



**MEETING THE FUTURE:**

**CONSULTATION ON PROPOSED CHANGES IN  
PATENT PRACTICE AND PROCEDURE**

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# Summary

## Introduction

1. This consultation paper sets out proposals for radical change in the Patent Office's practice in handling certain aspects of the search and examination of patent applications. The reason for these proposals is to make the search and examination process more efficient, and hence to enable the Office to provide its customers with high quality searches and examinations more promptly.

## Purpose of the consultation and who is being consulted

2. This consultation is aimed at stimulating an open debate on these aspects of Patent Office practice and procedure, to invite other ideas, and to enable decisions to be taken on whether to proceed with these or other proposals in full knowledge of users' views. Responses will be welcome from anyone interested in the operation of the patent system in the United Kingdom, but especially from those who have been, are, or expect to be users of the system. Copies of this consultation document have been sent to the individuals and organisations listed in Annex A. Further copies may be obtained from the Patent Office by contacting Eileen Tottle, tel 01633 814558, e-mail [eileen.tottle@patent.gov.uk](mailto:eileen.tottle@patent.gov.uk). An electronic version of this document is available on the Patent Office web site at [www.patent.gov.uk/about/consultations/index.htm](http://www.patent.gov.uk/about/consultations/index.htm)

3. This consultation document has been prepared in accordance with the Government Code of Practice on Written Consultations. The Code criteria are set out in Annex B.

## Summary of proposals

4. The main proposals contained in this consultation document are:
1. Truncated examination
  2. Abbreviated examination
  3. Requiring the filing of search and examination reports on corresponding cases
  4. Ceasing amendment of the description
  5. Disallowing omnibus claims
  6. Encouraging a compact style of consistory clause
  7. Reducing the Rule 34 period

8. Ceasing reframing abstracts
9. Making greater use of IPE reports produced under the PCT
10. Developing a code of practice between examiners and agents
11. Using fiscal incentives

### **How and when to respond**

5. Please send your responses by **1 November 2001** to -

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If you are responding on behalf of a representative group, please give a summary of the people and organisations that you represent.

6. If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Co-ordinator, whose details are included in Annex B.

### **Openness**

7. This is part of a public consultation exercise. As such, your responses may also be made public unless you make clear in responding that you want them to remain confidential.

## Background

8. Patent offices around the world are under strain. There are too few examiners to deal with rising numbers of patent applications, and the consequences for the timely delivery to users of patent searches and granted rights is obvious. On a global scale, this must point to an obligation on patent offices to work towards increased co-operation with a view to reducing duplication of effort and moving in due course towards mutual recognition of search and grant. Such work is already under way, for example:

- C in discussions on revision of the Patent Cooperation Treaty (PCT) under the World Intellectual Property Organisation;
- C within Europe, where in discussions on the Community Patent the role of national offices is under discussion.

9. The UK Patent Office is at the forefront of those which regard this work as being of the utmost importance if the patent system is to be relevant and useful to those who seek to use it. For that reason, we are also engaged in bilateral discussions with the Japanese Patent Office and the Australian Patent Office to explore the extent to which we can progress towards mutual recognition, and in discussing co-operation with the Danish Patent Office.

10. However, we need not only to look at the medium-term international solution; we must also consider the short-term domestic one. The input of patent work to this office has been rising steadily over a number of years. We have been recruiting very large numbers of new examiners and investing heavily in their training, but much of that investment is lost because many leave, especially to the profession, once they are trained. We have responded by taking a radical look at our examiner training, for example moving initial training off-site by using a course developed and delivered jointly with Manchester University. And we have introduced a better pay structure.

11. We have over the years also improved our search and examination processes and efficiency. But the mismatch between demand and our examiner capacity requires us to consider more radical approaches if we are to deliver examinations, and more especially searches, as promptly as users need them.

12. One of the areas we are reviewing for possible radical changes concerns our current search and examination practice. Naturally, we are anxious to have an

open and vigorous debate with our users on the merits and impact of our proposals. Since the measures proposed here relate primarily to the way we deal with patent applications filed by patent agents, we are especially concerned to hear the profession's views. Proposals to enable us to deal more effectively and efficiently with private applicant cases are being developed separately.

13. The proposals are outlined below. Some are firm suggestions for a particular line of action while others seek views on less developed ideas. We do not believe they will compromise the quality of the searches or examinations that we issue, nor the high presumption of validity of the patents that we grant. The aim is to maintain our high quality, but to do so more efficiently through effective collaboration with the profession. The obvious benefit to applicants and the profession would be that the Office would be better able to provide quick and efficient search, examination and grant of patents.

