



**IPO consultation on a proposal to amend the Patents Act 1977 to provide for online patent document inspection**

***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 31 January 2011 the Intellectual Property Office launched a formal [consultation](#) concerning proposals to amend the Patents Act 1977 by regulation, to provide for online patent document inspection. Under the proposals, a new section 118A will be introduced into the Act to provide that any copyright in documents made available for inspection under section 118(1) is not infringed by making the documents available to the public by electronic transmission in such a way that the documents may be accessed by members of the public, from a place and at a time individually chosen by them, or by copying the documents for facilitating their being made available in this way.

This exception from the exclusivity of the right to communicate the work to the public would not extend to broadcasting the work.

The operation and effect of the regulation will be reviewed within five years from entry into force.

Responses have been requested by 26 April 2011.

***IP Federation comments***

The IP Federation welcomes this initiative to provide for online inspection of documents in the files of patent applications, which it has been seeking for over five years. We consider that any costs involved should be met from EP(UK) renewal fees - as originally undertaken when the fee fund was ring-fenced - rather than from increased fees to applicants.

We have no comment on the text proposed for the new section 118A, which appears to provide what is needed to overcome copyright problems to enable patent documents available under section 118(1) to be inspected online.

Since the proposed section 118A applies to documents made available for inspection under section 118(1), we assume that it will be possible to inspect online all pre and post grant documents on the public part of the file, including any documents concerning applications for Supplementary Protection Certificates (SPCs). We also consider that it should be possible to inspect the files of European Patents (UK) online, though we have been told that these are not yet available in electronic form.

However, we would prefer that more general legislation should be introduced concerning the online inspection of material that is open to public inspection. In the intellectual property field, for example, it should be possible for trade mark and registered design files to be inspected online.

We consider therefore that section 47 of the Copyright Designs and Patents Act 1988 (CDPA) should be amended to provide for online document inspection. This section has not so far been revised to take account of the changes to sections 16 and 20 of the CDPA made in 2003. A modification of sub-section (2) of section 47 to include making available to the public by electronic transmission, as well as by copying or issuing, would be appropriate. Alternatively, an additional sub-section on similar lines to sub-section (2) could be included in section 47, covering making available to the public by electronic transmission and including the requirement that authorisation by the appropriate person would be required.

Furthermore, we consider that efforts should be made to improve third party access to cited technical literature. Where citations from literature are involved, access to what has been considered by the Patent Examiner is crucial. To obtain a copy of the citation from the copyright holder can be both difficult and time consuming.

It would be helpful if some form of blanket licensing system were in place, so that the IPO could issue copies on request. After all, the contributors to technical journals etc. must surely be aware that their articles might be cited in patent and other actions.

Finally, we should like reassurance that the introduction of the proposed section 118A will have retroactive effect.

### ***Conclusion***

We strongly support efforts to provide for online file inspection. While we have no objection to the proposal to introduce regulations amending the Patents Act 1977, we consider that more general provision should be made in the Copyright Designs and Patents Act 1988.

IP Federation  
20 April 2011

### **IP Federation members 2011**

The IP Federation (formerly TMPDF), 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. It is listed on the European Commission's register of interest representatives with identity no: 83549331760-12.

ARM Ltd  
AstraZeneca plc  
Babcock International Ltd  
BAE Systems plc  
BP p.l.c.  
British Telecommunications plc  
British-American Tobacco Co Ltd  
BTG plc  
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  
Nokia UK Ltd  
Nucletron Ltd  
Pfizer Ltd  
Philips Electronics UK Ltd  
Pilkington Group Ltd  
Procter & Gamble Ltd  
QinetiQ Ltd  
Rolls-Royce plc  
Shell International Ltd  
Smith & Nephew  
Syngenta Ltd  
The Linde Group  
UCB Pharma plc  
Unilever plc  
Xerox Ltd