

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

Attacking UK Patents

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This PPT

- The PPT is divided into 2 parts
 - Part 1 – Today's Presentation
 - Part 2 – Additional Materials - some background information relating to Part 1 for your reference at a later date (will not be part of today's discussion)

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PART 1

TODAY'S PRESENTATION

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Remit

- This is an **introductory** lecture
- Solely 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

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Explanation

- Tried to provide 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]*

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Why attack?

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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:

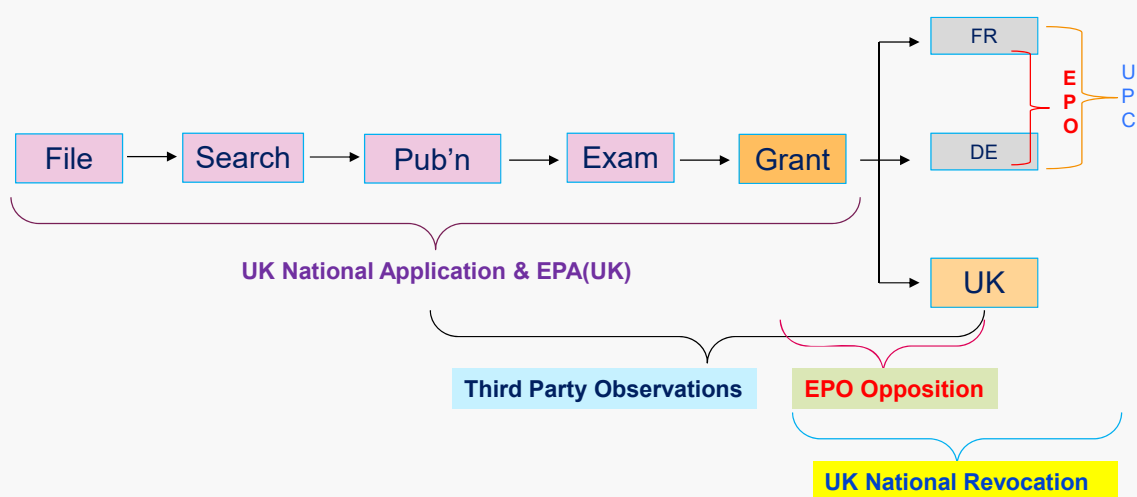
1. Draws attention to your client's actual or intended activities
2. May provoke an infringement action
3. May create an enemy from a potential partner
4. May provoke narrowing claim amendments towards your client's actual or intended activities
5. May fireproof the patent if unsuccessful
6. Could look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

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Possible attack routes?

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3 Attack Routes



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The Attack 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 (EP patents 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 to the Patent Office to explain why there is not a patentable invention
- You are not a party to the proceedings
- Can be filed anonymously for pending case
- For post grant EP cases – anonymous TPOs may have little (if 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 an EPO opposition)
6. Could prompt the applicant to file a back-up 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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Hypothetical Claim to Consider for Possible TPOs

Subject-Matter = A Coating Composition

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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? Does "more than 25% of product X" mean that the composition can be 100% product X?

What does "sheen" mean technically?

Is applying to a surface an essential step - thereby making the claim a quasi 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
- Revocation action may be brought before Comptroller (UK IPO) or before the court
- The patent and claims can be found wholly or partly valid, or found invalid

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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 cases (e.g. pharma & telecoms)
- 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 UK 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 about **€1,000** (about **€850**) and appeal fee is less than about **€3,000** (about **€2,785**) - but oppositions and appeals can 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. The patentee claims cannot improve the granted claim set (e.g. adding new dependent claims)
5. A divisional cannot be filed from the granted patent
6. “Strawman” opponent can be used
7. Opponent has equal procedural rights to be heard at the first instance and on appeal etc.
8. Typically no award of costs

