

## United Kingdom

### Administrative procedure

Patents granted by the Intellectual Property Office (hereinafter the “IPO”) cover England, Wales, Scotland, Northern Ireland and the Isle of Man. The IPO also operates as a tribunal dealing with ownership issues (e.g. entitlement, inventorship, compensation of employees, joint applicant disputes), technical issues (e.g. revocation, declarations of non-infringement) and licences (e.g. applications to decide on the terms of licences which can be given under a patent and applications for a compulsory licence under a patent). The IPO also decides various opposition matters, e.g. opposition to post-grant corrections and amendments, and surrender.

### Opposition

No pre-grant opposition procedure is available. A third party may only file pre-grant observations on the patentability of the application (Section 21 PA). The IPO will consider such observations, but the observing party does not become a party to the proceedings.

No post-grant opposition to the grant of a patent is available; however, third parties may seek revocation of a patent (see below) and may oppose certain post-grant actions.

### Appeal

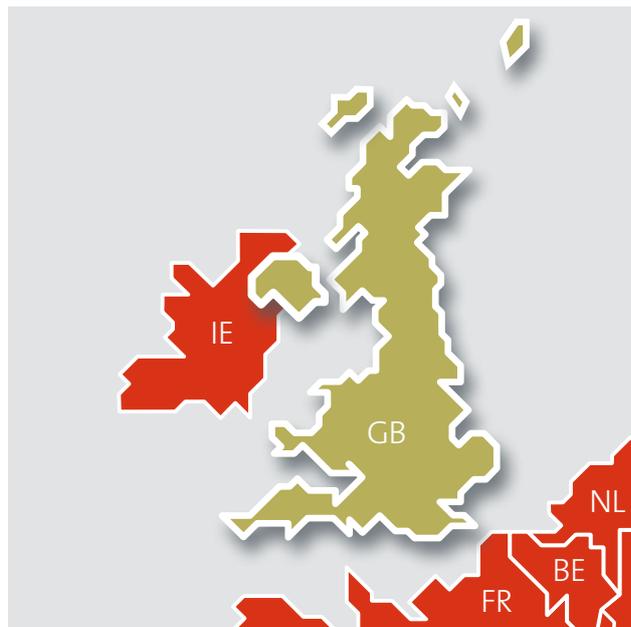
An appeal against decisions of the IPO must be filed with the Patents Court (Section 97(1) PA), unless the proceedings have been held in Scotland, in which case appeal lies with the Outer House of the Court of Session (Section 97(4) PA).

The period for filing an appeal is specified in the decision by the Hearing Officer responsible for that decision; this is usually set at 28 days from the date of the decision. Permission to appeal is not required.

### Revocation

The validity of a patent may be challenged before the IPO (in its capacity as a tribunal).

Anyone may apply to revoke a patent (Section 72 PA).



The IPO may also revoke patents on its own initiative

- (i) where the invention formed part of the state of the art under Section 2(3) (Section 73(1) PA);
- (ii) where there is a GB patent and a European patent (UK), the patents being for the same invention with the same priority date and the applications having been filed by the same applicant or his successor in title (Section 73(2) PA); or
- (iii) where a non-binding opinion of the IPO indicates that the patent is not valid due to lack of novelty or inventive step (Section 73(1A)-(1C) PA).

In all cases, before any revocation occurs, the proprietor of the patent is given an opportunity to make observations and/or to amend the specification so as to exclude any matter which may give reasons for the revocation or so as to prevent there being two patents for the same invention.

### Civil procedure

#### Infringement

Patent infringement is not a criminal offence. The patent owner or exclusive licensee may bring a civil action to the court of their choice (Sections 61(1), 66, 67 PA). The proceedings may be instituted against any person who is

alleged to have performed an act of direct or indirect infringement under Section 60(1), (2) PA.

The IPO can also hear infringement claims if the parties agree on that course of action (Section 61(3) PA), but in practice this has never happened.

If it appears to the IPO that the question of infringement referred to it would more properly be determined by the court, it may decline to deal with it, and the court then has jurisdiction to determine the question (Section 61(5) PA).

The United Kingdom comprises three separate jurisdictions:

- a) England and Wales – as shown in the diagram;
- b) Scotland – patent actions are brought before the Outer House of the Court of Session, with appeals being heard by the Inner House; and
- c) Northern Ireland – patent actions are brought before the Northern Ireland High Court, with appeals being heard by the Northern Ireland Court of Appeal.

All three jurisdictions have the Supreme Court as the final appeal court.

The Isle of Man is its own jurisdiction, and patent actions are brought before the High Court of Justice of the Isle of Man.

For England and Wales: in relation to patent disputes, there is no formal separation of jurisdiction between the Intellectual Property Enterprise Court and the Patents Court, and both form part of the Chancery Division of the High Court.

Normally, less complicated cases will be considered by the Intellectual Property Enterprise Court. There is no legal limitation on jurisdiction due to the complexity of the facts but it will only consider cases up to GBP 500 000 in damages (unless the parties agree otherwise). Costs are capped for each stage of a case, with a maximum total cap of GBP 50 000 for the case as a whole. The Intellectual Property Enterprise Court cannot consider appeals on decisions by the IPO.

