



RESPONSE TO CONSULTATION ON THE PROPOSED CHANGES TO THE PATENT RULES

FICPI-UK

FICPI-UK is a self-governing national association of FICPI (The International Federation of Intellectual Property Attorneys). We represent the interests of our members who are intellectual property attorneys (patent attorneys and trademark attorneys) working in private practice (i.e. in firms that have more than one client) in the United Kingdom, as well as of their clients.

We have about 100 members in over 25 firms spread across the UK, and members' clients vary from large international organisations, UK plcs, Universities and Charities to Small and Medium Enterprises and sole inventors.

Response

FICPI-UK welcomes the proposed changes to the Patent Rules.

Specific comments on the eleven proposals relating to practice under the Rules are set out below:

i. Introducing a notification of intention to grant, thereby removing the need for applicants to foreshadow divisional applications.

The proposal to introduce a notice foreshadowing grant is welcome by FICPI-UK, since as stated in the consultation document it introduces greater certainty for applicants.

The period between notification of grant and actual grant is primarily used to decide whether or not a divisional application is required. Therefore, FICPI-UK believes that the 2-week period proposed in paragraph 12 of the consultation seems short in view of the following processes which often occur during this period: time taken to receive the postal communication from UKIPO; internal processing by representatives, forwarding the communication (electronically) to clients; processing on the client side; receiving and processing client instructions; preparing any necessary divisional application.

FICPI-UK therefore proposes a window of at least 1 month between the notification of grant and the actual grant date. In comparison, the EPO uses a similar period of about 1 month.

We also wish to comment that the proposed wording for Rule 19 seems over-complicated. We wonder whether sub-paragraph (1) could be omitted and sub-paragraph (2) amended to read "A new application may be filed as mentioned in section 15(9) only if - ", with sub-paragraph (3) moved to sub-paragraph 2(c) which reads "the new application includes a statement that it is filed as mentioned in section 15(9). In summary, we propose that Rule 19 could read as follows:



19 – A new application may be filed as mentioned in section 15(9) only if –

- (a) the earlier application has not been terminated or withdrawn; and
- (b) the period ending three months before the compliance date of the earlier application has not expired; and
- (c) the new application includes a statement that it is filed as mentioned in section 15(9).

We appreciate, of course, that such a proposed wording may not be feasible if numerous other consequential changes are needed to other parts of the Rules, or indeed if parts of the primary legislation within the Patents Act itself refer to the existing Rule 19 (and as such cannot be changed at this stage). If such changes are not possible now, we would appreciate these comments being retained for use during a more substantial review of the Rules.

ii. Prohibiting the use of omnibus claims except where absolutely essential.

FICPI-UK finds this proposed Rule change acceptable, since the prohibiting of omnibus claims is not seen as detrimental to Applicants, particularly in view of the exception where absolutely essential.

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

FICPI-UK welcomes the proposed changes, and is in favour of the legislative option in order to simplify matters, i.e. to 12 months beginning immediately after the date on which the application was terminated.

iv. Allowing extensions to the period for filing an address for service.

FICPI-UK welcomes this change. It seems reasonable to allow the period for this to be extended.

v. Relaxing the formal requirements for drawings to allow applicants to provide shaded drawings and photographs.

FICPI-UK welcomes the suggestion to allow photographs and shading within drawings.



It is noted that FICPI-UK further urges the move towards acceptance of colour drawings, which we appreciate requires harmonisation with other intellectual property offices around the world.

vi. Removing the requirement for patent proprietors to notify the IPO each year of the address for receipt of the renewal reminder.

FICPI-UK welcomes this change.

vii. Clarifying the period for making amendments to international applications upon their entry to the UK national phase.

FICPI-UK welcomes this change.

viii. Clarifying the requirements concerning changes of names and addresses.

FICPI-UK welcomes this change.

As an alternative to the proposed introduction of sub-paragraph 6(b) to Rule 49, we wonder whether the proposed change could be incorporated by simply amending the title of Rule 49 to read “Correction or change of name, address, and address for service”, with similar reference to “correction or change” in the remaining sub-paragraphs of Rule 49, other than sub-paragraph 6(a) which refers to correction under Section 117. (As mentioned earlier, we appreciate that this might not be possible if primary legislation refers to the existing title).

ix. Correcting the drafting of the rule concerning advertising amendments made during infringement and revocation proceedings.

FICPI-UK welcomes this change.

x. Removing the requirement for triplicate copies of international applications to be filed when using the IPO as a receiving office for such applications.

FICPI-UK welcomes this change, since removal of this requirement is sensible if it is not being enforced.

xi. Removing the requirement for duplicate copies of Patents Form 51 to be filed when notifying the IPO of the appointment or change of agent.

FICPI-UK welcomes this change, since removal of this requirement is sensible if it is not being enforced.

Further information

If the UK IPO would like to discuss our comments, they should either contact the undersigned or:

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The above comments have been approved by the Council of FICPI-UK.

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