



NEWSLETTER

August 2015

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PRESIDENT'S LETTER

Dear FICPI Friends

As this is the first newsletter to be issued following my election as your new President of FICPI-UK, I would like to reiterate how delighted and honoured I am to have this opportunity. I'm looking forward to the challenge that this role will bring over the coming years, particularly in view of the sterling work that our immediate Past-President, Robert Watson, has made over recent years.

In July I represented FICPI at the Four Presidents' Meeting hosted by the UKIPO. I hope to build on the close working relationship that we have with the UKIPO, and with the Presidents of CIPA, ITMA and the IP Federation.

An important facet of FICPI is that we represent the interests of IP attorneys in private practice, and therefore one issue that I am keen to work on is how we promote the services being offered by IP attorneys from the UK, and in particular how we promote the contribution made by UK attorneys to innovation, and more generally to the UK economy.

Over recent months we have continued to respond to consultations being carried out by the UKIPO, such as the Draft Bill on Unjustified Threats, and the proposed Renewal Fees for the Unitary Patent. In May the Council of FICPI-UK met with representatives of the UKIPO to exchange views of the proposed changes to patent fees in the UK. A full report can be found below.

This year's Business Practice Seminar will take place in London on 24 September, and I hope that many of you will be able to join us. Next year will be another important year for FICPI-UK, when we host the UK round of the ABC meetings that rotate between the UK, US and Canada. Further details of the event can be found later in the Newsletter.

I am pleased to announce that, in addition to welcoming Nick Noble and Matt Cassie to the Council earlier in the year, we have since been joined by Alicia Instone, who will no doubt help provide even closer links with CIPA, in view of Alicia's role on the CIPA Council.

Finally, since this will be the last Newsletter to be edited by Alan Senior, I would like to express a huge thank you to Alan for all his hard work over many years!

Simon Rees

REPORT OF THE IMMEDIATE PAST-PRESIDENT, ROBERT WATSON FROM THE AGM

25 March 2015

Before briefly reviewing the last year, I should extend my thanks to all on Council for all their help and assistance. I would like to mention one person in particular for his efforts over the last few years.

Alan Senior has been a member of FICPI since 1999, and joined UK council in 2002 in time for the Sheen Falls ABC in 2002. He became the UK delegate in 2007 for the Amsterdam ExCo, and joined International Council in 2012. He has been a great support during my time as President, and was particularly active recently on the UPC work both within CET 3 and from a UK angle. Alan has said he will help out with the arrangements for our ABC next year, but that will be his last efforts for FICPI-UK.

As I said in my previous three reports, much of what I am about to say will have been reported by our Newsletter and by e-mail.

Following last year's visit and joint seminar with FICPI-China, the first international event was the ExCo and Seminar in Kyoto – I was unable to attend, but John Dean kindly supported Alan by acting as sub-delegate. Liz Dawson stood in for me at the Four Presidents' Meeting in May, whilst I was participating in FICPI's visit to the USPTO. We saw progress on the implementation of the various provisions of the IP Act, and also a number of meetings on Patent Law Harmonisation following the conclusion of the Tegersee Process (attended by John Dean). As we have reported, the process is now in the hands of the Group B+ chaired by John Alty.

We held a successful Autumn Dinner in October where Judge Hacon of the IPEC addressed us on his views following a year in the post. I took part in a roundtable meeting with the latest IP Minister, Baroness Neville-Rolfe.

The second ExCo was held in Barcelona along with a Forum – UK representation amongst the Forum speakers was strong (9 out of 71) and the event was highly enjoyable, as ever.

Liz Dawson has been ably representing FICPI at the discussion with CIPA and others on Diversity, which led to the first press release involving FICPI-UK in my term! Liz and I also met with Andrea Brewster and Lee Davies to discuss how FICPI-UK and CIPA could work better together.

My last meeting in post was a meeting at the UKIPO discussing the reform proposals for the EPO Boards of Appeal – a note of this meeting should be released shortly, but all involved felt generally positive about the direction being taken.

Our regular representation on both the PPWG and MDF has continued – thanks as always to all those who have made the time to attend these meetings.

In 2014, FICPI-UK submitted comments to the UKIPO on Patent Opinions, Renewal Fees, Patent Publication and repeal of s52 of the CDPA and to IPREG on the proposals for changing the Examination System for attorneys.

