



BOULT WADE TENNANT

European Patent and Trade Mark Attorneys,
Chartered Patent Attorneys and Chartered Trade Mark Attorneys

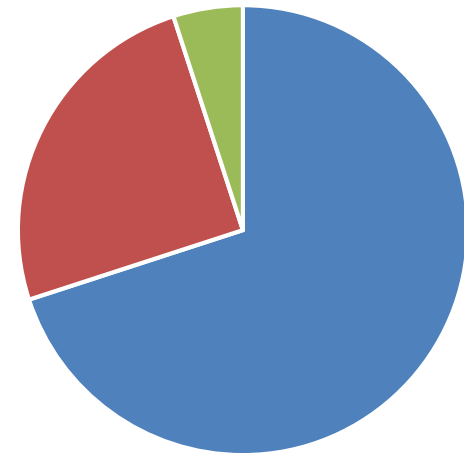
UKIPO Opinions Service

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Validity of a UK or EP(UK) Patent Opinion Requests 2015-2019

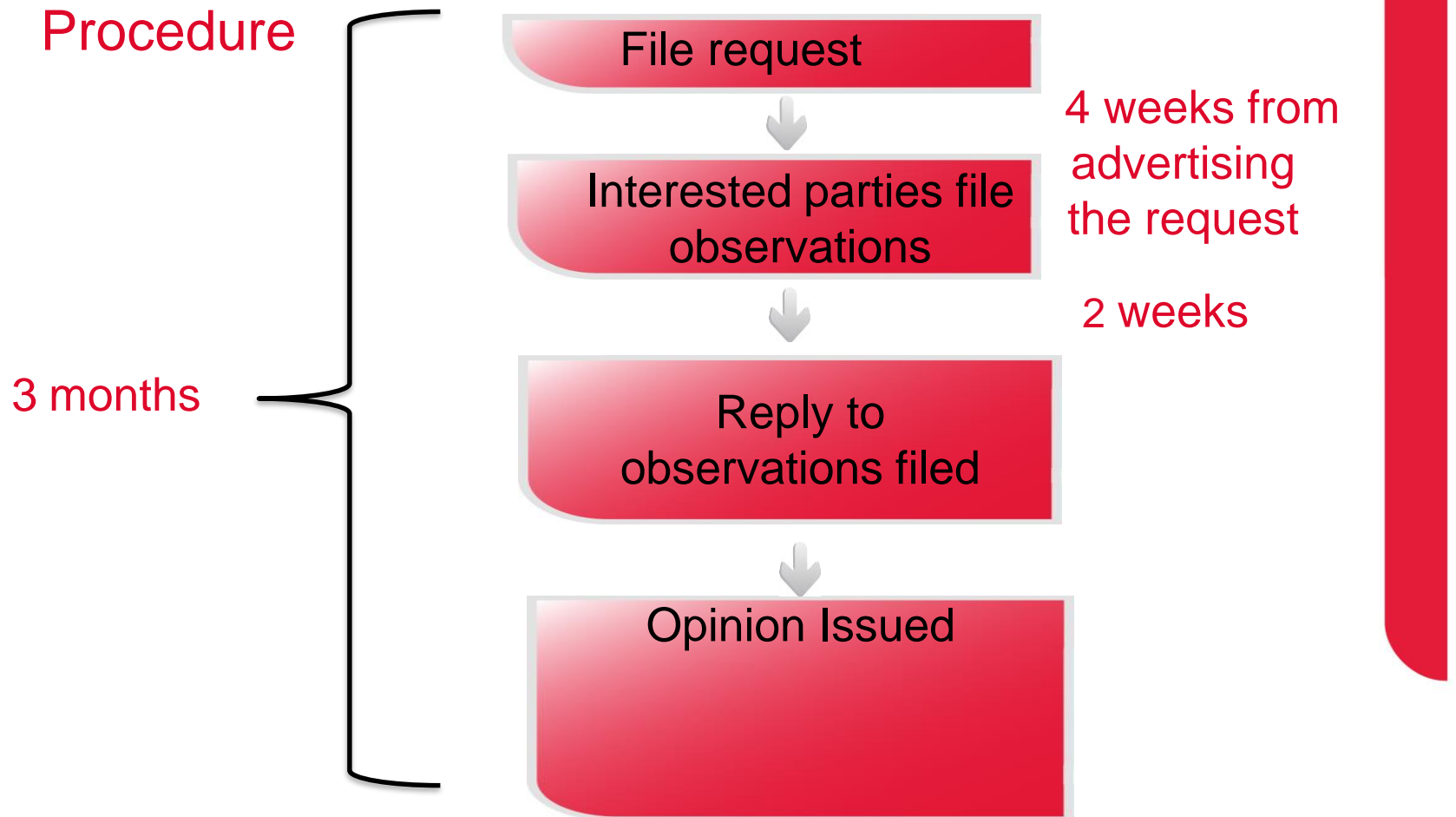
- Novelty
- Inventive Step
- Sufficiency
- Added Matter
- Extension of the Scope of Protection
- Excluded Subject Matter



