



Myerson Intellectual Property

Claimant's guide to
patent disputes

0161 941 4000
myerson.co.uk
lawyers@myerson.co.uk



Welcome

We understand the complexities of modern life and the importance of taking care of your business interests. So it's a deep source of satisfaction that so many businesses choose Myerson as their trusted adviser.

Why Myerson?

At Myerson, our expert patent infringement solicitors are here to listen, help you and have years of experience in dealing with complex patent cases. Due to the complex and technical nature of patent claims, we always review any case on first instruction and provide you with an overview of all potential options available.

We are proud to be ranked as **'Top Tier'** in the prestigious international directory **The Legal 500**, and commended by The Times **'Best Law Firms 2019'**. This means you can be certain that you will be receiving the highest quality legal advice and that we can advise you on complex patent issues.

Through our many years of service, we have developed close working relationships with trademark and patent attorneys and regularly liaise and work with them on a wide range of intellectual property issues such as patents and when disputes arise in relation to patents. These working relationships are a key element of the service we offer to our clients and which benefits our clients.

You can find out more about our Intellectual Property Team by clicking [here](#).



How We Work.

Every client and every case is different, and we are here to support you every step of the way.

Personal, Partner-led Service. Our experienced solicitors get to know you and your business inside out, so we can best advise you. We know that dealing with litigation can be stressful and we aim to take that stress away from you. We strive to become your trusted advisers, providing value and most of all, a genuine, personal service.

The Highest Level of Expertise. Combining commerciality, practicality and legal expertise enables us to deal with design right disputes in the most effective way.

We are also a member of the **Intellectual Property Lawyers Association** (IPLA), which is an association of law firms with an established IP department. Our membership provides both us, and our clients, with access to a wealth of knowledge and expertise relating to intellectual property.

A Team You Can Trust. We help clients nationwide with complex patent cases, acting for businesses who are both bringing and defending patent right claims. You can rest assured that our expert team knows its stuff!



Your Solicitors



Tim Norman

Senior Partner
Commercial Litigation

0161 941 4000
tim.norman@myerson.co.uk



Vicky Biggs

Senior Associate
Commercial Litigation

0161 941 4000
vicky.biggs@myerson.co.uk

The solicitors that will be working with you are specialists.

All of the solicitors in our Intellectual Property Disputes Team are specialists and have a detailed understanding of patents and how to handle business disputes involving patents.

Your matter will be handled discreetly and efficiently and overseen by **Tim Norman**, a Senior Partner in our Commercial Litigation Team.

Your team of solicitors will provide practical advice and work with you to deal with your patent dispute in the best way possible. This means you can concentrate on what's important, running your business.

You can find out more about our Intellectual Property Team by clicking [here](#).

0161 941 4000
myerson.co.uk
lawyers@myerson.co.uk



Our guide to patent disputes

What are patents?

Patents provide inventors with a legally protectable monopoly over their inventions and protect new and innovative technical features of products and processes.

Patents generally last for a limited period of 20 years, depending on the country.

To qualify for patent protection, an invention must be:

- New;
- Involve an innovative step;
- Be capable of industrial application; and
- Not specifically excluded from protection.

To obtain a patent, an application for a patent needs to be filed; this will normally be with the patent office of the country where the inventor works.

Patents can provide a high level of protection and are highly important in some industries; this is clearly seen in the case of pharmaceutical companies, who spend millions of pounds and extensive time on research and development.

The process for registering a patent is not easy and can be expensive. It also exposes a product to competitors through public disclosure of the technology behind it without the competitor breaching the patent.

Types of patent infringement

There are two types of patent infringement:

1. Direct infringement, meaning acts done directly to patented products or patented processes.
2. Indirect infringement, meaning acts done indirectly to patent products or patented processes.

In regard to direct infringement, this covers activities relating to patented products, use of patented processes, offering patented processes for use and products obtained directly through patented processes.

Products


Where the patented invention is a product, direct patent infringement occurs when the defendant:

- Makes the product;
- Disposes of the product (i.e. putting them on the market in the course of trade);
- Offers to dispose of the product;
- Uses the product;
- Imports the product; or
- Keeps the product.