Robert Watson

AGM REPORT

Date: 25 March 2015

1. Excusing late notice of AGM

Those present excused the late notice of the AGM, and as no comments had been received from members not present, it was assumed that no issues arose from this. It was suggested that two weeks from the distribution of these minutes be allowed in case any issues do arise.

2. Apologies for Absence

Apologies were received from Gareth Probert, Rowena Powell, Julian Crump, Terry Johnson and John Orchard.

3. Minutes of the Annual General Meeting dated 12 March 2014 for the year ending December 2013

The Minutes, which were made available to those attending the meeting, were approved and signed.

4. President's Report for the year

The President gave his report on the activities of FICPI-UK during 2014. Particular mention was made of Alan Senior's contribution.

5. Secretary's Report for the year

Due to the last minute absence of the Secretary, the President gave his report on the number of new members that had joined over the last year, 8, with 1 potential application pending.

6. Treasurer's report for the year, including the presentation of the unaudited accounts for 2014

The Treasurer presented the annual accounts of FICPI-UK for the year ending 31 December 2014 to the meeting and made available a written report for that same year. The previous decline in membership seems to be reversing, with a pleasing rebalancing of the demographic of members.

The meeting then voted formally to accept the accounts and to adopt all three Officers' Reports; the accounts then being duly signed.

7. Election of Officers and Council members

Nominations had been sought from the membership, but none had been forthcoming. The Officers and Council Members proposed by Council were elected on a motion proposed by Tim Roberts and seconded by Peter Garratt. They were:

President:	Simon Rees
Secretary:	Gareth Probert
Treasurer:	James Fish
Council members:	Julian Crump
	John Dean
	Liz Dawson
	Alastair Neill
	Nick Noble
	Alan Senior

8. Any Other Business

Robert Watson was thanked for his efforts as President over the last 4 years. As mentioned in point 4 above, Alan Senior was also thanked for his efforts as ExCo Delegate and Editor of the FICPI-UK Newsletter.

There being no other business, the meeting was then closed at 6:30pm.

NOTES OF PPWG MEETING

Date: 21 July 2015

Simon and Liz attended the last PPWG meeting in July. There was the usual open discussion and receptiveness by the IPO to user's views. The following are some of the topics on the agenda.

Amendment of Patent Rules

The IPO is overhauling the current rules to bring them up to date and informal suggestions before a full scale consultation in September will be welcome, either directly or via FICPI. The plan is for the new rules to come into force next April.

Examples of areas for improvement include:

- PCT related measures from substantive issues such as allowing voluntary amendments on entry to national phase to minor items such as removal need for triplicate paper copies of the PCT application.
- Omnibus claims may be prohibited! What do we think of that?
- Procedures for filing divisional applications should become less cumbersome, perhaps with a notice of grant foreshadowing the grant date similar to EPO procedure.
- The possibility of filing drawings in colour was discussed and the IPO will look into this further.

WIPO legal status task force

WIPO has a Task Force which has agreed a list of events that are to form the core of a standard for status information. There was a discussion of how much we use this and how detailed it should be. The consensus was that it should be clear and simple to administrate, that way it would be reliable. A lot of detail is not required since for that we can consult complete file histories.

Groundless Threats

Draft legislation on groundless threats has been opened to consultation. Despite being rather unclear we were told that the user organisations had already had considerable input into the wording so major changes at this stage are unlikely. Since then FICPI-UK has responded to the consultation welcoming the consistency between different IP rights and the fact that law firms cannot themselves be sued when acting on behalf of clients (although clients can sue us for giving them bad advice). CIPA has strongly criticised the detailed wording.

Expiry of patent term

Most EPC countries consider that the last day of the patent is the day of the anniversary of the filing date, in the UK it is considered to be day before and in Greece the expiry date is deemed to be the day after the anniversary! Harmonisation is needed as the Unitary Patent nears.

Future filing trends

Search demand has stabilised but examination demand is up 5% on the previous year – many examination requests are combined with search request. The IPO's capacity not quite sufficient at the moment but should be there in a few months. The intended target of 96% of search requests being fulfilled within 6 months is being met in most fields. Most acceleration requests are being handled within two months. The examination backlog should stabilise and there is hope for

significant inroads into it soon. Numbers of applications filed are rising faster than search and examination.

