

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

Attacking UK Patents

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Remit & Explanation

- This is an **introductory** lecture
- Soley aimed at people with **no or limited** experience in the IP profession
- Touches on general issues
- Does not go into great detail regarding the language of the statutes or the case law
- Tried to make it a practical overview
- Some hypothetical examples have been provided
- Would like this to be an interactive session
- Will not be “speaking to” each slide – some slides have been provided for your later reading and reference
- May focus more on the interactive, hypothetical slides

we have a lot of ground to cover ...

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Topics for today

- Reasons for Attacking
- Possible Attack routes
- General Pros and Cons
- UK Court Actions
- EPO Oppositions
- *[UPC]*

Why attack?

Some reasons to 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 the scope of the claims 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

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Why not attack?

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Some reasons *not* to attack:

1. Draws attention to your client's actual or intended activities
2. May provoke an infringement action
3. Why prod the hornets nest?
4. May create an enemy from a potential partner
5. May provoke narrowing claim amendments towards your client's actual or intended activities
6. May fireproof the patent if unsuccessful
7. Could look bad if you fail

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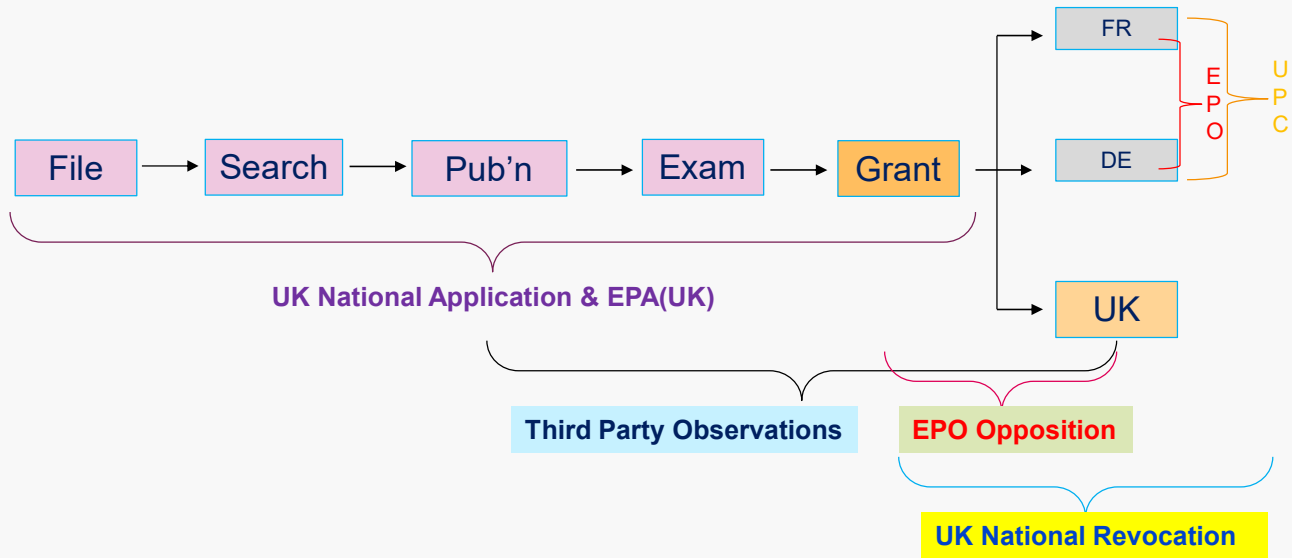
Possible attack routes?

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3 Attack Routes



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The Routes

- 3rd Party Observations (TPOs)
 - before grant - against both pending UK national and EP applications
 - after grant - at the EPO against an EP patent and whilst EPO opposition or opposition/appeal proceedings are still on-going
- UK National Revocation Action
- UK National Patent Office Opinion, followed by Revocation
- EPO Opposition (EPs only)

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3rd Party Observations (TPOs)

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TPOs - UKPA vs EPC

- s21 UKPA
 - Application is pending
- Art. 115 EPC
 - At any stage post publication
- Write explain to the Patent Office why there is not a patentable invention
- You are not a party to the proceedings
- Can be filed anonymously (but not post grant before the EPO to have any effect)

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TPOs – Pros?

