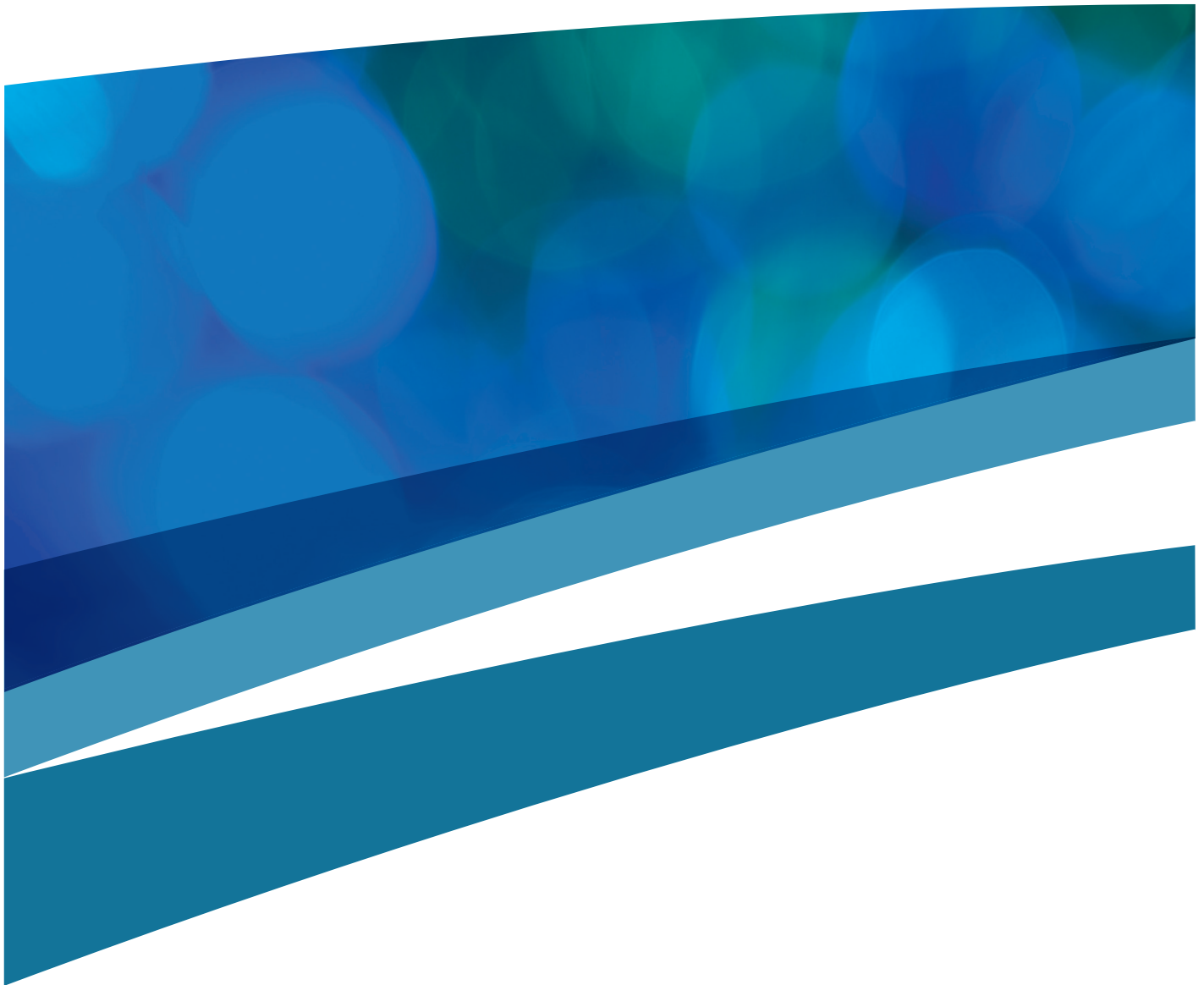




Intellectual  
Property  
Office

# Customer Visit Programme 2014





# Contents

Foreword.....	1
Summary .....	2
Introduction .....	3
Customer Visit Programme (CVP) - An overview .....	4
Patent Matters .....	6
<i>Filing Strategies</i> .....	6
<i>Patent Prosecution Highway - PPH</i> .....	8
<i>Unitary Patent and Unified Patent Court</i> .....	9
<i>Patent Box</i> .....	10
<i>EPO Service</i> .....	11
<i>Search and Examination Practice</i> .....	13
<i>Acceleration Services</i> .....	14
<i>PCT National Phase</i> .....	14
<i>Examiner Training</i> .....	14
<i>Ipsum</i> .....	15
<i>Grant Certificates</i> .....	15
<i>Patent Formalities</i> .....	16
Trade Marks .....	17
<i>Filing strategies</i> .....	17
<i>Application form and process</i> .....	17
<i>Speed and quality of examination</i> .....	17
<i>Correspondence Method</i> .....	17
<i>Enforcement abroad</i> .....	18
<i>Website and pointing to the Profession</i> .....	18
<i>Web-search</i> .....	18
<i>Practice questions</i> .....	18
Designs.....	19



