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01633 814736

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

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Chapter 1 Introduction

What is this booklet about?

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

What sort of disputes can the Comptroller decide on?

- 1.2 Under the Patents Act 1977, the Comptroller of the Patent Office can decide on most disputes about patents. In many ways the Comptroller's powers are like those of a judge in the courts. The most common disputes on which the Comptroller decides are in the areas of ownership, licences and technical issues. Below are some common examples.

Ownership

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

Licences

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

- **Applications for a compulsory licence under a patent** - requests that the patent owner be forced to grant a licence.

Technical issues

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

How will proceedings before the Comptroller be conducted?

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

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

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

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

- 1.7 Yes. Resolving your dispute through litigation should be your last resort. It is always better to avoid litigation if you possibly can, by either trying very hard to resolve the dispute amicably or, if that fails, trying alternative dispute resolution procedures such as arbitration or mediation. If you resort to litigation, it will take up a great deal of your time, involve a lot of stress and cost you quite a lot of money, most of which you will not recover even if you are successful. Remember too that normally only one side wins at litigation and it might not be you, but if you negotiate, you stand a chance of coming up with a deal that allows both sides to win.
- 1.8 If you want to try alternative dispute resolution, the Legal Services Commission has published a useful leaflet called 'Leaflet 23 Alternatives to Court'. You can access the leaflet on the Legal Services Commission's website at www.legalservices.gov.uk/leaflets/cls/leaflet_23_alternatives.pdf. You can also get a paper copy by phoning 0845 3000 343.

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



Chapter 2 Starting proceedings

How do I start proceedings in the Patent Office?

- 2.1 There are different Patents Rules for each type of proceedings. The procedures you follow depend on the proceedings you start. However, there are some things which most disputes have in common.
- 2.2 First, you will have to file a 'statement of case' with the correct Patents Form. You should use Patents Form 2/77 unless you are filing an opposition. To file an opposition, for example opposing an application to amend a patent, you should use Patents Form 15/77. At the same time as filing the form, you will need to pay a fee of £50. To find out more, contact the address given at the end of this booklet.
- 2.3 You will usually have to send a statement with the Patents Form. It is important that you send this statement as it forms the basis of your case. Your statement should set out the following.

- The matter in issue

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

- The facts which you rely on

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

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

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

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

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

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

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

2.6 You should file two copies of the statement and Patents Form. You should also file two copies of any documents mentioned in the statement. We will send a copy of the statement, Patents Form and any other documents filed to the other side involved in the dispute. We will also ask the other side to send us a counter-statement and will allow them a period of six weeks to do so.

2.7 If you are the person starting the proceedings, you will be known as the ‘claimant’. If you are opposing proceedings started by someone else, you will be known as the ‘defendant’.

What do I do if there are proceedings against me?

2.8 If you want to dispute the claim, we will allow you six weeks to file a counter-statement. You should file two copies of the counter-statement.

This should say clearly:

- which allegations in the statement you deny and why (if you plan to send in a different version of events, you should include this also);
- which allegations you cannot admit to or deny but need the other side to prove; and
- which of the allegations in the statement you admit to.

2.9 We will assume you agree with any facts that you do not dispute. You should confirm the accuracy and truth of the matter contained in your counter-statement by adding a declaration of truth as set out in paragraph 2.4. You should sign and date the counter-statement. An example of a counter-statement is included at the end of this booklet.

2.10 You should send us two copies of the counter-statement. We will send a copy to the person who started the proceedings.

2.11 Taken together, the statement and counter-statement make up the 'statements of case'. They show the facts that are in dispute.

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

2.12 If you don't file a counter-statement, we will assume you do not oppose the proceedings and you will lose the right to take any further part in them. The Comptroller will decide the matter based on information contained in the statement.

Can the statement or counter-statement be amended?

2.13 Yes, but only if the Comptroller agrees. The amendment may be a replacement statement or counter-statement or a supplementary (supporting) statement or counter-statement and will need to be filed in duplicate (that is, you have to send two identical copies). We will send the duplicate copy to the other side for information.

Once the Office has received the statements of case and served (copied) them to each side, what happens next?

