Civil Procedure" under rules 3.1, 3.9 and 17.3. These principles are generally underpinned by the courts' overriding objective to deal with cases fairly, (explained in more detail in [Chapter 2](#)).
- 1.44 The requirements of [rule 3.1](#) and [3.9](#) of the Civil Procedure Rules and their inter-relationship have been considered by the Court of Appeal. Rule 3.1(2)(a) gives the court, as part of its general powers of case management, the power to

extend or shorten the time for compliance with any rule, practice direction or court order (even if an application for extension is made after the time for compliance has expired).

[Rule 3.9\(1\)](#) gives a checklist of factors to be considered on an application for relief from sanctions imposed for a failure to comply with any rule, practice direction or court order: these include: the interests of the administration of justice; whether the application for relief has been made promptly; whether the failure to comply was intentional; whether there is a good explanation for the failure; the extent to which the party in default has complied with other rules, practice directions and court orders and any relevant pre-action protocol; whether the failure to comply was caused by the party or his legal representative; whether the trial date or the likely date can still be met if relief is granted; the effect which the failure to comply had on each party; and the effect which the granting of relief would have on each party.

- 1.45 As explained in "Civil Procedure", the Court of Appeal has on several occasions made it clear that all of these factors are to be taken into account on an application under rule 3.9. Even then it is not necessarily exhaustive since the rule requires the court to consider all the circumstances of the case - see eg [Meredith v Colleys Valuation Services Ltd \[2001\] EWCA Civ 1456](#), [2002] CP Rep 10. The Court of Appeal has also taken the rule 3.9 factors into account on applications under rule 3.1(2)(a) to extend a time limit after it had expired (see [Price v Price \[2003\] EWCA Civ 888](#), [2003] 3 All ER 911

and [Sayers v Clarke Walker \[2002\] EWCA Civ 645](#), [2002] 1 WLR 3095). However in *Robert v Momentum Services Ltd* [2003] EWCA Civ 299, [2003] 2 All ER 74, where the application was made before the period had expired, the Court distinguished *Sayers* as a "relief from sanctions" case and decided the matter with regard to the overriding objective, concentrating on the prejudice caused by the failure to comply with the time limit.

- 1.46 Bearing in mind that the Civil Procedure Rules are not binding on the comptroller, the hearing officer when considering these guidelines should always have in mind the less formal nature of proceedings before the comptroller. However an overriding objective corresponding to that in the CPR has been introduced by [rule 74](#) of the Patents Rules 2007, which strengthens the correspondence. Evidence in support of a request to exercise discretion (which is required by rule 3.9(2) on an application for relief from sanctions) should not be called for unless really necessary - see the observations of the hearing officer in [Denso Corporation v NGK Spark Plug Company Ltd BL O/076/03](#). Nor, in line with *Robert v Momentum Services*, need all the rule 3.9 factors be considered on a request to extend a time limit which has not expired or to postpone a hearing. Further guidance as to the factors to be considered in these and other particular circumstances is given in the relevant chapters of this Manual.

Construction of UK legislation

- 1.47 There are a number of established rules on the construction of statutes, some which are discussed below. In addition, the Interpretation Act 1978 sets out some broad principles for construction of statutes and contains many definitions of terms (such as month, person, service by post, writing) that apply unless the contrary intention appears.

Statutes should be read as a whole

- 1.48 Statutes should be interpreted in accordance with the general rule set out in *Canada Sugar Refining Co v R*. [1898] AC 735 at page 741:

Every clause of a statute should be construed with reference to the context and other clauses of the Act, so as, as far as possible, to make a consistent enactment of the whole statute or series of statutes relating to the subject-matter.

- 1.49 Thus, as stated in [International Paint Company Limited's Application \[1982\] RPC 247](#) at page 268:

The provisions of the Patents Act should all be read together and the Act construed as a whole if possible.

- 1.50 The presumption is that where a word or term is used in different places in a statute, it always has the same meaning in the absence of any express

indication to the contrary in that statute. Thus, in [Unilever Limited \(Davis's Application \[1983\] RPC 219](#) at page 229, Falconer J stated:

I cannot think that Parliament intended the word "therapy" to be used in two different senses in section 4(2), one in relation to the treatment of the human and another in relation to the treatment of the animal body.

Conversely, where different words are used in the same statute there is a presumption that they have a different meaning.

- 1.51 A statute should be construed so as to give some effect to every word unless there is a sound reason for treating a word or words as tautologous.

Construe words in their ordinary sense

- 1.52 Any definition of a word or phrase in the statute itself must necessarily be applied when construing that statute. Subject to that, words or phrases in a UK statute should be interpreted on their natural and ordinary meaning. The general rule, as endorsed in [Unilever Limited \(Davis's Application](#) (supra) at page 255, is that:

In dealing with matters relating to the general public, statutes are presumed to use words in their popular, rather than their narrowly legal or technical sense: 'loquitor ut vulgus' that is, according to the common understanding and acceptance of the term.

- 1.53 However, attempts to "prove" the meaning of everyday words by using a dictionary may need to be treated with some scepticism. As Mummery L J said in [Farmers Build Ltd v Carrier Bulk Materials Handling Ltd \[1999\] RPC 461](#) at p478:

No question of interpretation can be resolved simply by dipping into a dictionary. It is not the function of lexicographers to construe statutes.

- 1.54 The temptation to create alternative definitions for words or expressions in statutes should be resisted. To quote Mummery L J in Farmers Build again, at p479:

The process of statutory interpretation does not, however, require the court to supply definitions of words which Parliament has deliberately chosen not to define and which are simple, ordinary words of the English language. It is for the courts to decide whether those words apply to or cover the facts of the case for adjudication.

Construe in such a way as to avoid absurdity

- 1.55 As stated by Lord Reid in [Gartside v Inland Revenue Commissioners \[1968\] AC 553](#) at page 613:

It is always proper to construe an ambiguous word or phrase in the light of mischief which the provision is designed to prevent, and in light of the reasonableness of the consequences which follow from giving it a particular construction.

See also [Smith Kline and French Laboratories Ltd v R D Harbottle \(Mercantile\) Ltd and others \[1980\] RPC 363](#) at page 373.

- 1.56 In line with this rule, in *Therm-a-Stor Ltd v Weatherseal Windows Ltd* [1981] FSR 579 at page 595, Oliver LJ concluded in respect of the applicability of Schedule 4 to section 70 of the 1977 Act that:

*.....to make sense of paragraph 3(2) [of Schedule 4] at all, there has to be some departure from the literal meaning of the words used. The House of Lords adopted a similar approach in [Inco Europe Ltd v First Choice Distribution](#) [2000] 1 WLR 586 and gave guidelines on when it is permissible to depart from the plain words of the statute. However, the hearing officer should adopt such an approach only in exceptional circumstances, particularly in view of the statement of Lord Diplock in *E's Application* recited in paragraph 1.39 above.*

"Ejusdem generis" rule

- 1.57 Where particular words in a statute are followed by a generalising expression, the latter should be construed as limited to things within the same class as the particular words. Thus if a statute referred to "dogs, cats and other animals", the "other animals" should be construed as limited to domestic animals.

"Expressio unius est exclusio alterius" rule

- 1.58 Under this rule ("the expression of one thing implies the exclusion of another"), where a provision in a statute is restricted to specific circumstances, there is a presumption that the provision does not apply in other circumstances. For example, when the Design Right (Proceedings before Comptroller) Rules 1989 state that the comptroller can require an applicant to give security for costs if they neither reside nor carry on business in the UK or another EC member state, the presumption must be that he cannot require security if the applicant does so reside or carry on business.

"Generalia specialibus non derogant" rule

- 1.59 Where proceedings could conceivably be covered by two different provisions of the same statute, a more general provision cannot derogate from a more specific one. This is the rule of construction known as *generalia specialibus non derogant* - see [E's Application \[1983\] RPC 231](#) at pages 250-1.
- 1.60 Thus, in [Antiphon AB's Application \[1984\] RPC 1](#), Falconer J (prior to the amendment of the 1977 Act by the CDP Act 1988) refused to allow the filing

of drawings omitted from the patent application by way of correction under [section 117\(1\)](#) on the grounds that:

"A correction may not be allowed if the effect of it would be to allow an applicant to circumvent the clear mandatory requirements of section 15(2)."

- 1.61 A similar approach was adopted by the hearing officer in [Rhone Poulenc Sante's Patent \[1996\] RPC 125](#) where a correction to a translation of an EP(UK) if allowed under [section 117\(1\)](#) would have circumvented the provisions of [section 80\(3\)](#).

Comparison with previous statutes

- 1.62 There is a general presumption that if an earlier statute is superseded by a later statute, where the two statutes use the same wording the meaning of this wording in the later statute is the same as in the earlier one. This means that legal precedents as to the meaning of the wording in the earlier statute apply to the later statute.
- 1.63 This presumption can be displaced if it is clear the later legislation was intended to completely change the law. Thus it has been held not to apply to the Civil Procedure Rules - see paragraph 1.77 below. See also the decision of Falconer J in [Unilever Limited \(Davis's\) Application \[1983\] RPC 219](#) at page 229 that the old patent law had been largely "swept away" by the 1977 Act.
- 1.64 Where different wording is used, the hearing officer will have to consider to what extent the same meaning can be attributed to the later statute. See for example the discussion of the applicability of the "Catnic" purposive construction of claims under the Patents Act 1949 to the 1977 Act in [Kastner v Rizla Ltd and anr \[1995\] RPC 585](#) at page 594 et seq. See also the decision of Oliver J in [Smith, Kline and French Laboratories Ltd v R D Harbottle \(Mercantile\) Ltd and others \[1980\] RPC 363](#) at page 374 that:

If it had really been intended to effect a revolutionary change I would have expected it to be done by much stronger and more positive language than this. Indeed where the legislature did intend to make an alteration in the existing law or at least to clarify it, as in sub-section 2 of Section 60, it did so quite expressly.

Reference to Parliamentary debate

- 1.65 Although a statute should generally be interpreted on its own words, in *Pepper v Hart* [1992] 3 WLR 1032 the House of Lords held that:

Subject to any question of Parliamentary privilege, the rule excluding reference to Parliamentary material as an aid to statutory construction should be relaxed so as to permit such reference where

a) legislation was ambiguous or obscure or led to absurdity,

b) *the material relied upon consisted of one or more statements by a minister or other promoter of the Bill together if necessary with such other Parliamentary material as was necessary to understand such statements and their effect and*

c) *the statements relied upon were clear*

This should now be read in the light of the subsequent judgment of the House of Lords in [Wilson v First County Trust \[2003\] UKHL 40](#), [2003] 4 All ER 97. Referring to the duty of the court under the Human Rights Act 1998 to evaluate legislation in the light of the European Convention on Human Rights (discussed in 1.67 below), Lord Nicholls said:

The courts would be failing in the discharge of the new role assigned to them by Parliament if they were to exclude from consideration relevant background information whose only source was a ministerial statement in Parliament or an explanatory note prepared by his department while the bill was proceeding through Parliament. By having such material the courts would not be questioning proceedings in Parliament or intruding improperly into the legislative process or ascribing to Parliament the views expressed by a minister. The court would merely be placing itself in a better position to understand the legislation. To that limited extent there might be occasions for the courts when conducting the compatibility exercise to have regard to matters stated in Parliament.

Other rules

1.66 Statutory Instruments such as the Patents Rules are subordinate to the Act under which they are made and must be read together with that Act. The Rules cannot override express provisions in the Act from which they derive their authority. As James LJ said in *Ex parte Davis*, *In re Davis* [1872] 7 Ch 526 at p529:

If the Act is plain, the rule must be interpreted so as to be reconciled with it, or, if it cannot be reconciled, the rule must give way to the plain terms of the Act

i.e. a rule must not be ultra vires the Act. See also [R \(Haw\) v Home Secretary \[2005\] EWHC 2061 \(Admin\)](#), [2006] 2 WLR 50, where an order made pursuant to a power to make transitional provisions was ultra vires since it had the effect of amending the statute in question.

1.67 In general the interpretation given by a court to a statute is the meaning it has borne from the outset. As explained by Lord Nicholls in the judgment of the House of Lords in [In Re Spectrum Plus Ltd \[2005\] UKHL 41](#), [2005] 4 All ER 209, a ruling by the House of Lords that a previous decision was wrong simply corrects an error of interpretation and does not change the law: it therefore followed that, save in exceptional circumstances, there could be no

question of the House overruling a decision on interpretation with prospective effect only. However, under the [Human Rights Act 1998 \(section 3\)](#), primary and secondary legislation, whenever enacted, must be read and given effect in a way that is compatible with the European Convention on Human Rights so far as it is possible to do so. In general, even if construing a statute in this way necessitates giving the words of the statute something other than their plain meaning, or departing from the rules of construction given above, that should be done. However, as explained in [Wilson v First County Trust \[2003\] UKHL 40](#), [2003] 4 All ER 97, the courts are unlikely to apply section 3 retrospectively so as to change the interpretation and effect of existing legislation if this is likely to produce an unfair result for a party, eg (see *A v Hoare*, *The Times* 28 April 2006) by depriving a defendant of accrued rights or giving a claimant a cause of action he would not otherwise have had. If a provision of secondary legislation is incompatible with the Convention it can in theory be ignored, but in practice it should always be possible to find a meaning that is compatible (see [Goode v Martin \[2001\] EWCA Civ 1899](#), [2002] 1 WLR 1828 where the language of a rule of court was interpreted to secure a just result). Guidance on the interpretation of human rights legislation generally can be found in 'Civil Procedure' vol 2 at 3D-16.

Treaties and International Agreements

- 1.68 The question of the legal effect of treaties may occasionally arise in proceedings before the comptroller. Hearing officers therefore need to be aware of the underlying principles. A treaty is a written agreement between States and is governed by international law. In the United Kingdom the power to enter into treaties is a function of the executive under prerogative powers rather than of the legislature, and under the doctrine of parliamentary sovereignty a treaty cannot alter national law unless it is given effect by an Act of Parliament. The acceptance into United Kingdom law of rights and obligations created by European Community treaties therefore takes place, not directly, but under the [European Communities Act 1972](#) (see particularly sections [2\(1\)](#), [2\(4\)](#) and [3\(1\)](#)). The interaction between domestic and Community law in this regard, and the extent to which Community law prevails, is a matter of both complexity and controversy, and reference should be made to constitutional law reference books for a fuller treatment of the subject.
- 1.69 In the area of intellectual property, the effect of the [Agreement on Trade-Related Aspects of Intellectual Property Rights](#) (TRIPs) has been considered in [Azrak-Hamway International Inc's Application \[1997\] RPC 134](#) and [Lenzing AG's European Patent \[1997\] RPC 245](#). In *Azrak-Hamway* it was argued before the comptroller that United Kingdom legislation on licenses of right for design right and copyright was void for incompatibility with TRIPs, because TRIPs was part of Community law and hence of United Kingdom law under the European Communities Act 1972 (the Agreement having been signed both for the Community and by individual Member States). This argument failed, the hearing officer holding

that, although there was joint competence between the Community and the Member States to sign the Agreement, the provisions in question were within the area of competence of Member States, not the Community, and could not therefore be overridden by any part of TRIPs which had become embodied in Community law. Even if that were wrong, the hearing officer considered that TRIPs was not susceptible to being directly invoked in Community or Member State courts. A similar view was also taken in *Lenzing*, where Jacob J held it clear from Article 1(1) that TRIPs was not intended to have direct effect (unlike a Community Directive which was an instruction to individual Member States to bring their laws into conformity with the Directive). Its provisions concerning judicial review did not therefore confer a private right to challenge the registration by the comptroller of the revocation of a European patent by the European Patent Office. *Lenzing* was followed by the comptroller in *Franks' Applications* [BL O/024/05](#), [BL O/025/05](#), [BL O/026/05](#), and [BL O/027/05](#) with regard to the patentability exclusions of section 1 of the Patents Act 1977.

Construction of European Legislation

- 1.70 In construing EU law such as Council Regulations, the hearing officer should have regard to the judgment of the House of Lords in *Regina v Henn and Darby* [1981] AC 850, in particular the passage at B on p.905 which reads:

The European court in contrast to English courts, applies teleological rather than historical methods to the interpretation of the Treaties and other Community legislation. It seeks to give effect to what it conceives to be the spirit rather than the letter of the Treaties; sometimes, indeed, to an English judge, it may seem to the exclusion of the letter.

Since that judgment was given the UK courts have themselves moved towards a more purposive construction of domestic legislation, but European legislation still requires a different approach.

- 1.71 The following guidance on interpretation of EU legislation at paragraphs 2.266 and 2.268 of Volume 51 of Halsbury's Laws of England (4th edition) is helpful:

2.266 The text. The starting point for the interpretation of a provision is the words used, but the clear meaning of a provision and its literal meaning are not synonymous. In some cases, reference to the literal meaning of the text has been sufficient to establish its true construction, but literal analysis of the text is not always appropriate in view of the nature and scheme of the measure in question or the circumstances in which the provision was adopted. The literal meaning of a provision must be discarded if it is inconsistent with the general scheme and the context in which it is to be applied, or where there are discrepancies between the language versions of the text of the provision. In consequence, even if the wording used seems to be

clear, it is still necessary to refer to the spirit, general scheme and context of the provision, a fortiori, if the wording is unclear.

2.268 The preamble and preparatory material. Reference may also be made to the recitals in the preamble of a measure in order to confirm the interpretation to be given to a provision of Community law.

Documents drawn up in the course of the negotiation and drafting of the ECSC, EEC and Euratom Treaties are not available for use in interpreting provisions of the treaties. The Court of Justice has referred to the opinions of the governments of the member states submitted to the national parliaments during the debates on the treaties in order to discern their common intention or confirm an interpretation of the provision in question, but has effectively ceased to use them as an aid to interpretation, preferring to rely on the content and purposes of the treaties. Preparatory material may be used as an aid in the interpretation of secondary legislation or a convention if it has been published or is otherwise accessible to all the persons affected by the measure

- 1.72 Although there have been instances of the use of statements in the Council minutes as an aid to interpretation of EU law, *Laddie J in Wagamama Ltd v City Restaurants Plc and anr* [1995] FSR 713 held the burden of authority to be against it.
- 1.73 Thus, in interpreting EC Regulations, the hearing officer may refer to the Explanatory Memoranda contained in the proposals for the regulations as presented by the Commission, and to the Recitals at the commencement of the Regulations, but not any statements entered in, or intended to be entered in, the Council minutes. However, in taking account of the Explanatory Memoranda, regard should be taken of any difference between the text of the proposal and that of the Regulations as adopted.

Relevance of the Civil Procedure Rules

- 1.74 The comptroller is not bound by the Civil Procedure Rules and their associated Practice Directions. In [Rhone-Poulenc Rorer International Holdings Inc v Yeda Research and Development Co Ltd \[2006\] EWHC 160 \(Ch\)](#) Lewison J confirmed the view of the hearing officer that "he did not consider that he was bound to apply the CPR in all cases where there might be a lacuna in the procedures prescribed by the Patents Act and the Patents Rules, still less that he should regard the CPR as some sort of gloss which automatically applies as a further layer of rules governing those procedures". This presumably still holds although the overall outcome of the case was overturned on appeal by the House of Lords. Nevertheless, the Civil Procedure Rules have a significant influence on Office proceedings for a number of reasons. For example, the comptroller, by virtue of Rules [82](#), [86](#) and [87](#) of the Patents Rules 2007, has the same powers as a High Court judge in relation to the taking of evidence, the attendance of

witnesses and the discovery and production of documents. The hearing officer must therefore have full regard to the relevant Civil Procedure Rules in these matters. Further, where the comptroller and court have concurrent jurisdiction, evidence before the comptroller should be the same as that which would be admissible before the court ([ST TRUDO Trade Mark \[1995\] RPC 370](#)), so again, full regard must be had to the relevant Civil Procedure Rules. Yet again, whilst the Patents Rules state that evidence before the comptroller may inter alia be by way of affidavit (eg [rule 87\(1\)\(a\)](#) of the Patents Rules 2007), it is to the Civil Procedure Rules that one must turn to find out how an affidavit should be presented.

- 1.75 Perhaps more importantly, the Civil Procedure Rules commence by setting out as their "overriding objective" in rule 1 what is necessary to deal with a case justly. An equivalent "overriding objective" was introduced as a guiding principle governing procedures before the comptroller, by [rule 74](#) of the Patents Rules 2007. Considerations in relation to the overriding objective are therefore applicable in proceedings before the comptroller in the same way as they are to those before the courts - see Chapter 2.
- 1.76 Nevertheless, tribunals such as the comptroller's are expected to be a less formal and cheaper forum than the High Court, and this should be borne in mind when deciding how far to follow High Court procedures. Thus the High Court's standard disclosure procedures do not apply before the comptroller, although the comptroller still has the power to order disclosure.
- 1.77 The Civil Procedure Rules supersede the Rules of the Supreme Court. Because the latter were not subject to the "overriding objective" of rule 1 of the former, the court has held that even where the two rules have an identically-worded provision, the interpretation that had been put on that provision under the Rules of the Supreme Court should not necessarily be followed when interpreting the provision under the Civil Procedure Rules" see [Morgan Est \(Scotland\) Ltd v Hanson Concrete Products Ltd \[2005\] EWCA Civ 134](#), [2005] 3 All ER 135, and also Hart J's comments in *Natwest Lombard Factors Ltd v Arbis* (29 October 1999, *The Times* 10 December 1999). Thus caution needs to be exercised when considering whether it would be appropriate to follow what would have been the practice in the courts under the old rules, although - unusually - that may be the case where the Civil Procedure Rules have been drafted more narrowly so as to prejudice the overriding objective - see Pumfrey J in *Omega Engineering Inc v Omega SA* [2003] EWHC 1482 (Ch), *The Times* 29 September 2003.

Office Manuals and Practice Notices

- 1.78 Office practice manuals, such as this Manual, the [Manual of Patent Practice](#) and the [Litigation Manual](#), have no legal authority. As explained in the Introduction, they are an indication of current practice but are not binding on the hearing officer and cannot fetter the exercise of discretion by the comptroller.

- 1.79 In exercising his power to regulate procedures (see from paragraph 1.34 above), from time to time the comptroller issues [Tribunal Practice Notices](#) ("TPN"s). These have the same status as this Manual and their contents are reflected in this Manual as it is updated. They are available on the Office's web site, and some have also been published in RPCs.

Precedents

- 1.80 The hearing officer should always take full account of any relevant precedent cases in reaching a decision. The hearings clerk will automatically obtain copies of any precedents being used by a party at a hearing if the party itself has not provided them.
- 1.81 Where the hearing officer is aware of a precedent case which is prima facie relevant to any matter in issue but has not been referred to by the parties to the proceedings, he/she should ask Litigation Section to tell the parties that the hearing officer wishes to be addressed on it.
- 1.82 Judgments of the House of Lords and "courts of record" (eg the Court of Appeal and Patents Court) are binding on all inferior courts and tribunals. It is thus not open to the hearing officer to depart from a precedent of a court of record which is on all fours with the case in suit as regards any point at issue. Where, however, the hearing officer is satisfied that the case in issue is distinguished from an earlier case cited as a precedent on the facts or that the precedent did not in fact decide the point in issue, the decision of the court in the earlier case need not be followed.
- 1.83 Judgments of inferior courts (eg county courts) and tribunal decisions are not legally binding, but for obvious reasons of certainty and consistency ought not to be departed from in comparable circumstances without very good reason.
- 1.84 In the Office, decisions of one hearing officer are not legally binding on other hearing officers (unless subsequently upheld by a court of record). However, again the hearing officer should not depart from the reasoning of an earlier decision without good reason.
- 1.85 If relevant, the hearing officer should pay due regard to any rulings of the European Court of Justice.
- 1.86 With regard to precedents:-so far as Court of Appeal and House of Lords reports are concerned only judgments reflecting unanimous or majority decisions are strictly precedents; if the point in question was decided under earlier legislation now repealed, it should be ensured that the point remains valid under the current legislation; where a decision of a High Court judge has been fully considered but not followed by another judge of the High Court, the second decision should be considered as having settled the point. See *Colchester Estates (Cardiff) v Carlton Industries plc* [1986] 1 Ch 80; and obiter dicta should not be confused with binding precedent (the ratio

decidendi). The essential point is that while a judge's view will always be significant, obiter comments cannot be binding for the simple reason that the parties almost certainly had not been given the opportunity of making full and considered representations on the point in question. Thus, a close reading of a report will often be necessary in order to decide whether or not any particular aspect pronounced upon is obiter.

- 1.87 [Section 130\(7\)](#) of the Patents Act 1977 states that certain provisions of the Act are so framed, as to have, as nearly as practicable, the same effects as the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Cooperation Treaty. In interpreting those provisions, the hearing officer should take account of how corresponding Articles of the European Patent Convention have been interpreted by the European Patent Office and the courts and tribunals of other countries of the European Union (see [Pioneer Electronics Capital Inc and another v Warner Music Manufacturing Europe GmbH and anr \[1995\] RPC 487](#), a decision of the Patents Court on section 60(1)(e)). However, as stated by Laddie J, in *Wagamama Ltd v City Centre Restaurants plc and anr [1995] FSR 713* (a decision on interpretation of the Trade Marks Act 1994) at page 728

The obligation of the English court is to decide what the proper construction is..... It would not be right for an English court to follow the route adopted by the courts of another Member State if it is firmly of a different view simply because the other court expressed a view first.

- 1.88 Decisions of (a) the Boards of Appeal and Enlarged Board of Appeal of the European Patent Office and (b) the courts and tribunals of the member countries of the EU are not binding by themselves unless approved and adopted by a court of record. Nevertheless, such decisions, particularly those of the Boards of Appeal of the European Patent Office, should be regarded as persuasive and should normally be followed. The Court of Appeal in [Actavis UK Limited v Merck & Co Inc \[2008\] EWCA Civ 444](#) found that it was free (but not bound) to depart from the ratio decidendi of an earlier Court of Appeal decision if it was satisfied that the EPO Boards of Appeal had formed a settled view of European Patent law which was inconsistent with that earlier decision.

Weight to attach to legal reference books

- 1.89 The hearing officer may have regard to legal reference books provided that the parties have the opportunity to address the hearing officer on their contents. Whilst these works are not definitive, they can be very helpful and the hearing officer should not depart from any interpretation expressed in them without good reason.
- 1.90 Of particular relevance to proceedings before the comptroller are the CIPA Guide to the Patents Act, the Examination Guidelines of the European

Patent Office, and standard reference books such as Terrell on patents, Copinger or Laddie, Prescott and Vitoria on copyright and design right, and more generally, Cross or Phipson on evidence.

Changes to the law: transitional issues

- 1.91 Where there has been a change in the relevant law, the hearing officer may need to decide whether the old or new law applies. The general rule, as set out by Oliver LJ in connection with the change from the 1949 Patents Act to the 1977 Act in *Therm a Stor Ltd v Weatherseal Windows Ltd* [1981] FSR 579 at page 587 is that:

the logic of the matter would dictate that the old law should continue to apply as regards anything happening before the appointed date [for the entry into force of the new law], and that the new law should apply as regards anything happening after that date, but subject to any modifications which would be inappropriate or inapplicable having regard to the inescapable fact that what has to be dealt with is an infringement of a 1949 Act patent

(See also [Martinez's Patent \[1983\] RPC 307](#)). However, this is subject to any transitional or other express provisions such as those in the Schedules to the Patents Act 1977 and Schedule 5 of the Copyright, Designs and Patents Act 1988.

- 1.92 In addition, the [Interpretation Act 1978](#) provides that

16(1)... where an Act repeals an enactment, the repeal does not, unless the contrary intention appears: revive anything not in force or existing at the time at which the repeal takes effect; affect the previous operation of the enactment repealed or anything duly done or suffered under that enactment; affect any right, privilege, obligation or liability acquired, accrued or incurred under that enactment; affect any penalty, forfeiture or punishment incurred in respect of any offence committed against that enactment; affect any investigation, legal proceeding or remedy in respect of any such right, privilege, obligation, liability, penalty, forfeiture or punishment; and any such investigation, legal proceeding or remedy may be instituted, continued or enforced, and any such penalty, forfeiture or punishment may be imposed, as if the repealing Act had not been passed.

Reference to the European court of Justice (ECJ)

- 1.93 Whilst in practice a request to refer a matter of interpretation of EU law to the European Court of Justice under what is now Article 234 of the Treaty establishing the European Community is more likely to be made in the courts, the hearing officer in [Azrak-Hamway International Inc's Application \[1997\] RPC 134](#) at page 151 was of the view that comptroller

was entitled to make such a reference. However, the matter may not be entirely settled in view of the judgments of the ECJ in [De Coster v College des Bourgmestre et Echevins de Watermael-Boitsfort](#) (C- 17/00) [2002] 1 CMLR 12 and [Gabalfrisa SL v AEAT \(C 110/98 -C 147/98\)](#)[2002] 1 CMLR 13 concerning what was required to constitute a "court or tribunal" having the power to make a reference.

Finality in litigation

Estoppel

- 1.94 Estoppel is the principle whereby a party can be prevented from fighting certain issues or making certain assertions because of actions they have taken previously. Contrarily, looked at it from the point of view of the party in whose favour they operate, estoppels could be regarded as something which renders proof of certain facts unnecessary. There is a debate as to whether estoppels form part of substantive law or part of the law of evidence, but this looks to be a mere matter of semantics of no practical significance. It is important to note that estoppel must be expressly pleaded by the party wishing to invoke it against the other side. The fact that a party had omitted to plead estoppel at first instance was a major factor in disallowing it as a ground on appeal in [M-systems Flash Disk Pioneers Limited v Trek 2000 International Limited and Anr \[2008\] EWHC 102 \(Pat\)](#) see paragraphs 73 to 79.
- 1.95 Estoppel has become complicated by the evolution of case law, and (see below) by recent developments in the law concerning abuse of process by relitigation. Broadly, however, there are three basic classes of estoppel: estoppel by record (also known as estoppel per rem judicatem or res judicata estoppel), estoppel by deed and estoppel by conduct. However, there are several types of estoppel within the first and third classes. For further guidance on the types of estoppel see legal reference books on evidence such as Cross or Phipson.
- 1.96 Estoppel by record (doctrine of res judicata) applies where a relevant judgment (and that includes a decision of a tribunal such as the comptroller) has already been given. The judgment stands forever, as between the parties unless it is modified by the normal course of appeal (in which case the modified judgment stands in its place). For example, in an infringement action ([Poulton v Adjustable Cover & Boiler Block co \(1908\) 25 RPC 529](#) the plaintiff was awarded damages which were ordered to be assessed and paid by the defendant in due course. However, before the damages had been paid, the defendant caused the patent to be revoked on the basis of new evidence. Accordingly, he argued that he need no longer pay the original damages since the patent must, at the time of the first action, have been invalid. He was however held to the terms of the first decision. This judgment although old remains good law - see [Coflexip SA v Stolt Offshore MS Ltd \(No 2\) \[2004\] EWCA Civ 213](#), [2004] FSR 34, discussed below with regard to abuse of legal process. See also [Unilin Beheer BV v Berry Floor NV and](#)

- [Others \[2007\] EWCA Civ 364](#) in which it was decided that a later finding of invalidity of an EP(UK) patent in an EPO opposition would not disturb a finding in the UK Courts that the patent was valid and infringed as between the parties in the UK action, so that any damages must still be paid.
- 1.97 There are two types of estoppel by record. The first is "cause of action" estoppel where the same cause of action lies in a final judgment (cf the example given above). The second is issue estoppel which, per Lord Denning in *Fidelitas Shipping Co Ltd's v v/o Exportchleb* [1966] 1 QB 630 at p640, applies where, within one cause of action, there are several issues raised which are necessary for the determination of the whole case. Once an issue has been raised and distinctly determined (even if the question was in fact not the subject of any dispute or argument) then as a general rule neither party can be allowed to fight that issue all over again. But not always - cf, for example, *Rose Bro's (Gainsborough) Ltds Appln* [1960] RPC 247 and *Hodgkinson & Corby Ltd & anr v Wards Mobility Services Ltd* [1997] FSR 178. [Cinpres Gas Injection Limited v Melea Limited \[2008\] EWCA Civ 9](#) contains a discussion of the difference between cause of action and issue estoppel - see paragraphs 66 to 77. Estoppel was not established in that case, the judgment holding that there had been perjury by a witness closely identified with one of the parties; (see paragraphs 105 to 107), and adoption of the fraud by the party itself; (paragraphs 108 - 120).
- 1.97.1 For both cause of action and issue estoppel, particular caution is needed in respect of findings made by foreign courts, as illustrated in [Air Foyle Ltd v Center Capital Ltd \[2002\] EWHC 2535 \(Comm\)](#), [2003] Lloyd's Rep 753, which reviews some of the principles. In a patent validity/infringement action *Kirin-Amgen Inc & anr v Boehringer Mannheim GMBH & anr et al* [1997] FSR 289 where the question of issue estoppel was considered in the Court of Appeal it was held, inter alia, that there was no abuse of process, the patents and the law each differing from those of the US litigation and accordingly the facts required to reach a decision could be different. It was not right that parties who had no interest in the US market and no rights under the US patents should be precluded from putting forward their case as they saw fit to protect and enforce their rights in the United Kingdom. However, the fact that the reasoning of the foreign court may be open to criticism will not of itself prevent an issue estoppel from arising (see *Air Foyle* above). In [Special Effects Ltd v L'Oreal SA and Another \[2007\] EWCA Civ 1](#) it was held that cause of action or issue estoppel was not created where a party litigating in the High Court had lost on a similar issue in the Trade Marks Registry, since the decision of the Registry was not final.
- 1.98 In some cases a judgment may be conclusive as against all persons (judgment in rem). However, in most cases the earlier judgment must have been between the parties in question (judgment in personam). Thus, a fact cannot normally be treated as proved on the basis of evidence in a previous case between different parties (*Taylor's Central Garages (Exeter) Ltd v Roper* [1951] WN 385).

- 1.99 "Estoppel by deed" is, in theory, of potential relevance in entitlement cases. The basic rule is that a party who executes a deed is estopped in a court of law from saying that the facts in the deed are not truly stated. The following conditions must exist (a) there must be a distinct statement of some material particular fact; (b) a contract made with reference to such statement; and (c) an action founded upon, or brought to enforce the rights arising out of, the instrument.
- 1.100 However, the scope of estoppel by deed appears to have become extremely limited under present law, since it applies only between the parties to the deed and those claiming through them, only in actions on the deed and only to clear and unambiguous statements. Further, it does not prevent a party from pleading illegality or fraud, or availing themselves of any fact that may give rise to a right to rescind the deed in equity. Indeed, since the modern basis of the doctrine of estoppel by deed has become agreement, it is arguable whether there is any real distinction between it and estoppel by agreement (see below).
- 1.101 The third class of estoppel is "estoppel by conduct" (estoppel in pais). As again explained in Cross and in Phipson following *Pickard v Sears* [1837] 6 Ad&E 469:

Where one [party] by his words or conduct wilfully causes another [party] to believe in the existence of a certain state of things, and induces him to act on that belief, or to allow his own previous position, the former is concluded from averring against the latter a different state of things as existing at that time.

- 1.102 Estoppel by conduct is of several types as follows (not always clearly distinct):
- estoppel by agreement: where a party has made a representation by words or conduct that a certain state of facts exists, that party cannot assert to the contrary once the other party has acted upon the representation (see *Furr v CD Truline* [1985] FSR 553; see also *Brockhouse Plc v Davis*, BL 0/100/85 where the hearing officer found that there was insufficient evidence to establish estoppel)
 - estoppel by convention: this occurs where there is an agreed statement of facts the truth of which has been assumed by the parties as the basis of the transaction into which they are about to enter. Either party is estopped against the other from questioning the truth of the statement of facts so assumed
 - estoppel by representation: a party having made a representation by words or conduct about his or her future conduct, cannot assert to the contrary once the other party has acted on the representation to his own detriment (see *Hopgood v Brown* [1955] 1 All ER 550 at p 559, and also *Hartington Conway Ltd's Patent Applications* [2003] EWHC

1872 (Ch), [\[2004\] RPC 6](#) and [\[2004\] RPC 7](#) where the true owners of patent rights were estopped from asserting them)

- estoppel from silence, omission or acquiescence: when a duty to speak is owed to a person, he is entitled to assume from the silence of the party owing the duty that he is impliedly representing the non-existence of anything which would fall within the ambit of the duty. In [Dyson Ltd v Qualtex \(UK\) Ltd \[2004\] EWHC 2981 \(Ch\)](#), [\[2005\] RPC 19](#), in relation to a claim for infringement of design right, no estoppel by acquiescence of D arose in the sales of certain parts by Q: Q could not be heard to say that the silence of D amounted to knowledge and approval of the sales when Q had not told D about their plans but had merely taken the risk of them not finding out
- estoppel by negligence: this occurs when the party in whose favour it operates is the victim of the fraud of some third person facilitated by the careless breach of duty of the other party
- promissory estoppel: as stated in paragraph 1071 of volume 16 of Halsbury's Laws of England and adopted by the Patents County Court in [Hazel Grove \(Superleague\) Ltd v Euro-League Leisure Products Ltd & anr \[1995\] RPC 529](#) at 543:

Where one party has, by his words or conduct, made the other a clear and unequivocal promise or assurance which was intended to affect the legal relations between them and to be acted on accordingly, then, once the other party has taken him at his word and acted on it, the one who gave him the promise or assurance cannot afterwards be allowed to revert to their previous legal relations as if no such promise or assurance had been made by him, but he must accept their legal relations subject to the qualifications which he himself has so introduced

- quasi estoppel by common law election (estoppel by waiver): a party presented with two mutually exclusive courses of action, having made a choice, cannot change his mind once the other party has acted upon the representation to his detriment. There are two distinct types: a party can be presented with a choice of which other party to proceed against, or he can be presented with a choice of two courses of action against another party. However, in either case estoppel does not arise - ie the choice made by the first party is not irrevocable - unless the choices available are mutually exclusive and until the other party has acted upon the choice to his detriment

1.103 In the absence of binding authority or legislation, the concept of "file wrapper" or "prosecution history" estoppel does not, though, apply in the UK (see the comments of Laddie J in paragraphs 27 to 30 of [Telsonic AG's Patent \[2004\] EWHC 474 \(Ch\)](#), [\[2004\] RPC 38](#) and of Lord Hoffmann in paragraph 35 of [Kirin-Amgen Inc v Hoechst Marion Roussel Ltd \[2004\] UKHL 46](#), [\[2005\] RPC 9](#)). In other words, a patentee who used a certain

argument to persuade an examiner that the patent should be granted is not estopped from denying that argument in later proceedings, eg for revocation or a declaration of non-infringement. However, if they do so, they run a clear risk of invalidity. For example, if a patent claim had been allowed on the basis of an argument that it did not cover a certain construction that was known in the art, the patentee can still later argue that the claim does cover that equivalent, but if the argument is accepted, that will probably mean the claim is invalid for want of novelty.

Abuse of legal process by relitigation

- 1.104 In cases where one party seeks to litigate a new point against the other on the same facts as an earlier action between them, estoppel overlaps with the principle in *Henderson v Henderson* [1843] 3 Hare 100 that in the interests of finality of litigation the parties should bring forward their whole case at the outset, and that a party should not be twice vexed in the same matter. This area of the law has been clarified in *Johnson v Gore Wood & Co* [2001] 2 WLR 72, a case decided at first instance on the basis of estoppel by convention, but decided by the House of Lords on a rather wider basis of abuse. As stated by Lord Bingham:

It is however wrong to hold that because a matter could have been raised in earlier proceedings it should have been, so as to render the raising of it in later proceedings necessarily abusive. That is to adopt too dogmatic an approach to what should in my opinion be a broad, merits-based judgment which takes account of the public and private interests involved and also takes account of the facts of the case, focussing attention on the crucial question whether, in all the circumstances, a party is misusing or abusing the process of the court by seeking to raise before it the issue which could have been raised before.

It will therefore be seen that this principle is concerned, not with points that have already been decided in earlier proceedings as with estoppel by record, but with points that have not been raised earlier but which should have been. However it should not be interpreted as a presumption against the bringing of successive actions, since the burden remains on the defendant to show that there is abuse: the burden was not discharged in *Johnson v Gore Wood* in part because of the four-year delay from the launch of the later proceedings before abuse was raised. This judgment and the subsequent judgment of the Court of Appeal in [Specialist Group International Ltd v Deakin and another](#) [2001] EWCA Civ 777 contain a full discussion of relevant case law. Where the parties in successive actions are not identical it will be necessary to consider whether there is sufficient identity between them to justify one being bound by the earlier decision against the other (see *Gleeson v J Wippell & Co Ltd* [1977] 1 WLR 510, 515).

