

D YOUNG & CO **INTELLECTUAL** **PROPERTY**

Attacking UK Patents

Dr C T Harding

Partner, D Young & Co LLP

Honorary Professor of Law, Queen Mary University

(G206219 - ver 8 May 2023)

Topics for today

- Reasons for attacking
- Possible attack routes
- General pros and cons
- EPO Oppositions
- UK actions
- Decisions – binding, persuasive, otherwise
- Additional Strategy considerations

... we have a lot of ground to cover ...

Why attack a UK patent ...

Why attack?

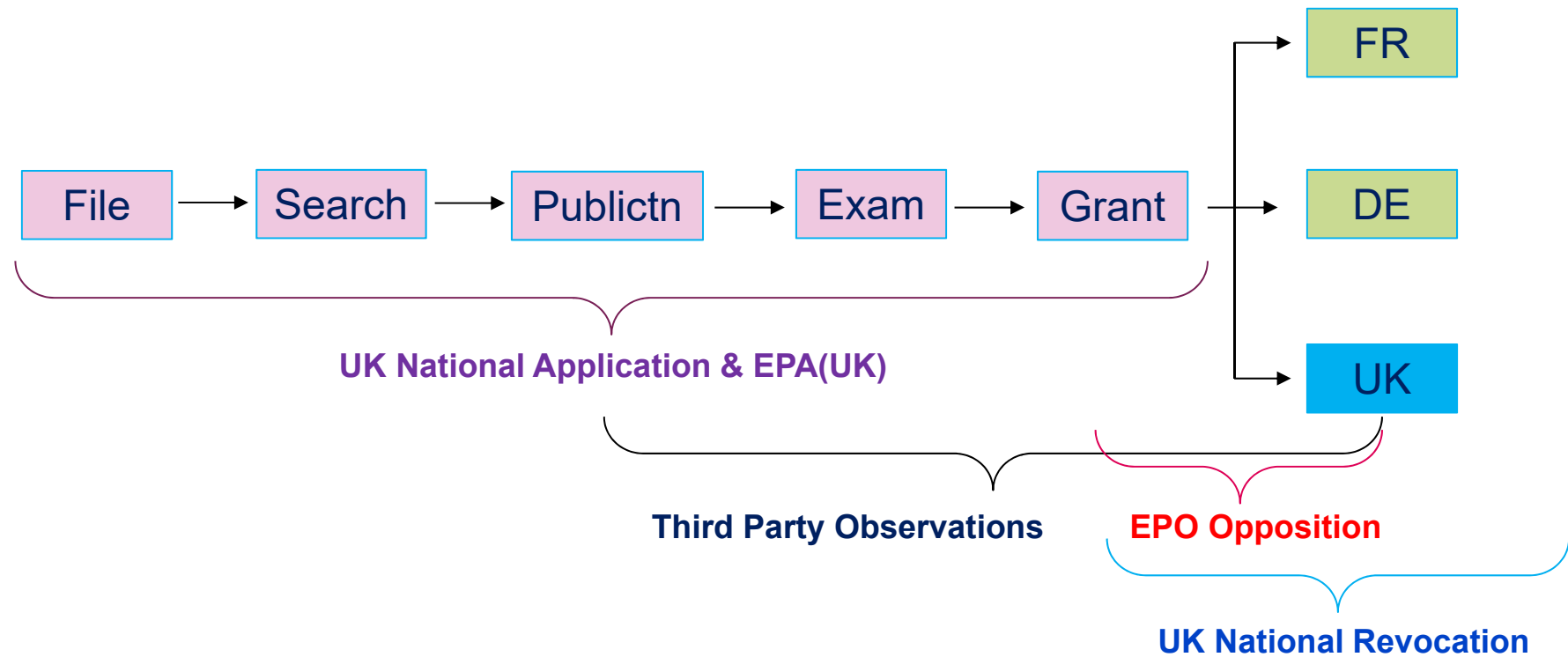
1. Remove a current or potential infringement threat
2. Freedom to operate
 - ❑ Advance clearance of an invalid patent
3. Force narrowing amendments to limit scope away from your client's actual or intended activities
4. PR purposes: seize the initiative – look strong
5. Exert pressure on the patentee
 - ❑ EG You may be in actual or possible negotiation – therefore apply pressure to settle low

Why *not* attack?

1. Draws attention to the client – may provoke an infringement action
2. Why prod the snake?
3. May provoke narrowing amendments towards your client's actual or intended activities
4. May fireproof the patent if unsuccessful
5. Could look bad if you fail

Possible attack routes ...

Essentially – 3 routes to attack a UK patent



The Routes

- 3rd-Party Observations before application grants – both UK national and EPA
- 3rd-Party Observations after grant and whilst EPO opposition proceedings are still on-going
- EPO Oppositions (EPs only)
- UK National Patent Office Opinion, followed by revocation
- UK National revocation action

3rd Party Observations ...

Pre-Grant Attack (IPO, EPO, or WIPO) – “Third Party Observations” (s.21; EPC Art. 115)

- 1) 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, and the comptroller shall consider the observations in accordance with rules.

[NOTE: can be filed in **ANY** EPO proceedings]

- 2) It is hereby declared that a person does not become a party to any proceedings under this Act before the comptroller by reason only that he makes observations under this section.

3rd Party Observations – Pros

1. May delay grant
2. May prevent grant altogether
3. Can raise any objection – in particular lack of clarity and/or lack of support (not available to raise these grounds in an EPO opposition against the granted claims of the opposed EP patent)
4. Can be anonymous – makes a counter-attack less likely
5. Are cheap – no official fee
6. No award of costs

3rd Party Observations – Cons

1. Not a party to the proceedings – no right to be heard
2. No follow-up
3. No right of appeal
4. Applicant can have a hearing or interview without you
5. If unsuccessful, potentially good ammunition may be wasted (e.g. for EPO opposition)
6. Could prompt the applicant to file a divisional application
7. May be giving the applicant a chance to tighten up the pending claim set – thereby making it more difficult to attack if granted

Attacking EP(UK) Patents via EPO Oppositions ...

EPO Oppositions (EPC Part V Art.s 99-105)

By far the most common way now UK patents are attacked.

