

9 October 2007

PATENTS ACT 1977

Kathryn Naylor

Requester

PROCEEDINGS

Request under section 74A of the Patents Act 1977
for an opinion on patent number GB 2400597 B

HEARING OFFICER

Phil Thorpe

DECISION

Introduction

- 1 This decision relates to a request for an opinion.
- 2 The request was filed on 25 July 2007 in the name of Kathryn Naylor of Mathys & Squire ("the requestor"). The request sought an opinion on whether patent GB 2400597 B ("the patent"), in the name of IMI Cornelius (UK) Limited, is valid in view of the disclosure in GB 2401423. The request recognises that GB 2401423 has been cited in two examination reports issued by the UK Intellectual Property Office ("the Office") during the pre-grant examination of the patent.
- 3 In a letter dated 6 August 2007, the Office informed the requester that it proposed to refuse the request as it appears to relate solely to a question that was considered during the examination of the patent. The letter offered a hearing to the requestor in the event that she wished to contest the decision. The letter noted that in the absence of any request for a hearing, the opinion request would be refused. The requester did not request a hearing. I therefore intend to refuse the request but before doing so will briefly set out the reasons for my decision.

The law

- 4 I discussed the law relating to opinions, in particular the various sections and rules relating to the refusal of a request in some detail in an earlier decision in which I refused another request for an opinion¹. A copy of this decision is publicly available on the Office's website and therefore I do not intend repeating that discussion here. I will however note that the relevant provision so far as this decision is concerned is section 74A(3)(b) which reads:

The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so-

(a) ...

(b) if for any reason he considers it inappropriate in all the circumstances to do so.

- 5 In that earlier decision I also considered at some length the question of whether it is appropriate to issue an opinion if the question at the heart of the request has already been considered during the pre-grant examination of the patent. I noted that it was always the intention that the opinion service would not be used to repeat or in some way reappraise the examination of the patent performed either in this Office or at the European Patent Office. Rather the intent was always that there should at least be something new – the request should not simply seek to go over old ground. The rationale for this being, not unreasonably, that a patentee should not be asked to deal again with a question that he has already dealt with to the satisfaction of the Office pre-grant.
- 6 I should perhaps add that I do not believe that every request for an opinion should be required to cite a new piece of prior art but rather that it should at least put forward a new question. In this case I can find no new question. The prior art relied on was clearly considered during the examination process - indeed it was cited against the novelty of the patent application in two separate examination reports. Consequently I do not believe that the request gives rise to any new question.

Conclusion

- 7 I refuse the request made under section 74 by Kathryn Naylor for an opinion on patent number GB 2400597 B.
- 8 I am conscious that the opinion procedure is relatively new and that there is little guidance available yet as to scope of questions on which it will be appropriate to issue an opinion. In light of this I believe that it is appropriate to refund the fee paid in this case.

¹ BL O/289/07 at http://www.ipo.gov.uk/patent/p-decisionmaking/p-challenge/p-challenge-decision-results/p-challenge-decision-results-bl?BL_Number=O/289/07

Appeal

- 9 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

Phil Thorpe

Deputy Director acting for the Comptroller