

Consultation – proposed changes to the Patents Rules

Introduction

The Federation represents IP intensive companies in the United Kingdom - a list of members is attached. Our member companies are extensively involved with IP in Europe and internationally. Not only do our companies own considerable numbers of IP rights, both in Europe and elsewhere, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions, here and elsewhere.

The consultation

On 29 February 2016, the Intellectual Property Office (IPO) launched a consultation seeking views on proposed amendments to the Patents Rules 2007. The consultation document is available on the [GOV.UK website](http://gov.uk).

The proposed changes are intended to simplify processes for customers, increase legal certainty, and take account of modern ways of working. Many of the changes proposed are in response to suggestions made by users of the patent system.

The IPO are also asking for evidence on how the proposals will work in practice, to inform their assumptions about economic impacts.

Comments may be e-mailed to consultation@ipo.gov.uk by 22 April 2016.

IP Federation response

The IP Federation would like to thank the IPO for giving us this opportunity to contribute to their work on their proposed changes to the Patents Rules. Our members welcome all the proposed changes.

The consultation sets out eleven proposals relating to practice under the Rules. Our responses follow a summary of each proposal.

- i. Introducing a notification of intention to grant, thereby removing the need for applicants to foreshadow divisional applications.

The IP Federation welcomes this change. A minimum period of four weeks is desirable between the notification of intention to grant and actual grant.

- ii. Prohibiting the use of omnibus claims except where absolutely essential.

The IP Federation welcomes this change in the spirit of harmonisation.

iii. Clarifying the period for making a request for reinstatement of a patent application.

The IP Federation welcomes this change. We note that, whilst the fixed 12 month period (legislative option) possibly gives better certainty and is probably easier for the IPO, the '2 months from non-compliance' system seems fairer for the patentee. Therefore we have a slight preference for the 'state the date on the form' (administrative) option.

iv. Allowing extensions to the period for filing an address for service.

The IP Federation welcomes this change.

v. Relaxing the formal requirements for drawings to allow applicants to provide shaded drawings and photographs.

The IP Federation welcomes this change. However, our members would not use the system until other intellectual property offices adapted their laws accordingly.

vi. Removing the requirement for patent proprietors to notify the IPO each year of the address for receipt of the renewal reminder.

The IP Federation welcomes this change.

vii. Clarifying the period for making amendments to international applications upon their entry to the UK national phase.

The IP Federation welcomes this change.

viii. Clarifying the requirements concerning changes of names and addresses.

The IP Federation welcomes this change.

ix. Correcting the drafting of the rule concerning advertising amendments made during infringement and revocation proceedings.

The IP Federation welcomes this change.

x. Removing the requirement for triplicate copies of international applications to be filed when using the IPO as a receiving office for such applications.

The IP Federation welcomes this change.

xi. Removing the requirement for duplicate copies of Patents Form 51 to be filed when notifying the IPO of the appointment or change of agent.

The IP Federation welcomes this change.

Conclusion

IP Federation members support all the proposed amendments to the Patents Rules 2007. We hope our few additional comments are useful.

IP Federation
21 April 2016



IP Federation members 2016

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. The CBI, although not a member, is represented on the Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd
Airbus
ARM Ltd
AstraZeneca plc
Babcock International Ltd
BAE Systems plc
BP p.l.c.
British Telecommunications plc
British-American Tobacco Co Ltd
BTG plc
Caterpillar U.K. Ltd
Dyson Technology Ltd
Eli Lilly & Co Ltd
Ericsson Limited
ExxonMobil Chemical Europe Inc.
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Glory Global Solutions Ltd
HP Inc UK Limited
IBM UK Ltd
Infineum UK Ltd
Johnson Matthey PLC
Merck Sharp & Dohme Ltd
Nokia UK Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
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Renishaw plc
Rolls-Royce plc
Shell International Ltd
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Syngenta Ltd
The Linde Group
UCB Pharma plc
Unilever plc
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