E Services.....	20
<i>Online Patent Renewals</i> .....	20
<i>EOLF Software</i> .....	20
<i>MyIPO</i> .....	21
<i>GOV.UK</i> .....	21
Finance Services.....	22
<i>Fees</i> .....	22
<i>Deposit Accounts</i> .....	22
<i>Blank Receipt Forms</i> .....	22
IP Bill .....	23
Dispute Resolution.....	24
<i>Patents Hearings Practice</i> .....	24
<i>Trade Mark Tribunal</i> .....	24
Opinions and Mediation .....	24
Business Support .....	26
<i>Small firms</i> .....	26
<i>Guide to Sources of IP Finance</i> .....	26
<i>IP Attachés</i> .....	26



## Foreword

Obtaining first-hand the views of customers is not something government departments and agencies have traditionally been renowned for – and even less, perhaps, for acting on what they are told. There has historically been a reliance on written consultation processes or surveys to gauge opinion.

This is where the IPO's Customer Visit Programme comes in. People working at the sharp end of patents, trade marks and designs delivery, together with customer insight colleagues from Innovation Directorate, have once again this year gone out and met customers all over the UK. Mostly this has been in their places of business, but we have also met a wide range of customers at events in London and Glasgow, which have particularly highlighted the intense pressures that small firms face in the IP community.

I am extremely grateful to the many people who given us their time in our customer visits over the last year. Their open, informative and constructive discussions with our visit teams have considerably enriched our understanding of the IP world.

I am naturally very pleased with the high regard in which many in the attorney and business communities hold the IPO, its people and its services. Of course I believe our people are our greatest asset, and I am proud when our customers tell us that too. But while positive feedback is always warming, it is the constructively critical comments which are the real nuggets which the Customer Visit Programme is intended to unearth. This report demonstrates how much we have learned about how we can make our services better for customers, and what new services we should be developing. It also shows what we are doing in response to what we have learned. The launch of a digital patent renewals service, which has proved extremely popular, is an excellent example of how speaking directly to our customers to get their views, suggestions and opinions enables us to develop a service which is truly centred on their needs.

The Customer Visit Programme is an important tool for the IPO and makes a major contribution towards shaping our services. I hope you will enjoy reading this report of its work. If you have any comments about it, please don't hesitate to get in touch with the programme leader, Nigel Hanley (Tel: 01633 814746), [nigel.hanley@ipo.gov.uk](mailto:nigel.hanley@ipo.gov.uk).

A handwritten signature in black ink that reads "Sean Dermotsey". The signature is written in a cursive, slightly slanted style.

Deputy Chief Executive



# Summary

## Purpose

The IPO has a statutory responsibility for granting IP rights in the UK. In fulfilling that statutory requirement we need to both maintain existing and develop new services and products to ensure we can fulfil our responsibilities but also that will meet the needs of our customers whether they are a multinational company or a small firm of one or two people.

To get the intelligence we need to carry on delivering a world class service we need to engage with our customers. The Customer Visit Programme is a vital resource for us in doing this and has established itself as a valuable source of information.

## The Visits

This year we have visited over 20 customers. We also held customer events in London for small attorney firms and sole practitioners and in Glasgow for Scottish Firms.

All the Customers we met appreciated the opportunity to meet us and we are more than grateful for their time. As an office we are extremely grateful for the often candid views and opinions that Customers expressed both on our existing service levels but also on our ideas and plans for new services.

## Conclusion

This is the second year of the visit programme and as in the first year we have received rich and varied views from our customers about how we deliver our services and our plans for the future. The information we gather greatly assists us in improving our service delivery. Notable areas this year include:

- The continuing importance of the six month search target in filing strategies
- The ever expanding need for E Services and the desire for customers to be involved in both development and testing
- Views on the EPO
- Views on the Unitary Patent and Unified Patent Court
- Supporting Business



## Introduction

The Patents, Designs and Trade Marks Directorate (PDTMD) within the IPO is responsible for the grant of Patent and registration of Design and Trade Mark rights. In collaboration with our colleagues in Innovation Directorate we carry out a number of visits and hold customer events to gauge their views on using our services and products.

The office has many formal consultation procedures and various official working groups which cater well for policy discussions with our stakeholders. However, whilst these work well for major policy changes they do not work so well in the day to day delivery of services where we need to deal with issues in relation to the transactions involved in delivering rights to our customers.

This is the second year of the Customer Visit Programme (CVP) and we have built on the foundations of the first year to further our knowledge of the views of our customers about how we deliver our services. This year we have also broadened our programme to try and hear the voice of the smaller attorney and sole practitioner customer by holding events in London and Glasgow.

The CVP has continued to provide other opportunities for us. It has allowed us to raise the profile of new services such as the Global PPH and the opportunity to further explain the provisions of the new IP Act. It also gives us the opportunity to get our customers' input on specific projects and get ideas for other services where we cannot easily use the consultation process. The informal environment of a visit is also a great opportunity to exchange views on how we work with each other and to work to solve any problems we have in the way we work with each other. Our experience has shown that this final point can really help lead to a strong relationship between us and our customers.

# Customer Visit Programme (CVP) - An overview

## ***The Benefits***

The CVP is a positive engagement exercise with our customers that has been cost effective in achieving its goals, most notably:-

- Continuing to develop as a vehicle for customer engagement using a combination of visits and events to reach customers of all sizes.
- Continuing to raise awareness of products and services offered by the IPO and also to obtain customer input and engagement for the development of new services.
- Internally, it has provided a vehicle for building relationships between staff involved in rights granting and those in other Directorates in the office strengthening our customer service.