# The Proposals

## *Proposal 1. Truncated Examination*

14. The proposal is to allow applicants a limited number of opportunities to amend following a section 18(3) examination report. We have in mind allowing two opportunities. If satisfactory amendments or arguments are not received within two actions, the application would be refused subject to a hearing. We believe there is no bar to the introduction of such a system under the present Patents Act and Rules provided a hearing is offered when it is proposed to refuse the application.

15. The aim is to prevent prosecution of applications generating repeated amendment actions, as sometimes happens at present. We estimate that 12% of examiner time is spent processing all the amendment actions resulting from section 18(3) reports. The proposed system is intended to have the beneficial effect of encouraging applicants to ensure specifications are well researched and drafted, and of encouraging examiners to object only to defects affecting validity. This should provide gains in efficiency.

16. We do not know the level of hearings that is likely to be generated, other than what is suggested by experience in other jurisdictions. In the Japanese Patent Office, for example, two opportunities are allowed to amend; 20% of refusals are appealed and the applicant succeeds in 60% of cases. If the effect of the proposal were merely to transfer amendment work into hearings work, there would clearly be no increase in efficiency - probably the reverse. However, what the proposal seeks to achieve is a change of attitude and culture, where the purpose of the examination process is seen to be the efficient grant of valid rights in whose achievement the professional representative is relied on to play a full part. The Office would therefore hope to rely on effective co-operation with agents to maximise this gain so that we did not simply replace time spent on amendment actions with time spent on hearings. A hearing fee might be introduced, set at a level to serve as a disincentive to indiscriminate requests for hearings but without hindering access to justice.

## *Proposal 2. Abbreviated Examination*

17. This proposal would involve examiners issuing an abbreviated examination

report, addressing only clear novelty and/or plurality objections raised in the search, as the first action under section 18. (A similar procedure is envisaged if a critical International Preliminary Examination (IPE) report exists on a PCT case entering the national phase - see paragraph 42 below.) The intention would be to secure major clarifying or limiting amendments, or possibly abandonment, without a full examination. This could be a quick administrative action by standard letter, probably before the normal examination is due. It could require very little input from the examiner other than identifying suitable cases, the work being done in the Office largely by administrative staff. A top-up search would not be done at this stage.

18. Different detailed procedures are possible. Our current preference is that the report could issue shortly after the Form 10/77 is filed. It could alternatively be issued at an earlier stage together with the Search Report, and require the applicant to file amendments when and if Form 10/77 were filed. The case of *Rohde and Schwarz's Application* [1980] RPC 155 approved the practice of raising objections under section 18 prior to filing of Form 10/77 so it appears the Office would have the *vires* for this procedure. Any other convenient time up until examination is due could also be chosen. The procedure would need to take into account the effect the first section 18 report has of triggering the right to amend, and in some cases the Rule 34 period. Cases would need to be fed out relatively slowly when the procedure was first introduced to avoid a sudden flood of work for agents and examiners.

19. The proposal could be adopted with or without truncated examination. If both were introduced together, abbreviated examination could provide the first of the two opportunities to amend. If an applicant had already amended voluntarily in response to the search report, they would not have used up either of their two full opportunities to amend following a section 18 report.

20. We estimate that 12% of cases examined might be withdrawn as a result of the abbreviated report for substantially no examiner input, saving say 3% of patent processing time. (Currently 20% of cases are withdrawn or refused during examination.) Cases returning on amendment would generally involve less work too, saving perhaps another 3% of patent processing time.

21. We do not believe this proposal for abbreviated examination will affect the quality of the patents granted. Rather, it shifts the work involved in patent examination to a point where it is more appropriately done by enabling serious objections to be dealt with earlier and in a more efficient procedure. We are not

aware of any bar to the Office introducing such a system under the present Act and Rules.

***Proposal 3. Requiring the filing of search and examination reports on corresponding cases***

22. We do not currently require applicants to provide the results of searches and examinations done on corresponding applications by other offices. The US Patent Office has very demanding requirements which are onerous and time-consuming to meet, and arguably disproportionate to the benefit they give. However, there may be benefit in requiring the applicant to notify the Office before grant of search or examination reports it has received from other offices, and this is what we propose. It could be helpful to the examiner to have this information available, and may also help spread best practice between patent offices, and improve the presumption of validity in different jurisdictions. We are open-minded as to the sanction which might be applied in the event of non-compliance. It is worth noting in this context that under changes to the European Patent Convention agreed at a Diplomatic Conference in November 2000, Article 124 of the Convention will enable the European Patent Office to invite the applicant to provide information on prior art found in equivalent applications, the sanction for failing to reply in due time being that the application is deemed withdrawn.

