Abel+Imray

Not Just a Matter of Opinion
The UK IPO Opinions Service

In 2014, the scope of the UK IPO's Opinion Service was expanded to give it more "teeth" - since then, the UK IPO has had the power to seek revocation of patents found invalid. A decade on, we review the ways in which parties have been using the service. We also explore the options available to help explain and highlight this low-cost, rapid route to impartial validity and infringement reviews of UK and European patents.

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Overview of UK IPO Opinions

Key features of the Opinions Service:

+ **A route to revocation** – If an opinion finds that a patent is "clearly invalid", the UK IPO may initiate revocation proceedings of its own motion. Thus, the Opinions Service provides a useful mechanism to clear the way of a clearly invalid patent without resorting to court proceedings.
+ **Streamlined and cost effective** – The opinions procedure is rapid, with the parties' entire case required to be set out at the outset. Following a reply to the request for an opinion, and counter reply, an opinion is issued on the written submissions without an oral hearing. Overall costs can be kept low (to a few thousand pounds or so) and are predictable. Parties bear their own costs.
+ **Speed** - An opinion is issued within three months of a request being filed. The rapidity of the procedure allows parties to better understand the merits of a case at an early stage of negotiations, e.g. within the 9 month window for an EPO Opposition.
+ **Impartiality** – The Opinions Service provides an impartial view from a senior UK IPO patent examiner on questions of validity and infringement, having considered arguments submitted by both sides. Thus, the opinion may carry greater weight than a one-sided legal opinion.
+ **Range of attacks** – It is possible to request an opinion on all major grounds of invalidity, including novelty and inventive step (both over published documents and prior use), excluded subject matter, industrial applicability, sufficiency of disclosure and added matter. Multiple grounds can be raised in a single request.
+ **New Grounds** – An opinion will not be provided on issues already considered in earlier proceedings and will be confined to new matters. In Opinion 11/16 and in Opinion 20/16 the IPO declined to provide an opinion on issues that had previously been considered in EPO Opposition proceedings and during examination. In Opinion 3/16 the question of added matter was considered a new ground. Despite the allowability of amendments having been examined during prosecution; it was confirmed that the question of whether the granted claim extended beyond the disclosure of the application could be reviewed.
+ **Non-binding** – A UK IPO opinion is just that, a non-binding opinion. There is nothing to stop the parties from seeking relief through the court on the same grounds as put forward in a request for an opinion, regardless of the findings of the opinion, nor is there any file wrapper estoppel. Following a finding that a patent lacks novelty in Opinion 12/14 a revocation

action was launched at the UK IPO (case BL O/183/16). The hearing office confirmed that the previous opinion was not binding nor were its findings given weight in these subsequent proceedings.

+ **Public** – All documents submitted in connection with an opinion are made public, as is the final written opinion. Thus, while the opinion may be non-binding, a published opinion may be a powerful tool in dealings with third parties.
+ **GB & EP patents and SPCs** – The UK IPO will provide an opinion on the validity and/or infringement of any granted patent covering the UK, and also on Supplementary Protection Certificates (SPCs) relating to a patented medicinal product for which a marketing authorisation had been obtained. In Opinion 10/16 the validity of an SPC directed to a patented medicinal product was considered.
+ **Anonymity** - Any person can request an opinion, there being no need to declare an interest. Accordingly, an opinion on validity can be obtained without revealing the identity of the interested party.

Case Study - Opinion 5/15

On 9 March 2015, Dyson requested an Opinion on the validity of patent GB2487996 directed to a hairdryer. Following a response from the patent owner and further comments from Dyson, an Opinion was issued on 4 June 2015 (i.e. within 3 months of the request). Although the main document cited had been considered in prosecution, attacks based on that document were considered a new ground as the document was reinterpreted in the light of passages from a newly cited text book. The IPO Examiner found the claims novel but lacking an inventive step.

On 18 September 2015 the UK IPO launched revocation proceedings. The patent owner argued that the claimed subject matter is inventive and, in December 2015, UK IPO decided not to make an order for revocation. Dyson is not estopped from commencing revocation action before the UK courts on the same grounds as put forward in their request for an opinion or on new grounds.

Route to Revocation

The possibility of being able to clear the way and have a competitor's patent revoked following a negative opinion on patentability without having to go through full court proceedings is a key attraction of the Opinions Service.