- 1.105 The principle in *Johnson v Gore Wood* may come into play where a claimant has available a variety of intellectual property and possibly other rights, but does not pursue them all at the outset. Examples of such cases are: [Nikken](#)

[Koshakuko Works v Pioneer Trading Co \[2005\] EWCA Civ 906](#), [2006] FSR 4 and [Secretary of State for Education and Skills v Frontline Technology Ltd \[2005\] EWHC 37 \(Pat\)](#), where in each case a patent was held invalid but the proprietor was not allowed after judgment to submit amendments which would introduce a claim different from any that had been under attack at the trial, because they would involve a further trial on validity, however small (see MoPP 72.43 concerning amendment in proceedings before the comptroller for revocation of a patent); [Hormel Foods Corporation v Antilles Landscape Investments \[2005\] EWHC 13 \(Ch\)](#), [\[2005\] RPC 28](#), where the claimant, having unsuccessfully attacked the validity of a trade mark before the registrar, was barred by cause of action estoppel from attacking validity on the same or different grounds before the court and by the [Johnson v Gore Wood](#) principle from claiming for revocation of the mark; [Building Product Design Ltd v Sandtoft Roof Tiles Ltd \(No 2\) \[2004\] FSR 41](#) in the Patents County Court, where the bringing of a second action for infringement by a different product from that in the first action was held to be an abuse of process and not a mere procedural inconvenience to the defendant.

Nikken makes the point that patent litigation is no different from any other as regards the amendment of a case after judgment. Further, as explained by Laws LJ in Nikken, the general principle of [Henderson v Henderson](#) is "clothed with new vigour by the overriding objective of the CPR, that in any given litigation the parties are required to bring forward their whole case".

- 1.106 The principle in [Johnson v Gore Wood](#) does not go as far as establishing a general rule that estoppel by record should only be allowed in order to prevent abuse of process. In [Coflexip SA v Stolt Offshore MS Ltd \(No 2\) EWCA Civ 213](#), [2004] FSR 34, the Court of Appeal held that [Poulton v Adjustable Cover & Boiler Block Co \(1908\) 25 RPC 529](#) (see above) had not been impliedly overruled: thus on similar facts to [Poulton](#), the defendants were bound by cause of action estoppel from asserting the invalidity of the patent.

INTER PARTES PROCEDURES

Last major update: July 2009

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CONDUCT OF PROCEEDINGS

2.00.1 Cases are managed actively in accordance with the "overriding objective" set out in [rule 74](#) of the Patents Rules 2007 (based on the equivalent provision in the Civil Procedure Rules), which provides for the comptroller to deal with cases justly. This includes, so far as is practicable:

1. ensuring that the parties are on an equal footing;
2. saving expense;
3. dealing with the case in ways which are proportionate-
 1. to the amount of money involved;
 2. to the importance of the case;
 3. to the complexity of the issues; and
 4. to the financial position of each party;
4. ensuring that it is dealt with expeditiously and fairly; and
5. allotting to it an appropriate share of the resources available to the comptroller, while taking into account the need to allot resources to other cases.

Guidance on the management of cases in accordance with the overriding objective has accumulated in a succession of Tribunal Practice Notices; [TPN 1/2000](#) following the Woolf reforms on the administration of justice, [TPN 6/2007](#) following the Patents Rules 2007 and [TPN 3/2009](#) following a review of the comptroller's patent tribunal function.

2.00.2 Rule 74(3) requires the comptroller to seek to give effect to the overriding objective when he exercises any power or interprets any rule, whilst rule 74(4) requires the parties to help the comptroller further the overriding objective. In a case under the equivalent provisions of the Civil Procedure Rules; - see [Tasyurdu v Home Secretary \[2003\] EWCA Civ 447](#), [2003] CP Rep 61, it was held that this includes the effective use of judicial time and that the court should be informed at the earliest opportunity if proceedings are to be withdrawn or if withdrawal is contemplated. Also for example, by virtue of Rule 74(4) a party should not conduct its case in a way that is obstructive, nor should a professional representative on one side take unfair advantage of the fact that the other side may be unrepresented

2.00.3 In every case, after the counter-statement has been received in the Office, the hearing officer reviews the case to assess how it can best be resolved in a cost effective manner and without undue delay. As set out in [TPN 3/2009](#), The hearing officer will consider whether Alternative Dispute Resolution is possible, in which case the parties will be encouraged to try ADR alongside the initial stages of the litigation process. He or she will also consider whether to issue a Preliminary Evaluation and if so at which stage of the proceedings, for example whether before or after the evidence rounds. The hearing officer will also consider whether the evidence rounds should be sequential or simultaneous. If the case is complex, he or she will consider whether a Case Management Conference is required. The Office aims to complete inter partes proceedings within 12 months of the filing of the counter-statement to ensure timely resolution of actions and to minimise cost. Normally a single hearing

officer will manage and hear the case throughout. Parties will consequently be invited at this stage to set a date for the hearing no later than 9 months ahead. Once set it is not intended that hearings dates will be vacated. Parties are expected to cooperate in resolving preliminary matters and keeping to timetables.

ALTERNATIVE DISPUTE RESOLUTION

2.01 Judicial proceedings between parties should be regarded as a last resort. It is always better for both sides if parties can resolve their differences by negotiation rather than resorting to the law. Alternative Dispute Resolution may provide the best opportunity for resolving the issues quickly, less expensively and with an increased chance of an amicable settlement. This may particularly be the case with rights such as entitlement or licences, but ADR is increasingly seen as a possible route in revocation cases and other proceedings in which validity is an issue. Consequently hearing officers consider whether settlement by ADR is a possibility in all proceedings and actively encourage the parties to consider this option in appropriate cases. If an application for revocation is withdrawn following ADR, the public interest is nevertheless safeguarded since the hearing officer, in accordance with current practice, comes to a view on the validity of the patent on the basis of the submissions before him. Where ADR seems appropriate, the parties are required to state whether they have already tried ADR; if not whether they are prepared to do so, and if they are not prepared to do so, to explain the reasons why. ADR can be based on negotiation (eg mediation, conciliation) or can involve a form of adjudication or assessment (eg expert determination or early neutral evaluation). The Office provides ADR services; details of which can be found on our website under "[Mediation](#)".

2.01.1 Where the parties agree to try ADR, the Office will require them to set dates for mediation activities and to keep Litigation Section informed of progress with those activities. It is expected that a period of two months will normally be sufficient for ADR at the initial stage. The Office will continue with the timetable for the litigation proceedings alongside any ADR activity and will not normally delay proceedings of its own motion, but will consider doing so if the parties so request.

2.02 ADR should not be imposed against the will of one or both parties. In [Halsey v Milton Keynes General NHS Trust \[2004\] EWCA Civ 576](#), [2004] 1 WLR 3002, Dyson LJ said that even if such a course of action was not a violation of the right to a fair trial required by Article 6 of the European Convention on Human Rights (see [Chapter 1](#)), it was difficult to conceive of circumstances where it would be appropriate. This was followed by the comptroller in [Secretary of State v Farrow System Ltd BL O/008/05](#) (an application for revocation).

PRELIMINARY EVALUATION

2.02.1 Preliminary Evaluations (PEs) are issued in most inter partes patent proceedings before the comptroller. An exception may be where an opinion under section 74A has already been obtained by one of the parties

addressing the issues in question. PEs are not binding on the hearing officer. His or her decision on the matters in question is not finalised until all procedures are completed and all representations have been made. In accordance with the rules of natural justice, the hearing officer must ensure he or she does not prejudge any issue in the PE. The aim of the PE is to focus the parties' minds on the key issues by exposing the strength or otherwise of their cases and so lead to more efficient conduct of the proceedings including the hearing. This may be achieved in some cases simply by highlighting questions the hearing officer considers important. In other instances the evaluation may go further and indicate the hearing officer's provisional view of the matters to be decided. PEs are generally briefer and less fully reasoned than the Office's section 74A opinions. They do not constitute decisions and are consequently not appealable. Where validity is in issue, PEs usually highlight the need for the patentee to identify claims alleged to have independent validity. They may also sideline prior art that has no real relevance to the matter to be decided. In other disputes which rely heavily on evidence, a PE may enable the hearing officer to give guidance on the issues which need to be proved and so avoid the filing of unnecessary evidence. In each case, the PE highlights the key issues to be considered.

2.02.2 The hearing officer decides whether and when to issue the PE. This will often be directly after the pleadings stage where it is thought beneficial to influence the filing of evidence, or alternatively after the evidence rounds, or at another time during the proceedings. He or she will consider at which point it is most likely to result in focusing the issues and reducing unnecessary work for the parties. PEs have little or no purpose if the parties ignore them. Therefore, parties are made aware that when awarding costs the hearing officer will consider whether a party has acted unreasonably in the light of the PE by, for example, pursuing aspects of a case which have been notified in the PE as irrelevant to the final outcome. If in the event it transpires that they were indeed irrelevant, such unreasonable behaviour could attract off-scale costs.

CASE MANAGEMENT CONFERENCE

2.02.3 Where the case is complex, or the issues do not appear to be clear cut, or in other situations where it is appropriate, the hearing officer will arrange a case management conference to determine how events should proceed. The hearing officer's directions for conduct of the proceedings will depend on the particular circumstances, but the usual intention at a case management conference will be to clarify the issues in dispute, to set the timetable for evidence rounds, to identify the issues on which the hearing officer requires evidence, the nature of that evidence and how it should be placed before him, and to set the date for the hearing.

2.02.4 The hearing officer will arrange for case management conferences to be conducted in person, or by video conference or telephone at his discretion and, if appropriate, in consultation with the parties. The parties' legal representatives will normally be expected to attend, but not the parties themselves unless they wish to do so.

ROLE OF LITIGATION SECTION

- 2.03 If inter partes proceedings go ahead, they are initially dealt with by a case officer in Litigation Section (see the [Litigation Manual](#) for details of procedures). The case officer is responsible for issuing communications from the hearing officer to the parties, advising the parties of the periods for filing their statements of case, evidence, responses to correspondence etc and drawing any procedural irregularities to their attention. When difficulties arise the case officer will normally discuss them with the hearing officer to decide the best way to proceed. The hearing officer should never have any direct contact with the parties, whether orally or in writing, save at a formal hearing, a case management conference or a pre-hearing review, to avoid any possible perception of bias. Further, when advising the case officer how best to proceed, the hearing officer should take care not to prejudge any issue on which one or other party may later wish to be heard.
- 2.04 Litigation Section is also responsible for making all the arrangements for hearings. This, and the appointment of the hearing officer and any assistant or observer, is dealt with in [Chapter 4](#).
- 2.05 [Transferred to 2.00.1]
- 2.06 [Transferred to 2.00.2]
- 2.07 [Deleted]
- 2.08 [Deleted]

RIGHT TO BE HEARD

- 2.09 A party has a right to an opportunity of being heard by the comptroller "before exercising adversely to that party any discretion vested in the comptroller". This is spelt out expressly for patents in [section 101](#) of the Patents Act 1977. It is not spelt out expressly in the primary legislation in respect of design right proceedings, but a right to a hearing is provided in [rule 5 of the Design Right \(Proceedings before Comptroller\) Rules 1989](#). In any case, the principle applies because it is a fundamental principle of natural justice (see [Chapter 1](#)). However, a "conditional" request, for a hearing to be held only if the hearing officer is minded to find against the requester, does not square with the need for the hearing officer to be seen as impartial, and should not therefore be entertained.
- 2.10 It is important to remember that this principle applies not just to the substantive decision but to every formal decision or informal ruling about procedure made along the way. Thus before exercising any of the powers discussed in this chapter, the hearing officer must make sure that Litigation Section have given the parties the opportunity to make submissions and that they have been asked specifically whether they want an oral hearing on the matter.

- 2.11 The parties need to be given reasonable notice of any hearing. For patent hearings, [rule 80\(5\)](#) of the Patents Rules 2007 provides for the comptroller to give "the parties notice of a date for the hearing". In practice, wherever possible, a timetable for the evidence rounds and the date for the hearing will be set after the pleadings have been filed so that the parties will have ample notice. Where time is tight, for example for urgent preliminary hearings, a period of notice of 14 days will normally be given. Rule 5(3) of the Design Right (Proceedings before Comptroller) Rules 1989 provides for a notice period of at least 14 days which can be reduced by agreement between the parties and the comptroller. Where it is helpful to the parties, hearing officers can be flexible about starting times so that urgent short hearings can be held in the afternoon.
- 2.12 Whilst the Office always tries to cooperate with the parties in setting a date, it is an important aspect of the overriding objective to deal with cases expeditiously. The hearing officer needs to be alert to parties who try to drag the proceedings out by demanding hearings on minor issues, requesting extensions of time and delaying complying with the timetable for the proceedings. The hearing officer should not hesitate to take a firm line and ensure the proceedings are kept on track.

PRIVATE LITIGANTS ("Litigants in person")

- 2.13 Litigants who do not employ the services of a legally-qualified representative may have special needs because of their unfamiliarity, not merely with the processes of litigation, but the very basis on which it is conducted. The comptroller can and should be as helpful as reasonably possible when acting in an administrative capacity where only one party is involved. However the position is rather different when the comptroller is hearing a dispute between two parties.
- 2.14 The comptroller must deal with all cases justly, which includes ensuring the parties are on an equal footing. If a private litigant loses out, not because their underlying case is poor, but simply because they didn't understand what they had to do, it is arguable that justice has not been done. This puts an obligation on the comptroller to explain to the private litigant what they have to do, and to tell them when they do something wrong.
- 2.15 However, there is another side to the coin. Helping the private litigant may be harming the other party's case and/or giving the impression that the comptroller is not adopting an unbiased approach to the dispute. This puts significant constraints on how far the comptroller may go, and a careful balance must be struck.
- 2.16 In an unreported decision dated 6 December 1999 in a case under the Trade Marks Act 1994 involving a private litigant, Trocadero Plc v Gracey O/440/99, Simon Thorley QC, acting as the "Appointed Person" made some helpful comments in this respect:

Accordingly, in relation to opposition and revocation proceedings, the Registrar's officers cease to perform an administrative function and act solely in a judicial (or quasi-judicial) capacity. The distinction is I believe an important one, particularly in the circumstances of the present case. When acting in an administrative capacity, the Registrar has to enter the debate with the applicant, has to reason with him and necessarily will engage in correspondence or in conversations with the applicant in order to seek to resolve any matters arising. . . . Once the Registrar begins to perform his judicial function, the position is different. The Registrar or his officer is acting as a judge. The proceedings are adversarial, the issues are circumscribed by the pleadings and the parties are free to adduce the evidence and arguments that they wish. It is the Registrar's duty to adjudicate upon the issue raised. It is not his duty and, indeed, it would be wrong for him, when exercising this function, to enter into a debate with either party as to the validity or otherwise of the contentions put forward on any of the issues raised in the proceedings. "Any of the issues", of course, does not just mean the substantive issues but would include procedural ones.

2.17 Later in the decision, Mr Thorley said:

. . . whilst I commend the Trade Mark Registry for their courtesy, patience and helpfulness, I do not believe they should have entered the debate with Mr Gracey in the way they did. If a party to an opposition or revocation proceedings wishes to raise an issue in those proceedings, the issue should be clearly formulated, either in the Statement of Grounds or the Counter-Statement or in a subsequent formal application so that the other party may have an opportunity to comment upon that issue, again by way of formal statement, and both parties can have an opportunity to file any necessary evidence. Once this is done the Registry can rule (following a hearing if necessary) whether the issue should be determined as a preliminary issue or whether it should stand over to be determined at the substantive hearing.

2.18 Thus whilst we should always be helpful, courteous and patient and should recognise that a private litigant's need for assistance may be greater than that of a represented litigant, there are proper limits to the allowances that should be made. The interests of justice may not be served by going beyond them.

Pro bono schemes

2.18.1 Hearing officers should always consider whether it might be appropriate to refer an unrepresented litigant to one of the pro bono schemes operated by the Chartered Institute of Patent Attorneys ([CIPA](#)), the Bar Pro Bono Unit and the Solicitors Pro Bono Group. It will be unlikely to be appropriate, for example, if the litigant has the resources to employ legal assistance but has simply chosen not to do so, or if the litigant is pursuing a manifestly hopeless case. The impact on the other party also needs to be considered - if one side has struggled to pay for legal help, they may not be pleased if their wealthier opponent then gets help provided free.

2.18.2 The CIPA scheme will only consider parties referred by the comptroller - a party cannot apply directly. However, a hearing officer should get the agreement of the party before making a reference. CIPA will then send the party an application form on which they must give details of the case, their finances and any other assistance they have sought. If the application is accepted, the party will then be allocated a CIPA member from the list of those willing to provide pro bono services. Details of the Bar and solicitors schemes can be found at <http://www.barprobono.org.uk/> and <http://www.lawworks.org.uk/> respectively.

LAYOUT OF DOCUMENTS

2.19 The courts expect statements of case, evidence and other documents to adhere to prescribed layouts. These layouts are quite helpful, so parties who are used to court proceedings will often also use them for proceedings before the comptroller. However, it is not essential to do so - so long as the reader can easily identify what the document is and find their way around it.

2.20 Whatever layout is used, all documents should include a heading identifying (a) the parties, (b) the nature of the proceedings and (c) the identity of the document. There are examples of how this can be achieved in the [Annex](#) to this Chapter. Further, paragraphs should be numbered to make it easier to refer to them later. In a long document, it can also be helpful to include subheadings.

STATEMENTS OF CASE

2.21 To initiate inter partes proceedings the claimant files a form under [rule 76](#) relating to the relevant section of the Act, or [rule 98](#) for a Review of an Opinion. In most instances this has to be accompanied by a statement of grounds (in duplicate see rule 76(1)) setting out:

- - the facts and grounds on which he relies, and
- - the remedy which he seeks.

The statement should comply with the specific requirements prescribed by rule 76(4). It must also be verified by a statement of truth. The comptroller notifies interested parties and the defendant must, if it wishes to contest the proceedings, respond by filing a counter-statement. Together these two statements of case should identify the substantive issues to be determined.

2.22 Exceptionally, in design right proceedings, the claimant responds to the defendant's statement with another statement, so there are then three statements in all - see rule 3 of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#). The conduct of Reviews of Opinions is set out in [Part 8 of the Patents Rules 2007](#) and follows its own course tailored to their particular requirements.

2.23 [Deleted]

The statement of grounds

- 2.24 The matter in issue is sometimes implicit in the remedy sought, for example where a licence is required or a declaration of non-infringement is sought. However, in most proceedings the matter in issue needs to be set out explicitly. For example, for a claim to entitlement to a patent application, the statement of grounds should set out who the claimant believes to be entitled, why he believes that to be the case, and the facts that he considers support that view. Similarly, for revocation of a patent, the statement should specify why the patent is considered to be invalid, and the prior art or other factual information relied on.
- 2.25 The facts to be relied on must be set out in reasonable detail. There is a balance here. The statement of grounds is not the place for putting forward all the evidence that the claimant intends to rely on, but it must explain the claimant's case sufficiently for the defendant to be able to respond to it fully. Care should be taken to ensure there are no gaps, such that the case put forward does not necessarily lead to the conclusion asserted.
- 2.26 The remedy sought must also be set out clearly. It should be consistent with the provisions of the relevant section of the legislation, as there is no point in claiming relief which the comptroller has no power to grant. If a party wishes to claim costs, it will have to do so at some point in the proceedings. They need not be specifically claimed in the statement, though they usually are.
- 2.27 It is not normally necessary to include detailed arguments in a statement of grounds. However, arguments should be included if, without them, the case would not be clear. This could happen if, for example, the claimant is relying on a particular interpretation of a claim, or on some interpretation of the law or case law that is not self evident.
- 2.28 Claimants sometimes think they can frighten their opponents by adding to their main case a whole host of other issues on which they would not really expect to win. This is rarely a good strategy. Running a long list of hopeless points will not endear the claimant to the hearing officer, will result in a Preliminary Evaluation sidelining them and if pursued may lead to an adverse costs award.
- 2.29 Sometimes the claimant may be in doubt as to the person from whom he/she is entitled to redress (eg in proceedings under [section 40](#) of the Patents Act 1977 where it may not be clear which company in a group of companies was legally the employer). In that case, it may make its claim against more than one defendant severally or in the alternative.
- 2.30 In the High Court it is usual for a general allegation in a statement of claim to be followed by a subsection headed "Particulars of [the allegation]" which then gives more details. It is not essential to use this layout in proceedings before the comptroller.

The counter-statement

- 2.31 A person who wishes to oppose or object to any part of the claimant's claim must file a counter-statement (in duplicate - see [rule 77\(6\)](#)) setting out the grounds of opposition or objection. If no counter-statement is filed, the claim will be treated as uncontested. If there is any doubt about whether or not the claim is being opposed, Litigation Section will query the position.
- 2.32 The basic purpose of the counter-statement is to narrow down the field of dispute, because the claimant will not need to prove any allegations which the defendant admits. If a counter-statement leaves uncertainty about what is and is not in dispute, it is inadequate (see from 2.36 below). Thus, in line with [rule 78](#) of the Patents Rules 2007, the defendant must state:
- - which of the allegations in the statement he denies;
 - - which of the allegations in the statement he is unable to admit or deny but which he requires the claimant to prove;
 - - which of the allegations in the statement he admits.

Or he may instead set out his own case in relation to each allegation. Again, costs need not be specifically claimed, though they usually are.

- 2.33 A counter-statement may work systematically through the statement responding on a point by point basis. Alternatively, it may respond to the claimant's story in a more general way by reciting its own story. Both approaches are perfectly permissible, and the defendant should use whichever one seems most appropriate in the circumstances. In practice most good counter-statements will use a mixture of both.
- 2.34 Any allegation made by the claimant which the defendant does not deal with in his counter-statement - either explicitly, or implicitly by giving an alternative version of events - is deemed to be admitted by the defendant as provided by [rule 78\(3\)](#). Whilst the claimant will not need to prove any allegations which the defendant admits, the claimant will need to prove allegations which are either denied or not admitted by the defendant.
- 2.35 Counterclaims rarely arise in proceedings before the comptroller, and so there is no formal procedure for dealing with them. Should a defendant wish to make a counterclaim, it should be included in the counter-statement. Whether the claimant needs to reply formally confirming that it resists the counterclaim will depend on the circumstances, though if the counterclaim raises new issues, the claimant must be given the chance to respond to them.

Adequacy of statements of case

- 2.36 Each party must set out (or "plead") in its statement of case all the matters on which it wishes to rely. If it only pleads some of them, it cannot come back after the comptroller has made a decision on the basis of those matters and try and raise other matters (cf *Chiron Corporation v Murex Diagnostics Limited* (No 9) [1995] FSR 318). Likewise (and subject to the comments below on

amendment of statements) it cannot normally introduce at the hearing matters not included in the statements of case - it is not sufficient to point during the hearing to passages in the evidence which foreshadow such matters (see *Roussel-Uclaf (Joly and Warmant's) Patent [1971] RPC 304*).

- 2.37 It also follows that it is not normally open to the hearing officer to consider of his or her own motion any issue which is not included in the statements of case, eg a further ground for revocation, but see the comments of Hoffmann LJ in [Yeda Research and Development Company Limited v Rhone-Poulenc Rorer International Holdings Inc and others \[2007\] UKHL 43](#) reported in 1.24.1 above, finding that a hearing officer has wide discretion in entitlement cases to consider what is fair and just in the circumstances and to make an order reflecting the relative contribution of the parties, notwithstanding the scope of the pleadings.
- 2.38 Whilst in the past statements of case filed in proceedings before the comptroller have sometimes been very sketchy and lacking in real detail as to the facts, they are now expected to be reasonably detailed. This was reinforced by the Vice Chancellor, Sir Richard Scott in [Julian Higgins' Trade Mark Application \[2000\] RPC 321](#) at p326:

Part of the problem, in my view, is the procedural practice that seems to have grown up in the past - although I am very relieved to hear from counsel that it is in the process of being, if it has not already been, cured - of not preparing proper pleadings with proper particulars of the parties' contentions. If the pleadings do not identify the right issues, the issues the parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing. The pleadings are supposed to identify the issues to which evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise.

- 2.39 Again, as Geoffrey Hobbs QC later said in [Demon Ale Trade Mark \[2000\] RPC 345](#) at p357:

Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focused statement of the grounds upon which they intend to maintain that the tribunal should or should not do what it has been asked to do. The statement should not be prolix. It should, however, be full in the sense indicated by Mr Simon Thorley QC in [COFFEEMIX Trade Mark \[1998\] RPC 717](#) at p722: "It must be full in the sense that it must outline each of the grounds . . . relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible, but it must be complete.

AMENDMENT OF STATEMENTS OF CASE

- 2.40 Once the counter-statement in reply has been filed, both parties should be clear about what issues of fact and law are in dispute. They then address disputed issues of fact by filing appropriate evidence and address disputed

issues of law by argument at the hearing. Sometimes, the counter-statement and/or the evidence highlight further issues that the claimant may want to address, or points that one side no longer wishes to pursue. This is to be avoided if possible by the parties assessing carefully how their case should be made and the evidence needed to support it. However, when it happens, a party may seek the comptroller's discretion to amend its statement. This can extend exceptionally to a defendant withdrawing admissions, see *White v Greensand Homes Ltd and Another*, *The Times* 19 July 2007. An amendment may also be requested to remedy defects or to add, delete or substitute a party.

- 2.41 In *Cobbold v London Borough of Greenwich* (Court of Appeal, 9 August 1999, unreported) Peter Gibson L J considered the approach that should be adopted under the Civil Procedure Rules 1998 to requests to amend (see paragraph 17.3.5 of "Civil Procedure"):

The overriding objective is that the court should deal with cases justly. That includes, so far as practicable, ensuring that each case is dealt with not only expeditiously but also fairly. Amendments in general ought to be allowed so that the real dispute between the parties can be adjudicated upon provided that any prejudice to the other party or parties caused by the amendment can be compensated for in costs, and the public interest in the efficient administration of justice is not significantly harmed.

However, as was explained in *EDO Technology Ltd v Campaign to Smash EDO*, *The Times*, 24 May 2006, there is no general presumption in favour of permission to amend, and whether the amendment is likely to delay trial is a factor which should be considered. In Office proceedings it is not expected that the hearing date will be postponed and parties will need to factor that into their timetables.

- 2.42 Against this background, there are a number of considerations to bear in mind:

- - A party should make any significant changes to its case clear at the earliest opportunity. The other side must have a proper chance to deal with every issue (including if necessary filing evidence), and so a party that tries to spring last minute surprises should not be allowed to get away with it.
- - Likewise a party should make clear at the earliest opportunity if it is abandoning any aspects of its case, so the other side does not waste time dealing with it. Failure to do so may lead to the party being penalised in costs.
- - Each party is expected to do its best to put its whole case forward at the outset. A party that deliberately or through incompetence fails to do so can expect later requests to amend its statement to receive less sympathetic treatment.

- 2.43 Unless it is clearly non-contentious, any proposed amendment is referred to a hearing officer to decide whether to allow it. In considering such requests, the hearing officer should take account of the above considerations, and also:
- - any objections or comments by the other party or parties
 - - the diligence of the party concerned in preparing its case
 - - Whether any ensuing delay is unjust to the other party or against the public interest.

To assess the diligence of a party, the hearing officer may demand evidence to show that they could not with reasonable diligence have discovered any new facts earlier or to explain the lateness of the amendment.

- 2.44 Sometimes a defect becomes apparent from the preliminary scrutiny of the statement of case by the Office. When this happens, Litigation Section may bring it to the attention of the party concerned, and extend the period for the other side to file their counter-statement or evidence so that it does not start until the defect has been addressed.
- 2.45 An amendment can be in the form of either a replacement statement or a supplementary statement. If the amendment is permitted, it will often be necessary to give the other party an opportunity to amend its statement and/or file further evidence to deal with the amendment.
- 2.46 It is not always necessary to make a formal amendment to the statement, particularly if the change is one that can be explained clearly and simply in a letter. A pragmatic approach can be adopted. The main consideration is to ensure that all parties and the hearing officer are left in no doubt about what is and is not now in issue.
- 2.47 Occasionally, a party will try to introduce a new issue (eg prior use of an invention) based on fresh evidence at the hearing itself. This is permissible only if it is of overriding importance and could not have been obtained by reasonable diligence beforehand (*Parmeter v Malthouse Joinery* [1993] FSR 68), and the other party must be given an adequate opportunity to consider the matter and to adduce evidence if they so wish. Where that is possible without adjourning or with a short adjournment, so that the hearing date is not lost, the hearing officer should consider allowing amendment on the *Parmeter* criteria. Where the hearing date would be lost, the new ground should not normally be admitted.

Adding, deleting or substituting parties

- 2.48 A request to substitute one party for another (eg because a patent in dispute has changed hands, or one company has acquired the interests of another) should generally be allowed unless there are objections from another party. If there are objections, the hearing officer will need to hear both sides before deciding whether to allow the request.

- 2.49 It is generally allowable to add claimants or defendants. However, no one should be added as a claimant without their consent (cf [rule 19.3\(2\) of the Civil Procedure Rules 1998](#)). Any new party must be given an opportunity to participate fully in the proceedings. In particular, any new defendant must be given an adequate period in which to file a counter-statement.
- 2.50 The comptroller has the power to order that someone should cease to be a party, though this is not very common. It could be necessary, for example, if a defendant satisfies the comptroller that one of several claimants has no cause of action, or that one of several defendants was joined improperly (eg merely for the purpose of disclosure). Exceptionally, under rule 8 of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#), a party to proceedings about subsistence, term or ownership of design right has the right to withdraw from the proceedings at any time before the comptroller's decision by serving a notice to that effect on the comptroller and every other party to the proceedings.

REFERENCE DOCUMENTS

- 2.51 For patent hearings, any document (other than those published by or kept at the Office) which is referred to in a statement, counter-statement or evidence, should be supplied to the Office, in duplicate if appropriate, in accordance with [rule 79](#) of the Patents Rules 2007. In the case of design right, each party is required to serve the documents "relevant to his case" - see rule 3 of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#).
- 2.52 If in design right proceedings, a party intends to refer at the hearing to any document not already referred to in the proceedings, that party should in accordance with rule 5(4) of the Design Right (Proceedings before Comptroller) Rules 1989 give at least 14 days' notice of its intention to the other party or parties and to the comptroller, unless they agree to a shorter period, together with particulars of the document. A copy of the document should be required if one is not readily available.

REQUESTING FURTHER INFORMATION

- 2.53 If a party feels it needs further information from the other side, eg to clarify some aspect of the statement of case, it should approach the other party direct. That party is expected to cooperate, assuming the request is reasonable. Guidance on what can be regarded as reasonable can be found in [paragraph 1.2 of the Practice Direction to Part 18](#) of the Civil Procedure Rules 1998:

A Request should be concise and strictly confined to matters which are reasonably necessary and proportionate to enable the first party to prepare his own case or to understand the case he has to met.

In practice, with the fuller pleadings expected in modern practice, requests for further information are much less common than they once were.

- 2.54 If the parties cannot agree over a request for further information, they can come to the comptroller, who has the power under [rule 82](#) of the Patents Rules 2007 and rule 5(5) of the Design Right (Proceedings before Comptroller) Rules 1989 to direct that one or other party furnishes further documents, information or evidence. This power may be exercised at any stage in the proceedings.

EXTENSIONS OF TIME

- 2.55 The period provided for filing the counter-statement, and the timetable set for the filing of evidence are expected to provide sufficient time for the parties to complete the required actions. In particular, the timetable for the evidence rounds will be known from the outset, and the parties are expected to be diligent in adhering to it in order that the hearing can take place on the appointed date. There is consequently a presumption against extending deadlines. Nevertheless (apart from the periods in relation to oppositions prescribed in [rules 76 \(2\)\(b\) , 77\(7\) and 77\(10\)](#)), there is provision for them to be extended, retrospectively if necessary, under [rule 81](#) of the Patents Rules 2007. In considering any request for an extension of time that does arise, the hearing officer will apply the general principles and the case law underlying the exercise of discretion explained in [Chapter 1](#) and will seek to keep delay to a minimum. It is not expected that any delay of the hearing itself would be allowed.
- 2.56 Accordingly, a party requesting an extension must keep their request to the minimum necessary to deal with the difficulty that has given rise to it, and must provide a clear and convincing explanation of the steps that they have taken to meet the original deadline, and the nature of the difficulty.
- 2.57 The effect of any extension of time on the other party must be considered as one of the factors in the exercise of the comptroller's discretion. To this end, Litigation Section automatically canvasses the view of the other party either in writing or by telephone, before a decision on whether or not to allow the extension is made. Where an extension of time is allowed, Litigation Section or the hearing officer will consider the effect on the timetable as a whole and if appropriate make any changes necessary so as not to disadvantage the other side.
- 2.58 [Deleted]
- 2.59 [Deleted]
- 2.60 [Deleted]

CLARIFYING ISSUES AND RESOLVING PRELIMINARY DISPUTES

- 2.61 Before the substantive hearing can take place, it sometimes happens that uncertainties and disputes arise as to the issues to be decided and the conduct of the proceedings. The Preliminary Evaluation is intended to resolve

many of these issues. Where matters remain outstanding, the following courses of action are open to the hearing officer:

- - In addition to the case management conference that may be conducted at the outset for certain cases, a conference may be held at any stage of any proceedings under [rule 82\(1\)\(i\)](#) of the Patents Rules 2007, at which the hearing officer may give directions as to the management of the case. It is for the hearing officer to decide whether to do so, taking into account any difficulties the proceedings have encountered, the need to clarify the issues, the complexity of the case, any related proceedings and any wider public-interest issues.
- - A pre-hearing review may alternatively be called under the same rule, at which the hearing officer may give directions as to the management of the hearing if he or she considers it appropriate. Such a review provides an opportunity to, eg, help the parties focus on matters of most relevance, issue directions on the conduct of or the programme for the hearing, agree the attendance of witnesses, establish whether an interpreter will be needed, or remind the parties to supply skeleton arguments. Pre-hearing reviews are only likely to be needed in exceptionally complex cases - the Chancery Division, for example, only calls a pre-trial review if the case is expected to last more than 10 days or if there are other special circumstances.
- - A preliminary hearing may be appointed to determine a procedural matter, either at the request of a party or at the suggestion of the Office with the agreement of the hearing officer. If it appears more convenient for a preliminary matter in dispute to be decided at the substantive hearing rather than at a preliminary hearing (eg because it does not affect the evidence stages or it involves consideration of substantive matters), this should be suggested to the parties. The same applies if it appears that the matters in dispute would be better dealt with in the less-formal atmosphere of a case management conference or pre-hearing review. However, where a party maintains his or her request for a preliminary hearing, this should only be refused on the direction of the hearing officer, after giving the parties the opportunity to make submissions.
- - A questionnaire may be issued to each party prior to the evidence rounds (by analogy with [rule 26.3 of the Civil Procedure Rules](#) and [Form N150](#)). However, to date it has never proved necessary to issue a questionnaire.
- - In addition to the use of Alternative Dispute Resolution for settlement of the dispute at the outset, as discussed in 2.01-2.02 above, the hearing officer will keep the possibility of ADR under review during proceedings. If it seems appropriate, for example after the evidence rounds or even after preparation for litigation, when the issues have been clarified and the parties may be better positioned to undertake ADR, the hearing officer will provide strong encouragement to the parties, for example by specifying the issues in the case that suit it to mediation and allowing a short period for ADR immediately before the date fixed for the hearing, failing which the hearing will go ahead.

(Rule 4 of the [Design Right \(Proceedings before Comptroller\) 1989, as amended 1999](#), makes provision for case management conferences and pre-hearing reviews in respect of design right proceedings.)

- 2.62 Matters in issue at the preliminary stages are often not set out in the pleadings but arise from the correspondence, eg requests for extension of time, amendment of pleadings, admission of further evidence, disclosure, privilege or confidentiality. Where a conference, review or preliminary hearing is to be appointed, or a procedural matter is to be determined at the substantive hearing, the hearing officer should therefore ensure that the issues are clearly defined and that it is clear to the parties what documents if any they need to provide. The parties should also make clear any order or direction that they are seeking. If necessary, the hearing officer should instruct Litigation Section to write to the parties to clarify these matters. It is always open to a party subsequently to ask for other issues to be considered, but this should be done before the conference, review or hearing so that the other side and the hearing officer have advance warning.
- 2.63 Because a case management conference will only be called to deal with pre-identified issues, the parties do not have to provide a case management information sheet, case memorandum or list of issues, as would be necessary in the Patents Court (see [Practice Direction 63](#)). The Office does not normally require a case management bundle either.
- 2.64 Under [rule 80\(5\)](#) of the Patents Rules 2007, the comptroller must give notice of the date of the case management or pre-hearing review where parties are to be heard. There is no specific provision for notice in respect of conferences or reviews in design right proceedings, but the comptroller may give such directions as he considers appropriate; (rule 4 of the Design Right (Proceedings before Comptroller) Rules 1989, as amended 1999). See [Chapter 4](#) for further information concerning the appointment of preliminary hearings.
- 2.65 A conference or review will usually be conducted using a telephone or video conferencing link, subject to the consent of the parties. If the parties are legally represented, it will be sufficient for the legal representatives to attend the conference, though the parties themselves may attend if they wish. Preliminary hearings will also be conducted in this way where possible; however, where the issues are complex or contentious, it may be preferable to hold a hearing in person.
- 2.66 The resolution of preliminary matters will usually require some sort of order from the hearing officer. Where it is not based on the mutual consent of the parties, any such order, whether oral or written, constitutes a decision on procedure which is appealable like any other decision of the comptroller. The procedure for giving decisions and orders is explained in [Chapter 5](#).

CONSOLIDATION OF RELATED PROCEEDINGS

- 2.67 It is permissible to consolidate related proceedings so that they run as a single action, with common evidence rounds and a common hearing. Consolidation is normally recommended to the parties in appropriate cases by Litigation Section and is rarely contested. It can save costs and/or time, but more importantly, can avoid putting the comptroller into the position of having to decide what is essentially the same issue in two separate proceedings, possibly on the basis of different evidence and arguments.
- 2.68 If consolidation is contested, the hearing officer will need to decide the matter, taking all the circumstances into account. In [Cerise Innovation Technology Ltd v Melih Abdulhayoglu and Comodo Technology Development Ltd, BL O/355/99](#), the hearing officer took account of the extent to which the issues were the same and the evidence was likely to be the same. He did not rule out consolidation merely because the defendants in the two cases were different.

STRIKING OUT; SUMMARY JUDGMENT

- 2.69 A party may apply to the comptroller to have another party's statement of case struck out either in part or in its entirety. Any application for striking out should identify precisely what is to be struck out and the grounds on which this is sought.
- 2.70 The party concerned and any other parties or potential parties to the proceedings should be informed of the application for striking out and given an adequate period of time (normally one month) in which to respond. Unless the party concerned consents to the striking out, the hearing officer will need to decide the matter.
- 2.71 The summary procedure of striking out should be used sparingly. In line with the principles set out in [rule 3.4 of the Civil Procedure Rules 1998](#), it may be used to strike out something which discloses no reasonable grounds for bringing or defending the claim, although often amendment of the pleadings will be more appropriate than striking out. It may also be used when there has been abuse of process, or a failure to comply with any rule or with an order of the comptroller. For examples of striking out, see [Justwise Group Ltd v Magis S.p.A BL O/126/05](#) and [Aleshin v Sony United Kingdom Ltd BL O/056/05](#); in [Justwise](#) a reference under section 246(1) of the Copyright, Designs and Patents Act 1988 was struck out because there was in fact no dispute on any of the matters covered by that section. The comptroller also has the power, in line with [rule 24.2 of the Civil Procedure Rules 1998](#), to give summary judgment against either party on a claim or on a particular issue where it is clear (without conducting a "mini-trial") that there is no real prospect of success or no other compelling reason for a trial - see [Entertainments UK Ltd's Patent \[2002\] RPC 11](#). This overlaps with the power to strike out (see 'Civil Procedure' at 3.4.6), and should likewise be used sparingly. For instance in [Entertainments UK](#), where success of the pleaded case was improbable as it stood but not impossible, the hearing officer declined to dismiss the case

without first giving the claimant an opportunity to submit a revised statement. It should be borne in mind that a summary judgment will create an estoppel in respect of future proceedings (see [Chapter 1](#)), but striking out will not - see *Robert Price v Elf Print Media Ltd*, Patents Court 1 February 2001 (unreported).

- 2.72 For striking out, where the claimed abuse is want of prosecution, the principles and factors set out by Neuberger J in *Annodeus Entertainment Ltd and another v Gibson and another* (The Times, 3 March 2000) should be considered. These factors stress the duty on a claimant to pursue an action expeditiously and suggest that, inter alia, the length of any delay, the reasons for it and the prejudice caused by the delay to other parties should be taken into account. A relevant consideration will be whether there is a substantial risk, not merely considerable doubt, that a fair trial has become impossible - see *Taylor v Anderson* [2002] EWCA Civ 1680, The Times 22 November 2002. Steps to strike out an action (or "treat it as withdrawn") for want of prosecution may also be initiated by the comptroller - see [lan Carruthers v lan Carruthers and M&P Fluorescent Fittings Ltd BL O/068/98](#), where failure to take the case forward or respond to official letters was regarded as an abuse of process.