## ***Service Profiles***

Our Customer Visits have continued to raise the profile of the following services:

- The Patent Prosecution Highway (PPH) particularly the Global PPH
- Patents Opinions service
- IPO Mediation services
- Changes in law due to the IP Act 2014
- The implementation of Gov.UK
- The Patent Box
- IP Attachés (with China of particular interest)
- Online Patent Renewals Service

## ***Intelligence***

We have also received substantial intelligence on the following areas:-

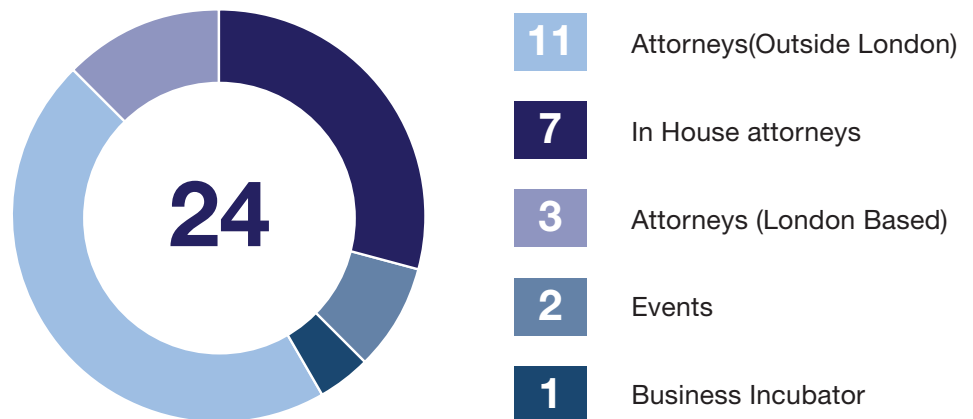
- The 6 month search target and relationship with filing strategies
- Views on service provided by the EPO
- Patent and Trade Mark practice
- Attorney use of IPO designs service
- The Unitary Patent and the Unified Patent Court



- Use of Finance services
- Business Support Services
- Ipsum

### **Customers: Numbers and Type**

As of 31<sup>st</sup> December 2014 a total of 24 visits or discussions had been held with our customers. Of these we visited 19 at their own premises; we held two events in Glasgow and London and hosted 3 visits at the IPO. On 7 occasions we were accompanied by the Chief Executive of the IPO, John Alty.



### **London**

Understanding the views of all our customers is important to us and we held a Customer event at BIS Conference centre in London for smaller attorney firms and sole practitioners. This was attended by 13 Patent and Trade Mark attorney firms and was opportunity to discuss a number of issues with IPO staff and included a question and answer session with John Alty, Chief Executive of the IPO.

### **Glasgow**

We are also aware of the need to speak to customers in all parts of the UK. Over the last two years we have spoken to firms all over England and Wales and this year we held a customer event at The Mitchell Library in Glasgow which was attended by 7 firms from across Scotland.

### **Chief Executive**

On six visits this year we were joined by the IPO Chief Executive, John Alty. This gave the firms visited the opportunity to provide views on a wide range of subjects beyond the normal range of subjects covered during customer visits.

# Patent Matters

## Filing Strategies

### *Search Target*

The search target of 6 months is a major driver in the filing strategy. The provision of a search within this time and the general quality of the search provides attorneys and their clients with time to make a careful decision on international filings.

### *Costs Associated with International Filing*

A number of firms and attorney groups have made clear that the cost of international filings is now an important question in how they proceed. It has become clear that the question of where to file is perhaps better phrased as where else do I file other than the United States. Even for clients or applicants who would be considered to be multi-nationals, where they file is becoming a question of both cost and effectiveness. Whereas in the past they would automatically have chosen the EPO for Europe there is a marked change to an interest in national patents with the UK and Germany being considered as the primary markets.

### *The PPH*

The PPH is becoming increasingly important in filing strategies adopted by firms. This appears to vary between a consideration that it may be of use to an active decision being made to file to use the PPH. In terms of filing a key consideration is that the speed and quality of the IPO provides advantages to customers to consider the IPO as the office of first filing.

For example, one customer explained that the PPH formed an active part of the filing strategy adopted. Using a combined search and examination followed by an international filing, assisted them in obtaining an early grant which could then be used for accelerating processing in their key markets, all of which were covered by the Global PPH.

### *Combined Search and Examination (CSE)*

The CSE is becoming a very popular first tool for attorneys. The additional benefit of having an examination report setting out the examiner's understanding of the application, and in particular how the prior art reads onto the claims, is considered very useful. When coupled with the speed at which we complete the search this affords the applicant plenty of time to make a decision for any priority filings or even to file a further CSE taking into account the examiner's reports. The use of CSE is also seen as the ideal starting point when a PPH application is being considered.



### *Subject Matter Specifics*

Subject matter appears in some cases to determine whether an application is filed with the IPO. Although not widespread there was a suggestion made by several attorneys that for some computer implemented inventions an EPO filing is preferred given the perception that this is more likely to result in a grant. We were also told by some that in the life sciences and some chemical and pharmaceutical areas a UK search is seen as helpful, but is likely only to serve as a priority for an international application.

