

## **Comments from UK on the topics proposed for discussion at the 2009 WIPO SCP meeting**

1. At a meeting of the Standing Committee on Patents in June 2008 the Committee endorsed a proposal from the chair that the following topics would be discussed at the next meeting in 2008 –

- a. Dissemination of patent information, including the issue of a database on search and examination reports;
- b. Exceptions from patentable subject matter and limitations to the rights, including research exemption and compulsory licences;
- c. Patents and technical standards;
- d. Client – attorney privilege.

The Secretariat invited delegations to submit comments on these items for inclusion in one or more working documents for the next meeting.

2. The UK's comments on each of these topics are set out in the attached Annexes A, B, C and D,

## Annex A

### Dissemination of patent information: the position in the UK

#### Introduction

1. This annex sets out a brief discussion of the position in the UK regarding the dissemination of patent information. Unless otherwise stated, the references to legal provisions are to the Patents Act 1977 (as amended)<sup>1</sup>.

#### Statutory publication

2. As in many other countries, the contents of a patent application and related documentation are generally not made public until the patent application is published under the statutory regime.

3. In the UK, this statutory publication takes place around 18 months after the filing or priority date of the application in question, under section 16.

#### Disclosure of information in an unpublished application

4. Before statutory publication, information in relation to an application may be disclosed in a number of different but limited circumstances. These circumstances are set out in section 118. In summary -

- where the applicant has explicitly consented to it, the contents of the unpublished application and information relating to it may be disclosed by the Intellectual Property Office;
- certain prescribed bibliographic information relating to the unpublished application may be disclosed as soon as the application is filed. This information includes the applicant's name, the title of the invention, the date of filing, the priority date (if any), the priority application number and country (if any), and the withdrawal, termination, assignment or licensing of the unpublished application;
- an unpublished application may be inspected by other parts of government in order to determine whether that application contains information which is prejudicial to national security or public safety;
- where a third party is put on notice by the patent applicant that an application has been made and that the applicant will, if the patent is granted, sue the third party for infringement, the third party is entitled to request inspection of

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<sup>1</sup> See <http://www.ipa.gov.uk/patentsact1977.pdf>

the application and any related documents, despite the fact that it has not been published;

- the Intellectual Property Office is required to send to the EPO any information which it is under a duty to send in accordance with the provisions of the EPC.

### Exemptions from publication

5. Some exemptions apply so that certain information is not part of a published application. In other words, when an application is published, certain material can be withheld. These exemptions concern -

- material which is prepared by the Intellectual Property Office for internal use only, material which (in the Intellectual Property Office's opinion) disparages a person in a way likely to damage him, and material which (in the Intellectual Property Office's opinion) would generally be expected to encourage offensive, immoral or anti-social behaviour;
- requests by inventors (but not patent applicants) to keep their names and addresses confidential. Reasons are needed for the name to be withheld but an address can simply be withheld on request;
- requests made within 14 days of a particular document being filed for the document or a part of it be kept confidential. Anyone (but usually the sender) may make such a request. The Intellectual Property Office has discretion to decide whether to accede to such requests and requires good reasons to be given. Usually, the reasons concern commercially sensitive information which it has been necessary to supply in order to support, for example, a request for an extension of time or for accelerated processing.

### Sharing and dissemination of patent information

6. The UK is involved in a number of initiatives which concern the sharing and dissemination of patent information.

7. Examiners routinely request applicants to disclose any search reports on published foreign equivalent applications. This is a non-statutory request – there is no sanction if the applicant does not comply. Nevertheless, applicants tend to do so on the understanding that it improves the quality of any patent granted.

8. The UK is committed to the WIPO Digital Access Service. This will allow patent applicants to request that their applications be made available via a database for priority purposes. Participating offices will be able to access the database to obtain copies of priority documents, thus eliminating the need for the applicant to file a paper copy.

9. The Intellectual Property Office is currently working on changes to its electronic filing systems so that, where the Intellectual Property Office is the Office of first filing, applicants may request that their applications are submitted to the database. This request will amount to the consent which UK law requires (see

above) to make an unpublished application available. Changes to our electronic filing systems are also needed so that, where the Intellectual Property Office is an Office of second filing, an applicant can request that a copy of a priority document is sourced from the database. UK legislation already allows for this, because it waives the requirement for an applicant to supply a document where it is made available to the Office via some other means (e.g. available via the internet without payment or via a service such as the DAS).