STAYING PROCEEDINGS

- 2.73 Sometimes one or both parties will ask the comptroller to stay an action pending the completion of some other litigation. Alternatively they may ask the comptroller to stay one issue whilst another is dealt with first. If both parties agree to a stay, the hearing officer in deciding whether to allow it should nevertheless consider the circumstances set out in 2.74 below including whether there is an alternative course of action which will bring the matter to a resolution.
- 2.74 If the parties disagree, the hearing officer will need to decide the matter, taking all the circumstances into account. These would include:
- - the potential to save costs
 - - the desirability of avoiding proceedings that could turn out to be unnecessary
 - - the desirability of avoiding inconsistent decisions in different legal fora
 - - the extent to which one or other party might be prejudiced by a stay
 - - the public interest
 - - the likely length of the stay
 - - the conduct of the parties.

Usually no one factor can be decisive. The hearing officer has to weigh them all up and decide where the balance lies - see eg [Rexam CFP Limited v Thibierge & Comar SA O/345/01](#) for a case (upheld on appeal) involving a variety of factors. The hearing officer should be cautious about granting a stay merely on the basis of the stated intention of one party to launch other litigation.

2.75 One of the commonest reasons for seeking a stay is to await the outcome of opposition proceedings before the EPO, on the grounds that they may render the proceedings before the comptroller otiose. Opposition proceedings before the EPO are notoriously slow, and if they have only just been launched it may be 4 - 8 years or even longer before they are concluded. Accordingly, the comptroller is normally reluctant to grant a stay in these circumstances. This reflects the practice in the courts - see, for example, [Glaxo Group Limited v Genentech Inc and Biogen Idec Inc \[2008\] EWCA Civ 23](#) which reviewed recent cases and, in paragraphs 79 to 88, issued general guidance on stays in such cases of parallel proceedings. The judgment held the principal considerations to be the length of the likely delay and the need for commercial certainty.

2.75.1 However, a stay may be appropriate if the EPO opposition proceedings are likely to be concluded reasonably quickly. On this, compare the judgments of Laddie J in *Unilever plc v Frisa N.V.* [2000] FSR 708 and *Minnesota Mining and Minerals v Rennicks (UK) Ltd* [2000] FSR 727. The EPO will accelerate an opposition in the case of a pending infringement action in a national court as discussed in their Guidelines for Examination, Part E Chapter VIII, paragraph 4, if requested to do so by a party to the proceedings or by the court. It is understood this would extend to other actions including a revocation action before the Office. In such a case, the parties should make the application to the EPO and inform the Office of the prospects for acceleration. A stay may also be appropriate if safeguards can be put in place to protect the interests of the party most likely to be harmed by the stay. For example, in *Bracco Spa v General Hospital Corporation* [2000] FSR 633 the judge stayed a revocation action subject to the patentee giving various undertakings, such as not to commence infringement proceedings during the stay, and only to claim damages by way of reasonable royalty.

2.76 When a stay is granted, the hearing officer should ensure that the proceedings do not languish forever in a state of suspended animation. Thus the parties should be required to tell the Office when the event which is to trigger the end of the stay has occurred, so that the hearing officer can review the position and issue directions for the continuance of the proceedings. In addition, the hearing officer will normally ask Litigation Section to seek a "progress report" from the parties at regular intervals.

DECLINING TO DEAL

2.77 Even where the comptroller has jurisdiction to hear an issue, in some instances he has the power to decline to deal with it. This power is available in patent proceedings under:

- - sections [8](#), [12](#) or [37](#) of the Patents Act 1977 - entitlement and inventorship
- - section [40](#) - employee compensation
- - section [61\(3\)](#) - infringement brought before comptroller by agreement of the parties

In each case, the test laid down in the Act is whether it appears to the comptroller that the issue involves matters which would "more properly be determined by the court". A similar power is available in revocation actions under [section 72](#), where under section 72(7)(b) the comptroller may certify in writing that to that effect.

- 2.78 In all the above cases, under [rule 63.11 of the Civil Procedure Rules 1998](#) any person seeking the court's determination of the matter must issue a claim form within 14 days of the comptroller's decision.
- 2.79 There are somewhat similar, although not identical, provisions in respect of design right proceedings under [section 246 of the Copyright, Designs and Patents Act 1988](#) (subsistence, term or ownership). Under section 251(1) and paragraph 28.1(2) of Practice Direction 63 the comptroller may refer either the whole proceedings or a particular issue to the courts, though the circumstances in which he might do this are not spelt out. Further, under section 251(2) the comptroller must refer the matter to the court if the parties agree he should do so.
- 2.80 Strictly, there is no provision for a party to apply to the comptroller for a decision declining to deal with an issue. Indeed in patent revocation actions, the applicant for revocation may apply directly to the court under [section 72\(7\)\(a\)](#) if the proprietor agrees. The comptroller may decline to deal of his own initiative if it appears appropriate to do so. Where a request comes from the parties, it is just as likely to come from the claimant as the defendant, as the claimant may not in law have the option of initiating the proceedings before the court rather than the comptroller. Alternatively the relief the court can grant may be more limited if proceedings are launched first in the courts. For example, whilst the courts can grant a declaration of entitlement to a patent application, they can only grant the full range of relief spelt out in [section 8](#) of the Patents Act 1977 on appeal from the comptroller or if the comptroller declines to deal.
- 2.81 The questions to be considered by the comptroller in declining to deal with entitlement cases under sections 8 and 12 of the Patents Act 1977 were dealt with by Warren J in [Luxim Corp v Ceravision Ltd \[2007\] EWHC 1624 \(Ch\), \[2007\] RPC 33](#). The comptroller had hitherto declined to deal only where the issues were so difficult and complex that the hearing officer felt he could not address them effectively. The Luxim judgment found that this was the wrong approach, and that the question to be considered by the comptroller was whether the court could "more properly" determine the issue. The comptroller should consider exercising discretion to decline to deal whenever a case was complex and should not do so "sparingly" or "with caution". In making the determination, it was necessary to consider the technical, factual and legal aspects of the case and judge these against the expertise and experience of a hearing officer as compared with that of a judge. Technical matters, expert witness evidence, English or foreign patent law would not indicate transfer to the court. Fraud, breach of fiduciary duty, and legal issues falling outside patent law, for example, might do so. The limited costs regime in the Office and its effect on the parties could also be a relevant factor.

- 2.82 It follows from this that whereas previous practice had been to consider declining to deal only where one or both of the parties requested it, following Luxim, it is necessary for hearing officers to consider the matter in all cases. Furthermore in some cases where both parties request it, the hearing officer may decide that it is nevertheless proper for the matter to be determined by the comptroller. The most common reason for a request is that there are parallel High Court proceedings covering much the same issues, and it would be undesirable for the both the court and the comptroller to be deciding the same issues. However, other arguments may be advanced and the hearing officer will have to decide where the balance lies.
- 2.83 When issuing a decision declining to deal, the hearing officer should consider the question of costs to date too, since this is something that probably cannot be formally referred to the court along with the substantive issues (see Helmut Schiller et al v Advanced Sustainable Energy Technology Ltd BL O/48/97).

DISPARAGING MATTER

- 2.84 Under [rule 51](#) of the Patents Rules 2007 the comptroller has the power to decline to make public any document or part of a document which disparages a person in a way likely to damage them. The hearing officer should be slow to use this power in relation to documents filed in inter partes patent proceedings. By their very nature such proceedings often involve one party criticising others in a way which could be construed as disparaging, and if such criticisms were suppressed that would undermine the Human Rights requirement for justice to be done in public.

SECURITY FOR COSTS

- 2.85 The comptroller can require a party to give security for costs under [section 107\(4\)](#) of the Patents Act 1977 or rule 22(2) of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#) before allowing the proceedings to continue, but does not consider seeking security unless asked to do so. The matter is handled mainly by Litigation Section. However, the hearing officer may be asked to advise on the appropriate level of security, and will need to deal with the matter as a preliminary issue if it is contested. The level should be determined after consideration of argument, and if necessary, evidence, wholly on a case by case basis proportionate to the likely level of any costs award that the hearing officer might make.
- 2.86 Patent proceedings commenced before 1 October 2005 are governed by [section 107\(4\)](#) as originally enacted, under which security is required in certain proceedings where a claimant neither resides nor carries on business in the United Kingdom. For patent proceedings commenced on or after that date, section 107(4) is amended by [section 15](#) of the Patents Act 2004 and [rule 85](#) of the Patents Rules 2007 to widen the conditions under which security can be required, which are now closely similar to those prescribed by [rule 25.13\(2\) of the Civil Procedure Rules 1998](#). Security can now be sought from any party, not just the claimant, but the comptroller must be satisfied that it is just to make an order having regard to all the circumstances of the case.

- 2.87 Impairment of a party's right of access to the comptroller which is disproportionate to the need to protect other parties could breach article 6(1) of the European Convention on Human Rights, so in considering a request for security the hearing officer should avoid imposing conditions which might have the effect of denying the party access to justice. For a fuller discussion of this principle, see [Olatawura v Abiloye \[2002\] EWCA Civ 998](#), [2003] 1 WLR 275 and [Nasser v United Bank of Kuwait \[2001\] EWCA Civ 556](#), [2002] 1 WLR 1868, (in relation to parties abroad). Paragraphs 3.1.5 and 25.13.6 respectively of 'Civil Procedure' refer.
- 2.88 [Deleted]
- 2.89 If security is ordered, it is for the parties to come to a mutually satisfactory arrangement for its payment. It may suffice for the appropriate sum to be guaranteed by the party's patent agent or solicitor, or by a bank in the United Kingdom. Where the party who is ordered to pay is unrepresented, the security can be paid into an account which the Office has for money held on behalf of third parties.

LEGAL AID

- 2.91 Legal aid is not available for proceedings before the comptroller, or for appeals from decisions of the comptroller.

Annex to Chapter 2 (see paragraph 2.20)

EXAMPLES OF A STATEMENT AND COUNTERSTATEMENT

[Entitlement](#)

[Revocation](#)

[Declaration of non-infringement](#) - statement only

Heading to identify the parties and the proceedings. Other formats are acceptable - e.g. see the example of a counter-statement

BETWEEN
Williams & Sons
and
George Jones

Claimant
Defendant

PROCEEDINGS

Reference under section 8 of the Patents Act 1977 in respect of patent application number GB3245678

Identify this document

STATEMENT of GROUNDS

Identify the parties and the matter in issue
Number the paragraphs
Set out the facts of the case
Claimant must supply two copies of the document mentioned

1. This reference is being made by Williams & Sons, the liquidators of the company Nuts Limited in connection with patent application number GB3245678. We claim that we are the rightful owners of the patent application filed by Mr George Jones in March 1998 and that ownership of the application should be transferred to us.
2. In 1996, 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 1998.
4. The invention described and claimed in patent application number GB 3245678 was devised by Mr Jones during the latter part of 1997. Mr Jones made a number of prototypes of the invention and tested these at the company before eventually finalising the invention.

Set out the relief claimed

5. At the beginning of March 1998, 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 1998.

Statement of truth

6. In September 1999, 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 in the Register of Patents.
7. During 2000, Nuts Limited got into financial difficulties. At a

meeting of the Board of Nuts Limited held on 5 July 2000, it was agreed that Williams & Sons should be appointed liquidators of the company and we were duly appointed on 12 July 2000.

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 36(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 favour.

I believe that the facts stated in this statement are true

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 are denied and why
State which allegations are admitted

Defendant must supply two copies of the document mentioned
Set out the relief claimed

Statement of truth

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 2000.

2. Paragraph 2 of the statement is admitted.

3. Paragraph 3 of the statement is not admitted. Whilst 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. Accordingly 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 wish to rely on this the defendant requires them to 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. Further, the company did not start making the new cashew-nut chopping machines until later in 1999.
6. Paragraph 6 is admitted to the extent that Mr Jones initially transferred his rights to Nuts Limited. However, this was conditional on a deal to purchase 1000 machines going through. At a Board meeting of Nuts Limited that Mr Jones took part in on 5 July 2000, 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 2000, seven days after the re-assignment of the patent application to Mr Jones.
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.

I believe that the facts stated in this counter-statement are true.

Signature:

Date:

BETWEEN

Bloggs Mouldings plc
and
BritGrit Limited

Claimant
Defendant

PROCEEDINGS

Application under section 72 of the Patents Act 1977
to revoke patent no GB 2545454

1. STATEMENT of GROUNDS
2. The claimant, Bloggs Mouldings plc, is a company registered in the United
3. Kingdom. The defendant, BritGrit plc, is the proprietor of patent no GB 2545454, which was granted on 17 December 2003 and claims a priority date of 16 January 2001.

The grounds for revocation

The claimant applies for revocation of patent no GB 2545454 on the following grounds:

- (i) under section 72(1)(a), that the invention is not patentable, because:
 - (a) it is not new as required by section 1(1)(a) and having regard to section (2)(1) and (2);
 - (b) alternatively, even if it is new it does not involve an inventive step as required by section 1(1)(b) and having regard to section 3; and
- (ii) under section 72(1)(c), that the specification of the patent does not disclose the invention clearly enough and completely enough for it to be preformed by a person skilled in the art.

The patent in suit

Patent no GB 2545454 relates to an impact resistant moulded plastics bin for the storage of gritting slat. Although not mentioned in the claims, the bin is intended for permanent installation by the roadside and is stated to have improved resistance to vehicular impact. It will be seen from claim 1 that the essential features of the bin are (a) it is moulded in one piece from a plastics material to have a base and upstanding sidewalls, (b) heavy metal particles are uniformly dispersed in the plastics material, and (c) angled reinforcing corner members are disposed within the moulding so as not to be exposed at the surface.

4. The remaining claims are appended directly or indirectly to claim 1 and
5. specify:
6. - (claim 2) that the particles are of diameter up to 5 mm;
7. - (claim 3) that the particles are of lead;
8. - (claim 4) that the corner pieces extend up to 5 cm from the corner in each direction; and
- (claim 5) that the bin has a back wall higher than the front wall and a hinged lid covering the opening.

Novelty

The invention as claimed in each of claims 1 to 5 is not new because of the

installation, before the priority date of the patent, of the grit storage bin which stands outside the headquarters of the defendant in Skidpan Lane, Gloomthorpe. The bin is in a position where it is freely accessible to the public. The claimant asserts that it was installed on or around 15 October 2000.

A photograph of the bin accompanies this statement. It is apparent from this that the bin has upstanding sidewalls, that the back wall is higher than the front and that a hinged lid is provided. The claimant further asserts that the bin includes a base and is moulded in one piece from polyethylene containing lead particles having diameters within the range 3.5 - 4.5 cm, and that it includes right-angled steel corner reinforcement pieces each limb of which extends 5 cm from the corner. The bin therefore possesses the features of each of claims 1 to 5.

Inventive Step

Even if the invention is shown to be new, the claimant contends that the invention as claimed in each of claims 1 to 5 does not involve an inventive step.

Attention is directed to the article "New Product Tests" by T Chest and I Fillet in "Storage and Flatpacks Monthly" pub. Box Clever Ltd, Cardiff, Vol 2 issue 1 (January 2000), at pages 33 to 35. In this article the authors describe the testing for impact resistance of a box for use in warehouses and garages to store tools and like bulky equipment. The authors state that the box has a length of 2m, a width of 1m and a height decreasing uniformly from 1m at the back to 0.75m at the front; that it is moulded in one piece from a polyethylene composition containing lead particles; and that it has steel corner pieces inlaid in, and flush with, the surface. They further state that the inlaid members have been found to improve resistance to impact damage from fork lift trucks. The photograph of the box which forms part of the article shows that in use it has a lid hinged to the back wall to cover the top opening.

9. The box therefore contains all the features of claims 1, 3 and 5 except for
10. feature (c) mentioned in paragraph 3 above, since the corner pieces are
11. exposed at the surface of the moulding. However, the claimant contends that
12. this would be an obvious modification for the man skilled in the fabrication of
plastics storage boxes to make. This is apparent from the many published
patent specifications in this art showing moulded boxes with both types of
reinforcement as alternatives, of which the following are examples:
GB wwwwww
US xxxxxxxx
US yyyyyyy
DE zzzzzzz

It is accepted that the dimensions of the particles and corner pieces specified in claims 2 and 4 are not mentioned in the Chest and Fillet article. However, the claimant contends that these are no more than would be arrived at by the skilled man by routine trial and error.

Invention not clearly and completely disclosed

The claimant contends that the term "heavy metal" used to define the particulate material is not clear in meaning, and that insufficient information is given in the specification of the patent to enable the skilled man to deduce an acceptable range of densities for the metal, lead being the only material specified. Accordingly, the specification does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art.

Relief sought

The claimant asks for:

- (i) revocation of the patent
- (ii) costs

The claimant believes that the facts stated in this statement are true.

Signature:

Date:

Note - Under rule 79 of the Patents Rules 2007, two copies each of the photograph (paragraph 6), the article (paragraph 8), and the US and German patent specifications must be filed, together with copies of a translation into English of the German specification. Evidence that the translation is accurate may be required if the comptroller has reasonable doubts about its accuracy (rule 113). A copy of the United Kingdom specification is not required.

BETWEEN

Bloggs Mouldings plc
and
BritGrit Limited

Claimant
Defendant

PROCEEDINGS

Application under section 72 of the Patents Act 1977
to revoke patent no GB 2545454

1. COUNTER-STATEMENT
2. The defendant, Brit-Grit Limited, acknowledges that it is the proprietor of
3. patent no GB 2545454.
4. The defendant denies the grounds for revocation put forward in paragraph
5. 2 of the statement. The defendant believes that the invention as claimed in each of claims 1 to 5 is new and involves an inventive step, and that the specification of the patent discloses the invention clearly enough and completely enough for it to be performed by a person skilled in the art.

The patent

Paragraph 3 of the statement is admitted. In particular, the defendant agrees that features (a), (b) and (c) are the essential features of claim 1. Paragraph 4 is also admitted.

Novelty

In regard to paragraphs 5 and 6 of the statement, the defendant admits that a bin according to the invention was indeed installed outside its headquarters in the manner described by the claimants. However, the defendant does not accept that the bin was "made available to the public" as required by section 2(2) of the Act, and the second sentence of paragraph 5 is therefore denied.

The bin is in fact installed at the rear of the premises, in a secure area to which only the inventor and some other employees of the defendant have access. Although the bin is visible through a 10 foot high wire perimeter security fence from the rear service road leading off Skidpan Lane, it is some 50 yards from the fence. Such examination as the public are able to give to the bin so installed is not sufficient to disclose its construction, particularly the features (b) and (c) mentioned in paragraph 3 of the statement (see *Lux Traffic Control Signals Limited v Pike Signals Limited and anr* [1993] RPC 107, pages 133 - 135).

6. The bin had been installed before the priority date of the patent to test its
7. weather resistance, but only those employees mentioned in the above
8. paragraph had access to it before that date. They were subject to a
9. confidentiality agreement as regards that access and any disclosure of its
10. construction to third parties. The defendant can prove that the constructional
11. features of the bin were disclosed to the claimants in breach of that confidence by a person who is no longer employed by the defendant. Therefore, under section 2(4) of the Act, this disclosure does not form part of the art for the

assessment of novelty.

Inventive Step

The defendant does not accept the claimant's arguments concerning inventive step. Thus although paragraph 8 and the first sentence of paragraph 9 are accepted as a fair summary of the Chest and Fillet box, paragraph 7 and the remainder of paragraph 9 are not admitted.

The defendant accepts that each of the patent specifications referred to in paragraph 9 of the statement discloses corner reinforcement both within and at the surface of the moulding, but does not accept that they represent a coherent body of prior art which would have led the skilled man to modify the Chest and Fillet box and arrive at the invention of claims 1, 3 and 5.

The boxes of these specifications have quite different constructions and purposes, both from each other and from the Chest and Fillet box. Thus GB wwwwww and US yyyyyyy disclose lidded boxes for domestic storage purposes, typically the storage of toys and clothes, and US xxxxxx discloses a portable tool box with a carrying handle in the lid. DE zzzzzz is directed to an open topped box whose cross-sectional area reduces from top to bottom so that a number of the boxes can be "nested" to form an easily portable stack. All of the specifications are concerned with small portable boxes, rather than the much larger "heavy duty" boxes of the kind disclosed by Chest and Fillet. There would in any case have been no incentive for the skilled man to place the reinforcement of Chest and Fillet inside the moulding, since its exposure at the surface is crucial to obtaining the desired impact resistance from fork lift trucks.

Paragraph 10 of the statement is admitted. However, these claims are dependant on claim 1, but in view of the above argument, the defendant does not accept that claims 2 and 4 lack inventive step.

However in order to distinguish the invention more clearly from the prior art mentioned in the statement, the defendant offers unconditionally to amend the patent by adding the following limitation to claim 1:

"..., the base being adapted to receive a fastening member for permanent installation of the box to a surface"

With consequential amendment to the description; the amendments being identified on the copy of the specification constituting Annex A to this counter-statement. The feature in question is clearly disclosed in the description of the preferred embodiment of the invention (see page 3 lines 18 - 23 and the Figure), where holes with thickened rims are provided through which the box can be bolted into position. None of the aforesaid prior art discloses such a feature, all being directed to boxes to boxes which are free-standing.

BETWEEN

Jonathan Muscles
and
Easydig Limited

Claimant
Defendant

PROCEEDINGS

Request for a declaration under section 71 of the Patents Act 1977 in respect of patent number GB 3111222

1. **STATEMENT of GROUNDS**

2. **Background**

3. The claimant, Jonathan Muscles, is a sole trader who has been running a
4. plant hire business for 22 years. Latterly he has expanded his business into
plant manufacture, and in particular, he is keen to break into the growing
5. market for small excavators with articulated jibs, of the type that might be
6. used by householders for small-scale jobs. He has designed a new
excavator for this purpose, which he has called the Microdig.
7. Easydig Limited are manufactures of large excavators, of the type used for
major civil engineering works. They are the proprietors of GB patent 3111222
which is still in force. The patent is concerned with the design of excavators.
8. On 12 July 2004 the claimant wrote to Easydig Limited, enclosing drawings
of his Microdig machine, asking for written acknowledgement that making,
9. disposing of, offering to dispose of, using or importing the Microdig would not
10. constitute an infringement of their patent. No reply was received, so the
11. claimant wrote again on 26 July, requesting an urgent response. A copy of
12. both the claimant=s letters is attached. On 9 August the claimant spoke by
13. telephone to Easydig=s solicitor, Mr Pinstripes, who confirmed that no reply
14. had been, or would be, sent. Accordingly the claimant is now applying to the
comptroller for an appropriate declaration.

The claimant confirms that, to the best of his knowledge, there are no proceedings pending in court in respect of this patent under any of the provisions mentioned in section 74(1) of the Patents Act 1977.

The claimant=s machine

The key features of the Microdig are shown in the attached drawings. It has a base structure 1, mounted on wheels 2, though it may alternatively be mounted on tracks. The base structure carries a small turntable 3 which is rotatable about a vertical axis X and carries a seat 4 for the operator. The turntable also carries an articulated jib 5 which can pivot about a horizontal axis Y. The axis Y is positioned in front of the axis X. Whilst this slightly reduces stability, it increases the reach of the jib and simplifies the construction. The jib 5 carries an arm 6 which projects back towards the operator. This arm gives the operator something to hold on to if he wants to lean forward as the jib is lowered.

The drawing also shows a number of other components, such as the

attachment 7 for the bucket or other equipment, the motor 8 and the control panel 9. The design of these features is not critical and may be varied to suit any specific needs. The essential features of the Microdig machine are those set out in the previous paragraph.

The patent

The patent specification has only one independent claim, claim 1, and this reads:

An earthworking machine comprising a wheel- or track-mounted platform, a cab for the operator rotatably mounted on the platform, an articulated jib comprising a first jib portion pivotally mounted on the cab and a second jib portion pivotally coupled at one end to the first jib portion, and mounting means at the other end of the second jib portion on which earth working tools can be mounted, wherein the first jib portion is located wholly in front of the axis of rotation of the cab.

Comparison of the claimant's machine and the patent

The patent is really concerned with earthworking machines that are an order of magnitude larger than the Microdig, and the engineering considerations are therefore totally different. Nevertheless, the claimant accepts that the Microdig has a platform, an articulated jib with first and second jib portions and a mounting means as required by claim 1.

However, the Microdig has no cab because there is no room for a cab on such small diggers. All it has is a seat on the turntable. Moreover, on the Microdig the first jib portion carries the arm 6 which extends backwards towards the seat, so the first jib portion is not even located wholly in front of the axis of rotation of the turntable. Thus the Microdig does not fall within the scope of the claim because it doesn't have two of the features required by the claim.

Validity of the patent

If the claimant's submission that the simple seat on the Microdig is not a cab within the meaning of claim 1 is rejected, the claimant alternatively submits that the patent is invalid because the invention does not involve an inventive step as required by section 1(1)(b).

The attached extract from Professor Homer's book *A Greek Engineering*, published in 1921, illustrates one of the drainage machines invented by Archimedes. This has a rotatable platform on which the operator stands, and a pivoted jib which is located wholly in front of the axis of rotation of the platform. The jib is not articulated, so there is no *A second jib portion*. Instead, a pivoting bucket is mounted on the end of the one-piece jib. Articulated jibs have been widely used on earthworking machines for at least 30 years. Indeed, because of the benefits they offer, they have almost completely displaced one-piece jibs. It would therefore have been obvious to any engineer in the business of designing earthworking machines to replace the jib shown by Archimedes with an articulated one. This would result in a machine falling within the scope of claim 1 - on the assumption, of course, that the word *A cab* has a broad meaning.

An invalid patent cannot be infringed. Thus even on the claimant's alternative argument, he is still entitled to a declaration of non-infringement.

Relief sought

The claimant seeks:

- (a) A declaration that making, disposing of, offering to dispose of, using or importing the Microdig machine as shown in the attached drawings and described above would not constitute an infringement of patent GB 3111222.
- (b) Costs.

I believe that the facts stated in this statement are true.

Signature:

Date:

Note - The drawings and the attachments are not included.

EVIDENCE

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THE COMPTROLLER'S POWERS

- 3.01 Inter partes proceedings are of a distinctly more formal nature than ex parte. In particular the proceedings will be concerned not with the establishment of an applicant's prima facie rights but with a dispute as to those rights involving another interested party. The facts on which each party relies will therefore need to be supported by evidence, unless admitted by the other side.
- 3.02 Under [rules 86 and 87](#) of the Patents Rules 2007 and rule 18(3) of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#), in England and Wales the comptroller has powers equivalent to those of a High Court judge in relation to the giving of evidence, the attendance of witnesses and the discovery and production of documents. (These powers include the powers available to the court to take evidence from witnesses in a foreign country, although it is extremely unlikely that the hearing officer will need to invoke them.) The hearing officer should therefore have full regard to the relevant parts of the [Civil Procedure Rules 1998](#) in these matters. In particular, where the comptroller and court have concurrent jurisdiction, evidence before the comptroller should be the same as that which would be admissible before the court ([ST TRUDO Trade Mark \[1995\] RPC 370](#)).
- 3.03 Under [rule 87](#) of the Patents Rules 1995 the comptroller has the power to take evidence in any form which would be admissible before the court, which includes oral evidence and cross examination. Under rule 5(2) of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#), the comptroller has the power to take oral evidence in lieu of or in addition to evidence by way of statutory declaration, affidavit or witness statement and allow any witness to be cross-examined.

NEED FOR EVIDENCE

- 3.04 The general rule is that all of the facts in issue or relevant to the issue in a given case must be proved by evidence. Apart from certain specific situations mentioned below, if a party fails to prove an essential fact the other side may well succeed even though the required evidence was in fact available. This means that the claimant will need to adduce evidence to prove the facts pleaded in his or her statement or to refute the defendant's evidence. Similarly, the defendant will wish to file evidence to support the facts pleaded in his or her counter-statement or to refute the claimant's evidence.
- 3.05 It is not, however, necessary to prove by evidence (a) facts which have been admitted by the other side, (b) facts of which the comptroller can take judicial notice and (c) presumptions of law which can be made once certain basic facts have been proved. These are explained in more detail below.
- 3.06 Evidence, and not just argument, may also be required where the comptroller is asked to exercise discretion in allowing amendments to a granted patent ([Coal Industry \(Patents\) Ltd's Patent \[1994\] RPC 661](#)).

- 3.07 Evidence can be oral (ie given in person in court) or written. Most evidence in proceedings before the comptroller is written, and it would be exceptional for the comptroller to allow a witness's main evidence to be given orally. The most likely situation for oral evidence to arise before the comptroller will be during cross examination of a witness who has already given written evidence. This is explained in [Chapter 4](#).
- 3.08 Occasionally artefacts are also submitted as evidence - eg a sample of the alleged prior art or of an article in respect of which a declaration of non-infringement is required.
- 3.09 The comptroller has the power to direct that such documents, information or evidence as he may require be furnished (eg see rules [82](#) and [86](#) of the Patents Rules 2007). In principle it is up to the parties to decide how to prove the facts on which they rely, and so generally the Office does not use this power to indicate to either party what evidence they should file. However where the hearing officer sees the need to manage the case through a Preliminary Evaluation or a Case Management Conference he may give guidance on the filing of evidence as discussed in [Chapter 2](#) at 2.02.1 to 2.02.4.
- 3.10 Exceptionally, evidence may be required from an official of the Office, eg on formalities and administrative procedures, though this is more likely to arise in ex parte proceedings (see for example [Rhone-Poulenc Sante's Patent \[1996\] RPC 125](#)).

BURDEN OF PROOF

- 3.11 The general rule is that the person who asserts something must prove it unless, of course, the other side admits it. This applies whether the assertion is an affirmative or negative one. The standard of proof required is the usual civil standard, ie balance of probabilities.
- 3.12 Normally, the onus is on the party who initiates the proceedings to establish his or her case (the "burden of proof on the pleadings"), eg the applicant for revocation in revocation proceedings and the referrer in entitlement proceedings. Where amendment is offered under [section 75](#) of the 1977 Act in revocation proceedings, the onus is on the proprietor to establish that the comptroller's discretion should be exercised in his or her favour, (see [Coal Industry \(Patents\) Ltd's Patent \[1994\] RPC 661](#)). Where the amendments are opposed there is also a burden on the opponent to establish his or her case, and so the onus is split. In such cases the Office will normally, in accordance with the practice of the court, expect the proprietor to file the first round of evidence ([Intel Corporation's Patent \[2002\] RPC 48](#)).
- 3.13 In some circumstances, the burden of proof (ie the burden of adducing evidence) may shift from the claimant to the defendant. This occurs where on proof of certain basic facts, it is reasonable to take certain other facts as proved in the absence of contrary evidence - see for example Perrett and anr's Application 49 RPC 406 and also where the defendant takes an

unhelpful stance, declining to counter arguments and evidence put forward by the claimant, as was held to be the case in [Baxter Healthcare Corporation & Ors v Abbott Laboratories & Ors \[2007\] EWHC 348 \(Pat\)](#).

MATTERS WHICH DO NOT HAVE TO BE PROVED BY EVIDENCE

Formal admissions

- 3.14 A party may admit a fact for the purpose of the proceedings in suit, thus saving the opposing party the trouble and expense of proving it. This may be done because the party concerned accepts the fact or, less commonly, because they do not regard it as significant to the proceedings.
- 3.15 A formal admission, once made, cannot normally be contradicted by the person who makes it in the course of the proceedings in suit. However, leave may be granted to withdraw an admission made by mistake or inadvertently and to amend the pleadings accordingly. See *White v Greensand Homes* in paragraph 2.40 above. Also any admission is only valid for the proceedings in suit.
- 3.16 Ideally, formal admissions should be made in the pleadings, so that the other party does not waste time assembling evidence to prove a fact that is admitted anyway. However, they can also be accepted later in correspondence or orally at the hearing itself.

Judicial notice

- 3.17 Where a court or tribunal takes "judicial notice" of a fact, it finds that the fact exists although the existence of the fact has not been established by evidence.
- 3.18 [Section 91](#) of the Patents Act 1977 expressly provides that judicial notice shall be taken of:
1. the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty (each of which is hereafter in this section referred to as the relevant convention);
 2. any bulletin, journal or gazette published under the relevant convention and the register of European or Community patents kept under it;
 3. and any decision of, or expression of opinion by, the relevant convention court on any question arising under or in connection with the relevant convention.

In addition, judicial notice must be taken of Acts of Parliament passed after 1850 ([section 3 of the Interpretation Act 1978](#)) and of EU treaties and decisions of EU courts ([section 4\(2\) of the European Communities Act 1972](#)).

- 3.19 In practice, copies of cited documents (in particular published patents and patent applications and articles from technical journals) as well as their dates of publication, are also almost invariably accepted as self-proving. If, however,

the authority of a copy of say a published patent, or its date of publication, is challenged then the party adducing the copy must prove it by evidence (see for example [Microsonics Corporation's Applications \[1984\] RPC 29](#)).

- 3.20 As explained in *Cross on Evidence*, a judge (and hence the hearing officer) may take judicial notice of common general knowledge, eg in respect of applications for perpetual motion machines. Nevertheless, as a general rule a judge may not act on his personal knowledge of facts or take steps to acquire such knowledge in private. However, this distinction is rather blurred in practice and as stated in *Cross* (page 71 of the 7th edn):

Nor should it be forgotten that some judges, like those in the Patents Court, are selected just because they have some technical expertise, and they may probably take notice of a wider range of matters, though their not having such expertise does not mean that they can take notice that there is none. All that can be said is that, within reasonable and proper limits, a judge, and, to a greater extent, a justice or juror, may make use of his special knowledge of general matters, but no formula has yet been evolved for describing those limits.

This follows the observation in the judgment of the Court of Appeal in [Hauni-Werke Korber & Co KG's Application \[1982\] RPC 327](#) that:

The judges who sit in the Patents Court are selected for their technical expertise. I am prepared to assume, for present purposes, that such a judge is entitled to say that a particular technical fact is within his own knowledge, but it is much more difficult to make a similar assumption in respect of a negative. I do not think that it would be correct to assume that such a judge could say that, to his own knowledge, an apparently technical term had no precise meaning.

- 3.21 In many situations, judicial notice will be tacitly accepted so that the hearing officer will not need to make any express finding on the matter. If, however, the matter is raised in the proceedings, the hearing officer will need to make a formal finding.

Presumptions of law

- 3.22 A presumption of law means that when certain basic facts have been proved, certain other facts must be taken as proved in the absence of contrary evidence. Examples of presumptions of law which may arise in patent proceedings are:

- - that if certain business transactions need to be done in a certain order to be effective and there is no acceptable evidence that they were done in the wrong order, they are presumed to have been done in the right order
- - that the person who applies for a patent is entitled to grant in the absence of evidence to the contrary (see [section 7\(4\)](#) of the 1977 Act).

THE WRITTEN EVIDENCE ROUNDS

- 3.23 In most inter partes proceedings, after the counter-statement has been filed a timetable will be established by the hearing officer in consultation with the parties for the filing of evidence. The first step is for the claimant to prepare and file its primary evidence ("evidence in chief") in support of his or her case. The defendant in turn then prepares and files evidence in support of his or her case. Finally, the claimant if it wishes can file further evidence ("evidence in reply") strictly in reply to the defendant's evidence. But where the defendant submits no evidence, it follows that there can be no evidence in reply. Additional evidence can only be filed with the leave of the hearing officer - see [Chapter 2](#).
- 3.24 In design right cases, since it is the rights owner, not the claimant, who files the "statement", one would normally expect the rights owner to file the first evidence round. However, the sequence is not prescribed in the rules, and so it is open to the hearing officer to vary it if a case is made out for doing so (see *Sterling Fluid Products Ltd's Application BL O/211/97*).
- 3.25 [Deleted]
- 3.26 [Deleted]
- 3.27 It is necessary to file duplicate copies of statements of grounds, counter-statements and applications for reviews of opinions in order to initiate and join an action. For evidence and other documentation required during the proceedings, a single copy only of each document is required, unless otherwise specified by the comptroller.
- 3.28 Although the hearing officer should not normally restrict the parties in respect of the evidence which they wish to file, he or she must be alert to the efforts of either party to gain advantage by deliberately filing excessive amounts of evidence. In appropriate cases, a Preliminary Evaluation will be issued or a Case Management Conference will be called to determine what evidence should be filed.

ADDITIONAL WRITTEN EVIDENCE

- 3.29 During cross examination of a witness at a hearing, the person conducting the cross examination may produce additional documents to test the witness's honesty or reliability. That practice is normal and acceptable. In all other circumstances the admission of evidence additional to the parties' evidence in chief and evidence in reply requires the leave of the hearing officer, who will require compelling reasons to justify it - see [Clear Focus Imaging Inc v Contra Vision Ltd](#) (Patents Court, 16 November 2001, unreported). The party seeking to introduce additional evidence must therefore request such leave, explaining why he or she wishes to introduce the evidence, its weight and significance, and why it was not filed in the normal evidence rounds.

- 3.30 The other party to the proceedings must be given an opportunity to comment on the admissibility of the evidence in question before any decision is taken. Where the other party raises no objection, the hearing officer should normally admit the additional evidence. Sometimes the other party will agree to the admission provided they themselves can file further evidence in reply to it, and again the hearing officer should normally allow this if the first party is content.
- 3.31 Where the admissibility of additional evidence is disputed, the hearing officer, after taking account of any views of the parties, should decide whether it would be more convenient to resolve the matter at a preliminary hearing or as a preliminary issue at the substantive hearing.
- 3.32 In deciding whether to admit additional evidence, the hearing officer should take all the circumstances into account, and should in particular consider all the factors specified in [rule 3.9\(1\)](#) of the Civil Procedure Rules 1998 governing requests for relief from sanctions: these are listed in Chapter 1 under "Exercise of Discretion". In [Denso Corporation v NGK Spark Plug Company Ltd BL O/076/03](#) the hearing officer considered that the correct approach was to arrive at a balance between these factors, these representing a good summary of the matters which the comptroller needed to take into account. In [Peckitt's Application \[1999\] RPC 337](#), where there was a five month delay, it was held that objections to admissibility should be raised as early as possible, but the fact that they were not could not make admissible that which was inadmissible.
- 3.33 The hearing officer should also consider the relevance of the new evidence to the substantive issues. In general, if it appears highly relevant and important, the hearing officer should be reluctant to refuse it unless there has been a gross abuse of process or if it would require vacation of the hearing date. If the lateness of the evidence puts the other side to additional expense the hearing officer may need to consider an appropriate order for costs. (For an example of a case in which the admission of late evidence was contested, see Stafford Engineering Services Ltd's Application BL O/228/97).
- 3.34 Sometimes a party seeks to hand up fresh evidence at the hearing itself. This practice is to be deplored and will not be allowed by hearing officers unless the evidence is of critical importance. Even then, new evidence will not be admitted unless it can be dealt with by the other side without requiring the hearing to be adjourned and recommenced at a later date (the delay being required because in the interests of natural justice, the other side would need time to consider it and file new evidence of their own). The hearing officer does have the power if he so decides to admit the new evidence and adjourn the hearing to a later date to allow that to happen, but the interests of justice are not served by such delay and he or she will not normally do so.
- 3.35 Where additional evidence is filed just before a hearing or is handed up at the hearing, an alternative procedure which may be adopted with the agreement of the parties is to admit the evidence de bene esse. In practice, this means that the parties address the hearing officer on the basis that the evidence in

question is admissible. After hearing the parties, the hearing officer decides whether it is necessary to admit the evidence in order to come to a decision on the substantive matters in issue. If it is necessary, the evidence is admitted and the other party should be offered the right of reply; if it is not necessary, the evidence is not admitted. This is less than ideal because it is liable to put the other side at a disadvantage to have to speak to new evidence they have not so far been aware of. Where this procedure is proposed, the hearing officer should ensure that the parties are left in no doubt as to precisely what is involved before seeking their agreement and guard against such disadvantage arising.

