

Andrew Hall

From: Glenn Rose'Meyer <Glenn.Rosemeyer@ipo.gov.uk>
Sent: 09 May 2013 15:44
To: 'andrew.hall2@btconnect.com'
Subject: Documents you requested
Attachments: 007 Requirements for assignments word version.doc; 007 Requirements for assignments.wpd; 018 Desk Instr. Regular irregularities.doc; 018 Desk Instr. Regular irregularities.wpd

Importance: High
Sensitivity: Private

Mr Hall,

Please find attached the docs I believe you referred to in our discussions today when you visited the IPO in Newport.

If these are not what you requested, please let me know.

Kind regards.

Glenn Rose'Meyer
Divisional Head of Administration
Patents Directorate

ASSIGNMENTS

Assignment is the sale of a patent/application. An assignment document may be quite straight forward, but as the transfer of ownership is involved it may be preferred and is the recommendation of the Office, that you employ the services of a Solicitor or Patent Agent.

However, if drawing up the document oneself, the following should be borne in mind.

Assignments must state:

- 1) The present owner of the patent/application giving both name and address(seller).
- 2) That the buyer is acquiring ownership and give his full name and address.
- 3) The signatures of all parties involved.
- 4) The number(s) of the patent/application.
- 5) Confirm that sale took place.
- 6) The date of the transaction.
- 7) A monetary amount paid. If applicable - certify that the transaction does not form part of a larger or series of transactions the value of which is in excess of ,60,000 (The certification clause), see below.

If the monetary consideration and certification clauses are both included, the document is exempt from Stamp Duty. If only one, or neither are included, or if the transaction is in excess of , 60,000, then the document should be presented to Inland Revenue for assessment of the duty to which it may be liable.

In order to register the assignment:-

File Patent Form 21/77 the fee is currently nil(, 0). Provided the form 21/77 has been signed by all parties to the assignment, no additional documents need be sent. However, if all signatures cannot be obtained, the original document &/or a certified copy of the document should be sent with the form 21/77.

When registration has been made, the original, if sent, will be returned endorsed with the Comptroller's stamp if a certified copy was provided for retention on the patent file. The documents held will be open to public inspection.

=====
"It is hereby certified that the transaction hereby effected does not form part of a larger or series of transaction in respect of which the amount or value or the aggregate amount or value of the consideration exceeds , 60,000."

The wording is prescribed (Section 34(4)) Finance Act 1958. It cannot be altered.

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PCT APPLICATIONS/ASSGN 1

An application for a patent electing the UK may be made under the Patent Cooperation treaty (PCT). Unlike an application to the EPO, such an application does not proceed to grant but S. 89 enters what is called the National Phase when it is treated as an application under the Patents Act 1977.

S 85(1)

Entry into the National Phase is by way of filing Form NP1 and fee that is treated as the Form 1/77 thereafter. The form is dated and given a number in line with the normal filing procedure at this Office, but its filing date

S89B(1) is deemed to be the date that it was filed with PCT. If the application has been published by PCT.

S 89(2) Then it is deemed to be in the public domain from the date of that publication.

In order to accord the application a seven figure number it is re-published in the UK. The UK Office publishes the details exactly as those published by PCT.

S30 & 32 Registration of a transaction, instrument of event, or a change of name is by way of F21/77 or 20/77 with the usual supporting evidence.

Practice Since the Office published the application details as published by PCT, it will not be possible to complete an action until after publication.

Procedure The action office should then contact Formalities for advice as to when the application will publish. As soon as publication has taken place the necessary entry should be placed on the register. The required file work should be completed as soon as the file becomes available after publication.

To: All
cc Paul Twyman
From:
Mr. M. Hewlett
GR15
Concept House
tel(GTN1214)4630
13 March 2002

GB9516364.8 ~ Applications filed claiming priority from PCT

The above case was filed in the United Kingdom as B. It appears the original PCT was filed in name A and a change of Applicant occurred after WIPO Publication.

Our problem is that these cases may have assignments or changes of name filed for registration and appear to be already in the correct name (B). When this has happened we are asked, by legal to accept the form (and money, if appropriate), but take no action, the name already being correct.

