

### Validity and Infringement opinions from the UKIPO

In 2005, the UK Intellectual Property Office (UKIPO) introduced a new procedure to provide independent, non-binding opinions on questions of validity and infringement of UK and EP(UK) patents. These opinions are provided quickly (typically within 3 months of being requested) and at relatively low cost. A flow chart of the procedure is shown overleaf.

#### WHO CAN REQUEST AN OPINION?

Any person can request an opinion on validity or infringement of a UK or EP(UK) patent from the UKIPO. Typically, opinions are requested by the patent holder, an exclusive licensee of the patent, or a person or company for whom the patent poses an infringement risk.

Mewburn Ellis LLP can request the opinion on your behalf. It is possible (if you wish) for you to remain anonymous during the opinion procedure.

#### What evidence and information must be provided?

When requesting an opinion, it is necessary to set out in full the evidence and arguments that support your position. This is important because the usefulness of the opinion will depend heavily on the evidence provided to the UKIPO Examiner. For example, if you are the patent holder and you want an opinion that a competing product infringes the patent, it is necessary to identify the patent, set out full relevant details of the alleged infringing product, explain why you think there is infringement, identify the persons who may have an interest in the procedure (e.g. the manufacturer of the alleged infringing product), and set out any relevant EPO, UKIPO or UK court proceedings that have considered the patent or patent application or are pending. Such proceedings may prevent an opinion being issued. We can help you with all of this.

With respect to validity, the UKIPO usually will not consider prior art that has already been sufficiently considered in relation to the same patent or patent application at the EPO or the UKIPO.

#### On which grounds can a validity opinion be obtained?

In a validity opinion, UKIPO will only consider issues of novelty and inventive step, based on prior art not previously sufficiently considered. Issues of added subject matter, sufficiency and non-patentable inventions will not be considered.

#### Will the request and opinion be confidential?

No. The request will be published, as will the opinion. If you want to obtain an opinion on any patent issue but do not want that opinion to be published, we can help you, either by providing an opinion for you ourselves, or by enlisting the help of a barrister.

#### Can we challenge an adverse opinion?

Only the patent holder has the right to apply for a review of the opinion. If the patent holder applies for a review, any person has the right to file observations on the issues in the case.

After a review, the patent holder has a limited right of appeal to the UK Patents Court.

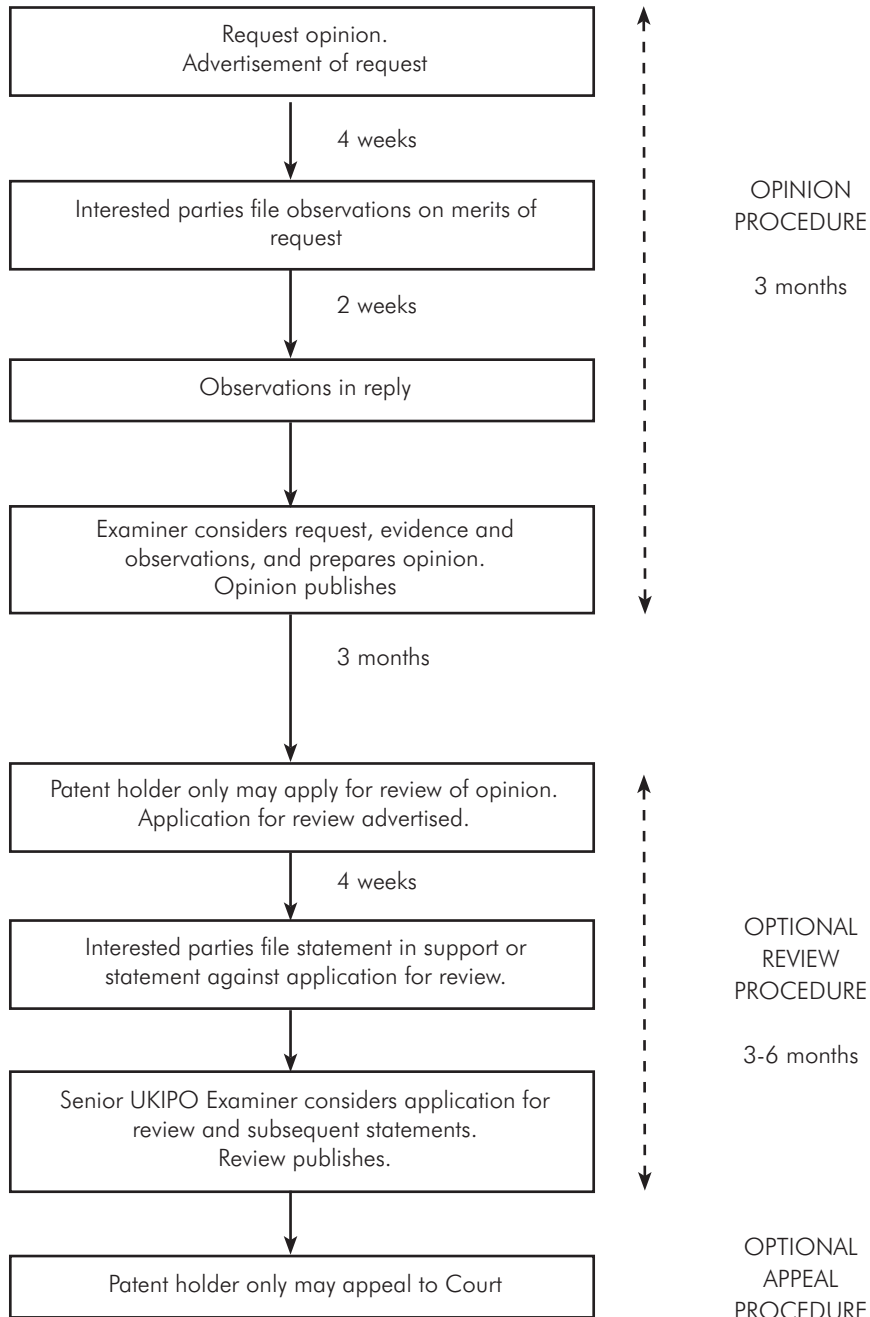
The only options for third parties to challenge the substance of an opinion, or of a review, involve contentious proceedings, e.g. an application for a declaration of non-infringement or an application for revocation.

#### What is the effect of the opinion?

The UKIPO opinions are non-binding. In any subsequent litigation, no party is bound by the statements made during the opinion procedure, or by the opinion itself. UK patent litigation is much more detailed and thorough than a UKIPO opinion, and so it is possible that the outcome of such litigation would be different to the UKIPO opinion.

#### What is the cost?

The official fee for requesting an opinion from the UKIPO is low - around £200. However, there are costs associated with putting together the documents for requesting the opinion, and monitoring the procedure. Costs will vary significantly depending on the complexity of the issues. Get in touch with your regular Mewburn contact for more information.



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