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Some Pros for TPOs:

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 e.g. an EPO opposition against the granted claims of the opposed EP patent)
4. Can be anonymous – makes a counter-attack less likely
5. Cheap – no official fee
6. No award of costs

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TPOs – Cons?

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Some Cons for TPOs:

1. Not a party to the proceedings – no right to be heard
2. No procedural follow-up (but can file additional TPOs)
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

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Any Problems With This Claim to Attack with TPOs?

A composition

used in the preparation of a coating

such as a paint

wherein the composition comprises

- more than 25% of product X
- less than 75% of a carrier

wherein the coating yields a lasting sheen when applied to a surface.

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Some clarity problems with the claim:

A composition

used in the preparation of a coating

such as a paint

wherein the composition comprises

- more than 25% of product X
- less than 75% of a carrier

wherein the coating yields a lasting sheen when applied to a surface.

Limited to making a coating?

All types of coatings or just paint coatings?

The addition of "more than 25% of product X" and "less than 75% of a carrier" means that the components do not add up to 100% - so what else is present?

Does "less than 75% of a carrier" cover 0% - meaning the composition can be 100% product X?

What does "lasting" mean?

What does "sheen" mean?

Is applying to a surface an essential step – thereby making the claim a quasis process claim?

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Attacking UK National Patents

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UK National Revocation

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

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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) in proceedings in respect of an actionable **threat** under section 70A above;
- 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) in proceedings before the court or the **comptroller** under section 72 above for the **revocation** of the patent;
- e) in proceedings under **section 58** above. *[Crown User – High Court]*

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UK IPO Revocation/ Declaration (s.72, s.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)

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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

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UK IPO Opinions (s74a, s73(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.

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Outcomes Of A Revocation Action

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

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Attacking EP(UK) Patents via EPO Oppositions

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EPO Oppositions (Art.s 99-105 EPC)

By far the most common way how 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.

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EPO Oppositions – Pros

1. Relatively 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 can be 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

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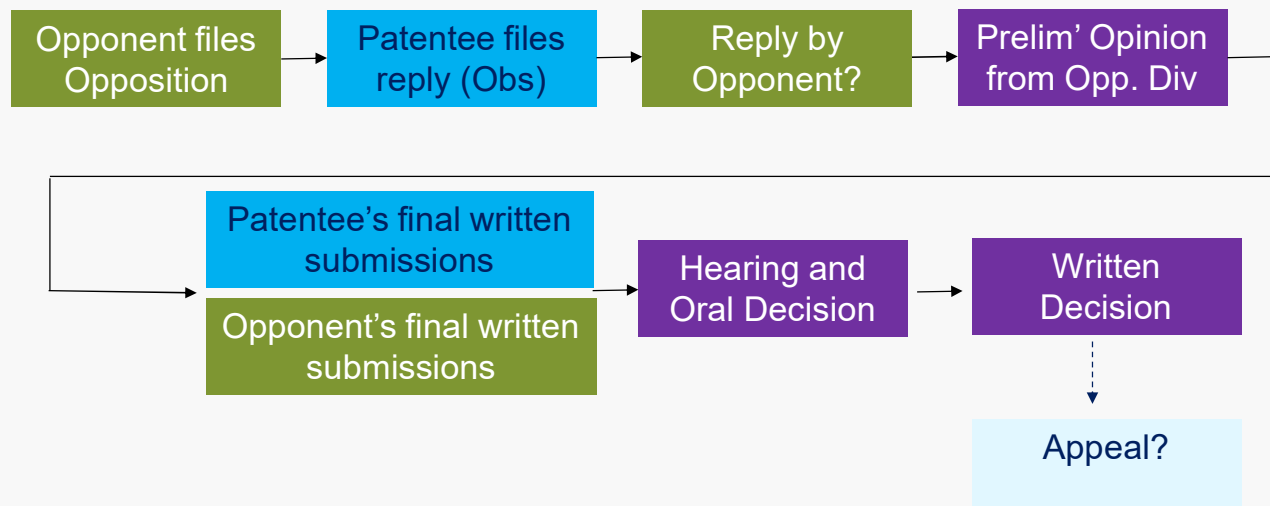
EPO Oppositions – Cons