To identify such a case you will have to notice;

- . It already stands in the correct name.
- . There is a claimed priority and above the line heading PCT NATIONAL PHASE.

Action required is only to check the papers filed, raise and resolve deficiencies, then confirm the application proceeds in the new name (B). You will need to diarise deficiencies for a reply any lack of response to chasing letters of this nature should be referred to the B1 with a view to amending the register to reflect the correct (old) applicant.

Booking-in procedures are completely unchanged.

M.Hewlett
Marks & Clerk
Sussex House
83-85 Mosley Street
MANCHESTER
M2 3LG

Direct Line 01633 814630
Our ref MH/ASSIGN.
Your ref MH/LP/M087747PGB.

Date 13 March 2002

Dear Sir

Patents Act 1977: Patents Rules 1995
Application/Patent No.GB9612505.9

I refer to your letter of 21 August 1996.

By virtue of Section 89(1) and 89A(1), the Application is treated as having been filed on the date that the international application was filed. If, therefore, the name of the Applicant differs from that on the PCT Documents as transmitted by WIPO, then the appropriate statutory procedure should be followed to change the name. Form NP1 is not effective for this purpose, not being a statutory form and being merely advisory.

If, as appears from the certificate, the Applicant has changed name, then the change should be requested on Form 20/77. No further evidence of the change is necessary in view of this certificate.

Please, therefore, file Form 20/77 to complete this requirement.

A period of one month is allowed, from the date of this letter, for the filing of the Form 20/77.

Yours faithfully

Mike Hewlett
Assignments

REGISTRATION OF TRANSACTIONS "VEB" TO "GMBH"/ASSGN 2

Following the unification of Germany and the adoption by the former East Germany of a new constitution, requests are made by agents to reflect this on the Patent Register for those patent proprietors so affected. The method by which this was to be effected was established following an enquiry by an agent.

Minute This unification has required companies to
13/8/91 incorporate under the unified German constitution, such an action involves
a reconstitution under German Federal Law, and is
Section effectively, an order or direction from a
33(3)E competent authority.

Rule 46(1) This requires evidencing via a Form 21/77.
Practice Evidence may vary, acceptable evidence is:
1) An extract from the Handels Register
2) A document purporting to be an assignment stating, it is transferring to a successor
following the unification requirements.

Procedure Documentation should be correctly translated
Rule 46(2) and certified together with, certified copies if appropriate.

DECEMBER 1991

DOCUMENTS NOT OPEN TO INSPECTION/ASSGN 3

All documents are inspected by the A1s on being booked in.

Documents requiring confidentiality fall into two categories:

Rule 93(4)c A) Any document to be treated as "for inspection and return only" such documents may be marked or, the request may be made in the accompanying letter.

Practice The Office also treats as "inspection and return only" those documents that are full agreements or licences and are accompanied by a "short-form" documents even though a specific request has not been made.

Rule 94(1) B) Documents that bear a confidential marking or, for which a confidential request has been made.

Rule 93(5)Ai) Documents that contain disparaging comments about named persons

Procedure All such documents are to be placed on a Not Open to Public Inspection (N.O.P.I.) file and attached to the green jacket externally, the case then to be passed to the EO:

Procedure A) On completion of the case or, as soon as a letter has to be sent to the applicant, the N.O.P.I. document is returned and the report sheet marked accordingly.

The N.O.P.I. folder is returned to the A1 for re-use.

Practice B) On a request for confidentiality being made, a letter is sent asking for reasons for the request for confidentiality. A period of 14 days from the date of the letter is allowed, at which point the documents will go O.P.I. The file should be called after one month and if no interim reply has been received the documents placed on open file.

Procedure On receipt of a reasoned request the documents are sent to the C2 for consideration.

JANUARY 1992

REGISTRATION OF UNDATED ASSIGNMENTS/ASSGN 4

As a general rule, documents submitted for registration are dated. All standard register entries relating to assignments work required the insertion of an effective date or, the system will reject the entry.