We should soon see whether the UPC will have an effect on rates of national filing.

TRIPOD (Transforming IPO services Digitaly)

Designs has been the trailblazer for this. We should now see changes on the patent side.

“View my cases” software is being trialled by some firms (for unpublished applications). This will enable e.g. changes of address to be done via direct log in. With e-filing the IPO is focussing on ways to help people file applications that are right first time, especially unrepresented applicants – more volunteers to trial e-filing are wanted.

Online manuals - Replacing the single PDF document with an html version is being investigated. Sadly there is no prospect for legislation such as the Patents Act and Rules being presented in this way

EPO

AC – met end June – items included approval of 2014 accounts – budget orientations for 2016 considered – appointments and reappointments to Boards of Appeal – some contracts extended – new EPO career system in EPO transitional provisions agreed – B+ work considered – changes to HR processes have been audited – unrest was discussed and auditors asked to consider – Sean and John met Brits working at the EPO to get their take on how things are.

CPL – meeting scheduled for 15 September – issues may include harmonisation, rule 82, rule 147, broccoli & tomatoes.

Liz Dawson

IPO ON BOARD OF APPEAL CHANGES

Date: 16 March 21015

Introduction

The UK IPO hosted a meeting on 16 March to review a draft proposal relating to reform the EPO Boards of Appeal (BoA). The proposal, prepared by the European Patent Office, will be discussed at a meeting of the EPO’s Administrative Council (AC) on 25 March.

The IPO hosted meeting was attended by representatives from CIPA, IP Federation, FICPI-UK, IPLA, the Law Society, a representative of the judiciary, and officials from IPO.

Summary of Discussion

The IPO explained the context behind the proposal, in particular a decision of the Enlarged Board of Appeal in review procedure (decision R19/12), and the objective of the draft proposal – which was to increase organisational and managerial autonomy of the BoA.

The proposal would see established a President of the BoA and a BoA committee (BOAC) within the current EPC framework. The majority considered that the proposed approach should be seen as an interim measure, until changes delivering greater autonomy could be incorporated in a revised EPC. Others thought that changes within the current EPC framework might be successful and that the impact should be reviewed before considering a revision of the EPC. All agreed that a future amendment to the EPC could not be ruled out and that this could take significant time (the EPC2000 took 7 years to enter into force).

The draft proposal was broadly welcomed but there was clearly scope for improvements and clarifications, particularly on the separate issues of independence and the efficiency of the boards.

The meeting also thought the AC would want to ensure the likelihood of further legal challenge was minimised.

It was noted that one of the limitations associated with the current proposal, where powers are to be delegated from the President of the Office to a new President of the BoA, was the extent to which this delegation was permanent. To clarify the position it was suggested that the AC should agree rules and processes, and set out plans in a political concordat that would help underpin the process.

On the subject of premises, the meeting generally agreed with the principle of physical separation but the majority were of the view that this didn't require relocation to another city or country. Indeed, it was noted that there was already separation between BoA members and the examiners under the current arrangements (with the BoA located in the Isar building). A move to another location within Munich could be supported if the current arrangements do not provide adequate physical separation.

There was a short discussion about the budget setting process for the BoA and the role of the Office and current President. It was noted that the wording did not make it clear whether the AC would have sight of the budget proposal from the BoA. The process must be transparent and the Office should not have the opportunity to exert influence on the BoA under the budget setting process.

Some of the group questioned the need for separate HR and other functions, as arrangements for sharing services would help to keep costs down. Others noted that autonomy required separation of various support and service providers - in order to avoid pressure points which might yield or be seen to yield influence. It was also clear that full separation involving EPC change might incur significant cost.

Representatives from users associations did not want to see the cost of greater autonomy passed onto users in the form of higher BoA fees. It was noted that the proposal would involve additional cost and that this would need to be funded by fees, however, the cost could be covered by a small increase in fees from across different areas.

A number of detailed points were provided on how the wording of the proposal might be improved. The substantive issues reported above and the detailed technical points will inform the UK position during discussion on this document at the March AC.