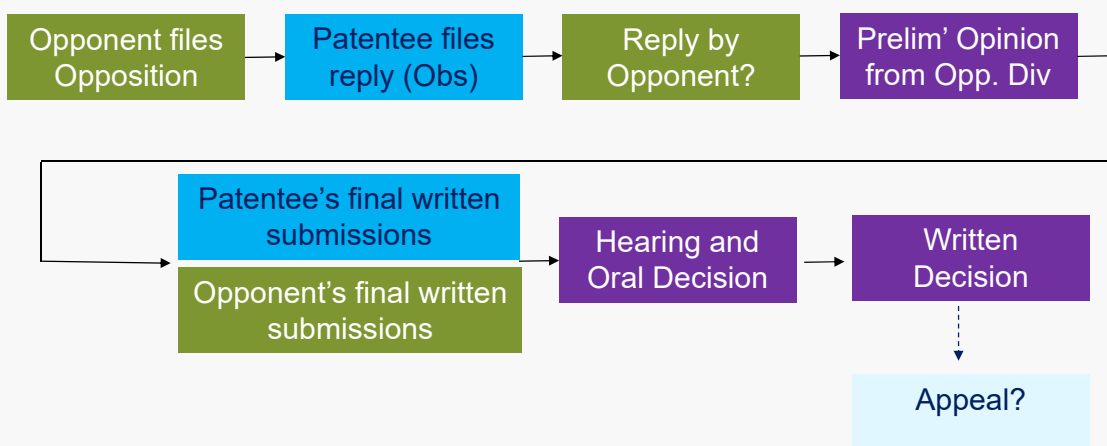
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EPO Oppositions – Cons

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 an EPO Opposition Hearing

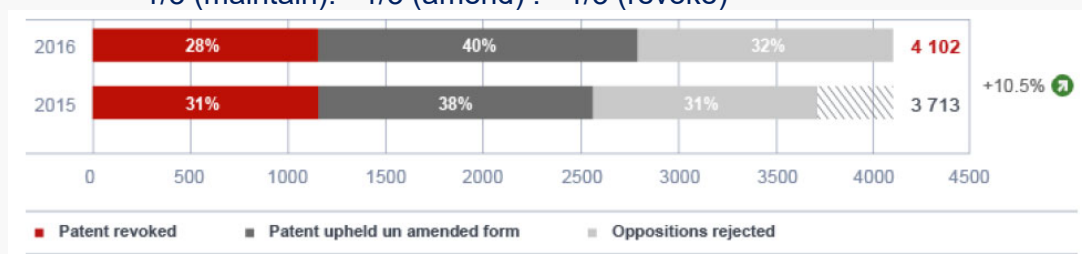
- Maintenance of the patent as granted
- Maintenance of the patent in amended form
- Revocation of the patent

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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
 - And even then there are tight rules to allow such an attack to be made
- Lack of Unity

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Added Subject-Matter & Broadening

- 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 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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Hypothetical Claim to Consider for Insufficiency

Subject-Matter = A Therapeutic

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Possible Insufficiency?

- 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
- Just one specific *in vitro* experiment showing 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, the subject matter disclosed in an earlier priority application must be directly and unambiguously derivable from the earlier application.
- (G2/98)

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Hypothetical Claim to Consider for Priority

Subject-Matter = A Composition

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Multi-component composition

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.

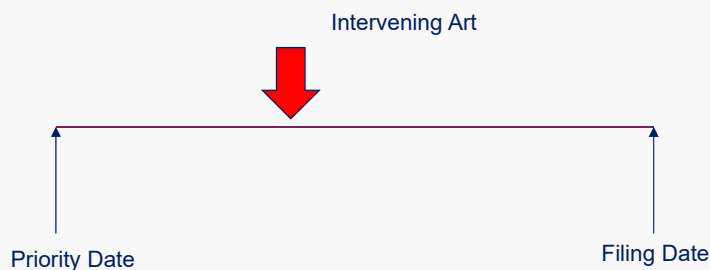
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But Why Attack A Claim To Priority?

