

# HOW TO SUCCESSFULLY DEFEND A PATENT

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# HOW TO SUCCESSFULLY DEFEND A PATENT

**A patent is an attacking tool:  
“keep off this patch or else!”**

- **why** would you need to defend a patent?
- and **when**?
- and **how**?



# WHY WOULD YOU NEED TO DEFEND A PATENT?

**Because people can attack it, e.g.**

- people you are telling to stop
- other people who feel at risk
- other people who'd like to operate

**They will say it is not “valid” .....**



# NOT **VALID**?

- your patent must be “valid”
- the Patent Office examines it to see whether it seems to be “valid”
- plus, anybody can challenge whether it is “valid”



# SO.....WHAT MAKES A PATENT “VALID”?

- your invention as defined in your patent must be new (“novel”) and not obvious (“inventive step”)
- your patent must give enough technical information (“sufficiency”)
- you haven’t made a dodgy change of wording (“added subject matter”)



# WHEN WOULD YOU NEED TO DEFEND A PATENT?

## BEFORE GRANT

- during the examination by Patent Offices:
  - the UK-IPO (UK Intellectual Property Office)
  - the EPO (European Patent Office)
  - others



# WHEN WOULD YOU NEED TO DEFEND A PATENT?

## AFTER GRANT

### EPO

- “opposition” – for all countries
- must file within 9 months of grant
- 6% are opposed

### UK-IPO

- national “revocation” attack – before the UK-IPO or Court
- rare – usually occurs when infringement is alleged



# WHEN WOULD YOU NEED TO DEFEND A PATENT?

## IN A COMMERCIAL SITUATION

- in licence or sale negotiations
- the potential buyer or licensee may try to find fault to reduce payment



# HOW DO YOU DEFEND A PATENT?

## MAKE A GOOD START

- make a good invention!
- file a careful and thorough initial patent application – the best you can

*This is the **most important** slide!*



# WHAT IS A GOOD PATENT APPLICATION?

- good in describing the invention
- good in saying what's new (“claims”)
- good in identifying any underlying principles
- **contains tapering definitions of the invention and its components, e.g. *R<sup>1</sup> is an alkyl group, preferably C<sub>1-8</sub>alkyl, preferably C<sub>1-4</sub>alkyl. A preferred alkyl group is an n-alkyl group, or ethyl, or, especially, methyl. An alkyl group R<sup>1</sup> may be unsubstituted, or substituted by.....***



# HOW DO YOU DEFEND A PATENT?

## DURING EXAMINATION

- when the Patent Office examine your invention they involve you: participate constructively
- if you have to amend your patent application do it very carefully; do not add information; do not “spin”



# HOW DO YOU DEFEND A PATENT?

## AFTER GRANT

- a challenge may probe the 4 key issues (new, inventive, etc). Fight it off, or amend (or negotiate?)
- if you learn – from a challenger or just from own knowledge – that your patent falls short: amend it
  - *can amend GB patent at the UK-IPO after grant*
  - *can amend EPO patent at the EPO after grant*



# How to Successfully Defend a Patent

- Questions?

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