CONFIDENTIAL EVIDENCE

- 3.36 Sometimes evidence is submitted which one of the parties (not necessarily the one submitting the evidence) considers is confidential. The hearing officer has the power (eg under [rule 53](#) of the Patents Rules 2007) to direct that the document, or specified parts of it, be treated as confidential if a party so requests within 14 days of its filing. If such a direction is given, the relevant matter should not be read out or referred to in open court. Information about the recording of confidentiality directions is given in MoPP 118.14, but in inter partes proceedings it will often be preferable for clarity to issue the direction to the parties in the form of an order, with a right to appeal if there has been any dispute about its terms.
- 3.37 As explained by the Court of Appeal in [Lilly Icos Ltd v Pfizer Ltd \(No2\) \[2002\] EWCA Civ 2](#), [2002] 1 WLR 2253, the starting point should be that very good reasons are required for departing from the normal rule of publicity, and a simple assertion of confidentiality, even if supported by both parties, will not suffice. Factors to be taken into account include the effect of any confidentiality order on third parties and the likely role of the evidence in the proceedings: thus in Lilly Icos the very limited role played by the document in question enabled the court to take a more relaxed view than might otherwise have been appropriate. Further explanation of the circumstances in which confidentiality may be directed can be found in MoPP 118.13.
- 3.38 If the direction relates only to parts of a document, the remainder of the document should be made available for public inspection by asking the party whose evidence it is to provide a second copy with the relevant matter blanked out. If the confidential material in the document is irrelevant to the issues in dispute, sometimes the party supplying the evidence will blank out the confidential matter before supplying the evidence in the first place. In that case the hearing officer may require a sworn statement from the party that the blanked out parts are indeed irrelevant - see *G E Capital Corporate Finance Group v Bankers Trust Co and others*, [1995] 1 WLR 172 - though usually it will be quite clear that the blanked out matter is irrelevant.
- 3.39 Sometimes a party will go further and seek to submit evidence which it does not want the other side to see, eg because they are a business competitor and the evidence would disclose to them valuable commercial information. As decided in *Upjohn L J in Re K (Infants)* [1963] Ch 381 and followed in [VNU](#)

[Business Publications BV v Ziff Davis \(UK\) Limited \[1992\] RPC 269](#), any party to the proceedings has a right to see all the evidence before the comptroller on which the other party relies, so there can be no question of the hearing officer admitting evidence that one party has not seen. However, in suitable cases it may be sufficient to grant access to the confidential evidence on a restricted basis, eg to allow the document to be seen only by the other party's legal representatives and/or by an independent expert, or to require strict undertakings on confidentiality. There are no hard and fast rules because each situation will be different, but the aim must be to get a reasonable balance between the interests of the two parties. An order should not continue to bind the affected party in the event the confidential material is published by or with the consent of the owner, and it is usual to include a suitable clause discharging them in that event. See below for confidential evidence in the context of disclosure.

DISCLOSURE

- 3.40 "Disclosure" (also sometimes known as "discovery") is a procedure whereby a first party can require a second party to disclose relevant documents which are in its control (ie either currently or formerly in its possession, or having a right to inspect them) even though those documents may be detrimental to the second party's case. Indeed, disclosure is not needed for documents which help the second party's case because that party will want to put them in as evidence of its own volition. As indicated in *Compagnie Financiere du Pacifique v Peruvian Guano Co* (1882) 11 QB 55, the whole point of disclosure is to enable the first party to see documents which might advance its own case or damage the case of its adversary. The term "document" is defined in the Civil Procedure Rules as "anything in which information of any description is recorded" and may therefore include tape recordings and computer databases (see paragraph 31.4.1 of 'Civil Procedure').
- 3.41 Disclosure is standard practice in High Court proceedings. However, despite the limitations that the courts now impose, it can still be a major factor in pushing up costs because of the time and effort involved in identifying what may well be a very large number of documents. Disclosure is not common in proceedings before the comptroller and the Office does not expect that to change. This is partly because the sorts of issues that the comptroller deals with are less likely to require disclosure. As Aldous J said in [Merrell Dow Pharmaceuticals Inc's \(Terfenadine\) Patent \[1991\] RPC 221](#) at page 228:

. . . it should not mean that the burden of discovery should become more widespread in Patent Office proceedings. It is not normal in proceedings before the comptroller for there to be discovery and experience has shown that discovery has not been necessary in most cases which, in the past, have come before him. No doubt this has been because complex questions on infringement and validity normally come before the court.

Further, if disclosure did become common in proceedings before the comptroller, the advantage of the comptroller as a relatively cheap jurisdiction would quickly be lost.

- 3.42 However, limited disclosure can nevertheless be appropriate in some proceedings before the comptroller. If a party does seek disclosure, the principles the hearing officer should apply in deciding whether and how to grant it should mirror those applied by the courts.
- 3.43 Under the Civil Procedure Rules 1998 there are two types of disclosure in court proceedings, "standard" and "specific". Standard disclosure (see [rule 31.6](#)) is a fairly wide-ranging requirement to disclose relevant documents which are or have been in a party's control. It normally takes place more or less automatically in intellectual property proceedings. Specific disclosure ([rule 31.12](#)) is an order to disclose specific documents or classes of documents. Orders for disclosure in proceedings before the comptroller are usually orders for specific disclosure. It is unlikely it would ever be appropriate for a hearing officer to order standard disclosure, though it sometimes takes place anyway by voluntary agreement between the parties.

Exercising discretion

- 3.44 The principles the Office has traditionally applied in deciding whether to order specific disclosure reflected Order 24 of the old [Rules of the Supreme Court](#), and this approach was endorsed by Aldous J in *Merrell Dow*, supra (again at page 228). Thus the questions the Office has considered are:
- - whether the documents concerned relate to the matters in question in the proceedings, and
 - - whether their disclosure is necessary to dispose fairly of the proceedings or to reduce costs.

Note that under the first of these tests the documents must relate to "any matter in question", which is not necessarily the same as the subject-matter of the proceedings. Further, relevance is not an issue. As Aldous J said in *Merrell Dow*, supra:

The test is whether the documents relate to the matters in question. If they do, then they should be disclosed and their relevance will be decided at trial. To decide whether a document relates to a matter in question, it is first necessary to analyse what are the questions in issue in the proceedings.

- 3.45 As in the courts, even if these tests were satisfied there was always discretion to refuse to order specific disclosure. For example, disclosure would be refused if the value of the material to the applicant was outweighed by the burden it would impose on the opponent, as discussed in [Molnlycke AB v Procter and Gamble Ltd \(No 3\) \[1990\] RPC 498](#). Similarly, it would be refused if the categories of document were in such general terms, without any adequate particularisation, as to amount to a "fishing discovery", as discussed in *British Leyland Motor Corporation v Wyatt Interpart Co Ltd* [1979] FSR 39 at pages 44-45. In [Oxford Gene Technology Ltd v Affymetrix Inc \(No 2\) \[2001\] RPC 18](#), a case where there was a question of what points were in issue, Aldous L J said :

Any disclosure should be limited to that issue and only ordered if necessary. An opponent may raise other grounds of abuse, but they should be properly particularised before wider disclosure becomes potentially necessary. ... The obligation to disclose material, facts and matters does not require the disclosure of documents and I can see no warrant for a patentee throwing all his documents at the court as a policy of caution.

- 3.46 The provisions of the Rules of the Supreme Court have now been replaced by the [Practice Direction](#) to part 31 of the Civil Procedure Rules 1998, so the Office's practice on disclosure should now reflect this Practice Direction. On specific disclosure in 5.4 it says that:

In deciding whether or not to make an order for specific disclosure the court will take into account all the circumstances of the case and, in particular, the overriding objective ...

- 3.47 As the hearing officer concluded in [Cerise Innovation Technology Ltd v Abdulhayoglu BL O/177/99](#), this does not involve discarding the old tests, because they are still a sensible part of considering all the circumstances of the case. However, the hearing officer should now additionally put greater emphasis on the principle of proportionality and on the need to ensure proceedings are dealt with expeditiously.
- 3.48 The hearing officer should not grant vague or excessively broad requests; although it is of course open to the hearing officer to grant disclosure that is more limited or more specifically-defined than that sought.

Procedures

- 3.49 Before approaching the comptroller for a disclosure order, the party requesting it should have attempted to reach a voluntary agreement with the other side as to what documents should be listed and/or produced. If, exceptionally, this has not been done Litigation Section or the hearing officer's assistant should establish whether the party concerned will voluntarily agree to provide what has been requested. If the answer is no, the request for disclosure should be referred to the hearing officer for a decision either on the papers, if the parties agree to that, or at a preliminary hearing.
- 3.50 To enable the hearing officer to consider "all the circumstances", a party applying for specific disclosure must explain its reasons in full and must identify the documents or classes of documents it seeks as clearly as is reasonably possible.
- 3.51 The comptroller has a wide discretion as to when to order disclosure. However, it would not normally be appropriate to do so before the issues have been defined by the statements of case (cf [RHM Foods Ltd and Others v Bovril Limited \[1983\] RPC 275](#)), even though under [rule 31.16](#) of the Civil Procedure Rules 1998 the court has the power to order disclosure before any proceedings have started. Even where the issues have been defined, it may still be preferable to await the evidence of the parties so as to avoid

unnecessary disclosure (see [University of Southampton's Applications \[2002\] RPC 44](#)).

- 3.52 As indicated in [rule 31.17](#) of the Civil Procedure Rules, it is possible to order disclosure against someone who is not a party to the proceedings. However, it would be rare for the comptroller to make such an order. Even the courts exercise considerable caution when considering a request for disclosure against a non-party, and they will not even entertain the request unless it is for specific documents which the court is satisfied do actually exist - see [American Home Products Corporation and anr. v Novartis Pharmaceuticals UK Ltd and anr. \[2001\] EWCA Civ 165](#), [2001] FSR 41.
- 3.53 Strictly, a party complies with a disclosure order by making available a list of the relevant documents. The other side must then be given an opportunity to inspect them and obtain copies if they require them. In practice, a party will often comply with an order for specific disclosure by simply supplying copies of the documents to the other side. The party does not need to supply the Office with either the list or the documents. This is because documents produced on disclosure only constitute evidence in the proceedings if they are subsequently supplied as evidence.
- 3.54 As set out in [rule 31.8](#) of the Civil Procedure Rules 1998, a party's duty to disclose is limited to documents which are or have been in its control. This means documents which are or have been in its physical possession, and documents to which it has or had a right to possession, to inspect or to take copies.
- 3.55 If a document is privileged (see later in this chapter) it must still be included in the list but the other party is not entitled to inspect it. If the disclosing party considers that a document is confidential, again it must still be included in the list, but it may seek restrictions on disclosure as explained above. In deciding what order to make, the hearing officer must aim to get a reasonable balance between the interests of the party seeking disclosure in seeing documents that might help its case and the interests of the other party in not revealing business secrets to someone who is probably a competitor (see *Warner-Lambert Co v Glaxo Laboratories Ltd* [1975] RPC 354). For example, in *Centri-Spry Corp v Cera International Ltd* [1979] FSR 175, where disclosure to independent expert of secret drawings was unlikely to be useful, disclosure to the plaintiff's employees was permitted subject to express undertakings to keep the disclosed material confidential. The hearing officer may also need to consider the position with regard to data protection legislation. As explained in [Johnson v Medical Defence Union \[2004\] EWHC 2509 \(Ch\)](#), [2005] FSR 28, the fact that a party has been refused access to documents under the Data Protection Act 1998 does not of itself preclude the party from seeking their disclosure. However, it will be necessary to bear in mind the concern of the legislature that confidential information relating to third parties should not be disclosed to a data subject.
- 3.56 The comptroller does not have the power to punish summarily for contempt of court (eg see [rule 86](#) of the Patents Rules 2007). Where a party fails to

comply with an order by the comptroller for disclosure, it is open to the other party to apply to the court for enforcement. Alternatively, the other party could apply to the comptroller for an order striking out the first party's case - see [Chapter 2](#). However, no such order should be made unless an ultimatum has been issued by the comptroller (ie "your case will be struck out unless you comply with the disclosure within 7 days") - see *Star News Shops Ltd v Stafford Refrigeration Ltd and others* [1998] 1 WLR 536.

Use of disclosed documents

- 3.57 As set out explicitly in [rule 31.22](#) of the Civil Procedure Rules 1998, except in limited circumstances a party to whom a document has been disclosed may use it only for the purposes of the proceedings in question. Thus in [Bonzel & Schneider \(Europe\) AG v Intervention Ltd and anr. \[1991\] RPC 43](#), in which there were already in existence proceedings between the parties in other European countries in which no discovery is available, the Patents Court refused to allow the defendants to use the documents which had been disclosed in other proceedings. The judge also took account of the restricted jurisdiction of the EPO to keep documents confidential and stated at page 50:

I must take into account all the matter I have referred to and decide whether the circumstances in this case are special, in the sense that they outweigh the reasons for the implied undertaking as set out by Megaw LJ in the Halcon case ([Halcon International Inc v The Shell Transport Co and ors \[1979\] RPC 97](#)). I conclude that they are not. Discovery in patent actions is a heavy burden and requires disclosure of documents which in the normal course of business would be considered as highly sensitive. To make the order in this case would be a real disincentive to full discovery by litigants. The documents are the plaintiffs' and the information should be kept to them in so far as possible in the interests of justice in the United Kingdom and so that justice can both be done and be seen to be done.

However, in *Apple Corps Ltd and another v Apple Computer Inc and anr* [1992] FSR 389, the High Court did release the plaintiffs from the implied undertaking to allow them to use in parallel proceedings before the EC Commission certain documents which they had obtained on discovery and which had been read out to the court in camera.

WITHDRAWAL OF EVIDENCE

- 3.58 A party may be allowed to withdraw evidence at the discretion of the hearing officer.
- 3.59 In exercising the comptroller's discretion, the hearing officer should have particular regard to the reasons for withdrawal. Where a party wishes to withdraw evidence which he or she regards as confidential because he or she has been refused a direction under [rule 53](#) or is not satisfied with the arrangements for the other party or parties to see the evidence, withdrawal should normally be allowed. Withdrawal of evidence which the hearing officer is satisfied is not relevant to any matter in issue may also be allowed.

- 3.60 Where evidence is withdrawn, it may be open to the other party to seek to re-introduce it following disclosure.

FORM OF WRITTEN EVIDENCE

- 3.61 Under the relevant rules, written evidence can be in the form of a witness statement, statutory declaration or affidavit. In general a party can choose which of the three it uses. The comptroller does have the power to require evidence to be given by statutory declaration or affidavit instead of or in addition to a witness statement, though exercise of this power is only likely to be warranted in unusual circumstances.
- 3.62 All three forms of written evidence are essentially the same in substance, viz a statement by a named person about facts relevant to matters in issue. They differ principally in the way the person making the statement confirms the truth of what they are saying. A witness statement is the least formal of the three, as the witness simply adds a signed statement that "I believe that the facts stated in this witness statement are true". With a statutory declaration, the witness signs it and declares it to be true in front of someone authorised to administer oaths, using a form of words prescribed by the [Statutory Declarations Act 1835](#). An affidavit goes one stage further and has to be formally sworn or affirmed before someone authorised to administer oaths.
- 3.63 As provided by [Rule 87\(3\)](#) of the Patents Rules 2007, the general rule is that evidence is to be by witness statement unless the comptroller directs or any enactment requires otherwise. It is an offence to make a false witness statement, so even though a witness statement is not sworn, for all practical purposes it can be treated as carrying the same weight as an affidavit. If the other side doubts its veracity, it is open to it to call the witness for cross examination, in which case the witness will be required to swear the truth of the statement or declaration at the hearing. Of course, even when written evidence is in the form of an affidavit it is open to the other side to request permission to cross examine the witness on what they have said.
- 3.64 The contents of a witness statement should comply with the requirements set out in [paragraphs 18.1 to 18.6](#) of the Practice Direction to Part 32 of the Civil Procedure Rules 1998. Thus it should be written in the first person, should distinguish between statements made from the witness's own knowledge and those which are matters of information or belief, and should indicate the source of the latter.
- 3.65 A witness statement should commence by giving:
- - the witness's full name;
 - - the witness's place of residence or, if the statement is being made in a professional, business or other occupational capacity, the address at which he works, the position he holds and the name of his employer;
 - - the witness's occupation;
 - - any association with the parties (eg if he is an employee).

- 3.66 Any document referred to in the statement must be attached as an exhibit. Exhibits should be numbered consecutively (and if the witness later files a further statement, the numbering of any exhibits should continue, not restart from 1). Each exhibit should be verified by the witness, eg by appending a signed statement such as "This is the exhibit WT1 referred to in my witness statement". In the witness statement itself, the exhibit should be referred to by a clause such as "I refer to the [letter or whatever] marked WT".
- 3.67 There is an example of a witness statement and exhibit in Annex 1 and Annex 2 to this Chapter. The requirements for affidavits are broadly similar to those for witness statements - see the [Practice Direction to Part 32](#) for full details. While at one time Litigation Section would check to see that the requirements are met, since July 2009 as set out in [TPN 3/2009](#), they no longer do so. It is the responsibility of the parties to ensure they comply with any material requirements. A witness statement or affidavit which contains formal defects may still be admitted with leave of the hearing officer, and in practice the hearing officer can usually turn a blind eye to unimportant formal defects, especially if the other side is not making an issue of them.
- 3.68 Written evidence in any other form is in general inadmissible. In particular, unsworn or unverified statements should not generally be admitted as they are not subject to the sanctions of the Perjury Act 1911 or, in the case of witness statements and the like, the Civil Procedure Rules 1998 (see Brooks and Cope's Application BL O/71/93).
- 3.69 In accordance with [rule 22.2](#) of the Civil Procedure Rules 1998, if a statement of case is verified by a statement of truth, that too may be used as written evidence of any of the matters set out in it. Rules [76](#) and [78](#) of the Patents Rules 2007 require statements of grounds and counter-statements to be verified by a statement of truth so that they can be used as evidence before the comptroller (and on appeal before the court) in this way.

OPINION AND EXPERT EVIDENCE; EXPERIMENTS

- 3.70 Whilst the main purpose of evidence is to prove the facts, witnesses may sometimes give opinions too. As a broad generalisation, such opinions are inadmissible as evidence because it is the job of the hearing officer, not the witnesses, to draw conclusions of law or fact. There are exceptions, though, and one exception that is particularly important in intellectual property disputes is the opinion of experts. As stated in section 3(1) of the [Civil Evidence Act 1972](#):
- where a person is called as a witness in any civil proceedings, his opinion on any relevant matter on which he is qualified to give expert evidence shall be admissible in evidence.
- 3.71 There is no definition of what is meant by an "expert", but in general an expert witness will be someone who has the expertise to help the hearing officer understand matters which require specialised knowledge. As stated in [Inpro Licensing Sarl's Patent \[2006\] RPC 20](#), [2006] EWHC 70 (Pat) at paragraph 6,

even a witness who lacks expertise in the particular area under consideration can read himself into the state of the art and can be of great assistance even if he lacks contemporary experience. However, expert evidence is not conclusive of any matter in issue. As with any other evidence, the hearing officer will need to decide how much weight to attach to it having regard to all of the circumstances of the case; in the Inpro case (paragraph 9) the court said even the evidence of an unsatisfactory expert who lacked objectivity was of some value as stating the most favourable level at which Inpro's case might be put. The ultimate decision is for the hearing officer alone based on all of the facts and evidence adduced in the proceedings, of which the expert's evidence is only one component. (see [Armstrong v First York Ltd, \[2005\] EWCA Civ 277](#), [2005] 1 WLR 2751).

3.72 Ideally an expert will have had no involvement with either the parties or the underlying events. However sometimes, in very specialised technical fields for which there are very few experts worldwide, it may not be possible for a party to find an independent expert (see, for example, [Denso Corporation v NGK Spark Plug Company Ltd BL O/327/03](#)). In these circumstances a witness who is not truly independent can still give evidence as an expert, though the hearing officer will need to be satisfied that the opinions given are genuinely objective. In paragraphs 99 to 121 of [Arpad Toth v David Michael Jarman \[2006\] EWCA \(Civ\) 1028](#), a conflict of interest was not found to disqualify an expert witness, but the conflict should be clearly disclosed, as early as possible in the proceedings.

3.73 Evidence of experts is not admissible on questions of construction - eg of a patent specification or of the terms of a statute - since these are matters for the hearing officer. As stated by Stuart-Smith LJ in [ICI v Montedison \(UK\) Ltd and anr \[1995\] RPC 449](#) at p 460:

But it is for the Court and not the expert witness to construe the document. See *British Celanese Limited v Courtaulds Limited* [1935] 52 RPC 171 per Lord Tomlin at p 196; [Glaverbel SA v British Coal Corporation \(No 2\) \[1993\] RPC 90](#) where Mummery J reviewed the authorities.

3.74 However, this does not debar expert evidence on the meaning of specialised or technical terms. As stated in [Glaverbel SA v British Coal Corporation \[1994\] RPC 443](#) at p.486:

It is for the court, not for any witness, however expert, to decide the question of construction in accordance with the meaning of the language used. Evidence can be given by experts to enlighten the judge on the meaning which those skilled in the art would give to technical or scientific terms and phrases and on unusual or special meanings given by such persons to words which might otherwise bear their ordinary meaning.

3.75 Much of the evidence given by an expert will be evidence of facts rather than opinion, but often it is a mixture of the two. For example, in *Toyo Tsushinki Kabushiki Kaisha's Application* [1962] RPC 9 the opponent relied on a public sale to establish non-secret use. However, the opponent's witness did not

give actual details of the transaction but said simply that the articles were commercially sold or were sold to the opponent company in the ordinary way of commercial business with no restrictions by the vendors upon the use to be made of them. The Patents Appeal Tribunal stated at page 15:

Both these statements are in terms factual, but they both necessarily import an expression of opinion, in the one case of what constitutes commercial sale and in the other of the definition of "the ordinary way of commercial business". ... Whether or not a transaction constitutes a public sale is a mixed question of law and fact and in the present proceedings this Tribunal cannot adopt a witness's conclusion of law without the confirmation which a full examination of the facts might provide.

- 3.76 Evidence from an expert as to whether an invention was obvious can be of assistance, though the courts have not always found it helpful. In [Molnlycke AB & anr v Procter & Gamble Ltd & others \(No 5\) \[1994\] RPC 49](#) at p113, the Court of Appeal suggested that the assistance of expert evidence would almost invariably be required. However, in Pfizer's Patent BL C/41/00 Laddie J suggested that such evidence was generally of limited assistance to a court. The expert can, he said, help the court understand the technology, assess the possible lines of analysis the skilled person might follow and the deductions they might reach to arrive at the development. However, at the end of the day, deciding whether or not an invention was obvious is a matter for the hearing officer, not the witness.
- 3.77 If expert evidence is likely to be useful in a particular case, commonly both sides will instruct an expert of their own. Under [rule 35.4](#) of the Civil Procedure Rules 1998, in court proceedings the parties have to get permission before putting in the evidence of an expert, but that requirement is not invoked in proceedings before the comptroller. Further, as provided by [rule 35.7](#), often the courts will not allow each side to produce its own expert but will require the appointment of a single joint expert. However, because of the nature of patents disputes, that is not the practice of the Patents Court and in general the Office does not object to the use of separate experts either, though it is open to the hearing officer to direct that the parties use a single expert if he or she thinks that will expedite the case. The courts also disapprove of "expert shopping" and will generally not allow a party to substitute one expert for another unless the first expert's report is also disclosed (see [Vasiliou v Hajigeorgiou \[2005\] EWCA Civ 236](#), [2005] 1 WLR 2195 and [Beck v Ministry of Defence \[2003\] EWCA Civ 1043](#), [2005] 1 WLR 2206): the hearing officer should follow a similar procedure if the situation arises.
- 3.78 Nevertheless, even though an expert will usually be appointed by one of the parties, the expert's duty is to the court, not the party who has instructed him or her. Indeed the court may order a pre-trial meeting of both parties' experts with a view to identifying and limiting the issues necessary to be decided (see [Hubbard v Lambeth, Southwark and Lewisham Health Authority \[2001\] EWCA Civ 1455](#), The Times, 8 October 2001). The underlying principle is now spelt out very clearly in [rule 35.3](#) of the Civil Procedure Rules 1998:

1. It is the duty of an expert to help the court on the matters within his expertise.
2. This duty overrides any obligation to the person from whom he has received instructions or by whom he is paid.

3.78.1 The Civil Procedure Rules also provide ([rule 35.12\(3\)](#)) for expert witnesses to produce joint statements of agreed and disputed matters. An equivalent practice may be followed in patent proceedings before the comptroller. Where each side has appointed expert witnesses, they may be required to produce between them a statement of agreed and disputed matters and a summary of their reasons for disagreeing. The hearing officer will consider in each case whether such a procedure is likely to reduce the cost and complexity of the proceedings as a whole, for example by reducing the need for cross examination, while bearing in mind the extra cost of producing a joint statement. The possibility of this requirement being ordered will normally be communicated to the parties when the timetable for the filing of evidence and the proceedings is arranged, or when it becomes apparent during proceedings that expert witnesses have been appointed. Where it is ordered, a date will be set for the joint statement to be filed, which will be after the evidence rounds but in good time for the hearing.

3.79 Expanding on the principle of the expert's duty to the court, in *The "Ikarian Reefer"* [1993] FSR 563 at page 565, Cresswell J said that duties and responsibilities of expert witnesses in civil cases included the following:

1. Expert evidence presented to the court shall be, and should be seen to be, the independent product of the expert uninfluenced as to form or content by the exigencies of litigation: *Whitehouse v Jordan* [1981] 1 WLR 246 at 256, per Lord Wilberforce.
2. An expert witness should provide independent assistance to the court by way of objective, unbiased opinion in relation to matters within his expertise: *Polivitte Ltd v Commercial Union Assurance Co plc* [1987] 1 Lloyd's Rep 379 at 386, Garland J and *Re J* [1990] FSR 193, Cazalet J. An expert witness in the High Court should never assume the role of an advocate.
3. An expert witness should state the facts or assumptions upon which his opinion is based. He should not omit to consider material facts which could detract from his concluded opinion (*Re J*, supra).
4. An expert witness should make it clear when a particular question or issue falls outside his expertise.
5. If an expert's opinion is not properly researched because he considers that insufficient data is available, then this must be stated with an indication that the opinion is no more than a provisional one (*Re J*, supra). In cases where an expert witness, who has prepared a report, could not assert that the report contained the truth, the whole truth and nothing but the truth without some qualification, that qualification should be stated in the report: *Derby & Co Ltd and others v Weldon and others*, *The Times*, 9 November 1990, per Staughton LJ.
6. If, after exchange of reports, an expert witness changes his view on a material matter having read the other side's report or for any reason, such

change of view should be communicated (through legal representatives) to the other side without delay and when appropriate to the court.

7. Where expert evidence refers to photographs, plans, calculations, analyses, measurements, survey reports or other similar documents, these must be provided to the opposite party at the same time as the exchange of reports.

3.80 The courts have not hesitated to express their strong disapproval of experts who do not live up to the high standards expected - see, for example, [Cantor Fitzgerald International v Tradition \(U.K.\) Ltd \[2000\] RPC 95](#) at page 127, [Cala Homes \(South\) Ltd v Alfred McAlpine Homes East Ltd \[1995\] FSR 818](#) at p841, [Autospin \(Oil Seals\) Ltd v Beehive Spinning BL C/50/95](#), and [Glaverbel SA v British Coal and anr \[1994\] RPC 443](#), and the commentary in paragraphs 35.3.1 to 35.3.4 of 'Civil Procedure'.

3.81 To reinforce these standards, as laid down in [paragraph 2.2](#) of the Practice Direction that supplements Part 35 of the Civil Procedure Rules 1998, a written report by an expert must:

- - give details of the expert's qualifications;
- - give details of any literature or other material which the expert has relied on in making the report;
- - contain a statement setting out the substance of all facts and instructions given to the expert which are material to the opinions expressed in the report or upon which those opinions are based;
- - make clear which of the facts stated in the report are within the expert's own knowledge;
- - say who carried out any examination, measurement, test or experiment which the expert has used for the report, give the qualifications of that person, and say whether or not the test or experiment has been carried out under the expert's supervision;
- - where there is a range of opinion on the matters dealt with in the report -
 - a) summarise the range of opinion, and
 - b) give reasons for his own opinion;
- - contain a summary of the conclusions reached;
- - if the expert is not able to give his opinion without qualification, state the qualification; and
- - contain a statement that the expert understands his duty to the court and has complied and will continue to comply with that duty.

3.82 The courts have also not hesitated in patent actions to question expert witnesses in order to probe inconsistencies in their evidence. This was held by the Court of Appeal in [Cainstores Ltd v Aktiebolaget Hassle \[2002\] EWCA Civ 1504](#), [2003] FSR 23 not to create apparent bias or to prejudice the right to a fair trial.

3.82.1 In [Meadow v General Medical Council \[2006\] EWHC 146 \(Admin\)](#), [2006] 1 WLR 1452 Collins J confirmed it was a rule of public policy that witnesses should not be deterred from giving evidence for fear of litigation against them,

and this extended to disciplinary proceedings by an expert witness' professional body. Although it was open to the judge to refer the expert's conduct to the professional body, this would not normally be appropriate where the evidence, although mistaken, had been given honestly and in good faith.

- 3.83 As will be apparent from the preceding paragraph, a request for experiments to be conducted can sometimes arise in patent proceedings. Such a request is rare in proceedings before the comptroller, but if one is made the parties should follow the same practice as the Patents Court - see [paragraphs 9.1 to 9.3](#) of the Practice Direction to Part 63 of the Civil Procedure Rules 1998. There is more guidance in paragraph 61.75 of the CIPA Guide to the Patents Acts (Sixth Edition).

CONTENTS OF EVIDENCE

- 3.84 Although ideally evidence should be directed only to the matters in issue, and the issuing of Preliminary Evaluations is intended to forestall the filing of irrelevant evidence, in some cases evidence will go beyond the essential. This may be because the statements of case did not identify the matters in issue as well as they should have done, because matters that were in issue at the beginning of the proceedings have since been conceded, or simply because the party concerned has not really thought carefully enough about what might help to prove the matters in issue and what would not. In such cases, the hearing officer can disregard evidence which is not relevant.
- 3.85 Whilst evidence ought to be concerned with facts, "evidence" prepared by private litigants or inexperienced professionals often contains arguments in addition to facts. The proper places for such arguments are, of course, the statements of case, the skeleton arguments and the submissions made at the hearing, and they are technically inadmissible as evidence. Nevertheless there is little point in formally striking them out of the evidence, so long as the hearing officer recognises them for what they are and treats them accordingly.
- 3.86 Evidence involving inferences of law or fact which it is for the hearing officer, not the witness, to decide should be treated similarly. Although the hearing officer may consider whether he or she agrees with any inference, he or she should be careful to distinguish between facts and inferences in reaching his or her decision

Hearsay

- 3.87 The formal legal definition of hearsay in [section 1\(2\)](#) of the Civil Evidence Act 1995 is very broad and would embrace much of the evidence in proceedings before the comptroller:

a statement made otherwise than by a person while giving oral evidence in the proceedings which is tendered as evidence of the matters stated.

In practice, hearsay generally refers to statements from a witness about what someone else said or wrote, as distinct from statements about facts to which the witness can personally testify.

3.88 A statement may be hearsay for some purposes but not others, and there are different degrees of hearsay. For example, if a witness A says that B told him about event X, that is direct evidence of what B said to A but hearsay so far as the occurrence of event X is concerned. If B actually witnessed event X, this would be first hand hearsay of event X, but if B had merely read a report of event X, this would be second hand hearsay.

3.89 Under [section 1\(1\)](#) of the Civil Evidence Act 1995, hearsay is admissible as evidence. However, under [section 4](#), in estimating the weight (if any) to be given to hearsay evidence the hearing officer must have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence. In particular, the hearing officer must have regard to the following:

- - whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;
- - whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;
- - whether the evidence involves multiple hearsay;
- - whether any person involved had any motive to conceal or misrepresent matters;
- - whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;
- - whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.

Website prints may be admissible as real evidence rather than hearsay - see [R\(O\) v Coventry Magistrates Court \[2004\] EWHC 905 \(Admin\)](#), The Times 22 April 2004.

3.90 As explained in the [Practice Notice on Evidence \[1999\] RPC 294](#), a party does not have to give formal notice that it is adducing hearsay evidence. However, the other side have the right to call the witness for cross examination.

"Similar fact" evidence

3.91 The courts are prepared to admit evidence of the similar conduct of a party on other occasions if it is logically relevant for determining the matter in issue, provided that it is not unfair or oppressive to the other side (see [O'Brien v Chief Constable of South Wales \[2005\] UKHL 26](#), [2005] 2 WLR 1038 for a fuller elaboration of the relevant factors). However, this is extremely unlikely to arise in proceedings before the comptroller, and the probative value of such evidence may in any case be extremely limited. Evidence of a history of

copying the claimant's products was held admissible in support of an allegation of infringement of design right and copyright in [Mattel Inc v Woolbro \(Distributors\) Ltd \[2003\] EWHC 2414 \(Ch\)](#), [2004] FSR 12.

PRIVILEGE

3.92 Privilege is the right to withhold relevant evidence (whether oral or written) in certain circumstances. It is a right that may be waived by the person or persons enjoying the privilege, but unless it is waived, the privileged evidence may not be introduced into the proceedings. No adverse inference should be drawn from the maintenance of a privilege (see [Oxford Gene Technology v Affymetrix Inc \(No 2\) \[2001\] RPC 18](#)).

3.93 There are several forms of privilege. The two that most frequently affect proceedings before the comptroller are legal professional privilege and privilege in without-prejudice negotiations. These are discussed in more detail below. Hearing officers should also be aware that:

1. No person is obliged to answer any question or produce any document or thing if to do so would tend to expose that person to proceedings for a criminal offence or recovery of a penalty under criminal law (see [section 14\(1\) of the Civil Evidence Act 1968](#), which applies to proceedings before the comptroller by virtue of section 18).
2. Documents whose disclosure would damage the public interest may be withheld - see [rule 31.19](#) of the Civil Procedure Rules 1998 and paragraph 31.3.33 of "Civil Procedure".

There is, though, no privilege in technical or commercial secrets. The correct approach for these is to consider an appropriate confidentiality order, as discussed in paragraphs 3.36 to 3.39 above.

3.94 Privilege most commonly arises when disclosure is sought or when one party attempts to introduce evidence relating to negotiations between the parties. If it becomes apparent that evidence has been filed that may be privileged, the hearing officer should not read it, but instead ask Litigation Section to remove it from the file and put it in a sealed envelope whilst the question of privilege is dealt with. If it becomes necessary to read the evidence in order to resolve the question, it is better to ask a different hearing officer to do so, so that the main hearing officer's view is not tainted by a knowledge of what is in the document. If a witness or party attempts to refer to privileged information during the course of a hearing, the hearing officer should intervene immediately to stop them.

3.95 For more information on privilege, see standard textbooks such as "Phipson on Evidence".

Legal professional privilege

3.96 Legal professional privilege covers communications between:

- - professional legal advisers and their client (or the client's agent) for the purpose of giving or getting legal advice;
- - third parties and the client, the professional legal advisers or the client's agents, if made for the purpose of getting or giving advice or collecting evidence for pending or contemplated litigation.

The scope of the legal advice privilege was reviewed by the House of Lords in [Three Rivers District Council v Bank of England \[2004\] UKHL 48](#), [2004] 3 WLR 1274. The Lords held that the correct test was that stated in *Balabel v Air India* [1988] 1 Ch 317, namely that "legal advice is not confined to telling the client the law, but must include advice as to what should prudently and sensibly be done in the relevant legal context". On that basis, and recognising that there might be difficult marginal cases as to whether there was a "legal context", the Lords held that the privilege extended to documents prepared to enable solicitors and counsel to give advice as to the presentation of a case to an inquiry, even where litigation was not contemplated.

- 3.97 Sections [103](#) and [105](#) of the Patents Act 1977 expressly extend privilege to proceedings before the comptroller, and [section 280](#) of the Copyright, Designs and Patents Act 1988 expressly extends it to patent agents.
- 3.98 Although legal professional privilege is important in proceedings before the comptroller, it is rarely an issue for the simple reason that professional representatives are usually well aware of it.

"Without prejudice" communications

- 3.99 Written or oral communications made for the purpose of a genuine attempt to settle a dispute between the parties are generally privileged, and will remain so even if a settlement is reached, even on the issue of costs. The Court of Appeal confirmed in [Reed Executive plc v Reed Business Information Ltd \(No 2\) \[2004\] EWCA Civ 887](#), [2005] FSR 3 that, notwithstanding the comment of Lord Griffiths in *Rush & Tompkins Ltd v Greater London Council* [1989] AC 128 that the parties should be able:

to speak freely about all issues in the litigation both factual and legal when seeking compromise and, for the purposes of establishing a basis of compromise, admitting certain facts

It has been said that the rule is not based on any public policy of encouraging parties to negotiate and settle. Rather it arises out of an implied agreement as to what is commonly understood to be the consequence of agreeing to negotiate without prejudice. Public policy justifications have however subsequently been maintained by the Patents Court in [Schering Corporation v Cipla Ltd \[2004\] EWHC 2587 \(Ch\)](#), [2005] FSR 25 and [Pearson Education Ltd v Prentice Hall India PTE Ltd \[2005\] EWHC 655 \(QB\)](#), [2006] FSR 8, referring to other Court of Appeal judgments pre-dating *Reed*.

- 3.100 This privilege exists irrespective of whether the relevant communications were actually labelled "without prejudice" and can include negotiations which took

place before litigation was contemplated, see [Barnetson v Framlington Group Limited \[2007\] EWCA Civ 502](#). Conversely, the mere fact that a document is labelled "without prejudice" does not necessarily mean it is privileged (see respectively [Chocoladefabriken Lindt & Sprungli AG v Nestle Co Ltd \[1978\] RPC 287](#) and [Kooltrade Ltd v XTS Ltd \[2001\] FSR 13](#)). The underlying tests are whether, considered objectively, the author genuinely intended it to be a negotiating document and how it would be received by a reasonable recipient (see [Schering Corporation](#) as explained in [Pearson Education](#), both mentioned above). The privilege extends to what was not said (eg failure to reply to an offer) as well as what was said. It can only be waived with the consent of both parties.

- 3.101 There are some exceptions to the privilege - for example, when it is necessary to establish whether the negotiations resulted in a concluded agreement - but they are fairly narrowly drawn. There is an extensive discussion of the case law in [Unilever plc v The Procter & Gamble Co \[2000\] FSR 344](#); and see also [Admiral Management Services Ltd v Para-Protect Europe Ltd \[2002\] EWHC 233 \(Ch\)](#), [2002] FSR 59.

EXAMPLE OF A WITNESS STATEMENT

This is a very simple example - most witness statements will need to be rather longer.

BETWEEN

Williams & Sons
and
George Jones

Claimant
Defendant

PROCEEDINGS

Reference under section 8 of the Patents Act 1977 in
respect of patent application number GB3245678

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 thirty years experience in the field of
2 design engineering. Exhibit GJ1 sets out my educational qualifications and
3 my employment details.
4 I formed the company Nuts Limited with Mr John Smith in 1996. I was
5 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.
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.
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 2000.
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 believe that the facts stated in this witness statement are true.

Signature:

Date:

EXAMPLE OF AN EXHIBIT

BETWEEN

Williams & Sons
And
George Jones

Claimant
Defendant

PROCEEDINGS

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

EXHIBIT GJ1

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

Signature:

Dated:

*Note: The document containing details of Mr Jones' 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 2002 called exhibit 'GJ2'.*

INTER PARTES HEARINGS

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APPOINTMENT AND LOCATION

- 4.01 The appointment of hearings is governed by such rules as [rule 80](#) of the Patents Rules 2007 and rule 5(3) of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#). In patent proceedings, a hearing follows according to the rules if either party requests to be heard, and the Design Right rules require a party to give written notice to the comptroller of his/her desire to be heard, though in practice in inter partes actions the launch of the action implies that matters will proceed to a hearing without the parties specifically having to request one.
- 4.02 After the counter-statement has been filed, a date will normally be set for the hearing, along with a timetable for the filing of evidence, as set out at the beginning of [Chapter 2](#). The hearing date will be set in agreement with the parties or at least after giving them the opportunity to make proposals. The Office will do its best to fit in with the parties' preferences. Although whenever possible, the same hearing officer will control the whole of the proceedings including the hearing, in cases of real difficulty where the hearing officer is not available on the parties' preferred date, the Office will consider changing the hearing officer so that the date can be met. If the parties are unable to agree a timescale with the Office in a short time, the Office will impose one. The objective is to complete the proceedings within 12 months.
- 4.03 For preliminary hearings, the Office will normally set a window within which the hearing should take place, giving the parties 14 days' notice, and will invite them to propose a date in the window. Failing that, the Office will set a date within the window. (For further information concerning preliminary hearings, see [Chapter 2](#) under "[Clarifying issues and resolving preliminary disputes](#)").
- 4.04 Short hearings may be scheduled for any convenient time including afternoon starts, especially where that will enable the parties to fit in with imminent dates. Hearings that are expected to last for at least half a day are normally scheduled to start at 10.30 am, though if they extend over more than one day the hearing officer may suggest starting at 10.00 am on the subsequent days if this is convenient to the parties.
- 4.05 An oral hearing will not always be necessary. In appropriate cases the hearing officer should encourage the parties to allow preliminary or even substantive issues to be decided on the basis of their paper submissions. However, an oral hearing can only be dispensed with if both parties agree. It can go ahead even if only one party wants to attend, but the hearing officer should take particular care, before reaching a decision in such a case, to ensure that the non-attending party is given an opportunity to comment on any points raised at the hearing and not covered by the paper submissions.
- 4.06 Hearings can be held anywhere in the United Kingdom; see for example section 4 of [TPN 3/2009](#). Specific provision is made in the Patents Act for hearings to be held in Scotland, see the beginning of [Chapter 8](#). However hearings are normally held in rooms on Office premises in London or Newport which are laid out as court rooms. The hearing officer will need to take the

parties' preferences into account when deciding upon the location. (See "[Conduct of hearing](#)" below concerning the use of the Welsh language in proceedings held in Wales).