Occasionally a document is received that does not bear a date. This is almost certainly an oversight and should be drawn to the attention of the person who has filed the documents. The wording for the letter is attached. The date thus obtained is used as the effective date.

The effort must be made to get a date in writing. The Officer actioning the case must not allocate a date other than on this basis.

it is in the best interest of all concerned that an effective date be given on the Register. however, though the date that persons assumed right or title may be significant in proceedings, neither the Patents Act 1977 nor the Rules made thereunder specify the requirement for the supply of an effective date. It follows that the Office cannot refuse to register because a date is not given. If the above procedure is followed and the person who filed the document declines to give a date, the case must be referred to the B2 for consideration of a suitable free-test entry on the Register to cover the particulars of the case.

CAVEATS/ASSGN 5

A caveat is a request for information relating to a patent or patent application which may ask for information on work undertaken by Assignments Section.

A caveat file is recognised by a red sticker on the front of the file, the caveat is stated on a red card, placed at the end of the minutes.

All cases for which a caveat has been filed:-

The caveat clerk is notified when a register entry has been completed as he/she gets a weekly Optics advice.

Procedure As a back-up, if an officer is dealing with a published case which appears to have a relevant caveat request, it should be minuted to the caveat clerk for his/her attention. For un-published cases the file should be minuted to the relevant Formalities Unit requesting they advise the caveat clerk and "A" publication as a response may need to be issued.

**PATENT APPLICATION SUBJECT TO A PROHIBITION ORDER
UNDER SECTION 22 (SECURITY CASES) / ASSGN6**

The purpose of this instruction is to formalise the section's action in respect of security cases.

Identification of a Security Case.

There will be no OPTICS entry. The nature of the error message on the screen may vary.

Procedure However, a telephone enquiry to Security Section (extension number 4989) will enable confirmation as to whether an application is held as a security case. No record is made of such a call, nor is any entry made on the Section's R S Book or Report Sheets. The booking-in procedures being undertaken without entry of a "Section 30" being made. The request is then held until it falls due for action, enquiries as to any additional requirements or deficiencies being made without reference to security cases (it may be necessary for the actioning officer to again check with Security Section s above whether they hold a case).

Minute Should an agent specifically refer to a 27 April 1992 security case (other than as a part of the original request or in evidence), a copy of the correspondence, with the security cases blanked out, is to be placed on the open file and the original held in an assignments Not Open To Public Inspection (NOPI) jacket. Amendments and blankings out are not made to

Practice legal documents or evidence supplied, the main object is not to draw attention to cases.

Minute When a security case is referred to in a 27 April 1992 schedule that does not form a part of the evidence, the schedule is to be copied for the open part of the file with the appropriate numbers blanked out, the amended copy will go on the open part of the file and the original in a NOPI assignment jacket.

Procedure After registration of the available cases, the file bearing the evidence should be minuted to Mr Hayes, GR70, Concept House with the legend "Assignment File For Your Attention". A pro-forma is attached which should be completed and placed in the assignment jacket.

Procedure The PAA1 advice letter is not to refer to security cases. Any correspondence in which agents refer to the apparent in-action on security cases is to be referred direct to Security Section.

ACTION : CHANGE OF NAME/ADDRESS
ASSIGNMENT
EXCLUSIVE/NON EXCLUSIVE LICENCE
MORTGAGE
MERGER
AGREEMENT
PROBATE/LETTERS OF ADMINISTRATION

EFFECTIVE DATES OF ACTION :

DATE OF FILING OF FORM 20/77
OR 21/77

OLD APPLICANT : NAME

ADDRESS

STATE OF INCORPORATION

NEW APPLICANT : NAME

LICENSEE

MORTGAGEE ADDRESS

STATE OF INCORPORATION

EVIDENCE FILED ON :

AMENDMENT OF OWNER POST-GRANT ASSGN 7.

Files become "unavailable" for some time before grant. There is always some time lag between the filing of a Form 21/77 or a Form 20/77 and when action can be effected. Clarification of inadequate evidence can lengthen the time case takes to process.

