

Consultation on Expansion of the IPO Patent Opinions Service

Introduction

The Federation represents IP intensive companies in the United Kingdom - a list of members is attached. Our member companies range from large multi-national companies to smaller SMEs, and 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 12 June 2012 it was announced that the Intellectual Property Office (IPO) is reviewing its Patent Opinions Service which allows individuals or companies to request an opinion on the validity or infringement of a patent. The consultation outlines proposals to expand the service to additional questions of patent validity, and validity and infringement of Statutory Protection Certificates (SPCs), and to provide the IPO with a power to begin revocation of a patent following issue of an opinion which concludes that a patent is invalid.

The questions and IP Federation response

The [consultation](#) is open until 4 September 2012 and comprises the following questions:

Expanding the questions that can be asked in relation to the validity of a patent

Question 1

Should the IPO be able to issue an opinion as to whether the invention in question is not capable of industrial application?

Question 2

Should the IPO be able to issue an opinion as to whether the invention in question relates to matter excluded by Section 1(1)(d)?

Question 3

Should the IPO be able to issue an opinion as to whether the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art?

Question 4

Should the IPO be able to issue an opinion as to whether the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed?

Question 5

Should the IPO be able to issue an opinion as to whether the protection conferred by the patent has been extended by an amendment which should not have been allowed?

Our members see no reason why the IPO should not be able to issue opinions on the matters set out in these questions. We note that the proposal relating to patent validity is to allow all grounds to be raised that could be raised in revocation, apart from entitlement.

We believe that safeguards need to be built in so this is not a fast-track system for the revocation of patents. To dissuade third parties from filing deliberately vexatious opinion requests, we think that the fees should be set at a sensible level which reflects the number of issues which the IPO is being asked to consider.

Question 6

Please provide any evidence you have about the likely costs and benefits of expanding as set out above the questions relating to validity that can be the subject of an opinion. For example, we would like to see any evidence you are able to provide on the costs associated with preparing and responding to opinion requests and any costs or savings associated with avoided litigation over disputed patents.

Question 7

If the Patent Opinions Service is expanded as set out above do you think your usage of the service will increase? If so, please provide detail by how much and in what areas.

The IP Federation is not in a position to submit evidence, or to give opinions on any increase in usage.

Expanding the Patent Opinion Service to cover SPCs

Question 8

Should the IPO be able to issue an opinion as to whether a particular act constitutes or (if done) would constitute an infringement of an SPC?

Question 9

Should the IPO be able to issue an opinion as to whether an SPC is valid?

Question 10

Please provide any evidence you have about the likely costs and benefits of expanding the Patent Opinion Service in this way to SPCs. For example, we would like to see any evidence you are able to provide on the costs associated with preparing and responding to opinion requests and any costs or savings associated with avoided litigation over disputed SPCs.

Question 11

If the Patent Opinions Service is expanded to SPCs do you think your usage of the service will increase? If so, please provide detail by how much and in what areas.

The IP Federation represents members from a wide range of industries, who do not have unanimous views on SPCs.

Expanding the circumstances under which the IPO can initiate revocation proceedings

Question 12

Should the IPO be able to revoke, on his [sic] own initiative, any patent that an opinion has concluded is invalid?

The members of the IP Federation are not united on this issue.

In any case, the question here should *not* be whether the IPO can actually revoke on its own initiative, but rather whether it can initiate revocation proceedings on its own initiative. The IPO should definitely *not* be able to

simply revoke a patent simply because it has issued an opinion that a patent is invalid.

Question 13

Please provide any evidence you have about the likely costs and benefits of this proposal. For example, we would like to see any evidence you are able to provide on the costs associated with responding to revocation action or appealing revocation decisions and how that might differ from the costs associated with responding to revocation action initiated by other parties.

The IP Federation is not in a position to do this.

Implementing the proposals

Question 14

If the IPO is given the power to initiate revocation action following an opinion as set out above do you think your usage of the Patent Opinions Service will increase? If so please provide detail on how much and in what areas.

The IP Federation is not in a position to do this.

Question 15

Do you agree that the Patents Act should be amended to give the IPO a more general power to issue opinions with the questions that can be the subject of an opinion being set out in secondary legislation?

Yes. That way, the IPO can try things out and adjust without too much difficulty.

Conclusion

The IP Federation supports the Government's policy objective to achieve strong and sustainable economic growth to ensure future prosperity for the UK economy. We agree that intellectual property and the ability to turn innovative, engaging and sustainable ideas into business success is a vitally important part of this.

It is hoped that any changes to the IPO Patent Opinions Service will be to this end, rather than simply provide a fast-track system for revocation of patents with no safeguards built in for patent holders.

IP Federation
3 September 2012

IP Federation members 2012

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. Its Council also includes representatives of the CBI, and its meetings are attended by IP specialists from three leading law firms. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd
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
Delphi Corp.
Dyson Technology Ltd
Eli Lilly & Co Ltd
ExxonMobil Chemical Europe Inc
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Hewlett-Packard Ltd
IBM UK Ltd
Infineum UK Ltd
Merck Sharp & Dohme Ltd
Microsoft Limited
Nokia UK Ltd
Nucletron Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
Procter & Gamble Ltd
Rolls-Royce plc
Shell International Ltd
Smith & Nephew
Syngenta Ltd
The Linde Group
UCB Pharma plc
Unilever plc
Vectura Limited