Robert Watson

REPORT ON FICPI EXCO MEETING - CAPE TOWN **12-18 APRIL 2015**

The main FICPI events for this year took place in Cape Town in April. The Congress was held from 13 to 17, and the ExCo took place for a whole day before it and half a day afterwards. In addition the old CET met before the ExCo, and the new CET at the end of the meeting.

All events were based in the Cape Town Convention Centre, which is linked to the Westin Hotel where most of us stayed. All the working sessions were there and many of the social events too. It is an enormous place which can cope with 10,000 people, so dealing with FICPI was easy. The social side and trips out were well worthwhile. There are various things to do in the Cape, a day trip to Cape Point, Table Mountain, Kirstenbosch Gardens, wine tours, Township visits, and they were all well worth it. There is Robben Island too, of course, which no doubt many visited independently.

The whole event was a great success, an enormous credit to FICPI and in particular to the President, Bastiaan Koster, whose home town it is and who was indefatigable and imaginative in his leadership.

EXCO

Because the ExCo bracketed the FICPI Congress it was only for a day and a half. It was strictly business with none of the workshops we have at longer meetings. There were 104 delegates and 37 delegates' guests.

This was the last ExCo of the three year term of Bastiaan Koster's Presidency. In his report, which is paper EXCO/ZA15/BUR/018, he mentioned as the main events and developments of UPC (and EPUE), the establishment of IP5, our Warsaw Colloquium on quality (quality is essential for efficiency and good attorneys are essential to quality), the Paris Colloquium with AIPPI, on Privilege, the successful Sorrento and Barcelona Forums and the numerous official visits to IP offices including WIPO and interested groups in Brussels. There have also been seminars attached to some of the IP offices visits.

Bastiaan's term has seen an improvement in finances: we were making small though manageable losses but are now usually in surplus. The Treasurer General, Marc Chauchard, has done very well to achieve this, and thanks to his work and Bastiaan's efforts (and also Alastair Neill as former President of FAB) progress has been made on the problem of discrepancy in subscription rates between countries where the whole (or most) of the profession belongs to FICPI (chiefly Germany), and other places where membership is voluntary. Membership size remains an issue, with a need to attract more TM practitioners and more members generally against all the competition for peoples' time. However, membership fees will be reduced as reported below.

Julian Crump, outgoing Secretary General, listed future events. These include an ExCo in Zurich 8-16 April 2016, an Open Forum which is planned for St Petersburg 5-8 October 2016, an ExCo in China in spring 2017 and another Forum planned for Venice 25-28 October 2017. This is the implementation of a new regime of fewer ExCos, which is another part of the current economy drive.

Eric Le Forrestier has been President of the CET for 6 years and is now standing aside. As usual there was extensive work to report, approve and ratify, much of this having been done at the Oxford CET meeting in January that Robert Watson had organised.

The papers concerned included EXCO/ZA15/CET 1101 (Andrew Parkes), a supplementary position paper for the Convergence Team at OHIM on the Black and White TM issue; 1102 by Elia Sugranes concerning the updating of the Register of the Madrid System; 1103 again by Andrew on re-establishment of rights at OHIM, the test has been slightly eased but there are still issues with the Guidelines; 1104 by Petter Rindforth on translation and transliteration of domain names; and 1105 by Andrew and Elia on the Madrid System User Survey by WIPO. Paper 1106 by Robert Watson on OHIM Fee diversion was for approval. It urges that OHIM's cash surplus should not be used outside TM and Design business.

On designs, Robert Watson had authored 1201 on Examination Guidelines (most of our previous suggestions have been taken up, but issues with ex officio action remain) and 1202 reporting on submissions made during the Convergence Programme.

Group 3, which deals with International Patents, PCT, Paris Convention, put forward for approval 1301, a FICPI position on Prior User Rights (Jan Modin) and 1303, a questionnaire on transferring priority rights (Michael Caine). The Prior User Rights position will be published as a white paper on FICPI's website shortly.

Paper 1503, contains the result of the recent patent term extension questionnaire. Paper 1601 by Barry Graham concerns a submission to the USPTO on attorney/client privilege while 1701 (Uwe Borchert) is a position paper on Utility Models and their useful place in the scheme of things. 1702 is a draft questionnaire on filing PCT applications in a foreign language.

