

What to do if Threatened with Infringement

Patents are a form of intellectual property (IP) right that give their owner exclusive territorial jurisdiction over the invention claimed. If a patent holder asserts that your activities risk infringing their patent rights then you will need to assess the situation quickly with professional advice e.g. from a qualified patent attorney.

What are patent rights?

A patent granted in the UK gives its owner exclusive rights to the patented product or process. Patents may be in force for up to 20 years. Only those with permission, e.g. licence holders, have a freedom to operate the protected technology during that period.

How can my activities infringe a patent?

Any commercial activities in the UK that involve making, supplying, selling, using or importing a patented invention can count as a direct infringement of the patent rights. Even providing part of the patented technology to another party, or working with someone such as a customer to put on the market something which is covered by a patent, may count as a form of infringement. Innocence is no defence to infringement, although if you had no prior knowledge of the existence of the patent then the level of damages awarded against you maybe lower if such ignorance was reasonable.

What actions may be taken against me?

Patent holders have the right to exercise their IP rights and to stop any activities which do not have their permission. If you are bringing goods into the country which are suspected to infringe a patent then they may be seized and detained by customs officers. If you have been carrying out infringing activities then the patent owner may seek compensation by applying to the courts. A court action could result in an injunction against you. Any infringing goods may be taken and destroyed. You may also be ordered to pay damages or give back an account of profits from your infringing activities.

Can I negotiate with the patent holder?

The Courts in the UK encourage parties to reach a negotiated settlement before resorting to litigation. You should therefore be given an opportunity to do this before litigation is commenced but it is important that you act quickly and seek immediate professional advice on this.

A commercial agreement with the IP rights owner will often be preferable for both sides as it avoids the time, expense, interruption and potentially bad publicity of being involved in legal action. If your businesses do not overlap then the patent owner may be willing to give you permission to operate e.g. within certain non-conflicting bounds in return for royalty payments. However this could still work out less costly than defending court proceedings or designing alternative technology outside the scope of the patent rights.

If you are able to produce evidence that the patent is invalid, or is likely to be, it may be possible to negotiate a lower or even zero royalty rate.

How do I know whether a patent is valid?

There is a presumption that a granted patent is valid until proved otherwise. However, although UK patents are examined before they are granted this does not necessarily mean that they are valid e.g. because the IP Office may not have had all relevant evidence before it at the time of examination. A patent attorney can help you to analyse a patent and advise whether there may be grounds to argue for invalidity. Having a professional search carried out may assist with this.

What if I have my own patent the technology?

Although you may have secured your own patent rights for an innovation in the same field, this does not necessarily mean that you have the freedom to operate without infringing other existing IP rights. However, if you evaluate your own IP assets then you may find there is an overlap which would allow you to cross-licence with another patent owner. This could work to the advantage of both parties.

How do I know what is protected by a patent?

The scope of any patent rights is defined by the claims to protection in the granted patent. As patents are often complicated documents requiring both technical and legal expertise to be interpreted reliably, you should seek the professional advice of a qualified patent attorney. He or she will be able to assess what is covered by the patent and advise whether your activities fall within that.

Can I claim compensation if I have been threatened unfairly with patent infringement and my business has been affected?

Yes, there are provisions in UK patent law to provide remedies where groundless threats of infringement are made against innocent parties and damage is caused. A patent attorney or IP lawyer can advise whether this applies to you.

How can I prevent myself from being threatened again?

To help you identify any potential conflict with existing patent rights you can carry out clearance searches for any new technology that you plan to bring to market. By seeking advice from an IP professional on your freedom to operate before you launch, there is less chance of being caught unaware and threatened with patent infringement.

Further advice

The patent attorneys at Dehns have considerable experience in advising small and medium enterprises in contentious patent situations and can give an honest, practical assessment of your options. Where necessary we can represent you in Court proceedings and instruct solicitors and barristers as required.



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