

Using the UK National Route

Dr Gareth Probert

FICPI ABC Meeting

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FICPI-UK

The British Association of The International
Federation of Intellectual Property Attorneys

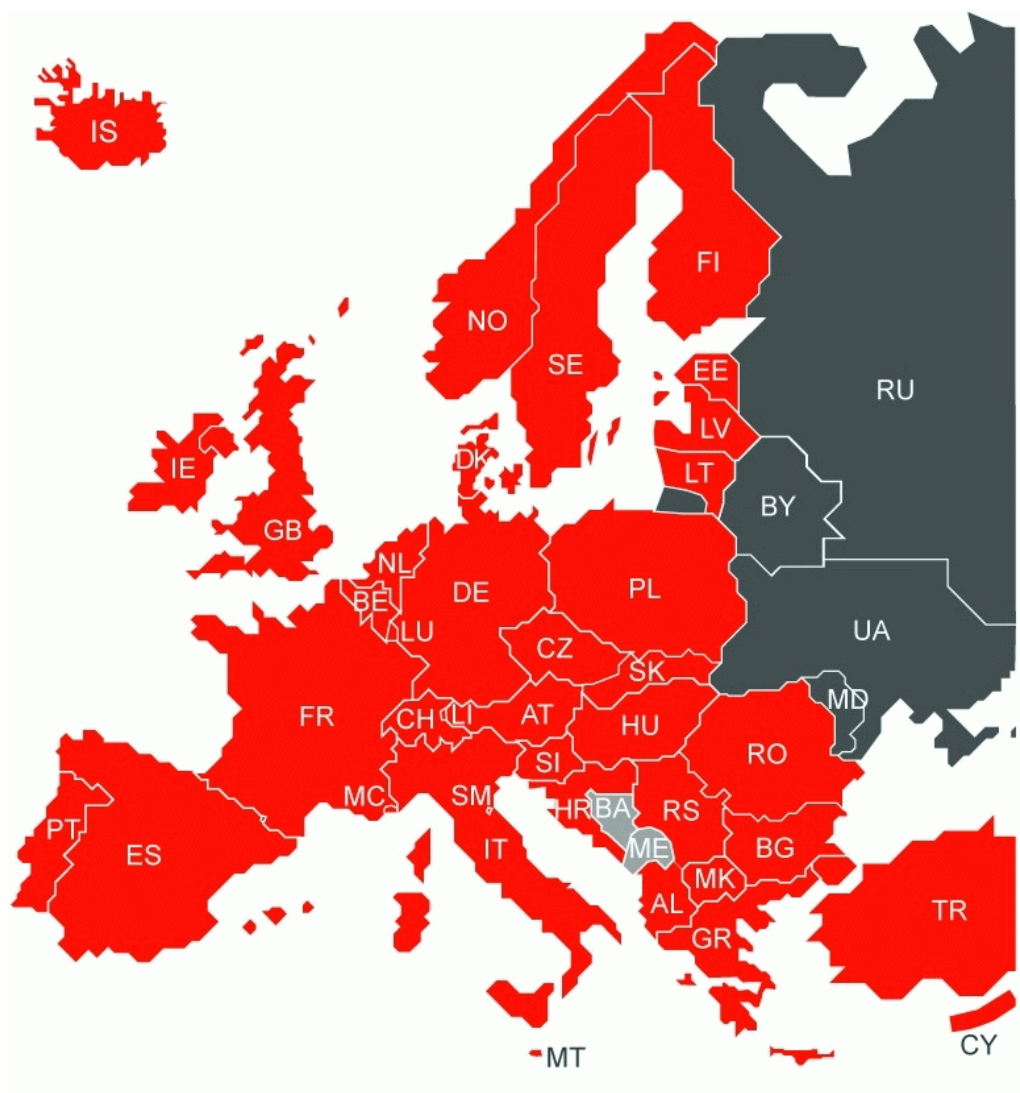
Overview

- The Unitary Patent and the UK
- Benefits of the UK IPO
- Tax Savings in the Patent Box
- Patents County Court

