

CHAPTER 5

DECISIONS

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5 DECISIONS

INTRODUCTION

5.01 Decisions are usually written by the Hearing Officer (HO) following an *inter partes* or *ex parte* hearing. Occasionally the HO will give an oral decision at the hearing. Where the part(y)ies agree, the HO may write a decision based on the papers filed. Decisions can be:

- Preliminary; where a preliminary point has been decided in order to progress the case to a substantive hearing
- Interim; where the final decision can only be issued once certain points have been fulfilled following the substantive hearing
- Substantive; where the definitive orders of the comptroller are made.

BL numbers

5.02 Each decision is allocated its own British Library number (BL number). The hearings clerk will allocate the BL number on receipt of the electronic version of the decision.

ISSUING A DECISION – (see Decisions & Abstracts checklist Annex 1)

HO action

5.03 The HO will email the Decisions&Abstracts e-mail box with the decision and abstract (summary) and request that the hearings clerk send a copy of the decision to the part(y)ies. An abstract should be supplied at the same time as the decision. If this is not possible then it should be supplied within 5 days.

Hearings Clerk action

5.04 Decisions are normally received through the Decisions&Abstracts e-mail box, which is regularly monitored by the hearings clerk. Unless instructed

otherwise, decisions are actioned as a priority and should be processed as soon as possible. The hearings clerk will attach the paper checklist to the relevant 'hearings arrangement' file in the DECISIONS folder if one is available.

The hearings clerk will:

- 5.05 On receipt of the decision, open it in word and check that it is on the correct template and correctly formatted. If not, the HO should be contacted immediately.
- 5.06 Open the BL number spreadsheet, H\Litigation\BL Numbers Spreadsheet, allocate the next number to the decision and enter the BL number, Parties names, P and the date the decision is issued on the spreadsheet. The BL number and the issue date will then be entered on to the decision.
- 5.07 Add the HO's electronic signature to the decision, H\Litigation\Hearings\Templates\HO Electronic Signature Library, and save the decision on the H drive in H\Litigation\Hearings. If required, the decision will be renamed so that it is saved as *CompanyName Pat/App number decision*.
- 5.08 Print 5 copies of the decisions for Ex Parte/ Section 13 or usually 6 copies for InterPartes and import a signed copy of the decision onto the dossier using Manual Import – doc code DECISION LIT. The status of the application should be checked and annotated accordingly as OPI or NOPI on the dossier.
- 5.09 Delete the signature on the decision in Word and resave.
- 5.10 Update the Hearings spreadsheet, H\Litigation\Hearings Spreadsheets, with the date the decision is issued and the section of the Act. The status should be checked to determine if OPI or NOPI for the OPI/NOPI column.

5.11 In Prose select the appropriate covering letter to be issued with the decision, complete options as follows:-

- Annex 2 for an NOPI decision
- Annex 3 for an OPI decision
- Annex 4 for a redacted decision
- Annex 5 for a decision before the Scottish Court of Session
- Annex 6 for a decision under section 13
- Annex 7 for a decision relating to Supplementary Protection Certificates (SPC's)
- Annex 8 for a decision relating to Designs.

The appropriate template should be selected and completed with the necessary information. Any paragraphs not required should be deleted. For Inter Partes proceedings separate letters should be issued to each party. Copies of all letters are imported onto the dossier. The decision should be issued with the covering letter to the parties.

5.12 Once the abstract is received open the abstract in word, add the same BL number and date as on the decision. Save the abstract on the H drive in H\Litigation\Hearings. If necessary rename the abstract so that it is saved as *CompanyName Pat/App number abstract*.

5.13 If the decision is OPI it will be placed on the external website. An e-mail should be sent to webmaster with the unsigned copy of the decision attached. The email should be headed 'new patent decision for the website'.
Do not send copies of NOPI decisions to webmaster.

5.14 Copies of all Inter Parte and Ex Partes decisions and abstracts should be circulated internally to the decisions circulation contact list on Outlook. Section 13 decisions are only circulated to a limited Section 13 decision contact list. **If the decision is NOPI ensure the covering e-mail states this.**

5.15 Set a task on Outlook for the following day to add the abstract and for the

day following that to check the decision and abstract are available to view on the external website.