2.14 We will then move to the evidence rounds. In all there are three evidence rounds. The person who started the proceedings will be allowed six weeks to file evidence. The defendant will be allowed the same period to file their evidence. The person who started the proceedings will then be allowed another six weeks to file evidence strictly in reply to the defendant's evidence. After that, either side will only be able to put new evidence forward if the Comptroller agrees.

2.15 We then usually appoint a hearing at which you and the other side have the chance to present your case in person to one of the Comptroller's hearing officers who will assess the cases of both sides and come to a decision. Or, if you both agree, the matter may be decided based on the written documents that both sides have provided. In either case, we will issue a written decision which either side can appeal against to the Patents Court, part of the Chancery Division of the High Court.



Chapter 3 Evidence

What is evidence?

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

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

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

What should my evidence be about?

- 3.2 You only need to provide evidence to support facts that are in dispute. You do not need to provide evidence to prove facts that the other side has already admitted to.
- 3.3 Your evidence should be concerned with proving facts, and not with the argument about what can be concluded from those facts. You will already have given your outline argument in your statement of case. You will have an opportunity to put your arguments more fully when it comes to the hearing.

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

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

What form does evidence take?

- 3.5 Evidence must be in the form of written statements about the facts by individual people. These are known as ‘witness statements’. A document such as the invoice mentioned in Example 1 in paragraph 3.1 can’t be put in as evidence on its own because it needs a statement from someone to explain what the document is supposed to be. The invoice would be put in as an ‘exhibit’ to the statement.

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

- 3.6 Anyone making a witness statement may have to go to the hearing so they can be cross-examined on what they have said, although often this will not be necessary.

Who should make witness statements?

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

How should I write a witness statement?

- 3.9 You should start with a title which identifies the proceedings. You should then give your name, address and occupation. If you are giving evidence in a professional or business role, you can give your working address, your position and the name of your firm or employer instead of giving your home address. Your evidence should be written in the first person (for example, ‘I’) and each paragraph should be numbered.

- 3.10 The statement must be signed and dated by the maker and contain a statement of truth, for example, “I confirm that the information contained in this statement is true to the best of my knowledge and belief.” The witness must also sign any exhibit mentioned in the statement.

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

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

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

Does evidence have to be written in English?

- 3.12 If you want to file evidence in a foreign language, you may do so though you will also need to file with it a translation into English made by a qualified translator. You will need to make sure that the translation is checked and certified as an accurate translation of the original text. To do this, the translator may, for example, file a witness statement confirming that the translation is true.

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

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

What happens when we reach the final evidence round?

- 3.15 At the start of the final evidence round, we will contact both sides to arrange a date for a hearing for about four months later. The hearing officer may order that we fix an earlier date or a later date. We will ask you to agree a date with the other side and to tell us about the date you have both chosen. We will also ask you if you want to cross-examine any of the other side's witnesses at the hearing. If you do, you will need to give their names to us and to the other side. Once you have told us about the date you have chosen, the hearings clerk will check that a hearing officer is available and will write to you to confirm the date.
- 3.16 If you do not provide us with a date for the hearing within a period set by the hearings clerk, he or she will set a date within the four-month period. If you want to be represented at the hearing by a patent agent, solicitor or barrister, it will then be up to you to find a representative who is able to appear on that date.



Chapter 4 The hearing

What is a hearing?

- 4.1 A hearing is an opportunity for each side to present their case in person to a hearing officer. Generally, a hearing will last at least a day. If a number of witnesses need to be cross-examined, the hearing may last a few days. Main hearings usually take place at our London office at Harmsworth House, 13-15 Bouverie Street. However, they can also be held at the Patent Office in Newport, South Wales or even elsewhere in exceptional circumstances. We are also able to hold hearings through a video-conference link. We do not charge a fee for a hearing.
- 4.2 We may hold preliminary hearings at any stage before the main hearing to decide, for example, procedural matters such as a request to suspend proceedings. When arranging a preliminary hearing, we will specify a period in which the hearing should take place and will normally give both sides 14 days to tell us about the date they have agreed on.

Can I represent myself at a hearing?

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

What will happen at a hearing?

- 4.4 Hearings follow certain formal procedures, but since hearing officers are not officers of the court, they will not be dressed in wig and gown. When you arrive, the hearings clerk will show you and the other side to the hearing room. Once you and the other side are ready to begin, the hearing officer will enter.
- 4.5 If you are not professionally represented at the hearing, the hearing officer will explain the procedures that will be followed and will advise you of your rights. Throughout the hearing you should address the hearing officer and not the other side. You and the other side will each have a chance to put your case to the hearing officer. This will include cross-examining witnesses.