A European Patent is:

- A single central application *until* grant
- A bundle of national patents *after* grant
- Can be enforced from the day of grant

BUT:

- Central opposition before the EPO is possible for 9 months from grant
 - May result in revocation, or limiting amendment, for all designated EPC States.

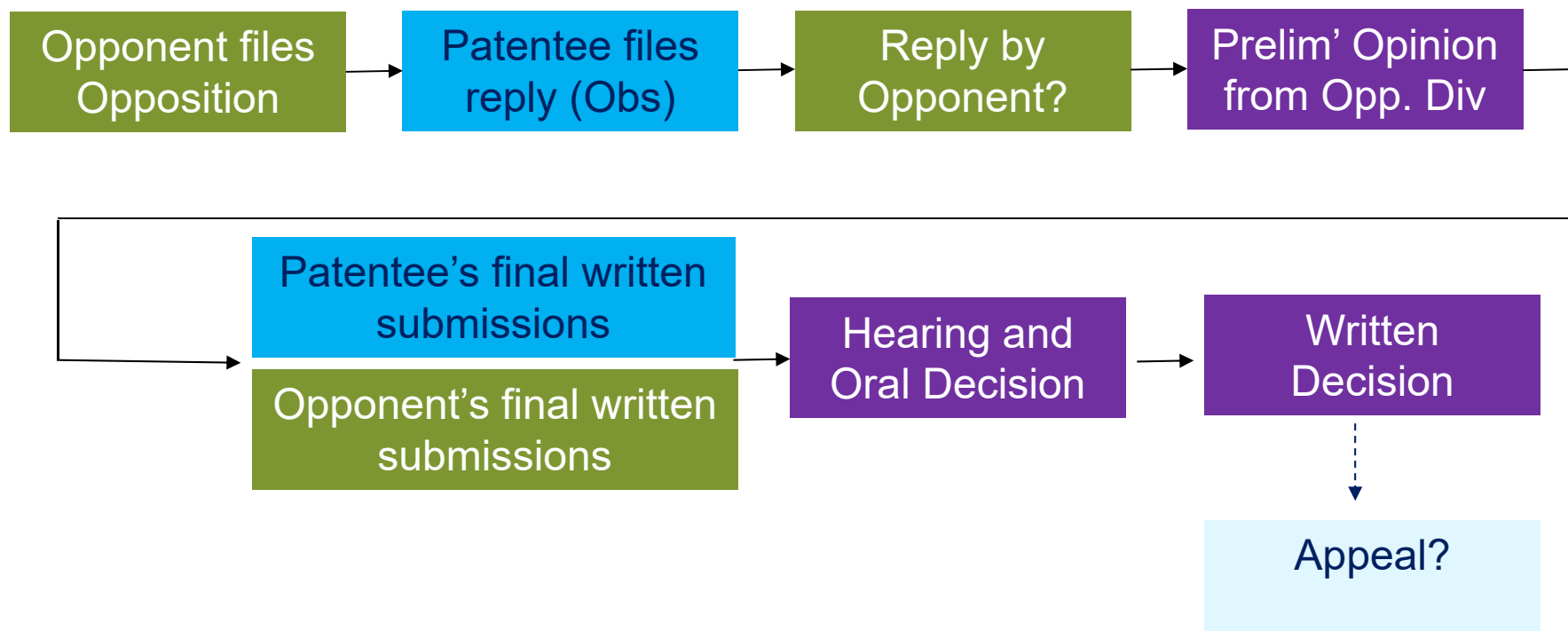
EPO Oppositions – Pros

1. Fairly cheap – opposition fee is less than **€1,000** (about **€850**) and appeal fee is less than **€3,000** (about **€2,785**) - but oppositions and appeals involve significant chargeable attorney time
2. The patent is revoked in all of the designated EPC states for the opposed EP patent
3. Amendments to the granted claims can only limit the claim scope
4. A divisional cannot be filed from the granted patent
5. “Strawman” opponent can be used
6. Opponent has equal procedural rights to be heard at the first instance and on appeal etc.
7. Typically no award of costs