Amicus briefs had been submitted on G3/14, clarity of amendment in opposition: apparently our paper was referred to and quoted in the opinion, which went just as we hoped; and G2/12 (Tomato 2) and G2/13 (Broccoli 2): we urge narrow interpretation of the exclusions.

Eric also mentioned CET's attendance on the "Asian tour" by himself, Robert Watson and Jürgen Schmidtchen, visits to WIPO, EPO (for the Tegernsee Group) and the UPC meeting in Trier.

The Treasurer General, Marc Chauchard has been industrious and realistic in addressing financial issues.

In 2016, membership fees will go down 8%; these are payable in addition to the group fee which is held constant. The "ceilings" have been adjusted so that the fee is 25% less for members 51 to 125 and 50% less for members beyond 125. Meanwhile the special arrangement for German members (i.e. all Kammer members), while still relatively small per head, will increase 28%. They will continue to contribute more than any other country overall, by an increased margin.

The cost saving efforts have included trimming the size of parties on official visits, where possible, but with the need to appear a substantial organisation paramount, a reduced daily compensation rate, and, if possible more economical CET venues.

There is good news on expansion of the Federation. In Malaysia and Russia we now have national sections (upgraded from provisional) and Turkey and Poland will soon be applying to become such. The provisional Romanian section is being prolonged at that status.

Mention should be made of PEC (Professional Excellence Commission) created and currently led by Danny Huntington which is presently working on the subject of improving communications between firms. There seems to be a big demand for advice and a number of keen participants in this commission. Also, there is the TEC (Training and Education Commission) up to now led by Peter Huntsman and responsible for organising the courses in South East Asia, (SEAD), in Europe (most recently in Cambridge – last September and this March) and, it was hoped in India. This all needs continued and further sponsorship but is worthwhile in developing early and long lasting relationships.

There are always outside speakers at ExCos. This time Joe Potenza represented ABA. He reported that among many activities they are talking to Congress on "troll legislation", they feel the USPTO interpretations of Supreme Court decisions are a bit awry and they are keeping a close eye on privilege developments.

Our WIPO guest, Jon Sandage (the new Deputy Director General for Patents and Technology) advised that PCT applications are still increasing, up 4.5% in 2014, and so are Madrid filings. There is increased Arbitration and Mediation work at WIPO. The standing committee on patents is not making much progress, but is due to try again in July and the draft design law treaty has got stuck too. There was to be a Diplomatic Conference in Lisbon in May on Appellation of Origin issues. Traditional knowledge and genetic resources are also still live topics of course. FICPI was complimented on the quality of its contributions to WIPO who do appreciate our balanced input.

This was the last Exco of the FICPI three year "term". Elections for the next three years produced a Bureau of Doug Deeth (CA) as President, Julian Crump (GB) Vice President, Roberto Pistoletti (IT) Secretary General with two deputies – Gustavo Barbosa (BR) and Jürgen Schmidtchen (DE) while Marc Chauchard (FR) will continue as Treasurer General.

The CET Presidency is being taken by Coleen Morrison from Canada; Robert Watson is one of her three VPs. Our British group has some other members of the CET, but more would be welcome in order to keep our presence up – we are actually greatly appreciated in our abilities to sort out tangled thinking and clumsy expression.

Andrew Parkes, who is stepping down, was given the special Malcolm Royal Award for services to FICPI at the Gala Dinner. This is entirely deserved; his energy, depth of knowledge, persistence and skills in communicating, both verbally and on paper, have been outstanding and have been the major part of FICPI's contributions in Trade Marks for as long as I have had anything to do with it.

The last bit of ExCo business was to pass five Resolutions, which had been approved in general terms before Congress the day before.

As to these:

- 1 Concerns follow-on (allegedly 'evergreening') patents. We think the position widely misunderstood and are against any new restrictions in patent law.
- 2 Information Disclosure Requirements on counterpart applications are over-onerous and perhaps ultra-vires (for PCT cases where a demand has been filed).
- 3 We ask to be more closely involved in IP5 discussions, to balance the voice of industry.
- 4 This concerns the urgent need for some legislation for SPCs on European Patents with Unitary Effect.
- 5 Is in favour of filing patent application drawings in colour; it can help not to be limited to black and white.

