

RESPONSE DOCUMENT

ON

A CONSULTATION ON FAST-TRACK PROCESSING OF PATENTS

Background

1. In December 2005, the Chancellor of the Exchequer asked Andrew Gowers to conduct an independent review into the UK Intellectual Property Framework. The Review was published on 6 December 2006. One of the recommendations outlined in the Review focussed on the speed at which patents are processed and granted and suggested that fast track processing should be pursued in order to speed up the process, when required by the applicant in a particular case. In the autumn of 2007 the UK Intellectual Property Office (UK-IPO) therefore carried out a public consultation on a new fast track service for processing patent applications. The consultation also included a proposal for the fast track processing of trade mark applications. This proposal has been dealt with in a separate consultation response document.

2. A new single process for fast tracking the processing of a patent application was proposed in the consultation document where, for an additional fee of £400-£600 Office actions would be fast-tracked so that a patent could be granted within a year from the date of filing. The new fast track system was to encompass our existing Combined Search and Examination (CSE) service, which would no longer be available as part of our normal service.

Responses

3. A total of 17 responses were received. Of these 16 commented on the proposal relating to patents. Responses were received from professional representative bodies and other interested representative bodies which together represent a large cross-section of users of the UK patent system, firms of patent attorneys, other interested firms, and from individual patent agents.

Summary

4. A detailed analysis of the responses received to the consultation, and the government response and conclusion, is set out below. In summary responses to the proposal were mixed. Overall there was greater support for retaining a system along the lines of our current accelerated services than for a system similar to that proposed in the consultation document. Some did however comment that there was a lack of awareness of our existing services.

5. In the light of these responses we will not be proceeding at this time with a fast track system for processing patent applications in the terms proposed in the consultation document. Instead we are in the process of clarifying and giving more prominence to guidance in relation to our existing services. This guidance will set out more clearly how our accelerated services may be used to provide a single fast track to grant. A new guidance note will be issued (see Annex A) and will be clearly available on our website.

6. We have also embedded into our balanced scorecard (which sets out our key targets) for 2008/09 a target for processing accelerated examinations, namely to issue a substantive response to an allowable request for accelerated patent examination within 2 months of receipt in 90% of searched applications. This will make it clearer what an applicant can expect from our accelerated examination service and emphasises our commitment to our accelerated services.

Issues

General principle

7. All respondents supported the principle of offering a fast track system for processing patent applications. There were however differences of opinion on the best way of achieving this. Some felt that the current system, where accelerated processing is available for free if there are adequate reasons for wanting accelerated processing, worked well. It was very flexible and, if accelerated processing was really needed, there were normally sufficient reasons for the Office to allow the request for accelerated processing. A couple of respondents gave examples of how they had used the existing services to obtain the grant of a patent in less than a year. A number of respondents mentioned that it was unclear that there was a demand for a new system, and that the Gowers Review recommended a system which complemented rather than replaced existing systems. It was however acknowledged that awareness of these existing procedures and how they could be used to achieve a fast grant was low. One representative body suggested that a fee could be payable in circumstances where the reasons for requesting fast track processing were not adequate. A number of respondents emphasised that any new fast track system should not have a detrimental effect on the quality or speed of the normal system. These respondents said that in fact the normal service should continually be improved with a view decreasing processing times and reducing backlogs.

8. Some other respondents supported a system where fast track processing to grant is available without requiring adequate reasons but upon payment of a fee. Some however felt that such a system should be free, and if a fee should be charged at all, it should be modest.

9. Overall there was greater support for retaining the requirement for reasons and not charging a fee than for a fee-bearing system available without requiring reasons.

Fast Track and Combined Search and Examination (CSE)

10. Most respondents, even those that supported a fee-bearing fast track system, did not support a fast track system which replaced the existing CSE service, currently available for free. It was highlighted that the free CSE service is an important selling point of the UK-IPO and to charge a fee for this service would reduce the attractiveness of the UK-IPO as a patent granting authority to filers of patent applications. If anything CSE should be encouraged to become the norm.