- 5.16 Set a task on Outlook for the end of the appeal period plus 2 weeks to clear the decision if no appeal is received. The end of the appeal period can be taken from the covering letter but is usually 28 days from the date of the decision for Patents, 6 weeks from the date of the decision if a substantive decision for a Design or 14 days from the date of the decision if a procedural decision in a Design case. For decisions issued following a hearing in Scotland, the appeal period should be confirmed with the hearing officer.
- 5.17 For a section 13 decision, a message should be sent on PDAX to the case officer requesting 'Clear records and Action'.

External Circulation

The hearings clerk will:

- 5.18 **If the decision is OPI**, send a copy of the decision to the EPO and the RPC editor. A third copy will be sent to the British Library along with a covering letter. (Annex 9). The British Library will send back the reply slip and the date confirmed as received will be entered on the BL Numbers spreadsheet.
- 5.19 Attach the last copy of the decision to a clear records pro-forma (Annex 10) and pass it to the B3 for processing. This is not required for section 13 decisions.
- 5.20 Enter the date the decision was sent on the BL number spreadsheet.

Second day

- 5.21 The abstract cannot be added to the Patents Decision database on the date that the decision is issued. It is usually added on the following day. If the HO has not supplied the abstract with the decision then it should be supplied

within 5 days. If the abstract is not received the hearings clerk should contact the HO.

The hearings clerk will:

5.22 Using the abstract, complete the fields in the PATENTS DECISIONS application. If a new hearing officer needs to be added, this is achieved through the PATENTS DECISIONS ADMIN application. Note that all section 13 decisions are Inter Partes. **NOPI abstracts should not be placed on the database until published.**

5.23 If the original decision was not supplied in a PDF format, Webmaster should provide a PDF version of the decision. Check the PDF version and confirm whether it is correct with Webmaster.

Third day

The hearings clerk will:

5.24 The decision and abstract should have been uploaded to the external website overnight. Check the website to ensure that the abstract and decision are correct. Any errors should be reported to webmaster.

5.25 Enhance the decision on PDAX and annotate the decision and letter OLF1.

5.26 Delete the abstract and decision in WORD before placing the original e-mail into the 'cabinet' in OUTLOOK. **NOPI decisions should not be deleted in WORD but stored in the NOPI decisions folder in the Hearings folder in H/Litigation.**

5.27 Print a cover paper for the paper file with the appeal date (from the covering letter) and a B/F date of an additional 2 weeks. The paper file should then be placed in the AWAITING APPEAL PERIOD folder and a task set in OUTLOOK to check if an appeal has been received.

NOPI Decisions

5.28 NOPI decisions, (Not Open To Public Inspection), are not published externally until the Patent is published or unless all parties give their consent. NOPI decisions usually relate to unpublished patent applications, section 40 cases, design right cases and decisions which contain potentially commercially sensitive material.

5.29 In the letter issued with the decision (see Annex 2), the parties are asked to inform us if they are content for the decision to be published. If consent is received then a version of the decision may be published or alternatively it may be agreed that all sensitive matter is removed and a redacted version may be published and circulated as above. This will also be sent out to the original recipients with a redacted decision letter (Annex 4).

5.30 If consent is not received then a Patents Form 49 is sent to the Caveat Clerk in Formalities asking to be informed when the Patent is published. Once it has been published then the Patent can be distributed and circulated in the normal way. Until it is published the electronic versions of the decision and abstract should be stored in the NOPI folder in the Hearings folder on the H drive while the paper copy of the decision and hearing arrangements should be kept in the team 3 cupboard.

ORAL DECISIONS

5.31 The HO may make an oral decision at the hearing. This may happen at smaller Ex-Parte cases where no transcript writer is present. In these cases the HO will provide a decision and annotate that an oral decision was given at the hearing. The decision will then be processed as normal.

5.32 Where an oral decision is given in the presence of a transcript writer, the transcript becomes a part of the decision. The hearings clerk should liaise with the HO to ensure that no NOPI information is in the transcript. Upload

the transcript to PDAX as DECISION-LIT and annotate as 'transcript'. The transcript will be issued to the parties with the decision and then processed as normal. If a transcript forms part of a decision then it must be forwarded to Webmaster with the decision to be published on the website.