### *Business Support*

This was an interesting area for discussion with a number of smaller firms. How and why a patent application is filed for some will depend on several factors of which two appear to be key, seeking proof of concept in an idea and/or this being used as a tool for leveraging finance. It was made clear to us that in cases like these the first or even second filing may not be further prosecuted as these are used to effectively refine the product being developed leaving perhaps the third or fourth as the patent application that will be pursued to grant. As one attorney put it, this does actually depend on the applicant still being in business.

We are aware of our customers' views on the need for a search within 6 months of request and will continue to make this a priority.

Our aim is to provide a fast and efficient service and the use of the CSE is seen as a valuable tool for that purpose. Indeed, it is one of the reasons we will continue to monitor the timeliness of CSEs as a ministerial target. We are also pleased to see that the work we have done in publicising the PPH is helping our customers.

The information customers provide us on their filing strategies is extremely useful and it continues to inform our priorities.

## Patent Prosecution Highway - PPH

In the first year of the programme we spent some time and effort to raising the profile of the PPH. In the second year we have noticed that it is now a significant factor in the filing strategy of a number of applicants. Specifically, the speed and service offered by the IPO through the Combined Search and Examination *route* makes the IPO attractive as an office of first filing.

The Mottainai approach has also been welcomed, as has the signing of a PPH agreement with China.

The Global PPH has also been welcomed and several customers have expressed support for the system. In particular, the inclusion of ROSPatent and the Swedish office have been seen as particularly useful.

Going forward, it is clear that many attorneys are now aware of the system and it forms a significant factor in how they approach international filings. It is also clear that fundamental to this is the IPO's ability to provide a fast and efficient service leading to an earlier grant than most offices. Expansion of the PPH has also been raised on a number of visits with India and Brazil being seen as helpful to their applicants.

Use of the PPH as a reason for acceleration was welcomed by most firms.

We welcome the response that the continued development of the PPH system and the increase in the number of the IPO's agreements has been well received. It is very encouraging that awareness of the PPH has increased and that the PPH has started to become a notable aspect of international filing strategies.

We continue to view the PPH as an important aspect of the global patent system and will work to expand the PPH network and to improve the attractiveness of the system for both users and other intellectual property offices.

## Unitary Patent and Unified Patent Court

### *Unitary Patent*

Attorneys and their clients continue to express concern about the unitary patent and the lack of information on renewal fees. It is suggested that this uncertainty is leading some to consider or to actively pursue a limited number of national patents in leading markets rather than seeking European Patents. Interest in seeking patents through national offices might also be influenced by a general uncertainty of how the Unified Patent Court will operate.

### *Unified Patent Court*

It would be fair to say that the Unified Patent Court is viewed somewhat cautiously by many attorney firms. Court fees are an unknown factor. Many have also raised a specific concern over a potential fee to opt-out. If there is to be a fee to opt out, firms are in favour of the fee reflecting the cost of administering the opt out rather than it being applied as an incentive to remain in the system. The establishment of a Central Division dealing with life sciences based in London was widely welcomed.

The EU-wide scope of protection of the Unitary Patent and the jurisdiction of the UPC has prompted some firms to consider the impact of this on their filing strategies. For UK applicants and attorneys there is certainly a wait and see attitude whilst the new system beds in.

The UPC Taskforce has been engaging with stakeholders, so the above comments from customer visits are not unexpected. The Taskforce is taking into account views from stakeholders in order to assist with developing some of the detailed working of the court.



## Patent Box

For much of the year customers' viewed the issue of the Patent Box as helpful though filings as a result had remained static or only slightly up. Several firms, as in the previous year had suggested they were *able* to provide or *were* already offering a service to help their clients exploit the Patent Box. In one instance there was a suggestion that they would consider holding their IP in a separate company to make the tax calculation easier. In another instance we were told a US company had relocated their IP to the UK in order to take advantage of the tax relief.

One firm had noted that they had seen new clients as a result of the accountancy profession being more aware of the Patent Box. However, their experience was that this had led to a rise in Trade Marks and Designs rather than an increase in Patents as they became more aware of IP rights.

There was also evidence that some applicants had moved towards a narrower claim set and linked directly to a product to maximise the tax benefit. The benefit from the Patent Box also made a UK grant a valuable asset given the delay in obtaining a grant at the EPO and incurring of maintenance fees.

Towards the end of the year it was announced that the Patent Box regime will change. What was clear from the views of attorneys visited after this change was that they were unclear as to where this left the Patent Box and more information was requested.

We have noted customers' feedback on Patent Box and await further detail on the details of operation of the new scheme. The Government expects to consult stakeholders on the details of the new scheme by *Autumn 2015*

## EPO Service

There have been some strong and forthright opinions offered on the service provided by the EPO. In many visits this proved an area where many attorneys freely offered their views without being pressed by the team.

Maintenance fees are a regular bone of contention with attorney firms. As a result of current EPO time scales many are paying these fees and in their words “not receiving a service”. It was not unheard of for attorneys to discuss cases that have been waiting for anything from 16 years upwards and in several cases 19 years. Comments were also made that this has a far more detrimental effect on SMEs. One particular view was that this is very much the case with computer implemented inventions, where the view that due to delays and costs, this was now a province for multi-nationals only.