10. The Intellectual Property Office is involved in work-sharing initiatives on a number of fronts, which involve the exchange or dissemination of patent information. For example, the Utilisation Pilot Project with the EPO involves sending UK search reports and citation information to the EPO for consideration on equivalent EP applications. The UK also has Patent Prosecution Highways in operation with the USPTO and the JPO. Where a UK examiner has determined that a UK application is in order for grant, the applicant in question can draw this to the attention of the relevant USPTO or JPO examiner who is working on the equivalent application – also making available copies of relevant examination reports and correspondence. Processing may then be expedited. Similarly, processing will be expedited in the UK if the applicant supplies the relevant information on a US or JP equivalent application which has been found to be in order for grant.

11. These work-sharing arrangements have produced benefits to the Offices involved and to the applicants in cases where they have been used. It is worth noting that the timescales involved mean that, at least so far, the general bar on sharing or disclosing information on unpublished UK applications has not prevented effective work-sharing. The information exchanged has either been published already or has been obtained directly from the applicant.

#### Electronic access to patent information

12. The UK Office makes patent information available electronically in a number of ways -

- The Patent Register and other information concerning the status of granted patents (including up-to-date information on any renewal fee payments) is available via the Intellectual Property Office's website – see <http://www.ipo.gov.uk/patent/p-find/p-find-number.htm> ;
- The Patents Journal is published on the Intellectual Property Office's website and lists on a weekly basis key events relating to patents and applications. It lists new applications, applications published, patents granted, patents on which proceedings have commenced, patents on which amendment or correction has been requested or agreed to, and patent assignments and licences registered. The Journal is provided in a searchable, database format – see <http://www.ipo.gov.uk/patent/p-journal/p-pj> and also is downloadable in a PDF format containing selected information of choice – see <http://www.ipo.gov.uk/patent/p-journal/p-pj-download.htm> ;
- Anyone may make a request via the Intellectual Property Office's website to be sent an uncertified electronic copy of the published contents of a patent

application or patent file, or selected parts of it. This costs £5. The requested content is emailed to the requester (or sent on CD). See <http://www.ipo.gov.uk/patent/p-applying/p-apply/p-apply-online/p-apply-online-uk-filingsystem/p-apply-online-uk-uncertified.htm>

## Annex B

### Exceptions from patentable subject matter and limitations of rights: the position in the UK

#### Introduction

1. This annex outlines the position in the UK regarding exceptions from patentability and the limitations placed on patent rights. Unless otherwise stated, the references to legal provisions are to the Patents Act 1977 (as amended)<sup>2</sup>.

#### Excluded subject matter

2. Section 1(2) lists “inventions” which cannot be patented. The list corresponds to, although is not identically worded to, that provided in Article 52(2) EPC 2000.

3. Excluded are:

- (a) a discovery, scientific theory or mathematical method;
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
- (d) the presentation of information.

4. These things are excluded only to the extent that the patent or application in question relates to them “as such”. The list is not exhaustive and the courts have suggested<sup>3</sup> that there could indeed be inventions (for example, a method of controlling traffic flow) which are excluded solely on that basis, and not because they fall into one of the defined exclusions.

5. There has been much case-law over the years seeking to clarify and codify the extent of the specific exclusions and the scope and effect of the “as such” proviso. Much of it has developed at the same time as in other jurisdictions which have very similar provisions, although the outcomes and approaches are not always the same.

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<sup>2</sup> See <http://www.ipo.gov.uk/patentsact1977.pdf>

<sup>3</sup> *Lux Traffic Controls Ltd v Pike Signals Ltd and Faronwise Ltd* [1993] RPC 107

6. The approach used by the Intellectual Property Office to determine whether an invention is excluded was introduced by the UK Court of Appeal<sup>4</sup> and it comprises four steps:

- (1) properly construe the claim;
- (2) identify the actual contribution (or, in the case of a patent application, the alleged contribution);
- (3) ask whether it falls solely within the excluded subject matter;
- (4) check whether the actual or alleged contribution is actually technical in nature.

The Court of Appeal viewed this four step test as being consistent with previous binding case-law which focussed directly on looking for a “technical contribution”.

