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Myerson **Business**

Claimant's guide to patent disputes

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Welcome

Copyright protects against the copying and unauthorised use of another's work. It is important to understand what rights you have when you create original work and how you can stop this from being exploited without your consent. Copyright disputes can happen due to numerous different reasons. However, the fundamental issue of copyright infringement is whether the work being disputed was protected and whether the new work is breaching any protection due to similarity.

Why Myerson?

Our expert copyright infringement solicitors are here to listen and advise you, we have years of experience in dealing with complex copyright cases. After we have reviewed your matter, we will provide you with all the potential options available. There are many remedies available, all of which will be discussed with you so you can make an informed decision. Throughout the process, we will stand by your side, making sure that you are effectively protected and fighting for the right outcome.

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 2023**'. So, you can be certain that you will be receiving the highest quality legal advice and that we can advise you on complex copyright issues.

Myerson is also the Manchester and Cheshire law firm member for the **MSI Global Alliance**, a top 20 ranked, leading, international association of independent professional firms. As the copyright matters, we deal with often involve an international element, we can call upon the expertise and knowledge of our fellow MSI members to ensure that our client's global interests are protected. You can **find out more about our Intellectual Property Team by clicking here.**



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.



Letters of Claim

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

This letter of claim should put the defendant(s) on notice of a claim and give the defendant(s) a reasonable amount of time (normally between 7 and 21 days) to 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.



You're in safe hands!

If you would like further information about how we can help you with **Patent Disputes**, or if you have any questions, please don't hesitate to contact a member of our **Commercial Litigation Team** today.

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