

26 April 2011

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STM Submission for the Consultation on Amending the Patents Act to Provide for Online Patent Document Inspection

Introduction

The International Association of Scientific, Technical and Medical Publishers (“STM”) comprises approximately 100 publishers of journals, books and reference works, based in 26 countries including many publisher-members based in the United Kingdom and other Member States of the European Union. EU-based publishers publish 49% of all research articles worldwide (STM’s members originate approximately 2/3 thereof), employing 36,000 staff directly and another 10-20,000 indirectly, and make a €3b contribution to the EU’s balance of trade. STM publishers have actively embraced the opportunities of the digital online environment, starting with journal content and other “native” digital products such as software, data and databases, as well as other digital tools. For more than ten years now, science, technology and medical researchers, along with medical practitioners, have had ubiquitous access to online tools that include published information, links between references in the literature, data sets, software, video content and even three-dimensional illustrations.

As an interested party representing its publisher members, STM is pleased to respond to this Consultation on Amending the Patents Act to Provide for Online Patent Document Inspection.

1. Proposed Exception Would Conflict With Normal Exploitation and Prejudice Published Works

In STM’s view the wording proposed for a new Section 118A to be inserted into the Patents Act 1977, as amended, (the “Patents Act”) may be adequate for some of the “documents” available for inspection under section 118 of the Patents Act, but not for copyright-protected published materials included with any patent application, or placed on file as a result of any patent application procedure.

Subjecting published materials available for purchase on the open market to a wide copyright exception is uncalled for, particularly if, by virtue of such an exception, these published copyright-protected materials may be made available over the Internet for free and may even be downloaded, stored or printed for both commercial and non-commercial purposes world-wide.

In STM’s view such a broad exception would be in conflict with the normal exploitation of the exclusive rights of the rightsholders – the very rights the Berne Convention’s Article 9(2), Article 13 TRIPS and Article 5(5) of the EU Directive 2001/29 seek to protect from over-broad exceptions (the so-called “three-step test”). STM’s publications would be especially hard hit in their core market, as these publications are among the most read and consulted by scientists, companies, researchers and others involved in the cycle of innovation, development, productivity gain and economic growth.

2. Current Patent Act, Patent Rules and Practice Provide Adequate Safeguards

In contrast, the current Section 118 of the Patents Act, read with Rule 48(3)(b) of the Patent Rules, as amended (version April 2010), makes clear that a copy of “documents”, as defined, may not be supplied on application to the comptroller if “making or providing such a copy would infringe copyright”.

This state of the law and practice is also well reflected in the present consultation document, where it is stated, *inter alia*, in paragraph 31 that:

“[...] We will continue our current policy of not making available copies of journals, books or articles which are available elsewhere. Therefore, the only works which will be made available online are ones where it is already possible to inspect them on the file or obtain copies.”

However, the proposed draft section 118A of the Patents Act would apply, on the face of it, to all “documents” referred to in section 118 of the Patents Act, ie it would also include published materials available elsewhere, namely publications offered by STM publishers. In practice, this would mean that STM publishers would have to depend on the current practice being maintained as a matter of policy, rather than law, by the Intellectual Property Office.

In STM’s view, it would be preferable and better in keeping with the law and spirit of copyright to maintain a clear, unambiguous and safe legal basis in the new law that confirms the current sound practice.

3. Draft Statutory Instrument Could Be Narrowed Without Compromising Stated Objectives – Narrower Draft Would Avoid Uncertainty and Potential Unintended Consequences

In STM’s view there may be a number of ways in which to narrow proposed section 118A of the Patents Act in such a way that the section only applies to “documents” the reproduction or supply of which would not constitute a copyright infringement, as provided for by existing legislation and Patent Rules.

One way could be to narrow the definition of “documents” in relation to proposed section 118A of the Patents Act to exclude works made available to the public in print or online. This could be done by specifying that section 118A only refers to “documents other than works made available to the public in print or online”.

4. Conclusion

STM believes that the aims and objectives pursued by the Intellectual Property Office in making documents available for online inspection, could be attained without a need for a copyright exception that would encompass in its present wording harm and prejudice to rightsholders of works already available in print and online.

STM stands ready to co-operate with the Intellectual Property Office to find a solution that allows online consultation of documents, yet remains in keeping with the UK’s traditionally copyright-friendly law and also with the UK’s international and EU obligations regarding copyright-protected works.

Yours faithfully,



Michael Mabe
Chief Executive Officer, STM