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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 Claim to Consider for Possible Lack of Novelty

Subject-Matter = A Dough Composition

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Dough Composition

Claim of Patent

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

D1

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

D2

Flour
iii. Yeast
iv. Enzyme A

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Dough Composition is Novel

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 UKPA: 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

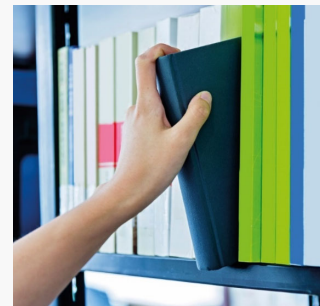
- **Step (a):** Identify the "closest prior art" (CPA)
- **Step (b):** Assess the technical results (or effects) achieved by the claimed invention when compared with the CPA
- **Step (c):** Define the technical problem to be solved as the object of the invention to achieve these results
- **Step (d):** 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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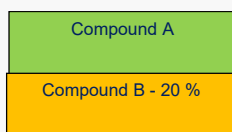
Hypothetical Claim to Consider for Possible Lack of Inventive Step

Subject-Matter = A Multi-component Composition

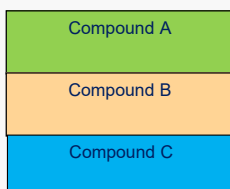
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Multi-component composition

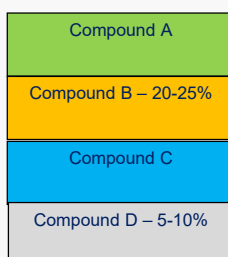
D1



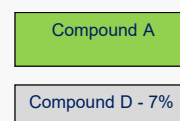
D3



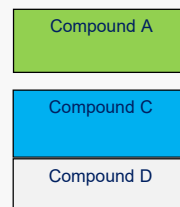
Patent Claim



D2

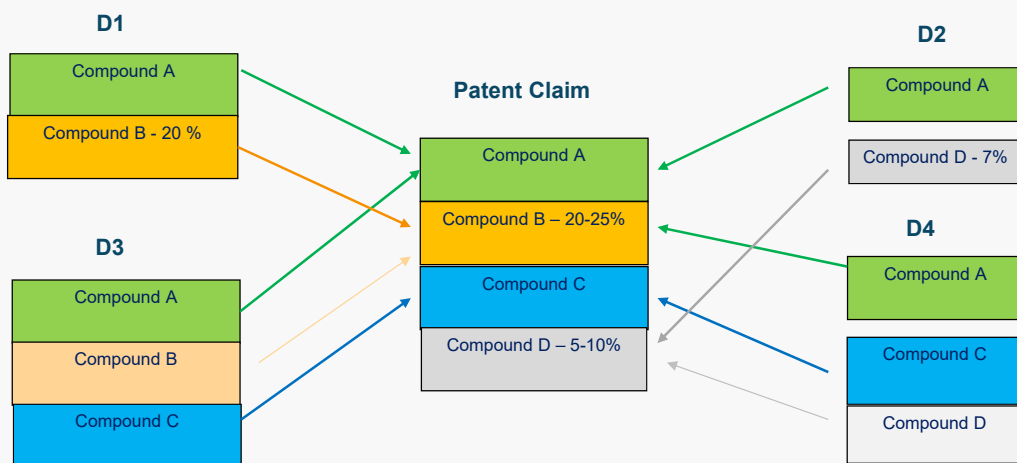


D4



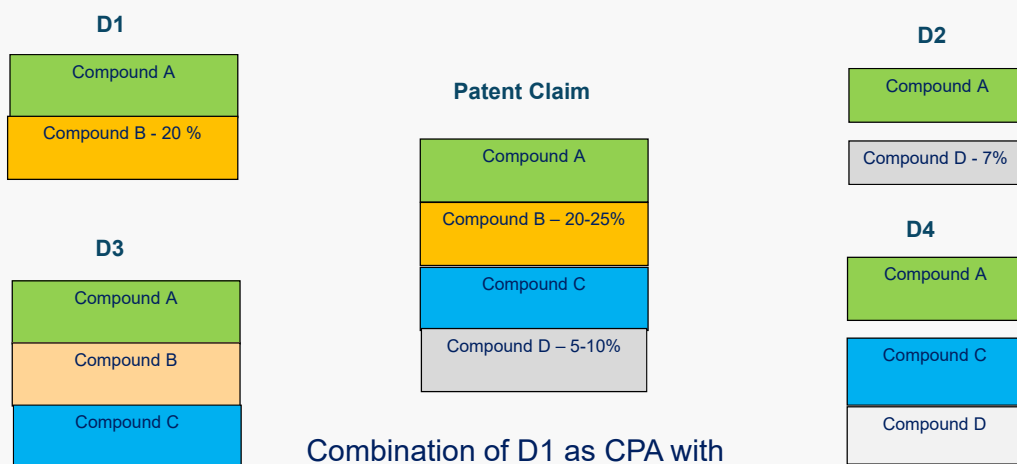
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Pozzoli Test – Obvious?