***Proposal 4. Ceasing amendment of the description***

23. This proposal is to disallow amendment of the description during prosecution of an application. Amendments would be allowed only to the claims. The idea parallels an embryonic suggestion put forward by the European Patent Office. Their reasoning is that the scope of a patent is determined by the claims, and the description is drawn on only if additional aid to interpretation is necessary. Consequently, it is not essential to amend the description during examination proceedings and specifications would then usually contain the description as filed. A change in UK practice could conveniently be synchronised with the European Patent Office move.

24. A possible alternative would be for the Office not to require amendment, rather than disallow it. Of the two, disallowing amendment seems preferable as it would provide a consistent basis for the interpretation of claims following its introduction, and would provide the maximum processing gain.

25. Patents with unamended descriptions under this scheme would require a different approach to claim construction. Significant discrepancies and contradictions could arise between the description and the claims, which would otherwise have been resolved during examination. The scope of claims is often shifted during examination so that the claims no longer agree with introductory statements in the description, or so that they exclude some of the embodiments. The description would have to be treated as an historical part of the document which was present in the original application, rather than as necessarily providing an explanation of the invention as finally claimed. Interpretation of claims would have to take any inconsistencies into account.

26. The change would save time at each examination and amendment stage since some objections would not be raised in the first place, and the checking that is currently necessary for added subject matter and consistency in amendments would be avoided. Examiners would still object in some cases to discrepancies between the claims and the description, where amendment to the claim might be called for. Perhaps a quarter of the time spent on each examination and amendment would be saved, a higher percentage of first “in order” reports might issue under section 18(4) and some amendment stages might be eliminated. This could amount to an overall saving in patent processing time of say 7%.

27. One view of such a change is that residual ambiguities and inconsistencies would create real problems in claim construction to the detriment of all affected by the patent system. Another view might be that such a system would tend to constrain applicants to claims which correspond more closely than at present to the invention that was originally presented in the specification. Given appropriate drafting of the original specification, claims could be limited in the light of prior art without risk of introducing inconsistency, but amendments which had the effect of shifting the scope of claims laterally would tend to introduce inconsistency and might consequently become less attractive to the applicant. This might be considered a positive outcome arguably fairer to third parties.

28. The provisions in the Act concerning pre-grant and post-grant amendment would need to be reviewed, as would section 125(1) on the scope of protection.

### ***Proposal 5. Disallowing Omnibus Claims***

29. We propose that a measure be introduced to disallow the use of omnibus claims. They appear to be of only very limited value to the patentee and can

generate otherwise unnecessary amendment stages, for example where claims overlap in parent and divisional applications. Also, as most descriptions contain generalising statements, omnibus claims are conventionally deemed to require a consistency clause consistent with the main claims, so the presence of an omnibus claim contributes to the need to include and amend consistency clauses. Disallowing them would reduce the amount of work and the number of amendments examiners would have to action. Perhaps 1% of patent processing time might be saved.

30. We note that other jurisdictions and offices, notably the European Patent Office, do not allow omnibus claims. Prohibition here could be effected by introducing a rule comparable to rule 29(6) of the European Patent Convention. The measure would further harmonise UK law and practice with that of the Convention.

31. While the lost protection seems to be minuscule, there are a number of precedent cases (listed in the *CIPA Guide* at paragraph 14.26 for example) where the omnibus claim alone was found valid and infringed. Applicants may object to the change for this reason, but with the measure in place, professionals would be relieved of the responsibility to their client to include omnibus claims by way of insurance.

#### ***Proposal 6. Encouraging a compact style of consistency clause***

32. The proposal is to encourage use of a compact formula such as “According to the present invention there is provided a method and apparatus as claimed in the independent claims” in place of the usual style which repeats the wording of the claims. This would save time and in some cases whole amendment actions aligning consistency clauses with the claims since clauses of this type would automatically remain consistent with them. The time saved might amount to 1% of patent processing time if the new formula were followed on all applications. We can see no drawbacks to this practice, which some agents already follow, and it would save both agents’ and examiners’ time.

33. If consistency clauses served no useful purpose in a particular specification they could be omitted altogether. This might increasingly be the case if omnibus claims were discontinued.

34. This development would probably be dealt with as a matter of good practice rather than an objectionable defect, and would be a candidate for the code of

practice discussed below.

### ***Proposal 7. Reducing the Rule 34 Period***

35. The current rule 34 period imposes a deadline in getting an application into order which provides a strong incentive to limit the number of amendment actions. In many cases there is just one year from the issue of the first section 18(3) report to put the application in order.

