



## Patent Consultations

In 2013 the IP Federation, based on discussions in the Patent Committee and at Council, has responded to various consultations and discussion papers from the UK IPO and EPO.

### ***UK Intellectual Property Office (IPO)***

#### ***'Superfast' accelerated patent processing at the IPO***

This consultation, launched in April for a June response, sought views on whether a proposed '90 day' patent system could be beneficial. Accelerated examination processes already exist in UK examination; this consultation was in respect of a 'superfast' version which would accelerate both examination and publication, on payment of a significant fee, and could lead to grant within 90 days.

The IP Federation response (PP8/13) foresaw many problems with such a system both for applicants and third parties alike, particularly since a full search covering Section 2(3) co-pending prior art was not possible in the time frame, nor could extensive assessments by third parties be made and submitted as third party observations in the minimum one month between publication and grant predicted by the consultation proposal. There was also concern that inexperienced applicants could damage their own future patenting prospects if applying for the superfast processing for a priority, or first filed, application.

All in all, it was felt that little benefit and potentially significant problems could arise from a 'superfast' accelerated examination, when in fact the existing accelerated examination system works well and (in our view) meets business needs.

Recently it has been indicated by the IPO that the 'superfast' accelerated patent processing proposal will not be taken ahead.

#### ***Discussion paper on an appointed person for patents***

Launched in March for response in May, this proposal was for an appointed person appeal system for patent appeals that operated in a similar way to the existing appointed person appeal system for trade marks.

In the trade marks appointed person system, cases are, on request by one of the parties, referred on appeal to an appointed person, instead of to the Court. The appointed person makes a definitive and binding judgement which is non-appealable. It is indeed a quick and effective route for trade mark issues. The system is currently also proposed for design issues.

The discussion paper mooted the possibility of introducing an appointed person system as a route of appeal in patents matters, including those for Supplementary Protection Certificates (SPCs), that would work in a similar way.

The IP Federation response (PP6/13) makes clear that the issues in trade marks disputes and patents (SPC) disputes are not of the same order of complexity. Patents and SPC matters are highly complex from a technical and a legal perspective, and are viewed as unsuited to an appointed person appeal system. In particular, entitlement disputes, infringement & revocation, and employee compensation disputes should be out of scope for such an appeal route, which, in our view, if brought in at all, should only be available in *ex parte* matters where the applicant has some control over whether an appeal would be heard only by an appointed person.

The IP Federation is the operating name of the Trade Marks, Patents and Designs Federation  
Registered Office 5th floor, 63-66 Hatton Garden, London EC1N 8LE

Email: [admin@ipfederation.com](mailto:admin@ipfederation.com) | Tel: 020 72423923 | Fax: 020 72423924 | Web: [www.ipfederation.com](http://www.ipfederation.com)

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At the time of writing, the IPO has given no indication that it will pursue an appointed person appeal route for patents and SPCs.

***European Patent Office (EPO)***

***Divisionals and Rule 36 EPC***

Rule 36 imposed a time limit for the filing of divisional applications and was brought in because of the EPO perception that significant numbers of divisional applications, including divisionals of divisionals, were being filed unnecessarily.

The EPO initiated a consultation as part of its “transparent, inclusive, and participative process” to collect views on the impact and effectiveness of this Rule.

The IP Federation response (PP4/13) put forward the view that the time limit imposed was unduly restrictive. It had often expired prior to the reaction of the Examining Division to the response to the first examination report, and therefore was believed to put the applicant at a disadvantage, leaving the applicant’s only option being the filing of precautionary divisional applications, the very practice that the EPO had sought to eliminate. The IP Federation preference was still to have an imposed time limit but one that was of a longer duration. We also wanted to see a clear requirement on the EPO Examining Divisions to continue and conclude examination once started, ideally also within a similar time limit.

Recently the EPO announced that Rule 36 would be amended to remove the time limit completely and allow the filing of divisional applications at any point during the pendency of the parent application; subsequent filings of second, third and subsequent generation divisionals would attract an additional fee.

Carol Arnold, 29 October 2013