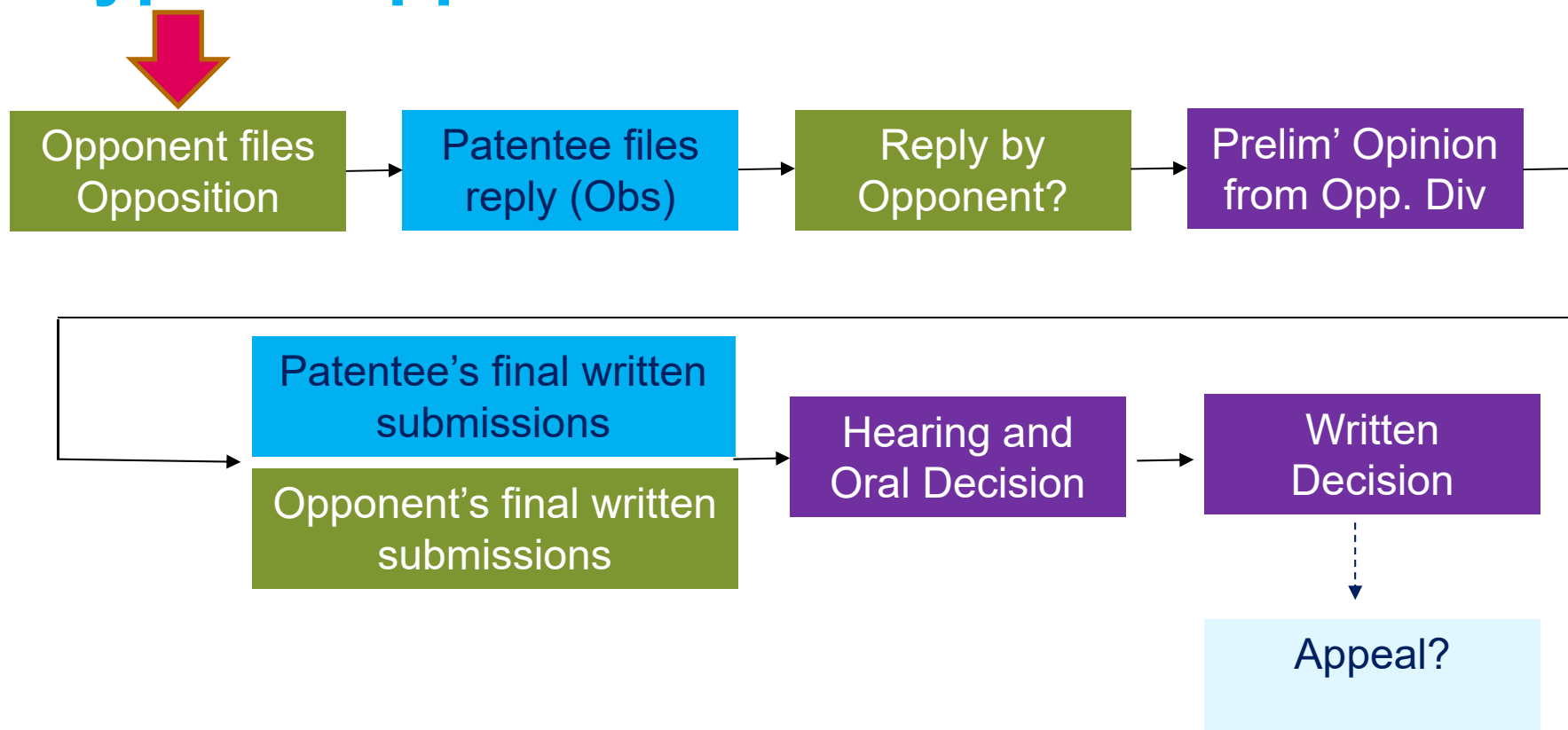
EPO Oppositions – Cons

1. Can be quite slow – usually at least 2 years from grant
2. Then there is the appeal stage – again usually another 2 years
3. Usually original Examiner is involved, so there can be a perception that you may be going uphill

Typical Opposition Time Course



Typical Opposition Time Course



Opposition Statements

Opposition Statement

- Raise all possible grounds (next slides)
- Attack all claims
- Include all documents and data – otherwise anything else may be considered to be impermissibly late filed
- Can file anonymously (straw man)

Grounds of Oppositions – Part 1

1. Added Matter

- a) Can be a very powerful attack
- b) Article 123(2): cannot add new matter after filing
- c) Article 123(3): cannot broaden the scope of the claims after grant
- d) Can be a squeeze between Art 123(2) and Art 123(3)

2. Insufficiency

- a) Can the skilled person (NB: person of ordinary skill in the art) perform the invention across the scope of the claims
- b) Burden on the Opponent to show lack of sufficiency
- c) Very powerful if the claim contains a parameter or (medical) use

Grounds of Oppositions – Part 2

3. Not patentable

i. Lack of novelty

- a) Often includes new prior art not considered in prosecution
- b) Prior use? Difficult attack
- c) Often priority is looked at in more detail (both substantive nature and procedural nature) – may open up more available prior art

ii. Lack of inventive step

- a) Use the EPO's "problem-solution" approach – again, discussed later
- b) Can try to start from a number of different CPAs
- c) Inventive across the scope? Burden is with patentee to show that is it.

iii. Subject-matter is excluded from or is an exception to patentability

Unavailable Grounds of Oppositions

1. Lack of clarity

- a) Unless causes lack of sufficiency?
- b) an amendment made during opposition may be attacked for lack of clarity if it didn't come from a dependent claim

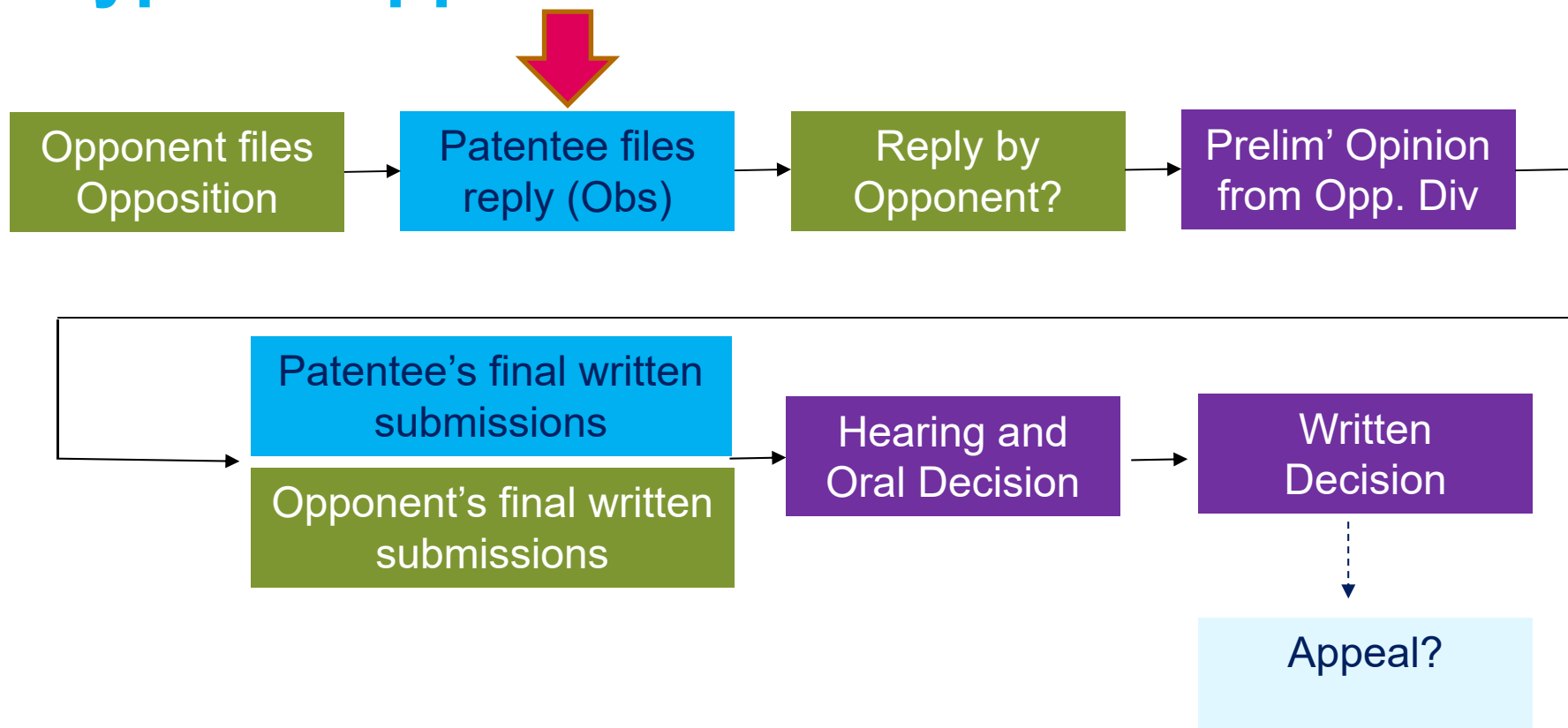
2. Lack of support

- a) Unless causes lack of sufficiency
- b) an amendment made during opposition may be attacked for lack of support if it didn't come from a dependent claim