EXCEPTION REPORT

- 5.33 In order to monitor decisions by HOs, Divisional Directors are sent each week a report generated from the hearings spreadsheet. This is usually sent on a Monday morning.
- 5.34 To produce the report, the hearings clerk must first open the hearings spreadsheet. This must remain open while the exception report is run. The Hearings Exception Report is found at H\ Litigation\ Hearing Spreadsheets\ Exception Report. To start the report, click the 'update' button on the screen, it will take a few minutes to generate the report.
- 5.35 Once the report is complete, e-mail it to the 'Exception Report' contact list on Outlook. If any mistakes are present then the person responsible for the case will e-mail the hearings clerk who will then rectify it.

NO APPEAL RECEIVED

- 5.36 If no appeal is received by the set date, (see 5.16) the decision can be cleared from the hearing clerk's records.
- 5.37 The arrangement pack should be removed from the 'Awaiting Appeal Period' file. The Pro-Forma (Annex 10) should have been returned from the B3, see 5.19, if not request it from the B3. This will provide the instructions on how to proceed. In Inter Partes cases it is usually only necessary to inform the case officer. In other cases a message is generated following the instructions received. This is then sent via PROSE to the manager of the formalities group responsible for the case. The message should be imported into PDAX.

5.38 The date the decision was cleared should be entered on the Hearings Spreadsheet.

5.39 Remove all unnecessary information from the arrangement pack and dispose of as required. Store the remainder of the arrangement pack – usually just the arrangement sheet, decision sheet and any non-standard information - in the cleared decisions store in the team 3 cupboard. As this becomes full, remove and dispose of the oldest packs.

APPEAL RECEIVED

5.40 See chapter 6.

BUNDLES

5.41 For some *Inter Partes* hearings bundles consisting of copies of all the papers that may be required at the hearing are produced by the parties (see Chapter 4). These bundles are offered back to the parties. When issuing the decision, the letter should be edited as appropriate.

5.42 Unless we receive a request to return the bundles to the party, the hearings clerk should destroy them once the appeal period has expired. **Note that the bundles are not to be confused with the original evidence filed in the proceedings, this will always stay with the case.**

Annex 1

Decision and Abstracts Checklist

DECISION & ABSTRACTS	
Open the Decision in word	
Go into the BL spreadsheet and allocate a BL number	
Insert the BL number on the Decision	O/ /13
Date the Decision the day it is issued	
Add the HO signature to the Decision (insert/picture/litigation/hearings/HO sigs)	
Save the Decision on the H drive, litigation, hearings – and put the company name as heading (file name) and decision	
Print a copy of the Decision with the signature on and make copies (main file(if paper)/hearings file/External Circulation) Make sure a signed copy goes on the dossier via Manual Import and change status to OPI on dossier – if decision is NOPI leave status until the decision is made OPI – do not circulate externally until notified the decision is OPI	
Delete the signature on the decision & resave	
Update the spreadsheet with the date the decision is issued and section of the Act – on the spreadsheet it will have 'check' in NOPI/OPI column, check on optics to see if case has been published, if it has then put OPI in column	
Compose the letter to go out with decision (check the appeal first to decide which letter ie section 13/design/SPC/PCT, use sect 13 if decision positive) – change status to OPI on dossier (if NOPI leave status until decision is made OPI)	
Open the Abstract in word	
Add the BL number and date	
Save on the H drive/ litigation/hearings – put Company name and abstract as file name	
New mail to webmaster – click on the paperclip to attach the saved copy of the decision – CHECK NO SIGNATURE (If decision is NOPI – do not send to webmaster for 28 days plus 1 week – only send after checking dossier for any correspondence and always check with the HO before making OPI in case of redacted version as this will go on the website)	
New mail to circulate – click on the paperclip to attach the decision and abstract (If NOPI, state on email)	
Set task for the Next day to put the abstract on the database (If NOPI – do not put abstract on until webmaster actioned)	
Set task for appeal period & mark hearings notes to state when appeal period is over (stated on cover letter plus 1 week) – if no appeal – clear case. (If NOPI – state on task to check when OPI, if OPI - re circulate the decision or redacted version, circulate externally) and clear case if no appeal lodged	
If the decision is a Section 13 – send a pecs message to the Case Officer to 'Clear Records & Action' the case.	
External circulation – Make an additional 3 copies, mail 1 to British Library, 1 to the EPO and 1 to RPC editor. (Covering letter to BL only)	
Attach last copy to Clear Records Pro-Forma and pass to B3 – unless Sect. 13	
On BL Number Spreadsheet enter date sent	