All these factors mean that there will be times when a case grants in the wrong name. No action is taken by the Office to identify these cases, rather a request for an amendment by the agent/owner is awaited. When a replacement certificate of grant is required the original must be returned before the new one is issued.

The factors that need to be taken into account when deciding whether erratum slips and/or a new certificate of grant are allowable are the assignment execution date and the date of grant under Section 24(1).

For the request to be allowable, the assignment must be executed before the grant date.

If a request for a fresh certificate and/or erratum slips is made the request is sent to the B1 Assignment Section who will check the dates. If the request is allowed the B1 will minute publication section as follows:

"Execution of the assignments having taken place before grant, the patent stands in the name of:

ABC
The High Street
NEWTON
Surrey

Please issue errata (and a replacement certificate of grant. The original certificate has been returned)".

The certificate of Grant, and B specification if returned, must be placed on their own file with the main correspondence, not on any evidence file, or assignments green jacket. If the request is not allowed a letter is issued (returning the certificate of grant) pointing out that the assignment date is after the date of grant but the new owner/name has been registered and if proof of ownership is required a certified copy of the register, as prima facie evidence of ownership, may be obtained on the filing of Form 23/77 with fee.

A similar situation can obtain at "A" publication. It is extremely rare for a request to be made to amend the "A" publication but when it is done the procedure is the same. The two dates to be taken into account are the date that the assignment was executed and the publication date Section 16(1).

SUPPLEMENTARY PROTECTION CERTIFICATES/ASSGN8

The Supplementary Protection Certificate (SPC), is a separate piece of property, which appears as a below the line entry on a patent register, an example is shown below;

"Supplementary Protection Certificate SPC/GB93/104 in respect of 2,4-Diamino-5-(8-dimethylamino-7-methyl-5-quinolylmethyl) pyrimidine in combination with Sulphadimethoxime was granted on 25 January 1994 for a maximum period expiring on 26 September 2006."

These certificates are capable of being sold separately from, or with the patent and can form an encumbrance on the patent to a new proprietor, if he/she is not aware of them, as they permit their owner to use the technology for the specific purpose stated in the SPC.

Where they appear on the register of a patent that is being assigned, the agent should be asked to confirm to the new proprietor that an SPC is registered, when the first letter relating to the assignment is issued. The agent should also be asked to confirm whether the SPC is part of the assignment, if this is not made clear from the documents supplied. This does not delay registration.

However, it is also possible for the SPC to be sold, licenced, or mortgaged separately and for registration of the transaction, instrument or event to be requested. Legal division have the responsibility for the granting and Formalities for the maintenance of SPC's, but the registration is to remain with us. Form 21/77 is still required, and the transaction should be considered in a similar way as the registration of the assignment or a licence of a patent, except that, the register entry is required to be a FREE-TEXT entry, no roles are to be opened, or closed, specimens are given below;

MALLINCKRODT VETERINARY INC, Incorporated in USA - Delaware, 421
East Hawley Street, Mundelein, Illinois 60060, United States of America registered as Holder of
Certificate Number SPC/GB93/104 in place of
THE WELLCOME FOUNDATION LIMITED, 183-193 Euston Road, London NW1 2BP,
United Kingdom
by virtue of deed of assignment dated 26.07.1995. Certified copy filed on EP0051879

Notice of Exclusive Licence of Certificate Number SPC/GB93/051 to May & Baker Limited (A
Company Incorporated in the United Kingdom), of RPR House, 52 St. Leonards Road,
Eastbourne, East Sussex, BN21 3YG, United Kingdom. Effective Date 14 December 1995
Evidence filed on GB1441359

The usual administrative procedures apply, index cards, PAA1 letter etc, should all be completed, noting the SPC as a separate piece of property. Under SPC Rules, there is no need to establish a State of Incorporation of the role being established. The SPC file should be requested from Ms M Screen Room 2R.88 and file work done on the SPC file to draw attention to the SPC database staff of the change in ownership. Address for service letters and Forms 51/77 should be copied to Ms M Screen in room 2R.88 who will record the change. Confirm to the agent this has been noted and book out the work.