Speed of service was also mentioned. Many attorneys were aware of PACE and it had been used, though there was a view that this was detrimental to other cases. Even with PACE there was a general view that it was still no quicker than using the IPO. The IPO in comparison was rated very favourably on speed and as one attorney put it “you can request acceleration and it accelerates”.

As an ISA the EPO is still well respected. The point was made that whilst Korea was cheaper and quicker if you wanted a proper search the only alternative was the EPO. As in past customer visits the prospect of the UK becoming an ISA was raised by a number of attorneys.

Comments on the quality of EPO examination have also figured this year. Search is generally viewed by attorneys as “as good as ours” or in some cases better. We have often explained that the EPO has the benefit of our search and their examiners work in smaller more defined areas of subject matter. This however should not hide the fact that several firms did raise this issue.

Examination practice was also raised on a number of occasions where it was felt that this in some part depended on whether your application was dealt with in Munich or The Hague. Plurality issues were specifically mentioned with Munich appearing to have a different approach to The Hague.

Inconsistency of approach to excluded matter was also raised with a wish by many that we would follow the EPO. The EPO approach appears to be favoured for two reasons, firstly that they are more lenient on computer programs and secondly because it is easier to operate and explain the inventive step approach used by the EPO. In all instances it was clearly explained that we have no choice other than to follow the UK courts and it was not open to us to change practice until instructed to do so by the courts. This was not always universally liked.

The accessibility of examiners was also raised on a regular basis. It was felt almost across all visits that the ability to speak and discuss a case with an examiner was a good thing and something the IPO allowed. However, the EPO examiners were not always so accommodating.



Towards the end of year several attorneys raised the issue of EPO staff relations.

It is in the interest of all UK stakeholders for UK representatives to play an active role in the governance of the EPO, and we will continue to do so. The UK Intellectual Property Office is in regular contact with relevant stakeholder organisations and is always willing to answer any questions that attorney firms and other users have about UK oversight of the EPO as a member of the Administrative Council



## Search and Examination Practice

Overall this year has seen fewer issues raised about Search and Examination practice.

### *Examination Opinions*

Examination Opinions accompanying search reports are on the whole welcomed. They provide a good understanding of the examiner's thoughts on an application. Opinions issued on 17(5)(b) cases were especially welcome as they provided a good basis of discussion with the applicant on how to continue. There were several views suggesting that these should become a standard feature of a search. Another view was that unless response to them was compulsory then some were unlikely to take any action until they were reissued as an examination report.

### *Excluded Matter*

Excluded matter was again a subject for discussion at many meetings. With a few exceptions UK practice is now clearly understood and accepted amongst the profession. That is not to say that they always agree with it as some suggest EPO practice to be superior. One issue that did arise from the visits was that once outside the traditional computing areas the practice is not always consistently applied. This has led to some unexpected problems for some applicants that can negate the advantage of seeking an early UK search.

### *Compliance Periods*

The section 20 date is welcomed by many though a view was expressed that it can lead to a lower quality examination report than our usual standard given that many examinations are now routinely setting a 12 month compliance period. That said many attorneys welcome the section 20 period and its role in assuring cases do not drift as has been the experience of some at the EPO.

### *Communication with Examiners*

Communication with examiners was welcomed by all those visited. Many asked for early communication whenever possible especially where an examiner was considering issuing a report under 17(5)(b) or recording claim 1 at least. In these cases it was felt that some form of discussion would be a positive step towards more efficient processing of the claims.

The overriding message given by attorneys is that they find the IPO delivers a high quality service within good timescales.

## Acceleration Services

The possibility of accelerating cases was raised at most meetings and whilst there was some awareness not all were fully aware of how this can be done. A number of attorneys did raise the question of being able to choose the order of examination of cases in their portfolio and asked that we consider something like this within the online case viewing service being developed.

## PCT National Phase

The PCT fast track was welcomed but it was felt that national phase applications should receive this treatment irrespective of whether there was an amendment on file. PCT costs were high and it was felt and given that the work of other offices could be utilized in an examination it was felt that this would justify more accelerated treatment. In one instance a firm used the speed of service as reason to recommend the IPO to its clients and then found it somewhat difficult to explain that it would not be examined for several years following publication.

## Examiner Training

In many visits we acknowledged the existence of the backlog of cases awaiting examination. In doing so we highlighted the current recruitment campaign and our intention to recruit 150 examiners over this and the next two years. Many attorneys welcomed this but sought assurance that the training overhead would not further increase the backlog or lead to a diminution of the high standards of examination they have grown to expect from the IPO.

In these instances we explained how we had overhauled training with the advent of the new NEST programme. As part of this discussion attorneys welcomed the assurances and in many cases were open to approaches for help or assistance where they could.

As a result of last year's programme we have been able to follow up on technical training of Examiners.

In a further case the relationship with one attorney meant we were able to host an EPO Examiner as part of the Externa Practica programme. This allowed examiners in our Computing Group (EX04) to have the opportunity to understand the EPO approach to excluded matter

We are pleased to see the use of Examiner Opinions is welcomed by our customers especially in the area of Excluded Matter.

