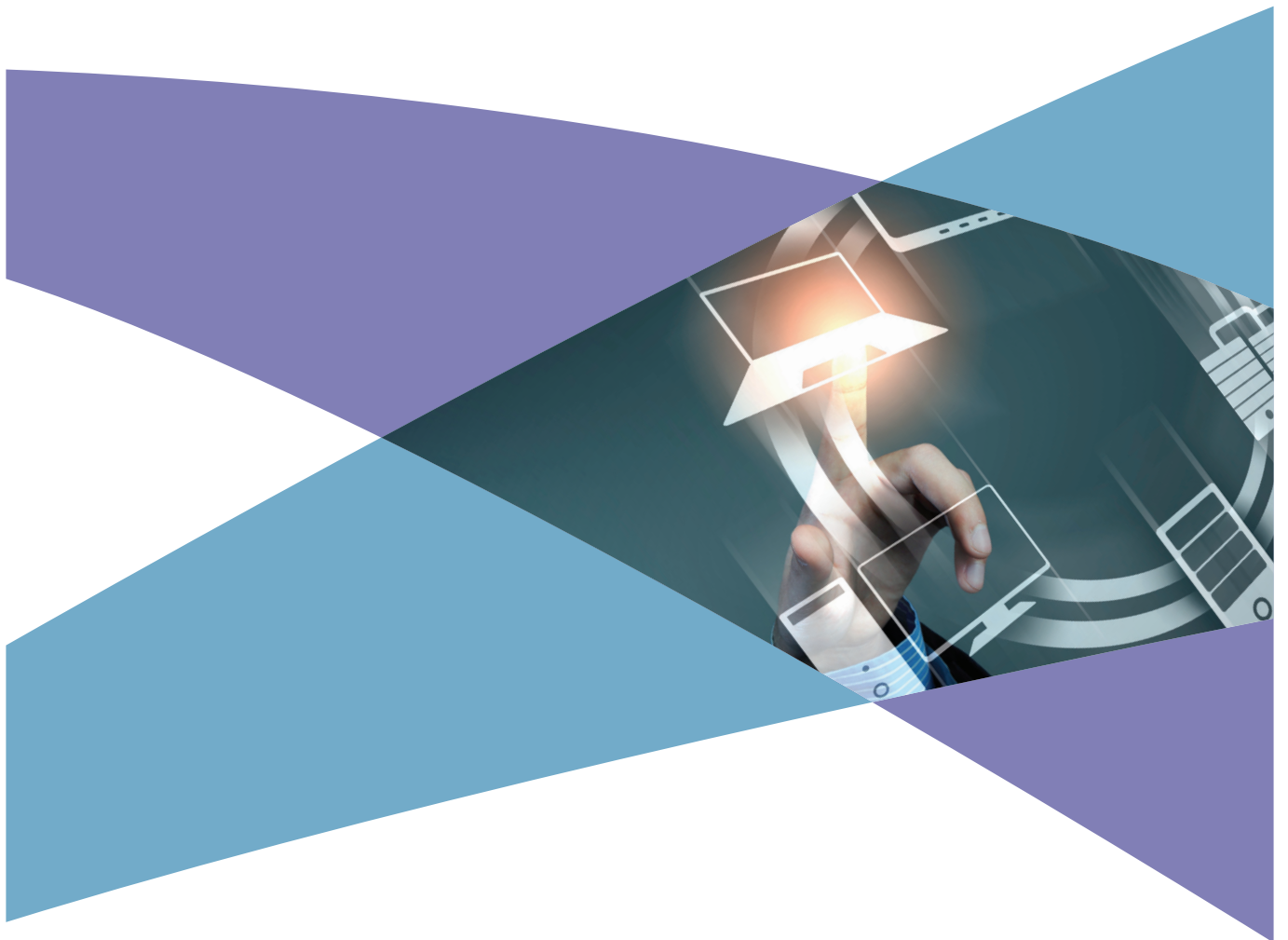


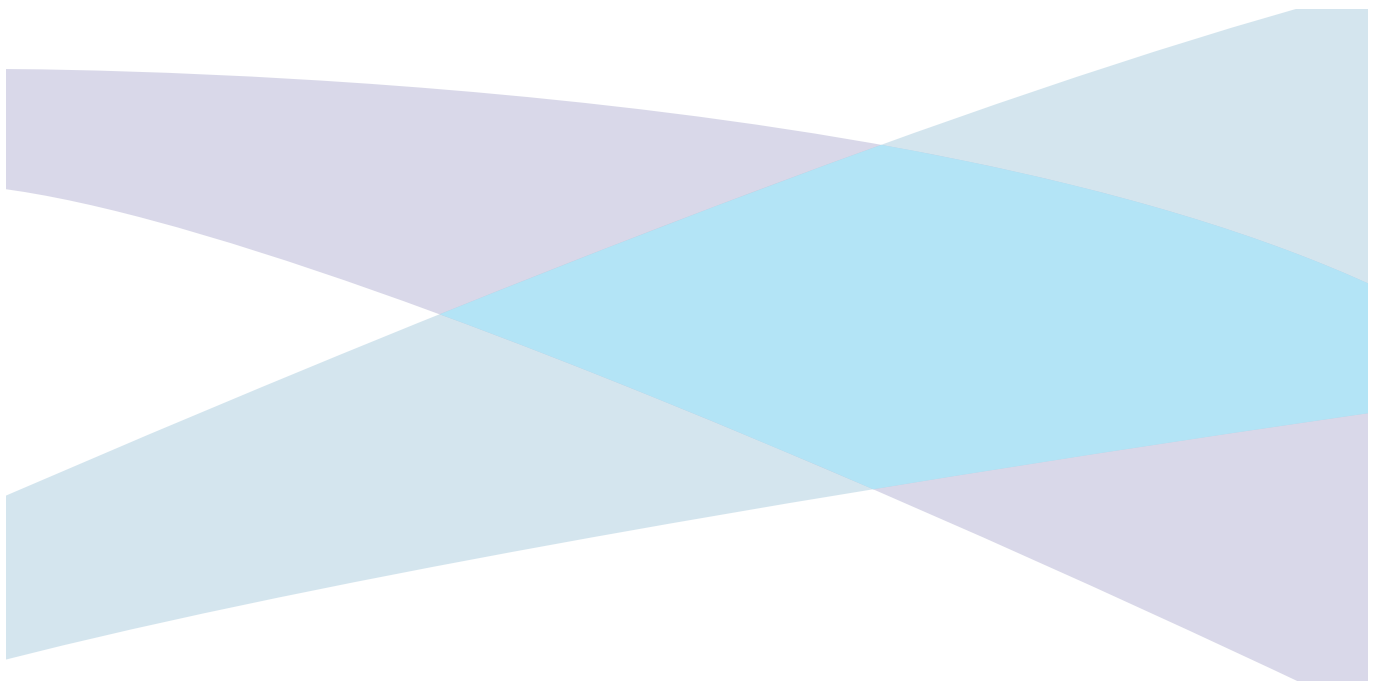


Intellectual
Property
Office

Informal Discussion Document: Publication of Patent Applications

Summary of Responses





Introduction

1. The Intellectual Property Office (IPO) launched an informal discussion document about a potential new IPO service in publishing patent applications in August¹ last year. The document sought to discover what applicants wanted from the patent system and proposed ideas on how the IPO might change its practice to offer publication of patent applications differently in the future. Alongside the discussion document, an online questionnaire was made available to a number of unrepresented applicants who had indicated a willingness to provide customer insight.
2. One of the main ideas proposed in the document was to offer publication of a patent application without requiring other patent processing. This would in appropriate cases save scarce patent examiner resource and still meet demand from some users, most notably lone inventors, for publishing a patent application without it proceeding to grant. This publication could be used for defensive purposes to prevent others gaining patent protection for their ideas but would not provide the applicant with any monopoly rights. The time saved by patent examiners could then be deployed more effectively in processing patent applications intended to proceed to grant.
3. The response to the informal discussion and questionnaire was extremely encouraging, with detailed comments from a wide cross-section of IPO users including patent professionals and unrepresented applicants. The main points raised in response were as follows:
 - the vast majority of applicants file patent applications with the intent of securing patent protection and do not use the system simply to publish details of their inventions;
 - commercial provision of defensive publication services already exists and there is no evidence to suggest there is any difficulty accessing these services;
 - there is strong demand across the board for a more flexible process for publishing patent applications, one which allows an applicant to request publication before the statutory 18 month period;
 - there is a risk that a defensive publication by the IPO would be confused for a patent application and be used by some to misrepresent their rights;
4. As a result of changes we have already implemented in the way we deal with patent applications from unrepresented applicants, our Private Applicant Unit (PAU) is now dealing with over 90% of patent applications from unrepresented applicants with very little input from specialist patent examiners. This means that any gains in examiner time we originally anticipated through the introduction of a defensive publication would now be very small compared with likely development costs.
5. Given the strong demand for a more flexible service which would allow earlier publication where desired by the applicant, this aspect will be taken forward. We can deliver this through existing streams of work in modernising our digital delivery of IP services and through our review of fees.
6. This document provides a summary of what respondents said about each of the ideas proposed in the discussion document and their other views concerning publication of patent applications.