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Problem & Solution – Inventive?



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What about the advent of the UPC?

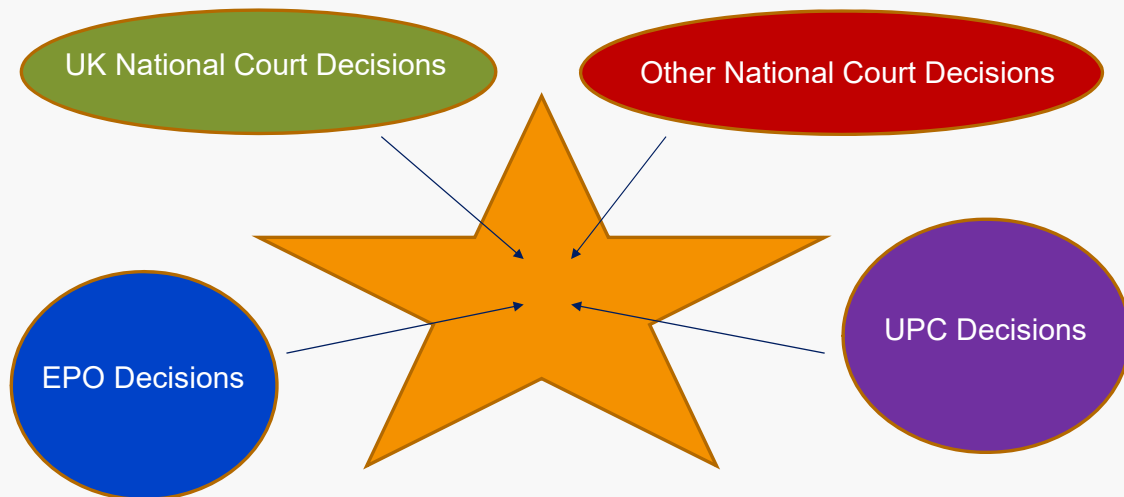
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As a direct consequence of Brexit ...

- 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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Growth of case law



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May be different outcomes – due to:

- Different parties
- Different prior art
- Different evidence
- Different approach to reliance on experts
- Different approach to the assessment of (for example) inventive step

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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 EP patents that cover the UK

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Thank you for listening

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Questions?

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PART 2

ADDITIONAL MATERIALS

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

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s.21 UKPA

- 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.
- 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.

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EPC Art. 115

In proceedings before the European Patent Office, following the publication of the European patent application, any third party may, in accordance with the Implementing Regulations, present observations concerning the patentability of the invention to which the application or patent relates. That person shall not be a party to the proceedings.

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National UK patent attacks ...

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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) ...
- c) ...
- d) ...
- e) ...

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

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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.

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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) ...
- 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) ...

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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.

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

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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.

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

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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

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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.