■ Validity ■ Infringement ■ Both

Validity of an SPC

Infringement of a UK or EP(UK) Patent or SPC



Filing Requirements

- Patents Form 17
- Fee of £200
- Disclosure of known, relevant UK or EP(UK) proceedings
- Two copies of a written statement of grounds and two copies of each document cited therein

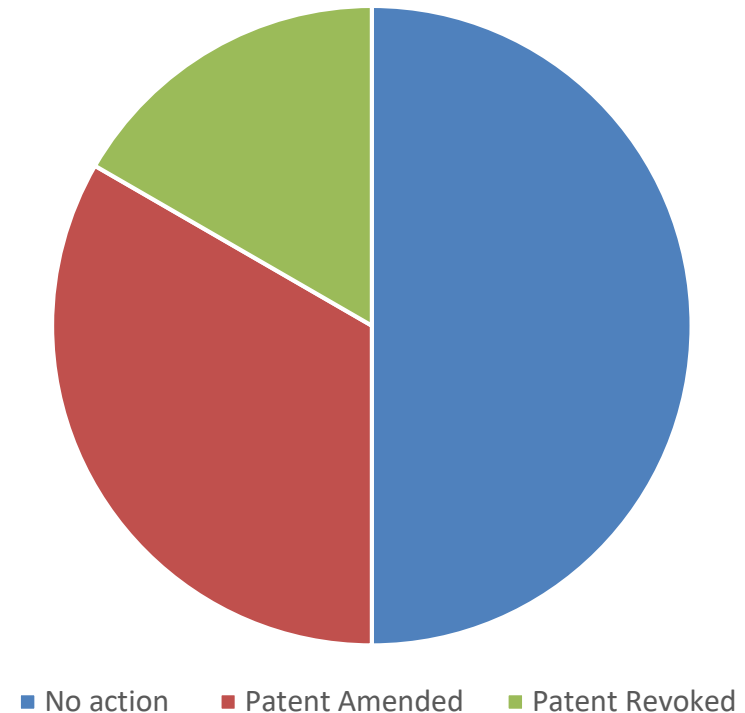
Refusal of a Request

- If the request relates to matters other than those set out in Rule 93(6) of the UK Patents Act
- If the request is frivolous
- If the request relates to an issue which has already been sufficiently considered in any relevant proceedings
- If the request repeats arguments already presented
- If there is insufficient information

Revocation of a Patent by the UKIPO

- The UKIPO has the power to revoke a UK or EP(UK) patent of its own initiative if an opinion finds the patent to lack novelty and inventive step
- Such a revocation should only occur in “clear-cut” cases

Negative Validity Opinion



Strategy for the competitor/infringer

Pros

- Cheaper than court proceedings or an EPO opposition
- An opinion can be requested outside the opposition window

Cons

- The opinion is non-binding
- The patent is unlikely to be revoked



Strategy for the patentee

Pros

- An infringement opinion may be helpful for negotiations with an infringer and cheaper than court proceedings
- A validity opinion might be helpful to dismiss newly cited prior art raised in negotiations

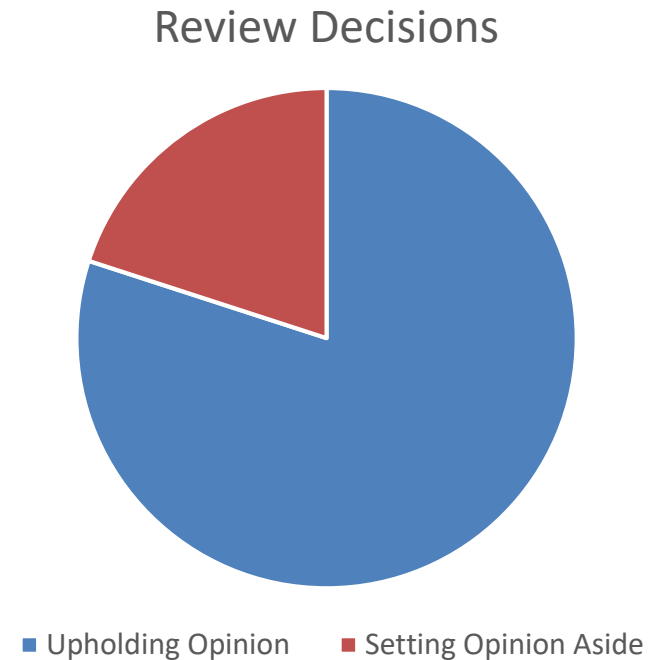
Cons

- Significant unexpected costs
- Potential for US IDS complications
- An opinion request on validity may lead to revocation of your patent, although this is unlikely
- Limited time to respond and you do not get to have the last word



Challenging an Opinion

- Request a review of the opinion
- Launch Separate Legal Proceedings either in the courts or at the UKIPO



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