2nd day – put abstract on Decision database if decision check notification is received from Webmaster. (Section 13 are all IP)	
3rd day - CHECK DECISION/SUMMARY ON WEB PDAX – Enhance decision –OLFI enhanced decision and letter	
Delete the Decision and abstract before dragging into the cabinet	

Annex 2
Decision letter NOPI

Your reference: XXX

Our reference: 3Y31/Name/GB/EP

Date

Dear Sirs

Patent Number : GB/EP (Proprietor)

Reference under Section XXX of the Patents Act 1977

1. Please find enclosed a copy of a decision dated xxXXxx.

2. Decisions are normally made available for public inspection in full on our website. However, because this decision relates to an unpublished patent application, you are asked to let us know in writing **within 28 days of the date of this letter** whether you are content for us to publish the decision on our website. If nothing is received in writing from you, the decision will remain Not Open to Public Inspection until such time as the patent application is published.

3. As the decision has been in your favour, the application has been remitted to the examiner or other relevant case officer who will be in contact with you as required.

OR

3. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).

4. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the current fee within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. **Any request for an extension to the appeal period identified in the decision must be made to the court.**

5. Once you have filed your appeal, you must send a copy of the sealed Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

6. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

A letter in identical terms is being sent to the other side. (delete as required)

Yours faithfully

Name (Hearings Clerk)
Litigation Section
Patents Directorate

Annex 3
Decision letter OPI

Your reference: XXX

Our reference: 3Y31/Name/GB/EP

Date

Dear Sirs

Patent Number : GB/EPXXXXXX (Proprietor)
Reference under Section XXX of the Patents Act 1977

1. Please find enclosed a copy of a decision dated xxXXxx.
2. As the decision has been in your favor, the application has been remitted to the examiner or other relevant case officer who will be in contact with you as required.

OR

2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).

3. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the current fee within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. **Any request for an extension to the appeal period identified in the decision must be made to the court.**

4. Once you have filed your appeal, you must send a copy of the sealed Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.

5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

A letter in identical terms is being sent to the other side.(delete as required)

Yours faithfully

Name (Hearings Clerk)
Litigation Section
Patents Directorate

Annex 4
Decision letter Redacted

Your reference: XXX

Our reference: 3Y31/Name/GB/EP

Date

Dear Sirs

Patent Number : GB/EP (Proprietor)

Reference under Section XXX of the Patents Act 1977

Please find enclosed a copy of a decision dated xxXXxx.

The version is Open to Public Inspection, since it contains none of the sensitive information contained within the Not Open to Public Inspection version.

If I can be of any assistance please do not hesitate to contact me.

A letter in identical terms has been sent to the other side. (Delete as required)

Yours faithfully

Name (Hearings Clerk)
Litigation Section
Patents Directorate

Annex 5
Decision letter Scottish court

Your reference:xxxx

Our reference: 3Y31/Name

Date

Dear Sirs

Patent Number :
Reference under Section

1. Please find enclosed a copy of a decision dated xxXXxx.
2. The Patents Act 1977 gives you the right to appeal to the Court of Session against the decision if you wish to do so. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the Court of Session, Parliament House, Parliament Square, Edinburgh, EH1 1RQ.
3. Copies of the Notice of Appeal must be lodged with the Court of Session (address above) together with the fee, within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
4. Once you have filed your appeal, you must send a copy of the sealed Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.
6. Decisions are normally made available for public inspection in full on our website. However, because this decision relates to an unpublished patent application, you are asked to let us know in writing **within 28 days of the date of this letter** whether you are content for us to publish the decision on our website. If nothing is received in writing from you, the decision will remain Not Open to Public Inspection until such time as the patent application is published. *(delete as required)*

A letter in identical terms is being sent to the other side. *(delete as required)*

Yours faithfully

Name (Hearings Clerk)
Litigation Section
Patents Directorate

Annex 6
Decision letter Section 13

Your reference: XXX

Our reference: 3Y31/Name/GB/EP

Date

Dear Sirs

Reference under Section 13 (XXX) of the Patents Act 1977

Please find enclosed a copy of a decision dated xxXXxx.