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Some UK Litigation Aspects

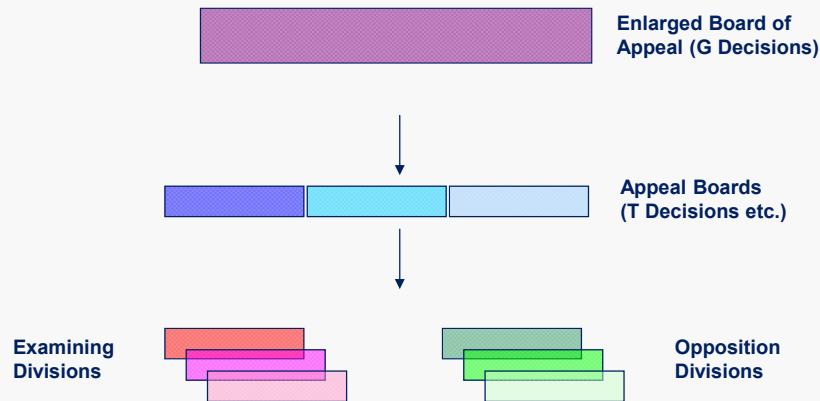
- Discovery – anything materially relevant which is not privileged & confidential
- Often have to establish the CGK with many documents and with expert declarations/testimony (cross examination)
- Often have to confine the substance of the case to a handful of key documents
- May not be possible to introduce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

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EPO Oppositions

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EPO Case Law Framework



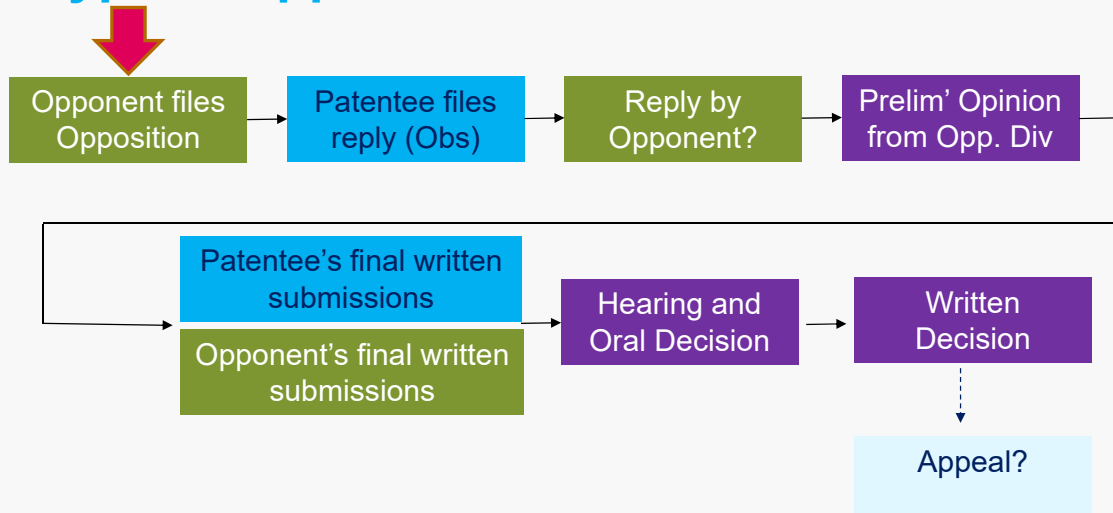
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Extent of Opposition

- In first instance proceedings the OD should examine only those **grounds** for opposition which the opponent has submitted within the time limits and have properly supported with facts and evidence (G10/91)
 - **Exception 1:** the subject-matter of **dependent claims** attached to an independent claim found invalid in opposition proceedings may be examined as to patentability even if they have not been explicitly opposed, provided the information already available casts *prima facie* doubt on the validity of their subject-matter (G9/91).
 - **Exception 2:** the opposition division may consider other grounds which, *prima facie*, in whole or in part seem to prejudice the maintenance of the patent (Art. 114(1) EPC, G10/91). In **appeal** proceedings this is possible only with the approval of the patentee.

