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You are most welcome to visit our newly enlarged web-site at www.haseltinelake.com. We will continue to issue newsletters and fuller briefing notes in hard copy by mail, to save you the trouble of printing them. In addition, however, they can now all be obtained on-line through the site (www.haseltinelake.com/publications).

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Next Stage of Implementation of the UK Patents Act 2004

The next stage of implementation of the changes created by the UK Patents Act 2004 will take place on **1 October 2005**.

Particular points of interest include:

- the **renewal term** of UK patents will now be the last day of the month which contains the anniversary of the filing date, and the six-month grace period will now also end on the last day of the relevant month, i.e. UK law is brought into line with Continental and EPO practice. The new renewal term calculation applies to any UK patent where the renewal term calculated in the old way (precise anniversary date) expires on or after 1 October 2005. The new grace period calculation applies to any UK patent where the grace period calculated in the old way expires on or after 1 October 2005;
- before the preparations for publication of any national UK patent application have been completed, any named inventor can apply to **waive his right to be named**, or can require that **his address is not published**. An application to waive an inventor's right to be named will be examined by the UK Patent Office and may be refused. A requirement by an inventor that his address is not to be published must be accepted by the Patent Office. The inventor can later request publication of the unpublished details, if desired. This change, which is of particular interest in the biotech field, applies to all national UK patent applications for which the preparations for publication are completed on or after 1 October 2005;
- the procedure for **requesting the UK Patent Office to provide an opinion on infringement or validity of a granted UK patent** (i.e. a granted national UK patent or the UK part of a granted European patent) begins on 1 October 2005 (see below).

→ <http://www.opsi.gov.uk/si/si2005/20052471.htm>

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Start of UK Patent Office Opinions on Infringement or Validity

As mentioned above, the UK Patent Office will from **1 October 2005** start accepting requests for it to provide an opinion on (a) whether a granted UK patent (i.e. a granted national UK patent or the UK part of a granted European patent) would be infringed by a certain activity or (b) whether the granted UK patent has novelty and inventive step.

The procedure is governed by Sections 74A and 74B of the Patents Act 1977 (as amended) and Rules 77A to 77K of the Patents Rules 1995 (as amended), which come into effect on 1 October 2005.

- The patentee or any other person ("requester") makes the request and submits the facts to be taken into account. The official fee is £200. The requester must state the names and addresses of any person known to him as having an interest in the request and must identify any relevant pending/concluded UK or EPO proceedings known to him (Rule 77B(1)(2)). A request can be filed by a patent attorney without identifying his client (Rule 77B(3)).
- The request is noted on the UK Patents Register (Rule 77C). Because of the very short deadlines involved in the procedure (see below), we recommend that the Register is watched if a third-party intervention might be required.
- The Patent Office informs all known interested parties and advertises the request (Rule 77E).
- **Any person** may file observations on the matter within a period of **four weeks** counted from the date of advertisement of the request (Rule 77F(1)(7)), and the patentee and any exclusive licensee (to the extent he did not file the observations) and the requester have until two weeks after the end of the four week observations period to reply to the observations (Rule 77F(4)).
- The patentee and any exclusive licensee and (if different) the requester receive copies of the filed documents, preferably by electronic means (Rule 77F). We understand that the Patent Office will encourage the use of e-mail. The Patent Office has announced that it intends the procedure to be quick and efficient. Although discretionary extension of these very short deadlines is theoretically available under Rule 110(1), we understand that the Patent Office will be reluctant to allow extensions.

- After the deadlines for observations and replies have expired, an Examiner prepares the opinion, and issues it to the patentee and any exclusive licensee and (if different) the requester, and to any other person who filed observations (Rule 77G).
- The patentee and any exclusive licensee have until **three months after the date of issuance of the opinion** within which to apply to the Patent Office for a review of an adverse opinion. The sole ground of review is that the opinion came to a wrong conclusion (Rule 77H). If an application for review is filed, the Patent Office informs the requester and any other person who filed observations, and advertises the application for review (Rule 77I).
- **Any person** may file a statement or counter-statement on the matter with a period of four weeks counted from the date of advertisement of the application for review or two months counted from the date of issuance of the opinion, whichever is the later (Rule 77I(4)), and the Patent Office copies the papers to the other parties and directs the subsequent procedure (Rule 77I(5)(6)).

The Patent Office does not have to provide an opinion, and must decline to provide an opinion where the request is frivolous or vexatious or where the question has already been considered in other proceedings (Section 74A(3); Rule 77D).

As mentioned in the January 2005 issue of this Newsletter, the outcome of any review is considered as a formal decision at Patent Office level. This is in contrast to the original opinion, which has no formal status as a decision. If an application for review does not succeed in having the opinion set aside completely, the matter can be appealed to the courts, and the ultimate decision on appeal will bind a lower tribunal on the same facts.

Therefore, the patentee and any exclusive licensee will need to consider carefully the chances of success, before applying for review of an adverse opinion.

It will be interesting to see how much weight courts or other tribunals place on the UK Patent Office opinions. This may well determine how widely the procedure comes to be used.

If the quality of the opinions is high, however, the procedure in relation to validity could well be useful for testing prior art that is being considered for possible use in oppositions, nullity actions, revocations or re-examination procedures on parallel patents in other jurisdictions, both in Europe and elsewhere, or in pre-grant observations on parallel applications that are still pending elsewhere. Similarly, the procedure in relation to infringement could well be useful – particularly for small and medium sized businesses – for resolving disputes before litigation.

We will keep you informed of developments, as the details of the procedure become established.

→ <http://www.opsi.gov.uk/si/si2005/20052496.htm>

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