



## **Intellectual Property Bill 2013–14: IP Federation position on Clause 18 (sharing information with overseas patent offices)**

### ***Introduction***

The IP Federation represents the views of a significant number of major innovative UK companies in matters concerning intellectual property policy. A list of members is attached. Our member companies are extensively involved with IP in Europe and internationally. Not only do they own considerable numbers of IP rights, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions.

### ***Clause 18 of the Intellectual Property Bill 2013–2014***

This clause as amended on report (formerly Clause 17) relates to the exchange of information with other Patent Offices. The idea behind this provision is, we suppose, to allow the exchange of search and examination results for unpublished applications (information about published applications is already exchanged). Such exchanges increase efficiency, save duplication and unnecessary work, and are in every way admirable. Perhaps such exchanges are contemplated only with major offices such as the USA, EPO, Japan and Korea.

However, the effect of the proposals is much less clear. The new power given by the section is extremely broad. Any information that the other patent office requests may be sent - subject only to the working arrangements made with the other patent office, of which only 'protecting confidentiality' is essential.

Any 'patent office', which is quite broadly defined, may request the information. Possibly, in the case of smaller countries, the information provided from the UK could substitute for a local search or examination, which is not unreasonable, unless such requests would make too much extra work for the UK office. However, the 'working arrangements' are completely at the discretion of the Comptroller: they do not have to be approved by Parliament, unlike other powers proposed under the Bill.

There is no limitation on the type of information which may be exchanged or the form in which it might be requested: for example, a request might be for 'details and copies of all applications in the name of Company X relating to technology Y'.

### ***Suggestions to limit Clause 18***

The IP Federation suggests that the provision should be substantially limited, in the following ways:

- the information to be exchanged should be limited to search and examination results;
- information should be provided only about UK applications designated by UK filing number, from which priority has been claimed in the country of the patent office seeking information;
- no information should be provided earlier than one year from the date of the UK filing, unless the applicant agrees otherwise;
- the UK applicant should be informed of the request and the information provided; and
- information should only be provided to patent offices of countries on an approved list, to be added to from time to time, by statutory instrument.

### ***IP Federation proposal to amend Clause 18***

The IP Federation therefore proposes that this Clause should be amended by replacing subsections (3A) to (3C) with:

- (3A) No information shall be sent to a patent office outside the United Kingdom ("the other office") in reliance on subsection (3)(aa) unless the other office provides the application number of a UK patent application and the application number of a patent application being examined by the other office which claims priority from the UK patent application. No such request shall be acted on before one year from the filing date of the UK application. Any information sent to the other patent office must be limited to information on search or examination carried out on the UK application.
- (3B) Information shall not be sent to the other office unless working arrangements have been agreed between the comptroller and the other office, including provision for ensuring that the confidentiality of the information sent to the other office is protected.
- (3C) The applicant for a UK application for which a request for information has been made by another office shall be informed of the request and of the information sent to the other office.
- (3D) Information shall not be sent to another office in reliance on subsection 3(aa) unless that other office is an organisation which carries out, in relation to patents, functions of the kind carried out by the Patent Office and which is on an approved list, which may be varied from time to time by statutory instrument.

IP Federation  
21 October 2013



### **IP Federation members 2013**

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  
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  
Delphi Corp.  
Dyson Technology Ltd  
Element Six 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  
Johnson Matthey PLC  
Merck Sharp & Dohme Ltd  
Microsoft Limited  
Nokia UK Ltd  
Pfizer Ltd  
Philips Electronics UK Ltd  
Pilkington Group Ltd  
Procter & Gamble Ltd  
Renishaw plc  
Rolls-Royce plc  
Shell International Ltd  
Smith & Nephew  
Syngenta Ltd  
The Linde Group  
UCB Pharma plc  
Unilever plc  
Vectura Limited