We recognise concerns that we do not dilute our strong training and quality standards, and have invested heavily in ensuring that our new training programme maintains these. We remain committed to ensuring that we have sufficient examiners to provide a high quality and timely service to all our customers.

## Ipsum

Ipsum is a popular tool amongst attorneys and several made suggestions for its improvement. These included issues concerning licence of right and making SPC information available.

The ability to make Section 21 observations from Ipsum would be welcomed.

In response to feedback from our customers, we've introduced improvements to our on-line Patent Information and Document Service, Ipsum. The changes are designed to make it easier for customers to file observations on the patentability of published patent applications. We have also provided additional information on patent compliance dates and licence of rights which have been recorded on granted patents. These changes went live at the beginning of March 2015

## Grant Certificates

Our grant certificates are considered less than impressive. Several attorneys asked for something a bit more substantial. For many small firms the certificate was seen of something of value that was not reflected in the existing offering. Chinese and US grant certificates were considered to be good examples.

## Patent Formalities

Formalities teams have continued to support the visit programme with staff spending significant time with Records and Formalities teams in various firm's offices. This has allowed them to develop relationships with firms which have resulted in increased communication between the two which has in some cases avoided potential problems.

Drawings were once again raised as an issue though this was less than last year. The main problem appears to relate to consistency of approach when a number of applications were filed with the same drawing set. An issue was also raised with a drop in quality of the images due to conversion of images from online PDF to a format used in the online system.

Attorneys would also welcome the ability to file colour drawings or even other forms of media. Reliance on black and white drawings is considered somewhat Victorian given developments in technology.

Filing Priority documents was also identified as an issue and particular where the DPMA was concerned. Firms have become used to the PDAS system and find it saves both time and effort. However, this is not available for the DPMA and the current procedure requires manually filing a Form 23 with the IPO to obtain a certified copy. It was suggested that Form 23 be made available online as manually filing is considered archaic.

Formalities staff were actively involved in the visit of other Government IP Staff to the IPO and hosted a separate session. As a result of that session there is an open offer for Formalities staff to spend time with the other Government IP departments for training purposes.

The lack of an online version of Form 51 was raised on a regular basis.

The CVP has proved a useful opportunity for our Formalities staff to discuss issues with their counterparts in attorney firms. This has allowed us to establish not only good working relationships but has also allowed us to explain our practice and understand how the attorneys work. In some cases the better understanding of our processes has led to Attorneys changing their practice for the benefit of both. One such area has been in filing replacement specifications at the amendment stage.

We have also noted the comments on providing electronic forms and issues experienced with drawings. Though the solution is not always in our hands as we are reliant on scarce IT resources and international rules attorneys comments are noted and are being used to inform our practice.

# Trade Marks

## Filing strategies

Generally speaking, Trade Mark Attorneys recommend first-filing in the UK due to the speed of examination and the quality of the subsequent right which is granted. This application is then used to secure protection in other territories. Due to international markets, some larger corporate filers use OHIM directly due to their need to protect their trade mark in wider jurisdictions.

## Application form and process

Formalities staff were in the main responsible for submitting the application form and the general comments were that the new form is easy to complete. TMClass received some negative comments regards lack of terms on the searchable database. The Trade Mark Classification Team received praise in this regard though and was cited as being helpful and informative whenever there is a classification query at the time of filing.

## Speed and quality of examination

The overwhelming feedback from visits is that Trade Mark Attorneys, and large corporate filers, are very satisfied with our speed and quality of examination. Direct contact with the case examiner is much appreciated and the IPO compares favourably in terms of clarity, quality and accessibility with the OHIM, WIPO and the US.

## Correspondence Method

Some Attorneys do not realise they can reply direct to the examiner by clicking on the hyperlink in the examination report (which routes the letter directly to the examiner's in-box) - they assume they do not get confirmation of receipt so instead fax or send in a hard copy. Some who do use the reply link really like this and welcome the PDF confirmation of what has been received, so they have proof of reply at their end. As covered under the 'MY IPO' umbrella comments, all Attorneys said they would like full access to correspondence portfolios so they can view incoming and outgoing correspondence on their files and third parties' files too, when appropriate. General perception that we are equal, or probably better than OHIM on accessibility and processing of cases, but we fall behind regards our e-service offering.

## Enforcement abroad

The theme of difficulties enforcing in overseas markets, such as China, came through in the discussions. The high profile visits the IPO has had to China were mentioned, along with the work of our Attachés. General concerns were raised regarding a need to lobby for better fairness and timeliness in these jurisdictions. A major concern, in particular, is Chinese companies registering well-known brands before the legitimate owner can secure rights in these emerging markets.

## Website and pointing to the Profession

There was general commentary around a perception that the IPO does not promote the benefits of seeking legal advice prior to filing. This was a specific issue raised both before and at the London meeting where it was suggested that we concentrate to heavily on the Patent attorney profession. It is appreciated the Government is driving to make access to business more readily available, which is understood, but it was felt that our website, for instance, does not set out the role of the profession prominently enough.

## Web-search

General comments were that our web-search facility is more user-friendly and useful than TMView. Some enhancements would be nice to make searching for other owners' portfolios more comprehensive. Other professional users employ third party search companies to carry out this type of work on their behalf.

