

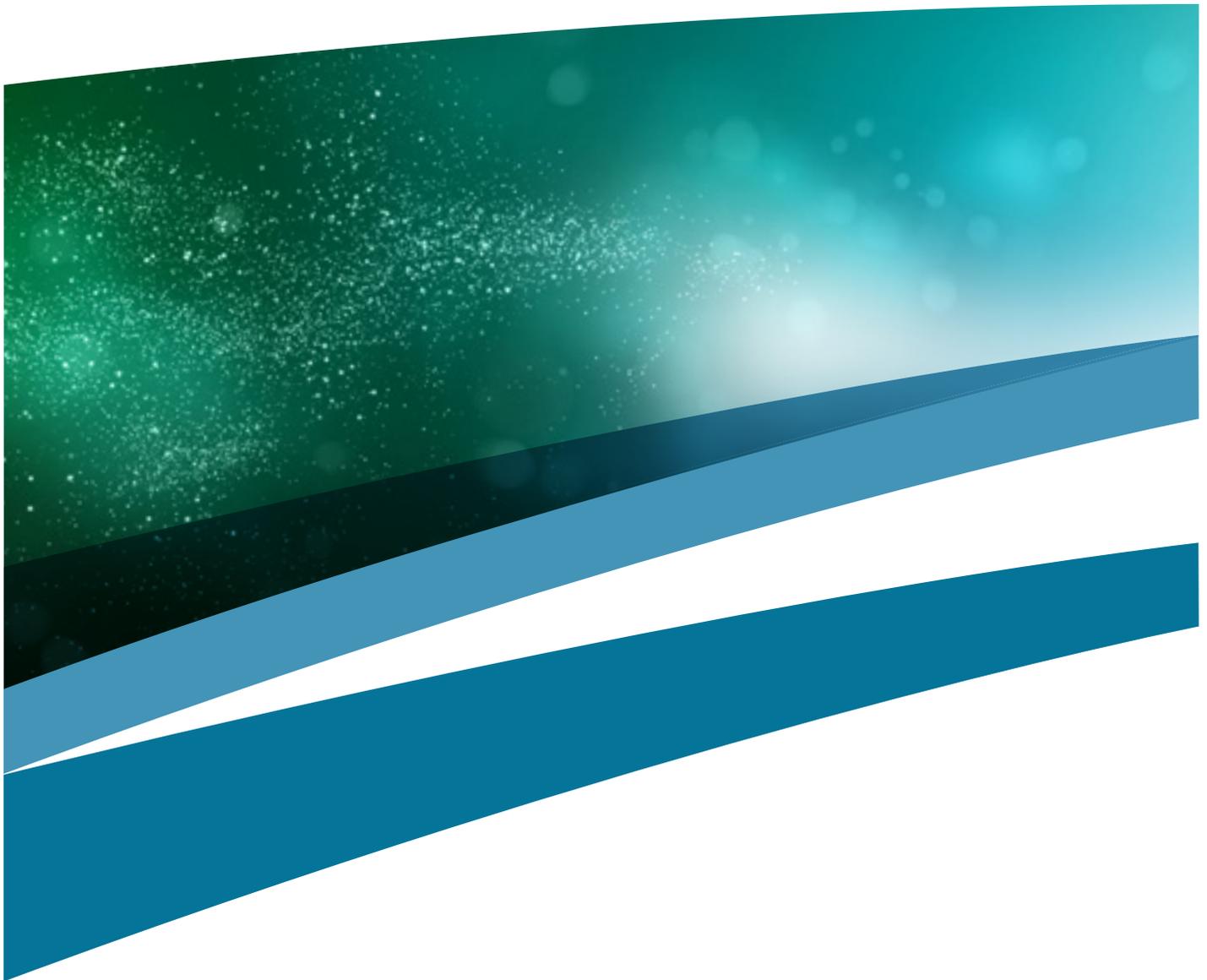


Intellectual
Property
Office

Amendment of the Patents Rules 2007:

Expansion of the Patent Opinions Service and Renewal fees for restored European patents (UK)

Government Response





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Background

1. On 2 June 2014, the Intellectual Property Office (IPO) published a consultation document entitled "[Amendment of the Patents Rules 2007: Expansion of the Patent Opinions Service and Renewal fees for restored European patents \(UK\)](#)".
2. The document set out in detail the Government's planned changes to secondary legislation in relation to two of the patents measures in the Intellectual Property Act 2014: the expansion of the Patent Opinions Service, and the payment of renewal fees following restoration of a European patent (UK).
3. The consultation period ended on 4 July 2014.
4. This document summarises the responses received and details our conclusions. While it may not be practical to respond to each individual point raised, they have all been taken into account.