1. Can be quite slow – can be 2 – 3 years
2. Usually original Examiner is involved in the first instance proceedings – and so there can be a perception that you may be on an uphill struggle
3. Then there is the appeal stage – can be another 2 – 3 years

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Typical Opposition Time Course



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Outcomes of the Opposition Hearing

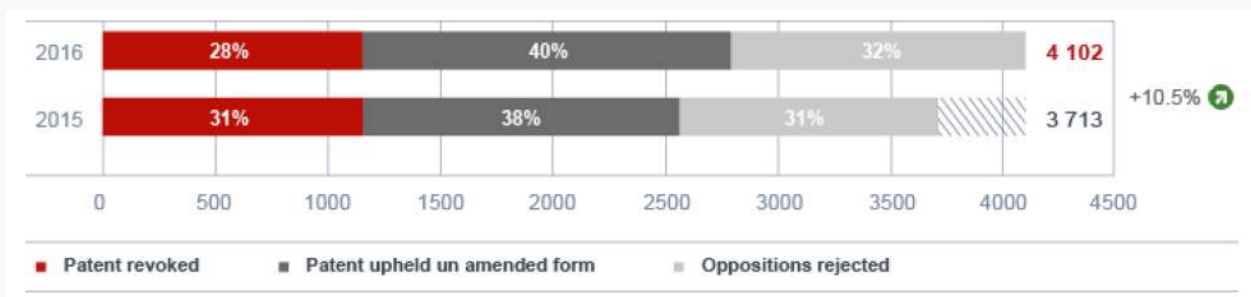
- Maintenance of the patent as granted
- Maintenance of the patent in amended form
- Revocation of the patent

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Typical Opposition Outcome %s

- A small percentage (~5%) of EPs are opposed – but this is still a **very large** number relative to national revocation actions
- Over the years, the typically outcome are:
 ~1/3 (maintain): ~1/3 (amend) : ~1/3 (revoke)



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Opposition Statements

Opposition Statement

- “Any person” can file an opposition
 - Can file anonymously (“straw man” G 4/97)
 - Joint opposition between several persons is admissible (G 3/99)
 - Patentee cannot oppose own patent (G 9/93, OJ EPO 1994, 891)
- Try to raise all possible grounds
- Try to attack all claims
- Try to include all relevant/pertinent documents and data – otherwise anything else you may wish to file later may be considered to be impermissibly late filed
- Try not to base most of your opposition statement on EPO case law

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Substantive Patent Attacks Against:

National Granted UK Patents & Granted EP(UK) Patents

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Common Substantive Attacks

- Added subject-matter
- Lack of sufficiency
- [*Priority attack*]
- Lack of patentability – e.g.:
 - lack of novelty
 - lack of inventive step
 - lack of industrial applicability

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Some Attacks Are NOT Available Against the Granted Claims

- Lack of clarity
 - Unless the granted claims have been amended
 - And even then there are tight rules to allow such an attack to be made
- Lack of support
 - Unless the granted claims have been amended
- Lack of Unity

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Added Subject-matter

- Can be a very powerful attack before the EPO
- Cannot add new matter after filing (e.g. Article 123(2) EPC)
- Cannot broaden the scope of the claims after grant (e.g. Article 123(3) EPC)
- Can be a squeeze between the 2 requirements

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Added subject matter: G2/10

The 'gold standard'

- **“Any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Article 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed.** As is the case for any other amendment, the test for an amendment to a claim by disclaiming subject-matter disclosed as part of the invention in the application as filed must be that after the amendment **the skilled person may not be presented with new technical information.** Hence, disclaiming subject matter disclosed in the application as filed can also infringe Article 123(2) EPC if it results in the skilled person being presented with technical information which he would not derive directly and unambiguously, using common general knowledge, from the application as filed.”