Since October 2014, 71 final opinions have found a patent to be invalid, while 74 found a patent to be valid. We have reviewed the fate of patents found invalid, and identified only 29 patents that were maintained as granted. A small number (9) have been revoked in their entirety, and a few others (4) surrendered by the patent owner. Another 23 invalid patents were amended, either pro-actively by the patent owner following issuance of the opinion, or during revocation proceedings. In a small number of cases (6), proceedings are still ongoing, with the UK IPO considering arguments for maintenance and/or amendment. These results demonstrate the effectiveness of a UK IPO invalidity opinion in forcing limitation, abandonment or revocation of patents. The IPO's willingness to launch revocation proceedings demonstrates that there is a readiness to exercise its power to revoke "clearly invalid" patents.

The question of whether or not a patent is "clearly invalid" appears to be assessed on a case by case basis, and it remains difficult to make firm conclusions on whether or not a given case will be put forward for revocation. However, it does appear to be the case that a finding of invalidity through lack of novelty significantly increases the likelihood of the UK IPO proceeding with revocation proceedings.

Following Opinion 5/15 in which the patent was found novel but lacking in inventive step, revocation proceedings were commenced, showing that lack of inventive step alone can meet the "clearly invalid" requirement. However, following Opinion 7/15 and 10/15, in which it was found that patents lack an inventive step over a single document, revocation actions were not commenced after the patent owner took action to respond to the findings in the opinions.

The decision not to launch revocation proceedings following Opinion 7/15 indicates that lack of inventive step alone may only result in revocation proceedings in exceptional circumstances. In that case, it was concluded in the opinion that an

independent claim to a method of marking a product with a coating lacked novelty. After the opinion was issued, the patent was limited to claims that specified the substrate on which a coating is applied, which had been found novel but lacking an inventive step. Somewhat surprisingly, given the Examiner had found that "there is nothing inventive in specifying a substrate", the UK IPO did not then commence revocation proceedings on the grounds that the revised claims were no longer "clearly invalid".

More recently, Opinion 10/22 concluded that a patent was invalid through lack of novelty, resulting in the UK IPO initiating the revocation procedure. The patent owner sought amendment of the claims to restore novelty, but the UK IPO decided that the amended claims lacked inventive step and thus revoked the patent. In that case, the revocation decision was issued less than two years after the opinion request was first filed.

Once a revocation action has been launched by the IPO there are indications that it will see the matter through. In the revocation action following Opinion 25/14 the IPO is continuing to insist that the patent is invalid despite the patent owner arguing for the patent to be maintained.

If a request for an opinion is withdrawn before the opinion is issued, the UK IPO will not continue to issue the opinion or initiate revocation proceedings. Accordingly, the filing of a request for an opinion might be a way of bringing a reluctant patent owner to the negotiating table.

A downside of the Opinions Service is that a third party who requests an opinion on validity is not a party to subsequent revocation action and cannot contest a decision by the IPO not to initiate revocation proceedings. However, as illustrated in Opinion 12/14 there is no barrier to the requester launching revocation action at any point, regardless of the outcome of the opinion, and a UK IPO opinion may help settle disputes at an early stage.

Revocation - Summary

To conclude, while revocation of a patent following a finding of invalidity in an IPO opinion is far from guaranteed, the requesting of an opinion is a viable alternative to court proceedings as a first step in challenging the validity of a patent.

Impartial View on Infringement

A UK IPO opinion concluding that a patent is infringed will not result in any award for damages – is it a non-binding opinion, not a decision on infringement. However, patent owners and third parties alike may find issuance of an impartial opinion on infringement useful in helping to resolve a dispute, in the UK or elsewhere. For example, a UK IPO opinion could be sought on the UK part of a European patent also in force with the same claims in other countries.

Of the 65 opinions on infringement issued since October 2014, over half (38) concluded that the patent was not (or would not be) infringed. Note that while some infringement opinions may be sought by the patent owner, others are sought by third parties seemingly with the objective of showing that they do not infringe.

It is worth keeping in mind that, when an opinion on infringement is requested, the UK IPO will notify the patent owner and any exclusive licensee to give them an opportunity to comment on the opinion. The UK IPO will also contact anyone who has filed a suitable caveat on the patent and any other interested party identified in the opinion request. The request, any observations, and the final opinion will be made available on the public file.