All papers referred to are in the Library of the FICPI.org website. The resolutions are on the opening page.

This was my last of 15 ExcOs as UK delegate and was made much easier thanks to Robert's help as sub-delegate. I have enjoyed them all and it has been very interesting. Simon Rees, UK group President, is going to take over: he is already well known and will I am sure be an excellent representative.

I have been very generously supported by J A Kemp and am most grateful to them.

Alan Senior

REPORT ON WORLD CONGRESS – CAPE TOWN **13-17 APRIL 2015**

This was a really successful Congress, held at a good venue with ample room to mingle and an unusually interesting set of speakers and topics. Bastiaan Koster, outgoing President, deservedly received warm congratulations for his efforts in making it so worthwhile.

A total of 382 members, speakers and observers (of whom 17 were from UK) were joined by 100 delegates' guests for the event.

Here are notes on the sessions I attended.

The keynote speech was given by Craig Opperman, now Chief General Counsel of Naspers and with a terrific record of managing, selling, exploiting and valuing millions of dollars worth of IP in different parts of the world. He started at Spoor & Fisher and feels strongly that patent professionals, although now busy, are in danger of being overlooked or obsolete and are not prominent enough in IP as a whole; which is a much wider topic than patents. The top IP people are normally not patent attorneys. For example, Naspers' only assets are IP, a minority of it patents. He sees rising filing numbers as a threat ("commoditising") which lowers the brainy

input required: less time is spent preparing each case nowadays, he claimed, and he also notes a fall in patent litigation as a sign of reducing importance of patents in the IP firmament.

Interesting and thought provoking, it was an outstandingly articulate presentation.

Andrew Bailey of the University of Cape Town Technology Transfer spoke on that University's approach and concerns. They have a lot of work, 2,500 research contracts a year, and the University helps with seed funding for the patenting procedure. Potential partners seem to be delaying commitment for longer than previously, putting PCT expenses on the department and delaying useful input from partners. A longer PCT chapter 2 period and universal grace period would be very welcome. The tactic currently is a UK initial filing, search and perhaps early grant. This helps a lot with finding commercial partners. A very good paper.

The internal review system of current projects has become increasingly sophisticated, and schemes to get academics to delay publication have been developed.

Contributions from people from Sasol and Accelergy completed this session. Both were concerned with recognition of the importance of IP; it cannot be avoided and needs to be kept under constant review, and turned into useful business information. They noted that its continued growth and increasing complexity means that the topic is becoming ever larger. Sasol is the South African oil from coal expert: Accelergy, from Texas, are into synthetic fuel and fertilisers leaving low carbon footprint.

A session on "evergreening" featured Jürgen Dressel (Novartis) who gave the most effective of the presentations in explaining the misleading nature of this emotive term. Don't forget, he pointed out, that generics companies also invest and traditionally innovative companies produce generics. Fiona Bor of Mylan, formerly SKB and Teva thinks some "incremental" improvements do not merit 20 years, and it is awkward she says that the standards of patentability vary internationally.

Ellen 't Hoen, founder of the Medicines Patent Pool, thinks many secondary patents are underserving of the normal term. She gave several examples of situations where public pressure had caused patent holding companies to back away from enforcement, particularly as regards AIDS, so far, but other areas will see the same thing soon.

"Managing your assets in the Software Space" was an interesting session led by Brett Slaney (Blakes, Toronto). Tim May (Finnegans) started with comments on Bilski and Alice, the interim USPTO Guidelines now in place and said that many US patents that would previously have survived now do not. James Ward (Haseltine Lake) dealt with the present European situation. Krishna Pathiyal of Cisco Systems took the honours really with his comparison of open source and patents.

Cisco have 25,000 engineers, billions of dollars revenue and thousands of patents. But they also provide, and use, OSS, and indulge in "targeted givebacks" to the open community. It is important to manage OSS participation proactively to reduce IP risk, and so basically OSS and IP co-exist, are both important and profit from each other. Even Red Hat, he points out, hold patents; defensively. This was a clear example of how there is far more to IP than merely acquiring the rights.

