



Expansion of the Patent Opinions Service – business guidance

Background

The IPO launched the Patent Opinions Service in 2005 to help businesses resolve patent disputes by providing a quick and affordable assessment relating to the validity or infringement of patents. An opinion, although non-binding in nature, can assist in resolving a dispute before it escalates into full litigation before the courts. Even where litigation is unavoidable, an opinion can help the parties to better focus their cases and thus save time and money. An opinion costs £200.

Current situation

Currently, the IPO can only issue opinions on the questions of (a) whether a patent is or would be infringed and (b) whether a patent is invalid because the invention is not novel or does not involve an inventive step.

If an opinion considers that a patent is invalid, it is the responsibility of the third party to start revocation proceedings if necessary. This could be a costly and lengthy process.

What's changing

Given the success of the Patent Opinions Service since its introduction, the service will be expanding on 1 October 2014 to provide opinions on a much wider range of patent disputes. It will also provide opinions on Supplementary Protection Certificates (SPCs).

In addition, the IPO will be able to start the process of revoking a patent if an opinion has been issued indicating that the patent is not new and inventive. See below for further details of how this will operate.

Detail

From 1 October 2014 onwards, the Patent Opinions Service will offer non-binding opinions on the following matters:

- whether a particular act constitutes (or would constitute) an infringement of the patent;
- whether the patented invention is new and/or involves an inventive step;
- whether the invention in question is capable of industrial application;
- whether the invention in question relates to matter excluded by section 1(1)(d) of the Patents Act 1977;

- whether the specification of the patent discloses the invention clearly and completely enough for it to be performed by a person skilled in the art;
- whether the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed;
- whether the protection conferred by the patent has been extended by an amendment which should not have been allowed;
- whether a particular act constitutes or (if done) would constitute an infringement of a Supplementary Protection Certificate (SPC); and
- whether an SPC is valid.

Currently the IPO allows a single opinion request to cover both infringement and validity of a patent, as long as the questions relate to the same patent and to a single act of potential infringement. We intend to continue this practice, such that from 1 October 2014 it will be possible to cover both validity and infringement of a patent or an SPC in one single request, and for that request to cover any number of the grounds on which validity can be questioned.

Possibility of revocation following an opinion

In addition, where an opinion request was filed on or after 1 October 2014 and an opinion is issued indicating that the patent is not novel or lacks an inventive step, the IPO will be able to start the process of revoking that patent. The IPO will only do this in clear-cut cases where the patented invention clearly lacks novelty or an inventive step. In addition, the following safeguards will exist for the patent holder:

- The patent holder will have the opportunity to apply for a review of the opinion before any revocation action is commenced.
- The patent holder will have the opportunity to provide arguments or to amend his patent to try to overcome the problem and prevent revocation.
- If the patent is revoked, the patent holder will be able to appeal this decision to the courts.

July 2014