- 4.6 Usually, if you started the proceedings you will be asked to present your case first. You should go through your arguments, showing how they are supported by the evidence. You will also need to deal with the other side's counterarguments, for example, by showing that they are irrelevant or that they are not supported by the evidence. The other side will then be asked to present their case, putting their own arguments and showing why they consider the first side's arguments to be wrong. Finally, you will be asked to reply to the other side's arguments. Your reply is an opportunity to deal with any points raised by the other side which you could not deal with when you first presented your case. You will not be allowed to raise fresh points at this stage.
- 4.7 If it was the other side who started the proceedings, the roles will be reversed and you will be asked to present your case after the other side have presented theirs. If any witnesses are to be cross-examined, that will normally be done when the first side is presenting their case.
- 4.8 At the end of the hearing, you should wait until the hearing officer has left the room before you leave.

Can the matter be decided without a hearing?

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

What happens next?

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

What powers does a hearing officer have?

- 4.11 A hearing officer can only do things that the Patents Act 1977 gives him or her the powers to do. A hearing officer cannot, for example, make a particular order if the law doesn't give him or her the authority to do so. In reaching a decision, a hearing officer will interpret and apply the law. He or she cannot change the law or twist it in

any way to suit a particular case. However, a hearing officer does have some powers to regulate procedures and in certain circumstances may use their own judgement. This doesn't mean that hearing officers can do what they like. They still have to act in a reasonable and fair way.

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

- 4.12 In the interests of justice, we must give both sides an adequate opportunity to make their case and prepare their evidence. Adding together the six weeks allowed for filing the counter-statement, for each of the evidence rounds, for a reasonable time to prepare for the hearing and for the hearing officer to write the decision means that even if everything goes extremely smoothly, the proceedings are most unlikely to be completed in less than nine months and, often, progress is far from smooth.
- 4.13 If the proceedings are of particular public interest or if both sides ask us to speed up the proceedings, the hearing officer will consider shortening, for example, the periods for filing the counter-statement and evidence. Hearing officers can also use their judgement to shorten the four-month window for holding a main hearing. In exceptional circumstances, they can also shorten the 14-day period we give to the sides to agree a date for a preliminary hearing. Through these types of measures, hearing officers will try to do all they can to speed up the proceedings. They will, however, be looking to make sure that each case is dealt with fairly.

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

- 4.14 It is for the hearing officer to decide whether an award for costs should be made depending on the circumstances of the case. If you win, you may get costs awarded to you, but if you lose, you may have to pay costs to the other side. In general, any costs awarded are not meant to compensate people for their actual costs. We have issued a scale of costs and have published it on our website at www.patent.gov.uk/about/notices/tribunal/2000/tribunal2.htm or, you can get a copy from the address given at the end of this booklet.



Chapter 5 Appealing against an office decision

Can I appeal against a Patent Office decision?

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

How do I go about filing an appeal?

- 5.3 For appeals to the Patents Court, you must make a notice of appeal on the correct form and file it with the appropriate fee (currently £100). You can get more details from:

High Court Appeals Office
Room WG07, West Green Building
Royal Courts of Justice
Strand
London, WC2A 2LL.
(Phone: 020 7947 7383)

- 5.4 You must send two copies of the notice of appeal to the High Court Appeals Office with the fee. You must also send a copy to the Comptroller as soon as possible and no later than seven days of sending it to the Appeals Office.
- 5.5 If you are the person making the appeal, you will be known in the proceedings as the 'appellant'. The other side will be known as the 'respondent'.

How will the appeal be conducted?

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

Can I represent myself?

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

What if my appeal is unsuccessful?

5.8 If your appeal is unsuccessful, the court may order you to pay the other side's full costs, including the costs of any representative, for example, a solicitor or counsel. This could be very expensive.

5.9 You may be granted permission to appeal to the Court of Appeal. If your appeal is heard and is unsuccessful, you may be granted permission to appeal to the House of Lords, though this is very rare. In appeals to the Court of Appeal and the House of Lords, it is usual for both sides to be represented by a barrister.