Infringement opinions are not limited to question of direct infringement - in Opinion 4/19, a conclusion of infringement by equivalents was reached. The UK IPO examiner found that a third party process and its products did not fall within the scope of the claims, but the third party process nevertheless varies in a way that is immaterial and thus would infringe the patent if performed in the UK.

The UK IPO has demonstrated that it will put considerable effort into analysis of opinion requests. In Opinion 2/24, the examiner inspected a physical sample of an allegedly infringing product in order to determine whether or not a 'moulding induced parting line' could be identified, as required by the claims of the patent. In any event, in reaching a conclusion that the patent was infringed, the examiner commented that they considered it extremely likely that the third party product is manufactured by a moulding process that would necessarily result in the present of such a parting line.

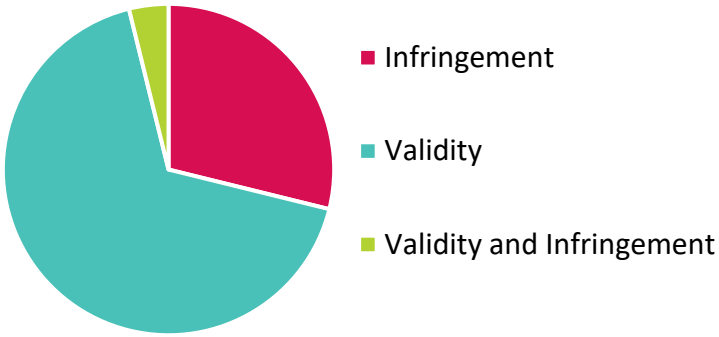
The UK IPO is also prepared to provide an opinion on potential infringement. In Opinion 11/21, the examiner concluded that a concept design for a submarine would infringe a claim to a submersible tank unit, if put into production and/or used or sold in the UK.

Infringement – Summary

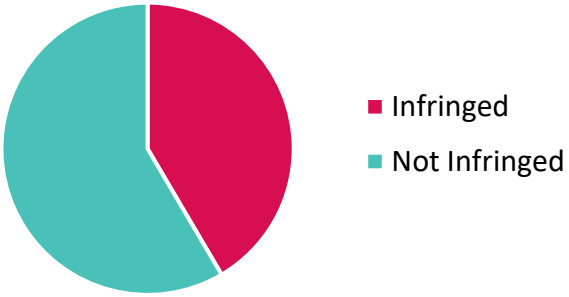
Although UK IPO infringement opinions can neither result in an award of damages or an injunction, nor preclude a patent owner asserting their patent, there are situations where an impartial and thoroughly analysed infringement opinion may have value. The UK IPO has shown a willingness to consider questions of infringement from various angles, and to issue opinions quickly.

Overview of 200+ opinions issued since October 2014:

Breakdown of issues considered



Outcome of the opinions that considered infringement



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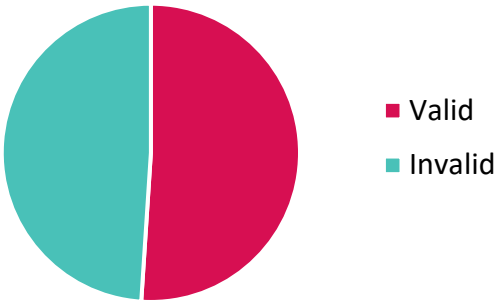
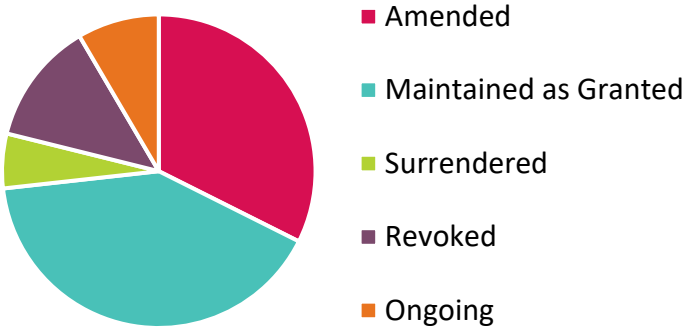


Subsequent fate of the patents found invalid



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