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Example of the Squeeze

- Method claim directed to using “test substances”
- Applicant had to define the “*test substances*” in the claims during Examination stage
- Applicant could have used either of the terms: “**at least two gene sequences**” or “**a plurality of gene sequences**”
- Applicant actually used: “**a plenty of gene sequences**”
- No basis for “**a plenty of gene sequences**” – therefore added matter
- Replacement of “**a plenty**” with “**at least two**” or “**a plurality**” results in a broadening of scope

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Insufficiency Attack

Essentially the argument runs:

- The patent does not provide the skilled person with sufficient or any technical teachings enabling him/her/they to practice the claimed invention across the claim scope

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Insufficiency at the EPO: T 19/90

Serious doubts & Verifiable facts

- “The mere fact that a claim is **broad is not in itself a ground** for considering the application as not complying with the requirement for sufficient disclosure under Article 83 EPC.
- **Only if there are serious doubts, substantiated by verifiable facts**, may an application be objected to for lack of sufficient disclosure.”



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Possible Insufficiency With This Hypothetical Example?

- Claim:
“A compound that can interact with liver cells for delivering a therapeutic molecule to the liver to treat a liver cancer.”
- Data in patent:
 - Just one compound – simple chemical
 - The compound binds to red blood cells in a specific test tube experiment

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Some Considerations:

- Claim:
 - “A compound that can interact with cells for delivering a therapeutic molecule to the liver to treat a liver cancer.”
- Data in patent:
 - Just one compound – simple chemical
 - In a specific test tube experiment the compound binds to red blood cells
- Is the disclosure of just 1 compound enough for all compounds?
- Can the specific experimental result be extrapolated to interacting with liver cells?
- Do the data really show that the compound is effective – or at least has the potential of delivering any therapeutic to treat any liver cancer?

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Priority Attacks

Procedural/formal

- Assignments
 - incorrect dates
 - incomplete
 - ineffective

Substantive

- Not the same teachings as application
- Not the same invention

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Claiming Priority – Substantive Attack

- To support a claim to priority, subject matter disclosed in an earlier application must be directly and unambiguously derivable from the earlier application - G2/98

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Hypothetical Example

Claim of Patent

Compound A
Compound B
Pharma excipient
Optional compound C

Priority teachings – P1

Compound A
Compound B
Optional Compound C

Priority teachings – P2

Compound B
Pharma excipient
Compound C.

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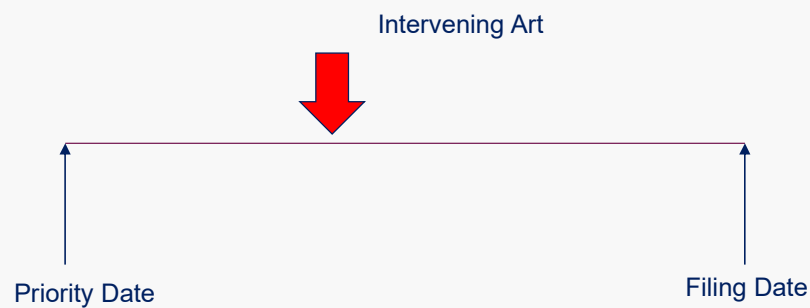
But Why Attack A Claim To Priority?

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Reason for attacking priority:

- Extends the prior art window
- And sometimes with devastating effect



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Novelty

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Novelty at the EPO: T 1387/06

Directly and unambiguously derivable

“According to established jurisprudence [ref 1], it is prerequisite for the acceptance of lack of novelty that the claimed subject-matter is “**directly and unambiguously derivable from the prior art**”. In other words, it has to be “**beyond doubt** - not merely probable - that the claimed subject-matter was directly and unambiguously disclosed in a patent document” [ref 2]. This includes that novelty of the claimed subject-matter vis-à-vis a prior art document cannot be opposed on the basis of only equivalents to the features directly and unambiguously disclosed in the cited document [ref 3].”

