

Discussion Document on an Appointed Person for Patents and SPCs

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. Not only do our companies own considerable numbers of IP rights, both in Europe and internationally, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions.

The discussion document

The IPO launched on 26 March 2013 a [discussion document](#) that takes a look at the issues surrounding introducing an Appointed Person appeal route for patents matters (and, by extension, matters relating to supplementary protection certificates). Comments are sought by **21 May 2013**.

IP Federation response

Our response to the questions is as follows:

1. Should there be an Appointed Person route of appeal for decisions the Intellectual Property Office makes on patents? Why, or why not?

In paragraph 3 of page 1 of the Discussion Paper, it is stated that “from 2011-2012 there were 230 decisions issued by IPO hearing officers on patents of which 10 were appealed to the Court, **which were all *ex parte* cases.**”

The proposal is that an Appointed Person system for patents would work the same way as it already does for trade marks. However the two IP rights are not the same and therefore it is inappropriate to have the same system. A patent right once revoked cannot be retrieved, whereas a trade mark owner has the possibility to re-apply for a trade mark right should it be cancelled by the decision of an Appointed Person.

As the owners of patent and SPC rights of significant value, we are also extremely concerned that matters such as infringement and validity of these rights could be determined by a decision of the Appointed Person during proceedings initiated by a 3rd party, without the right of appeal to the Court. Patent and SPC matters are highly complex from both a technical and legal perspective, making them wholly unsuitable for such a truncated process.

Therefore, in our view, a proportionate approach here would be to set up an Appointed Person route of appeal for decisions the Intellectual Property Office makes on patents, **but only for *ex parte* matters**. The choice of whether to use the route is then fully with the owner of - or applicant for - the relevant right.

If for some reason this proportionate approach is not followed, and an Appointed Person route is also set up for decisions the Intellectual Property Office makes on patents in *inter partes* matters, then it must be possible to transfer the matter to the Court **on request of one of the parties** - this should **not** be a matter of discretion for the Appointed Person.

2. How many patent appellants might use the Appointed Person appeal route and what cost implications would this have for the parties?

It is reasonable to expect that the number of appeals will rise if a very low cost route of appeal is provided.

A £500 charge is mooted to avoid frivolous appeals; we believe that in the context of patent actions, this is too low to have this deterrent effect.

3. Are there any special considerations in setting up an Appointed Person appeal route for patents – such as certain subject matter or areas of law which should be out of scope?

In addition to our comments in response to Question 1, any Appointed Person for patent and SPC matters will need to be a patent specialist, given the technical and legal complexity of such cases.

If an Appointed Person route is set up for decisions the Intellectual Property Office makes on patents in *inter partes* matters, then the following matters should be out of scope, due to their technical and legal complexity:

- Employees' inventions and Employee compensation
- Entitlement disputes
- Infringement & revocation

Final comment

In our view, a proportionate approach would be to set up an Appointed Person route of appeal for decisions the Intellectual Property Office makes on patents, **but only for *ex parte* matters**. The choice of whether to use the route is then fully with the owner of - or applicant for - the relevant right.

IP Federation
20 May 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
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