URGENT TREATMENT REQUESTED BY FORMALITIES - ASSGN 9.

The Assignments/Formalities Quality Circle has agreed a standard procedure to deal with cases where the Change of address, Form 20/77, 21/77 should be actioned immediately. The cases will be identified by Formalities who will have either, set the case in order for A-Publication/Grant, or who will have received a request on Form 23/77 for certified office copies. The procedure will also apply to requests received from European Translation section where there is a Form 23/77 action pending.

The Formality Officer will minute the file to the EO with a statement saying what action they have to take and what they require the Assignment section to do.

Our responsibility is to deal with the case and issue a reply with the file saying either, "Assignment action complete-OPTICS and file records up-dated, see evidence filed on", or "Assignment action cannot be completed - further action pending agents reply, see fax/letter dated" in any case this must be done, or the Formality unit advised, within 24 hours.

DISPUTE MANAGEMENT 10

Occasionally doubt is cast upon the validity of documents, or a formal court action (divorce, contract litigation) is pending resolution. Post-Grant can only consider whether the transaction/instrument/event does, or does not establish a prima facie right. Cases are likely to be relatively rare and not easily resolved simply by following pre-determined guidelines. Involve the B2 in all cases. If an urgent view is requested by any party and B2/B3/C2 are unavailable PDD/H should be involved. The Office should then register the transaction, or not and suggest entitlement proceedings (Section 8, or 37), rectification of the Register (Section 34), or that an external court action be launched, ie. a formal environment designed to resolve the dispute. What follows is the procedure adopted because of two disputed assignments (GB9508186.5 and GB2132744). See also GB2261583 for guidance by Legal Division.

Part 1. Initial Booking - in and general handling

When told about a dispute, normal booking-in procedures are followed, and the papers linked to the assignment, if received. Whenever the dispute is raised, action to make changes to the rights recorded/registered should be suspended. Changes of name may still be registered. Changes of Address for Service must be carefully considered.

Post-Grant does not decide these matters, but they may be decided elsewhere and it is important to remain above the dispute. Comments about the types of papers required and the attention/weight they will be given should be restricted to general practice, no confirmation should be given that a statement once received will resolve the situation. The intention is to take a view based on the balance of the prima facie evidence. Not to make a registration is to come down on the side of whoever is already on the register.

The B1 will involve the B2, or above before taking a final stance.

Correspondence should be phrased, "it is the preliminary view of the Patent Office", "in the view of the Office", "in the opinion of the Patent Office". Do not use the words "decided", "decision", or the like, as they have legal meaning in disputes when used by examiners/legal, further Sections 30-33 of the Patents Act 1977 do not provide for decisions.

There is no formal proceeding and it is not customary to require Forms 51/77 from the agents involved.

Part 2. Substantive treatment of the dispute.

A1

Booking - in procedures are unchanged, the letter is treated as relating to a Form 21/77 action. An entry is made in the RS book under the 21/77 line, although obviously no fee has been received. The comments column may be annotated "dispute reference", for identification purposes. The letter should be made urgent and placed at the front of the pending work.

B1

Notification of a dispute will usually be a letter by the party claiming loss. First establish whether the matter they dispute has yet to be received (1), is awaiting registration in pending

work (2) or, has been registered (3).

There may be references to fraud, or wrongdoing by a person in the letter or statements filed, these must be brought to the attention of the C2, any such statements may well be held Not Open to Public Inspection. References in letters or statements which appear disparaging or likely to damage a person should be placed Not Open to Public Inspection by virtue of Rule 93(5)(a)(i). The agent should be advised of that action and instructed to restrain future comments to factual statements.

1) If nothing has been received, there is little to do. Place the documents on file (to be available for Public Inspection after fourteen days). Then write to the agent suggesting they file a caveat request asking to be notified of an Application for Registration of a Transaction/Instrument/Event. At this stage file Form 49/77, noting an internal caveat with the caveat clerk (G.Y73) and request to be told when a register entry is made "Application under Section 30/32 filed on ddmmyy". This is to draw attention to the Form 21/77 that may be filed to request registration of the disputed transaction.