Ref 1 = Case Law of the Boards of Appeal of the EPO

Ref 2 = T1029/96 of 21 August 2001, sect. 2.8 of the reasons

Ref 3 = T167/84, sect. 6 of the reasons, and T928/93 sect. 2.1.3 of the reasons



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Hypothetical Example

Claim of Patent

i. A dough comprising
ii. Wheat flour
iii. Yeast
iv. Enzyme A

D1 (no iii)

i. A dough comprising
ii. Wheat flour
iv. Enzyme A

D2 (no explicit i & not specific ii)

Flour
iii. Yeast
iv. Enzyme A

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Inventive Step

s.3: An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

Art. 56 EPC: An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

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Despite some similarity in wording there are differences in the approaches for the assessment of (lack) of inventive step

- UK = “*Pozzoli Test*”
- EPO = “*Problem-Solution*” Approach

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UK Pozzoli Test

- **Step 1:** Identify the person skilled in the art (**PSA**) and his/her/their relevant common general knowledge (**CGK**)
- **Step 2:** Identify the inventive concept of the claim in question
- **Step 3:** Identify what are the differences between the claimed subject-matter and the prior art
- **Step 4:** Viewed without any knowledge of the claimed alleged invention, do the differences constitute steps which would have been obvious to the PSA or do they require a degree of invention?

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EPO Problem/solution approach

Step (a): Identify the "closest prior art" (CPA)

Step (b): Assess the technical results (or effects) achieved by the claimed invention when compared with the CPA

Step (c): Define the technical problem to be solved as the object of the invention to achieve these results

Step (d): Examining whether or not a PSA 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.

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EPO Inventive step: T 606/89

Choice of closest prior art

“In order to apply this [problem solution] approach for objectively assessing inventive step, it is **essential to establish the closest prior art. Generally, this requires that the claimed invention should be compared with the art concerned with a similar use which requires the minimum of structural and functional modifications.** Thus, in the present case, this involves not only comparing the claimed compositions with those of the prior art, but also giving consideration to the particular properties which render the compositions suitable for the desired use.”