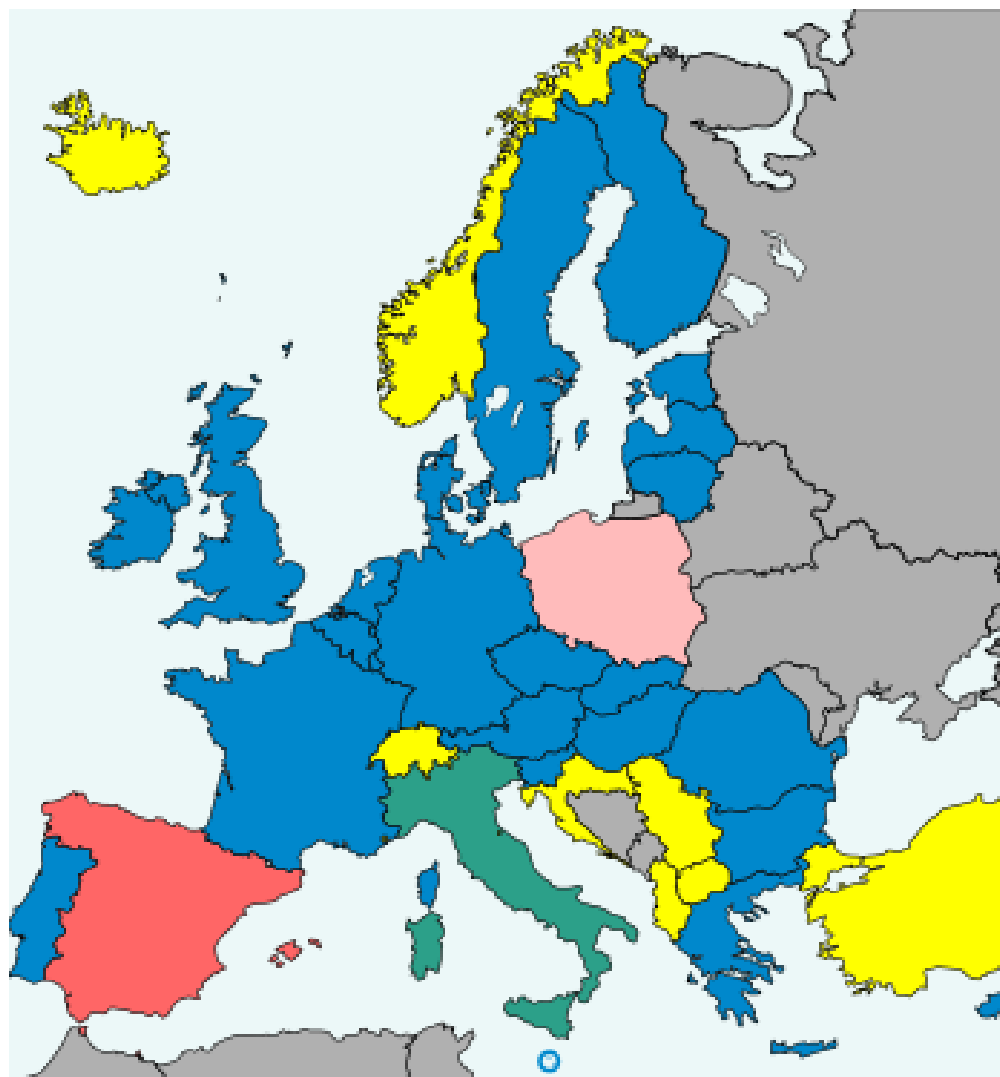
Unitary Patent - Summary

- Single right covering most European countries
- Enforced for all states in single action
- Challenged for all states in single action
- Single renewal fee
- Unitary Court will have exclusive jurisdiction over existing European patents and SPCs

European Patent Office



Unitary Patent System



Unitary Patent and the UK

Key Questions

- Opt out of UPC
- When?
- Is there a fee?
- Can I opt back in?