The Fast Track fee structure and the level of the fee

11. Many respondents said that a fee should not be charged. A number of respondents felt that, if a fee was to be charged, it should be modest. The proposed fee level of £400-£600 was considered too high a premium for a fast track service. A link between the level of the fee and the level of demand was acknowledged. Comparisons were drawn between the fees for a UK fast tracked application at the proposed fee levels and the minimum fees for a patent application filed at the European Patent Office (EPO). Some did however say that UK official fees were a small percentage (5-10%) of the overall cost of obtaining a granted UK patent. One respondent said that the fee should not be used to manage demand, but should be set at the level that the extra work involved in fast tracking an application would cost. An interesting point made by a respondent was that if a patent application is published and granted more quickly then it is enforceable for a larger number of years. The cost per year that the patent is in force may therefore actually be lower for a patent fast tracked through to grant. Few respondents commented specifically on the preferred fee structure. Views were mixed amongst those that did.

Third party observations under section 21

12. The consultation asked whether the three month period allowed following the publication of an application for third parties to file observations on the patentability of the invention before granting a patent on that invention was appropriate, or whether this period could be reduced with no detrimental effects on the quality of granted patents. Some respondents said that three months was about right whilst others said three months was a minimum. There was little support for reducing the period. One respondent suggested that a mechanism for observations to be filed directly from the publication enquiry service would be useful. A representative body suggested that the UK-IPO could perhaps investigate whether providing means for third parties to file third party observations against patents post grant might provide a useful improvement to quality as providing notice on the file of potentially relevant art, and providing information to patentees to enable them to limit their patents if required.

Demand

13. There were mixed views as to the level of demand for the proposed service. Some felt that it would be relatively low (less than 5%) whilst others felt that it could be higher with the removal of the need to provide reasons for requesting fast track. Some took the view that the level of the fee would act to control demand whilst others felt that even with the increased fee the official fees were still a relatively small percentage of the total cost of obtaining a granted UK patent. Some respondents thought that there could be an increase in demand from unrepresented applicants. It was pointed out by several respondents that the EPO's free accelerated search service, for which no reasons are required, is taken up on approximately 5% of applications.

Other comments

14. One representative body asked whether, in cases where patents were granted and litigation was subsequently completed before the search for documents not published at the time of the initial search could be completed, injunctions could be granted in a case where no one was aware of the prior art.

15. The consultation document mentioned the risk of unrepresented applicants opting for fast track when it was not in their best interests to do so. A number of respondents agreed that this was a real risk. One respondent suggested that fast track should only be available to professional representatives. Another respondent which represented inventors however said that in many cases an invention would not suffer from the early publicity resulting from early publication of the patent application and that the risk to unrepresented applicants should not be overstated.

16. It was suggested that third parties should be able to request fast track processing of any patent application.

17. One respondent suggested a fast track system for examination which brought the application to the stage that it was in order (but not granted) and a separate fast track system for accelerating the formalities associated with grant once it had been agreed that the application was in order.

18. One respondent said that a request for fast track should not automatically trigger early publication.

Government response and conclusion

19. The views of all the respondents are fully appreciated and have been carefully considered. In the light of these responses we will not be proceeding at this time with a fast track system for processing patent applications in the terms proposed in the consultation document. In particular we will not introduce a fast track system which carries a premium fee. This means that Combined Search and Examination (CSE) will remain available for free as it is at present. Instead we are in the process of clarifying and giving more

prominence to guidance in relation to our existing services. This guidance will set out more clearly how our accelerated services may be used to provide a single fast track to grant. For example a new guidance note will be issued along the lines of Annex A and will be clearly available on our website. We have also embedded into our balanced scorecard (which sets out our key targets) for 2008/09 a target for processing accelerated examinations. This target is:

“to issue a substantive response to an allowable request for accelerated patent examination within 2 months of receipt in 90% of searched applications.”

This will make it clearer what an applicant can expect from our accelerated services and emphasises our commitment to our accelerated services.

Annex A – Guidance note

Getting your patent granted more quickly

1. Getting your patent granted may sometimes seem like a long process. Your application must first be searched, then published, and then examined before it can be granted. We do however offer ways of speeding things up in certain circumstances and together these accelerated procedures can help you get a granted patent much more quickly.

Will a fast grant be helpful?