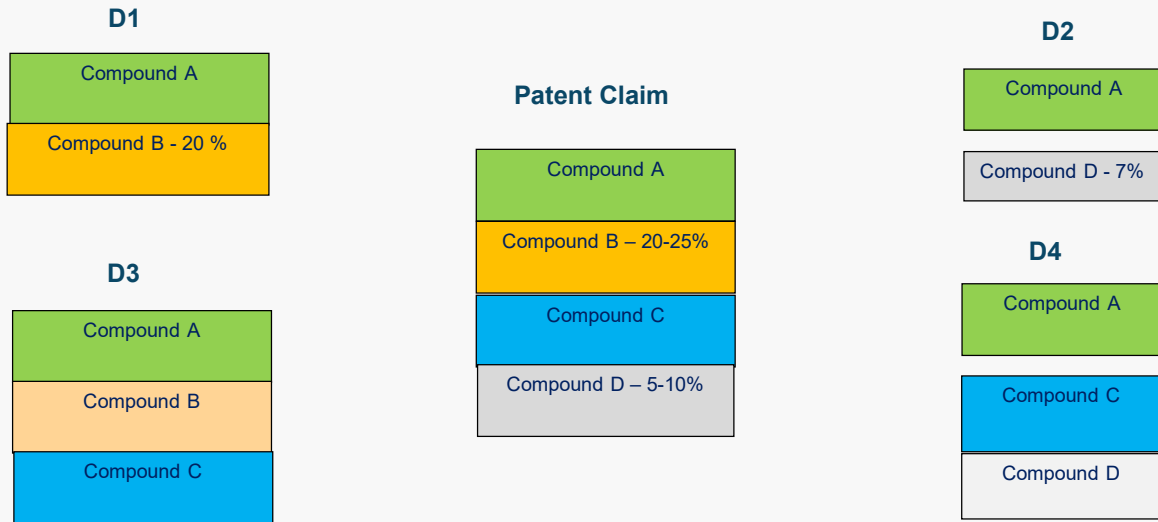


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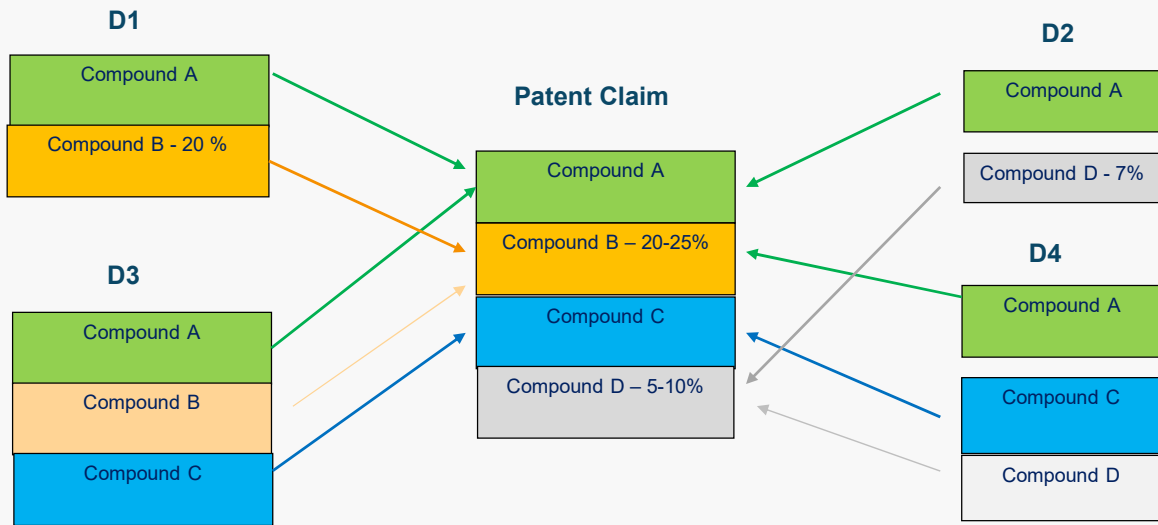
Hypothetical Example



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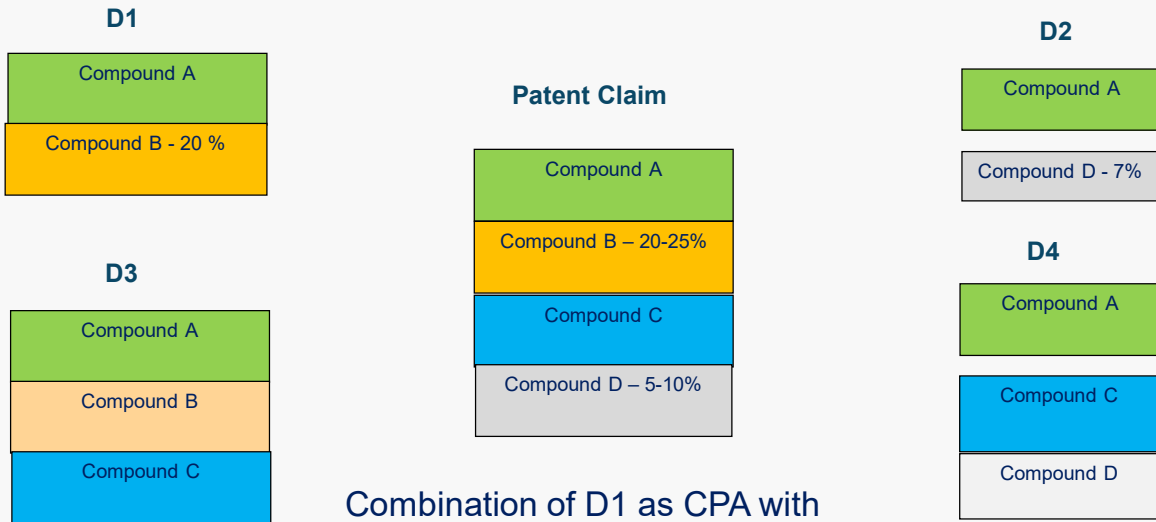
Pozzoli Test – Obvious?



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Problem & Solution – Inventive?



Combination of D1 as CPA with say D2 (or *vice versa*) does not provide all claimed features

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What about the advent of the UPC?

As a direct consequence of Brexit ...

- UK is not part of the UPC
- An opted-in EP patent (i.e. an EP patent that has not been opted-out) will not cover the UK
- Hence, a UPC action will have no effect on a UK designation of an EP patent
- You still have to attack EP(UK) patents via EPO opposition procedure route (if available) and/or UK national route

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Summary

- General pros and cons for whether or not to attack
- Many possible ways of attacking UK patents
- General pros and cons for the forum and timing of when to attack
- For the time being, EPO Oppositions are set to continue to be the most favoured approach for attacking

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Thank you for listening

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Questions

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