If I can be of any other assistance please do not hesitate to contact me.

A letter in identical terms has been sent to the other side. *(Delete as required)*

Yours faithfully

Name (Hearings Clerk)
Litigation Section
Patents Directorate

Annex 7
Decision letter SPC

Your reference:

Our reference:

Date:

Dear

SUPPLEMENTARY PROTECTION CERTIFICATES: REGULATION (EC) No 469/2009 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL OF THE EUROPEAN COMMUNITIES

1. Please find enclosed a copy of a decision dated xxXXxx
2. Regulation 5 of the Patents (Compulsory Licensing and Supplementary Protection Certificates) Regulations 2007 extends the existing provisions of the Patents Act 1949 and 1977 to certificates. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedures Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details of which may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand London WC2A 2LL (telephone number 020 7947 7383).
3. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the current fee within the time period specified in the decision. The latest date for appeal is therefore xxXXxx. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
4. Once you have filed your appeal, you must send a copy of the sealed Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal.
5. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

Yours faithfully

Name (Hearings Clerk)
Litigation Section
Patents Directorate

Annex 8
Decision letter Design

Your Reference:

Our Reference: 3Y31/name/file reference

Date

Dear Sir

Title in bold

1. Please find enclosed a copy of a decision dated *****.
2. Decisions are normally made available for public inspection in full. If you are unhappy about any part of the decision being made public in this way (eg because it refers to commercially-confidential information) please let me know **within 28 days from the date of this letter**, explaining your concerns. If the hearing officer accepts your concerns, the decision will be made public in a suitably edited form.
3. The Copyright, Designs and Patents Act 1998 (as amended) gives you the right to appeal to the Chancery Division (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules 1988 (as amended) and the associated Practice Direction. If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the High Court Appeals Office, Room WG7, West Green Building, Royal Courts of Justice, Strand, London WC2A 2LL (telephone number 020 7947 7383).
4. Three copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the current fee **within in the time period specified in the decision**. The latest date for appeal is therefore xxXXxx. **Any request for an extension to the appeal period identified in the decision must be made to the court.**
5. Once you have filed your appeal, you must send a copy of the Notice of Appeal to both me and to any other party to the proceedings as soon as practicable and no later than 7 days from the date of filing the appeal. February 2012
6. I must warn you that costs, which may be large, are normally awarded against the unsuccessful party to the appeal.

[Bundles] (optional delete as necessary)

7. I note that you produced bundles for use at the hearing. If you would like these returned to you please inform me before the end of the appeal period, otherwise, the bundles will be destroyed.

A letter in identical terms is being sent to the other side.

Yours faithfully

Name

Litigation Section

Patents Directorate.

**Annex 9
British Library covering letter**

Name
Floor 1
Zone 6
British Library
96 Euston Road
London
NW1 2DB

XX XXXXXX XXXX

Dear XXX

Intellectual Property Office Decisions

Please find enclosed a copy of a Patent Office decision.

The reference number accorded to this decision is BL O/XXX/XX

It would be appreciated if you could acknowledge receipt by returning the tear off slip below.

Yours Sincerely

XXXX XXXXXXXX
Litigation Section
Patents Directorate

=====

FOR THE ATTENTION OF:

XXXX XXXXXXXX
Litigation Section Room 3Y31
The UK Intellectual Property Office
Cardiff Road
Newport
Gwent
NP10 8QQ

<p>I acknowledge receipt of Patent Office Decision</p> <p>No. [BLO/XXX/XX] which was received on []</p>

Annex 10

CLEAR RECORDS PRO FORMA - DECISIONS

PATENT NUMBER GB/EP

BL NUMBER

SECTION OF ACT

B3 – Head of Litigation Section Name	
1. Update OPTICS and carry out Register Entries. If S13 case carry out clear records and publishing action.	
2. Insert date appeal period expires	APPEAL PERIOD EXPIRES
3. Pass to Hearings Clerk	

Hearings Clerk Name	
1. Ex Parte – If no appeal, return to relevant fmls group as:	
2. Inter Partes – If no appeal, return to relevant B2 case officer for clear records	
3. No appeal period set in decision. Clear records.	
4. Any other scenario (Specific Instructions required)	