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# Not Just a Matter of Opinion
# The UK IPO Opinions Service

**Since October 2014 the scope of the UK IPO's Opinion Service has been expanded to give it more "teeth". Two years on, it is time to reconsider the effects of those changes and why many are embracing the expanded service with enthusiasm.**

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## Overview of UK IPO Opinions

Key features of the current Opinions Service are as follows:

+ ***NEW*** **A route to revocation** – If an opinion finds that a patent is "clearly invalid" and it is "clear-cut" that the patent lacks novelty or inventive step, then 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 and paper-based in which the parties' entire case is set out at a very early stage. Following a reply to the request for an opinion, and counter reply, an opinion is issued on the paper file 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 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.
+ ***NEW*** **Range of attacks** – It is now 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 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 *NEW* SPCs** – The UK IPO will provide an opinion on the validity and/or infringement of all granted patents 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 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 Patentee 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 Patentee 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 revised service.

Since October 2014, 13 final opinions have found a patent to be invalid and 13 have found a patent novel and inventive. In the 8 instances in which a finding of invalidity has been finalised (e.g. because the period to request a review of the opinion has passed), the IPO has launched revocation proceedings in 5 cases. The IPO's willingness to launch revocation proceedings demonstrates that there is a readiness to exercise its power to revoke "clearly invalid" patents.

Since the changes came into effect in October 2014:

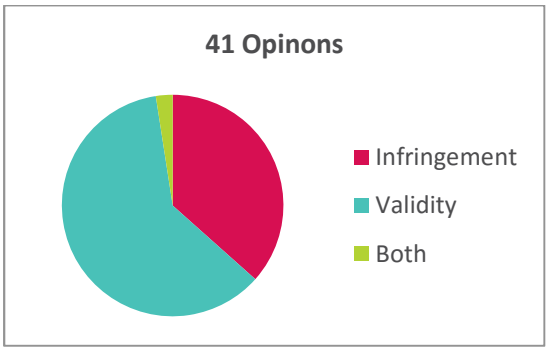
- 41 Opinions issued
- 26 Opinions considered validity
- 13 Findings of invalidity
- 5 Revocation actions commenced
- 3 Revocation actions concluded:
  2 patents revoked, 1 maintained

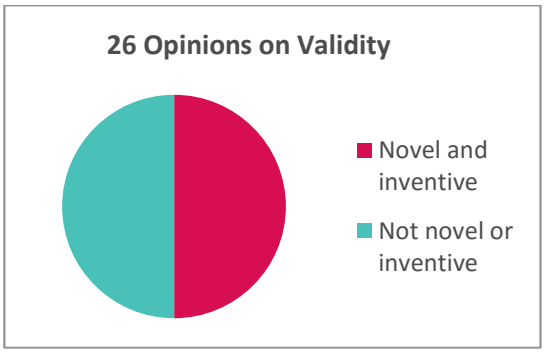
The sample size is too small to draw any firm conclusions about when the IPO considers a patent to be "clearly invalid". In 4 out of the 5 cases in which the patent was found to lack novelty, and no action was taken to amend the claims, revocation proceedings were launched, thus suggesting that a finding of lack of novelty is likely, but not certain, to result in a revocation action. 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 patentee 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".

**41 Opinions have been issued since the changes came into effect on 1 October 2014:**

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Revocation actions commenced by the UK IPO

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 patentee 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 patentee 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.

## 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. ■

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