3. Lack of unity

4. Formal Deficiencies

Typical Opposition Time Course

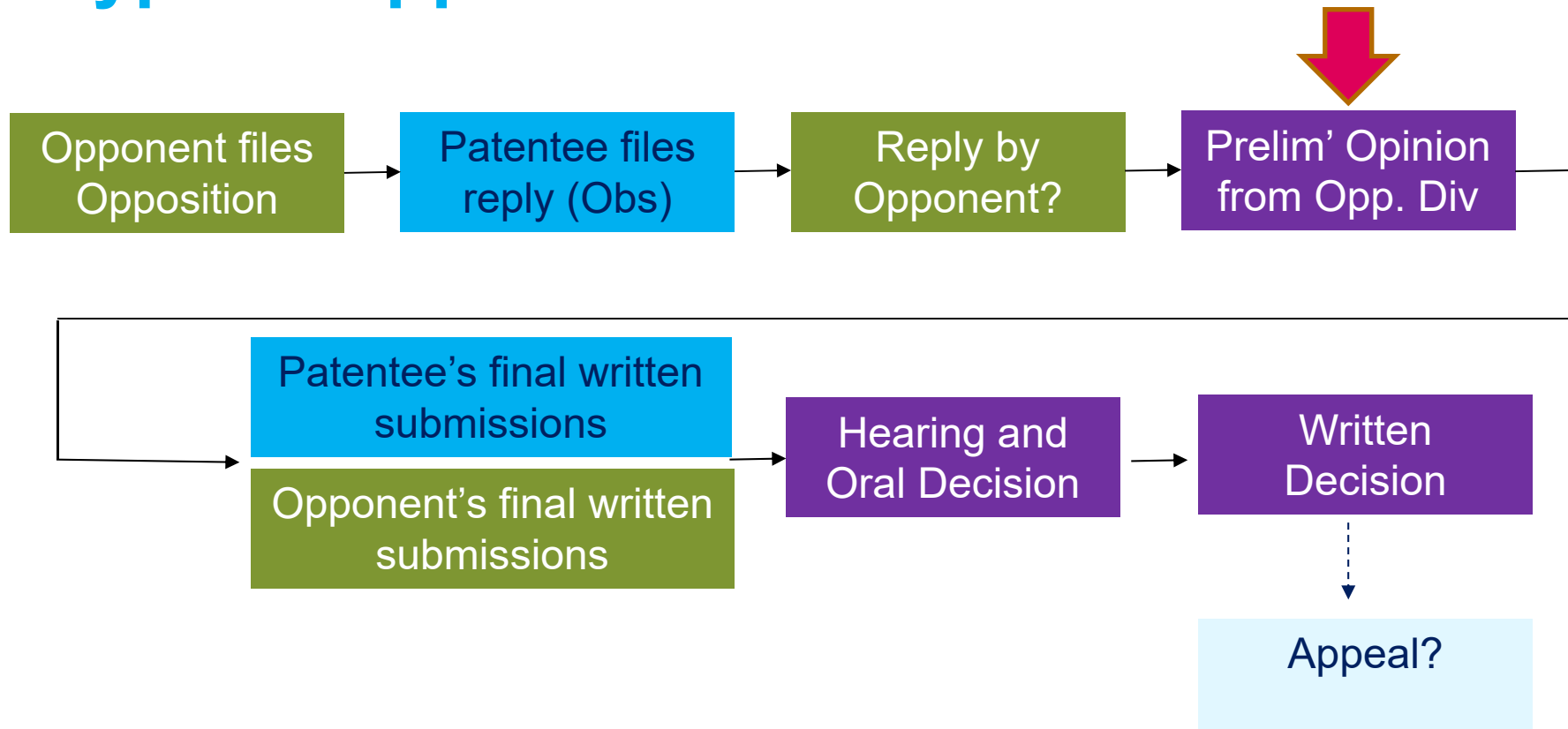


Opposition Observations

Patentee's Counter-statement (Observations)

- File complete case
- Including Auxiliary Requests (fall-back positions)
 - Beware Rule 80 EPC limitation
 - File ALL combinations
- Include all documents and data – otherwise everything else may be considered to be inadmissibly late filed
- 4 month deadline; 2 month extension only available in “exceptional” cases