Processes

Where the patented invention is a process, direct patent infringement occurs when the defendant:

- Uses the process;
- Offers the process for use in the UK and the defendant either knows, or it would be obvious to a reasonable person in the circumstances, that use of the patented process without the consent of the proprietor would be an infringement of the patent;
- Disposes of the process;
- Offers to dispose of the process;
- Imports the process; or
- Keeps the process.



A defendant may be guilty of indirect patent infringement where all of the following apply:

- the defendant supplies or offers to supply in the UK a person with any of the means relating to an essential element of the patented invention for the purpose of putting the invention into effect.
- either the defendant knows or it must be obvious to a reasonable person in the circumstances that the means are suitable for putting, and are intended to put, the invention into effect in the UK.
- the person supplied with the information or to whom the offer is made is not a licensee or another person entitled to work on the relevant invention.

How to bring a patent infringement claim

Specialist advisors


Claims relating to patents can be extremely technical and complex meaning they are often dealt with by specialist courts in both England and Wales. For this reason, we always recommend that claimants in patent infringement proceedings instruct specialist intellectual property solicitors.

It is also quite common for a specialist intellectual property barrister to be instructed as well in order to advise claimants in patent infringement proceedings, assist with the drafting of necessary court documents and to represent claimants in court.

To make a claim, the claimant must be the proprietor of the patent or a co-owner of the patent or an exclusive licensee.

Letter of claim

If infringement proceedings are contemplated, a claimant should first write a letter of claim to the potential defendant(s).



The letter of claim must sufficiently identify the relevant patent(s) to enable the defendant(s) to evaluate them and formulate a view on infringement. The best way to do this is to provide copies of the relevant patent(s).

All parties involved in patent infringement claims are expected to act reasonably in exchanging information and evidence prior to court proceedings being issued.

Court proceedings

If the claim cannot be resolved, then it is likely court proceedings will need to be issued. High value claims for patent infringement are brought in the High Court, specifically in the Intellectual Property List of the Business and Property Courts. Lower value claims are brought in the specialist Intellectual Property Enterprise Court (IPEC) where capped costs operate.

IPEC also has its own small claims track which deals with patent infringement cases which are worth less than £10,000.

To issue court proceedings, specific court documents will need to be drafted. These are normally a claim form and particulars of claim. There will also be a court fee payable to issue court proceedings which depends on the value of the claim and the relief sought.

We always recommend that a barrister drafts these documents with assistance from a solicitor to ensure they comply with court rules. These documents will identify the parties, state the cause(s) of action and the remedies sought.

The defendant(s) will then be given an opportunity to file and serve a defence to the claim (generally within 28 days of court proceedings being issued but extensions of time can be agreed).

After that, the Court is likely to order the parties to take the following steps to prepare the case for trial:

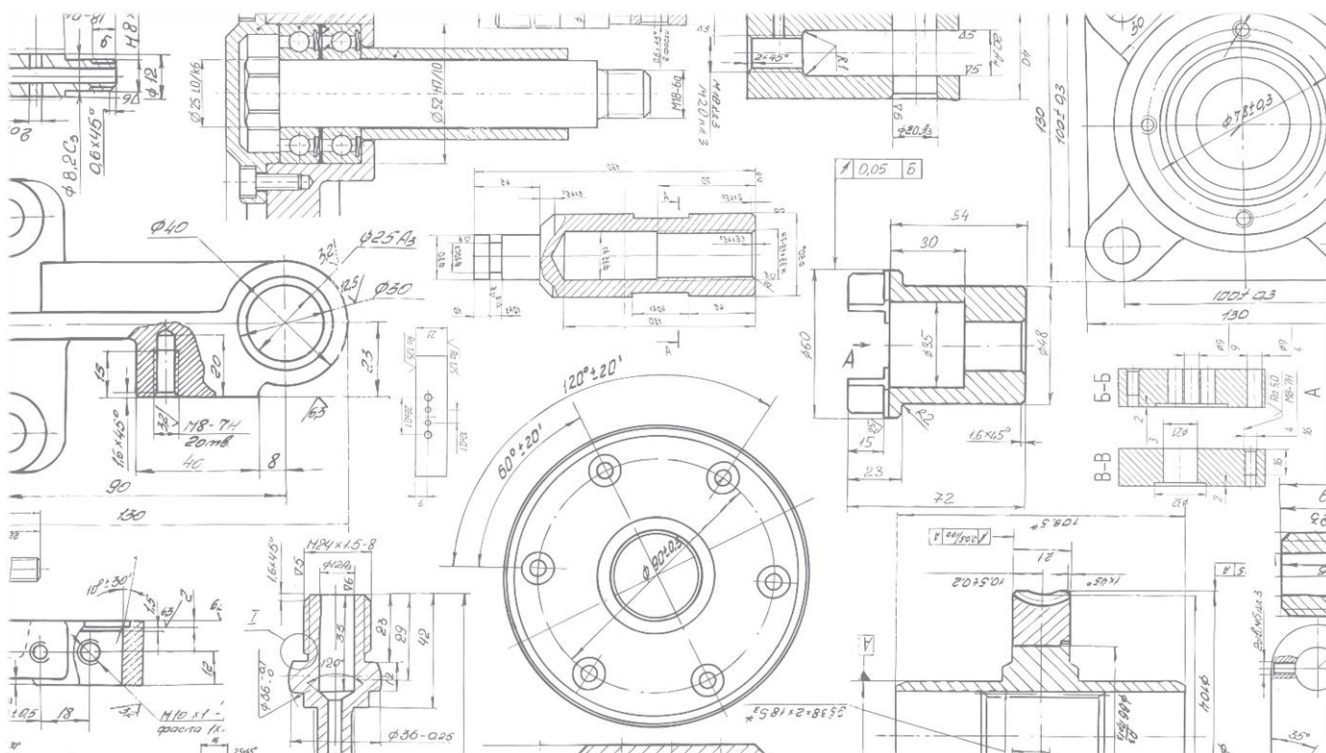
- disclosure of documents,
- witness statements; and
- experts reports.


It is our experience that most patent infringement cases settle without the need for there to be a trial.

Remedies available for a successful claim

There are several remedies available for claimants when a claim for patent infringement is successful. These are as follows:

- Obtaining an injunction restraining the defendant from committing any type of patent infringement;
- Obtaining a court order that the defendant deliver up or destroy any infringing product or article related to the patented product or process;
- Damages or an account of profits relating to the infringement;
- A declaration that the claimant's patent is valid and has been infringed by the defendant;
- Publication of the Court's judgment setting out the infringement that has occurred; and
- Recovery of costs incurred in bringing the patent infringement claim.





Don't just take our word for it...

"Myerson Solicitors LLP has a really strong IP team which is growing".

"The team represents International Pastry Concepts LLC (a New York-based pastry house which invented the Cronuts products that are sold worldwide) on various matters such as enforcing international trademarks".

"The team has an excellent way of dealing with clients and managing cases generally, as well as good judgment – they know when to push, and when to take the victory".

"The firm has a huge range of satisfied clients from all over the country, despite not being the most high profile of firms, so they must be doing something right".

"The team are phenomenally hard workers who produce first-class written work, even from difficult clients".

"Fantastic service and excellent communication throughout the process. I would highly recommend and use their service again".

To view more Myerson reviews visit our Review Solicitors page by [clicking here](#).

You're in safe hands!

If you would like further information about how we can help you with your patent dispute, or if you have any questions, please do not hesitate to contact a member of our Intellectual Property Disputes Team today.

Call: 0161 941 4000

Click: myerson.co.uk

Email: lawyers@myerson.co.uk



Because
life is rarely
black and
white.



myerson



Myerson Solicitors LLP

Grosvenor House, 20 Barrington Road, Altrincham WA14 1HB
Tel: 0161 941 4000 | Fax: 0161 941 4411 | DX19865 Altrincham
lawyers@myerson.co.uk | www.myerson.co.uk | [@myersonllp](https://twitter.com/myersonllp)

Myerson is the trading style of Myerson Solicitors LLP, a limited liability partnership registered in England & Wales number OC347078, whose registered office is as above. This firm is authorised and regulated by the Solicitors Regulation Authority number 515754. VAT Registration number 380 4208 70. Any reference to a partner means a member of Myerson Solicitors LLP. A list of members is available for inspection at our registered office.