- 4.07 As a general rule however, inter partes hearings are held in London at 21 Bloomsbury Street, WC1B 3HF. These are the new London offices of the Intellectual Property Office following relocation from Harmsworth House in June 2009. The hearing officer may need to decide on any dispute over the venue after hearing submissions from both sides. The video link or telephone conferencing may provide a compromise solution in appropriate cases (eg for short preliminary hearings - see below).

Use of telephone and video conferencing for hearings

- 4.08 Where the issues to be resolved are simple and likely to take only a short time (as with many preliminary procedural hearings), the use of telephone and video conferencing has the potential for significant savings of time and costs. This line has been firmly stated by the courts, with the clear message that ignoring the availability of such facilities may be reflected in awards of costs - see eg the Court of Appeal in *Babbing v Kirklees Metropolitan Council* [2004] EWCA Civ 1431, *The Times* 4 November 2004 in relation to short applications to the court and *Laddie J* in *Robert Hewitt v P McCann Ltd* 30 March 1998 (unreported). In view of this, the Office will encourage parties to hold suitable preliminary inter partes hearings, case management conferences and pre-hearing reviews using telephone conferencing arrangements and video links. The hearing officer should ensure that neither side is disadvantaged by the use of such facilities. Thus particular care will need to be taken with the arrangements if only one of the parties will be at the remote site. Telephone and video conferencing are unlikely to be suitable for substantive hearings or complex legal issues which generally will be better handled in person (but see below for cross-examination by video link).

HEARING OFFICER, ASSISTANT AND OBSERVER

Appointment of hearing officer

- 4.09 Generally, a Divisional Director or Deputy Director will handle hearings on both substantive and preliminary procedural issues in contested inter partes proceedings and will also decide claims in uncontested proceedings (where the defendant does not file a counter-statement or drops out later). However, some matters may be dealt with by officers at other grades; for example unopposed claims under [section 13](#) are dealt with by a B3 officer in Litigation Section.
- 4.10 Litigation Section allocate each case to a case officer following service of the statement and at the same time nominate the hearing officer. Wherever possible, the hearing officer will control the case for the duration of the proceedings including any preliminary evaluation, case management conference, preliminary hearings and the substantive hearing. Another hearing officer will normally only get involved in a case for pressing case

management reasons (such as the admission of privileged documents which the main hearing officer should only see if admitted, or so that the parties can meet a deadline for the hearing on a date when the main hearing officer is not available).

- 4.10.1 After the counter-statement has been filed, the hearing officer will assess the case and decide, as explained in paragraphs 2.00.1 to 2.02.3, whether the parties should be encouraged to try ADR, whether a Case Management Conference should be arranged and on the timing of any Preliminary Evaluation and the order and timing of evidence. In any event, as a result of this assessment and the resulting communications with the parties, a timetable will be set for the proceedings, with a hearing date normally about 9 months ahead, or on a shorter timescale for straightforward cases.

Appointment and role of assistant

- 4.11 The hearing officer will normally appoint a Deputy Director or senior patent examiner as an assistant for the proceedings including the substantive hearing. For preliminary hearings and case management conferences, the hearing officer may appoint a Deputy Director, a senior patent examiner or any other officer of B3 grade or above, depending on the requirements of the case; for simple issues an assistant may not be necessary. An assistant should not previously have dealt with the patent or application in issue as an examiner or case officer
- 4.12 Subject to any specific guidance issued by the hearing officer, the role of the assistant is to help the hearing officer during the hearing, and also by:
- - dealing with some of the procedural issues that tend to arise before the hearing
 - - drafting the preliminary evaluation
 - - preparing a pre-hearing report (see below)
 - - after the hearing, preparing an initial draft for the decision (see [Chapter 5](#)) along the lines directed by the hearing officer.
- 4.13 On being appointed, the first action of the assistant should be to familiarise himself or herself thoroughly with the file and the issues in question. The assistant should check for any outstanding matters and ensure that they are dealt with expeditiously, liaising with the action officer in Litigation Section as necessary. The assistant should consult the hearing officer freely where difficulties arise, since the hearing officer may wish to intervene to ensure that matters are progressing satisfactorily, ensure timetables for ADR and evidence are being followed and if necessary to call a case management conference or a pre-hearing conference. The hearing officer may ask the assistant to draft the preliminary evaluation.
- 4.14 Where the parties need to be contacted by letter or telephone, this should normally be done by the officers in Litigation Section, not the assistant, although where appropriate the hearing assistant should provide Litigation Section with the actual text of the letter to issue or at least give clear and full

guidance as to its contents. However, if the issue is particularly tricky or complex it may be preferable for the assistant to contact the parties.

Pre-hearing report

- 4.15 Unless the matter in issue is a very simple one, before any hearing, whether substantive or preliminary, the hearing officer normally asks the assistant to prepare a pre-hearing report. The purpose of the report is to enable the hearing officer to get to grips as quickly as possible with the salient facts and issues. The hearing officer may also ask for a report before a case management conference or pre-hearing review.
- 4.16 The actual content and structure of a pre-hearing report will depend on the nature of the proceedings, but it is often useful to include:
- - a list of the evidence filed with a brief indication of who each declarant is, an outline of the contents and a summary of any exhibits;
 - - if a timetable of events is critical and complex, a chronology.
- 4.17 The report does not usually need to go into details of matters that are not in issue at this stage. Thus for a preliminary hearing, a detailed discussion of the substantive issues that will be at stake later will rarely be needed - a brief, scene-setting summary will suffice. Similarly, for a substantive hearing there will usually be no need to go through all the problems that cropped up in the pleadings and evidence rounds if these are now effectively water-under-the-bridge.
- 4.18 The report does not normally need to comment on matters not raised by the parties, eg printing errors, unless they affect the proceedings. However, where there is any doubt as to whether the comptroller has vires to determine an issue or to make an order which is sought, this must be drawn to the hearing officer's attention.
- 4.19 Normally the pre-hearing report should be sent to the hearing officer not less than a week before the date of the hearing, unless the hearing officer requires the report earlier (eg in the case of complicated proceedings or absence on leave).
- 4.20 If, as is not uncommonly the case, significant new issues arise after the pre-hearing report has been sent to the hearing officer, the assistant should make sure they are brought to the attention of the hearing officer, providing a supplementary pre-hearing report if necessary.

Observer

- 4.21 The hearing officer may select a patent examiner or formalities examiner or other officer to attend the hearing as an observer for training purposes. The assistant should send the observer a copy of the pre-hearing report and any other documents necessary for the observer to understand the proceedings. If possible, the observer should also have an opportunity to see the file before

the hearing and be involved in discussion of the case between the hearing officer and the assistant. The observer should also be sent a copy of the decision.

POSTPONEMENT

4.22 Given that the timetable for the filing of evidence and the date of the hearing will have been set months in advance, requests for postponement of hearings should be rare and there is a strong presumption against allowing them since to do so conflicts with the objective of dealing with cases expeditiously. Once set, it is not intended that hearing dates will be vacated. However, if a request does arise, it should be considered in the light of the matters explained under "[Exercise of discretion](#)" in [Chapter 1](#). The principles governing such requests are broadly similar to those underlying any request for an extension of time (see [Chapter 2](#)) and will include what is necessary in the interests of justice, and the balance of advantage to the parties as well as the delay. The hearing officer will need to have regard to:

- - the agreement or otherwise of the other party
- - the closeness of the date set for the hearing and whether a new date can be arranged which does not incur significant delay
- - the reason for the request, e.g. unavoidable unavailability of the party, witnesses, or counsel; sickness; transport difficulties etc
- - whether or not there looks to be clear abuse of process, e.g. it is a clear delaying tactic.

4.23 Where the hearing officer agrees to a postponement, the delay should be kept to the minimum needed to deal with the reason for the postponement so that the hearing can go ahead as soon as possible thereafter.

4.24 Sometimes the purpose of a postponement request is to allow the parties to settle or use ADR. Negotiation should be encouraged, subject to the case reverting to litigation on a reasonably rapid timetable, and preferably without postponement of the hearing at all in the event that the negotiations or ADR turn out to be unsuccessful. [Paragraph 2.61](#) refers. Litigation Section should be requested to diary the file for review by the hearing officer after the set time, to put the case back on track.

PRE-HEARING REVIEW

4.25 The hearing officer has the power to call a pre-hearing review if he or she considers it appropriate. The procedures for this are broadly similar to those for case management conferences and are also explained in [Chapter 2](#) under "[Clarifying issues and resolving preliminary disputes](#)". A pre-hearing review is likely to be necessary only where the case is exceptionally complex.

CONDUCT OF HEARING

- 4.26 The local hearings clerk (or his or her deputy) will normally be in attendance at least 10 minutes before the hearing. The hearings clerk and hearing assistant need to ensure that all the reference works, eg RPCs, to which the parties and the hearing officer intend to refer are available in the hearing room.
- 4.27 The hearings clerk will arrange for the parties to be admitted to the hearing room. When they are ready to begin, the hearings clerk will announce the hearing officer as he or she enters the room. The assistant should follow, bringing any papers that have not been brought in already. An observer or adviser will normally also enter at the same time and sit with the hearing officer facing the parties; if for any reason they sit in the body of the room, they should do so in the seats reserved for the public, in a position such that they cannot inadvertently overhear any discussions between those attending on each side.

General hearings etiquette for the parties

- 4.28 In the High Court, there are elaborate rules on who may sit where, how they should behave, what they should wear, when they should stand, how they should address the judge and many similar matters. Parties do not have to worry about this in Office hearings, since these are not constrained by rigid rules of etiquette and are much less formal than the courts. In general:
- - Each party is allocated one "side" of the hearings room: normally the party who is to open (see below) sits on the hearing officer's left. Subject to that, the attendees may sit where they wish although the person who is actually presenting the case should be in the front row.
 - - There is no dress code for attendees.
 - - There is no required mode of addressing the hearing officer or others: it is usual to address the hearing officer as "sir" or "madam", but equally acceptable to use his or her name if preferred.
 - - It is not necessary to stand up to address the hearing officer, or (as used to be the custom) to stand up or bow when he or she enters or leaves the room.
 - - A party who is uncertain about a point of procedure may ask the hearing officer for clarification; the hearing officer will draw no adverse inference from such questions.

The matters of how a case should be presented and when it is acceptable to interrupt the other side are explained below (see "The hearing officer's conduct").

Order of presentations

- 4.29 In inter partes hearings, one party opens, the (or each) other party replies and finally the first party has the right of reply to any points made by the other party or parties. Where a party is represented by King's Counsel and a junior, junior counsel should be asked whether he or she has anything

further to add following the KC's main address but not following the KC's right of reply. If, in exercising the right of reply, the first party raises any points for the first time, the hearing officer can either refuse to admit them or, more commonly, must give the other party a chance to reply to the fresh points.

- 4.30 Normally the hearing officer should be addressed on all the points in issue in one address. However, in some cases, particularly where a preliminary point is involved, it may be convenient to hear different points separately. If there is any doubt about the matter, the hearing officer should direct how the hearing should proceed after considering any views expressed by the parties.
- 4.31 The right to begin is normally vested in the party who bears the initial burden of proof. As regards the substantive matters in issue, this is normally the party who files the first and last rounds of evidence. Thus, in entitlement proceedings it is the referrer; in revocation proceedings it is the applicant for revocation; in settlement of the terms of licence of right proceedings it is the proprietor of the right; in the case of an application for a compulsory licence it is the applicant. However, in the case of procedural matters, the burden of proof will depend on the circumstances, eg where a party is seeking the admission of late-filed evidence, the onus is on that party to establish its admission. In most cases, the parties will agree between themselves who should begin and the hearing officer should not normally interfere (unless for example where he or she suspects that an unrepresented party is unaware of his or her right to begin). However, if there is no agreement, the hearing officer will have to decide the matter at the hearing after considering any submissions by the parties.

The hearing officer's conduct

- 4.32 The competences required of a hearing officer are summarised in a framework document, reproduced as an Annex to this Chapter, which has been drawn up by the Patents Directorate in the in the light of guidance given by the Administrative Justice and Tribunals Council and the Judicial Studies Board (see [Chapter 8](#) explaining the role of these bodies). The hearing officer must at all times act in an impartial, judicial manner and in accordance with the Human Rights Act 1998 and the principles of natural justice (see [Chapter 1](#)). He or she must always be polite, objective and dispassionate when addressing the parties. At the same time the hearing officer must remain alert not just to the points being made but to the direction in which the whole line of argument is leading. It is quite proper, and only to be expected, that counsel will use all the skills of the advocate, including subtlety and allusion as well as logical argument, to present their case in the best possible light and prejudice the hearing officer in their favour (particularly where the case is weak), and the hearing officer must guard against being taken in by this.
- 4.33 Where a party is not represented, the hearing officer should explain the hearing procedure at the outset, to make sure the party understands what is going to happen and what they should do.

- 4.34 Where a party is represented, the hearing officer should only explain the procedure where it is apparent that the representative does not understand it, eg where the representative is unqualified or is clearly inexperienced in litigation.
- 4.35 Where a party is represented, then normally only the representative should address the hearing officer. However, the hearing officer may adopt a flexible attitude where expedient.
- 4.36 In addition, the hearing officer must maintain control and ensure that proceedings remain on course. While a party must be given every reasonable opportunity to present and develop his or her case, it is open to the hearing officer to intervene where a party introduces totally irrelevant matter or continues to repeat him or herself unnecessarily.
- 4.37 Whilst one side is presenting its case, the other side should not normally interrupt. However, there are occasions when an interruption is helpful, eg to concede a point, or clarify an argument that the first side is trying to counter, and this is quite permissible. The hearing officer should, though, intervene if the interruptions become disruptive or there is a risk of the address developing into an argument between the parties.
- 4.38 While the hearing officer should not interrupt a party unnecessarily, he or she should always do so when it is necessary to elucidate a point, to check that a particular point has been correctly understood, or to check whether a party accepts or disputes a point. The hearing officer may remind a party that a particular point is not disputed by the other side.
- 4.39 Hearings are expected to last no longer than one day where there is no cross-examination and no longer than two days where there is cross-examination. If it is necessary for the parties to tailor their speeches and cross-examinations in order to fit within these time limits they will be asked to agree an approximate apportionment of the available time between them in advance of the hearing. In any event, hearing officers will retain discretion to deal with excessively long speeches and cross-examination.
- 4.40 The hearing officer should seek the parties' views on any matter not raised by them but which he or she feels is pertinent to the issues; wherever possible the parties should be informed of such a request before the hearing. For example, if the hearing officer is not satisfied that the comptroller has vires to determine an issue or to make an order which is sought, he or she should ask to be addressed by the parties on the point.
- 4.41 The hearing officer may also make proposals where he or she thinks these will advance the proceedings. However, this must be done in such a way as to avoid any impression that the hearing officer is favouring one party or has in any way prejudged the issue to be decided.
- 4.42 At the end of the hearing, the parties should each be left with the feeling that he or she has explained his or her case fully, that his or her arguments have

been listened to and understood, and that he or she understands the implications of any advice or warnings that have been given; in short, the party should feel that he or she has received a fair hearing.

- 4.43 A statement made by a hearing officer in the course of inter partes proceedings will not under any circumstances give rise to an action of defamation, even if it is false. This principle applies to all tribunals recognised by law which exercise judicial functions and includes within its scope the evidence given by witnesses (see eg *Trapp v Mackie* [1979] 1 WLR 377 at 379, 385-386).

Use of foreign languages and of Welsh

- 4.44 Where a witness who does not speak English is to be cross-examined, the party whose witness it is must provide an interpreter. They should notify the Office and the other side of their choice of interpreter in advance, so that in the unlikely event of an objection to that choice there is time to resolve the matter before the hearing. The interpreter should be sworn. There is no prescribed form of oath or affirmation for the interpreter, but the following wording is kept on a card with the witness oaths and affirmations (see above) and may be used:

I (swear by Almighty God / do solemnly sincerely and truly declare and affirm) that I will, to the best of my ability, faithfully interpret the evidence of and the questions put to (him/her).

- 4.45 The hearing officer's assistant should arrange for the most important documents to be available to the interpreter before the hearing. The parties should themselves endeavour to ensure that any documents on which they wish to (cross) examine the witness in question are translated beforehand into the language in question (see observation in [Glaverbel SA v British Coal Corporation and anr \[1994\] RPC](#) at page 485)
- 4.46 Where anyone else wishes to address the hearing officer in a foreign language (most likely to arise with an unrepresented non-English speaking party), again the onus is on them to provide an interpreter, but there is no need for the interpreter to be sworn
- 4.47 Concerning the giving of notice, there is one exception to the above. If the hearing is held in Wales, then in accordance with [section 22\(1\) of the Welsh Language Act 1993](#), any party, witness or other person is entitled to speak in Welsh without prior notice, with the use if necessary of an interpreter. If the parties are aware that Welsh will be spoken at the hearing, they should make arrangements for an interpreter to be present and notify the Office. However if prior notice has not been given, a non-Welsh speaking hearing officer will have no option but to adjourn the hearing until an interpreter can be found. The Office holds a list of Welsh speakers on its staff who would be prepared to assist, but if none of these are acceptable to the parties they will need to find an interpreter. Oaths and affirmations may also be given in Welsh without interpretation - see below.

Role of the hearing officer's assistant

- 4.48 The hearing officer's assistant should not intervene directly. However, the hearing officer may consult with the assistant during the hearing and he or she may quietly draw the hearing officer's attention to any matter which he or she thinks may be important.
- 4.49 The assistant should take notes of the main arguments and oral evidence even if a shorthand writer is present and/or the hearing officer is taking his or her own notes. These notes should be full enough for reference in the post-hearing discussion and for a first draft of the decision while the transcript is awaited.
- 4.50 During the course of the hearing, the assistant should ensure that the correct documents are before the hearing officer. The assistant should deal with any other matters which arise on the instruction of the hearing officer, including swearing-in witnesses.
- 4.51 Other duties of the hearing officer's assistant in respect of the hearing include:
- - ensuring that all reference works and authorities are available in the hearing room
 - - notifying the hearings clerk when the hearing concludes and waiting for him/her to arrive to lock the room
 - - swearing in witnesses
 - - making suitable arrangements for excluding witnesses during cross-examination, where necessary
 - - numbering and labelling new exhibits if any are handed up at the hearing, and drawing up a schedule of them
 - - dealing with documents requiring translation
 - - providing information to the shorthand writer.

Further details are given elsewhere in this chapter. However, each case can provide its own unique problems and the assistant will need to be flexible, show initiative and to act on the instructions of the hearing officer and liaise with the hearings clerk as appropriate.

ADJOURNMENT; RECESS; CONCLUSION OF HEARING

- 4.52 The hearing officer has the power to adjourn the hearing if he or she decides this is necessary.
- 4.53 Short adjournments may, for example, be ordered:
- - for a party's representative to seek further instruction
 - - for a party and/or the hearing officer to consider amendments proposed at the hearing in revocation proceedings
 - - to permit the hearing officer to prepare an oral decision
 - - for a 'comfort' break

4.54 Longer adjournments may for example be ordered:

- - to allow amendment of the pleadings
- - to allow new evidence to be considered or adduced
- - to obtain a translator to enable the hearing to be held in Welsh or oral evidence to be given in a language other than English
- - to allow counsel to prepare a final speech and/or to put in summaries on law and fact (see [Glaverbel SA v British Coal and anr \[1994\] RPC 443](#), headnote 22).

4.55 The established practice is for a hearing to be adjourned for the luncheon recess between 1.00 - 2.00 pm and overnight recess at or soon after 4.00 pm. However, these hours may be departed from at the suggestion of the hearing officer or parties, eg to enable the hearing to be concluded without a recess or a witness to conclude his or her evidence before the recess.

4.56 Where the hearing cannot be concluded within the period allowed, whether because of adjournment or otherwise, the hearing officer should give directions as to when it should resume, after hearing the views of the parties. The hearing officer should aim to minimise the delay and inconvenience to the parties.

4.57 At the end of the hearing or during an adjournment or at the end of a morning or afternoon session, the hearing officer should leave the room first. The case files may be left in the hearing room during the lunchtime recess and, on a multi-day hearing, between consecutive days, although the hearing officer should not leave any personal notes.

4.58 If the hearing concludes at any other time, the hearing assistant must notify the hearings clerk. The assistant should remain until everyone has left or the hearings clerk or other officer arrives to lock the court room. It is also the responsibility of the assistant either to take all the documents to the hearing officer's room or to arrange for the hearings clerk to do this.

PROVISION OF BUNDLES

4.59 A 'bundle' is a consolidated set of all the papers that might be needed at the hearing, including the pleadings, the evidence and any other documents. A bundle is intended to make it simpler for the parties to refer to individual documents during the hearing. Whilst a bundle is always required by the courts, the Office does not require a bundle to be provided if there is only a modest number of documents and there is to be no cross-examination. They will therefore seldom be necessary for case management conferences, pre-hearing reviews and simple preliminary hearings. However, a bundle is very useful if there are a lot of documents and/or if there is to be cross-examination.

4.60 It is the responsibility of the claimant to compile the bundle. The bundle needs to be prepared in good time so that both sides can use the relevant page references in their skeleton arguments. The bundle will normally require a

number of folders which should be labelled distinctively (eg. A, B, C...), and the pages in each folder should be numbered consecutively from beginning to end. It is also very helpful to insert tabbed dividers between the various groups of papers and to provide an index.

- 4.61 It is not normally necessary for the parties to provide a folder containing the authorities as the hearing officer will have available at the hearing any Reports on Patent Cases, Fleet Street Reports and Office decisions to which the parties intend to refer. However, if the parties are intending to refer to several authorities from other sources, a folder containing those authorities may be helpful.
- 4.62 Several copies of the bundle will be needed. The claimant should supply a copy to the defendant at least a week before the hearing. At least two copies should also be supplied to the Office (one for the hearing officer and one for the shorthand writer), plus a third one for the witness box if witnesses are to be cross-examined. However, the Office copies of the bundle do not need to be supplied in advance - it is sufficient if they are brought to the hearing on the morning of the hearing. If the Office copies are supplied in advance for a hearing that is to be in London, they should be sent direct to 21 Bloomsbury Street and not to Newport. If there is to be cross-examination and bundles are not used, the parties still need to ensure between them that they have a spare set of all documents for the witnesses.
- 4.63 The bundle is provided for the convenience of the hearing only. It is not part of the evidence proper and is not open to public inspection - see *GIO Personal Investment Services Ltd* [1999] 1 WLR 984. However, the Office retains it for a while after the hearing before discarding it (or returning it if requested), in case there is an appeal at which the parties might wish to re-use the bundle.
- 4.64 The High Court has experimented with having the bundle in electronic form, accessed by PCs or laptops in front of the judge, the two counsel and any witness. Any request to do this in a hearing before the comptroller should be considered sympathetically, because it may not only save paper but also speed up the hearing by making it easier to locate passages being discussed. However, an early warning must be given to enable the necessary facilities to be organised.

SKELETON ARGUMENTS

- 4.65 The parties are expected to supply skeleton arguments, together with authorities, at least two days before the hearing, as they are of considerable benefit in organising submissions and making efficient use of hearing time. They help focus the mind and enable the hearing officer and the parties and their representatives to gain a better appreciation of the issues and arguments. They should wherever possible be filed by e-mail.
- 4.66 A skeleton argument should concisely summarise the party's submissions on the law and any relevant authorities, the issues that need to be resolved by the hearing officer and how the evidence supports its case. It should be as

brief as the nature of the issues allows. Certainly it should rarely need to exceed 20 double-spaced A4 pages, and will often be much shorter than this.

- 4.67 In principle, skeleton arguments are not open to public inspection unless they are accepted in lieu of oral submissions - again, see GIO Personal Investments, *supra*. In practice, though, skeleton arguments are not usually read out in full, much being taken as read, and so are nearly always at least in part in lieu of oral submissions.

ORAL EVIDENCE; CROSS-EXAMINATION

- 4.68 Whilst in most proceedings before the comptroller only written evidence is used, the comptroller does have the power to take oral evidence at the hearing. Indeed, oral evidence can be crucial if there is conflict between the written evidence of different witnesses. For patents, the power to take oral evidence comes from [rule 87](#) of the Patents Rules 2007 relating to the form of evidence and [rule 82](#) giving the comptroller wide powers to control the conduct of hearings and the way in which evidence is placed before him. [Rule 5\(2\)](#) of The Design Right Rules 1989 allows the comptroller to take oral evidence in lieu of or in addition to written evidence and allows witnesses to be cross-examined.
- 4.69 Whilst the comptroller has power to take only oral evidence from a witness, in practice it would be very unusual for him to do so, particularly since [rule 87\(3\)](#) provides that the general rule is for evidence to be by witness statement. Normally oral evidence arises where the witness has already given written evidence and is being put in the witness box to allow cross-examination on that evidence.
- 4.70 Oral evidence in the High Court is given in three stages, ie examination-in-chief of the witness by his own counsel, cross-examination by counsel for the other side, and finally re-examination by his own counsel solely on points that emerged during the cross-examination. However if (as is usual in proceedings before the comptroller) the witness has already given written evidence, the examination-in-chief reduces to formally confirming that the witness is indeed the person who gave the written evidence, that they still stand by what they wrote and, if not, what corrections they now wish to make to it. Note that if the witness is in fact an unrepresented party, the hearing officer may need to conduct the formal examination-in-chief.
- 4.71 Where oral evidence is to be given, normally the claimant's representative will give an abbreviated opening speech before calling his or her own witnesses. The other side's witnesses are then called, and after that the defendant's representative puts his or her case, picking up on points that emerged during cross-examination as appropriate. Finally, the claimant's representative replies, again picking up points in the oral evidence. However, this sequence may be varied if appropriate, eg if a particular witness is only available for a limited period or if there is oral evidence from one side only.

Ordering and enforcing attendance

- 4.72 There is no presumption that cross-examination of the witnesses who have deposed written evidence will take place, but if cross-examination is requested it will normally be allowed unless the comptroller directs otherwise. This principle was enunciated in [Peckitt's Application \[1999\] RPC 337](#) under a previous version of the Patents Rules but still holds good under current legislation.
- 4.73 If a party wishes to cross-examine one or more of the other side's witnesses, it should give the other side and the comptroller reasonable notice. Failure to do so can jeopardise the hearing date if the witness is unavailable. Normally four weeks notice prior to the hearing would be regarded as reasonable notice, but longer may be appropriate if the witness is known to be abroad or would otherwise find it difficult to attend at short notice. Ideally the parties should make their intentions as to cross-examination clear after the evidence rounds have been completed, so that the other side is in a position to prepare its approach.
- 4.74 If a request for cross-examination of a witness is contested, the hearing officer will need to decide whether to allow it. This will normally need to be done in advance of the substantive hearing, either at a preliminary hearing or, if the parties agree, on the basis of written submissions. The hearing officer should consider whether it is reasonable in all the circumstances, having regard to the overriding objective and the competing interests of the parties. Among the factors to be considered are:
- - whether cross-examination is likely to elucidate the facts on which any matter is to be determined;
 - - the additional hearing time and costs to the parties; the ability of witnesses to attend;
 - - whether it will delay the setting of a date for the hearing; and
 - - whether it will have a "domino" effect, needing all witnesses to be cross-examined as a result;
 - - the effect on any timetable of speeches and cross-examination for the hearing.

The hearing officer should generally resolve any doubt in favour of the party requesting cross-examination but should be mindful of the need not to exceed the two day limit.

- 4.75 Where the hearing officer decides a person should attend the hearing to be cross-examined on his or her evidence (or to give hearsay or expert evidence), he or she should make an order to this effect under [rule 82](#) of the Patents Rules 2007 or rule 18(4) of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#).
- 4.76 Where a witness refuses to attend a hearing, or to give evidence if present, the comptroller would not appear to have the power of enforcement even if the hearing officer has ordered attendance. Instead, the aggrieved party

would need to apply to the court for enforcement by way of a subpoena. If this is not done and the witness concerned has already given written evidence, then unless the parties agree that this written evidence should be considered even though the witness is not available for cross-examination, the hearing officer would appear to have no option but to discount this evidence. Failure to comply with a subpoena is a matter for the court which granted it, and the hearing officer must adjourn any hearing in which a subpoenaed witness fails to appear to give evidence or submit to cross-examination as the case may be.

- 4.77 If a witness genuinely cannot attend for cross-examination (eg. because they are dead), their evidence should not be struck out. However in deciding what weight to attach to the evidence, the hearing officer must take account of the fact that the witness could not be cross-examined on it.
- 4.78 Even if the parties themselves have agreed to cross-examination, the hearing officer can still overrule them if he or she feels cross-examination is not justified (eg if the parties appear to be engaging in tit-for-tat requests for cross-examination, or if the issues to be explored in cross-examination are unlikely to affect the final decision). He or she should not hesitate to do so in appropriate cases in order to avoid unnecessary work and costs to the parties. The hearing officer should, of course, allow the parties to make submissions before making any ruling.
- 4.79 Whilst it is always preferable for a witness who is to be cross-examined to attend the hearing in person, sometimes this is not feasible or sensible. This is particularly the case with foreign witnesses and (see [Polanski v Condé Nast Publications Ltd \[2005\] UKHL 10](#), [2005] 1 WLR 637) fugitives from justice. Since it is unlikely that the powers available under the Civil Procedure Rules to take evidence abroad will be of much assistance, the hearing officer can in these circumstances allow cross-examination to be carried out using a video conference link. (See [Interfilta \(UK\) Ltd's Patent \[2003\] RPC 22](#) for such a case, and "Civil Procedure" at 32.3.1 for a fuller discussion of the factors to take into account.) It is up to the party whose witness it is to make the necessary arrangements. They will need to book video conferencing facilities at the remote end and give the Office details in good time so that we can check that the communication link works satisfactorily. The parties should agree a time during the hearing at which the cross-examination of that witness will take place, and they should also agree on an independent person (normally a local attorney, but not the witness' own attorney) who will supervise the witness, to make sure they are not referring to extraneous documents or being given prompts by someone else. The party whose witness it is should make sure copies of all documents and exhibits to which the witness might be asked to refer are made available at the remote end (eg by sending a copy of the bundles to the supervising attorney) and to arrange for swearing in. At the hearing the hearing officer will need to move into the body of the court for the duration of the video conference, or reconvene the tribunal in the video conference suite, so that he or she and the parties' counsel or other representatives are visible on screen at the remote end. The witness will normally be sworn in using one of the standard English forms of

oath. A bundle should if possible be provided for the assistant if he or she cannot sit by the hearing officer for this part of the proceedings.

Swearing in a witness

- 4.80 In accordance with [section 1 of the Oaths Act 1978](#) ("1978 Act") before giving oral evidence, a witness must swear an oath. Alternatively, if the witness objects to this ([section 5\(1\)](#)), or it is not reasonably practicable to administer an oath in a manner appropriate to the witness's religious belief (section 5(2) and (3)) he or she should make a solemn affirmation. Under section 5(4), such an affirmation has the same force and effect as an oath.
- 4.81 The hearings clerk should where possible establish before the hearing whether the witnesses wish to take the oath or to affirm. If they wish to take the oath, they should be invited to identify the holy book on which they wish to be sworn.
- 4.82 Various versions of the Bible (including the Old and New Testaments) and the Koran are held by the hearings clerks in Harmsworth House and Newport. Where the required holy book is not available in the Office, the witness should be asked to affirm.
- 4.83 As far as practicable, the hearing officer should attempt to accommodate any particular religious practices. Thus, Sikh and Muslim witnesses may ask to wash their hands, feet or other parts of their body before they take the oath. Sikh witnesses may also wish to remove their shoes and cover their heads. Male Jews may also wish to cover their heads. Rastafarians may wish to keep on their hats and swear on the authorised version of the Bible substituting "Jah" for the word "God". Certain holy books, in particular the Gita (Hindu), the Adi Granth (Sikh) and Koran (Muslim) should remain covered except when they are being touched by the witness taking the oath (in which case the witness should remove the book from the covering him or herself).
- 4.84 [Section 1\(1\)](#) of the 1978 Act provides:
1. (1) Any oath may be administered and taken in England, Wales or Northern Ireland in the following manner:-
- The person taking the oath shall hold the New Testament, or in the case of a Jew, the Old Testament, in his uplifted hand, and shall say or repeat after the officer administering the oath the words "I swear by Almighty God that" followed by the words of the oath prescribed by law.
- 4.85 In accordance with this section, the Christian and Jewish oath is:
- I swear by Almighty God that the evidence which I will give shall be the truth, the whole truth and nothing but the truth.
- 4.86 Other oaths admissible by virtue of 1978 Act section 1(3) are as follows:

Hindu (Taken on the Gita)

I swear by the Gita that the evidence I shall give shall be the truth, the whole truth and nothing but the truth.

Muslim/follower of Islam (Taken on the Koran)

I swear by Allah that the evidence I shall give shall be the truth, the whole truth and nothing but the truth.

Sikh (Taken on the Adi Granth)

I swear by Guru Nanak that the evidence I shall give shall be the truth, the whole truth and nothing but the truth.

4.87 The words of the solemn affirmation are:

I do solemnly sincerely and truly declare and affirm that the evidence I shall give shall be the truth, the whole truth and nothing but the truth.

In the case of Quaker or Moravian witnesses, this may be amplified as follows:

I being one of the people called the Quakers (United Brethren called Moravians) do solemnly sincerely....

4.88 Although it is normal for witnesses to raise the holy book in his or her right hand, this is not compulsory except (a) in Scotland (see [Chapter 8](#)) and (b) in the case of a Muslim taking the oath on the Koran.

4.89 The texts of the above oaths and affirmations are kept on cards by the hearings clerks in Harmsworth House or Newport. The hearing officer's assistant should ensure that any cards which might be required are to hand at the hearing. In accordance with section 16 of the [Evidence Act 1851](#), swearing of the oath or the making of the affirmation should be administered by the hearing officer. The hearing officer's assistant should hand the appropriate oath or affirmation card and (in the case of an oath) the appropriate holy book to the witness who should then be asked to read the words on the card.

4.90 The Scottish oath (see [Chapter 8](#)) is acceptable in England and Wales (1978 Act, section 1(3)). If a hearing takes place in Wales, then a witness may also swear or affirm in Welsh without interpretation ([section 23](#) of the Welsh Language Act 1993). The Christian and Jewish oath in Welsh is:

Tyngaf i Dduw Hollalluog mai'r dystiolaeth a roddaf fydd y gwir, yr holl wir, a dim ond y gwir.

The solemn affirmation in Welsh is:

Yr wyf yn datgan a chadarnhau yn ddifrifol, yn ddiffuant ac yn ddidwyll mai'r dystiolaeth a roddaf fydd y gwir, yr holl wir, a dim ond y gwir.

- 4.91 Evidence which could lawfully be made is not invalidated because an oath was administered in a form and manner other than that prescribed ([section 4\(1\)](#) of the 1978 Act) or because it was given on oath by a witness who had no religious belief at the time (section 4(2)).

Giving oral evidence

- 4.92 The object of cross-examination is to contradict or qualify the facts given in the written evidence. It may also be used to establish facts which support the cross-examining party's case or attack the credibility of the witness in respect of his or her knowledge of the facts, impartiality and/or veracity - see eg [Alliance and Leicester plc's Trade Mark Application \[2002\] RPC 29](#).
- 4.93 Re-examination must be confined to an explanation of matters arising in cross-examination; leading questions may not be put and no new facts may be introduced.
- 4.94 Leading questions are questions which suggest the desired answer, or which put disputed matters to the witness in a form permitting a simple reply of "yes" or "no". Such questions are permissible, and indeed normal, in cross-examination. They are not allowed either in examination-in-chief or in re-examination since, as the party knows exactly what his or her witness can prove, such evidence might appear to be a pre-arranged version rather than a spontaneous narrative. The ban on leading questions is intended to make it more difficult to conceal such a degree of pre-arrangement. However, introductory, non-controversial matter may be excluded from this ban in order to save time, provided the other party raises no objection.
- 4.95 The hearing officer should avoid interrupting the flow of cross-examination so far as possible, but may do so to clarify an answer or to stop a line of questions which is going nowhere or is clearly merely trying to intimidate the witness. Bearing in mind that the witness is supposed to be telling not merely the truth but the whole truth, the hearing officer should also intervene if the cross-examiner is deliberately preventing the witness from giving full answers. Any questions which the hearing officer may have and which do not relate to matters raised by counsel should be put at the end of re-examination and, following the witness' answer, counsel should be given the opportunity to cross-examine and re-examine the witness on the particular point.
- 4.96 A witness is allowed to consult documents such as diaries and log books to refresh his or her memory, provided the documents were made either by the witness him - or herself or by someone else in his or her presence, or if assented to or checked by the witness. The documents may be inspected by the opposing counsel. In practice this rarely arises in proceedings before the comptroller as the witness will already have given written evidence.

- 4.97 Documents or objects may be introduced in cross-examination. Usually they are designed to test the honesty or reliability of a witness, although occasionally they may simply be to facilitate the cross-examination (eg examples of articles which are the subject of the dispute). These constitute evidence, and after the witness and counsel have finished with them they should be handed up to the hearing officer for addition to the file. The hearing officer should first ensure the other side have a proper chance to inspect them. The hearing officer's assistant should label them in such a way as to clearly identify them. If a number of documents are handed up, the assistant should keep a log of them and number them in much the same way as exhibits to written evidence.
- 4.98 Sometimes a witness will be asked to make a drawing (preferably on a flip chart) or view some slides or the like. Again these constitute evidence and must be labelled and kept with the file.
- 4.99 Where a party objects to the evidence given by or a question put to a witness, and the other party does not accept the objection, the hearing officer will normally have to rule on the challenge before the hearing can proceed further. In such circumstances, the hearing officer should invite argument from both sides.
- 4.100 Normally, the witnesses will sit in the hearing room throughout the hearing. However, where cross-examination is intended to explore conflicts between the evidence of different witnesses, counsel may ask for witnesses who have not yet been cross-examined to be excluded from the room whilst another witness is being cross-examined. Such requests should normally be allowed. It may also be appropriate to exclude witnesses in the case of inter partes proceedings which are not open to the public (see later in this chapter) if any party objects to the presence of a witness while the latter is not giving evidence. The hearing officer's assistant should liaise with the hearings clerk to ensure there is somewhere for the witness to wait.
- 4.101 If a witness has not finished giving evidence when the court adjourns, eg for luncheon or overnight recess, the hearing officer should tell the witness that he or she is still under oath and may not discuss the case with anyone during the adjournment - and that includes the legal representatives of the side that has called them as a witness. When the hearing resumes, the hearing officer should formally ask the witness to confirm that they have indeed not discussed the case with anyone.

Assessing oral evidence

- 4.102 As explained in [Chapter 5](#), it is important for the hearing officer to give an assessment in his or her decision of the reliability of a witness under cross-examination. The hearing officer must therefore pay careful attention to the performance of the witness throughout the cross-examination, noting not merely what is said but how it is said and how the witness responds to probing questions. It is not sufficient for this purpose simply to rely on a transcript of the proceedings, which will say nothing about, eg, pauses in the

discussion or visual clues that the witness may have given. The hearing officer should not necessarily take things at face value: he or she should assess the consistency of the witness's account not only when taken in isolation but also when compared with anything that the parties have agreed on or that has clearly been shown by other evidence to have occurred. Inconsistencies may not mean the witness's evidence should be dismissed as unreliable, whilst a consistent and wholly plausible account may be a careful fabrication. For example:

- - If a nervous witness gives inconsistent answers, the hearing officer will need to assess whether they are intrinsically unreliable or whether they are essentially honest but cracking under the stress of cross-examination. If the latter, the hearing officer may conclude that their underlying written evidence is believable despite the inconsistent oral answers.
- - Even honest witnesses may suffer from genuine but inaccurate perception of events, imperfect recollection or wishful thinking. If a witness's evidence is shown to be defective for such reasons, the hearing officer will need to decide whether the evidence cannot be trusted at all or whether it is only the account of one or two details that is suspect.
- - A lie does not necessarily entail the rejection of all the evidence of a witness (see [EPI Environmental Technologies Inc v Symphony Plastic Technologies plc \[2004\] EWHC 2945 \(Ch\)](#), [2005] 1 WLR 3456). Nevertheless, if a witness is exposed as lying on a point that is crucial to the case, the hearing officer will need to view the whole of his or her evidence with suspicion.