#### Matter contrary to public policy or morality

7. Section 1(3) applies a separate exclusion to an invention the commercial exploitation of which would be contrary to public policy or morality. More specifically, implementing the EC directive on the legal protection of biotechnological inventions<sup>5</sup> involved setting out a specific list of inventions which are excluded. The list is found in Schedule A2 to the Act, and states that the following are not patentable inventions:

- (a) the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene;
- (b) processes for cloning human beings;
- (c) processes for modifying the germ line genetic identity of human beings;
- (d) uses of human embryos for industrial or commercial purposes;
- (e) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes;
- (f) any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro-biological or other technical process or the product of such a process.

This list is non-exclusive and other inventions may be excluded under the general provision of section 1(3). Also something is not regarded as contrary to morality simply because it is prohibited by law.

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<sup>4</sup> *Aerotel Ltd v Telco Holdings Ltd & Ors Rev 1* [2007] RPC 7

<sup>5</sup> Directive 98/44/EC

8. By way of an example, in 2003 the UK clarified its practice in relation to inventions involving human embryonic stem cells. Since it is clear from the Act that uses of human embryos for industrial or commercial purposes are not patentable inventions, the Intellectual Property Office will not grant patents for processes of obtaining stem cells from human embryos. Furthermore, human totipotent cells (which have the potential to develop into an entire human body) are also not regarded as patentable because the human body at the various stages of its formation and development is excluded from patentability (see above).

9. However, human embryonic pluripotent stem cells arise from further division of totipotent cells and do not have the potential to develop into an entire human body. Although there is some opposition in the UK to research involving embryonic stem cells, such research is tightly-regulated and legal, and a number of reports from influential UK political, medical and scientific bodies in recent years have emphasised the enormous potential of stem cell research, including embryonic stem cell research, to deliver new treatments for a wide range of serious diseases. This indicated that on balance the commercial exploitation of inventions concerning human embryonic pluripotent stem cells would not be contrary to public policy or morality in the UK. Thus the Office does not regard inventions involving such cells as being excluded under section 1(3).

#### Methods of treatment or diagnosis

10. A further exclusion from patentability is set out in section 4A. This states that a method of treatment of the human or animal body by surgery or therapy, or a method of diagnosis practised on the human or animal body, is not patentable. This exclusion does not extend to a novel and inventive substance or composition for use in any such method – which may legitimately be protected.

#### Compulsory licensing

11. Two distinct compulsory licensing regimes are available in the UK.

12. The first regime is a general one which applies to all patents which have been granted for more than three years, and is set out in sections 48 to 52. Generally speaking, a compulsory licence is available where demand for a patented product is not being met in the UK on reasonable terms. Other situations concern circumstances where the proprietor has refused to grant a licence on reasonable terms or has imposed conditions on such licences, so that the use of other products or patented inventions flowing from the patent in question is unfairly prejudiced or hindered, or the establishment or development of commercial or industrial activities in the UK is unfairly prejudiced. However, the detailed provisions depend on some particular conditions being met and also vary depending on whether the proprietor of the patent in question is a “WTO proprietor”<sup>6</sup> or not.

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<sup>6</sup> A “WTO proprietor” is one who is a national of, or is domiciled in, a WTO country, or who has a real and effective commercial or industrial establishment in a WTO country.

13. The second regime is a specific one which applies only to patents which relate to the manufacture of pharmaceutical products. A recent EC Regulation<sup>7</sup> provides for the availability of a compulsory licence for anyone who wishes to make a specific patented pharmaceutical product solely in order to export it to a developing country with a particular public health problem. The Regulation sets out a number of proceedings which may take place as part of the procedures involved – for example proceedings to apply for, modify or revoke such a licence. Specific provisions in UK law implement this regime insofar as patents in force in the UK are concerned.

14. The compulsory licensing regimes are very rarely used in the UK. Only a small number of applications for a compulsory licence under the general regime have ever been made in the UK, and none have yet been received under the specific regime concerning the compulsory licensing of patents relating to the manufacture of pharmaceutical products.

#### Exemptions from infringement

15. Section 60(5) sets out that various acts are not an infringement of a patent in force in the UK. These include an act:

- (a) done privately and for non-commercial purposes
- (b) done for experimental purposes relating to the invention
- (c) of preparing extemporaneously in a pharmacy a medicine for an individual in accordance with a prescription.