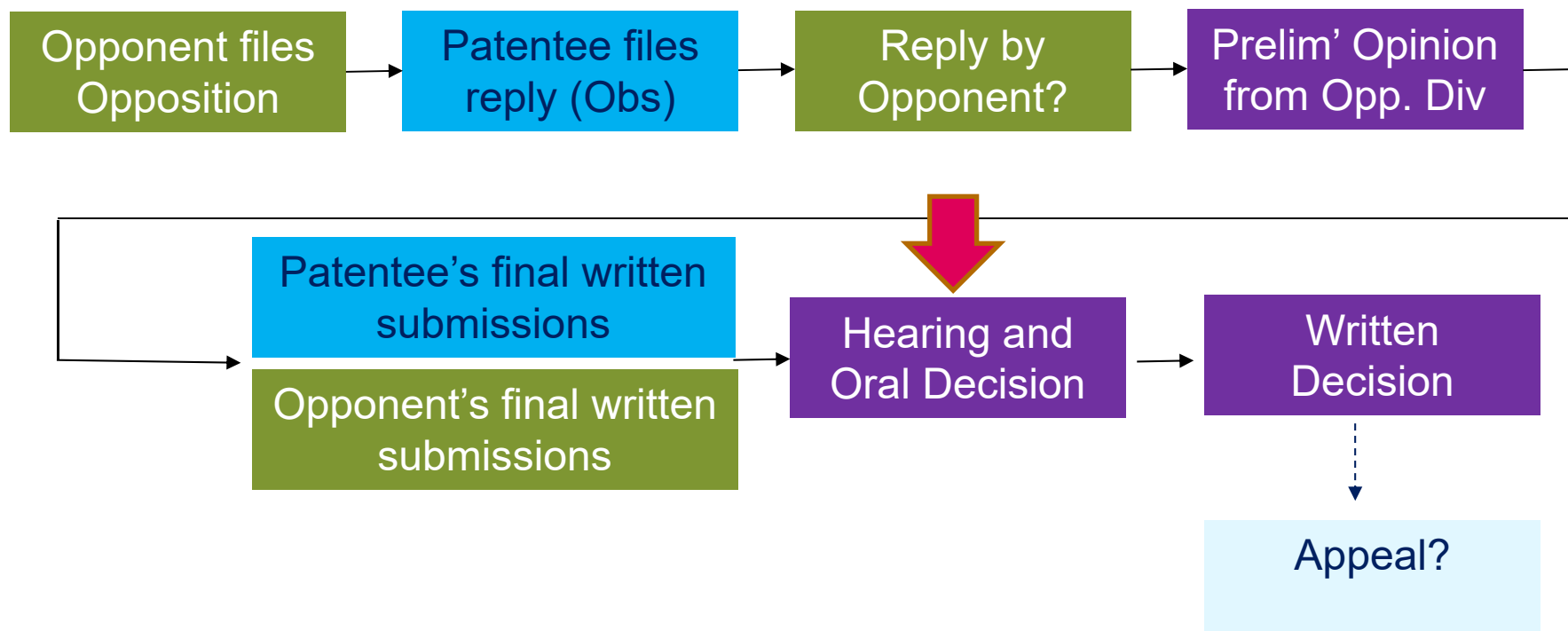
Typical Opposition Time Course



Oppositions – Preliminary Opinion

- The PO is a **non-binding** opinion
- Typically prepared by the Primary Member of the Opposition Division
- Highlights issues for discussion at hearing
- Sets date of hearing – difficult to move
 - At least 6 months notice of hearing
 - Typically via ViCo
- Final written submissions 2 months before
- Sets deadline to request translation (if required)
- Be careful about being complacent with a PO in your favour

Typical Opposition Time Course



Nature of the Opposition Hearing

- Typically the case is heard in front of a 3-person EPO Opposition Division:
 - Primary Examiner – Rapporteur – usually examined pre-grant
 - Chairman – usually not involved pre-grant
 - Second Member – takes the minutes
- Typically by videoconference (“ViCo”) – on rare occasions may be in-person (Munich/Hague)
- Can be with just a single day, or more (depending on the number of parties – esp. in biotech cases) with an oral decision at the end
- The written reasoning of the EPO Opposition Division typically follows 3-6 months later – this is the Interlocutory Decision
- If the Interlocutory Decision is not appealed then the Interlocutory Decision becomes the final Decision
- There may be some plans for possible “super opposition divisions” – especially in the biotech sphere

Arguing at the Opposition Hearing

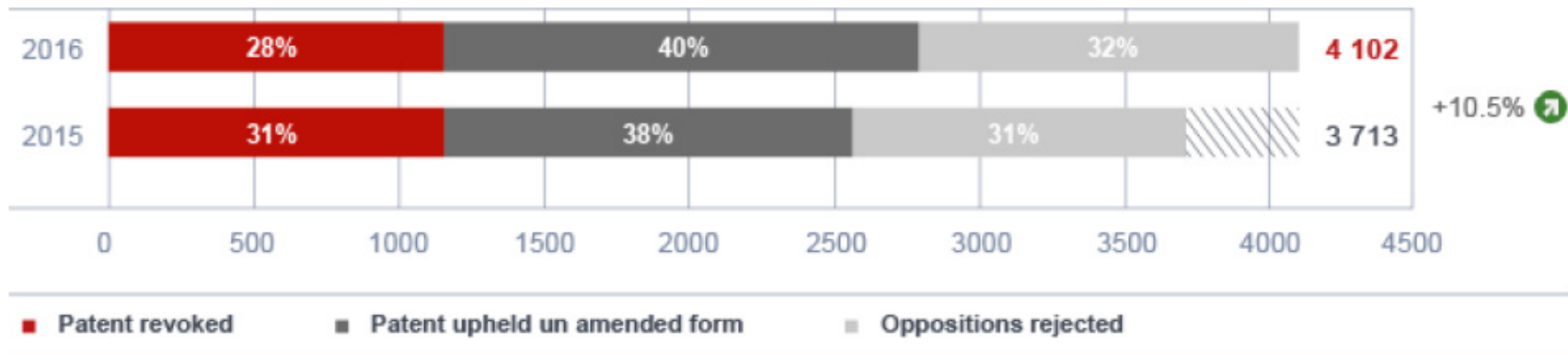
- Usually, European Patent Attorneys do the advocacy
- Be prepared for all kinds of surprises:
 - New prior art
 - New evidence
 - New arguments
 - New amendments