4.103 With expert witnesses, imperfect recollection or deliberate lying are less likely to be an issue, but the hearing officer should watch out for experts whose impartiality is questionable - for example, those who seem to be acting as advocates for their party's case, or who proffer opinions on matters such as patent law that are actually outside their expertise. As explained in [Chapter 3](#), an expert's evidence is not conclusive of any matter in issue.

SHORTHAND WRITER, TRANSCRIPTS AND RECORDING

4.104 It is normal to have a shorthand writer present at any substantive hearing. It is up to the hearing officer to decide whether to request a shorthand writer for a preliminary hearing, case management conference or pre-hearing review, depending on the nature of the issues to be considered. As an alternative, the hearing officer can arrange for a hearing to be recorded electronically. A sound recorder is available from Litigation Section for this purpose, permitting downloading as a data file. In that case the hearing officer must make a note of the proceedings for the file covering at least the main issues .

4.105 Two types of transcript are available. The standard version involves a single shorthand writer covering the whole proceedings and is not delivered until some time after the hearing. The other is a daily version involving two or more shorthand writers working sequentially for short periods and is typically

available first thing the following morning. The latter type is considerably more expensive than the standard version, but can be very useful to counsel for multi-day hearings with extensive cross-examination. However, the Office will only pay for the cost of a standard transcript, and so if one or both parties want next-day transcripts, they must commission them from the shorthand writer and pay for them. Where both parties share the cost of next-day transcripts, the transcripts must also be supplied to the hearing officer on a next-day basis. Where only one party is willing to pay, the transcripts will only be available next day for that party and the hearing officer will not get them until the end of the hearing.

- 4.106 At the conclusion of the hearing, the assistant should check whether there are any documents or information (eg. the spelling of names) which the shorthand writer requires. The assistant should also ask for expedited treatment if the decision needs to be issued quickly.
- 4.106.1 An electronic copy of the transcript will be placed on the electronic case file by Litigation Section. If a party to the action requests a copy of the transcript, Litigation Section should arrange for a copy to be sent; the Office owns the copyright in transcripts produced for it under contract.

ADMITTING THE PUBLIC

- 4.107 [Rule 84](#) of the Patents Rules 2007 provides that hearings which take place after the patent application has been published shall be in public. Particulars of each hearing, including the date, time and location, are advertised weekly at the 21 Bloomsbury Street Office and on the Office's website. The public may however be excluded under rule 84(3) in exceptional circumstances, after consultation with the other side, for example where the disclosure of confidential information is likely to damage the business interests of one or more of the parties. Similar provisions apply to design right hearings - see rule 5(6) of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#).
- 4.108 Normally, where a direction that a document be treated as confidential under [rule 53](#) has already been given or where a request for such direction is being considered, the relevant part or parts of the hearing should be held in camera, the remaining parts of the hearing being held in public. Where access to a document has been restricted to a party's legal representative, the party may need to be excluded from the hearing room when the document is considered. Those parts of any transcript relating to proceedings in camera must be redacted from any version of the transcript which is open to public inspection on the official file of the proceedings.
- 4.109 Admittance of the public to design right hearings is regulated by rule 5(6) of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#) (together with rules 11 and 15). Similar considerations to those specified above will apply. Note however that in contradistinction to the files of published patent applications, the files in such cases are considered to be not open to public inspection.

APPOINTMENT OF ADVISERS

- 4.110 [Rule 102](#) of The Patents Rules 2007 and rule 19 of The [Design Right \(Proceedings before Comptroller\) Rules 1989](#) both give the comptroller power to appoint an adviser. The function of an adviser would be solely to advise or to answer a question posed by the hearing officer. The decision to appoint an adviser lies with the hearing officer.
- 4.111 Since advice on any field of technical subject matter is available in the Office, it is highly unlikely that external advice on a technical matter would ever be required. It is conceivable that a specialist such as a linguist or accountant might be needed to advise on a conflict of evidence in relation to the meaning of a foreign document or complex financial matters. However, the appointment of an adviser should only be made as a last resort where the point on which advice is required is fundamental to the decision and no other way (in particular directing that further documents, information or evidence be furnished under [rule 82](#) of the Patents Rules 2007 or rule 5(5) of the Design Right (Proceedings before Comptroller) Rules 1989) is open to the hearing officer.

RESPONSIBILITY OF PROFESSIONAL REPRESENTATIVES

- 4.112 Barristers are deemed to be "officers of the court", but all professional representatives are under a duty to pursue their case in a proper manner. Thus they must inform the court of all the relevant statutes and precedents (see *Copeland v Smith & anr* [2000] 1 WLR 1371), and where a legal authority is against their argument, they must not suppress it, although they may attempt to distinguish or criticise it. Further, they must not take unfair advantage of an unrepresented party, and indeed barristers are often commendably helpful to such parties.

Hearing Officer competences

[See paragraph 4.32](#)

COMPETENCES

Level of background knowledge

Understands

- the legal framework, jurisdiction and procedures of the comptroller acting as a tribunal

- the substantive law underlying the subject-matter of disputes

Eliciting and addressing the relevant issues

Elicits the points in issue

Identifies and assimilates relevant facts and evidence

Communication

Communicates effectively, both orally and in writing

PERFORMANCE INDICATORS

Familiar with content of Patent Hearings Manual and relevant parts of Manual of Patent Practice

Uses appropriate sources to obtain further advice or information

Deals appropriately with any issues which arise at the hearing or when giving a decision (whether written or oral)

Undertakes sufficient preparatory work on the case so as to be familiar at the hearing with the points at issue

Identifies areas requiring clarification, or further argument or evidence

Able to distinguish facts which are in issue from those which are not

Familiar with the difference between argument and evidence, and with the law of evidence as explained in the Patent Hearings Manual

Correctly assesses the reliability of evidence, both written and oral

Asks clear, concise and relevant questions which are understood by those to whom they are addressed

Makes appropriate comments (and knows when to refrain from making comments)

Employs active listening skills (eg is attentive, checks perception)

Uses appropriate body language (eg posture, gesture, facial expression, eye

[See paragraph 4.32](#)

contact)

Explains any relevant legal or procedural issues in language that the parties or their representatives at the hearing can understand

When giving a decision, makes clear the findings, the reasons for them, and the consequences which follow

Non-discrimination

When asking questions or making comments, uses language and forms of address which are sensitive to the differences mentioned opposite

Aware of and respects

- cultural and other differences amongst those who appear at the hearing (including differences in age, beliefs, gender, race, religious customs, sexual orientation and lifestyles)

Makes effective provision for the interpretation of evidence or argument in foreign languages or in Welsh

- particular needs of parties, witnesses and representatives with physical or mental disabilities

Arranges for the religious customs of witnesses to be respected when sworn to give oral evidence

Ensures that the needs of those with physical or mental disabilities are accommodated

Conduct of hearing
(including preliminary issues)

Gives clear and prompt instructions to case officers and hearings clerks, and builds and maintains effective working relations with them

Manages the hearing and the procedures leading up to it in a manner which

Ensures that the pre-hearing procedures do not become derailed or delayed, and that any preliminary disputes are expeditiously resolved

- establishes and maintains the independence and authority of the tribunal - accords with the Office's overriding objective (PHM 2.00.1)

Gives clear briefings and instructions to assistants and observers

- accords with the requirements of the Human Rights Act 1998 and with the principles of natural justice

At the hearing:

- behaves in a measured, calm and non-confrontational manner

[See paragraph 4.32](#)

- maintains firm and effective control of the proceedings, and does not allow argument and cross-examination to become unduly protracted

- maintains an appropriate balance between formality and informality

- ensures that all parties are on an equal footing and are able to present their cases fully

- communicates (see 'Communication' above) in a way which enhances and promotes equal treatment and the perception of it by the parties

- recognises and respects the needs of those appearing without representation, maintaining an appropriate balance between assisting their understanding and the impartial conduct of the proceedings

Decision-making

Deals appropriately in the decision with any issues which arise during the hearing

Makes clear findings, the reasons for them, and the consequences which follow

Gives effective, well-structured and timely decisions (both written and oral)

Where the decision is reserved, seeks the opinions of assistants and observers on the issues to be decided, and discusses the issues with them before giving a decision

Delivers decisions within the Office's target time, or otherwise within any timescale agreed with the parties

INTER PARTES DECISIONS

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GENERAL CONSIDERATIONS

5.01 The hearing officer's formal decision on any matter may either be given orally at the hearing (possibly after a short adjournment for the hearing officer to prepare it), or reserved and issued in writing later. In general, the hearing officer should endeavour to give an oral decision on a preliminary matter if the issues at stake are relatively straightforward procedural ones. For more complex preliminary issues and for the substantive issues, the hearing officer should normally issue a written decision - wherever possible within two months of the date of the hearing or (where no hearing is held) of referral for a decision on the papers. However, if a decision is needed quickly, it is possible to give an oral one on the spot and follow it up with written reasons later.

5.02 Decisions can be final or interim. In inter partes proceedings, an interim decision will generally issue where the hearing officer considers that a party should be given an opportunity to take some action, eg to submit amendments or file documents, in order to avoid an adverse finding.

5.03 [Rule 80\(6\)](#) of the Patents Rules 2007 requires that:

When the comptroller has decided the matter he shall notify all the parties of his decision, including his reasons for making the decision.

Thus, in patent proceedings before the comptroller, the reasons for a decision must always be given. This is also part and parcel of the "fair hearing" required by Article 6 of the [European Convention on Human Rights](#), and of the standards of openness and fairness required by the Administrative Justice and Tribunals Council (see [Chapter 8](#)). It is also important to make sure that the order or ruling the hearing officer makes is clearly and unambiguously stated.

5.04 The decision is the personal decision of the hearing officer and should be expressed as such. Quite apart from considerations of "plain English", use of the passive voice to express conclusions (eg "it is considered that . . .") is inappropriate in a decision.

5.05 Although a case management conference or pre-hearing review is a less formal procedure than a hearing, it will generally require the hearing officer to give a decision including some sort of order. The decision should be given orally wherever possible. Where it is not simply an assent to an agreed order drawn up by the parties, it constitutes an appealable decision like any other decision of the comptroller. Reasons should be given, although it will not normally be necessary to discuss them at length.

WRITTEN DECISIONS

Format

5.06 A template in Word is available to hearing officers to enable written decisions to be prepared with a headnote in a standard format on the front page and

incorporating the Office name and logo. Examples of the wording of headings for various types of decision are shown in Annex A to this Chapter. The parties should be identified as "claimant" and "defendant" wherever possible, although there may be situations, eg in some licensing decisions, and reviews of opinions where other identification would be preferable. Whilst the heading "Decision" will often be appropriate, it may be replaced by more specific wording to cover particular circumstances, eg "Preliminary Decision", "Interim Decision", "Order", or "Decision on Costs".

5.07 The template also includes the date of issue of the decision and the "BL" number under which the decision will be available for inspection in the British Library (see "Issuing decisions" below for the allocation of the number).

5.08 To facilitate making judgments available on the Internet, as from the beginning of 2001 the courts have adopted a standard document format for judgments (see [2001] 1 WLR 194). For consistency, Office decisions should now follow the same format. Thus decisions should:

- - be printed at single line spacing;
- - have each paragraph numbered (though indented subparagraphs should not be numbered and -see [Williams v J Walter Thompson Group Ltd \[2005\] EWCA Civ 133](#), [2005] IRLR 376 - long sequences of Roman numerals should be avoided);
- - have the paragraph numbers in the margin (eg by increasing the left margin from 25 mm to 37 mm, and back tabbing the numbers to 25 mm);
- - have the pages unnumbered.

Subheadings should be provided, although it may not be necessary for short decisions (two pages or less) and simple decisions which can easily be comprehended without them. The selection of suitable subheadings for an inter partes decision will depend on the length and complexity of the decision and the way in which it is set out (see below). However, it may be helpful at least to distinguish introductory and background matters, matters in issue, evidence, argument, conclusions, orders and appeal provisions.

5.09 The decision should end with the signature in the standard format, eg

[Signature]

ANOTHER

Divisional Director, acting for the comptroller

It is preferable not to have the signature on a page by itself. This can usually be avoided by minor adjustments to the layout.

5.10 Precedents should be given their full title and source when they are first quoted, but subsequent references may be in abbreviated form. References to House of Lords and Court of Appeal judgments dated from 11 January

2001 onwards and to High Court judgments given in London from 14 January 2002 onwards should include the "neutral citation" number assigned by the court before the identity of any report of the judgment (see [2001] 1 WLR 194 and [2002] 1 WLR 346). These numbers are of the form:

- - for the House of Lords, "[2001] UKHL number"
- - for the Civil Division of the Court of Appeal, "[2001] EWCA Civ number" (or "EWCA Crim" for the Criminal Division), and
- - for the High Court, "[2002] EWHC number (X)", where "X" identifies the division or specialist court, eg Ch, QB, Pat and Admin for the Chancery and King's Bench Divisions and the Patents and Administrative Courts, respectively.

Case reports published from the first issue of 2001 onwards by Sweet & Maxwell, which include the Reports of Patent, Design and Trade Mark Cases, the Fleet Street Reports and the Common Market Law Reports, should be identified by the unique reference number assigned by the publishers, rather than the page number as for earlier reports. These numbers run in a yearly sequence from 1 onwards. Thus, eg, Oxford Gene Technology Ltd v Affymetrix Inc (No 2) should be cited as [2001] RPC 18 rather than [2001] RPC 310.

Setting the scene

- 5.11 The decision should be self-sufficient in the sense that it should be capable of being fully comprehended without reference to other documents. However, in the interests of user-friendliness care should be taken not to rehearse evidence and argument, or to quote verbatim from background documents, in greater length than is strictly necessary (see [Williams v J Walter Thompson Group Ltd \[2005\] EWCA Civ 133](#), [2005] IRLR 376). There is no rigid structure for a patent, design or design right decision because the nature of the issues varies so much, but it will normally need to include, in addition to the arguments and conclusions, most of the following.
- 5.12 Background: It is often helpful to start by summarising the background to the proceedings in order to present them in context.
- 5.13 Hearing, parties and representatives: The decision should state whether or not a hearing was held. If it was, the decision should give the dates and who represented the parties. Where a party was represented by counsel, the name of the instructing patent attorneys or solicitors should also be given.
- 5.14 Subject matter: To the extent that it is relevant to the issues at stake, the decision should explain the technical subject-matter involved.
- 5.15 The law: The decision should normally recite the provisions of the Act, Rules or other legislation (eg the Patent Cooperation Treaty) relevant to the matters in issue. This does not necessarily have to be done at the beginning - it may sometimes be more convenient to include it during discussion of the arguments.

- 5.16 Matters in issue: The decision should set out what matters are (or remain) in issue. For example, in revocation proceedings it should identify which claims are under attack and on what grounds, any amendments offered and whether they are offered conditionally or unconditionally. So far as they are still relevant, the decision should also say what matters have been admitted. The decision should also indicate the orders or other relief sought.
- 5.17 Evidence: It will sometimes be helpful to summarise the evidence before getting down to a detailed discussion of the arguments, although often it will be more convenient to deal with the relevant evidence when discussing the arguments.
- 5.18 Witnesses: If there has been cross examination, the hearing officer should give his or her assessment of the reliability of the witnesses. This is important for two reasons. Firstly, it underpins the hearing officer's conclusions. Secondly, because the witnesses will not be cross-examined afresh before the judge in the event of an appeal, the judge will have to rely on the hearing officer's assessment of them and therefore needs to know what that assessment is - see [Ladney and Hendry's International Application \[1998\] RPC 319](#). No action for defamation will lie if the assessment is critical of a witness - see [Chapter 4](#) above.

Argument and conclusions

- 5.19 For each matter in issue and/or each line of argument advanced, the decision should summarise the arguments advanced before giving a reasoned conclusion. In discussing the arguments, the decision should refer to any precedent relied on by the parties unless it is manifestly not relevant to the matter to be decided. If a conclusion follows from either the exercise of discretion or a refusal to exercise discretion (see [Chapter 1](#) above), the hearing officer should make clear what considerations have been taken into account and how they are balanced.
- 5.20 The hearing officer should generally only make a finding on a matter which does not strictly need to be decided if this would simplify matters on appeal. For example, if a hearing officer decides to revoke a patent on the grounds of prior publication, strictly there is no need to consider whether the patent is also invalid on the grounds of inventive step. Nevertheless it may be convenient for the hearing officer to decide the second issue on the basis that his or her finding on a first issue might be wrong (see for example [Rhone-Poulenc Sante's Patent \[1996\] RPC 125](#)).
- 5.21 The hearing officer should generally avoid giving an opinion on a matter which he or she is not deciding (whether because it is not in issue or because a decision is no longer necessary because of a finding on another issue) as it could prejudice a later decision. There can occasionally be circumstances in which such an opinion might be helpful to the parties, but Mummery LJ's caution in [Office of Communications v Floe Telecom Limited \[2009\] EWCA Civ 47](#) should be kept in mind. Paragraphs 20 to 21 read:

- 5.20. ... There are sound reasons why courts and tribunals at all levels generally confine themselves to deciding what is necessary for the adjudication of the actual disputes between the parties. Deciding no more than is necessary may be described as an unimaginative, unadventurous, inactive, conservative or restrictive approach to the judicial function, but the lessons of practical experience are that unnecessary opinions and findings of courts are fraught with danger.
- 5.21. Specialist tribunals seem to be more prone than ordinary courts to yield to the temptation of generous general advice and guidance. The wish to be helpful to users is understandable. It may even be commendable. But bodies established to adjudicate on disputes are not in the business of giving advisory opinions to litigants or potential litigants. They should take care not to be, or to feel, pressured by the parties or by interveners or by critics to do things which they are not intended, qualified or equipped to do. In general, more harm than good is likely to be done by deciding more than is necessary for the adjudication of the actual dispute.
- 5.22 The hearing officer must not decide formally any matter which is not in issue, and should not infer fraud or bad faith from the facts of the case if this has not been specifically pleaded.
- 5.23 Books or documents which are neither mentioned in the written statements in the case nor brought to the attention of the parties at or before the hearing should not be referred to in the decision unless (a) they merely state authority for a proposition which was accepted at the hearing, and this is made clear in the decision itself, or (b) the hearing officer considers that they are of importance and gives the parties concerned an opportunity of commenting upon them in writing or orally before he arrives at his decision (see *Courtaulds Limited and anr's Application* 61 RPC 55). Similarly the hearing officer should generally avoid relying on precedents or arguments which the parties have not had an opportunity to consider and make submissions on (see [Silver Spring Water Co Ltd's Trade Mark Application \[2003\] RPC 21](#)).

Orders and costs

- 5.24 The hearing officer will need to give effect to his or her findings by way of an order or direction. For example, in the case of an application for revocation of a patent which has been at least partially successful, the hearing officer will need to make an order that the patent be revoked, that it be maintained with amendments offered by the proprietor or that the proprietor be allowed a specified period in which to submit (further) amendment. The hearing officer should take care to ensure that any order is within the powers of the comptroller.
- 5.25 When framing an order or decision, the hearing officer should take care that it leaves the parties in no doubt how they should proceed if events do not follow the seemingly obvious course. It will not usually be necessary to cover every possible scenario which might arise, but the hearing officer should bear in mind the possible effects of eg withdrawal of a party, lodging of an appeal, or

a claim of privilege in respect of documents to be disclosed. It may be necessary to give the parties the option of seeking further directions from the hearing officer in certain situations.

- 5.26 Usually any order will be included within the text of the decision. Sometimes, though, it may be better to follow the High Court practice and issue a decision on the substantive issues first and make the order later. This is particularly useful where it would be helpful to have submissions from the parties on the precise form of the order.
- 5.27 When the parties have been given an opportunity to have an input into the form of the order, they will sometimes draw up an agreed order recording the consent of both parties to its terms. If the hearing officer is content with the order he or she may simply sign it. An order of this nature is usually in the formal High Court style, and, whilst there is no need to bring it into line with the format of Office decisions, it may sometimes be desirable to adjust some of the formal wording.
- 5.28 The decision should also deal with the award of costs (see below) by making an award, by declaring that there is to be no award or by saying that costs are deferred to a later decision.

Appeal

- 5.29 With very few exceptions, any decision of the comptroller is open to appeal. For more details of the appeal procedure, see [Chapter 7](#). Since an appeal to the court from a decision of the comptroller on patent or design right matters constitutes a "statutory appeal" within the meaning of [paragraph 17](#) of Practice Direction 52 to the Civil Procedure Rules 1998, the period for appeal is 28 days from the date of the comptroller's decision, or, where a statement of reasons is given later than the decision, from the date on which the statement is received by the appellant (paragraphs 17.3 and 17.4). There would appear to be no discretion for the comptroller to direct any different period. The decision should normally therefore conclude with a final paragraph along the lines:

Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days - (or, where a statement of reasons is given later than the decision, "... within 28 days of the receipt of this statement by the appellant.").

(This does not apply to appeals to the Registered Design Appeals Tribunal or to appeals in Scotland - for these, see [Chapters 7](#) and [8](#).)

- 5.29.1 Where there is no prospect of an appeal, for example where there is only one party (or where one of the parties has withdrawn) and the decision is favourable to the active party, there is no need to include such a paragraph. In that case, the hearing officer should request the hearings clerk to omit the corresponding part of the covering letter.

5.30 The lodging of an appeal does not have the automatic effect of staying the order or decision of a lower court at common law. Under [rule 52.7](#) of the Civil Procedure Rules, the decision or any order in it is stayed only if the appeal court or the lower court so orders (see [Nettec Solutions Ltd's Trade Mark Application \[2003\] RPC 17](#) at paragraphs 14-15). The hearing officer should therefore consider whether any order in the decision might need to be stayed if the decision is appealed. It may sometimes be desirable to ask the parties at the hearings for submissions on whether a stay is appropriate. Each case will depend on the circumstances. However, it may well be appropriate to stay an order requiring a party to take some positive action (eg filing amendments or other documents, or executing a deed), so that the party concerned does not have to take the action before they have decided whether they wish to appeal the decision - although the impact of any delay on the other side will need to be taken into account. Conversely, it will not generally be necessary to stay an order affecting the status of a patent (eg revocation, refusal), unless a case is made out for a stay. Sentences along the following lines:

- "If an appeal is filed, my order that should be treated as stayed under rule 52.7(a) of the Civil Procedure Rules pending the outcome of the appeal."

- "If an appeal is filed, this will not of itself stay my order that , but it will be open to to apply to the comptroller for a stay under rule 52.7(a) of the Civil Procedure Rules."

may be included, as appropriate, in the appeal paragraph.

ORAL DECISIONS

5.31 Ideally an oral decision should follow the same lines as a written decision so far as its content is concerned. In practice, oral decisions are likely to be somewhat shorter and spend rather less time on setting the scene. Nevertheless, it is important to make sure that the reasons for the decision are properly explained, that the order or ruling made by the hearing officer is clearly and unambiguously stated, that the appeal period is also stated and that, if relevant, costs are dealt with. The parties should be left in no doubt where a reasoned oral decision is given that the appeal period runs from the date of the decision.

5.32 The hearing officer should ask the shorthand writer to supply to the hearings clerk a transcript of the decision per se as quickly as possible. (The rest of the transcript can usually wait.) In line with High Court practice, on receipt of the transcript the hearing officer should check it through and edit it as necessary. It is understood that High Court judges vary immensely in the amount of editing they do, but in general any editing the hearing officer does should be confined to making sure that the language reads reasonably smoothly and that the written words do accurately reflect the intended meaning as conveyed orally: the substance of the decision should not be changed. Having edited the transcript in manuscript, it should then be faxed or e-mailed back to the shorthand writer who will make the requested alterations. The transcript should then be issued under the cover of a front page containing a headnote

in the same format as used for written decisions (see "[Written decisions](#)" above) and a statement that the decision was given orally and the attachment is the transcript of the decision as approved by the hearing officer (see eg [BL O/180/04](#), [BL O/189/04](#)). A copy should be placed on the file. The original version of the transcript should be destroyed. If a reasoned oral decision is given but no shorthand writer was present (which may be the case for some preliminary hearings, case management conferences and pre-hearing reviews), then, depending on the circumstances, the oral decision may need to be followed by a written confirmation of the decision.

- 5.33 If the matter is urgent, the hearing officer may make an unreasoned oral decision on the spot, to be followed by a written statement of reasons later. However, although the period of appeal is not affected by any delay in issuing the statement (since, as explained above, it runs from the date on which the statement is received by the appellant rather than the date of the oral decision), the hearing officer should still aim to issue the statement quickly. Other than in exceptional circumstances, the statement should be issued no later than a week from the oral decision and earlier if the urgency of the situation warrants it. It should normally be issued in the format of a decision, but should be headed as a statement of reasons and have an introduction which makes clear that it is not the decision itself. It will be copied and distributed in the same manner as a written decision (explained below).
- 5.34 The hearing officer will need to give an oral ruling in respect of any procedural matter which is taken as a preliminary point at the substantive hearing, and may also need to give similar rulings on procedural points as the hearing progresses, eg on the admissibility of certain evidence or on the conduct of cross-examination. Strictly speaking, these are separate decisions of the comptroller which are subject to appeal. If the parties are prepared to go along with any such ruling at the time, it is not necessary to follow the above procedure for checking and editing the transcript or to issue the ruling as a separate decision. However, the hearing officer should make sure that the reasons for the ruling are given in the substantive decision.

COSTS

- 5.35 The comptroller has the power to award costs in proceedings before him - see [section 107\(1\)](#) of the Patents Act 1977 and rule 22(1) of the [Design Right \(Proceedings before Comptroller\) Rules 1989](#). As Anthony Watson QC, sitting as a Deputy Judge, confirmed in [Rizla Ltd's Application \[1993\] RPC 365](#), the discretion conferred on the comptroller in this respect is very wide, with no fetter other than the overriding one that he must act judicially.
- 5.36 The hearing officer should only award costs to a party if that party has requested an award, though in practice most parties make clear they are seeking costs in their statements of case. If there is any doubt as to whether a party is seeking costs, the hearing officer should check the position at the hearing.

- 5.37 In general costs should be awarded to whichever party was successful, although the level may need to be reduced if it was only partially successful. The principles governing the level of costs are explained below. Where proceedings collapse before the substantive hearing because the claimant withdraws, the hearing officer may still need to decide whether to award costs against the claimant before the proceedings can be finally disposed of. However, where proceedings are withdrawn because the parties have reached a settlement, that settlement will normally include an agreement on costs and so no order from the comptroller will be necessary.
- 5.38 The level of costs should not be reduced against a successful party who refused to take part in alternative dispute resolution procedures, unless the losing party can show that the refusal was unreasonable (see [Halsey v Milton Keynes General NHS Trust \[2004\] EWCA Civ 576](#), [2004] 1 WLR 3002). For the purpose of determining what is reasonable, Halsey does not override the privilege afforded to "without prejudice" negotiations (see [Reed Executive plc v Reed Business Information Ltd \[2004\] EWCA Civ 887](#), [2005] FSR 3).
- 5.39 In licence of right cases, usually neither side can be described as the "winner". Accordingly it is customary for the comptroller not to make an award of costs in respect of the substantive issues unless there are some exceptional circumstances, eg one side pursuing unreasonable terms.
- 5.40 In actions for revocation of a patent where the proprietor has to make amendments under [section 75](#) of the 1977 Act to avoid revocation, the claimant has in principle succeeded (by showing that the patent was indeed invalid), and is therefore entitled to costs. However, once the patentee has unconditionally offered amendments which cure the invalidity, any subsequent unreasonable behaviour by the claimant may reduce the costs which would otherwise have been awarded.
- 5.41 In cases of opposition to amendment of a patent under [section 27](#) of the 1977 Act, it was customary in the past either to award costs to the opponents or to make no award, on the grounds that the opponents were serving a public good by bringing about a rigorous scrutiny of the amendments. However, this is not now a line to be followed automatically when deciding costs: whether or not the opponents were serving any interests beyond their own is just one factor to be considered in all the circumstances of the case - see eg [Crown Cork and Seal Technologies Corp v Calix Technology Ltd BL O/062/03](#) and [J Maple & Son Ltd v Pownall BL O/001/04](#) where costs were awarded to the proprietor.
- 5.42 The hearing officer should be prepared to make an award of costs at any appropriate stage in the proceedings and not just "save them up" to the end, because this associates the costs more closely with their cause (see [Tribunal Practice Notice 2/2000](#), reproduced at [\[2000\] RPC 598](#) and [Tribunal Practice Notice 4/2007](#)). Thus whenever making a decision on a preliminary matter, the hearing officer should presume in favour of making an award there and then to whichever party was successful in respect of the points raised at that hearing, or specifically making no award if the issues were fairly evenly

balanced. In deciding, the level of costs may reflect any unreasonable conduct which has caused increased expense for the other party (see below for examples of such conduct).

- 5.43 Any order for costs should set a deadline of 7 days after the expiry of the appeal period for payment. If an appeal is lodged, payment of the costs awarded would be suspended pending the appeal. Failure to make payment following an award of costs at a preliminary stage would have implications for the continuation of the case.
- 5.44 In deciding on the level of costs, the hearing officer should take account of any submissions on the matter made by the parties. Normally these will be made at the hearing. However sometimes - particularly in lengthy cases involving counsel - the parties will prefer to follow the High Court practice and ask to make their submissions on costs after they have seen the decision on the substantive issues. If the hearing officer agrees to this, the substantive decision will have to be followed up by a further decision dealing solely with costs. Costs should not however be held over to await the outcome of an appeal (see *Harrison's Trade Mark Application* [2002] EWHC 3009 (Pat), [2004] FSR 13).

The scale for costs

- 5.45 It is long-established practice for costs awarded in proceedings before the comptroller to be guided by a standard published scale. The scale costs are not intended to compensate parties for the expense to which they may have been put but merely represent a contribution to that expense. This policy reflects the fact that the comptroller is intended to be a low cost tribunal for litigants, and builds in a degree of predictability as to how much proceedings before the comptroller, if conscientiously handled by the party, may cost them. In entitlement disputes where the primary jurisdiction lies with the comptroller, no account should be taken of the fact that a party is effectively deprived of the opportunity to obtain full costs (after taxation) before the court (see [Statoil ASA v University of Southampton BL O/268/05](#)). The practice of the High Court and the provisions of the Civil Procedure Rules do not therefore provide any general guidance for the assessment of costs before the comptroller.
- 5.46 The standard scale of costs for proceedings commenced on or after 3 December 2007, is set out in [Tribunal Practice Notice 4/2007](#) and is as follows:
- a. Preparing a statement and considering the other side's statement:
 - From £200 to £600 depending on the nature of the statements, for example their complexity and relevance.
 - b. Preparing evidence and considering and commenting on the other side's evidence:
 - From £500 if the evidence is light to £2000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.

- c. Preparing for and attending a hearing:
 - Up to £1500 per day of hearing, capped at £3000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.
- d. Expenses:
 - i. Official fees arising from the action and paid by the successful party (other than fees for extensions of time).
 - ii. The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.
- (For proceedings commenced before 3 December 2007, the previous scale applies - see [Annex A](#) of [Tribunal Practice Notice 2/2000](#), reproduced in [2000] RPC 598). It is not necessary for the hearing officer to make a precise assessment. It suffices to round the award to the nearest £50.

Departing from the scale

5.47 The scale is not mandatory. The hearing officer has the power to award costs off the scale where the circumstances warrant it. In extreme cases, costs may even be increased to the extent of approaching full compensation, or be reduced to zero or be awarded to the side that has formally lost the issue being tried. This flexibility should be used to deal proportionately with, for example:

- - delaying tactics, failure without good cause to meet a deadline, or other unreasonable behaviour, particularly where the other side is put to disproportionate expense;
- - a claim launched without a genuine belief that there is an issue to be tried;
- - seeking an amendment to a statement of case which, if granted, would cause the other side to have to amend its statement or would lead to the filing of further evidence, if the amendment had clearly been avoidable;
- - unreasonable persistence in a course of action that has been indicated in a Preliminary Evaluation to be inappropriate;
- - costs associated with evidence filed in respect of grounds which are not pursued at the substantive hearing (though a party should not be deterred from dropping an issue which, in the light of the evidence filed by the other side, it now realises it cannot win);
- - unreasonable rejection by the party that eventually loses of efforts to settle the dispute before the proceedings were launched or a hearing held;
- - unreasonable refusal by that party to attempt alternative dispute resolution;
- - unnotified failure to attend a hearing;
- - breaches of rules;

and the increase or reduction should be commensurate with the extra expenditure incurred by the other side as the result of such behaviour. It should however be emphasised that merely because a party has lost or has withdrawn from the proceedings does not of itself mean that their behaviour in fighting the case was unreasonable: it only becomes unreasonable if it was fought in a way that incurred unnecessary costs.

- 5.48 Note that in the past, and especially following the decision in Rizla, hearing officers have been reluctant to depart from the scale. However, at the time of Rizla we did not have what the Deputy Judge called an "established yardstick" against which we could assess whether to depart from the scale. We now do effectively have such a yardstick in that through the process of consultation over [TPN 2/2000](#) our users endorsed the principle of awarding off-scale costs in the sort of situations mentioned in the preceding paragraph, not necessarily confined to the criterion of "without reasonable belief that there is an issue to be tried" developed in Rizla.
- 5.49 Cases which give guidance on the factors to be taken into account when deciding whether to award off-scale costs include [Statoil ASA v University of Southampton BL O/268/05](#) and [Stafford Engineering Service Ltd's Application \[2000\] RPC 797](#) (where compensatory costs were awarded, amounting in the former case to £120,000), [ASI Solutions PLC v Nu-Phalt Ltd BL O/154/06](#) (where a number of factors were considered but scale costs were nevertheless awarded), [ADRENALIN Trade Mark Application BL O/040/02](#) (a decision of the Appointed Person, illustrating circumstances where costs might be reduced to zero), and [Portasilo Limited v Manchester Cabins Limited BL O/119/09](#) where the side that won on a preliminary issue was ordered to pay costs to the loser because of unreasonable behaviour in the way it had prosecuted the action. Where hearing officers award off-scale costs, the reasons for doing so should be explained fully in the decision, to give practitioners a clear indication of practice in this respect.
- 5.50 In entitlement proceedings, allegations of dishonesty and of lost opportunity to exploit an invention are commonplace. These circumstances alone do not justify a departure from the scale - see [Du Pont de Nemours and Co \(Rebouillat's\) Applications \[1996\] RPC 740](#).
- 5.51 Scale costs are the usual way of dealing with the expenses of the litigation, but sometimes the hearing officer will be asked to take other expenses into account, eg the expenses incurred by one party in prosecuting a patent application to which they have now been found not to be entitled. The hearing officer has discretion to make a corresponding addition to or offset against scale costs. However, care is needed because the other party will have had no say in the magnitude of the expenses incurred - see, for example, [Du Pont de Nemours and Co \(Rebouillat's\) Applications \[1996\] RPC 740](#).
- 5.51.1 If one of the parties in dispute before the Comptroller has agreed a conditional fee arrangement (CFA) with their legal representative, any "success fee" will not be taken into account when assessing costs. If the normal scale is applied, there will be no uplift to take account of any CFA. Even when off-

scale costs are awarded, the amount will be assessed using the usual principles for assessing off-scale costs, and the amount will not be affected by the existence of a CFA. Because of this, the requirement in [CPR 44.15](#) to provide information about any CFA does not apply in proceedings before the Comptroller. However, parties will need to consider the implications of CPR 44.15 in the event of any subsequent appeal to the courts.

ISSUING DECISIONS

- 5.52 In recent years, patent judges have adopted the practice of giving a draft of their judgment in confidence to counsel 3-7 days before it is formally handed down so they can check for errors and slips. Whilst this is not routinely necessary for decisions of the comptroller, there may be occasions when it is useful to do so, eg to give the parties an opportunity to check that an order or licence drafted by the hearing officer contains no inadvertent pitfalls. It is not intended to be an opportunity for the parties to re-open the arguments - see [Royal Brompton Hospital NHS Trust v Hammond, \[2001\] EWCA Civ 778](#), 76 Con LR 62 and [Gravgaard v Aldridge & Brownlee, \[2004\] EWCA Civ 1529](#), The Times 2 December 2004; however this may be open to some doubt in the light of Pumfrey J's observation in *Navitaire Inc v Easyjet Airline Co Ltd* and another [2005] EWHC 282 (Ch), [\[2006\] RPC 4](#) that a draft gives the parties' advisers an opportunity to satisfy themselves that the court had reached the right conclusion, and should not be wasted by simply using it to correct typographical errors. If the hearing officer wishes to give a draft decision, this should be headed in accordance with the template in Annex B, which follows that used by the courts in accordance with [Practice Direction 40E](#) on reserved judgments. All pages of the draft must be watermarked to distinguish it from the final decision. The template allows a timetable to be set for submission of comments (which should if possible be agreed between the parties), and explains the confidentiality restrictions which will normally be applied. In the final decision, it is permissible if necessary for the hearing officer to state that comments on a draft have been taken into account). In general, once the final decision has been published the draft and any related correspondence should be open to public inspection.
- 5.53 When the decision is ready for issue, unless other arrangements have been made by individual hearing officers, the hearing officer should send the decision and abstract (see 5.58 below) as e-mail attachments to the "decisions & abstracts" mailbox maintained by Litigation Section. The hearings clerk will open the decision document, insert the hearing officer's electronic signature, allocate and apply the next BL number and insert the date. A copy of the signed decision will be placed on the corresponding patent file, by importing an electronic copy if the file is electronic, or by printing out a copy, for a paper file. An unsigned version is sent to the Webmaster for placing, together with the abstract, on the Office's website. The decision must be mailed to the parties on the day it is dated, as any delay would reduce the effective period for appeal. The hearing officer should alert the hearings clerk to any special circumstances, eg any need for confidentiality (see below).

- 5.54 The hearings clerk will mail a copy of the decision to the parties under cover of a letter explaining the appeal procedure. The hearings clerk will also arrange for the decision to be copied to the British Library (where it will be available for inspection) and distributed within the Office.
- 5.55 An order recording the consent of the parties which has been signed by the hearing officer should be sent to the parties and placed in the "decisions" part of the open file. However, it is not otherwise treated like a decision: in particular it is not put on the website, sent to the British Library or circulated around the Office.
- 5.56 When the decision relates to an application which has not been published the hearings clerk will include a clause in the covering letter to the parties giving them a period of 28 days to object, with reasons, to the decision being laid open to public inspection (see the [Litigation Manual](#)). The hearings clerk will inform the hearing officer of any response. If there is no objection the hearings clerk will place the decision on the file and lay it open to public inspection in the normal way. If there is an objection, the hearing officer will need to consider the reasons given, with a view to getting the parties' agreement to laying open an edited version of the decision (eg with the omission of passages identifying the detailed technical subject matter of the application). The full version of the decision should be placed on file to become open to public inspection if and when the patent application is published under [section 16](#).
- 5.56.1 If the hearing officer becomes aware, whether from the parties or otherwise, that the publication of a decision is likely to have any unusual commercial impact, such as an effect on share prices, he or she should if necessary agree with the parties a suitable publication mechanism and should instruct the hearings clerk accordingly. For instance, where share prices are likely to be affected, the decision could be e-mailed to the parties at an agreed time after the stock markets have closed and simultaneously placed on the website.
- 5.57 [Deleted]

Abstracts of decisions

- 5.58 The hearing officer (or assistant) should prepare an abstract of the decision for the website. A template is available for its completion. The abstract should be sent to the "decisions and abstracts" mail box at the same time as the decision, as set out in 5.53 above. The abstract should bring out the main issues of relevance from the decision, and should identify (a) the provisions of law at issue (eg "PA 1977 sections 71(1), 74(7)"), (b) all "keyword" entries appropriate to the case (see below) and (c) any earlier decisions in the same proceedings. A few examples for decisions of varying degrees of complexity are given in Annex C to this chapter, and these show the subject matter fields which are to be used. An entry should be made under each field: if there are no earlier decisions 'None' should be entered under 'Related Decisions' A legal provision should always be entered under 'Provisions Discussed'.

5.59 The keyword entries should contain one or more primary keywords from the list below, which will be used to facilitate electronic searching and for indexing purposes. If appropriate a few words can be added to show in general terms the nature of the matter considered in the decision. See the Annex for examples. If none of the listed keywords is relevant to a particular issue, please let the hearings clerk know and suggest an addition.

