

UNITED KINGDOM

219. Section 21 of the Patents Act 1977 provides that, where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations. Such other person cannot become a party to any proceedings under the Act before the ~~comptroller~~~~controller~~. In other words, apart from the receipt of acknowledgement (see below), he has no right to discuss the matter directly with an examiner or request a notification about the decision taken by the examiner. The observations can be submitted anonymously. No fee is required for the submission of observations.

220. Rule 33 of the Patents Rules 2007 provides detailed procedures regarding third party observations. The ~~comptroller~~~~controller~~ must send to the applicant a copy of the observations on patentability, unless they disparage any person in a way likely to damage such person or are generally expected to encourage offensive, immoral or anti-social behavior. The ~~comptroller~~~~controller~~ may, if necessary, send to the applicant a copy of any document referred to in the observations. It is recommended that any observations be filed within three months after the application has been published, as a patent may be granted after that period.¹⁶⁶ The observations must be made in writing, and can be filed on paper or electronically. They shall be supported by evidence wherever possible.

221. The Office will acknowledge receipt of the submitted observations if contact information of the submitter is available. Where observations were made before the grant of the patent, an examiner will take them into account when deciding upon the patentability of the invention concerned. The observations will be added to the official file, which is available to the public, and a copy of the observations will be sent to the applicant. Even if the observations are received after the grant of the patent, they will be placed in the patent file, and a copy of the observations will be sent to the patentee.

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260. While the United Kingdom provides no opposition system, it is possible for anyone to request revocation of a patent under Section 72 of the Patent Act 1977. Upon request of any person, the Comptroller may, by order, revoke a patent for an invention on any of the following grounds: (i) the invention is not a patentable invention; (ii) the patent was granted to a person who was not the only person entitled; (iii) the specification of the patent does not disclose the invention clearly and completely enough for it to be performed by a person skilled in the art; (iv) the matter disclosed in the specification of the patent extends beyond the original patent application as filed; and (v) the protection conferred by the patent has been extended by an amendment which should not have been allowed.

261. The quasi-judicial inter partes proceedings, which are conducted by a senior official, are very similar to post-grant opposition proceedings, but without any time limit for commencement.¹⁹⁵ The applicant has to make a written statement and the patentee is given the possibility to file a counterstatement. The Comptroller might revoke patents ex officio. The request can be made during the life time of the patent. According to Section 72(5), the decision of the Comptroller on the request for revocation has no estoppel effect. The revocation has an ex tunc effect.¹⁹⁶

###. Separately, the comptroller has the power to initiate revocation proceedings on his own initiative, in certain limited circumstances. These are set out in section 73 of the Patents Act 1977. First, he can start revocation proceedings if it appears that the patent lacks novelty by virtue of the disclosure in a patent application which has an earlier priority date but which was published after the priority date of the granted patent in question. Second, he can start revocation proceedings if it appears there is a granted European Patent (UK) for the same invention and held by the same patent proprietor. And third, he can start revocation proceedings where a non-binding statutory opinion on the validity of the patent has been requested and issued (see section 74A of the Patents Act 1977), and that opinion takes the view that the patent lacks novelty or inventive step. The comptroller has said that he will only exercise this last power in "clear cut" cases. In all scenarios, the patent proprietor has the

chance to make observations and arguments, and also to amend the patent. An oral hearing is also available before the comptroller makes a final decision on patent revocation.

VII. INTERFACE BETWEEN THE DIFFERENT MECHANISMS

A. RECENT REFORMS OF NATIONAL SYSTEMS

262. The national and regional opposition systems have seen many changes in recent years. Some of those changes in national legislation are further described below.

[...]

###. The Intellectual Property Act 2014 amended the Patents Act 1977 to widen the comptroller's powers to issue non-binding opinions, on request, in relation to questions of patent validity and infringement. The comptroller can now issue opinions on all aspects of patent validity including excluded matter and sufficiency. The IP Act 2014 also introduced the comptroller's ability to initiate patent revocation following a non-binding opinion which finds a lack of novelty or inventive step – see para ### above.”