Outcomes of the Opposition Hearing

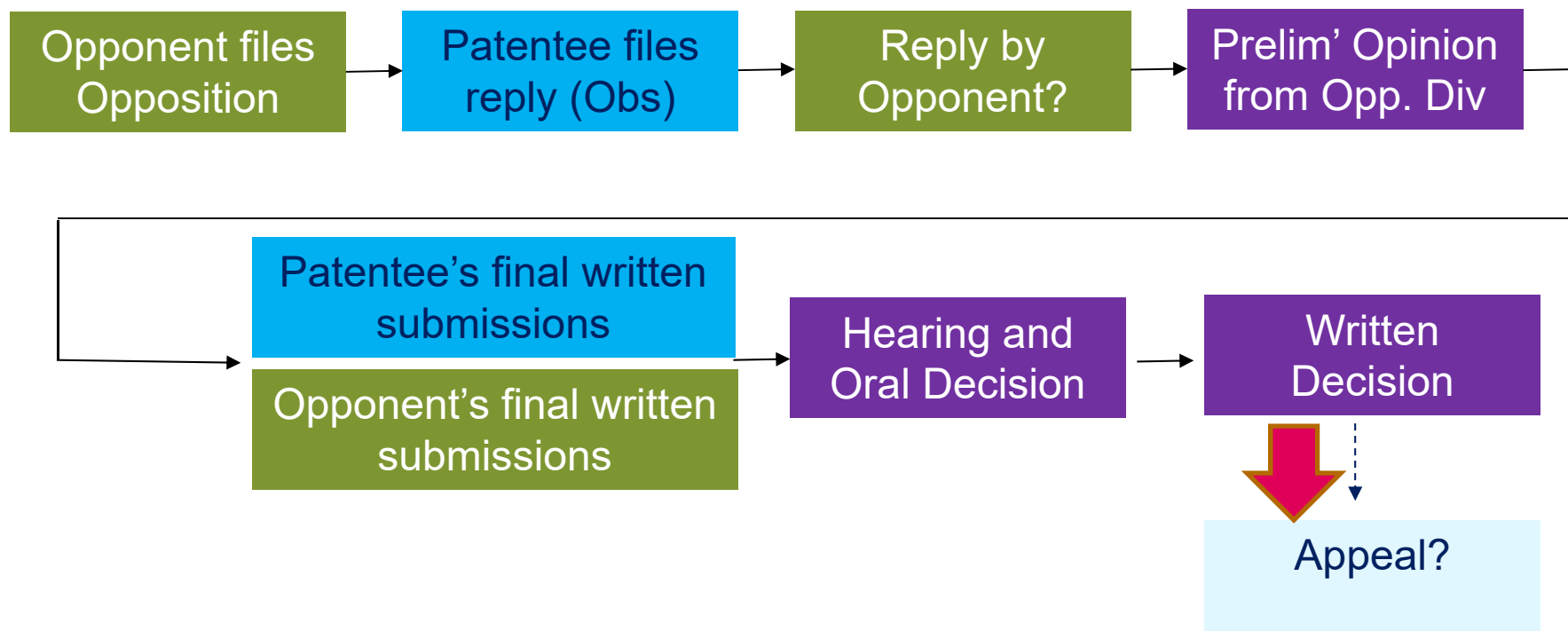
- Maintenance of the patent as granted
- Maintenance of the patent in amended form
- Revocation of the patent

Typical Opposition Outcome %s

- Only a small percentage (~5%) of EPs are opposed – but this is still a very large number relative to national revocation actions
- Outcomes typically 1/3, 1/3, 1/3 over the years



Typical Opposition Time Course



Opposition/Appeal (EPC Part VI Art.s 106-112)

- File Notice of Appeal and pay Appeal Fee
 - Within 2 months of the written Interlocutory Decision
- File Grounds of Appeal
 - Within 4 months of the written Interlocutory Decision

Opposition/Appeal Procedure

- “Front-loaded”: Appellant(s) files the case
- Other side (also Appellant or Respondent) replies (4 months of notification)
- Patentee may try to propose further amendment(s) – conditional or auxiliary
- Hearing date set (or ordered) by the Appeal Board
- Preliminary Opinion of Appeal Board issued before the hearing date
- Very tight rules for admission of any further submissions

Nature of the EPO Appeal Hearing

- Typically the case is heard in front of 3-person EPO Appeal Board
 - Chair
 - Technical Member
 - Legal Member
- Can be by videoconference (“ViCo”) or may be in-person (Munich)
- Can be with just a single day, or more (depending on the number of parties – esp. in biotech cases) with an oral decision at the end
- The reasoning of the EPO Appeal Board typically follows 3-6 months later – this is the Appeal Decision

Outcomes of the EPO Appeal Hearing

- Maintenance of the patent as granted
- Maintenance of the patent in amended form
- Revocation of the patent
- Remittance back to the first instance (Opposition Division)

National UK patent attacks ...

Post-Grant GB Attack Routes – s.74(1)

Subject to the following provisions of this section, **the validity of a patent may be put in issue** –

- a) by way of **defence**, in proceedings for infringement [...]
- b) ...
- c) ...
- d) ...
- e) ...

Post-Grant GB Attack Routes – s.74(1)

Subject to the following provisions of this section, **the validity of a patent may be put in issue** –

- a) ...
- b) in proceedings in respect of an actionable **threat** under section 70A above;
- c) ...
- d) ...
- e) ...

70A Actionable threats

(1) Subject to subsections (2) to (5), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.

(2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—

(a) where the invention is a product, making a product for disposal or importing a product for disposal, or

(b) where the invention is a process, using a process.

(3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a) or (b).

(4) A threat of infringement proceedings is not actionable if the threat—

(a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to a product or process, and

(b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to that product or process.

(5) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.

(6) In sections 70C and 70D “an actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

Post-Grant GB Attack Routes – s.74(1)

Subject to the following provisions of this section, **the validity of a patent may be put in issue** –

- a) ...
- b) ...
- c) in proceedings in which a declaration in relation to the patent is sought under section 71 above [*can be before the court or the **UK IPO***];
- d) ...
- e) ...

71 Declaration or declarator as to non-infringement

(1) Without prejudice to the court's jurisdiction to make a declaration or declarator apart from this section, a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown—

(a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and

(b) that the proprietor has refused or failed to give any such acknowledgment.

(2) Subject to section 72(5) below, a declaration made by the comptroller under this section shall have the same effect as a declaration or declarator by the court.

Post-Grant GB Attack Routes – s.74(1)

Subject to the following provisions of this section, **the validity of a patent may be put in issue** –

- a) ...
- b) ...
- c) ...
- d) ...
- e) in proceedings under **section 58** above. *[Crown User – High Court]*

58 References of disputes as to Crown use

(1) Any dispute as to—

- (a) the exercise by a government department, or a person authorised by a government department, of the powers conferred by section 55 above,
- (b) terms for the use of an invention for the services of the Crown under that section,
- (c) the right of any person to receive any part of a payment made in pursuance of subsection (4) of that section, or
- (d) the right of any person to receive a payment under section 57A,

may be referred to the court by either party to the dispute after a patent has been granted for the invention.

Post-Grant GB Attack Routes – s.74(1)

Subject to the following provisions of this section, **the validity of a patent may be put in issue** –

- a) ...
- b) ...
- c) ...
- d) in proceedings before the court or the **comptroller** under section 72 above for the **revocation** of the patent;
- e) ...