2. You should think carefully about whether a fast grant is in your best interests. For example, the earlier your patent application is published the earlier the technology is in the public domain. Many applicants are happy to proceed to grant at a slower pace because it enables them to develop and plan the commercialisation and marketing of their invention whilst the patent application process continues. It gives them time to determine whether their invention is commercially viable before committing to a greater financial outlay.

3. There are however circumstances when a fast grant of a patent may be particularly helpful. For example you may see someone infringing your patent application and may want to get a quicker grant in order to be able to take action. Or an investor may require a granted patent before they are willing to invest in your invention (although some investors may be satisfied with the filing of a patent application).

We offer three types of accelerated service:

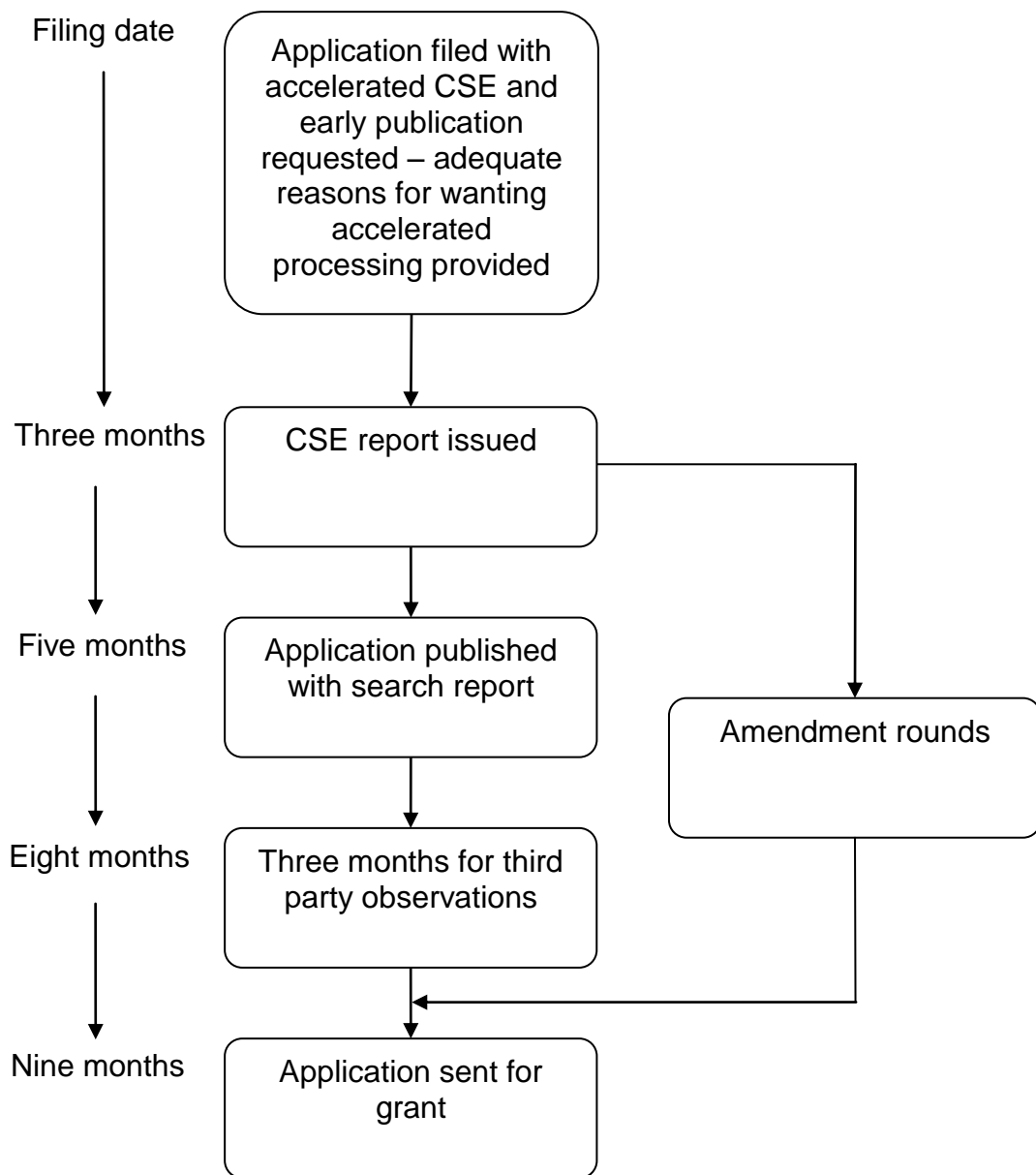
- Combined search and examination (CSE)
- Accelerated search and/or examination
- Early publication