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Typical Opposition Time Course



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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)

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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

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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

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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

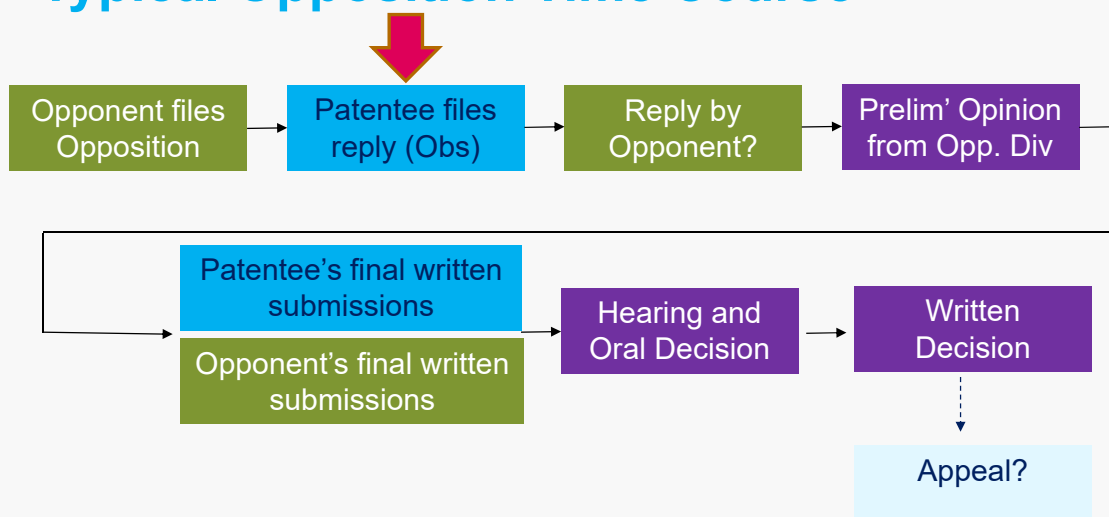
- a) Unless causes lack of sufficiency
- b) an amendment made during opposition may be attacked for lack of support if it didn't come from a dependent claim

3. Lack of unity

4. Formal Deficiencies

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Typical Opposition Time Course



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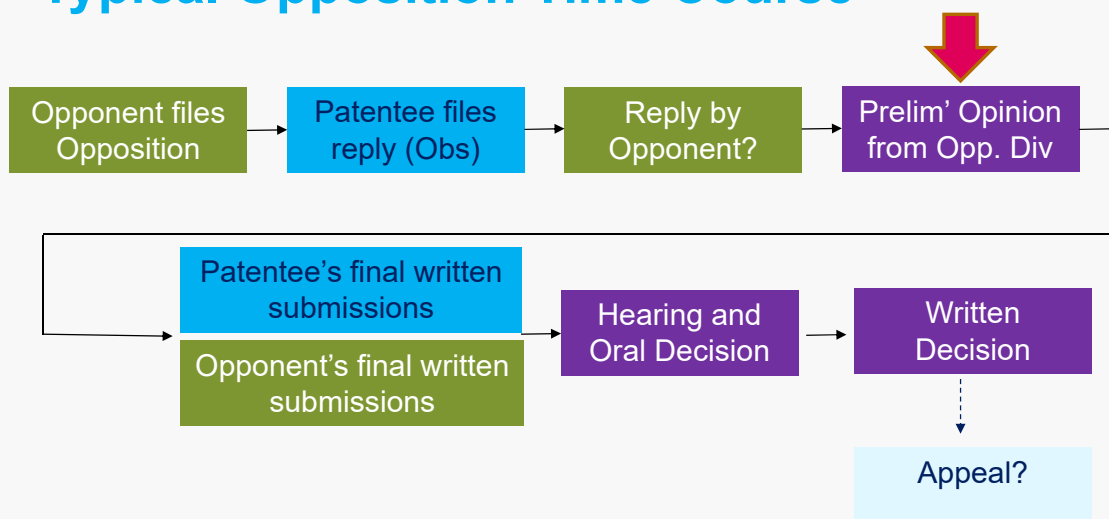
Opposition Observations

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

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Typical Opposition Time Course