Grounds for a UK National Revocation

Grounds – Section 72(1) UKPA

- Not a patentable invention
- Patent granted to someone else not entitled
- Lack of sufficient disclosure
- Added matter
- Post-grant claim broadening

72 Power to revoke patents on application.

(1) Subject to the following provisions of this Act, the court or the comptroller may by order revoke a patent for an invention on the application of any person (including the proprietor of the patent) on (but only on) any of the following grounds, that is to say—

(a) the invention is not a patentable invention;

(b) that the patent was granted to a person who was not entitled to be granted that patent;

(c) the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art;

(d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed, or, if the patent was granted on a new application filed under section 8(3), 12 or 37(4) above or as mentioned in section 15(9) above, in the earlier application, as filed;

(e) the protection conferred by the patent has been extended by an amendment which should not have been allowed.

(2) An application for the revocation of a patent on the ground mentioned in subsection (1)(b) above—

(a) may only be made by a person found by the court in an action for a declaration or declarator, or found by the court or the comptroller on a reference under section 37 above, to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked; and

(b) may not be made if that action was commenced or that reference was made after the second anniversary of the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(5) A decision of the comptroller or on appeal from the comptroller shall not estop any party to civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds referred to in subsection (1) above, whether or not any of the issues involved were decided in the said decision.

(6) Where the comptroller refuses to grant an application made to him by any person under this section, no application (otherwise than by way of appeal or by way of putting validity in issue in proceedings for infringement) may be made to the court by that person under this section in relation to the patent concerned, without the leave of the court.

UK National Revocation

- UK National effect only
 - Decision in the UK does not have any binding affect the patent in any other country and *vice versa* (but some can be persuasive)
- Can bring proceedings *ab initio*, or as a counterclaim to infringement proceedings
- As with an EPO Opposition outcome – the patent and claims can be found wholly or partly valid, or found invalid
- Revocation action may be brought before Comptroller (i.e. the UK IPO) or before the court

Some UK Litigation Aspects

- Discovery – any thing materially relevant which is not privileged & confidential
- Often have to establish the CGK with many documents and with expert declarations/testimony (cross examination)
- Often have to confine the substance of the case to a handful of key documents
- May not be possible to introduce late submissions
- Loser pays winners costs
- Possibility of injunction

UK IPO Revocation/ Declaration (ss. 72, 71)

- Before an IPO Hearing Officer – senior, experienced official
- Can use a strawman – e.g. an attorney firm (Oystertec case)
- Cheap – official fee **£50**. But requires chargeable time. Costs awarded to winner, but only on IPO scale (max about **£7K**) except in cases of procedural abuse.
- Flexible, rapid procedure:
 - File pleadings
 - Case management Conference (telephone) to plan following stages
 - Hearing (usually 1-2 days)
 - Can hear witnesses, order disclosure of documents
 - Typically around a year to decision
- Appeal to the High Court (and, in some cases, Court of Appeal)

Court proceedings

- May be in:
 - England and Wales – Patent Court or Intellectual Property Enterprise Court (“IPEC”), see CPR Part 63, and Court Guides
 - Scotland – Court of Session, see Rules of Court Chapter 55
 - Northern Ireland – High Court of Northern Ireland
- England and Wales – IPEC gets lower value cases (under **£0.5M**) & Patent Court gets higher value (pharma & telecoms) cases
- Typically takes about a year to trial
- IPEC rules limit trial to one day, and streamline procedure generally
- IPEC cost recovery normally limited to £50K

UK IPO Opinions (ss. 74a, 73(1A))

- Can apply for an IPO Opinion on:
 - Infringement
 - Validity
- Cheap, written procedure (fee **£200**, no Hearing, less time-intensive than opposition or revocation)
- Non-binding. But can be useful in bringing parties to settlement
- Patentee does not have to participate
- If IPO considers patent is clearly invalid, it can then revoke of own initiative under s.73 – appealable to High Court.

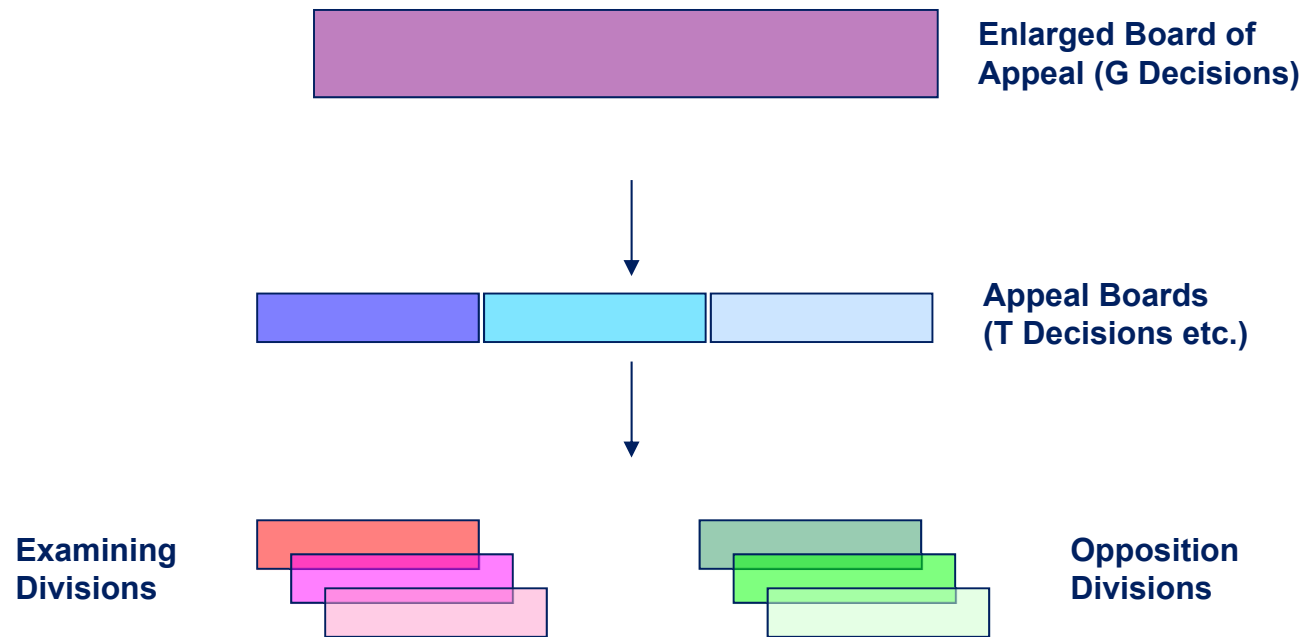
What about the advent of the UPC?