¹ https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/341899/discussion-patent-applications.pdf

Summary of responses

Action before search

7. The first suggestion proposed in the discussion document was “Action before search”. Currently where a patent examiner is of the opinion that a patent application is unlikely to be granted, they may write to the applicant before searching the application and offer a refund of the search fee if they withdraw their application at this stage. The suggestion put forward in the discussion document would allow the applicant on receipt of such a communication to also request publication of the application without a search being carried out. Such a request would also be taken as a request for withdrawal once early publication of the application had taken place at 18 months².
8. There was broad agreement among respondents that the creation of an alternative route to publication would be an efficient use of the IPO’s resources as it would provide applicants with the opportunity of publication while reducing the burden on the remaining application procedure.
9. The main concern of respondents in relation to this proposal was ensuring that applicants and third parties were fully aware of the status of the application after publication: some respondents considered that it was important to indicate very clearly that the application was being published without search and that it would be abandoned upon publication, and some felt that a footnote on the front of the document or a note on the register would not be sufficient as this would not be picked up when conducting patent searches. A “DP” or a “C” suffix as opposed to the “A” currently employed for early publication at 18 months would provide greater clarity in freedom to operate searches.
10. It was suggested that legislative changes would be necessary to prevent the possibility of restoring such publications back into the patent application process and cause further uncertainty for third parties. Other legal provisions might also be necessary to prevent further abuses, such as simultaneously filing a first conventional patent filing and a second one for defensive publication purposes.
11. Another concern expressed by some respondents was the possibility that dishonest providers of patent services would use this procedure to obtain an official-looking publication to present to their clients without fully explaining to them that their patent rights had been abandoned.
12. It was suggested that applications published under this proposal should continue to be classified and abstracted for third party search purposes. One respondent suggested that if the publication is not to be regarded as a patent application then the name of the applicant could be removed. The same respondent also noted that patent applications are currently subject to national security considerations and require clearance prior to publication, whereas existing defensive publications do not.

13. One respondent drew attention to the very similar but now abandoned US Statutory Invention Registration (SIR) system as a possible area for further research.
14. One respondent who already uses commercial defensive publication services said that the issue of copyright in the disclosure would need to be clarified and an opportunity to correct bibliographic details, e.g. the names of the inventors, should be available. Another respondent noted the benefit of making defensive publications available in patent office searches but questioned whether the relevant databases were ever accessed.
15. In terms of demand, just over a third of unrepresented applicants said that the action before search suggestion was appealing to them. From the questionnaire responses regarding what unrepresented applicants wanted from the patent process, only 72% felt that disclosure of their invention to the public was an important consideration, as opposed to the 90% who wanted some form of certificate as recognition of being the inventor/owner and the 100% who said that the ability to stop others using, making or selling their invention was important.
16. The view of the patent profession is that this option would be particularly attractive to unrepresented applicants and might occasionally be of interest to their clients. A number of industry respondents said that they use the option of defensive publication through commercial providers on a regular basis and said that a cheaper option through the IPO would be very attractive. Given the existence of commercial invention publication services such as Research Disclosures and ip.com, one respondent questioned whether the IPO should be investing time and money in introducing a new procedure when it might be better to direct efforts at promoting these existing “defensive publications”.

Certificate of disclosure

17. The second suggestion concerned a certificate of disclosure, whereby the applicant would receive a certificate naming the applicant and/or inventors once the application had been published. The certificate would not offer the protection of a granted patent but would provide recognition that an application was made.
18. Even though 90% of the unrepresented applicant respondents to the questionnaire said that they thought a certificate in recognition of their efforts was important, there were very few detailed comments in favour of such a certificate. The one main concern that was raised was that the certificates could be misused by some to suggest that they had patent rights when none existed.
19. The general view of industry and the patent profession was that a certificate of disclosure might appeal to some unrepresented applicants but would not be of interest to them or their clients.

