

October 2005

Welcome to www.haseltinlake.com!

You are most welcome to visit our newly enlarged web-site at www.haseltinlake.com. We will continue to issue newsletters and fuller briefing notes in hard copy by mail, to save you the trouble of printing them. In addition, however, they can now all be obtained on-line through the site (www.haseltinlake.com/publications).

UK Patent Office Opinions

From **1 October 2005**, the UK Patent Office have begun to accept requests for it to provide an opinion on (a) whether a granted UK patent (i.e. a granted national UK patent or the UK part of a granted European patent) would be infringed by a certain activity or (b) whether the granted UK patent has novelty and inventive step. The new opinions procedure has been introduced to provide parties with an alternative means of resolving disputes without having to file full-blown legal proceedings in the courts or Patent Office. The Patent Office has announced that it intends the procedure to be quick and efficient and has indicated its aim is to issue an opinion around three months after a request is made.

The procedure is governed by Sections 74A and 74B of the Patents Act 1977 (as amended) and Rules 77A to 77K of the Patents Rules 1995 (as amended), which came into effect on 1 October 2005.

- **Anyone** is able to request an opinion on any issue of validity or infringement. For example, a patent holder may request an opinion on his own patent, or another party may request an opinion on a patent without having to declare an interest.
- The requester makes the request and submits the facts to be taken into account, together with any documents to be relied upon. The official fee is £200. The requester must state the names and addresses of any person known to him as having an interest in the request and must identify any relevant pending/concluded UK or EPO proceedings known to him (Rule 77B(1)(2)). A request can be filed by a patent attorney without identifying his client (Rule 77B(3)).
- No issues which have already been sufficiently considered in a previous opinion or during the processing of the patent application, or matters which have been determined in full-blown legal proceedings, will be reconsidered by the Patent Office Examiner preparing the opinion. The Examiner may, however, take into account documents already on the case file when considering new documents.
- The Patent Office does not have to provide an opinion, and must decline to provide an opinion where the request is frivolous or vexatious or where the question has already been considered in other proceedings (Section 74A(3); Rule 77D).
- The request is noted on the UK Patents Register (Rule 77C) and the Patent Office informs all known interested parties. The request for an opinion is not kept confidential. Anyone may inspect the request and, if it proceeds, it will be advertised on the Patent Office website. Information as to the status of the request will also be available on the Patent Office website.
- **Any person** may file observations on the matter (without payment of a fee) within a period of **four weeks** counted from the date of advertisement of the request (Rule 77F(1)(7)), and the patentee and any exclusive licensee (to the extent he did not file the observations) and the requester have until two weeks after the end of the four week observations period to reply to the observations (Rule 77F(4)). Because of the very short deadlines involved in the procedure (see below), we recommend that the Register is watched if a third-party intervention might be required.
- The patentee and any exclusive licensee and (if different) the requester receive copies of the filed documents, preferably by electronic means (Rule 77F). We understand that the Patent Office will encourage the use of e-mail. Although discretionary extension of these very short deadlines is theoretically available under Rule 110(1), we understand that the Patent Office will be reluctant to allow extensions.
- After the deadlines for observations and replies have expired, an Examiner prepares the opinion, and issues it to the patentee and any exclusive licensee and (if different) the requester, and to any other person who filed observations (Rule 77G).
- The opinion issued by the Patent Office is non-binding. For example, it does not result in revocation of the patent nor are any legal remedies (e.g. damages) available.
- The patentee and any exclusive licensee have until **three months after the date of issuance of the opinion** within which to apply to the Patent Office for a review of an adverse opinion. The sole ground of review is that the opinion came to a wrong conclusion (Rule 77H). If an application for review is filed, the Patent Office informs the requester and any other person who filed observations, and advertises the application for review (Rule 77I) on the Patent Office website.
- **Any person** may file a statement or counter-statement on the matter with a period of four weeks counted from the date of

advertisement of the application for review or two months counted from the date of issuance of the opinion, whichever is the later (Rule 77I(4)), and the Patent Office copies the papers to the other parties and directs the subsequent procedure (Rule 77I(5)(6)).

- If during the course of review proceedings a patent holder wishes to amend the patent, the Patent Office may consider staying the review until the amendment proceedings are concluded.
- The review proceedings may be decided at a Patent Office hearing if one of the parties wishes it, or on the papers if not. A reasoned decision will be issued and published on the Patent Office website.
- The outcome of any review is considered as a formal decision at Patent Office level. This is in contrast to the original opinion, which has no formal status as a decision. If an application for review does not succeed in having the opinion set aside completely, the matter can be appealed to the courts, and the ultimate decision on appeal will bind a lower tribunal on the same facts. Therefore, the patentee and any exclusive licensee will need to consider carefully the chances of success, before applying for review of an adverse opinion.

It will be interesting to see how much weight courts or other tribunals place on the UK Patent Office opinions. This may well determine how widely the procedure comes to be used.

If the quality of the opinions is high, however, the procedure in relation to validity could well be useful for testing prior art that is being considered for possible use in oppositions, nullity actions, revocations or re-examination procedures on parallel patents in other jurisdictions, both in Europe and elsewhere, or in pre-grant observations on parallel applications that are still pending elsewhere. Similarly, the procedure in relation to infringement could well be useful – particularly for small and medium sized businesses – for resolving disputes before litigation.

We will keep you informed of developments, as the details of the procedure become established.

→ <http://www.opsi.gov.uk/si/si2005/20052496.htm>

David Nash and Christine Fenlon
For further information email dnash@haseltinlake.com
or cfenlon@haseltinlake.com



CHRISTINE FENLON, Partner – London

*UK and European Patent Attorney
BSc Physics
Imperial College, London*

Email: cfenlon@haseltinlake.com
Tel: +44 (0) 207 420 0500

ASHLEY GILES, Partner – Bristol

*UK and European Patent Attorney
BEng Civil Engineering, MSc Hydraulics
Bristol University*

Email: agiles@haseltinlake.com
Tel: +44 (0) 117 910 3200



JOHN CHEYNE, Partner – Bristol

*UK and European Patent Attorney
BSc Mechanical Engineering
Bristol University*

Email: jcheyne@haseltinlake.com
Tel: +44 (0) 117 910 3200

ELIZABETH COOPER-ROLFE, Attorney

*UK and European Patent Attorney
BSc Physics
Bristol University*

Email: erolfe@haseltinlake.com
Tel: +44 (0) 207 420 0500



ROBERT GAMES, Attorney – Bristol

*UK and European Patent Attorney
BEng Mechanical Engineering
Southampton University*

Email: rgames@haseltinlake.com
Tel: +44 (0) 117 910 3200

CHRISTOPHER GIBBS, Partner – Leeds

*UK and European Patent Attorney
MA Natural Sciences (Physics)
Cambridge University*

Email: cgibbs@haseltinlake.com
Tel: +44 (0) 113 233 9400



Please visit our new website at
www.haseltinlake.com

London: Imperial House, 15 – 19 Kingsway, London WC2B 6UD
Tel: +44 (0) 20 7420 0500 Fax: +44 (0) 20 7420 0505

Leeds: West Riding House, 67 Albion Street, Leeds LS1 5AA
Tel: +44 (0) 113 233 9400 Fax: +44 (0) 113 233 9401

Munich: Rosenheimer Strasse 30, D-81669 Munchen, Germany
Tel: +49 (0) 89 6227 1760 Fax: +49 (0) 89 485 686

Bristol: Redcliff Quay, 120 Redcliff Street, Bristol BS1 6HU
Tel: +44 (0) 117 910 3200 Fax: +44 (0) 117 910 3201