



## PATENTS ACT 1977

REQUESTER                      E-link Technology Co. Ltd

ISSUE                          Request under section 74A of the Patents Act 1977  
   for an opinion on patent number GB 2529565 B

HEARING OFFICER              Phil Thorpe

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### DECISION

#### Introduction

- 1 This decision relates to a request for an opinion.
- 2 The request was filed on 26 January 2021 in the name of E-link Technology Co. Ltd. (the requester). The request sought an opinion on whether or not patent GB 2529565 C (the patent) in the name of Hangzhou Chic Intelligent Technology Co. Ltd. would be infringed by disposal or use in the UK or importation into the UK of a product described in the request. The patent and the product relate to self-balancing scooters (colloquially *hoverboards*).
- 3 In a letter dated 5 February 2021 the Office informed the requester that it proposed to refuse the request as it did not raise a *new question*. The letter offered a hearing to the requester in the event that it wished to contest the decision. The letter noted that in the absence of a response, the opinion request would be refused. No such response has been received and the requester has not requested a hearing. I therefore intend to refuse the request but before doing so will briefly set out the reasons for my decision.

#### The law

- 4 Section 74A(3)(b) of the Patents Act provides that in relation to opinions:
  - (3) *The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so-*
    - (a) ...
    - (b) *if for any reason he considers it inappropriate in all the circumstances to do so.*

- 5 The use of this provision to refuse opinion requests has been discussed in several other Office decisions<sup>1</sup>. In particular, those decisions looked at whether or not it was appropriate to issue an opinion if the question at the heart of the request had already been considered during the pre-grant examination of the patent. It was always the intention that the opinion service would not be used to repeat or in some way reappraise the examination of the patent performed either in this Office or at the European Office. Rather, the intention was that there should be something new and the request should not simply seek to go over old ground. The rationale is that a patentee should not be asked to deal again with a question that he has already dealt with to the satisfaction of the Office pre-grant.
- 6 The opinion request here does not relate to validity. Rather it is directed at infringement of the granted patent, so issues about what has been considered pre-grant do not apply. Nevertheless, I consider that the intention that there should be something new still applies, the rationale being that the patentee should not have to deal repeatedly with the same issue whether it be raised pre- or post- grant. In particular for opinions, the patentee should not be required to deal with a new opinion which goes over the same ground covered by a previous opinion.

### **Discussion**

- 7 Opinion 17/20 has previously been issued on this patent. That opinion dealt with whether or not the patent was infringed by a product described in the corresponding request. The opinion considered that the product would not infringe the patent. In particular, the product lacked an inner cover.
- 8 The product described in the new opinion request is very similar to that described in the previous infringement opinion. In particular, the description of the two products is identical, as is the claim chart. Although there are minor differences in the photographs of the products and there is some further detail in the argument, I do not consider that it has any bearing on the matters considered in the previous opinion. The content of the previous opinion appears to apply equally to both products with only inconsequential exceptions. Whilst I acknowledge that there are differences between the products, they do not seem to be material to the issue of infringement. If an opinion were to issue based on this new product, it would be in effect identical to the previously issued opinion.
- 9 Ultimately, in the absence of any material differences between the products, there is no new question to be answered in respect of the infringement of the patent by such a similar product. In these circumstances I do not consider it appropriate for the patentee to have to deal again with an issue that has already been considered in a previous opinion.

### **Conclusion**

- 10 I refuse the request made under Section 74A by E-link Technology Co. Ltd for an opinion on GB 2529565 C.

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<sup>1</sup> See for example Office decisions BL O/370/07, BL O/298/07 and BL O/289/07.

- 11 In accordance with Rule 106(4) I believe that it is appropriate to remit the entire fee paid in this case.

**Appeal**

- 12 Any appeal must be lodged within 28 days after the date of this decision.

**Phil Thorpe**

**Deputy Director acting for the Comptroller**