The Patents Court has the jurisdiction to transfer to the Intellectual Property Enterprise Court any proceedings which it is satisfied should have been filed there. The Intellectual Property Enterprise Court may also transfer proceedings to the Patents Court. If a party wishes proceedings transferred from one court to another, it needs to make an application to the court that currently has jurisdiction over the proceedings.

## Nullity/counterclaim for revocation

Invalidation of a patent may be used as a defence in an infringement action and the defendant may counterclaim for revocation of the patent. Both validity and infringement are handled within the same action, although case management decisions by the court may lead to one being decided before the other.

If validity is put in issue in infringement proceedings and it is found that the patent is only partially valid, the court or the IPO may grant relief only in respect of the part of the patent which is found to be valid and infringed, or reduce the damages accordingly (subject to further conditions – Section 63 PA).

Standalone actions for invalidity of a patent may be brought before the IPO, the Intellectual Property Enterprise Court or the Patents Court.

Anyone may apply to revoke a patent (Section 72 PA).

In any action involving invalidity, the proprietor of the patent is able to request amendment of the specification so as to exclude any matter which may give reasons for the revocation. If the action is before the court, the IPO must be notified, so that the amendment can be advertised for possible opposition (Section 75 PA).

## Remedies

The court may order an injunction against future infringements, compensation by damages or an account of profits, delivery up or destruction of infringing materials. The court will not, in respect of the same infringement, both award damages to the proprietor of a patent and order that they be given an account of the profits (Section 61(2) PA).

The IPO has more limited remedies available than the courts – the proprietor of the patent may only make claims for damages and/or for a declaration that the patent is valid and has been infringed (Section 61(3) PA).

## Other actions

A declaration 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 IPO in proceedings between the person performing or proposing to perform the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor (Section 71 PA).

A person who, in good faith and before the priority date of the invention, carries out an act which would constitute an infringement of a patent granted for that invention, or makes effective and serious preparations to do so, has the right to continue to do so even if such a patent has been granted. However, this does not extend to licensing another person to do that act, except in specific circumstances (Section 64 PA).

A claimant can choose to launch proceedings before either the IPO or the courts in a dispute concerning employee compensation (Section 40 PA).

## Appeal

Appeals from decisions of the IPO go to the Patents Court (Section 97(1) PA). Permission to appeal is not required.

Appeals from decisions of the Intellectual Property Enterprise Court go to either the Chancery Division of the High Court (for interim orders) or the Civil Division of the Court of Appeal (for final orders). Permission is required, either from the deciding judge or the appeal court.

Appeals from decisions of the Patents Court go to the Court of Appeal (Civil Division). There is no automatic right of appeal; a party must ask the trial judge for permission. If permission is refused, an application for permission can be presented to the Court of Appeal, where a single Lord Justice will consider whether to grant permission to appeal.

Where the Patents Court decision is an appeal from a decision of the IPO, only certain decisions can be the subject of a further appeal to the Court of Appeal (Section 97(3) PA).

The appeal panel of three judges normally includes a judge specialised in patent cases. An appeal is not a rehearing; facts are taken to be as found by the judge at the first instance, and the appeal examines whether that judge correctly applied the law to those facts.

Further appeal can be filed with the Supreme Court. Permission to do so is given by either the Court of Appeal itself, or by the Supreme Court on application to it. The appeal can only be on an important question of law.

In certain circumstances, it is possible to appeal directly from the Patents Court to the Supreme Court.

## Parallel proceedings

A decision on whether or not to stay national proceedings where EPO proceedings are underway is made on a case-by-case basis; the default option is to grant a stay, and it is for the party resisting to show why it should not be granted. A number of factors are considered, with the ultimate question being where the balance of justice lies.

## Arbitration/mediation

Parties are strongly encouraged by the courts to resolve civil disputes before litigation, particularly through use of alternative dispute resolution (ADR), and this includes patent proceedings. Not doing so does not affect the merits of the case, but may have implications for costs following a court judgment.

There are no mandatory authorities for ADR, and parties are free to choose the type and provider of ADR they wish to use; the Patent Office offers mediation as a commercial service.

## Enforcement

Enforcement of civil judgments is not automatic; the person awarded the judgment must apply to the court for the order to be enforced. There are various options available for enforcement, including execution against goods, imposing a charge against assets, and freezing bank accounts.

Because of the United Kingdom's multiple jurisdictions, the mechanism for enforcement of civil judgments depends on the jurisdiction the enforcement takes place in:

- In England and Wales, court bailiffs and Enforcement Officers are responsible for carrying out an enforcement order.
- In Scotland, Sheriff Officers and Messengers-at-Arms have responsibility.
- In Northern Ireland, this is the responsibility of the Enforcement of Judgments Office.
- In the Isle of Man, Coroners and Lockmen act to execute enforcement orders.

The nature of the enforcement proceedings will also depend on where the order has originated (whether the enforcement is across jurisdictions, for example); however, there is no difference between enforcement of an interim order and a final judgment.

The IPO has no powers to enforce its judgments; enforcement must be done by the courts.

### Relevant national law

Patent Act 1977 as amended (October 2014) [cited as: PA]

### Compulsory licence

Compulsory licences may be granted by the IPO (Section 48 PA). An application may not be made before three years have elapsed from grant of the patent. Grant of a licence may be opposed by any person, not just the proprietor of the patent (Section 52 PA).

### Competent authorities or courts (England and Wales)