Unitary Patent and the UK

- Consider filing nationally in UK & elsewhere
- Do you need all the EPO/EU countries?
- 70% of EU GDP in 5 countries – UK, DE, FR, ES, IT
- National filing / PCT route
- Typical costs (including renewal fees)

UK IPO

- Several options for fast prosecution:
 - Accelerated Search and/or Examination
 - Green channel
 - Combined search and examination
 - Patent Prosecution Highway
 - US, CA, JP, KR, DE
 - Fast track for PCT (UK) applications

UK IPO

- Normal procedure - 3 – 4 years
- Fast prosecution - 9 – 12 months
- Proposed “superfast” procedure:
 - Claiming priority - 90 days
 - No priority claim - 120 days

UK IPO

- More sensible attitude to Added Matter
- Examiners want to grant patents
- Omnibus claims are allowable
- Inventive step without the problem/solution approach
- No Opposition procedure

UK IPO

Bolar Provision

- Current exemption from infringement for tests to obtain data to support applications for the approval of generic pharmaceutical products
- Narrow compared with some countries

UK IPO will soon broaden the exemption to cover:

- Innovative drugs as well as generic drugs
- “health technology assessments” (e.g. devices)

UK IPO

Post-Grant Opinions Service

- UK IPO will provide an Opinion on questions of validity (novelty and inventive step) and infringement
- Small official fee
- Complete within 12 weeks
- Popular with users and the Courts

- Will be expanded to include other grounds of invalidity
- UK IPO will have power to revoke patents

Patent Box

- New tax regime introduced in April 2013
- Lower Corporation Tax on company profits
- Tax reduced gradually from 2013
- From April 2017 Corporation Tax will be 10%
- Not simple to use Patent Box;
 - but could provide large tax savings

Patent Box

Requirements to benefit from system:

- A qualifying patent
 - any EPO patent
 - a national patent in certain countries
 - UK
 - AT, BG, CZ, DK, EE, FI, DE, HU, PL, RO, SK or SE
- UK company must:
 - own or exclusively licence the patent
 - be involved in development of the patented invention or the product or process incorporating the invention

Patent Box

- Qualifying Income
 - selling or licensing patent rights
 - damages from patent infringement
 - selling patented products
 - income from use of patented process
 - income from services reliant on patented tool
- Product needs at least one patented component
- Component must be “integral” to product

Patents County Court

- Fast, cheap forum
- Good (departing) judge
- Patents, designs, trade marks, passing off, copyright, database right
- Small claims track (<£5k)

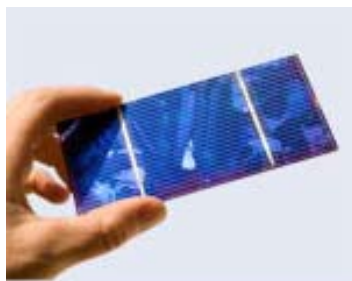
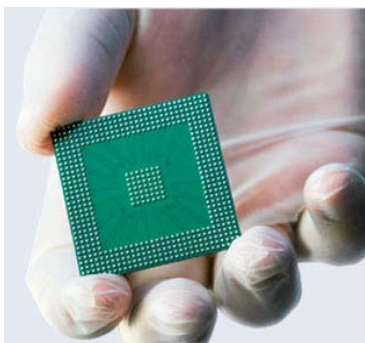
Patents County Court

- Certainty on costs
 - Specific caps for each stage of the trial
 - Overall £50k maximum for the trial
 - £25k maximum for inquiry into damages/profits
- Certainty on damages
 - £500k maximum

Patents County Court

- Judgments well-received
- Proactive case management
- Streamlined procedure
- Hearings should be no more than 2 days
- Patent Attorneys have rights of audience

Any Questions?





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Dr Gareth Probert

Potter Clarkson LLP

The Belgrave Centre

Talbot Street

Nottingham, NG1 5GG

United Kingdom

T: +44 (0)115 955 2211

F: +44 (0)115 955 2201

E: gareth.probert@potterclarkson.com

www.potterclarkson.com