Benoit Battistelli gave the first presentation on behalf of a patent office. No doubt readers are aware of much of what he said when reciting filing and grant numbers, that the new classification system is being widely used, that prior art citations are increasingly in Asian languages, that an "early search" initiative gives a result in 6 months. The IP5 "global dossier" is on its way and will become more complete as time goes by – he used the Congress to announce the extension of the scheme to Japanese and South Korean files. He dodged a critical question about Board of Appeal delays and indicated that discussions of EP with UP patent renewals were difficult.

A session on IP offices in the future had people from the EPO, South Africa, France, Australia, Japan, OHIM, US PTO, ARIPO and WIPO. They all contributed snippets, and perhaps the ARIPO

man from Harare was the surprise packet with an accomplished description of what they do – and don't: such as the Madrid system which they cannot work because domestic laws are not sorted.

South Africa will start examining applications in three years. They are getting help from the JPO. The Australians are helping ARIPO examiners, the US PTO is surprised by the quantity of post grant proceedings and are short of judges. The OHIM man gave a glimpse of the "Black and White" problem by saying he thinks their convergence programme proposes a logical extension of the Translator decision. Arguing did not seem worthwhile!

The EPO Board of Appeal reform was mentioned, too, in sensible terms.

In other sessions, James Pooley was interesting on IP Treaties and harmonisation. TRIPS, he says, which put IP as part of trade, disappointed developing countries in that there is not enough access to technology nor enough transfer of it. This has left them with little appetite for more harmonisation. And are you surprised that Eli Lilly expect every patent they obtain to be contested, as Larry Welch told us?

Finally, an open discussion on "where are we going" showed that many delegates, whether or not influenced by Craig Opperman's opening presentation, think that our business will extend its competence into business and financial advice, divide between high profit, low volume work and vice versa, concentrate on domestic clients and expect our ancillary services to be eroded. But that we will still draft, file, prosecute and litigate.

Alan Senior

MEETING WITH IPO REGARDING FEE CHANGES

Date: 21 May 2015

At the May council meeting we were pleased to welcome James Porter and Debbie Cooke from the IPO. James is the head of a team dealing with patent law and practice at the IPO and Debbie is one of the team whose current role is to handle the fees review.

The visit was prompted by a suggestion in a PPWG meeting that users should be consulted on the overall strategy of the fees review before specific figures were proposed for particular fees. This demonstrates that what we say at PPWG is listened to, so if you have a particular issue to raise with the IPO please bring it to our attention so that we can raise it on your behalf.

During the run up to the election civil servants were not permitted to organise their own events to canvass views but were able to attend and discuss IPO policy at meetings already arranged for other purposes, such as a FICPI Council meeting. James and Debbie were attending a CIPA meeting in the afternoon and had already had discussions with industry groups. The perspective from a group solely of private practitioners is often different.

It is part of the IPO's Corporate Plan to undertake a review of the statutory fees. This is overdue since the last one was in 2010.

The review is likely to have the following objectives:

- To ensure that the income of the IPO is sustainable (since it gets no income from the government)
- To ensure balanced cost recovery
- To influence applicant behaviour
- To ensure consistency, e.g. across all rights granted.

A number of ideas for possible new fees and balancing of existing fees were discussed, some based on knowledge of fees applied in other jurisdictions. Here are some of the ideas the IPO is airing and the views we expressed.

PATENTS

Page fee – this was felt to be unjustified, at least at the filing stage, since the specification is not actually printed and therefore a large number of pages does not create extra work.

Claims fee – this might be palatable but the threshold of 15 applied by the EPO is too low especially for chemistry inventions. It was agreed that applicants should be encouraged to avoid several independent claims of overlapping scope which create work for examiners, and something along the lines of EPO Rule 43 was suggested rather than a fee for multiple independent claims. If claims fees are to be introduced we would like the opportunity to amend the claims prior to the search being carried out.

Search fee – the fact that the IPO does a good quality search very cheaply, together with the PPH, is thought to be the main reason for the IPO's increasing work load. There is room for some increase but if the fees get too high applicants might go elsewhere to first file.

Grant fee – could this help to rebalance the prosecution costs versus renewal fees? This would be more palatable than higher examination fees, but harder to justify since there is little further work to be done at that stage.

Extension of time fees – reasonable EOT fees were felt to be acceptable.