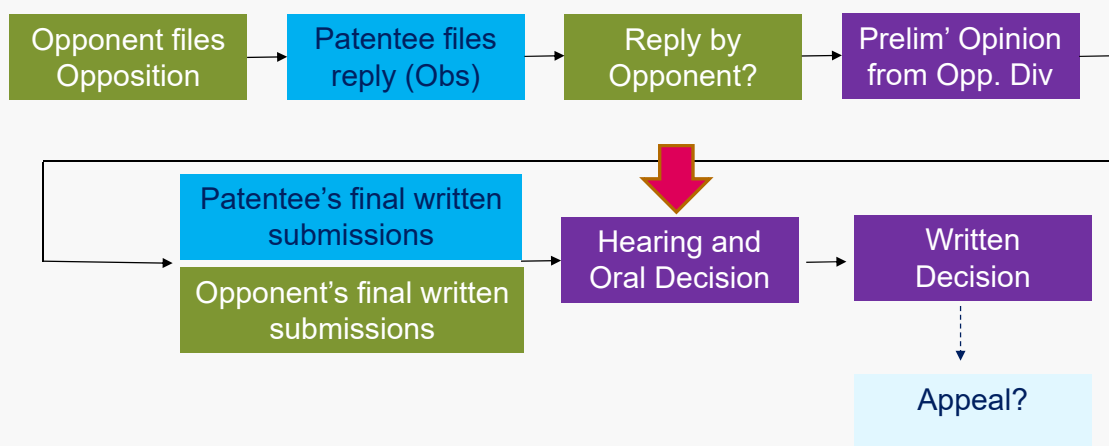
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Oppositions – Preliminary Opinion

- 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

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Typical Opposition Time Course



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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

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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

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Outcomes of the Opposition Hearing

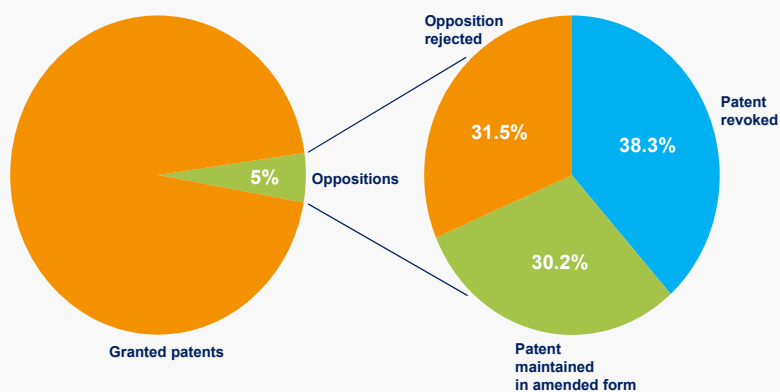
- Maintenance of the patent as granted
- Maintenance of the patent in amended form
- Revocation of the patent

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Typical Opposition Outcomes

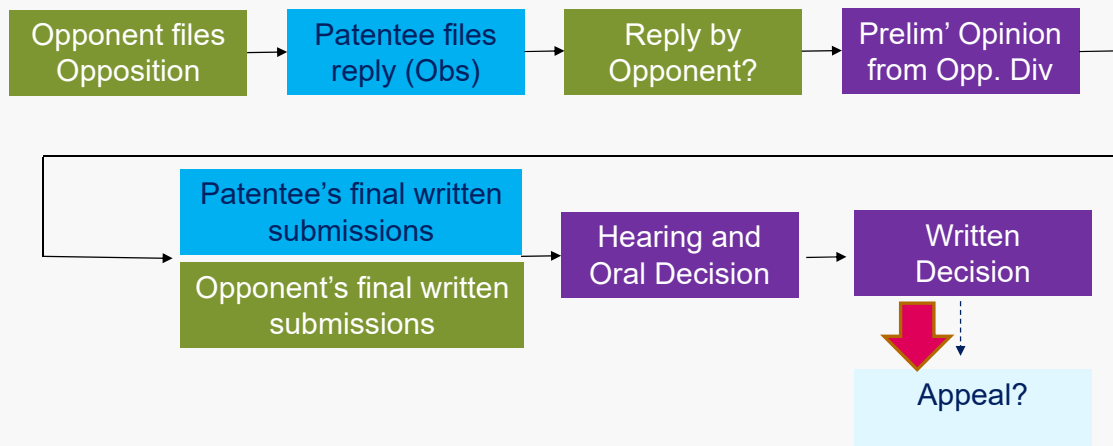
Oppositions were filed against 5% of granted European patents.