2) Where a request for registration is already pending, trace the Form 21/77 and place all of the papers on the one evidence file, keep the dispute matter separate on the ordinary correspondence section of the file. Write to the disputing agent advising of the pending form (if appropriate when it will be available for Public Inspection), where it is held and by whom it was filed. Write to the agent filing the request for registration, advising them of the dispute and asking for such comments as they may have (to do this you should enclose a copy of the dispute letter) and raise any technical deficiencies with the request.

3) If registration has already happened, advise the agent with a copy of the register (if unpublished only a written statement can be issued).

The dispute may revolve around disposal of property which is prohibited by a court (eg. an injunction issued pending completion of a divorce). The agent should then be recommended to file the court order and ask for registration of that restriction on Form 21/77 as an event affecting the rights in the Patent.

Once comments from each side have been received a view should be taken and relevant action planned. It may be felt worthwhile to allow a period between issuing the letter and completing any action necessary. It is not correct to refuse to act because someone is disadvantaged. Until the correct action has been completed under Section 33, there is no person aggrieved to file an action under, for instance Sections 8, 34, 37, to seek an inter - partes decision on the case and a final settlement.

SIGNMENT SECTION STAFF MEETING

ACCEPTABLE SIGNATURE DESIGNATIONS ON FORM 21/77/ASSGN 11

Position;

The new Form 21/77 allows for signatures by or, on behalf of parties to a transaction (assignment, mortgage, licence). We receive forms completed by agents & solicitors who sign saying they are agent for, solicitor to etc. but, not that they act for and on behalf of

Difficulty;

We should have a clear and consistent line on the acceptability or, otherwise of the various statements.

Decision;

Signatures must be written and must be against identifiable parties (licensor, assignee/assignor, mortgagor, Fred Bloggs, parties listed overleaf, etc.) but, need not be written separately against each r&le. They should be accepted where the person signing claims to act in any formal capacity for the parties to the transaction.

17 FEBRUARY 1997

PRESENT:

Mike Hewlett

Philip Heaven

Paul Edwards

Barbara Jones

Natalie Morgan

FORM 21/77 EXECUTION

Following the Civil Evidence Act 1995 and after discussion with Legal Division there are effects on the completion of Form 21/77. Rules and the Form 21/77 itself make no statement that the Form must be signed. The need for signature(s) is based on our reliance on the document to support the request for registration. Broadly there are three themes;

If the Form has not been signed at all, registration should be made only on the basis of the evidence filed.

Where the Form has been filed with "hearsay" evidence and the transaction is one which may attract Stamp Duty, a signature at (7) on the Form is required to confirm both that rights were acquired and that Stamp Duty requirements are met. A signature by a professional to that statement is accepted without question.

When the Form is filed to request registration and no supporting evidence is provided, the requirements are for a signature by the mortgagor, the licensor or, if an assignment both parties. For a licence or assignment those signature(s) are taken to confirm compliance with Stamp Duty legislation.

HEARSAY EVIDENCE/ASSGN 12

The Civil Evidence Act 1995 has now come into force. The effect of this Act is to allow hearsay evidence to be accepted as proof that something happened. For us this means to support requests for registration on Forms 20/77 & 21/77.

What can we now accept and what can we not accept?

Accept:

Notarial statements saying that a transaction, instrument or event has taken place.

Statutory declarations and affidavits.

Minutes of meetings which confirm that something has happened (eg. minutes of a company meeting which confirm a change of name has been registered with the appropriate authority).

Letters and statements from registration authorities (eg. EPO2544).

Not Accept:

Statements saying that something will happen (eg. minutes of a meeting agreeing that a change of company name will take place).

Letters and statements which do not cite a basis, or document from which they draw the information.

See also Signature designation (ASSGN11).

A precedent case heard in the High Court before Justice Jacob (1) has led to a review of the types of assignment execution that can be accepted for registration. This has arisen because assignment/mortgage documents must be executed by the parties to the transaction, if they are not to be void (2).

