

Annex A - Section 104 Amendments During Opposition Proceedings: Check Sheet

PATENT OPPOSITIONS ACTION:

Application/Patent No _____

Statement of proposed amendments no _____ (1st, 2nd, 3rd, etc)

The Regulations require amendments proposed on an application under opposition to grant, to be provided to the opponent for comment.

HAVE AMENDMENTS BEEN PROPOSED AFTER A SUBSTANTIVE DECISION HAS BEEN ISSUED? YES/NO

DATE STATEMENT OF PROPOSED AMENDMENTS FILED BY APPLICANT/PATENTEE

_____/_____/_____

DATE COPIES FORWARDED TO OPPONENT BY OPPOSITION OFFICER

_____/_____/_____

DATE COMMENTS FROM OPPONENT DUE

_____/_____/_____

Examiners should note that Patent Oppositions will send a copy of the request (if any) and the amendments to the opponent and invite them to file comments within 21 days of the date of the letter. If the opponent does not consider 21 days sufficient, they may seek further time (up to the maximum of 2 months from the initial invitation) to comment.

If the invitation has not been sent, examiners should bring this to the attention of Patent Oppositions. Examiners **must not** grant leave to amend until the opponent(s) have had the opportunity to consider the amendments.

PLEASE RETURN THE FILE TO PATENT OPPOSITIONS ONCE THE AMENDMENTS HAVE BEEN CONSIDERED - DO NOT HOLD ONTO THE FILE

HAVE COMMENTS BEEN RECEIVED? YES/NO

HAS THE TIME FOR FILING COMMENTS EXPIRED? YES/NO

1. EXAMINER ACTION: COMMENTS HAVE NOT BEEN RECEIVED.

A. IF THE TIME FOR FILING COMMENTS HAS EXPIRED AND:

- (i) the report is **adverse**, issue the report as per normal (Note: There is no statutory time period for the applicant to respond to an adverse report, however the Commissioner's expectation is that the applicant responds in a timely manner – Patent Oppositions to monitor); or
- (ii) the report is **clear**, the examiner should grant leave to amend and direct advertisement of the amendment.

B. IF THE TIME FOR FILING COMMENTS HAS NOT EXPIRED AND:

- (i) the report is **adverse**, issue the report and include a note that the time for comments has not yet expired and that comments will be forwarded when received. If the comments are received proceed as per EXAMINER ACTION: COMMENTS HAVE BEEN RECEIVED (see below).
- (ii) the report is **clear**, place a note to that effect on the correspondence file drawing this to the attention of Patent Oppositions, then return the file to Patent Oppositions. When the time for comments expires the file will be returned to the examiner. If no comments have been received, the examiner is then to grant leave to amend and direct advertisement of the amendments. If comments are received proceed as per EXAMINER ACTION: COMMENTS HAVE BEEN RECEIVED (see below).

2. EXAMINER ACTION: COMMENTS HAVE BEEN RECEIVED.

DATE COMMENTS FILED BY OPPONENT _____/_____/_____

A. IF AN ADVERSE REPORT IS WARRANTED

A report is to be issued (or another report, if a report has already issued) as per normal (see note above in 1(A)).

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B. IF AN ADVERSE REPORT IS NOT TO ISSUE

The examiner should immediately grant leave to amend and direct the advertisement of the amendments.