4. Details of these three services are available below. Combined search and examination and early publication are available upon request but to accelerate search or examination you must demonstrate to us why it is important to you that these be accelerated.

How can you use these to get a fast grant?

5. If you request, at the time of filing your application, all three of the above services (and provide adequate reasons for wanting things accelerated – see below) and respond promptly to our reports and letters then you can get your patent granted very quickly – for example in less than a year. See the example timeline below for further details.

A fast track to grant



6. Even if you are not able or do not wish to provide us with adequate reasons for wanting things accelerated, you can still request combined search and examination and early publication which, if you respond promptly to our reports and letters, can still get your patent granted quickly.

Details of the three services

Combined search and examination (CSE)

7. Most applicants request examination of their patent application some time after receiving the results of the search. If you file your requests for search and examination at the same time we will however do the examination at the same time as the search and issue a combined report. This will start the examination process much sooner and thus helps to get your application ready for grant more quickly. You don't need to provide us with any reasons for wanting to use this service. You will normally receive both the search and the examination reports within four months of requesting search and examination.

Accelerated search and examination

8. For normal applications we aim to issue search reports within about four months – we have an agency target to issue 90% of patent search reports within four months of request. But there may be occasions when you want a search (or a combined search and examination) more quickly, and in such circumstances you can request this. You will however have to give us adequate reasons for your application to jump the queue. Your actions may be a factor in deciding whether to agree to the request. For example a delay in requesting search may in some circumstances count against you.

9. You can also request an accelerated examination. As for accelerated search, you need to give us adequate reasons for your examination to be accelerated. You can request accelerated examination at any time, even before the application has been searched, in which case you can ask for accelerated combined search and examination (CSE).

What do you get if your search, examination or CSE are accelerated?

10. If we agree to your request for accelerated search, examination or CSE, the examiner will arrange a timescale with you as to when a report will be issued. If your examination or CSE is accelerated, all subsequent amendment actions will also be accelerated providing your actions continue to demonstrate a desire to process your application quickly. We have an agency target to issue a substantive response to an allowable request for accelerated patent examination within 2 months of receipt in 90% of searched applications.

What sort of reasons will the UK-IPO accept to allow accelerated processing?

11. Whether or not the reasons provided will be sufficient for us to allow a request for accelerated search or examination will depend very much on the circumstances of the case in question. If you demonstrate that you need a patent granted quickly because you are aware of a potential infringer, or need

a faster search, examination or grant in order to secure an investor, then we are likely to accede to your request for accelerated processing.

Early publication

12. Most applications are published eighteen months from their filing date (or priority date if they have one). You can however request that your application be published early. If you make such a request your application will be published in about six weeks from our receipt of your request (provided the search has been done). This helps achieve a fast grant as a patent cannot be granted until three months after the application has been published. This is to allow a period for interested parties to make observations on the patentability of the invention.

How do you request these accelerated services?

Combined search and examination

13. Your application will automatically be subject to combined search and examination if you file your requests for search and examination at the same time.

Accelerated search or examination

14. You can request accelerated search or examination in writing, setting out the reasons why you need your search or examination to be accelerated. If you want to request accelerated processing at the same time as filing your patent application, you can include the request in a covering letter. An examiner will consider your request and will confirm whether or not your request has been allowed, based on the reasons you give.

15. It is helpful to us if you clearly mark any correspondence for example, as **“URGENT – ACCELERATED PROCESSING REQUESTED”** or using similar words if your application is being accelerated. This will help us to identify correspondence relating to accelerated applications as early as possible after the Office has received the correspondence and thus ensure that the examiner receives this correspondence as quickly as possible.