

## CHAPTER 13

### SECTION 71

### DECLARATION AS TO NON INFRINGEMENT

Introduction	13.01 - 13.04
Initial action	13.05 - 13.07
Formal requirements	13.05
Action by Litigation Assistant (A1)	13.06 - 13.07
Statement of Grounds	13.07 - 13.12
What should the statement of grounds contain?	13.07 - 13.10
What happens if the statement does not comply?	13.11
Serving the statement of grounds	13.12
Counter-statement	13.13
Management of proceedings	13.14
Evidence rounds	13.15
Decision	13.16 - 13.20
Updating the register (B3 action) - free text entries (below the line)	13.17 - 13.19
Clear records action	13.20

## **13 DECLARATION AS TO NON-INFRINGEMENT**

### **INTRODUCTION**

- 13.01 This section provides for the making of a declaration that an act does not, or a proposed act would not, constitute an infringement of a granted patent.
- 13.02 Before an application can be made under section 71 the person seeking the declaration must-
- (a) apply in writing to the proprietor for a written acknowledgement to the effect of the declaration claimed and must furnish him with full particulars in writing of the act in question and
  - (b) confirm that the proprietor has refused or failed to give any such acknowledgement.
- 13.03 If the proprietor refuses or does not give the acknowledgement sought, then an application for a declaration may be made to the Comptroller.
- 13.04 Where proceedings are pending in the court under any of sections 58, 61, 69, 70, 71 or 72, no proceedings may be instigated before the comptroller under section 71 without the leave of the court. However court proceedings for infringement of a patent may be stayed pending the outcome of proceedings under sections 71 and 72 before the comptroller.

### **INITIAL ACTION**

#### Formal Requirements

- 13.05 Follow the procedures at 1.04 to 1.07.

#### Action by Litigation Assistant A1

- 13.06 Follow the procedures at 1.08 to 1.09.

## STATEMENT OF GROUNDS

### What should the statement of grounds contain?

- 13.07 Follow procedures at 1.11 to 1.12.
- 13.08 The statement of grounds should also indicate that subparagraphs (a) and (b) of section 71(1) have been complied with.
- 13.09 It is not always easy to establish that the requirements of section 71(1)(a) have been complied with and this can often result in a delay with the case. It is important that the claimant gives precise and complete information in relation to the article, process, etc which is alleged not to infringe the patent. However the provision is satisfied by providing a sample of the alleged non-infringing article providing that its inspection by competent persons will make clear all aspects of the device material to the question of infringement. Also a description to be read in conjunction with a detailed drawing will suffice.
- PECS:-** Annotate the front cover of the PECS file to show that a sample of the alleged non-infringing article has been filed and state where it has been stored eg “Sample of ..... filed on ..... . Stored in Litigation Section”.
- 13.10 Although implicit in the application, the relief sought should be stated explicitly in the statement in order to assist the HO at a later date.

### What happens if the statement does not comply

- 13.11 Follow procedures at 1.13 to 1.18

### Serving the Statement of Grounds

- 13.12 Follow the procedures at 1.19 - 1.20.

## THE COUNTER-STATEMENT

13.13 Follow procedures at 1.25 to 1.26.

## **MANAGEMENT OF PROCEEDINGS**

13.14 Follow procedures at 1.28 to 1.40.

## **EVIDENCE ROUNDS**

13.15 Follow procedures at 1.41 to 1.45.

## **DECISION**

13.16 Follow the procedures at 1.45 to 1.47.

### Updating the register (B3 action) - free text entries (below the line)

13.17 If the application has been allowed:

- use REG ENT free text and type in a register entry as follows:

“In a decision of the comptroller dated day, month, year, the application under section 71 for a declaration of non-infringement filed on day, month, year, was allowed”.

13.18 If the application has not been properly launched:

- use REG ENT free text and type in a register entry as follows:

“In a decision of the comptroller dated day, month, year, the application under section 71 filed on day, month, year was deemed not to have been properly launched”.

13.19 If the application has been refused:

- use REG ENT free text and type in a register entry as follows:

“In a decision of the Comptroller dated day, month, year, the application under section 71 filed on day, month, year, was refused”.

## Clear records action

13.20 As well as the actions listed in 1.47, if a sample of an alleged infringing article has been filed and the case is a PECS case, the electronic file will need to be updated.

**PECS:-** Annotate the front cover of the PECS file to show that the sample filed has been sent to NMP for storage eg “Sample of ..... filed on ..... sent to NMP on .....”.