

Preventing the use of ‘*omnibus*’ claims in patent applications

Department for Business, Innovation & Skills

RPC rating: **not confirmed**

Description of proposal

The Intellectual Property Office (IPO) approach to ‘omnibus’ patent claims is currently inconsistent with the European and international practice. Patents that refer generally to descriptions or drawings, but do not specifically state the technical features, are known as ‘omnibus’ claims. The IPO’s current practice in allowing these claims can lead to a lack of clarity on the scope of a patent, and creates difficulties for third parties working in the same area. The proposal would amend the Patents Rules 2007 to ensure the IPO approach reflects international practice to accept omnibus claims only where absolutely necessary.

Impacts of proposal

The Department states that the proposal would provide third parties with legal clarity on patent claims, and would mean businesses are not prevented unjustifiably from working in a particular area. The Department also expects there to be a reduction in the cost of legal advice in relation to understanding patent claims.

The triage assessment also sets out that there are likely to be some benefits to businesses applying for patents, through speeding up the application process by reducing the time required for examiners to consider applications.

The Department believes that it will not be possible to monetise these benefits.

As the proposal would still permit omnibus claims where absolutely necessary, the Department expects the impact on those relying on omnibus claims to be ‘limited’. The Department has not provided an indication of the likely scale of this impact and, as discussed below, has not provided any indication of the potential loss of benefits, such as economic rent, associated with omnibus patents. The RPC is, therefore, unable to confirm the proposal as being suitable for the fast track.

Quality of submission

Red – not fit for purpose issues

The RTA provides insufficient information on the potential impact on businesses no longer able to use omnibus patent claims. On the basis of the information provided, businesses that currently use such claims are acting within the law and, if acting rationally in pursuing an

omnibus claim, would derive some benefit from being able to do so, for example some competitive advantage, or lower costs in filing a claim. Without further information on the scale of these impacts, it is not possible to confirm that the proposal is suitable for the fast track. The Department may wish to consider submitting a full impact assessment (IA) if there is currently insufficient evidence to say confidently that the gross costs are below £1 million in every year.

Other comments

The triage assessment refers to the proposal being part of a wider programme of work to recast the Patent Rules 2007. It would be helpful to explain how the proposal relates to the other changes, and to other current proposals to amend intellectual property law.

Initial departmental assessment

Classification	In scope
----------------	----------

RPC assessment

Classification	In scope
Small and micro business assessment	Not required for fast track submissions (would be required if a full IA was submitted)



Michael Gibbons CBE, Chairman