What is meant by void? What effect does the document have?

Void, in this instance, means no legal, registerable title passed to the assignee. The document is an enforceable agreement conveying equitable rights.

What is not acceptable?

Any document which does not have both signatures as part of the original execution. A separate acceptance cannot meet this requirement since it "accepts" property from the earlier document, thus it cannot be part of that "assignment".

What is acceptable?

Documents executed in counterpart, where the assignment clearly provides for both parties to sign and both have, although, on separate originals. Assignments where the assignee's signature has been added to the original, although as an afterthought. Care, these can only be effective from the latest signature. Assignments which refer to an earlier agreement and are otherwise complete in all respects, although no earlier date of execution can be entered in the Register (with effect from, effective date etc) (3)

What should the Office do about these documents when asked to Register them?

Legal division have instructed an entry to be put on the Register under Rule 44(4) "an equitable right in favour of ... has been noted" (4).

An official letter should be sent outlining the position and this will request observations and offer a hearing (5).

Why is this entry made and what should be done with enquiries from the agent or third parties?

The entry is a temporary holding position, it does not complete the Form 21/77 request. This serves to warn third parties of the existence of the equity.

Since formal observations and the opportunity of a hearing are involved, telephone conversations must be carefully reported, any question which is not answerable in simple terms should be requested in writing, it may form part of an observation formally and a reply could be used as evidence during a hearing.

What happens after this?

The agent will either;

A) File a legally effective document registration of which is made to complete the original Form 21/77 request.

B) Write in with observations or request a hearing, at which time the file will be minuted to the unit manager for onward transmission to Legal Division.

If the dispute is resolved in the Applicant for registration's favour, the new title will be entered as requested under Rule 46.

If the dispute is decided against the Applicant for registration, no registration is made. Any fee on Form 2177 is refunded and the entry under Rule 44(4) remains. If the owner in equity requires to enforce their rights legally in the future, either the assignor will have to be joined in the action, or the registration of legal ownership will have to be completed.

C) Not respond, in which case requests for examination, renewal fees etc. should only be accepted on forms bearing the Applicants/Proprietors name on the file/register.

Mike Hewlett

Bibliography

1 Baxter International Inc. et al. vs Nederlands Produktielaboratorium Bloedtransfusieapparatuur en Infusievloerstoffen BV et al. No 278 CH 1997

2 Patents Act 1977 Section 30(6).

3 Coflexip Stena Offshore Limited's patent RPC No. 6 1997

4 "Entered under Rule 44(4): Discretionary notice of an equitable right to this Application/Patent in favour of Dated ddmmyy Certified copy of the agreement filed on GB/EPnnnnnn."

5 "I refer to the Form 21/77 filed at the Office ddmmyy to register the assignment of this patent.

The Office is unable to register the transaction under Rule 46 as the document of assignment has not been signed by the parties in accordance with the requirements of Section 30(6). In this respect it is noted that the transaction document itself is signed only by the assignor, and although it is accompanied by a letter of acceptance which is signed by the assignee, nevertheless the acceptance is a separate document which does not appear to form part of the assignment proper. The equitable right created by the defective transaction document has been recorded as a discretionary entry in the register under Rule 44(4).

You may, within one month of the date of this letter, file observations or request to be heard in this matter."

Effective Dates

ASSGN 14

Requests for registration of a transaction (usually an assignment) sometimes refer to an >effective date= of the transaction, asserting that an earlier (un-exhibited) document transferred title. It is usually part of the registration request that this earlier date is the date accorded to the change of ownership on the Register.

Before such a registration can be made there are objections to be overcome, eg. consideration of the potential Stamp Duty liability of that earlier document and its= meeting the requirement to be signed by all parties, together with all other technical requirements. Unless these considerations can be satisfied registration should not be made quoting that earlier date.

While a Form 21/77 signed by all parties will be accepted at face value, registration based on an assessment of the evidence should reflect that evidence and not documents which are unseen and not available for inspection.

SEE PAGE 8

Mike Hewlett
24 May 1999