

January 2005

CHANGES TO UNITED KINGDOM PATENT LAW AND PRACTICE

On 1 January 2005 a number of important changes to patent law and practice came into force in the United Kingdom. The changes have been made through the new Patents Act 2004 and Patent (Amendment) Rules 2004, which update and modernise UK patent law and, in particular, provide a more supportive framework to enforce patent rights and to underpin and promote innovation. Other changes are also being made through the Regulatory Reform (Patents) Order 2004 to bring UK patent law into line with the Patent Law Treaty, and result in the softening of the formal requirements of the patenting system.

Late declarations of priority

- When an application is filed in good time (i.e. within the 12 month period) late declarations of priority can be requested at any time up to 16 months after the earliest priority claimed, and will be automatically accepted.
- An application can now be filed up to two months late (i.e. between 12 and 14 months after the earliest priority to be claimed), and a declaration of priority to the earlier case allowed, provided it can be shown that the failure to file the application in time was "unintentional".

Filing Date

A filing date can now be obtained based on:

- just a reference to an earlier convention application (provided the subsequently filed specification is wholly based on this earlier application).
- the filing of a Foreign language document.
- no fee is required to obtain a filing date. However, an application fee has been introduced to trigger a formalities examination. The search fee has been reduced to offset this new fee, so that the total fees remain unchanged.

Missing parts of the description and/or drawings

Missing pages of text and/or drawings can be filed late, **without losing the original filing date**, if it can be shown that the missing material was wholly present in an earlier priority document.

Also, in the case where priority is not being claimed, the existing provision of re-dating an application to the date on which missing drawings are filed will be extended to include re-dating the application to the date on which missing pages of the description are filed. In this situation, the applicant retains the right to remove such material and keep the original filing date if re-dating would have other detrimental consequences, e.g. bringing other documents into the state of the art.

The three "Rs"

Resuscitation will enable an application withdrawn on request of the applicant to be resuscitated, if the request for withdrawal was made by mistake.

Reinstatement is being introduced to allow applications lapsed through failure to meet official deadlines to be reinstated.

Restoration of lapsed patents through non-payment of renewal fees is being relaxed to remove the need to prove that "due care" was taken to renew the patent.

To obtain **Reinstatement** or **Restoration** the applicant will need to show that the failure was "unintentional". It is not yet clear what degree of evidence will be needed to prove the failure was "unintentional", but early indications show that the Patent Office will try to take a liberal view unless the particular facts on a case warrant a more detailed test. Third party rights may be invoked if a third party has started to work the invention, or made serious and effective preparations to do so, in the interim.

Extensions of time limits set by the Patent Office (for example in response to substantive examination reports) can now be requested retrospectively, up to two months after the initial deadline. No reasons or fees are required, ie available as of right.

Translations of foreign language priority documents will no longer be required as a matter of course, but only on request of the Patent Office.

In addition, translations filed at the UKPO when validating a EP(UK) will no longer need to be verified. The automatic time extension for late filing has been extended from 1 month to 2 months. The Comptroller's discretion is still required to file translations beyond this date.

Transactions recorded at the UK Patent Office will only require the signature of the assignor or mortgagor if executed after 1 January 2005. At present the signatures of all parties to the agreement are required.

Employee Compensation is being widened to allow an employee to claim compensation in respect of outstanding benefit derived from the invention or patent (or both). Previously, compensation could only be obtained for outstanding benefit obtained as a direct result of the patent.

Security provisions are being relaxed such that foreign filing permits are not required by UK residents, unless the invention relates to military applications, or something that would knowingly be prejudicial to national security or the safety of the public.

Remedies in Entitlement Proceedings will enable a successful party to file a new (back-dated) application where the original application is withdrawn or refused. No longer dependant on the publication of the original application. Existing protection for original applicants and licensees (who act in good faith) is extended to cover the new situation.

The following provisions are intended to assist SME patentees and infringers, and to promote mediation and early settlement of patent disputes.

Threats – threats provisions are being amended so that an accusation of sale of a product which the potential infringer has made or imported (if a product) or used (if a process) will not amount to an actionable threat. Until now threats against such primary infringers could only be made against the acts of making the product, or using the process. Further guidance is also given on what does not amount to a threat, making it easier for patentees to make non-actionable enquiries of a potential infringer.

Costs – costs awarded by the court will be based on the financial position of the parties involved. This means that large patentees taking on smaller infringers may not necessarily recover all of their costs, even if they win outright.

Enforcement of Damages will be made easier through a quick and simple county court procedure (in England and Wales). Similar provisions will apply in Scotland.

Other notable changes coming into force later in 2005

Opinions – upon request by any party the UK Patent Office will issue an Opinion on infringement and/or validity (judged on novelty and inventive step only). The Opinion will be non-binding. Although third parties (including a patentee) can file observations, only the requestor of the Opinion will be party to the proceedings. The owner or exclusive licensee of a patent can request a review of an Opinion, and the outcome of such a review will be a binding Opinion.

Renewal payments will become due at the end of the month rather than the anniversary of the filing date, thereby bringing the UK into line with most other European countries.

The following changes will also be made to bring UK law into line with changes being made to the European Patent Convention:

Post grant amendment will be brought into line with European practice, thus narrowing the court's and Comptroller's discretionary ground for refusing a patent amendment.

Swiss type claims will no longer be needed to protect the second medical use of known substances.

For more information on the above plus information on other changes, please refer to our separate "Patent Briefing Paper: UK Patents" or contact **Simon Rees** srees@haseltinelake.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