As a direct consequence of Brexit ...

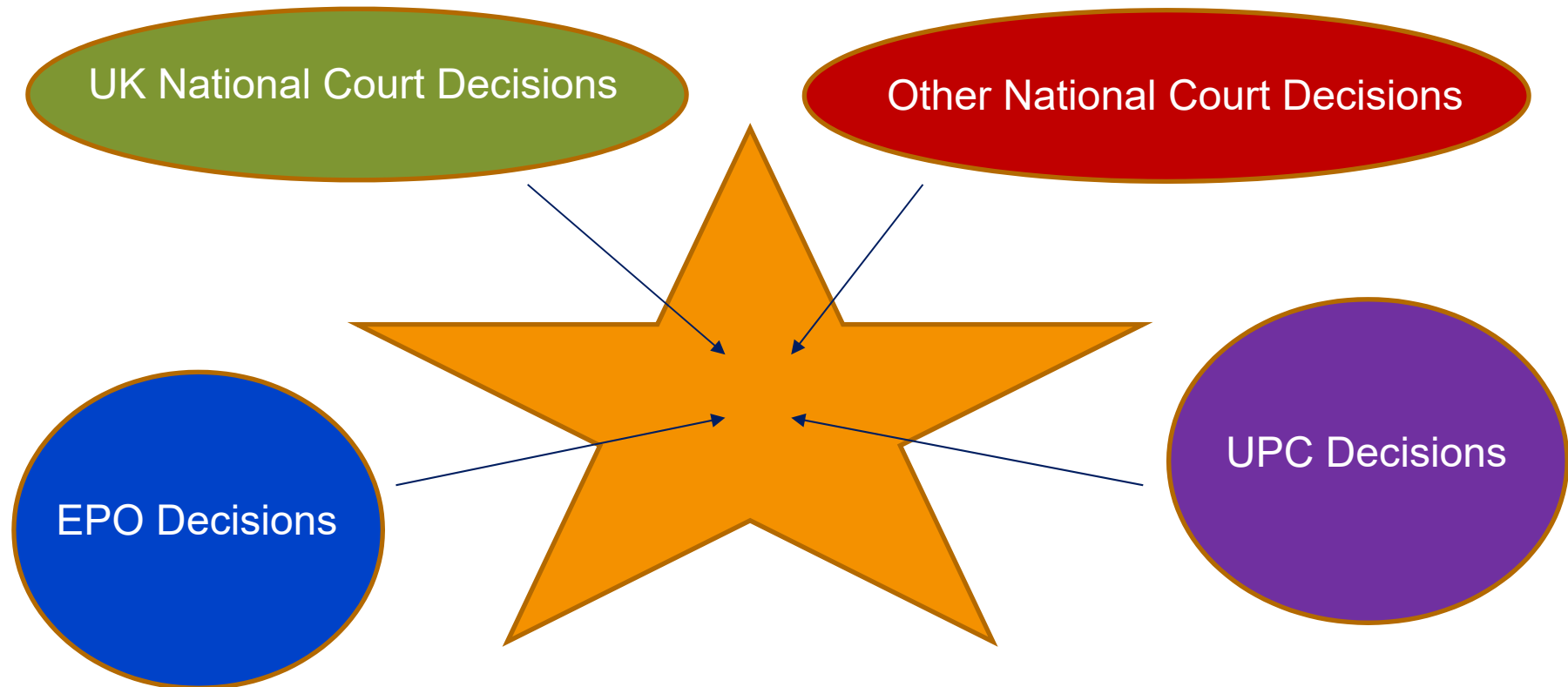
- UK is not part of the UPC
- Hence, you cannot challenge the UK part of an opted-in/opted-out part of an EP patent
- You still have to attack EP(UK) patents via EPO opposition procedure route (if available) and/or UK national route

Decisions - binding or persuasive or otherwise ...

EPO LEGAL FRAMEWORK



Wider interaction?



May be different decisions due to different approaches – e.g. the assessment of inventive step

EPO – Problem/solution approach

- (a) Identify the "closest prior art"
- (b) Assess the technical results (or effects) achieved by the claimed invention when compared with the "closest state of the art"
- (c) Define the technical problem to be solved as the object of the invention to achieve these results
- (d) Examining whether or not a person of ordinary skill, having regard to the state of the art in the sense of Art. 54(2) EPC, would have suggested the claimed technical features for obtaining the results achieved by the claimed invention.

UK Courts – Pozzoli test

- **Step 1:** Identify the person skilled in the art and their relevant common general knowledge (CGK)
- **Step 2:** Identify the inventive concept of the claim in question or if that cannot readily be done, construe it
- **Step 3:** Identify what, if any, differences exist between

UPC Approach to Inventive Step

- Far too early to tell or even to predict
- No case law
- May not get any case law for some while yet

Additional strategy considerations ...

Overall considerations

- Client's position

- Is this a present or future problem?
- What would be the cost of losing an infringement action?
- How much can the client spend on attacking the patent?

- Patentee's position

- Are they a competitor?
- Are they using the invention at all?
- How rich are they?

Tactical considerations

- Timing – do you want to proceed fast or slow?
- Strength of your case?
 - Never underestimate the other side
 - Try to map out all possible outcomes
 - Is there any amendment the patentee could make which would catch the client and be valid?
- Proof – if it is inventive step, is it:
 - Document combination? (if so, go EPO or IPO?)
 - General obviousness? (if so, go Court and expert witness?)

Considerations for using more than one route

- Anonymous Third Party Observations pre-grant
 - Can you direct the patentee away from your client's product?
 - Can you keep your best prior art in reserve in case you fail?
- Proceedings fast – immediate revocation on grant
 - Quicker than an EPO opposition – a year or so
- Proceeding slow (e.g. if the patent only has a couple of years left)
 - EP opposition may keep the patentee tied up for 4+ years until danger is past
- Coordinating other attackers
 - Easier to run inconsistent cases between two parties

Thank you for listening



Questions

D YOUNG & CO **INTELLECTUAL** **PROPERTY**

Dr Charles Harding
Honorary Professor of Law, Queen Mary University
cth@dyoung.com

