

## Patent Office opinions: Leeds meeting – 24 November 2005

### **Outline of Peter Hayward's points (30 minutes)**

*Points in red are covered on PowerPoint slides*

#### SLIDE 1

##### Programme

Outline subjects to be covered:

- History
- The basics
- Purpose
- Procedures
- What's on the web

#### SLIDE 2

##### History

- Continuing concerns about difficulty/cost of patent enforcement
- Bill for EPC 2000 changes gave opportunity to legislate
- Initial ideas:
  - allow Office to hear infringement without *both* sides agreeing
  - Office re-examination of validity on request e.g. USPTO-style
- Consultation early 2003:
  - included both open meeting and Ideas 21 meeting in January
  - little support for PO infringement
    - jeopardises PCC, limited relief, creates extra step if appealed
  - mixed views on re-exam
    - could help litigation or insurance
    - but could increase costs and potential for harassment, and undermine confidence in patents
    - some suggested cut-down procedures or confidential opinions
- PO floated idea of cut-down, open, non-binding re-exam process, which could also be applied to infringement
  - meetings with CIPA, Ideas 21, judges, Gallafent &c in Jun-Sep
  - idea generally supported and developed

- alternatives (e.g. RG's binding re-exam) considered but not supported
- Incorporated in Bill
- Meetings around UK in Autumn 2004 to flesh out detailed Rules

### SLIDE 3

#### The basics

- anyone can request an opinion on novelty/IS and/or infringement
- must make a case ("look at these 20 docs/this object" not enough)
- case must be new
- request advertised –others can comment (inc patentee)
- patent examiner (independent technical/legal expert) gives opinion

### SLIDE 4

#### Aims

- quick and affordable way of getting an impartial assessment that should carry weight with both sides in a dispute
- help parties resolve disputes, or narrow them before litigation:
  - provide basis for negotiating a settlement
  - focus them on to key issues in dispute
  - allow them to test the strength of their arguments
  - provide access to litigation insurance
- NOT simply an extra step in litigation
- users may find many other helpful uses – and that's fine
- a world first
  - JP Hantei (50 pa): infringement only, much fuller proceedings
  - AT feststellungsantrag: infringement only (and one sided?)

Half way point in talk

## SLIDE 5

### Detailed procedure

- balance between speed and thoroughness, following consultation
- procedure:
  - fee £200 (form 17/77)
  - requestor sets out in writing
    - question upon which opinion is sought
    - his submissions on that question
    - any facts/evidence to be taken into account
    - details of other interested parties
    - details of any relevant proceedings

## SLIDE 6

- PO sends to the patent holder (if necessary) and other interested parties
- advert appears on web within 3 weeks
- anyone can file observations (electronically) within 4 weeks of advert, but must copy to requester and patentee
- requestor and patentee have 2 weeks to respond (strictly in reply)
- opinion then issues within 3 weeks

### Features

- everything open to public from day 1
  - filings, refusals, withdrawals, opinions all on web site
  - caveats possible
- no evidence rounds, no discovery, no hearing, no witnesses
  - much quicker than proceedings - 12 wks overall (9 if no observations)
  - extensions of time only for compelling reasons
  - still allows time for parties to consider and comment
  - but simple, cheap and quick means it cannot be legally binding
- aiming for high quality - specially selected and trained Senior Examiners
  - an opinion will only be as good as the written submissions
    - poor or one-sided submissions will reduce value of opinion
    - may be conditional

### Other points

- (rarely, to guard against abuse) will refuse if frivolous, vexatious, old grounds
- not appealable
- review of opinion only in limited circumstances
  - only patentee can request
  - only if opinion found invalidity, or non-infringement as a result of a particular interpretation of specification.
  - appealable if opinion not set aside

### Implementation

- launched 1 Oct 2005
- 3 requests so far: 2 x infringement (patentee), 1 x validity (3<sup>rd</sup> party)