



Intellectual
Property
Office

Discussion Document: Publication of Patent Applications





Introduction

1. Patents protect new inventions and cover how things work, what they do, how they do it, what they are made of and how they are made. If a patent application is granted, it gives the owner the ability to take legal action under civil law to try to stop others from making, using, importing or selling the invention without permission.
2. The Intellectual Property Office (IPO) is the body responsible for granting patents in the United Kingdom. Over recent years the number of patent applications received by the Office has been increasing. This means the IPO must continue to look carefully at how to balance the needs of patent applicants and the public more widely, as well as doing what is best for economic growth in the UK.
3. The IPO is increasingly aware that not all of our applicants want the same thing from the patent application process. Applicants may not need their application to proceed all the way to grant, or would perhaps like the opportunity to select aspects of the application process in a different order. For example they may be interested in having their application published quickly but are content to wait for the results of the search until a later time.

Current situation

4. The usual timeline for processing a patent application is shown below. [Publication](#) of the patent application usually takes place just after 18 months from the filing date or priority date of an application¹. This is known as A-publication. At this point the details of the application including a description of the invention, illustrative drawings and claims are published on our website to freely view and download, and hard copies are made available for purchase. The front page of the published document also includes bibliographic details like the applicant's name, the inventor's name and the date the application was filed.

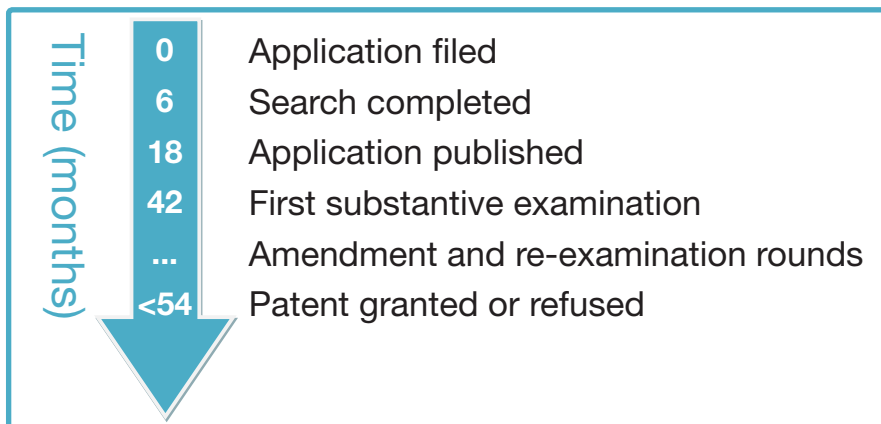


Figure 1: Typical timeline to grant for a standard patent application

¹ in accordance with rule 26(1) of the Patents Rules 2007

5. The IPO offers applicants the opportunity to have their application published earlier than this (accelerated publication); though it is our practice to only allow publication once a search has been performed. This means that anyone who is interested in the invention can see the search results at the time of publication, giving an indication of the likelihood a patent will be granted.
6. The ability to take legal action against a potential infringer (someone making, using, selling or importing your invention without permission) is only available if and when a patent is granted².
7. Publication of a patent application makes the details of an invention available to the public and therefore could prevent others from gaining a patent for the same invention in the future.
8. Publishing a patent application is not the only way of disclosing an invention and preventing others from gaining patent protection for it. For example it is possible to disclose details of an invention through a personal or company website or by using a commercially available technical disclosure service. Once you have made the details of an invention public in one of these ways, you too will be unable to obtain a patent for the same invention in the future.

Possible options for change

9. This discussion document is an opportunity to find out what applicants want from the patent application system and so enable the IPO to consider how we might use resources more appropriately. The document proposes ideas for how the IPO might change its practice to offer publication of patent applications differently in the future. We are looking to gain as much insight as possible so that we can assess whether these ideas are worth pursuing further. A number of possibilities are presented, however these are not mutually exclusive and it may be that more than one option will be pursued.
10. We are interested in hearing views on the specific points raised, on any other related issues which users think are relevant, and on the question generally of whether or not there should be more options for how and when publication takes place.

a) Action before search

11. Where a patent examiner is of the opinion that a patent application has serious issues and therefore a patent is unlikely to be granted, they may write to the applicant before searching the application. The examiner will offer the applicant a refund of the search fee if they withdraw their application at this stage. This is known as Action Before Search or ABS. Once this offer is made, most applicants withdraw their application.

² although once a patent is granted it may be possible in some circumstances to claim damages from the date of publication. Patents Act 1977(as amended), s.69(1)

However roughly 25% of such applications are not withdrawn before search and instead proceed to search and A-publication.

12. It is unclear whether applicants continue with such applications because they disagree with the examiner's interpretation and feel the application is acceptable for grant, or whether they are simply looking to have their application published. If an applicant only wants publication of their application, but not to progress further, it would seem to be an inefficient use of IPO resources to also search the application. The IPO could instead allow applicants in this position to receive accelerated publication without a search being performed. A request for publication without search in this instance could be taken to also be a request for withdrawal of the application once A-publication has taken place. In this way such cases would require no further action from the IPO or the applicant.
13. It is possible that applications of this sort can be distinguished from other A-publications by inclusion of a footnote on the front of the document, to clarify to third parties that these applications will not continue any further in the application process.
14. Publication of the specification would not offer the protection of a granted patent. It would however offer the applicant the following things: official IPO publication, the ability to stop others from patenting the same invention later, entry onto patent databases around the world and a specification describing the invention and identifying the inventor.

b) Certificate of disclosure

15. [Certified and uncertified copies](#) of documents relating to patent applications are available for purchase to prove details about a patent application. In addition (as discussed in paragraph 4) copies of a published application can be [downloaded](#) or purchased in paper form. In spite of this it has been suggested that some applicants are interested in a certificate confirming that their invention has been disclosed at publication (a certificate of disclosure). It is possible therefore that some applicants request examination of their application because it is currently only when an application has been examined and granted that any kind of certificate is produced. A certificate of disclosure could therefore be made available once the application has been published to certify that publication has occurred and naming the applicant and/or inventor(s). Such certificates could be optional and may require payment of a fee. The certificate would not offer the protection of a granted patent, but would provide recognition that the application had been made and the details disclosed.

c) A more flexible patent application process

16. The IPO is exploring what the patent application process will look like in the long term. As part of this we have plans to simplify and automate more of the process over the coming years. In an automated system

it can be envisaged that once the application fee has been paid³ the applicant could choose to have their application published at any point prior to the 18 months required by the Patents Act, regardless of whether a search has been performed. Applicants would then be free to continue with or withdraw their application in line with their particular requirements. We are interested in finding out whether there is an appetite for such a facility to be made available as part of any future electronic systems.

17. Questions

Question 1: Would any of the options discussed above be of interest to you, and why/why not?

Question 2: Would any of these options increase or decrease the number of applications you file?

Question 3: Would the availability of the options above make you more or less likely to request search and/or examination at the IPO?

Question 4: Would the options above impact you as a third-party rather than an applicant?

Question 5: Should there be more freedom over when publication takes place? Why or why not?

Responding to this discussion paper

18. Please email your responses, including any answers to the above questions and any other views you may have to: consultation@ipo.gov.uk

Alternatively, please use the following postal address:

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19. Please let us have your comments by 26th September 2014.

20. Responses are welcomed from any individual, organisation or company. Copies of this document, including large print versions, are available from the contact address given above.

Openness and confidentiality

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