The Chartered Institute of Patent Attorneys

UK-IPO Consultation proposed changes to the Patents Rules

This response to the Intellectual Property Office's Consultation on proposed changes to the Patents Rules is submitted on behalf of the Patents Committee of the Chartered Institute of Patent Attorneys (CIPA). Members of the Patents Committee include practitioners from "*private practice*" (individual private practice firms) and practitioners from in house patent/legal departments. Thus, the views expressed below represent those of attorneys who practice before the IPO and bodies who are represented by these patent attorneys, which include multinationals, small to medium enterprises, universities and private individuals.

Comments on the consultation

CIPA is grateful that the UK-IPO has sought comments from its users before making changes to the Patents Rules. This approach ensures that potential issues can be highlighted before any legislative changes are made. The proposed changes as a whole are seen as a welcome change, save for the comments set out below.

It appears that the majority of the proposed changes should eliminate undue administration, such as the need to file triplicate copies of international applications.

Introducing a notification of intention to grant

This is perceived to be a good idea, and it should provide applicants with a definitive date on which to take action. It will also allow attorneys in private practice an opportunity to advise clients of the final date on which they will need to take action. The change should provide greater clarity to the grant process.

However, what remedies would be available to an applicant wishing to file a divisional application if the communication provided an incorrect grant date or an error was made during the grant process, such that an application proceeded to grant before the date indicated in the communication? Once an application has proceeded to grant, it will not be possible to file a divisional application. This could cause a potential flashpoint in the event of an error.

Prohibiting the use of omnibus claims

There appears to be a general affinity for omnibus claims in the UK, especially following *Rotocrop International Ltd v Genbourne Ltd* [1982] FSR 241 where an omnibus claim was construed to cover variants that were not protected by other "*conventional*" claims. Further, omnibus claims can prove to be useful for obtaining claims of a narrow scope that protect the commercial embodiment of an invention.

Although Sir Colin Birss commented that the UK-IPO should consider whether omnibus claims serve any useful purpose today (see *Environmental Recycling Technologies Plc v Upcycle Holdings Ltd* [2013] EWPCC 4), comments made in that case also stated that omnibus claims do neither harm nor good.

Omnibus claims are generally only included in applications if there is deemed to be some merit in their inclusion. These claims are perceived to be a final fall-back position, and their scope is narrow.

There is generally no difficulty in construing such claims, see for example the examiner's comments in opinion 13/14[1] concerning GB 2 332 376 B.

The consultation document states that the use of omnibus claims would be excluded, except where "*absolutely essential*". However, the "*absolutely essential*" wording does not feature in the proposed wording of Rule 12. If the test is to be whether an omnibus claim is "*absolutely essential*", it is unclear how it will be determined whether an omnibus claim might be "*absolutely essential*". It is likely that applicants will be of the view that such claims are indeed essential if they have been included in their application. However, the UK-IPO could deprive applicants of a just reward for disclosing their invention by ruling that an omnibus claim is not "*essential*". The potential for disagreement on this point could increase the burden on examiners to deal with such exchanges.

The proposed wording of Rule 12 states that the claims should not rely in respect of technical features of the invention on references to the description, drawings or any photograph unless it cannot be otherwise clearly defined in words. However, the EPO allows applicants to refer to parts of the description in the claims. For example, at the EPO it is acceptable to refer to methods of conducting a test that are set out in the description by citing the relevant paragraph(s), and it is also acceptable to refer to examples set out in the description in the claims. The IPO's proposed wording, therefore, appears to go further than necessary to exclude only omnibus claims, and it would cause a disparity between practice before the EPO and the IPO.

In addition to the above, the proposal set out in paragraph 22 is that new Rule 12 would apply to all pending applications. It is unclear how this would work in reality. If an application is in order for allowance before new Rule 12 came into effect, but it contains an omnibus claim, would the examiner issue a further examination report requesting the omission of the omnibus claim? If the only outstanding objection issue is the presence of an omnibus claim, then it does not appear to be worthwhile issuing a further examination report and delaying grant.

The alternative proposal set out in paragraph 23 would place less burden on the IPO, but it would mean that there is a two tier system in operation at the IPO; for applications filed before and after the implementation date of new Rule 12.

In view of the fact that omnibus claims have been deemed to provide neither harm nor good, there does not appear to be any compelling reason to change the approach to omnibus claims when doing so could increase the examination burden on the UK-IPO for those applicants who are determined to retain such claims in their applications.

Clarifying the period for making a request for reinstatement of a patent application

Of the options proposed, the legislative option appears to be more practicable. It should avoid time being wasted trying to identify the date on which the cause of non-compliance was removed. Also, it should remove any concerns that may be associated with making a declaration that may be found to be incorrect at a later date.

Under the current system, third parties typically adopt a cautious approach and generally take the view that an application should not be deemed to be withdrawn until the twelve month period has elapsed. Thus, the legislative option would remove any ambiguity.

Allowing extensions to the period for filing an address for service

[1] https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/356147/op1314.pdf

No comments or objections.

Relaxing the formal requirements for drawings

No objections. As the UK-IPO has appreciated, the representation of some forms of technologies by monochrome figures is not necessarily practicable. However, will such drawings be reproducible in online databases, such as espacenet, so that third parties can review them in full?

Requirement for to notify the IPO each year of the address for receipt of the renewal reminder

No comments or objections.

Clarifying the period for making amendments to PCT applications entering the UK national phase

No detailed comments or objections. The proposal appears to be sensible.

Clarifying the requirements concerning changes of names and addresses

The current wording can lead to confusion, so the proposed changes appear to be sensible.

The rule concerning advertising amendments during infringement and revocation proceedings

No comments or objections.

Removing the requirement for triplicate copies of international applications

No comments or objections.

Removing the requirement for duplicate copies of Patents Form 51 to be filed

No comments or objections.

Other proposals

In response to question 17, which refers to the current practice under Rule 111 and the recent changes to the Manual of Patent Practice (MPP), section 123.47.1, CIPA notes that the updated MPP section states:

> "*Extensions of time under rule 111 may not be used to 'un-terminate' an application or extend a time period that has already expired*"

However, this appears to be in contradiction to Rule 111, which states:

> "*The comptroller shall extend any period of time specified in the Act or these Rules where he is satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service*".

The IPO has interpreted Rule 111 in the past to apply to due dates that have already expired, see for example O/365/14 where the due date for putting an application in order for allowance had passed but it was extended nonetheless by the IPO under Rule 111. It is, therefore, unclear why the IPO has changed its interpretation of Rule 111, where there does not appear to have been any judicial ruling that would have prompted such a change.

It would seem that the revision of the MPP section 123.47.1 needs further thought. Alternatively, if it is now the IPO's view that Rule 111 should <u>not</u> apply to due dates that have expired, then the wording of Rule 111 should be amended accordingly to make that explicitly clear. In that event, further consultation with explicit proposals may be desirable.