

UK IP Office Opinions – A Low Key Route to Challenging Validity

In October 2014 the scope of the UK IPO's opinion service was expanded to give it more "teeth". The UK IPO is now able to initiate revocation proceedings of its own motion if a patent is found to be "clearly invalid" and the range of issues that can be considered in an opinion has been expanded. This article reflects on the first 18 months of the expanded service and why it is now being embraced by companies in the chemical and life sciences sector.



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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, seven final opinions have found a patent to be invalid and eight have found a patent novel and inventive. Of the seven instances in which a patent was found invalid, the IPO has launched revocation proceedings in four instances, demonstrating that there is a readiness to exercise its power to revoke "clearly invalid" patents.

The sample size is too small to draw any firm conclusions about what constitutes a sufficiently clear finding of invalidity to meet the "clearly invalid" and "clear-cut" test. In three out of the four cases in which the patent was found to lack novelty, revocation proceedings were launched 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 making 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 are no longer "clearly invalid".

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 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.

As well as providing an assessment of the validity of a patent, opinions can be sought on Supplementary Protection Certificates (SPCs). In [Opinion 9&10/16](#) the validity of a Supplementary Protection Certificate (SPC) directed to a patented medicinal product was considered. While the main claims of the Patent were found invalid, dependent claims covering the product on which marketing

authorisation had been granted were found valid and so the SPC was also found to be valid.

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.

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.

If you would like more information regarding the UK IPO's opinion service, or more information regarding any of the points raised above, please do not hesitate to get in touch with your usual Abel & Imray contact, or send an email to ai@abelimray.com.

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