## Practice questions

There were only a couple of queries regards practice issues. Some wanted clarification of our policy on protection afforded to 'black and white' marks. There were some comments regards a perception that we have 'toughened-up' on criteria for acceptance of a series of marks, although no examples were provided. The impact of new TLDs was also raised and what, if any, impact this would have on trade mark practice/policy.

The majority of the feedback was positive and subsequently the main message in the short term on these issues was to carry on as we are. We do though fully intend to continue to monitor customer feedback and will use the results of the Customer Journey Mapping exercise (the results of which are due Summer 2015) to enable us to prioritise any improvements.

## Designs

Following the initiation of the Designs Modernisation project the CVP team cooperated with the project team to seek views from attorneys on the current filing system and options for the future.

Almost all those asked observed that OHIM was their first choice for filing a design. There were several reasons for this:

- i. The coverage offered by a European design was far superior to a UK only design;
- ii. The cost of an application at OHIM at twice that of the UK, made an OHIM application far more cost effective in terms of value for money;
- iii. OHIM have an online service which was easy to use and further contributed to the making it a value for money service. For several attorneys an online service would have to be in place before they considered filing at the IPO.
- iv. Manually filing documents for a UK design was expensive and laborious in comparison to OHIM

Many firms we visited who did design work were more than willing to work with the project team to develop and test any online service offering.

We are in the process of implementing an eFiling service for Designs, and we are actively involving customers in shaping and testing this service so that it meets their needs.

We are planning a review of our application filing fees, and our Designs renewal fees – the aim will be to ensure that the UK offering is competitive, and is seen as an attractive proposition for UK business who do not need European wide coverage.

We have taken note of the contacts that have been provided, and they will be invited to be part of any further shaping work and/or consultative processes that we take forward as part of Designs modernisation.

## E Services

Most of our 2014 customer visits included a member of the Customer Insight team. Their meeting objectives were to:

- Build our understanding of how customers use IPO online services.
- Ensure the customers were aware of key changes that IPO planned to make to online services
- Test customer appeal and interest in new service development proposals and capture feedback and preferences on our proposed approach.
- Engage customers in testing service prototypes and in trialling new services

The new and emerging services discussed at 2014 customer visits included, the online Patent Renewals service, the Gov.uk website, the EPO's CMS service which will replace EOLF and the development of the MyIPO concept.

### Online Patent Renewals

Customer feedback obtained through customer visits in 2013 had shaped the design of the altogether new patent renewal service at [www.gov.uk/renew-patent](http://www.gov.uk/renew-patent). We also used the visit programme to recruit triallists for a 'beta' phase which started in November 2013. In all 25 triallists put the service through its paces through to March, with their feedback helping us to refine and improve the service. In April we then opened the service up to our wider customer base and by the end of the year it has been used to successfully complete over 11,000 renewals from customers in over 50 countries. We have already seen a big reduction in the volume of renewals made on paper forms and customer reaction has been exceptionally positive.

### EOLF Software

In 2014 we have seen through the visit programme growth in customer awareness of the EPO's planned replacement of their EOLF software. We acknowledge that there remains strong demand for EPO's filing solution to continue to offer the ability to file UK applications at the IPO and we have initiated discussions with the EPO in this vein.



## MyIPO

In 2014 our MyIPO work moved out of initial concept and grew into proof-of-concept development work. Patent Attorneys and Records Managers we met during customer visits supported our development of an online facility that they could log-onto to view and manage their pending cases and associated reports. A proposal to allow re-use of EPO smartcards for a secure log-on also met with strong approval during visits and this is now the focus of development work in this area.

## GOV.UK

October 6 2014 saw IPO move its website to the Gov.uk site. In the run-up to this transition customer visits were an opportunity for us to develop awareness of the move and critically, get feedback on our proposed new information architecture. During visit discussions concerns over losing the much valued 'IP Professional' area of the IPO website came to the fore. This feedback really helped IPO make the case for developing the 'Law and Practice' area which is accessed from our new home page at GOV.UK/ipo and which contains all of the options previously located under 'IP Professional'.

The Customer Insight team would like to thank all the people we met through the visit programme over the last year for their openness, time and constructive feedback. We are using that feedback to make the case for investing in new development work and to shape our priorities.

We are encouraged that there is a strong appetite for IPO to expand its range of online services. We also greatly appreciate the readiness customers have shown to work with us in developing services that will meet their needs.

## Finance Services

Most CVP visits raised the question of whether we should continue a Fax Filing service. Most attorneys wanted such a service kept even if only for emergencies. This view became more prevalent the further from Newport or London you travelled.

Another common reason for not ending fax filing was the unavailability of some forms on the Web Service. The presence of Forms 23, 51 and 52 was heavily requested in this regard.

## Fees

Fees for IPO services were raised by a number of attorneys. It is fair to say that many see the fee level as low which contributed to the IPO being seen as very good value for money. Many attorneys proffered the opinion that we should charge more for our services.

## Deposit Accounts

We also asked about the future operation of deposit accounts in part promoted by the recent EPO service update. All attorneys who have a deposit account would like to see a version with online access. They also specifically asked that it showed up to date real time balances as many had experienced difficulties with the similar EPO service.