16. In relation to (b), the UK courts<sup>8</sup> have said that the absence of any reference to “non-commercial” experimental work indicates that experimental purposes with a commercial end in view may still be exempt from infringement. For example, trials carried out in order to discover something unknown or to test a hypothesis or to find out whether something which is known to work in specific conditions will work in different conditions can fairly be regarded as experiments which are exempt. But trials carried out in order to demonstrate to a third party that a product works, or works as its maker claims, (for example in order to obtain information to satisfy a third party regulating the safety of such products) are not acts done “for experimental purposes” (but see so-called “Bolar” exemption below)

17. The UK is currently consulting users<sup>9</sup> on this research exemption, with a view to seeking evidence on the effect of the exemption, whether it is in need of clarification and whether it hinders legitimate research.

18. Other exemptions relate to certain specific acts in connection with ships, aircraft or other vehicles which have accidentally or temporarily entered the UK, its waters or its airspace.

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<sup>7</sup> Regulation (EC) No. 816/2006 published 9 June 2006

<sup>8</sup> *Monsanto Co v Stauffer Chemical Co and another* [1985] RPC 515

<sup>9</sup> <http://www.ipso.gov.uk/consult-patresearch.pdf>

19. A further class of exempted acts relate to the use by a farmer of the product of his harvest for propagation by him on his own farm, and the use of an animal or animal reproductive material by a farmer following the sale to him of breeding stock or that material.

20. And a final class of exemptions relate to clinical trials on patented medicinal products (the so-called “Bolar” exemption<sup>10</sup>). This exempts from patent infringement any studies, tests or trials on generic medicines required to show that the generic product is bioequivalent to an approved patented product where these acts are required to obtain marketing authorisation.

21. Finally, case-law<sup>11</sup> has confirmed that repair of a patented product does not amount to making that product, and so genuine repair does not amount to an infringing act. That said, it is not necessarily easy to determine when repair ends and making the product begins. The case in question centred around mesh screen assemblies used in vibratory sifting or filtering machines, comprising two tensioned filter meshes bound to a frame. The alleged ‘repair’ of the screen involved stripping the frame, re-coating with adhesive and applying new meshes, followed by tensioning and heating to cure the adhesive. This process was found to be equivalent to purchasing the frames on the open market and then using them to produce a mesh screen assembly, and thus constituted an infringing act.

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<sup>10</sup> See article 13 paragraph 6 of Directive 2001/82/EC on veterinary medicinal products and article 10 paragraph 5 of Directive 2001/83/EC on medicinal products for human use.

<sup>11</sup> *United Wire Ltd v Screen Repair Services (Scotland) Ltd* [2001] RPC 24

## Annex C

### Patents and technical standards: the position in the UK

1. There are no specific provisions in UK patent law relating to technical standards. However, general provisions such as compulsory licensing are available in certain circumstances (see Annex C).

2. Nevertheless, the courts in the UK will consider making a negative declaration whether one or more particular patents are essential to a technical standard<sup>12</sup>. In a recent case<sup>13</sup> Nokia sought a declaration that the manufacture and sale of 3G mobile telephones would not infringe key patents which were regarded by European Telecommunications Standard Institute as essential to the European 3G Standard. Ultimately the court concluded that the requested declarations would be genuinely useful and granted declarations on the basis of its finding of whether the patents in question were indeed essential to the Standard.

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<sup>12</sup> [2006] EWCA Civ 1618

<sup>13</sup> [2007] EWHC 3077 (Pat)

## Annex D

### Client – attorney privilege: the position in the UK

1. In Europe the position on privileged communications between an applicant for or the owner of a patent, trade mark, design etc is governed by national law. These national provisions on privilege apply regardless of whether the communications are concerned with a European or a national application for a patent, trade mark or design.