Abuse of process	Inventive step
Added subject matter	Inventorship
Alternative Dispute Resolution	Jurisdiction
Amendment	Licences [inc Licence of right and Compulsory licence]
Appeal	Novelty
Assignment	Opinions and Reviews
Burden of proof	Oppositions
Certificate of contested validity	Orders
Claim construction	Offences
Clarity	Other non-compliance
Confidentiality	PCT application
Contract	Pleadings
Correction	Plurality of invention
Costs	Priority date
Cross-examination	Privilege
Crown use	Rectification of irregularities
Decline to deal	Rectification of register
Delay	Reinstatement
Design Right [inc Copyright in Design]	Renewal
Disclosure [formerly Discovery]	Restoration
Divisional application	Revocation
Employees/employment	Scottish law or proceedings
Entitlement	Section 20 period
Estoppel	Stay of proceedings
Evidence	Striking out
Excluded fields (Allowed)	Sufficiency
Excluded fields (Refused)	Summary judgment
Extension for paediatric testing	Supplementary Protection Certificates
Extensions of time	Support
Filing date	Surrender
Human Rights [inc Natural Justice]	Third party observations
Industrial application	Third party terms
Infringement	Withdrawal

CONFIDENTIAL MATERIAL

- 5.60 If the decision refers to confidential material, the full version of the decision should not be published. It should be placed on a part of the file which is not open to public inspection, and a second version of the decision should be produced with the confidential material removed - though no more should be removed than is absolutely necessary. Only the second version should be made available to the public. The hearings clerk will check that the parties are happy with the second version before it is published.
- 5.61 If the decision relates to an unpublished patent application, the hearings clerk will in any case seek the approval of the parties before making the full decision open to public inspection - see 5.56 above.

REPORTING DECISIONS

- 5.62 [Rule 118](#) of the Patents Rules 2007 provides that:

118. The comptroller must make arrangements for the publication of -

(a) reports of cases relating to patents, trade marks, registered designs or design right decided by him; and

(b) reports of cases relating to patents (whether under the Act or otherwise), trade marks, registered designs, copyright and design right decided by any court or body (whether in the United Kingdom or elsewhere).

- 5.63 The comptroller publishes such reports in the Reports of Patent Cases, responsibility for which is contracted out to legal publishers. The Editor has overall responsibility for deciding which cases to report, as well as for putting the decision into a form suitable for publication and writing or commissioning headnotes. However the comptroller can ask for decisions which he considers to be particularly important to be included. Cases relating to intellectual property matters are also published in other series of reports, particularly the Fleet Street Reports, but the comptroller has no responsibility for these.
- 5.64 If a hearing officer feels a case is sufficiently useful or important to be reported, he or she should draw it to the attention of Legal Division, who will liaise with the Editor. Hearing officers other than Divisional Directors should first consult their Divisional Director.
- 5.65 If a case which has already been reported goes to appeal, the outcome of the appeal should also be reported. If a case which was not reported initially goes to appeal, the hearing officer should reassess whether the case ought to be reported once the appeal decision has been given.

CHANGING DECISIONS

5.66 In general, once a formal written or oral decision has been issued it is final so far as proceedings before the comptroller is concerned. Thus the hearing officer cannot change it if he or she has second thoughts or becomes aware of new case law, nor can the hearing officer reopen decided issues in response to further argument or evidence submitted by a party.

5.67 However, in [Interfilta \(UK\) Ltd's Patent \[2003\] RPC 22](#) and following an extensive review of the case law, the hearing officer held that the comptroller had a discretion analogous to the courts to re-open issues after the hearing and even after the issue of a decision. In the light of the overriding objective, the hearing officer laid down the following principles for the exercise of this discretion:

- - there had to be some finality in litigation and the discretion had to be exercised sparingly and only in exceptional circumstances - the fact that the other party could be compensated in costs was not sufficient;
- - a slightly more liberal approach to re-opening issues was possible before rather than after judgment, but the presumption was that the parties had made all their submissions by the end of the hearing;
- - the introduction of new issues after the hearing was subject to the same scrutiny as for new issues before the hearing, with the scales weighted a little more against allowance;
- - where there was a risk that a patent might be found invalid, the public interest in sorting the matter out quickly needed to be considered as well as the private interests of the parties;
- - allegations of a risk of injustice had to be examined to see if they were of substance and the burden lay on the party seeking to re-open the issue to put all the necessary material before the comptroller.

(Where new evidence is sought to be admitted, it will be necessary to consider whether it could with reasonable diligence have been obtained for the hearing, whether it would have an important influence on the case, and whether it is credible - see *Navitaire Inc v Easyjet Airline Co Ltd (No. 2)* [2005] EWHC 282 (Ch), [\[2006\] RPC 4](#)).

5.68 Whilst this would seem to be at variance with the comments of Sedley LJ in the judgment of the Court of Appeal in *Akewushola v Secretary of State for the Home Department* [2000] 1 WLR 2295 at p2301D that:

For my part I do not think that, slips apart, a statutory tribunal - in contrast to a superior court - ordinarily possesses any inherent power to rescind or review its own decisions. Except where the High Court's jurisdiction is unequivocally excluded by privative legislation, it is there that the power of correction resides.

this comment was probably strictly obiter save in the context of the particular tribunal with which the court was dealing (the Immigration Appeal Tribunal). Thus in regard to the powers of magistrates the Court of Appeal in [R](#)

[\(Mathialagan\) v London Borough of Southwark \[2004\] EWCA Civ 1689](#), The Times 21 December 2004, held that there was no general power at common law for magistrates to re-open and re-hear a civil case, but thought it might be open to them to correct a clear mistake by them, going to the basis of the jurisdiction or the fairness of the proceedings, such that the decision would clearly be quashed on judicial review.

5.69 By analogy with the procedures in the courts (see [rule 40.12](#) of the Civil Procedure Rules 1998) and as implicitly approved by the Court of Appeal in *Akewushola* above, the hearing officer may at any time correct an accidental slip or omission in any judgment or order. This may be done either of the hearing officer's own motion or in response to a request from one of the parties. However, if the error is minor and would be readily apparent to the reader who would be unlikely to be misled as to what was intended, no action need normally be taken.

5.70 A court has an inherent power to vary its own orders so as to carry out its own meaning and to make its meaning plain. As Lord Watson said in *Hatten v Harris* [1892] AC 560:

Where an error of that kind has been committed it is always within the competency of the Court, if nothing has intervened which would render it inexpedient or inequitable to do so, to correct the record in order to bring it into harmony with the order which the Judge obviously meant to pronounce. The correction ought to be made on motion, and it is not matter either for appeal or rehearing.

The comptroller probably has the same power in view of the decision of the Appointed Person in [Nettec Solutions Ltd's Trade Mark Application \[2003\] RPC 17](#) (paragraph 15).

5.71 If a hearing officer makes a decision on procedure, that does not debar the comptroller from re-assessing the situation and possibly coming to the opposite conclusion at a later stage if circumstances change. For example, if a hearing officer refuses a request to stay a case and then, at a later stage, related proceedings are launched in the courts, the earlier decision does not stop the hearing officer reconsidering the matter afresh in the light of the new circumstances. In effect, this is a new decision, not an amendment of the previous decision. It would also be permissible to stay a previously-made order pending the hearing of an appeal.

5.72 A decision which is corrected or clarified still bears its original date. There is no formal procedure for making corrections or clarifications - the hearing officer should adopt whatever course seems sensible. For example, in [Tasker v Wilson and Colley BL O/184/00](#) the hearing officer issued an "[Addendum](#)" to the decision.

5.73 Where only one party attended the hearing, the decision of the hearing officer will not be set aside at the instance of the non-attending party (compare [rule](#)

[39.3](#) of the Civil Procedure Rules 1998) if that party made clear before the hearing that it was maintaining its case.

ENFORCING DECISIONS

- 5.74 Although the comptroller can order a party to take certain action (eg pay costs, execute an assignment or grant discovery), he does not have the power or the resources to enforce such orders. In general, therefore, an aggrieved party seeking enforcement of an order must go to the court (see [sections 61\(7\)](#) and [107](#) of the Patents Act 1977 for the enforcement of orders for costs and for damages in infringement proceedings). However, if the default relates to a procedural issue, eg failure to grant discovery, the hearing officer may in practice have an effective sanction in that he or she has the power to reject the case of the defaulting party on the grounds that they have not complied with the order.

ANNEX A TO CHAPTER 5 Examples of Decision Headnotes (see Paragraph 5.06)

<u>EXAMPLE 1</u>	PATENTS ACT 1977	BL O/nnn/04
BETWEEN	(1) British Bulldog Limited (2) John James Hargreaves and Megacorporation plc	5th January 2004 Claimant Defendant
PROCEEDINGS	Reference under sections 8 and 12 of the Patents Act 1977, and application under section 13, in respect of patent application numbers GB 0254321.4 and PCT/GB03/56798	
HEARING OFFICER	A B Williams	
<hr/> DECISION <hr/>		
<u>EXAMPLE 2</u>	PATENTS ACT 1977	BL O/nnn/04
BETWEEN	Minibiz plc and John Henry Johnson	6th January 2004 Claimant Defendant
PROCEEDINGS	Application under section 72 of the Patents Act 1977 to revoke patent number GB 2456789	
HEARING OFFICER	C D Smith	
<hr/> INTERIM DECISION <hr/>		
<u>EXAMPLE 3</u>	COPYRIGHT, DESIGNS AND PATENTS ACT 1988	BL O/nnn/04
BETWEEN	Ann Elizabeth Brown and Crazishapes Company Limited	7th January 2004 Applicant Licensor
PROCEEDINGS	Application under section 247 to settle the terms of a licence of right available under section 237 in respect of design right	
HEARING OFFICER	E F Jones	
<hr/> DECISION <hr/>		
<u>EXAMPLE 4</u>	PATENTS ACT 1977	BL O/nnn/04
(EX PARTE) APPLICANT ISSUE	British Bulldog Limited Whether patent application number GB 0345678.5 complies with section 1(2)	8th January 2004
HEARING OFFICER	A B Williams	
<hr/> DECISION <hr/>		

ANNEX B to CHAPTER 5 Headnote for a draft decision (see paragraph 5.52)

PATENTS ACT 1977

BL O/nnn/07
5th April 2007

BETWEEN

British Bulldog Limited
and
Megacorporation plc

Claimant
Defendant

PROCEEDINGS

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

HEARING OFFICER

A B Williams

UK Intellectual Property Office is an operating name of the Patent Office

DRAFT DECISION

This decision will be issued on 12 May 2006. This draft is being sent to the legal representatives of the parties to enable them correct any obvious errors. It is not an opportunity to re-open argument on the case.

The legal representatives should submit a list of any such errors by 12.00 on 11 May 2006, either by return e-mail or by fax to Litigation Section, Patents Directorate on 01633 814491. This will enable changes to be incorporated into the final decision if the hearing officer accepts them. The list should be copied to the other party and if possible a single list should be agreed between the legal representatives.

The draft is confidential to the legal representatives. However, a copy may be shown in confidence to the parties provided that neither the decision nor its substance is disclosed to any other person or used in the public domain, and no action is taken (other than internally) in response to the draft before the decision is formally issued.

The draft decision and any related correspondence will become open to public inspection once the decision has been formally issued [and the patent application in suit has been published].

1 Decision text

A B Williams

Divisional Director acting for the comptroller

ANNEX C TO CHAPTER 5 Examples of Abstracts (see paragraph 5.58)

Example 1

Concerning rights in US 08/090131; GB 2253948
BL O/001/98 Dated: 08/01/1998 Hearing Officer: Mr P Hayward
Party/Parties: Edenlist Ltd v David Scott and Brian Scott
Keywords: Orders - failure to comply; authorisation to sign assignment document
Related decisions: July 1997 (O/121/97), 15 August 1997 (O/141/97)

Following proceedings under sections 12(1) and 37(1), it had been determined that Edenlist were the rightful owners of both patents. The proprietors had been ordered to execute an assignment of the US patent, but failed to do so. The referrer was authorised to sign an assignment on behalf of the proprietors (Cannings' United States Application [1992] RPC 459 followed).

Example 2

Concerning rights in GB 9509562.6; GB 9609921.3
BL O/021/98 Dated: 12/03/1998 Hearing Officer: Mr S N Dennehey
Party/Parties: Furfix Products Limited v Harold John Andrews
Provisions discussed: PA 1977 section 8
Keywords: Inventorship - contributions of consultant and consultor
Related decisions: Final decision 8 July 1998 (O/143/98)

Interim decision

Mr Andrews was employed by Furfix as a structural engineering consultant. A drawing had been shown in confidence to Mr Andrews for consideration and testing purposes. Mr Andrews subsequently described a modification and indicated that he had applied for a patent, offering to sell the rights for the costs incurred in filing. Furfix declined and instigated proceedings.

Four relevant elements were identified in the inventions (a)-(d). The first drawing from Furfix showed features (a), (c) and (d). The applications in suit included features (b), (c) and (d) (though the claims would cover use of feature (a) instead of feature (b)). Following *William Rose Smith's Patent* [1905] 22 RPC 57, if a person has discovered an improved principle and employs an agent to assist him in carrying out that principle and that agent makes valuable discoveries accessory to the main principle, then the improvements are the property of the inventor of the original improved principle. If the contribution is more than an accessory to the main principle then the agent is the "inventor" of that feature. It was held that Mr Andrews exercised his initiative beyond his brief and unprompted devised the fully open base; this was not merely accessory to the main concept. Consequently Mr Andrews was the owner of feature (b) and Furfix of features (a), (c) and (d).

The earlier application had been treated as withdrawn before publication with the later application claiming priority from it. In respect of the earlier one, a declaration was made of the portions which were invented by Donald Furr. In respect of the later one, an addendum was ordered mentioning Mr Furr as joint inventor. An opportunity was given to the parties to agree the most appropriate course of action, recommending that Furfix accept the original offer. In the event of a failure to agree, it was indicated that the likely order would be for assignment to one party or the other with an irrevocable exclusive licence, with power to sub-license, to be awarded to the other party in respect of items incorporating, or not incorporating as appropriate, feature (b).

Example 3

Concerning rights in GB 2261136
BL O/022/98 Dated: 12/03/1998 Hearing Officer: Mr M C Wright
Party/Parties: Simon Paul Carrington
Provisions discussed: PA 1977 section 28
Keywords: Restoration - reasonable care
Related Decisions None

The applicant for restoration relied on r.39(4) reminder notices to remind him to pay renewal fees. This is in itself acceptable, but it is necessary to show that due care is then taken, either paying the fee immediately, filing the paper where it is certain to receive attention or making some sort of diary note. In the event, the paper was used to record a number of telephone messages and was subsequently lost. The proprietor was held not to have taken due care and the application for restoration was refused.

Example 4

Concerning rights in GB 2125349
BL O/031/98 Dated: 19/03/1998 Hearing Officer: Mr B Westerman
Party/Parties: Roy Hudson v John Michael Worthington
Provisions discussed: PA 1977 section 72
Keywords: Revocation - application withdrawn
Related Decisions None

The applicant for revocation did not wish to pursue the application. The objections raised were considered and no order for revocation was made.

Ex parte HEARINGS

Basic legal principles	6.01-6.08
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Need for evidence	6.09-6.14
Procedure	6.15-3017
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Defining the issues	6.20-6.22
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Choice of written or oral decisions	6.51-6.55
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BASIC LEGAL PRINCIPLES

- 6.01 An ex parte hearing differs from an inter partes hearing in that it continues the administrative procedures of the Office with regard to patents and patent applications under the [Patents Act 1977](#) (hereinafter "the Act"). It is not formally adversarial in nature, since there is only one party to the proceedings, who will normally be the patent applicant or proprietor (hereinafter "the party "). Any Office official who is present is there to assist the hearing officer and the party by presenting the matters in issue and answering any questions that they may have.
- 6.02 Nevertheless, the hearing officer exercises a judicial function in deciding between two conflicting views of the points in issue, and ex parte hearings are just as much a part of the comptroller's tribunal jurisdiction as inter partes hearings. The proceedings will need to be concluded by a formal decision of the hearing officer, whether written or oral, and any such decision is subject to the same right of appeal to the Patents Court as an inter partes decision (see [Chapter 7](#)).
- 6.03 The comptroller has no administrative function in regard to design right under the [Copyright Designs and Patents Act 1988](#). His functions under that Act are confined to the settlement of certain inter partes disputes, and so ex parte hearings on design right are most unlikely to arise.
- 6.04 Insofar as they are relevant and subject to the comments below, the basic legal principles set out in [Chapter 1](#) apply equally to ex parte patent proceedings. However, because there is only one party, the hearing officer has a greater responsibility to ensure that a proper balance is achieved between the rights of the party and the public interest. Although the fact that the hearing officer is an employee of the Office is unlikely of itself to be an indication of bias sufficient to give rise to a breach of Article 6 of the [European Convention on Human Rights](#) (see eg [R \(PD\) v West Midlands and North West Mental Health Review Tribunal \[2004\] EWCA Civ 311](#)), it is nevertheless essential that the hearing officer keeps an open mind on the matters being heard and is seen to do so. On no account should his or her conduct give rise to any suspicion that the matters in issue have effectively been settled between the hearing officer and the case officer so that the Office is merely "going through the motions" at the hearing.
- 6.05 For a pre-grant hearing, the hearing officer should ensure that, during the proceedings which have led to the hearing, the party has been informed of (and has understood) the rights and obligations imposed under the Act, that due account has been taken of any submissions put forward by the party, and that the examiner or other official concerned has applied the provisions of the Act and Rules correctly and has taken account of all relevant precedent cases. Although in many cases the party's interests will be in the hands of a patent attorney or counsel, the hearing officer must satisfy him or herself that all the relevant provisions of the Act have been considered and not rely wholly on the attorney (or counsel) to do so, particularly where issues under the less familiar sections of the Act are involved. If the hearing officer becomes aware

that an alternative approach by the examiner or other official concerned might lead to resolution of a dispute without the need for a formal hearing, he or she should advise accordingly.

- 6.06 On the other hand, the hearing officer must remember that the Act exists to define and limit the rights of applicants and proprietors having regard to the public interest, and that an unduly lenient approach towards the party might detract from the legitimate interests of a potential competitor. For example, where the hearing officer decides to reinstate an application or patent which has been advertised as withdrawn, refused or terminated, he may need to consider whether terms should be imposed to protect the interests of third parties who have used the invention in reliance on the advertisement. (Such protection applies automatically to an order for restoration under [section 28](#) of the Act by virtue of [section 28A](#).)
- 6.07 Although in pre-grant patent proceedings the benefit of any doubt might be resolved in favour of the applicant, this will not necessarily be the case post-grant. If the patentee is allowed to include something through post-grant amendment to which he or she is not entitled or to substantiate a right or claim which is of doubtful validity, the interests of third parties could be unfairly harmed. For example, they may have taken some action which would have been perfectly legitimate given the patent as granted but now ceases to be legitimate. It is worth remembering that whilst the reasons given by the patentee to justify post-grant amendment may well appear to be satisfactory (eg exercising diligence in ensuring that the validity of his patent is not impugned by prior art which has recently come to light), he or she may be contemplating action against a rival.
- 6.08 Thus, in pre-grant proceedings the applicant should be given reasonable latitude in protecting his or her invention, ie the applicant should be allowed to do something unless there is good reason to the contrary. The onus post-grant is on the proprietor to establish that there is a deficiency that he or she is entitled to correct and that the action proposed is reasonable. Alternatively, if the proprietor wishes the comptroller to grant relief or a right, eg in restoration proceedings, he or she must establish an entitlement to that relief or right and that it is reasonable to give it. A proprietor may therefore need to provide evidence of a higher standard in support of his or her case in post-grant proceedings.

EVIDENCE

Need for evidence

- 6.09 In most ex parte proceedings no evidence is required, although evidence and explanation, and not just argument, may be necessary where the comptroller is being asked to exercise discretion - see [Coal Industry \(Patents\) Ltd's Patent \[1994\] RPC 661](#). Evidence from an Office official (who must be able to speak from his own knowledge of the matter) may also be required in certain circumstances.

- 6.10 Express provision is made for evidence to be filed in the following ex parte patent proceedings:
- - request for permission to make a late declaration of priority under [rule 7](#) of the Patents Rules 2007;
 - - request for reinstatement of application under [section 20A](#) of the Patents Act 1977 governed by [rule 32](#)
 - - application for the restoration of a lapsed patent under [rule 40](#);
 - - request for correction of an error in the register under [rule 50](#);
 - - request for information where [section 118\(4\)](#) applies under [rule 52](#);
 - - request for extension of time under [rule 108](#).
- 6.11 Also, under [rule 47](#) the comptroller may require evidence to prove the existence of a transaction to be registered, and under [rule 49](#) he may require evidence to prove an alteration of name or address.
- 6.12 The comptroller also has a general power under [rules 82](#) and [87](#) to direct that evidence should be furnished in such form, manner and within such periods as may be required. In practice, the hearing officer should not normally require evidence to be filed in ex parte proceedings. However, where he is of the view that a particular fact needs to be proved, the party to the proceedings may be allowed a period in which to file evidence (see for example Darenth Vending Services Limited's Patent BL 0/46/94).
- 6.13 Although it is not usually necessary in proceedings arising out of the substantive examination of patent applications under [section 18](#) of the Act, an applicant may occasionally wish to file evidence, eg to establish that an invention does involve an inventive step. In such cases, evidence should be directed to proving facts which are in dispute, rather than giving the opinion of the applicant or a witness on the question which the hearing officer has to decide. The boundary may not always be clear-cut, particularly in the case of expert evidence (see [Chapter 3](#)).
- 6.14 Where observations on patentability are made under [section 21](#) of the Act, the substantive examiner may ask the informant to file supporting evidence in appropriate cases - see Manual of Patent Practice (MoPP) [21.13](#).

Procedure

- 6.15 Subject to any statutory provision, the requirements as to the form and content of evidence in ex parte proceedings are the same as for inter partes proceedings (see [Chapter 3](#) above, and [rules 82](#) and [87](#) of the Patents Rules 2007). The evidence will usually be by witness statement. Exceptionally, however, the hearing officer may allow oral evidence to be given, and the person giving the evidence should then take an oath or affirm ([Chapter 4](#)).
- 6.16 Any evidence to be filed should be available for the hearing, but if it is produced for the first time at the hearing, the hearing officer may need to adjourn the proceedings to allow time for him or her to consider it. If evidence is not produced at the hearing, it is unlikely to be allowed on appeal ([Wistar](#)

[Institute's Application \[1983\] RPC 255](#)). In appropriate cases, the hearing officer may instruct the hearings clerk when appointing the hearing to advise the applicant accordingly (eg using letter clause ELC12).

- 6.17 Since the proceedings are not adversarial, anyone giving evidence in ex parte proceedings, whether written or oral, is not subject to formal examination and cross-examination. See further below under "Conduct of hearing".

BURDEN OF PROOF

- 6.18 In ex parte proceedings, the onus is on the party being heard to establish his case before the comptroller. Thus, where a party is seeking relief under [rule 107\(3\)](#) of the Patents Rules 2007, the onus is on that party to establish that there has been an irregularity or prospective irregularity which is attributable wholly or in part to an error, default or omission on the part of the Office where this is not admitted by the Office. Similarly, where relief is sought under [rule 111](#), the onus is on the party to establish that the failure to file a document or the like was wholly or mainly attributable to a failure or undue delay in the postal services in the United Kingdom.

- 6.19 As regards objections arising from the substantive examination of patent applications, the approach to be adopted is that where a prima facie case is made out by the examiner, the onus is on the applicant to refute it by argument or evidence. However, where after considering the matter in the light of the arguments and any evidence adduced, the hearing officer finds that there is genuine doubt, it may be appropriate to resolve it in favour of the applicant. [Macrossan's Application \[2006\] EWHC 705 \(Ch\)](#) however established that there is no general rule of giving the benefit of the doubt to the applicant where excluded matter is at issue.

- 6.19.1 Floyd J took this consideration a step further in [Blacklight Power Inc. v The Comptroller- General of Patents](#) [2008] EWHC 2763 (Pat) where he explained how the standard of proof should be applied where there was substantial doubt as to the validity of a scientific theory upon which an invention was based. He said in paragraph 34 that:

It is not the law that any doubt, however small, on an issue of fact would force the Comptroller to allow the application to proceed to grant. Rather he should examine the material before him and attempt to come to a conclusion on the balance of probabilities. If he considers that there is a substantial doubt about an issue of fact which could lead to patentability at that stage, he should consider whether there is a reasonable prospect that matters will turn out differently if the matter is fully investigated at a trial. If so he should allow the application to proceed.

DEFINING THE ISSUES

- 6.20 With applications for restoration of a patent under [section 28](#) of the 1977 Act, unopposed applications under [sections 27](#), [48-51](#) and [117](#) and withdrawn applications for revocation under [section 72](#), the matter to be determined is

set out in the documents accompanying the application. Accordingly there is normally no doubt as to either the party to the proceedings or the issues to be decided. If there is any doubt, Litigation Section should be asked to write to the party to clarify the position.

- 6.21 In other cases, particularly where a hearing is appointed to determine an objection raised on a pending patent application by a formalities examiner or patent examiner, the matter(s) in issue will normally be apparent by reference to the correspondence on the file and relating to the objection. However, in all cases the party concerned should be fully informed, in an official letter prior to the hearing, of the Office's objections.
- 6.22 If a new issue arises either before, during or after a hearing, the hearing officer must give the party concerned adequate opportunity to make submissions in the matter even if this means adjourning the hearing. Under no circumstances should the hearing officer decide a matter on which the party concerned has had no opportunity of being heard or on the basis of arguments which were not raised at the hearing.

APPOINTMENT OF HEARING OFFICER

- 6.23 In the case of a hearing on an objection raised by the search examiner or substantive examiner in respect of a patent application pre-grant, the hearings clerk will normally allocate the case to a Deputy Director to take the hearing. Cases are allocated on a rota basis, having regard to work loadings and to particular subject-matter needs. (Where the Deputy Director is absent and a senior patent examiner is substituting, the substitute is empowered to act as a hearing officer.)
- 6.24 Where the name of a Deputy Director has appeared in correspondence (other than in his/her capacity as hearing officer) or the Deputy Director has discussed the case with the applicant by telephone or at an interview, then the hearings clerk should be asked to select another Deputy Director as hearing officer.
- 6.25 Ex parte hearings on proceedings under the Act in respect of granted patents, in particular on proceedings under [section 73](#), on unopposed requests for amendment under [section 27](#) and on unopposed requests for correction under [section 117](#), will normally be taken by the Deputy Director whose group currently handles the relevant subject matter.
- 6.26 Ex parte hearings on formalities matters and PCT applications are normally taken in Patents Directorate Legal Section by a Deputy Director, Assistant Director or grade C2 officer, as appropriate. However, where the hearing involves both a formalities objection and a substantive examination objection on a patent application, the hearing may be taken by the Deputy Director where this is more convenient.

- 6.27 Hearings on applications for restoration under [section 28](#) are normally taken by the Assistant Director or grade C2 officer in Patents Directorate Legal Section.
- 6.28 The officer who has been dealing with the case - or, if they are relatively junior, their senior officer - should attend and be prepared to explain the objections which have led to the hearing. Where the internal procedures of the Office are relevant to the matter(s) in issue, the officer should be ready to explain them. Whilst the case officer should always be present, the hearing officer may in addition appoint a grade C2 officer as an assistant where this would be a useful development opportunity and an efficient use of resources. Other officers may also be allowed to attend ex parte hearings for training purposes.

OFFERING AND ARRANGING THE HEARING

- 6.29 In general, a junior officer who has been dealing with the case should only offer a hearing with the prior approval of a senior officer (see eg [Manual of Patent Practice 18.79](#)). A senior patent examiner does not require such approval, though he/she should inform the group Deputy Director before doing so.
- 6.30 If in response to the offer the patent applicant or proprietor does not wish to be heard, is content to leave the matter to the comptroller, or makes no reply, no hearing need be appointed but a formal decision based on the papers on file will still be necessary to resolve the issues outstanding. If the party is offered an opportunity to file submissions, he should be given reasonable notice, say at least 14 days, of the date by which submissions should be filed, and on or after which the hearing officer will consider the matter.
- 6.31 If a hearing is to be held, the officer who has been dealing with the case should address the case to the hearings clerk with a minuted request that a hearing be appointed. The hearings clerk then arranges the hearing in consultation with the hearing officer and the applicant or proprietor.
- 6.32 Where a hearing is needed to decide a matter raised in the examiner's report under [section 18\(3\)](#) or the acceptability of a late response thereto (see [Manual of Patent Practice 18.59-60](#)), and less than two months of the unextended [rule 30](#) period (for putting the application in order) remain, the hearings clerk should be instructed to arrange the hearing as soon as possible. Appropriate notice should be given, as provided by [rule 80\(5\)](#) in view of the urgency of the case. It is in the applicant's interest that any hearing is held and the decision issued before the expiry of the [rule 30](#) period (including any extension under [rule 108](#)) to maintain the possibility of amendment within the extended [section 20\(2\)](#) period following an adverse finding (cf MoPP 20.06 and 20.08).
- 6.33 Once the date for the hearing has been fixed the officer who has been dealing with the case should, if he or she has not already done so, write to the applicant or proprietor making clear what are the issues to be decided at the

hearing and forewarning of any precedent cases to be referred to, so long as these have been published. To avoid any impression of bias or procedural unfairness, the practice of preparing a report for the hearing officer giving an opinion on the matters to be decided has been discontinued, in the light of the observations in [Macrossan's Application \[2006\] EWHC 705 \(Pat\)](#) at paragraphs 15 - 19 (although the court did not think that such a report, or the holding of internal discussions, was necessarily unfair). Consequently the letter from the case officer should raise all the outstanding issues in sufficient detail for the hearing officer fully to appreciate what is in contention, what needs to be decided and any consequential matters, for example if the decision is to refer the application back to the examiner for further processing. [MoPP 18.79.1](#) refers.

6.34 Normally, the hearing will be held in a suitable room on Office premises, usually in Newport and sometimes in the hearing officer's room, although the hearing may be held by telephone or video conference if those attending are content to do so (see [Chapter 4](#)). It is not usually necessary for the room to be laid out as a court room. The hearing officer and any other officials should assemble in the room beforehand. The hearings clerk will meet the other persons attending and direct them to the room at the appropriate time.

6.35 It is normal for a shorthand writer to be present for the hearing although the hearing officer may on occasion decide otherwise. The hearings clerk will make the necessary arrangements. As an alternative, the hearing officer may make an electronic recording and minute proceedings himself as explained in paragraph 4.104 above. A shorthand writer should always be present where:

- - the arguments are likely to be complex;
- - counsel are representing the party;
- - oral evidence is likely to be taken;
- - an oral reasoned decision is likely to be given;
- - the decision is likely to set a procedural precedent; or
- - there is a possibility that disagreement or misunderstanding could arise as to what had taken place.

6.36 Normally, the question of admitting the public to ex parte hearings does not arise. However, like inter partes hearings, they are governed in this respect by [rule 84](#) of the Patents Rules 2007 and the hearing officer should follow the established practice in respect of inter partes hearings, namely that, except where the proceedings relate to an application for a patent which has not been published under [section 16](#), the hearing will normally be open to the public. The same considerations then apply as in inter partes proceedings as described in [Chapter 4](#).

CONDUCT OF HEARING

6.37 Since there are no pleadings at an ex parte hearing to define the issues, the hearing officer is free to adopt a fairly informal procedure in order to elucidate and adjudicate upon the differences between the officer who has been dealing

with the case and the party being heard. It should though always be borne in mind that it is the party or his representative who is being heard.

- 6.38 With this in mind, the hearing officer should always invite the party or his representative to open. Where counsel is appearing it is customary for him or her to open and have the last word. Where, as occasionally happens, the officer is asked by the party or his representative to open it is important that the officer is prepared to present the issues so that the hearing officer is fully appraised of what needs to be decided.
- 6.39 There are no formal adversarial procedures at an ex parte hearing and argument and counter-argument will therefore tend to merge to a greater extent than in inter partes proceedings. However, initially the hearing officer should hear what both the party and the case officer have to say, in whatever order is decided, so that a picture is built up of the arguments that have led to the need for a hearing. Thereafter, the hearing officer must assume the responsibility for questioning the applicant or his representative and witnesses, if any, but may involve the officer in the argument especially if amendments have been suggested in an attempt to overcome the officer's objections.
- 6.40 It is perfectly reasonable for the hearing officer to make proposals or suggest amendments where these are considered to advance the proceedings. However, this must be done in a way that does not suggest that the officer who has been dealing with the case is being favoured or that the issues have been prejudged.
- 6.41 At the end of the hearing the hearing officer should satisfy himself or herself that all the issues have been considered, and should confirm that neither the party nor the case officer have any further points to raise before drawing the hearing to a close.
- 6.42 It is not usual for an ex parte hearing to be adjourned but the hearing officer may decide that it is necessary for example in the following circumstances:
- - where the party's representative needs to seek further instruction;
 - - where either the hearing officer or the party and/or his representative need to consider proposed amendments;
 - - where either the hearing officer or the party need to consider issues, argument or evidence arising for the first time at the hearing;
 - - where the hearing officer needs to prepare an oral decision.
- 6.43 The hearing officer should always give directions as to when an adjourned hearing should be resumed after hearing the views of the party or his representative and, if necessary, the officer who has been dealing with the case.

GIVING AND ISSUING DECISIONS

6.44 The procedures for giving, issuing, abstracting and reporting decisions, whether written or oral, final or interim, are essentially the same as for inter partes decisions, except that only one party is present. Generally, therefore, the guidance in [Chapter 5](#) should be followed for ex parte decisions. (The examples of decision headnotes and abstracts in the Annexes to Chapter 5 include both inter partes and ex parte decisions.)

6.44.1 However, it will be often be efficient for ex parte decisions to adopt a simpler style. Thus:

- - whilst the issues at stake in the hearing must be mentioned, there is no need to detail all the steps of the prosecution history where this is not relevant
- - all arguments on a single issue should be dealt with together to avoid unnecessary repetition
- - where evidence is present there is no need to list and summarise it formally if the hearing officer accepts the submissions (but the reasons for not accepting evidence must be made clear)
- - where the same arguments (whether on similar facts or on points of law) have been rejected with clear reasoning in an earlier decision, it is acceptable simply to refer to the earlier decision
- - a single decision may cover more than one case form the same applicant or proprietor if this would be more efficient than separate decisions
- - there is no need to provide detailed arguments in decisions on why perpetual motion machines cannot work.

Some things however cannot be left out. It is necessary to discuss the relevant legal provisions, and in restoration cases to mention the key events. Generally in patentability cases, one main claim should be recited (but not necessarily similar independent claims); but even this may not be necessary when the hearing officer refuses an application as non-patentable and considers the entire contents of the specification

6.45 For both written and oral decisions, the hearing officer should always give reasons for his or her decision, as required by [rule 80\(6\)](#), which applies to ex parte as well as inter partes proceedings by virtue of [Part 4 of Schedule 3](#) to the Patents Rules 2007. However, where the decision is favourable it will not normally be necessary to set out the arguments in great detail - an outline may well suffice. In either case, as explained in [South Bucks District Council v Porter \(No 2\) \[2004\] UKHL 33](#), [2004] 1 WLR 1953 (a planning decision, also discussed at [Chapter 1](#) above under "Human Rights"), the reasons can be briefly stated so long as they are adequate and intelligible, the degree of particularity depending entirely on the nature of the issues falling for decision. For an example of where abbreviated reasoning may be permissible, see the [Practice Notice of 24 November 2004](#) "Patent applications relating to methods of doing business".

- 6.46 The hearing officer must not decide formally any matter which has not been put in issue, or make any finding on the basis of grounds, arguments, information or precedents which were not put to the party beforehand. Particular care should be taken where the decision is being reached on the papers because the party does not wish to attend the hearing. The party must be given an opportunity to make submissions on any new ground, argument, information or precedent before the decision is made, and if they arise for the first time during the hearing it should be adjourned if necessary.
- 6.47 Thus, in pre-grant ex parte proceedings it is not open to the hearing officer formally to find that a patent application is in order for grant subject to amendments which were not discussed at the hearing. If the hearing officer finds that the application is not in order, he or she should consider whether to refuse the application outright (where no saving amendment appears possible, as often occurs, eg, in decisions on patentability under [section 1\(2\)](#) of the Act), or whether to allow an opportunity to submit amendments. In the latter event, it is not usually necessary to give an initial interim decision, since there are no opposing or third party interests to consider, unless there are other circumstances which make it desirable to do so. If an interim decision is given, the hearing officer will need to give a final decision in due course to terminate the proceedings.
- 6.48 An interim decision may be necessary in post-grant ex parte proceedings where amendments are to be advertised, eg hearings on amendments under [section 27](#) of the Act where the examiner and the proprietor are unable to agree on the allowability of the amendments - see MoPP 27.17.
- 6.49 It is the Office's practice not to award costs in ex parte proceedings.
- 6.50 Exceptionally the hearing officer may defer issuing a decision after the hearing, eg pending a decision of the court or the European Patent Office on the application or patent in suit. The hearing officer should only do this where there exist very good reasons which justify such deferment in preference to an immediate decision and after taking full account of the views of the party concerned. It is generally preferable to avoid this situation arising in the first place, by staying or adjourning the proceedings until after the event which would necessitate deferment.
- 6.50.1 When the decision relates to an application which has not been published the hearings clerk will include a clause in the covering letter to the parties giving them a period of 28 days to object, with reasons, to the decision being laid open to public inspection (see the [Litigation Manual](#)). The hearings clerk will inform the hearing officer of any response. If there is no objection the hearings clerk will place the decision on the file and lay it open to public inspection in the normal way. If there is an objection, the hearing officer will need to consider the reasons given, with a view to getting the parties' agreement to laying open an edited version of the decision (eg with the omission of passages identifying the detailed technical subject matter of the application). The full version of the decision should be placed on file to become open to

public inspection if and when the patent application is published under [section 16](#).

Choice of written or oral decision

6.51 Whilst it will in many cases be preferable for the hearing officer to issue a written decision, in order to expedite proceedings the hearing officer should always consider whether the case is suitable for an oral decision. This may be appropriate, eg

- - where the issues are simple and require only a short decision;
- - where the decision is in favour of the party and the arguments and reasons need not be set out in detail (see above);
- - where the hearing officer upholds an objection but decides that it is met by amendments offered by the applicant;
- - where the arguments are simple and the hearing officer can quickly and fairly reach a view on them; or
- - where there is little likelihood of being overturned on appeal.

6.52 Where the matter is urgent (eg for an ex parte hearing held very close to the end of the period specified in [rule 30](#) of the Patents Rules 2007 for putting the application in order for grant) an oral decision may be necessary simply because there is not time to issue a written decision without disadvantaging the party to the proceedings. The oral decision may be given initially without reasons if necessary, but it should be followed by a written statement of reasons (see [Chapter 5](#) above) before the [rule 30](#) period expires.

6.53 However, the hearing officer should always bear in mind that the [rule 30](#) period may be extended under [rule 108](#) and is automatically extended under [section 20\(2\)](#) to allow for an appeal provided the decision (or written statement of reasons following an unreasoned oral decision) is issued before the expiry of the [rule 30](#) period (see MoPP 20.08 - 20.10).

6.54 Where an oral decision was given but no shorthand writer was present, then it should be followed by a written confirmation of the decision and any reasons for it. The written confirmation should make clear any conditions which need to be satisfied before the processing of the application or patent may continue, and should identify in full any amendments which were agreed at the hearing.

6.55 Where the hearing officer does not give an oral decision at the hearing, he or she should tell the party at the hearing that the decision will be reserved and given in writing. Preferably the hearing officer should also indicate when the decision can be expected, particularly where the party is not represented and/or time is short.

Preparing written decisions

6.56 When preparing a written decision, the general considerations in [Chapter 5](#) apply to its layout, including the provision of a headnote (see the example in

Annex A to Chapter 5). For many ex parte decisions, particularly where the hearing arises out of the examination of a patent application, it will be preferable to specify "issue" rather than "proceedings" in the headnote.

- 6.57 The considerations in [Chapter 5](#) also apply to subheadings. For ex parte decisions it may be helpful to distinguish introductory and background matters, including any facts not in issue; the law applicable; the Office's prima facie view; the party's arguments; the assessment of the arguments; the conclusions; and the appeal provisions.

PROCEDURE AFTER ISSUE OF DECISION

- 6.58 Once any appeal period in the decision has expired without an appeal being brought, the hearings clerk will, subject to any instructions from the hearing officer, forward the file of the application or patent for the next appropriate action to be taken by the Office.
- 6.59 If a decision refuses to allow an application to proceed to grant as it stands but specifies a period within which amendments, agreed or otherwise at the hearing, may be filed, then if the amendments are filed the officer who is dealing with the case must report on them to the hearing officer who gave the decision. It is for the hearing officer, not the case officer, to determine whether amendments arising from the proceedings are acceptable. The hearing officer will either confirm that the amendments are adequate or will authorise the issue of a report setting out objections to them. (Such a report may deal with other outstanding matters, but these should be set out separately.) When the hearing officer is content that the matters arising from the decision have been satisfactorily dealt with, he or she should minute the file accordingly, and, if the initial decision was an interim one, should issue a final decision terminating the proceedings. The file may then be forwarded for the next action. If amendments cannot be agreed to the satisfaction of the hearing officer, or if no amendments are filed, then the application is treated at the end of the [section 20](#) period as having been refused in accordance with [section 20\(1\)](#).
- 6.60 If a decision refuses an application outright or directs that it should be treated as withdrawn, or if the application is treated as refused under [section 20\(1\)](#) in accordance with the above paragraph, then after the expiry of the period in which an appeal may be brought, the application should be advertised as terminated.