5.10 You will only be granted permission to appeal if the court believes your appeal has a chance of success.



Chapter 6 Conclusion

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

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

Can I get legal aid?

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

Where can I go for more information?

- 6.3 If you'd like more information on procedures, please contact us. If you would like, however, to discuss the merits of your case, you should contact a solicitor or patent agent. You should check your local phone book for a solicitor. For a list of agents in your area, contact:

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

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



Chapter 7 Examples of documents

Examples of a statement and counter-statement

These are very simple examples. Most statements and counter-statements will need to be longer.

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

Between

Williams & Sons

Claimant

and

George Jones

Defendant

Proceedings

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

Identify this document.

Statement

Set out the matter in issue.

- 1 This reference is being made by Williams & Sons, the liquidators of the company Nuts Limited, in connection with patent application number GB 3245678. We claim that we are the rightful owners of the patent application filed by Mr George Jones in March 1998 and that ownership of the application should be transferred to us.

Number the paragraphs.

Set out the facts of your case.

- 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.

You should send us two copies of the document mentioned.

- 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.
- 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.
- 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 at the Patent Office.
- 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 39(1)(b) of the Patents Act 1977. This says that an invention made by an employee belongs to the employer if the employee's responsibilities were such that he or she had a special obligation to look after the employer's interests. As a director of the company, Mr Jones had such an obligation.

Set out the relief
you are claiming.
Statement of truth.

- 9 In view of the facts set out above, we would like the following relief.
- a That the Comptroller confirms Williams & Sons, as liquidators of the company Nuts Limited, are entitled to the grant of patent application number GB 3245678 and that the application should be transferred to us and go ahead in our name.

 - b That an award of costs be made in our favour.

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

Signature:

Date:

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

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

Counter-statement

State which allegations you deny and why.

1 This counter-statement is made on behalf of Mr George Jones. Paragraph 1 of the statement is denied. Mr Jones is the rightful owner of patent application number GB 3245678 under an assignment dated 5 July 2000.

State which allegations you admit to.

2 Paragraph 2 of the statement is admitted.

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

4 Paragraph 4 of the statement is admitted.

5 Paragraph 5 of the statement is not admitted. It is denied that Mr Jones was working for Nuts Limited at the time he filed the patent application. Also, the company did not start making the new cashew-nut chopping machines until later in 1999.

6 Paragraph 6 is admitted to the extent that Mr Jones initially transferred his rights to Nuts Limited. However, this depended on a deal to buy 1000 machines going through. At a board meeting of Nuts Limited that Mr Jones took part in on 5 July 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.

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

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

Signature:

Date:

Example of a witness statement

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

Between

Williams & Sons

Claimant

and

George Jones

Defendant

Proceedings

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

Witness statement of George Jones

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

1 I am a mechanical engineer with over 30 years' experience in the field of design engineering. Exhibit GJ1 sets out my educational qualifications and my employment details.

2 I formed the company Nuts Limited with Mr John Smith in 1996. I was introduced to Mr Smith by a friend who was aware of my interest in setting up a company to manufacture chopping machines for the peanut market.

3 I had an interest in the company as a shareholder but I did not receive a regular salary from the company. When I filed my patent application, I was not an employee of the company.

4 Although the company was initially successful, owing to the terms of a financial deal not being fulfilled, the Board of Nuts Limited agreed to appoint Williams & Sons as liquidators of the company at a board meeting held on 5 July 2000.

5 At the meeting, the Board also agreed that although I had transferred my rights in patent application number GB 3245678 to Nuts Limited, because the terms of the financial deal had not been met, the transfer should be treated as not valid. It was confirmed that ownership of the application should stay with me. Exhibit GJ2 is a draft copy of the minutes taken by my secretary, Sandra Black, at the meeting.

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

Signature:

Date:

Example of an exhibit

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

Exhibit

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

Signature:

Date:

Note: The document containing details of Mr Jones' 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'.

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

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

Phone: 01633 814736
Fax: 01633 844491
Minicom: 08459 222250
E-mail: patents@patent.gov.uk

You can also get more information on our role as a tribunal on our website at

www.patent.gov.uk/about/notices/tribunal/index.htm

Please keep this booklet with your other patent papers in case you need it in the future.

You can also get the following leaflets from us which may also be relevant.

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