36. What we propose is that the rule 34 period should be triggered in all cases from the issue of the first examination report, so that whenever that report issues there is just one year in which to put the case in order. Some amendment actions that would otherwise take place might then be omitted by examiners and agents focussing more closely on the action needed.

37. Combined Search and Examination cases (CSEs) could be dealt with in a similar way making an appropriate allowance for section 16 publication to take place and to ensure sufficient time was allowed for a top-up search to be carried out.

38. This proposal would require a change in the Patents Rules.

### ***Proposal 8. Ceasing reframing abstracts***

39. The Office might eliminate the time spent reframing abstracts by accepting the abstract filed by the applicant in all cases; alternatively, that time might be limited by amending the abstract only where absolutely necessary.

40. Although many of the abstracts provided by applicants are satisfactory, there is little advantage to them in tailoring the abstract to be an effective search tool. The examiner is ideally placed at the time of doing the search to do this, and can often add real value, highlighting the important matters and including details omitted by the applicant. However, the increasing use of computer searching, with databases which include abstracts from a number of other sources, means that it may no longer be critical for the UK Office to produce refined abstracts for the benefit of third parties. The Office does however currently use them as a primary tool in searching its own paper files.

41. Section 14(7) of the Act is permissive and this reduction in intervention could apparently be introduced simply as a matter of practice in the Office within the existing Act and Rules.

***Proposal 9. Making greater use of IPE reports produced under the PCT***

42. PCT cases entering the national phase may carry an International Preliminary Examination (IPE) report. This report may suggest that the application is open to major objections, or it may indicate the view that it is ready for grant, subject to any necessary top-up search. We propose that in the latter case, no further examination should be undertaken, but that a report under section 18(4) should issue immediately. In the former case, we would expect agents to offer the view they take of the IPE report in advance of substantive examination, failing which an abbreviated examination report would issue, along the lines already proposed in paragraph 17 above. If this approach was not felt appropriate, for example in areas where objections under section 1(2) are common, an alternative proposal would be that cases with no objections on the IPE report could immediately undergo a top-up search and full examination, while cases with objections on the IPE report are treated as above.

***Proposal 10. Developing a Code of Practice between Examiners and Agents***

43. There are many practices adopted by agents in the prosecution of patent applications which save examiners time and work, and others which have the opposite effect. No doubt agents could also identify helpful practices by examiners. We propose setting up a joint working party of examiners and agents to draw up a code of best practice. This might usefully be a function of the Focus Group we have now set up. The code of practice could be publicised through the *Patents and Designs Journal*, on the Patent Office website and by the Chartered Institute of Patent Agents. It might cover the following among other things:

C Statements of claim are occasionally extremely complex, with many different independent claims covering slightly different aspects of the same invention and other variations covering different inventions. The complexity and proliferation of claims is sometimes much greater than is genuinely needed to secure appropriate protection. This often happens when an agent files a specification on behalf of an overseas applicant. The Office would like to discourage this practice and to discuss ways of dealing

with any that continue to be filed, such as by an “amendment before search” action.

- C The practice of filing manuscript amended pages in addition to retyped pages is very useful, and to be encouraged.
- C The Office would wish to encourage applicants to file amendments following the issue of the search report as this often significantly reduces the amount of work needed in section 18 examination and follow-up actions.
- C The practice of filing divisionals with the same claims as the parent leads to unnecessary and wholly nugatory work as the examiner is obliged by section 17(5) to search the first invention. This results in the original search being reissued and the “real” search only being carried out subsequently. Alternatively examiners may arrange with the applicant for amendment prior to the search in order to address the invention that is really intended. There is no advantage in filing such claims as an insurance against refusal of the earlier filing date, as was once the case, and the Office would like to discourage it as wasteful of applicants’ money and agents’ and examiners’ time.
- C It is relatively common for agents to request extensions to the reply period for examination reports, which creates work in issuing a letter with the new deadline. Beginning work on the case earlier in the 6 month period might reduce the need for extensions. Where extensions are requested, this could conveniently be done by e-mail.
- C If an agent is aware that an applicant has lost interest in an application, it would be good practice to withdraw it straight away. Comments from examiners suggest that this is not always done at present.
- C Similarly, divisionals could be filed as soon as the need for them is identified. Many seem to appear very late in the life of the parent application. It may be useful to discuss any genuine constraints which cause late filings.
- C As discussed above, the use of compact style consistory clauses would save time for both agents and examiners during prosecution.