A more flexible patent application process

20. The final suggestion concerned a more flexible patent application process whereby the applicant could choose to have the application published at any point prior to the 18 months required by the Patents Act regardless of whether a search had been performed.
21. Some respondents said that being able to publish a patent application quickly without a search and without abandoning the application (as in the action before search suggestion above), would be of particular interest as it would be a cheaper option than using existing commercial defensive publication outlets.
22. Some respondents expressed a similar concern to that of the proposed “action before search” procedure in that the status of the published documents would need to be made very clear to third parties. In addition, the indication of prior art found as a result of search currently allows third parties to assess the likelihood that an application will proceed to grant and the scope of the likely monopoly, and without these search results a third party would have to undertake its own search in order to provide the legal certainty needed to continue with investments in R&D.
23. One respondent questioned whether an accelerated publication would have prior art effect under section 2(3) of the Act and the relationship with proposals for a grace period would also need to be properly understood. Another respondent suggested that a more flexible, faster publication process would be particularly helpful in putting potential infringers on earlier notice and could ultimately lead to faster grants and faster financial benefits through the Patent Box.
24. A number of respondents said that greater flexibility should not mean allowing publication to be delayed beyond 18 months because of the need for certainty for third parties. Some also said that the existing system of accelerated processing provides the necessary flexibility an applicant might want.
25. Overall, there appears to be strong support for the general idea of introducing more flexibility into the publication process, with a suggestion that a more detailed consultation should be undertaken.

Other suggestions for improvement

26. Some respondents said the IPO should consider offering a completely separate platform for defensive publications, such as a self-service publication website where the user could upload a disclosure in any format. The IPO could then assign a unique reference number and publication date which not only gives greater credibility to defensive publications but could be utilised in any patent searches the IPO conducts. Another respondent suggested that the IPO should use its existing publication infrastructure to produce such defensive publications.
27. Other respondents said that publication with a search report should take place well before the one year point so that an applicant can prove the existence and substance of their application to potential investors. Others said that the IPO should be publishing documents every day of the week rather than just every Wednesday as is currently the case, and also, given advancements in electronic filing and electronic publishing, it could easily reduce the publication cycle to days rather than weeks.

Conclusion

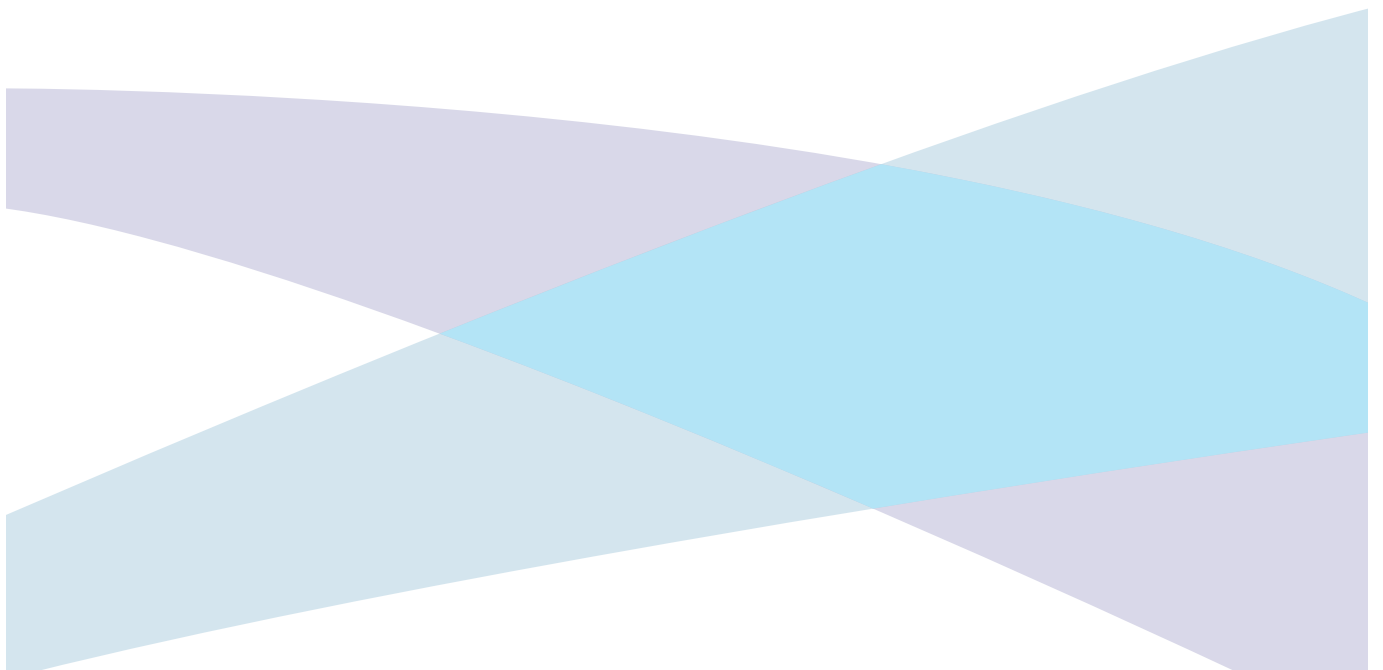
28. The comments regarding action before search suggest there is not a significant demand for such a service. Only a third of unrepresented respondents were interested in the idea and such a service is already commercially available in some format. The IPO therefore does not intend to take this idea forward.
29. The responses indicate that certificates of disclosure would be a “nice-to-have” for some unrepresented applicants but offer little wider benefit. The concerns raised about false representation of patents rights based on such a certificate therefore mean the IPO does not intend to pursue this option.
30. In light of the positive response to the third option set out in the discussion document, the IPO intends to deliver a more flexible patent application publication service through existing streams of work in modernising our digital delivery of IP services and through our review of fees.