CHANGING DECISIONS

- 6.61 The position is essentially the same as in the case of inter partes proceedings (see [Chapter 5](#)). Thus a decision of the comptroller is normally final and can only be reversed on appeal, although it may exceptionally be possible to rescind or revise a decision in accordance with the principles established in [Interfilta \(UK\) Ltd's Patent \[2003\] RPC 22](#) (see [Chapter 5](#)). A decision to do so should only be taken after discussion with a Divisional Director.

6.62 There have been a number of cases in the past in which a decision has been rescinded or reviewed because of administrative error in the Office, eg:

1. In Albright & Wilson Limited's Patent BL O/46/95, the hearing officer's decision on the papers under [section 73\(2\)](#) was rescinded because it was made without taking notice of documents which had been filed before the date of the decision but had not been brought before the hearing officer.
2. A decision to refuse an application was rescinded because the hearing officer was unaware of a telephone call from the applicant which had not been recorded on the file, the call indicating that the applicant wanted, contrary to the situation apparent from the file, to continue with the application.
3. In a case in which the hearing officer decided only on the allowability of amended claims offered at the hearing on his understanding that the applicant did not wish to maintain the original claims, the hearing officer subsequently issued a supplementary decision on the applicant's submission that this understanding was incorrect and the amendments were conditional on an adverse finding on the original claims.
4. A decision taken by an officer not empowered to act was rescinded on the grounds that it was not a properly taken decision.

Although the position cannot be regarded as settled, it would seem from the Interfilta principles that a decision could still be rescinded or revised where there has been an irregularity in procedure in or before the Office under [rule 107](#). However it will be necessary to consider all the circumstances of a case, particularly whether there has been acquiescence or delay by the party, and whether the party can show that there is a substantial risk of injustice if the original decision is allowed to stand.

APPEALS

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RIGHT TO APPEAL

7.01 As explained in [Chapter 5](#), almost all decisions of the comptroller in respect of patents and design right are subject to appeal. Under [section 97\(1\)](#) of the Patents Act 1977 and the Patents Rules 2007, however, the following are expressly excluded from the right to appeal:

- - adequacy and reframing of the abstract under [section 14\(7\)](#);
- - omission of matter from a specification under [section 16\(2\)](#);
- - directions in respect of security and safety under [section 22\(1\) or \(2\)](#);
- - decisions under [rule 106](#) (remission of fees)
- - decisions under [rule 88](#) (proceedings in Scotland)
- - decisions under [rule 100](#) to set an opinion aside

7.02 Appeals from decisions in respect of patents and of those design right matters referred to the comptroller under [section 246\(1\)](#) of the Copyright, Designs and Patents Act 1988 lie to the court, whilst appeals from decisions under [sections 247](#) and [248](#) of the 1988 Act on the settlement of the terms of a design right licence of right lie to the designs Appeal Tribunal - see [section 97\(1\)](#) of the Patents Act 1977 and [sections 249](#) and [251\(4\)](#) of the 1988 Act. This chapter is concerned mainly with the principles and procedures governing appeals to the court. Where they differ, those relating to appeals to the Tribunal are explained further below under "Appeals to the Designs Appeal Tribunal".

7.03 Following the entry into force of [Part 63](#) of the Civil Procedure Rules 1998 on 1 April 2003, patent appeals go to the Patents Court and design right appeals to the court go to the Chancery Division in accordance with [rule 63.17](#). In both cases appeals are governed by the general procedural rules for appeals in [Part 52](#) of the Civil Procedure Rules and its associated [Practice Direction 52](#). The provisions are explained in [Tribunal Practice Notice 1/2003](#) (Revised) [\[2003\] RPC 46](#).

7.04 Any decision of the comptroller for which there is no formal appeal route is still open to judicial review - see below.

NATURE OF THE APPEAL

7.05 Generally, under [rule 52.11](#) of the Civil Procedure Rules 1998, the appeal is limited to a review of the comptroller's decision (unless the court considers that in the circumstances of an individual appeal it would be in the interests of justice to hold a re-hearing) and the court will not receive oral evidence or evidence that was not before the comptroller. Explaining the nature of a review under rule 52.11, the Court of Appeal in REEF Trade Mark [2002] EWCA Civ 763, [\[2003\] RPC 5](#) confirmed that findings of primary fact would not be disturbed unless the hearing officer made an error of principle or was plainly wrong on the evidence: the factors to be considered included the nature of the evaluation required, the standing and experience of the fact-finding tribunal and the extent to which it had been necessary to assess oral evidence. As stated by Robert Walker LJ, where no oral evidence had been heard, the court should show "a real reluctance but not the very highest

degree of reluctance to interfere in the absence of a distinct and material error of principle". In the patents case Hartington Conway Ltd's Patent Applications [2003] EWHC 1872 (Ch), [\[2004\] RPC 7](#) Pumfrey J, following REEF, considered that it would be necessary to produce a compelling case for revisiting findings of fact made by the lower tribunal. It would also seem necessary following the Court of Appeal's decision in Merck & Co Inc's Patents [2004] EWCA Civ 1545, [2004] FSR 16 that a ground of appeal that the hearing officer erred "in principle" should actually identify the principle and not be used simply to mask a complaint about the assessment of evidence by the hearing officer.

- 7.06 The above reasoning applies to reviews of opinions, as was confirmed by Kitchen J in DLP Limited [\[2007\] EWHC 2669 \(Pat\)](#), and would seem to apply to appeals from ex parte as well as inter partes decisions - see Dyson Ltd's Trade Mark Application [\[2003\] EWHC 1062 \(Ch\)](#), [\[2003\] RPC 47](#), where Patten J held that Article 6 of the European Convention on Human Rights did not compel the court to conduct a re-hearing in such a case.
- 7.07 In accordance with [rule 52.10](#) of the Civil Procedure Rules, the court can exercise any power that could have been exercised by the comptroller. For patents, this applies in any case by virtue of [section 99](#) of the Patents Act 1977.

PERIOD FOR APPEAL AND EXTENSION THEREOF

- 7.08 Since an appeal to the court from a decision of the comptroller on patents or design right constitutes a "statutory appeal" within the meaning of [paragraph 17.1](#) of Practice Direction 52, the period for the appellant to file his notice of appeal with the court is 28 days. In accordance with [paragraphs 17.3 and 17.4](#), this period runs from the date of the decision or, where a statement of reasons is given later than notice of the decision, from the date on which the statement is received by the appellant. The comptroller would appear to have no power either to extend or to shorten this period: any application to vary the period should be made to the court under [rule 52.6\(1\)](#) of the Civil Procedure Rules and [paragraphs 5.2 and 5.3](#) of Practice Direction 52 and should be lodged with the Chancery Clerk of the Lists. The parties cannot themselves extend the period by agreement. In inter partes proceedings, the respondent may also file a notice and must do so where he wants the court to uphold the decision of the comptroller for different or additional reasons. Unlike the appellant's notice, the period for filing is not governed by Practice Direction 52, and so the comptroller would appear to have the seemingly anomalous power to direct the period under [rule 52.5\(4\)](#) for filing the respondent's notice (see *Smith International Inc v Specialised Petroleum Services Group Ltd* [BL O/009/05](#)).
- 7.09 This differs from the procedures under the superseded Practice Direction 49E, where the appeal period depended on whether or not the decision was on a matter of procedure and could be extended by the comptroller at the request of a party. However, similar provisions still govern appeals to the designs

Appeal Tribunal and appeals to the Court of Session in Scotland - see below, and also [Chapter 8](#).

OFFICE PROCEDURE

- 7.10 The appellant and (if filing a notice) the respondent must each serve a copy of their respective notices on the comptroller as soon as practicable and in any event not later than 7 days after it is filed with the court - see rules [52.4\(3\)](#), [52.5\(6\)](#) and [63.17\(3\)](#) of the Civil Procedure Rules 1998 and [paragraph 17.5](#) of Practice Direction 52. When an appeal is lodged, the hearings clerk will send the file to the hearing officer and his or her assistant for information and comment, and will send an electronic copy of the decision to the court.
- 7.11 In ex parte cases where the appellant requests a hearing on the papers, the hearing officer should consider whether, if the matters are straightforward, to accede to the request, or whether in more complex cases it would assist the court for the comptroller to be represented. In such cases, the comptroller should be represented by counsel (normally a junior barrister specifically appointed as Comptroller's Counsel), instructed by the Treasury Solicitor. The hearings clerk will make the necessary arrangements for instructing counsel.
- 7.12 The notice of appeal will go first to the Divisional Director, head of patent litigation. He or she will decide who should take the lead in handling the appeal. This may be a particular Deputy Director who is responsible for the subject matter and is familiar with previous appeals and with counsel's past experience. The original hearing officer will be kept fully informed and may assist. Once the hearings clerk has been given the date on which the appeal will be heard, the lead hearing officer should prepare an explanatory brief for counsel, if appropriate arranging for the original hearing officer to assist or take a major role in its preparation. A suggested format is shown in the Annex to this chapter. It should include the warning that the appeal must not be held in open court where an application is not open to public inspection. If the hearing officer thinks that the original decision is sufficient for this purpose, the brief should merely state that there is nothing to add to the decision. However, a fuller brief should be prepared when it is desirable to emphasise or elaborate on some point in the decision or to indicate some matter on which it is felt that a stand should be taken. It can be assumed that counsel will not depart from the line indicated by the decision and brief, although a change of approach may become necessary because of a point raised during the course of the court hearing. On a particularly tricky or important issue, either the hearing officer or counsel may request a briefing meeting.
- 7.13 If the issue at stake is a particularly important one on which a number of other cases depend, Treasury Solicitors should be asked (via the hearings clerk) to approach the court and seek to have the appeal speeded up.
- 7.14 Normally, the comptroller is not represented on appeal in inter partes proceedings. However where he has an interest, or a point of law is at stake which affects his jurisdiction, it may be appropriate. In [Goddin and Rennie's Application \[1996\] RPC 141](#) the comptroller was represented solely to resist a

claim by one party for an award of costs against the comptroller. In *Luxim Corp v Ceravision Ltd* [\[2007\] EWHC 1624 \(Ch\)](#), [\[2007\] RPC 33](#), the comptroller was represented at an appeal concerning the circumstances in which he should decline to deal with entitlement references, and in [Yeda Research and Development Company Limited v Rhone-Poulenc Rorer International Holdings Inc and others](#) [\[2007\] UKHL 43](#) the comptroller intervened in the House of Lords hearing since this case concerned a) whether a claim to entitlement must necessarily rest on a breach of some other rule of law and b) the extent of the comptroller's powers to allow amendment of pleadings.

- 7.15 The hearing officer should not attend the appeal hearing. However, he or she should always arrange for someone from the Office (eg the hearing officer's assistant) to attend the appeal hearing for an ex parte case, and will usually do this for a inter partes case too.
- 7.16 After the appeal decision has been handed down, the hearings clerk will circulate the case to the hearing officer and others for information. The hearing officer should recommend whether the case should be reported and make sure that any necessary further action is taken. For example, if the Office decision called for amendments to be made to a patent specification and the appeal was dismissed, the hearing officer may now need to make further directions to ensure the amendments are made.

RECOVERY OF COMPTROLLER'S COSTS

- 7.17 It is the normal practice for the comptroller to ask for costs where an appeal on ex parte proceedings is dismissed. It is open to the comptroller not to press for an award of costs to be paid where the party is likely to suffer some form of hardship if a costs award is made against them; where a significant point of general legal interest is involved; if it appears that the likelihood of recovering costs is negligible or if the expense of recovery is likely to outweigh the amount of the award. Any decision not to press for an award, or not to pursue recovery of an award that has been made, should be made in conjunction with Finance Directorate.
- 7.18 When costs are awarded to the comptroller, the hearing officer or hearing clerk should notify both the Finance Directorate and the officer in Litigation Section responsible for authorising payments to the Treasury Solicitor so that the recovery of the debt can be monitored. (A record of who has been notified should be made on the case file to avoid inadvertent multiple notifications.)
- 7.19 Costs may be awarded against the comptroller where an appeal against an ex parte decision is upheld ([Associated British Combustion Ltd's Application](#) [\[1978\] RPC 581](#); [Omron Tateisi Electronics Co's Application](#) [\[1981\] RPC 125](#)).
- 7.20 For an appeal against an inter partes decision, it is not appropriate for the comptroller to seek an award of costs on appeal even if he is represented as amicus curiae, since he is not party to the proceedings. For the same reason,

any claim for an award of costs should be resisted, as was successfully done in [Goddin and Rennie's Application \[1996\] RPC 141](#).

FURTHER APPEAL

- 7.21 For patents, under [section 97\(3\)](#) of the Patents Act 1977 further appeal lies to the Court of Appeal only under certain sections of the Act, mainly those dealing with ownership, validity and infringement, or where the decision of the Patents Court is alleged to be wrong in law. Leave to appeal must be obtained by applying directly to the Court of Appeal or to the Patents Court. In [Smith International Inc v Specialised Petroleum Services Group Ltd \[2005\] EWCA Civ 1357](#), [2006] 1 WLR 252 the Court of Appeal held that there had been no express or implied repeal or amendment of the procedure in section 97(3) by [section 55](#) of the Access to Justice Act which requires permission for a second appeal to be given by the Court of Appeal. For design right, leave to appeal from the decision of the High Court must be obtained from the Court of Appeal in accordance with [rule 52.3](#) of the Civil Procedure Rules and [section 4](#) of Practice Direction 52.
- 7.22 Any further appeal to the House of Lords requires leave. Note that as from October 2009, the judicial functions of the House of Lords will be exercised by a new supreme court, as part of the changes introduced by the [Constitutional Reform Act 2005](#).
- 7.23 The procedures within the Office - eg for briefing counsel - are much the same as for the original appeal. Practice Directions and Standing Orders applicable to civil appeals in the House of Lords are to be found in the "Blue Book". However, the Office often gets little or no warning of when the appeal is to be heard.

JUDICIAL REVIEW

- 7.24 Judicial review is another route by which decisions of the comptroller can be challenged. It is a procedure whereby the High Court (namely a Divisional Court of the King's Bench Division) can exercise its supervisory jurisdiction over the proceedings and decisions of inferior courts, tribunals or other persons or bodies which perform public duties or functions.
- 7.25 Applications for judicial review are subject to the leave of the court. The main grounds on which leave might be granted are that:
- - there were no powers to make the decision in question, or the powers were not being used for their proper purpose or in a proper way;
 - - the procedures by which the decision was reached were unfair;
 - - the decision is one that no reasonable body could come to;
 - - the decision was reached in breach of the [Human Rights Act 1998](#) or the rules of natural justice.
- 7.26 The court will not normally grant leave for judicial review where there is another avenue of appeal. This means that generally only decisions of the

comptroller in respect of which no appeal is available are likely to be subject to judicial review (including decisions under the PCT - see [Chapter 8](#)). In [Omron Tateisi Electronics Company's Application \[1981\] RPC 125](#) the High Court refused to exercise its discretion to grant an application for judicial review on the grounds that there were positive advantages in deciding the matter by way of appeal. However, the court observed that a litigant was under no obligation to exercise a right of appeal to the Patents Court from a decision of the comptroller before having recourse to the King's Bench Division for judicial review. For example, where the error alleged was obvious on the face of the decision and went essentially to jurisdiction (rather than to error of law not going to jurisdiction), judicial review to quash might be cheaper, quicker and more appropriate.

7.27 The legal basis for judicial review comes from section 31 of the [Supreme Court Act 1981](#), which provides for the following remedies:

- - Certiorari - an order quashing a decision or subordinate legislation that the court has found to be unlawful;
- - Mandamus - an order telling a body to do something it had previously unlawfully refused to do;
- - Prohibition - an order telling a body not to perform a particular act that the court has held to be unlawful;
- - Declaration - a declaration by the court of what the law is (eg that a decision was unlawful);

In practice, only certiorari and mandamus are likely to be relevant to proceedings before the comptroller, although in theory prohibition could also be. The court also has the power to issue an injunction or order damages to be paid.

7.28 The relevant rules of court are contained in [Part 54](#) of the Civil Procedure Rules. The procedures within the Office are essentially the same as in the event of an appeal.

APPEALS TO THE DESIGNS APPEAL TRIBUNAL

7.29 Under [section 249](#) of the Copyright, Designs and Patents Act 1988 appeal from a decision of the comptroller on the settlement of the terms of a design right licence of right lies to the designs Appeal Tribunal. The constitution of this tribunal is prescribed by [section 28](#) of the Registered Designs Act 1949 as amended by paragraph 17 of Schedule 3 to the 1988 Act: it is normally composed of a High Court judge. It may exercise any power that could have been exercised by the comptroller - see [section 28\(7\)](#) of the 1949 Act and [section 249\(2\)](#) of the 1988 Act.

7.29.1 The [Tribunals, Courts and Enforcement Act 2007](#) provides in [section 143](#) for this Appeal Tribunal to be abolished and for appeals to be referred instead to the High Court or the Patents County Court. However that provision has yet to be brought into force: a series of commencement orders, of which the most recent is the [Tribunals, Courts and Enforcement Act 2007 \(Commencement](#)

[No. 7\) Order 2009](#), which have provided for commencement of other sections of the Act on a timetable up until 6 April 2009, do not yet apply to section 143.

- 7.30 The procedural rules governing the Tribunal are contained in the Registered Design Appeal Tribunal Rules 1950 as amended in 1970. In the absence of any subsequent amendment to cater for design right appeals, it would seem that they apply to these by virtue of [section 28\(8\)](#) of the 1949 Act and [section 249\(2\)](#) of the 1988 Act.
- 7.31 The Rules do not make clear whether the appeal to the Tribunal is a review of the comptroller's decision (as explained above for appeals to the court) or a full re-hearing. However in [Masterman's Design \[1991\] RPC 89](#) at page 103 the Tribunal decided afresh whether to refuse registration of a design.
- 7.32 In accordance with rule 2, the appellant should serve a copy of the appeal notice on the comptroller within 2 days of filing it with the Tribunal.

Period for appeal and its extension

- 7.33 Rule 1(2) prescribes a period for appeal of 14 days for a decision on a matter of procedure and six weeks otherwise. In accordance with rule 4, the comptroller has the power to extend - but not shorten - this period upon request, provided the request is made before its expiry. Any request outside the prescribed period (which would include a request for a second extension within the period of the first extension) can only be granted by leave of the Tribunal, and should be lodged with the Registrar of the Tribunal at the Royal Courts of Justice.
- 7.34 Corresponding provisions applied to patent appeals under the now superseded Practice Direction 49E (see "Right to Appeal" above). The procedure and case law developed under that Direction would therefore seem to apply mutatis mutandis to appeals from the comptroller to the Tribunal.
- 7.35 Thus, it is for the hearing officer to determine whether the decision is on a matter of procedure (and that determination is itself a decision on a matter of procedure), and accordingly this must be stated in the decision. This can conveniently be done by a final sentence along the lines:

As this decision is [is not] on a matter of procedure, any appeal must be lodged within

The term "procedure" in this context should be interpreted as meaning steps to be taken in the proceedings in suit as distinct from the substantive result of the proceedings.

- 7.36 Extensions of the period for appeal under rule 4 are discretionary and will not be granted lightly by the comptroller. As explained in [Tribunal Practice Notice 3/2000](#), in deciding whether to grant an extension the hearing officer should have full regard to the same overriding objectives of [rule 1.1](#) of the Civil Procedure Rules 1998 (see [Chapter 1](#)), one of which is to deal with cases

expeditiously and fairly. Thus extensions should be granted only if there is a reason which is sufficiently strong to outweigh the potential harm to other parties and the public that may be caused by further delay.

- 7.37 Like any other request for an extension of time (see [Chapter 2](#)), a request for extension of the appeal period must give full, detailed reasons. Before deciding the matter, the comptroller must give the other party an opportunity to make submissions. The parties must also be given the opportunity to be heard if they so wish, though normally they are content with written submissions.
- 7.38 Some guidance as to reasons which might be allowable may be obtained from patents decisions under Practice Direction 49E prior to 1 April 2003 - see eg [Clear Focus Imaging Inc v Contra Vision Ltd BL O/137/00](#), [Takeda Chemical Industries Ltd's SPC Applications BL O/005/02](#) and [Robinson and Brooks' Application BL O/262/02](#) allowing extension and [Nachf's Application \[1983\] RPC 87](#) refusing one. However, each case must be assessed on its merits, because a reason that might be persuasive in one case might not be persuasive in another if the surrounding circumstances are different. An extension may be granted either for a specific period or for a period whose length is dependent on some other event.

Judicial review

- 7.39 There is no right of appeal from decisions of the designs Appeal Tribunal, since an appeal to the Tribunal is not a proceeding in the High Court. However, decisions of the Tribunal are subject to judicial review, which would be heard in the High Court - see, for example, [Ford Motor Co Ltd's Design Applications \[1994\] RPC 545](#).

Annex to [CHAPTER 7](#) (See [paragraph 7.12](#))

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
PATENTS COURT

IN THE MATTER OF patent application GB ... in the name of ...

and

IN THE MATTER OF an appeal by ... against the decision of the comptroller refusing the application

BRIEF FOR COUNSEL

1. The patent application in suit relates to This appeal is against the decision of the Hearing Officer, ... , to refuse the application under section ... on the ground that it

2. [Text of brief to follow]

Further information

3. [If appropriate] Counsel should note that the application is not yet open to public inspection and the appeal proceedings should not therefore be heard in open court.

4. If there are any other points on which counsel would like our comments, please come back to me. We will be happy to attend a conference with counsel if necessary.

Costs

5. In the event that the appeal is dismissed, we seek an award of costs.

[Name of officer preparing brief]

MISCELLANEOUS

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PROCEEDINGS IN SCOTLAND

General

- 8.01 Inter partes proceedings may be held in Scotland in appropriate circumstances where the proceedings are taking place under sections [8](#), [12](#), [37](#), [40\(1\) or \(2\)](#), [41\(8\)](#), [61\(3\)](#), [71](#) or [72](#), of the Patents Act 1977, as provided in [section 123\(2\)\(f\)](#).
- 8.02 [Rule 88](#) of the Patents Rules 2007 provides that where there is more than one party to the proceedings, and any party applies to the comptroller, the proceedings will be held in Scotland if all the parties consent or if the comptroller considers it appropriate.
- 8.03 The situation is likely to arise where one party resides in Scotland and all the parties agree to it being held there; or if all the parties reside there and one of them makes the necessary request, unless it is shown that it would be unduly burdensome to any other party.
- 8.04 The comptroller can also agree to the hearing being held in Scotland even where none of the parties resides there, if one party requests it and the balance of convenience is in favour.
- 8.05 An application for a hearing in Scotland should be made in reasonable time to allow the other parties to be consulted and where necessary for the comptroller to decide whether to grant the application. Time will also be needed for the administrative arrangements for the hearing to be made. The party making the application should set out the reasons for the application and should propose a venue on neutral ground or otherwise acceptable to both parties, or a locality for the hearing.
- 8.06 Where the proceedings are to be held in Scotland, the hearing officer should notify the hearings clerk who will then liaise with the parties on the venue and if necessary approach the relevant court authorities with a view to hiring a local courtroom.
- 8.07 There is no appeal from any decision of the comptroller under [rule 88](#) whether to hold hearings in Scotland. However, such a decision would appear to be open to judicial review (see [Chapter 7](#)).
- 8.08 Where proceedings are held in Scotland, should it be necessary to have regard to the procedure which would be adopted by the court in the circumstances of the case, the hearing officer should refer to the Rules of the Court of Session which can be found at:

<http://www.scotcourts.gov.uk/session/rules/index.asp>

In addition, the [Civil Evidence \(Scotland\) Act 1988](#) applies to civil proceedings before a tribunal and would thus appear to apply to proceedings before the

comptroller. However, the provisions of the Patents Act 1977 and Patents Rules 2007 take precedence.

- 8.09 There is no specific equivalent to Patents Rule 88 in the Design Right (Proceedings before Comptroller) Rules 1989. However, it seems clear that proceedings in Scotland are equally contemplated (see [rules 18\(4\) and 22\(1\)](#)), and thus that similar considerations must apply.

Terminology

- 8.10 There are some differences in terminology in Scottish proceedings from those in England and Wales, for instance:-
- - claimant = pursuer
 - - costs = expenses
 - - court order = interlocutor
 - - defendant = defender
 - - disclosure = recovery
 - - High Court = Court of Session
 - - trial = proof

Evidence

- 8.11 Under [rule 86](#) of the Patents Rules 2007, in Scotland the comptroller has the same powers as a judge of the Court of Session as regards the attendance of witnesses and the discovery and production of documents. The comptroller's powers in relation to the giving of evidence are governed in Scotland by [rule 87](#) as they are in England and Wales. Under [rule 18\(4\)](#) of the Design Right (Proceedings before Comptroller) Rules 1989, in Scotland the comptroller has all the powers of a Lord Ordinary of the Court of Session in relation to the giving of evidence, other than the power to punish summarily for contempt of court, and all the powers of the Court of Session in relation to the attendance of witnesses and the recovery and production of documents.
- 8.12 The powers of the Court of Session in Scotland are set out [section 5](#) of the Court of Session Act 1988.
- 8.13 In Scotland, the Rules of the Court of Session 1994 [chapter 36.10](#) provide as follows:

FORM OF OATH FOR WITNESSES

I swear by Almighty God that I will tell the truth, the whole truth and nothing but the truth

FORM OF AFFIRMATION FOR WITNESSES

I solemnly, sincerely and truly declare and affirm that I will tell the truth, the whole truth and nothing but the truth

In accordance with Scottish practice, it is usual for the witness to swear with uplifted hand, and the hearing officer should say the words for the witness to repeat.

8.14 The oath taken in the usual manner in Scotland is also acceptable in England and Wales ([Oaths Act 1978, section 3](#)).

8.15 The admission of hearsay in civil proceedings in Scotland is governed by [section 2](#) of the Civil Evidence (Scotland) Act 1988 which provides:

2.-(1) In any civil proceedings -

(a) evidence shall not be excluded solely on the ground that it is hearsay;

(b) a statement made by a person otherwise than in the course of the proof shall be admissible as evidence of any matter contained in the statement of which direct oral evidence by that person would be admissible; and

(c) the court, or as the case may be the jury, if satisfied that any fact has been established by evidence in those proceedings, shall be entitled to find that fact proved by the evidence notwithstanding that the evidence is hearsay.

8.16 Thus, although the position in Scotland was formerly markedly different to that in England and Wales, this difference has effectively been removed through the introduction of the [Civil Evidence Act 1995](#) in the latter.

Privilege

8.17 Express provisions for communications with solicitors or in Scotland relating to patent proceedings and with patent agents are contained in [section 105](#) of the Patents Act 1977 and [section 280](#) of the Copyright, Designs and Patents Act 1988 respectively.

Costs

8.18 In a similar manner to that in England and Wales, the hearing officer has the power to award costs (in Scotland termed "expenses") in proceedings before the comptroller under the provisions of the Patents Act 1949, the Patents Act 1977 and the Copyright, Designs and Patents Act 1988.

Appeals

8.19 Appeals under [section 97\(4\)](#) of the Patents Act 1977 and [section 251](#) of the Copyright, Designs and Patents Act 1988 (on decisions under [section 246](#)) lie to the Court of Session and are heard in the Outer House by a nominated intellectual property judge. However, under [section 249](#) of the 1988 Act, appeals from decisions under [sections 247](#) and [248](#) on design right licence of right matters lie to the Registered Designs Appeal Tribunal: in Scotland the Tribunal consists of a nominated judge of the Court of Session.

- 8.20 The procedure for appeal is prescribed by [chapter 41 part iii](#) of the Rules of the Court of Session 1994 - "Appeals in form 41.19". [Chapter 55.14](#), part of the chapter on "Causes related to intellectual property", overrides some of the general appeal provisions in chapter 41 and provides that appeals from decisions under the Patents Act 1977 or [section 246](#) of the Copyright, Designs and Patents Act 1988 shall be lodged within 14 days in the case of a decision on a matter of procedure, or within 6 weeks on any other matter, taken from the date of the decision. Considerations in relation to appeals from decisions under [sections 247](#) and [248](#) of the Copyright, Designs and Patents Act 1988 to the Registered Designs Appeal Tribunal are explained in [Chapter 7](#) under "Appeals to the Registered Designs Appeal Tribunal".
- 8.21 As provided by [55.14\(10\)](#), the appeal is a re-hearing, rather than a review as is the case in England and Wales under [Part 52 of the Civil Procedure Rules](#) (see [Chapter 7](#)). However, evidence additional to that led before the comptroller may be led only with the leave of the court.

PROCEEDINGS UNDER THE PATENT COOPERATION TREATY

- 8.22 There is no provision in the PCT for hearings in respect of any matters which come before the Office in its capacity as receiving office under the Treaty. However, it is established practice that the applicant should be offered a hearing to determine any dispute which has not been resolved by the International Unit (who act as the receiving office).
- 8.23 Such decisions are not open to appeal but are subject to judicial review (see for example [R v The Comptroller-General-General of Patents ex parte Celltech Limited \[1991\] RPC 475](#)).
- 8.24 Any dispute under [section 89](#), [89A](#) or [89B](#) of the Patents Act 1977 regarding the entry of any application into the national phase or following such entry, is subject to a hearing and appeal as in the case of regular national filing.

ADMINISTRATIVE JUSTICE AND TRIBUNALS COUNCIL; JUDICIAL STUDIES BOARD

- 8.25 The [Administrative Justice and Tribunals Council](#) has a statutory duty to keep under review the constitution and working of the tribunals under its supervision. As a result, from time to time a member of the Council (or its Scottish Committee, or its Welsh Committee) may attend a hearing. The Divisional Director responsible for litigation should be informed when this occurs.
- 8.26 The Council also seeks to ensure that tribunals are open, fair, impartial and accessible to users. To that end it promotes the provision of appropriate guidance and the sharing of best practice (see, eg, its publication "[Framework of Standards for Tribunals](#)"). The Council works closely with the [Judicial Studies Board](#), a non-departmental public body whose Tribunals Committee has responsibility for supervising training for tribunal chairmen and members.

The Board has published guidance on tribunal competence; "[Tribunal Competencies; Qualities and Abilities in Action](#)". The standards in these framework documents apply where relevant to the comptroller's tribunal functions and, based on these standards, the Patents Directorate has drawn up a framework of competences for hearing officers (see [Chapter 4](#)).

SUPPLEMENTARY PROTECTION CERTIFICATE HEARINGS

- 8.27 Supplementary Protection Certificates (SPCs) are issued under [Council Regulation \(EEC\) No.1768/92](#) for medicinal products and [Regulation \(EC\) No.1610/96 of the European Parliament and of the Council](#) for plant protection products. Extensions to SPCs are issued under [Regulation \(EC\) No.1901/2006 of the European Parliament and of the Council](#) for medicinal products that are tested for paediatric use. Most disputes will arise ex parte during the examination of the application for a SPC or for a paediatric testing extension. Hearings are therefore taken by the Deputy Director of the examining group in which SPCs are examined (presently PD/Ex06) or another DD familiar with them, and the guidance in [Chapter 6](#) for ex parte hearings applies mutatis mutandis.
- 8.28 Article 15(2) of 1768/92, Article 15a(2) of 1768/92 inserted by Article 52(8) of 1901/2006 and Article 15 (2) of 1610/96 allow any person to bring an action for a declaration of invalidity of a granted supplementary protection certificate, or revocation of a paediatric extension, before the body responsible under national law for the revocation of the corresponding basic patent. Thus, it is possible for the Office to be involved in inter partes proceedings in respect of SPCs but to date this has not happened.
- 8.29 The headnote to a decision issued in respect of a SPC should identify the legislation as:
- COUNCIL REGULATION (EEC) NO. 1768/92
 - and/or
 - REGULATION (EC) NO. 1901/2006 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL
 - or
 - REGULATION (EC) NO. 1610/96 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL

and should identify the application or certificate by its normal identifying number following the format; "SPC/GB/yy/abc" (the granted certificate retaining the same number as the application).

- 8.30 It follows from [rules 63.1\(2\)\(e\)](#) and [63.17](#) of the Civil Procedure Rules 1998 that appeals against Office decisions are heard before the Patents Court in the same manner as for national patents. Because the Regulations are Community legislation, the question of reference to the European Court of Justice (see [Chapter 1](#)) may be more likely to arise than in other Office proceedings.

PROVISION OF EVIDENCE BY OFFICIALS

- 8.31 From time to time the Office is asked to provide a witness statement for use in court proceeding. For example, it may be asked to explain the normal Office procedures for processing patent applications or what happened on a particular case. Any such request should be notified to Legal Division, who keep a file of statements supplied in the past.
- 8.32 As with any evidence to be used in legal proceedings, it is important to ensure that the officer who provides the witness statement can speak with authority and personal knowledge of the facts in question.

RETENTION OF FILES IN THE OFFICE

- 8.33 Normally the official files of patents and patent applications are disposed of 5 years after the last action or renewal. However, Litigation Section will automatically arrange for the files of all inter partes cases on which a decision has been issued, and all ex parte cases for which there has been a court judgment on appeal, to be retained as "precedent cases". These will be retained indefinitely subject to periodical confirmation. For other ex parte cases the decision and any published patent specification should normally suffice. The file will therefore be retained as a precedent case only for exceptional reasons, and in such cases the hearing officer should instruct Litigation Section accordingly. The Office now operates electronic case files on the Patents Electronic Case System (PECS) and in due course all litigation files will be PECS files.

Table of cases

Notes on case nomenclature:

AC	Appeal cases
Ad&E	Adolphus & Ellis's Reports, King's Bench Division
All ER	All England Law Reports
BL	Court (C) or Office (O) decisions in British Library (Patents Section)
Ch	Law Reports: Chancery Division
CMLR	Common Market Law Reports
Con	LR Construction Law Reports
CP	Rep Civil Procedure Reports
ECHR	European Court of Human Rights
EHRR	European Human Rights Reports
EW...	*Neutral citation number for Court of Appeal, High Court and Patents County Court cases
FSR	Fleet Street Reports
IRLR	Industrial Relations Law Reports
Lloyd's Rep	Lloyd's Law Reports
QB	Law Reports: Queen's Bench Division
RPC	Reports of Patent, Design and Trade Mark Cases
UKHL	*Neutral citation number for House of Lords cases
WLR	Weekly Law Reports
WN	Weekly Notes (Law Reports)

(* - These are citation numbers assigned by the court. They refer to the case itself and not to a report thereof. See [paragraph 5.10](#) for further explanation concerning citation of court judgments and reports of cases)

Table of cases referenced in the Patents Hearings Manual:

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A v Hoare	The Times, 28 April 2006	1.67
Actavis UK Limited v Merck & Co Inc	[2008] EWCA Civ 444	1.88
Admiral Management Services Ltd v Para-Protect Europe Ltd	[2002] EWHC 233 (Ch) , [2002] FSR 59	3.101
ADRENALIN Trade Mark Application	BL O/040/02	5.49
Air Foyle Limited v Center Capital Ltd	[2002] EWHC 2535 (Comm) , [2003] Lloyd's Rep 753	1.97
Akewushola v Secretary of State for the Home Department	[2000] 1 WLR 2295	5.68
Albright & Wilson's Patent	BL O/46/95	6.62

Aleshin v Sony United Kingdom Ltd	BL O/056/05	2.71
Allergan Inc v Merz Pharma GmbH & Co. KGaA	BL O/271/06	1.14
Alliance & Leicester plc's Trade Mark Application	[2002] RPC 29	4.92
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Anderson's Application	BL O/297/02	1.21
Anheuser-Busch Inc v Portugal	[2005] ECHR 686 , [2007] ECHR 40	1.21
Annodius Entertainment v Gibson	The Times, 3 March 2000	2.67
Antiphon AB's Application	[1984] RPC 1	1.60
Anufrijeva v Southwark London Borough Council	[2003] EWCA Civ 1406 , [2004] 2 WLR 603	1.21
Apple Corps v Apple Computer.	[1992] FSR 389	3.57
Armstrong v First York Ltd	[2005] EWCA Civ 277 , [2005] 1 WLR 2751	3.71
Arpad Toth v David Michael Jarman	[2006] EWCA (Civ) 1028	3.72
ASI Solutions PLC v Nu-Phalt Ltd	BL O/154/06	5.49
Associated British Combustion's Application	[1978] RPC 581	7.19
Attridge Law (a Firm) and Another v Coleman	The Times 12 Jan 2007	1.93
Autospin (Oil Seals) v Beehive Spinning	[1995] RPC 683 , BL C/50/95	3.80
Azrak-Hamway International's Application	[1997] RPC 134	1.69;1.93
Babbing v Kirklees Metropolitan Council	[2004] EWCA Civ 1431, The Times, 4 Nov 04	4.08
Balabel v Air India	[1988] 1 Ch 317	3.96
Barnetson v Framlington Group Limited	[2007] EWCA Civ 502	3.100
Baxter Healthcare Corporation & Ors v Abbott Laboratories & Ors	[2007] EWHC 348 (Pat)	3.13
Beck v Ministry of Defence	[2003] EWCA Civ 1043 , [2005] 1 WLR 2206	3.77
Blacklight Power Inc v Comptroller-General of Patents	[2008] EWHC 2763 (Pat)	6.19.1
Bonzel & Schneider (Europe) AG v Intervention Ltd	[1991] RPC 43	3.57
Bracco Spa v General Hospital Corporation	[2000] FSR 633	2.75
British American Tobacco v The Netherlands	[1996] 21 EHRR 409	1.20-21
British Leyland Motor Corporation v Wyatt Interpart	[1979] FSR 39	3.45
British Celanese v Courtaulds	[1935] 52 RPC 171	3.73

Brockhouse Plc v Davis	BL O/100/85	1.102
Brooks and Cope's Application	BL O/71/93	3.68
Building Products Design Ltd v Sandtoft Roof Tiles Ltd (No 2)	[2004] FSR 41	1.105
Cainstores Ltd v Aktiebolaget Hassle	[2002] EWCA Civ 1504 , [2003 FSR 23]	3.82
Cala Homes (South) v Alfred McAlpine Homes East	[1995] FSR 818	3.80
Canada Sugar Refining v R.	[1998] AC 735	1.48
Cantor Fitzgerald International v Tradition (U.K.)	[2000] RPC 95	3.80
Centri-Spry Corp v Cera International	[1979] FSR 175	3.55
Cerise Innovation Technology v Abdulhayoglu and Comodo Technology Development	BL O/355/99	2.68
Cerise Innovation Technology v Abdulhayoglu	BL O/177/99	3.47
Chiron Corporation v Murex Diagnostics (No 9)	[1995] FSR 318	2.36
Chocoladefabriken Lindt & Sprungli AG v Nestle Co Ltd	[1978] RPC 287	3.100
Cinpres Gas Injection Limited v Melea Limited	[2008] EWCA Civ 9	1.97
Clear Focus Imaging v Contra Vision	BL O/137/00	7.38
Clear Focus Imaging v Contra Vision	16/11/2001 (unreported)	3.29
Coal Industry (Patents)'s Patent	[1994] RPC 661	1.42, 3.06, 3.12, 6.09
Cobbold v London Borough of Greenwich	09/08/1999 (unreported)	2.41
COFFEEMIX Trade Mark	[1998] RPC 717	2.39
Coflexip SA v Stolt Offshore MS Ltd (No 2)	[2004] EWCA Civ 213 , [2004] FSR 34	1.96
Colchester Estates (Cardiff) v Carlton Industries plc	[1986] 1 Ch 80	1.86
Compagnie Financiere du Pacifique v Peruvian Guano	(1882) 11 QB 55	3.40
Copeland v Smith	[2000] 1 WLR 1371	4.112
Courtlands's Application	61 RPC 55	5.23
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Dyson Ltd v Qualtex (UK) Ltd	[2004] EWHC 2981 (Ch) , [2005] RPC 19	1.102
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Ford Motor Co's Design Application	[1994] RPC 545	7.39
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Gartside v Inland Revenue Commissioners	[1968] AC 553	1.55
GIO Personal Investment Services	[1999] 1 WLR 984	4.63 , 4.67
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Glaverbel SA v British Coal Corporation	[1994] RPC 443	3.74 , 3.80 , 4.45 , 4.54
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Hodgkinson & Corby v Wards Mobility Services	[1997] FSR 178	1.97
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Hormel Foods Corporation v Antilles Landscape Investments	[2005] EWHC 13 (Ch), [2005] RPC 28	1.105
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Ian Carruthers v Ian Carruthers and M&P Fluorescent Fitting	BL O/068/98	2.72
ICI v Montedison (UK)	[1995] RPC 449	3.73
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