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Fast Track Processing of Patents and Trade Marks

- A consultation by UK-IPO

General comment

We welcome the proposal by UK-IPO to offer comprehensive fast track services for the grant and registration of UK patents and trade marks respectively, under which there will be no requirement for the applicant to give reasons for requesting the fast track. Circumstances do arise where rapid grant or registration is needed, not only to deal with potential infringement but also to help with the prosecution of applications abroad.

This welcome is conditional upon the understanding that there will be no deterioration in the standard services for processing applications.

We have reservations about the levels of fees proposed for the services. As a service provider, the UK-IPO should consider that the prompt delivery of its services - the processing of applications - should be normal, not exceptional. Its staffing and organisation should be such as to provide prompt and efficient services as a matter of course, covered by the normal fees. No extra fees are charged at present for the existing accelerated service for patents, rightly in our view. It would be better to offer reduced fees to those who are prepared to accept delay, rather than to charge much higher fees to those who reasonably expect good service. If fees must be charged for the proposed fast track services, they should be set at modest levels.

High fees will be particularly onerous to SMEs, who may be well represented among those who need quick results.

The consultation document asked for comments on a number of particular issues:

Patents

Fee structure

We cannot predict which of the alternative structures will be more satisfactory, although overall fast tracking from application to grant seems a likely need. We suggest that separate fees for fast tracking search and examination individually could be charged, with a composite fee, considerably less than the sum of the two components, for those who decide before search that they want both stages to be fast tracked. The remarks above concerning the need for and size of fees should be kept in mind.

Time for filing third party observations

We are against reducing the time permitted for observations. It can take considerable time for a third party to become aware of a published application, analyse its effect, find the prior art and formulate a reaction.

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Usage

Our member companies expect to use the service, but only when necessity dictates. Bearing in mind that there is little take up of the existing (no premium) accelerated service, usage might be, perhaps, up to 10 % of cases.

Risks

The consultation document asked for views on the risk factors discussed in the document. We agree with the analysis that fast tracking may result in slightly increased risk (above the risk that exists in any event from "normal" processing), but this will be outweighed by the benefit of early grant when this is needed.

As mentioned above, we consider that usage of the system will be limited to situations where early grant is important for an infringement action or foreign prosecution. Unrepresented applicants could perhaps receive a leaflet explaining the risks inherent in the granting process and the small increase in risk that fast tracking would entail.

Trade Marks

We have not received any adverse views on the proposed conditions for applying for the fast track service. We would not expect, under the extra fee level proposed or indeed under a lower level of extra fee, that fast track requests would become the norm and have no reason to disagree with the 10% estimate of possible take up.

However, we emphasise that it is particularly important in the trade mark field that the standard service, which we particularly appreciate, should not deteriorate. We have noted the reassurances in the consultation document concerning both the maintenance of the standard service targets and of quality under the fast track service.

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