2. The relevant provision in UK patent law, as it relates to patent attorneys, is found in section 280 of the Copyright, Designs and Patents Act 1988. This reads:

(1) *This section applies to communications as to any matter relating to the protection of any invention, design, technical information, trade mark, or as to any matter involving passing off.*

(2) *Any such communication -*

*(a) between a person and his patent agent, or*

*(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent,*

*is privileged from disclosure in legal proceedings in England, Wales or Northern Ireland in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.*

(3) *In subsection (2) “patent agent” means -*

*(a) a registered patent agent or a person who is on the European list,*

*(b) a partnership entitled to describe itself as a firm of patent agents or as a firm carrying on the business of a European patent attorney, or*

*(ba) An unincorporated body (other than a partnership) entitled to describe itself as a patent attorney, or*

*(c) a body corporate entitled to describe itself as a patent agent or as a company carrying on the business of a European patent attorney.*

(4) *It is hereby declared that in Scotland the rules of law which confer privilege from disclosure in legal proceedings in respect of communications extend to such communications as are mentioned in this section.*

3. The relevant provision as it relates to trade mark attorneys in UK is found in section 87 of the Trade Marks Act 1994. This reads:

*(1) This section applies to communications as to any matter relating to the protection of any design or trade mark, or as to any matter involving passing off.*

*(2) Any such communication—*

*(a) between a person and his trade mark agent, or*

*(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his trade mark agent,*

*is privileged from, or in Scotland protected against, disclosure in legal proceedings in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his solicitor.*

*(3) In subsection (2) “trade mark agent” means—*

*(a) a registered trade mark agent, or*

*(b) a partnership entitled to describe itself as a firm of registered trade mark agents, or*

*(c) any other unincorporated body or a body corporate entitled to describe itself as a registered trade mark agent.*

4. The effect of the provisions as they relate to patent attorneys and trade mark attorneys is therefore essentially the same except that the range of communications covered is greater for patent attorneys.

5. The intention of these provisions is to ensure that all advice which attorneys are competent to give to their clients is privileged. Thus communications may be privileged in any legal proceedings regardless of whether those proceedings are before the courts or the UK Intellectual Property Office. That also includes communications made as part of the process of applying for protection. In fact, those communications are not restricted to the process of applying for a protection in the UK. Communications in respect of applying for and prosecuting an application in another country, including under the PCT, the Madrid Agreement or the Hague Agreement, may also be privileged insofar as the UK courts are concerned.

6. There is no restriction on where the communication must take place in order for it to be privileged. This means that, under UK law, a communication between a client and his attorney in respect of, for example, patent proceedings in another country is likely to be privileged for the purposes of any UK proceedings, regardless of whether the communication itself took place in the UK or not.

7. As can be seen from the provisions reproduced above, privilege extends to any communication between an attorney and any person, which is for the purpose of

obtaining information, or which is in response to a request for information, if that information is for the purpose of instructing the attorney.

8. The privilege attached to these communications is defined by reference to the general privilege in UK law enjoyed by a client and his solicitor (so-called “legal professional privilege”). This legal professional privilege generally falls into two categories of privileged communication.

9. The first category is privilege as a result of a request for, or the giving of, legal advice. This is relatively broad in nature, but that does not mean that all communications between a client and his legal adviser are necessarily covered – it is necessary for the legal adviser actually to be acting in that capacity and thus being requested to give, or giving, advice.

10. The second category is privilege as a result of actual or contemplated litigation. This covers communications for the purpose of requesting or giving advice in relation to such litigation, and also communications for the purpose of obtaining evidence for such litigation. The actual or contemplated litigation need not be litigation in the UK. Therefore, it is necessary to look at the purpose for which the communication was made, in order to ascertain if the communication is privileged under this category. Provided its dominant purpose was in relation to actual or contemplated litigation, privilege should apply. Finally, if there is contemplated litigation, that contemplation must be genuine and more than just a fear that litigation may happen. (Of course, any advice given by a legal adviser in those circumstances may be privileged under the first category.)

11. It should be noted that attorney privilege in the UK is confined to (UK) registered attorneys and to patent attorneys on the “European list” i.e. the list of European patent attorneys maintained under Article 134 EPC 2000. Although we not aware that the point has not been tested in the UK courts, it would seem at least arguable from the wording of section 280(3) that, insofar as UK proceedings are concerned, European patent attorneys of any nationality enjoy privileged communication with their clients. Advice given by non-registered attorneys will qualify for privilege under separate legal provisions if given by someone qualified to act as a solicitor or barrister.

12. Importantly under UK law the privilege itself is in the control of the client, not the attorney. Therefore, the client may waive that privilege in respect of a particular communication, even though the attorney does not want to. Equally, the client may choose not to waive that privilege, even though the attorney wants to.