



## An opinion on opinions

With a few months having passed since the introduction of the new powers of the UKIPO with respect to its Opinions Service, we take the opportunity to review the changes and the uptake of the new service.

A key component of the IP Act 2014, which entered into force on 1 October 2014, was the increase in the powers of the UK Intellectual Property Office (UKIPO) with respect to its Opinions Service. In particular, the UKIPO has now been granted the power to revoke a UK patent when it is found to be lacking in novelty or inventive step.

With a few months having passed since the introduction of the new powers, we are taking the opportunity to review the changes and comment on the uptake of the updated service.

### The revamped Opinions Service

In a broadening of the existing powers, opinions on the validity of a UK patent can now be requested from the UKIPO on the full range of grounds for lack of validity. Previously, validity opinions were only provided with respect to novelty and inventive step.

New grounds for requesting an opinion are post-grant claim broadening, insufficiency, added subject matter, and/or excluded subject matter; this update brings the opinions process more closely into line with the opposition procedure at the European Patent Office, but still without the time limit for filing.

The opinion of the UKIPO remains non-binding but if it is concluded that the patent is lacking in novelty or inventive step, then the UKIPO can now initiate revocation proceedings of its own accord. In the case that revocation proceedings are initiated, the patentee will have the opportunity to oppose the revocation by filing appropriate

amendments and arguments, as would be the case in revocation proceedings brought by a third party.

### Why use the Opinions Service?

We envisage that the new and improved Opinions Service will be of interest to third parties who wish to contest the validity of a UK patent in a cost effective manner. The official fee for requesting an opinion from the UKIPO is a mere £200, which is significantly cheaper than entering full revocation proceedings.

A further advantage is provided in that an opinion can be requested by any party, so 'straw man' requests can be filed to avoid a potential infringer catching the attention of the patentee.

As a response from the patentee is required within a relatively short time from the request for an opinion, the service could be used to gain an insight into the arguments and evidence the patentee might utilise when defending against full revocation proceedings in the UK or on corresponding patents abroad. Furthermore, as there will be costs associated with responding to the request, the Opinions Service can be used to gauge how important a patent is to the patentee, and their likelihood of enforcing the patent in the UK and worldwide.

The new powers may mean that prima facie invalid patents could be removed easily and cheaply by a third party by requesting an opinion and waiting for the UKIPO to exercise its revocation powers.

Opinions are also still available on infringement as well as validity. Although they are non-binding, a favourable opinion can be useful when entering discussions with third parties, whether you are patentee or an alleged infringer.

## Are more opinions being requested?

Early signs indicate that the new Opinions Service may be encouraging the filing of more requests for validity opinions, but there does not appear to have been a great rush of requests since the changes came into force. A total of 7 requests were filed for novelty/inventive step opinions in 2014 in the 9 months to the end of September. In contrast, 5 requests for validity opinions were submitted in the final three months of that year following the entering into force of the new powers on 1 October 2014, with 3 more requests to date this year.

## What don't we know?

There are still question marks over how the UKIPO will use its new powers and the way opinions will be used by third parties.

The UKIPO has indicated that the new revocation powers will only be exercised in cases of prima facie or clear cut lack of novelty or inventive step. However, this suggestion has not been backed up by the amended legislation. There is, in theory at least, a chance that revocation proceedings could be instigated whenever a negative opinion on novelty or inventive step is reached. It remains to be seen whether the UKIPO will use its powers aggressively or whether the majority of patents will be left alone unless a third party instigates revocation proceedings.

It appears that, due to the cheap cost of requesting an opinion, a third party could easily file multiple requests as a nuisance to a patentee holding many patents. Whether further amendment to the Opinions Service will be required to address these issues will become clear over the coming years.

## Conclusion

Overall, the updated Opinions Service represents a significant boost to the powers of the UKIPO and offers an attractive and cost-effective way for a third party to investigate the validity of a patent without alerting the patentee to their identity. Patentees should note the importance of responding to a request for an opinion, now that a negative opinion could result in the revocation of their UK patent.

## How can A.A. Thornton & Co. help?

If you have any specific queries in relation to requesting an opinion from the UKIPO on a third party patent or on the increased risks to you as a patentee, then A.A. Thornton & Co. are well placed to advise you further. Visit our website at [www.aathornton.com](http://www.aathornton.com) for contact details.

Our patent attorneys are qualified to advise on all aspects of UK and European patent law. The services of our patent attorneys are listed below (click on the links for further information):

- Patent drafting
- Patent prosecution
- Conducting patent opposition proceedings before the EPO
- Advice relating to patent infringement and validity
- Advice relating to patent ownership and licensing of technology
- Conducting patent due diligence
- Patent litigation support

## Contact

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