

Challenging a competitor's pending or granted UK or European Patent



How to get a patent revoked

A patent is fundamentally a legal right to stop others from using the invention claimed in the patent. So what if someone else has a patent which is blocking your business? You may want to see if you can get it “knocked out”.

What are the grounds for revocation?

To get a patent revoked you effectively need to show that it should never have been granted in the first place. The most common reasons are that the patented invention was not new when the patent application was filed, or was obvious (i.e. no inventive step). To try to show that an invention was not new or not inventive, a prior art search can be undertaken. Anything available to the public before the priority date of the patent can potentially be used.

There are a few other things that can make a patent invalid—it might be that the invention is excluded from patentability (e.g. the invention is no more than a business method), or the invention is not sufficiently described in the patent. However, lack of novelty and/or lack of inventive step are the most common grounds.

Can I attack a patent application before it is granted?

Yes you can. It is possible to make “observations” on a pending patent application. This could include bringing prior art to the attention of the examiner. This procedure is generally low-cost and low-risk, and attacking the patent at this early stage can often be worthwhile.

What are my options to revoke a patent which has already been granted?

Procedurally there are a number of options for attacking a patent after grant. The key consideration when choosing an option is the likely cost to you and the risk of being ordered to pay the other side’s legal costs if you lose. Patent revocation in the High Court is notoriously expensive but there are now several options which are viable to small and medium sized businesses.

One recent development is the UKIPO’s power to start revocation proceedings of its own initiative, following an office opinion that the patent is clearly invalid. We have found this procedure to be very successful in some cases, but would usually recommend it only where there is strong documentary evidence of lack of novelty, or perhaps a very strong case for lack of inventive step.

With a more subtle case, particularly where oral evidence from witnesses may be needed, revocation proceedings at the UKIPO or in Court will be more appropriate. This costs more, but the UKIPO and Intellectual Property Enterprise Court both have procedures in place to reduce costs, make these procedures accessible to SMEs and level the playing field if attacking a well-funded patentee.

The table attached sets out the main options. We can discuss the advantages and disadvantages of each route with you in detail and develop a strategy that works for you.

Are there any other options?

If considering attacking a patent, it is important to take into account any possibility that the proprietor may be prepared to grant you a licence. Potential workarounds may also be worth looking at. It is possible to prepare revocation arguments and use these in licence negotiations, and this can be a good strategy to obtain favourable terms.

Options for challenging your competitor's pending or granted UK or European Patent



	Third party observations (Art 93. EPC / s. 21 Patents Act)	Opposition (Art 99 EPC) European Patents Only	UKIPO Opinion Service	UKIPO Revocation	IPEC Revocation	High Court Revocation
When is the procedure available?	Before grant	Up to 9 months after grant	After grant	After grant	After grant	After grant
Typical Cost	Typically less than £1000	€785 official fee Typically £5000-£25,000+ attorney fees	£200 official fee Typically £2000—£5000 attorney fees	Typically £5000—£25,000+ Depends on representation and strategy	£30,000—£100,000+ Depends on representation and strategy	£100,000+ Depends on representation and strategy
Anonymous submission possible?	Can be filed completely anonymously if required.	Pseudonymous (“straw man”) submission possible.	Pseudonymous (“straw man”) submission possible.	Pseudonymous (“straw man”) submission possible.	Pseudonymous (“straw man”) submission possible.	Pseudonymous (“straw man”) submission possible.
Grounds available	Novelty, inventive step, clarity, sufficiency, patentability, added matter	Novelty, inventive step, sufficiency, patentability, added matter	Novelty, inventive step, sufficiency, patentability, added matter, extended scope (grounds not considered before grant)	Novelty, inventive step, sufficiency, patentability, added matter, extended scope, (entitlement)	Novelty, inventive step, sufficiency, patentability, added matter, extended scope, (entitlement)	Novelty, inventive step, sufficiency, patentability, added matter, extended scope, (entitlement)
Third party participation / hearing arrangements	None after filing of observations, although public file can be monitored and further submissions made.	Full inter-partes proceedings. Either side entitled to require oral proceedings, usually held in Munich or The Hague.	Written submissions, not a full inter-partes procedure, Examiner takes into account submissions and comes to his/her own opinion.	Full inter-partes proceedings, but controls will be exercised to limit evidence. 1-2 day hearing usually in Newport, South Wales.	Full inter-partes proceedings, but controls will be exercised to limit evidence. 1-2 day hearing usually in London.	Full inter-partes proceedings, scope to present any relevant evidence. Hearing usually in London, could be 3 days plus if needed.
Risk of adverse costs	None	Unusual. Generally only if a party has behaved unreasonably by filing evidence or withdrawing at very late notice.	None	Generally limited to a few thousand	Generally limited to £50,000	Unlimited and can be large (£100,000+)

Typical costs given do not include searching or other types of investigatory work to find grounds for opposition. Various invalidity searching options are available if required.

This table is for guidance only and does not include every subtlety—please contact us for detailed advice. Email fnoble@albright-ip.co.uk, phone +44 (0) 1242 691801