Division/additional search – is the IPO sufficiently strict on amendments after the opportunity for voluntary amendments has passed? Are there opportunities to require applicants to divide applications or request additional searches with a view to a more focussed and hence efficient examination?

Application fee – applications from unrepresented applicants that are not pursued cause a lot of work for no fee under the current structure. Could the requirement for an application fee be brought forward whilst still complying with the PLT? At least the IPO would like to discount the fee if paid on filing which was felt acceptable since most represented applicants have this paid on filing.

Fee for recordal – this needs to be harmonised across all rights. Also a slightly larger fee to record a transaction against multiple patents would be acceptable.

Fee for Hearing – this was felt to be unacceptable and to interfere with the basic right of the applicant to be heard.

Post Grant Amendment fee – this would be acceptable since by that stage the patent must be important and worth spending money on.

Opinions – the current fees were felt to be much too low and to encourage opinions to be sought frivolously.

DESIGNS

Designs fees were already discussed in an MDF meeting. Here there are more “genuine” unrepresented applicants. At present the fee is attractive and a large increase would push applicants towards OHIM which is favoured by attorney representatives. It was noted that in Germany you can register ten designs for the price of one.

TRADE MARKS

At the moment a mark can be registered in up to three classes for the same fee. Applicant behaviour and hence cluttering of the trade marks register could be influenced by charging a fee per class.

CONCLUSION

The IPO will take account of the views put forward and formulate a strategy. In the autumn there will be an open consultation on proposed fees, by which time specific amounts will have been proposed.

You are of course free to put forward your personal views on any of the above, or any other issue, direct to the IPO. However they will carry more weight if endorsed by a body such as FICPI, so if you have any comments that you would like us to relay to the IPO please let us know as soon as possible. We will consider them in council and if we agree we will contact the IPO and put forward your position on behalf of FICPI.

Liz Dawson

FUTURE EVENTS

BUSINESS PRACTICE SEMINAR/AUTUMN DINNER

24 September 2015

The annual FICPI-UK Business Practice Seminar will be later than usual this year, but it will be worth the wait. This year's theme is "Shaping our Businesses for the Future" and here are some of the topics we shall be discussing:

- partner remuneration – the pros and cons of different partnership structures – do the traditional models stand up to present day challenges?
- other business structures and the trials of setting up alone – speakers will share their experiences of working freelance, setting up their own firms and being part of skills networks
- protecting the firm during partner and team moves – patent attorneys are more mobile than they used to be and fewer are staying with the same firm for their whole career – how can firms weather the upheavals of significant departures?
- the opportunities and threats to our businesses from harmonization and globalization
- diversity – why should you operate a diversity policy and if you think you do it already, are you sure?

Our meetings are always marked by a willingness by all participants to share their own insights and we hope this will be no exception. Put the date in your diaries and more information will follow soon.

Simon Rees

ABC MEETING

June 2016

We are delighted to announce next year's ABC Meeting will be taking place at the host venue for the 2010 Ryder Cup and the 2014 NATO Summit; The Celtic Manor Resort from Sunday 19th to Thursday 23rd June 2016.

The professional programme for the conference comprises of three morning sessions, presenting the latest news and developments from the UK, US, and Canadian groups. Following on from the success of the previous UK event in Bath in 2011, we are once again privileged to be joined by the Rt Hon Professor Sir Robin Jacob as a guest speaker, for an update on the Community Patent Court.

The schedule is designed to permit group outings in the afternoons and evenings for member networking while taking in the sights, sounds, and tastes of South Wales. A full programme will be developed over the coming months, for what will be a memorable event. The social events will include a banquet at Cardiff Castle, a visit to the Welsh Folk Museum in St Fagans, and to “Big Pit”, which is a coal mining museum that’s a World Heritage site – to include a trip underground to the coal face!

The joint ABC conference is not limited to FICPI members from the US, UK, and Canada, but is open to all FICPI members and, of course, accompanying persons.

Registration details will be sent in the autumn.

Simon Rees

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Diary 2015:

24 Sept Business Practice Seminar
 November Annual Dinner

Diary 2016:

Spring EXCO, Zurich
 19-23 June ABC Meeting – Newport, South Wales
 Oct FICPI Forum, St Petersburg

Diary 2017:

Spring EXCO, China
 Autumn Forum, Istanbul

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