For some an ability to update their account online was welcome, and in one instance given as a reason that stopped them from supporting the removal of a fax filing service. However, in some cases particularly where there is an in-house attorney team this would be of little help given the need to work within internal accounting systems. Many offered their services to assist in developing and testing any system.

## Blank Receipt Forms

An issue was raised with the issue of blank receipt forms by email for forms that do not bear a fee. These were considered unnecessary and wasted time opening the email and then the attached form. We were asked to consider ending this and save time and effort for both the IPO and the customer.

We welcome the comments and suggestions made at what is a very opportune time as we are currently reviewing our ways of working alongside the development of our finance and rights granting systems. We will feed all of these suggestions into our projects.



## IP Bill

The IP Bill/Act was discussed at many meetings. In many cases attorneys were grateful for the guidance and information provided, highlighting the key changes for Designs and Patents. There was little comment on the substance of the changes, with customers seeming to be happy to leave the discussion of the more contentious issues in the hands of their representative organisations (who were closely involved in lobbying during the Bill's passage).

Linked to this the visit teams probed on customer awareness and interest in the new provisions for patent webmarking that came into force on 1<sup>st</sup> October. In general, awareness was low but interest was very high and many firms said that they would be raising this with their customers and confirmed they would be happy for us to go back to them in 12 months time to review the impact of the new virtual marking regime.

# Dispute Resolution

## Patents Hearings Practice

Online filing of proceedings material would be welcome as part of any E Service offering. There was also the suggestion that when documents had been filed that a receipt would be welcome, given the importance of dates in this work.

Changes to hearing procedures and the use of hearing assistants were generally welcomed. However, in one instance it was felt that there was a lack of dialogue both before and during a hearing which could be avoided. It was also suggested that it would be beneficial for hearing officers to give an indication of their view at the hearing as is apparently the case at the EPO.


Cost of litigation was also raised and especially the costs involved in appealing an office decision. Whilst it was accepted that IPEC costs were capped even this was felt to be beyond the reach of most SMEs.

## Trade Mark Tribunal

Attorneys are generally satisfied with the quality and speed of decisions. The fast track option is of interest in certain circumstances when speed and simplification of the process is required, although none of the Attorneys we visited had used the service at the time of the respective visit. There is a perception that the IPO is tougher on the length of stays and case management than the OHIM is. Some users commented that it would be useful to have a preliminary ruling on the day of a hearing when appropriate (e.g. in clear-cut cases) so as not to have uncertainty for a couple of months while the final decision is being written. The issue of what constitutes genuine use to avoid revocation action was also raised. Unsurprisingly, all users would like an electronic opposition facility

## Opinions and Mediation

Opinions and Mediation were again raised on customer visits. Though many of those visited had not used the service awareness was high. The changes to the service following the IP Bill were welcomed. There was a general view that whilst it may help some smaller entities, it was perhaps of limited use to larger applicants.



Awareness of the mediation service was not high in many of the firms that we visited. Although some were aware of the fact that we offered the service they were unclear how to access it whilst others were not even aware it was available.

We note our Customers' views on Patents Hearing Practice and are actively looking at how we can better explain the process to help users make better and more efficient use of it.

We note that users are generally satisfied with the quality and speed of decisions in contested Trade Mark cases and will continue to work on further improvements to both

# Business Support

## Small firms

A particular concern of smaller firms is the point that an applicant approaches them in the innovation process. As one pointed out we are able to help obtain IP rights but applicants often want more than that, such as help with seeking finance and business planning.

One issue that was raised was the costs of being in business as a patent attorney. For smaller firms who do not necessarily have large clients the margins are very slim. The view was expressed that this may present a future problem and could lead to a rise in smaller firms seeking patents to “self lawyer” as they would be unable to afford the fees demanded by larger firms who can rely on multinational clients.

## Guide to Sources of IP Finance

The pamphlet “Business Support for SMEs” produced by Business Support outlining access to sources of Finance for Patent Applicants was very popular with Firms. It was felt by many that this was a very useful tool in allowing them to support the applicant throughout the process of the patent application. Many firms and certainly at the London Meeting would like to see this maintained and perhaps expanded to include other useful information.

## IP Attachés

Information on the IP Attaché network was provided at most visits. This is seen as a very positive move of the IPO. On several occasions we were able to effect an introduction for an attorney to the relevant attaché.

We note the issues raised about the potential costs to smaller firms and will consider options for potential research in this area.

The booklet will remain available in hard copy and we plan to update in the forthcoming year.

We now have IP attachés in perhaps the four the most important and challenging markets. So far they have helped around 8,750 British businesses to avoid or deal with IP related issues. We are working with IP stakeholders and businesses to identify other priority markets and areas for government support to British businesses looking to operate overseas, whether through an expansion of the attaché scheme or other forms of support



Concept House  
Cardiff Road  
Newport  
NP10 8QQ

Tel: 0300 300 2000  
Fax: 01633 817 777

[www.gov.uk/ipo](http://www.gov.uk/ipo)

For copies in alternative formats please  
contact our Information Centre.

**When you no longer need this booklet,  
please recycle it.**

© Crown copyright, 2015

This document is free for re-use under the terms of the  
Open Government Licence.

Images within this document are licensed by Ingram Image.

**Published: March 2015**

DPS/1332-03/15