Around one third of all opposed patents were revoked.



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Typical Opposition Time Course



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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

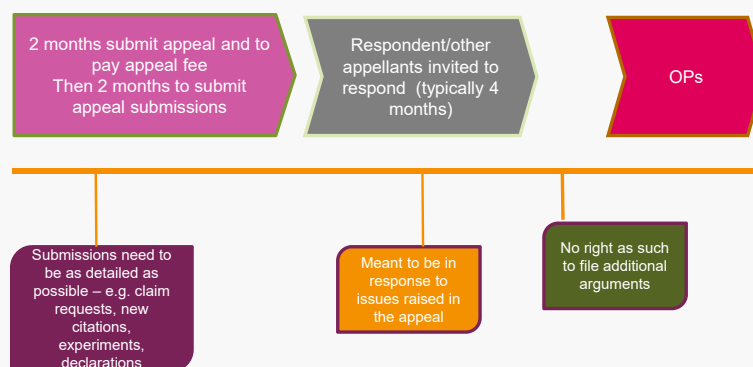
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Opposition/Appeal Procedure

- “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

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Appeal Procedure timeline



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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

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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)

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UPC Revocation Action

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UPC Fees (July 2022)

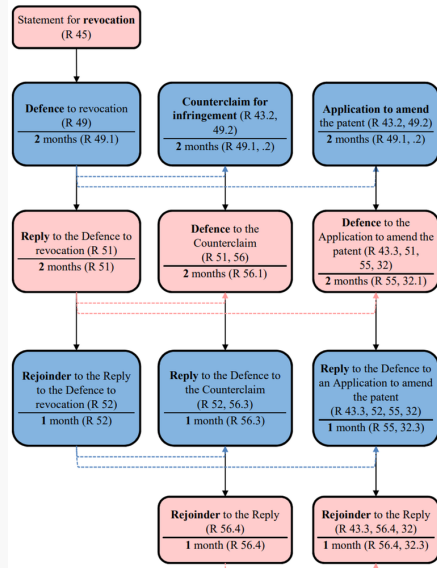
Procedures/actions	Fixed Fee
Revocation action [R. 46]	20,000 €
Counterclaim for revocation [R. 26]	same fee as the infringement action subject to a fee limit of 20,000 €
Annulment for provisional measures [R. 206.5]	11,000 €

Procedures/actions	Fixed fee
Infringement action [R. 15]	11,000 €
Counterclaim for infringement [R. 53]	11,000 €
Action for declaration of non-infringement [R. 70]	11,000 €
Action for compensation for license of right [R. 80.2]	11,000 €
Application to determine damages [R. 132]	3,000 €

Value of action	additional value-based fee
Up to and including 500,000 €	0 €
Up to and including 750,000 €	2,500 €
Up to and including 1,000,000 €	4,000 €
Up to and including 1,500,000 €	8,000 €
Up to and including 2,000,000 €	13,000 €
Up to and including 3,000,000 €	20,000 €
Up to and including 4,000,000 €	26,000 €
Up to and including 5,000,000 €	32,000 €
Up to and including 6,000,000 €	39,000 €
Up to and including 7,000,000 €	46,000 €
Up to and including 8,000,000 €	52,000 €
Up to and including 9,000,000 €	58,000 €
Up to and including 10,000,000 €	65,000 €
Up to and including 15,000,000 €	75,000 €
Up to and including 20,000,000 €	100,000 €
Up to and including 25,000,000 €	125,000 €
Up to and including 30,000,000 €	150,000 €
Up to and including 50,000,000 €	250,000 €
more than 50,000,000 €	325,000 €

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Revocation Action – Written Procedure



- Pink = Claimant
- Blue = Defendant

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UPC Approach to Inventive Step

- Early to tell
- No extensive body of case law (yet)

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Additional strategy considerations ...

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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?

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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?)

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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

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