Summary of conclusions

5. Following careful consideration of the responses received, the Government intends to take forward the proposed changes to secondary legislation in the manner and timescale set out in the consultation document.

Responses and analysis

6. A total of four responses were received. The respondents included professional representative bodies (acting on behalf of both patent holders and other interested parties) and an individual business (a patent holder). A list of the respondents can be seen in the annex to this document.

Expansion of the Patent Opinions Service

7. All four responses received were entirely supportive of the proposals relating to the expansion of the patent opinions service.
8. One respondent pointed out that it would be helpful if guidance such as a Manual or a Practice Note were to be published setting out the safeguards that will be available to the patent owner in relation to the new revocation power introduced by section 16(4) of the Intellectual Property Act 2014. The IPO agrees with this suggestion and will ensure that the Manual of Patent Practice is updated, together with other guidance as appropriate, at the time the revocation power is introduced.

Payment of renewal fees following restoration of a European patent (UK)

9. Three of the four responses were supportive of the proposals relating to the payment of renewal fees following restoration of a European patent (UK).
10. The fourth response did not support the approach proposed for the situation where the outstanding fees are not paid within the prescribed period, which was set out in paragraph 50 of the [consultation document](#).
11. In the situation where the outstanding fees are not paid within the proposed two-month prescribed period following restoration, this respondent did not support the provision of an additional six-month period for late payment followed by a thirteen-month period in which restoration is available. The respondent explained that this adds up to a “drawn out” process which could create uncertainties for potential competitors about whether they are able to launch their product.
12. The IPO believes the following points should be borne in mind when considering this aspect of the proposal:
 - The proposed approach, set out in paragraph 50 of the [consultation document](#), is directly aligned with the existing timescales available following a failure to pay a renewal fee in relation to a domestic UK patent under sections 25(4) and 28 of the Patents Act 1977, together with rule 40 of the Patent Rules 2007;
 - The proposal relates purely to the situation where a European (UK) patent which has previously been revoked is restored under the European Patent Convention (EPC). The only circumstance in which the patent remains revoked whilst an

appeal is considered, such that annual renewal fees are not payable, is where a petition for review by the Enlarged Board of Appeal has been filed under Art.112a of the EPC. It is worth noting that all other types of appeal have suspensive effect such that the patent is not treated as revoked and annual renewal fees are payable whilst the appeal is being considered;

- The IPO is aware of only four European patents (UK) which have been restored under these circumstances since Art.112a was introduced into the EPC in 2007.
13. The IPO agrees that time periods which cause uncertainties for potential competitors about whether or not a patent will remain in force should be kept to a minimum. However, given that three out of the four respondents supported the proposals and given the number of cases where this situation is likely to occur, the IPO believes it is most appropriate to ensure that the time periods directly align with the existing approach where there has been a failure to pay a renewal fee in relation to a domestic UK patent.
 14. In paragraph 51 of the [consultation document](#), it was pointed out that the onus will be on the patent owner to pay the necessary fees at the IPO without any reminder being sent to them, as the IPO may not have been notified by the EPO within the proposed two-month period that the patent has been restored. No comments were made in relation to this proposed approach, except that one respondent suggested the IPO should seek to have information provided by the EPO to patent holders setting out the UK requirements, perhaps through the EPO's "[National law relating to the EPC](#)" publication. The IPO agrees that this is a good idea and so will explore with the EPO how best to provide this information.

Conclusion

15. In light of the above, the Government intends to take forward the proposed changes to secondary legislation in the manner and timescale set out in the [consultation document](#).

Next steps

16. The Government intends to make the proposed changes to the Patents Rules 2007 on 1 October 2014, subject to it being possible to gain the relevant Ministerial agreement and Parliamentary approval.
17. Consequently, the expanded Patent Opinions Service will be available to any opinion requests made on or after 1 October 2014. Similarly, the new requirement for the payment of outstanding fees within a time period following restoration of the patent under Article 112a EPC will be introduced for all such restorations taking place on or after 1 October 2014.

Annex – list of respondents

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