### *Proposal 11. Using fiscal incentives*

44. Conventionally, fees have been set primarily to recoup overall costs, and also, as is widely appreciated, to facilitate access to the system by subsidising new applications through the requirement for successful patentees to pay renewal fees. Lower fees are sometimes required of SMEs in other countries but this has not been a course previously followed in the UK. Many other patent offices also use fees additionally to encourage desirable patterns of behaviour in their applicants. In particular, extra fees are charged for lengthy specifications and complex claims. Generally also other patent offices have higher application fees than we do, which may discourage speculative applications. The Japanese Patent Office applies higher fees for paper filings than for electronic filings; other jurisdictions charge fees for amendment actions after the first; and so on.

45. It would not be unreasonable to consider, as part of the “meeting the future” initiative, whether we should introduce fiscal incentives as a way of encouraging appropriate filing and prosecution behaviours. After all, it might be possible to argue that if all applications were limited to a manageable description and a short set of claims, a significant amount of time might be saved on a proportion of cases. We have mentioned fees for hearings earlier. Other possibilities might include fees for large numbers of claims, or of independent claims, and pages of description.

46. However, the Office is committed to undertaking a comprehensive review of its fees policy. In the light of that, it would be premature to make specific proposals in this consultation paper.

## ANNEX A

1. Copies of this consultation document have been sent in the first instance to:

(a) Members of a Focus Group established to assist the Patents Directorate in meeting the future, the external members of which are:

Guy Selby-Lowndes (Moonrakers)  
Luc Vandamme (Dow Corning)  
Graham Jones (Graham Jones & Co)  
Richard Gallafent (Gallafent & Co)  
John Dean (Withers & Rogers)  
Sue Ruck (Small Business Service)  
Martin Ridge (DTI Innovation Policy)  
Andrew Serjeant (Serjeants)  
Dr A J Rollins (Nycomed Amersham)  
Anne Willcocks (DTI Competition & Markets)

(b) Member organisations of the former Standing Advisory Committee on Industrial Property (SACIP), which are:

The Law Society  
The Law Society of Scotland  
The Bar Council  
The Institute of Patentees and Inventors  
Trade Marks, Patents and Designs Federation  
Confederation of British Industry  
University of London, Queen Mary and Westfield College  
British Retail Consortium  
Incorporated Society of British Advertisers  
Chartered Society of Designers  
Chartered Institute of Patent Agents  
Institute of Trade Mark Attorneys  
Association of British Chambers of Commerce  
Consumer's Association  
National Consumers Council  
Federation of Small Businesses  
Licensing Executives Society

(c) Organisations which formerly received SACIP papers, namely:

International Federation of Industrial Property Attorneys  
International Chambers of Commerce  
Association of the British Pharmaceutical Industry  
Intellectual Property Institute  
London Chamber of Commerce and Industry  
Institute of Practitioners in Advertising  
Anti-Counterfeiting Group  
Intellectual Property Lawyers Association  
British Brands Group  
Patent and Trade Mark Group, Institute of Information Scientists  
The Patent Judges  
The Intellectual Property Sub-Committee of the City of London Law Society  
British Pharma Group  
The British Agrochemicals Association Limited  
British Generics Manufacturers Association

## General Principles of Consultation

1. This consultation is being conducted according to the Code of Practice on Written Consultation issued by the Cabinet Office<sup>1</sup>. This recommends the following criteria:

1. Timing of consultation should be built into the planning process for a policy or service from the start, so that it has the best prospect of improving the proposals concerned, and so that sufficient time is left for it at each stage.
2. It should be clear who is being consulted, about what questions, in what timescale, and for what purpose.
3. A consultation document should be as simple and concise as possible. It should include a summary, in two pages at most, of the main questions it seeks views on. It should make it as easy as possible for readers to respond, make contact or complain.
4. Documents should be made widely available, with the fullest use of electronic means (though not to the exclusion of others), and effectively drawn to the attention of all interested groups and individuals.
5. Sufficient time should be allowed for considered responses from all groups with an interest. Twelve weeks should be the standard minimum period for consultation.
6. Responses should be carefully and open-mindedly analysed, and the results made widely available, with an account of the views expressed, and reasons for decisions finally taken.
7. Departments should monitor and evaluate consultations, designating a consultation co-ordinator who will ensure the lessons are disseminated.

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<sup>1</sup> Available from the Cabinet Office website at:  
<http://www.cabinet-office.gov.uk/servicefirst/2000/consult/code/consultationcode.htm>

## **Comments about the consultation process**

2. If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Co-ordinator, who is -

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NP10 8QQ

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