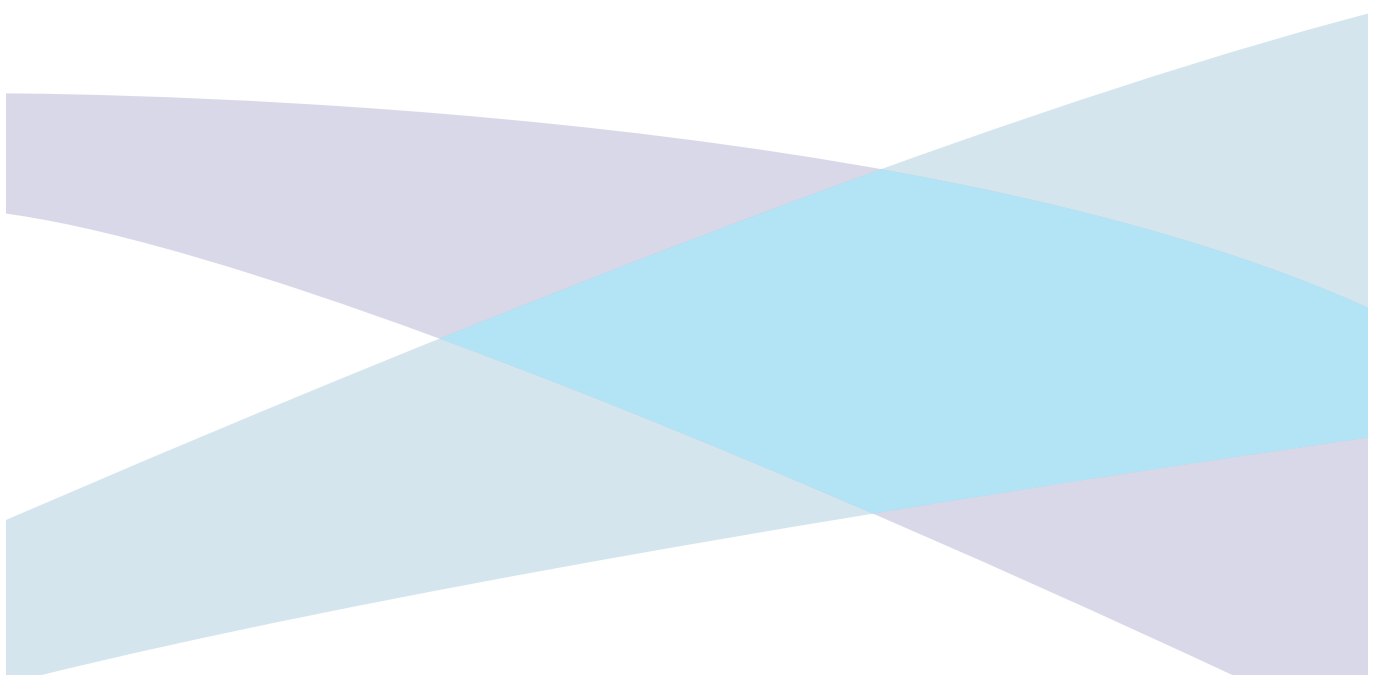


Annex - List of Respondents

The IPO received a total of 14 responses to the discussion document and 22 responses to the online questionnaire. Detailed comments were received from:

Dyson Technology Limited
Intellectual Property Lawyers' Association
Chartered Institute of Patent Attorneys
FICPI-UK
Rolls Royce
Magister Limited
Murgitroyd
Babcock International Group
GKN
AGCO
PATMG
Philip Eagle
Hardwick & Co
Syngenta





Concept House
Cardiff Road
Newport
NP10 8QQ

Tel: 0300 300 2000
Fax: 01633 817 777

www.gov.uk/ipo

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