

# BRIEFING: What to do when your patent application is apparently “knocked back”

When a patent application is filed, it is rarely certain what relevant prior art may be revealed in the Search Report. In most cases, the patent office concerned will cite “category X” or “category Y” documents (that is documents believed to be directly relevant to the subject matter of one or more of the claims) against some, or all of the claims of the patent application. When this happens, the Applicant has several options:

The first thing to keep in mind is that the Examiner's *opinion* is just that – a rebuttable opinion, which means that in some cases it is possible to overcome an apparent lack of novelty or inventiveness by argumentation alone. In most cases, however, the claims will have been drafted deliberately broadly to draw a wider search of the subject matter, and in that case, the claims may be broader than the actual inventive contribution justifies. In that case, or indeed if some hitherto unknown prior art is cited, it is often necessary to restrict the scope of the claims. Restriction can take the form of combining some of the claims to identify a new and non-obvious combination of features, or it could involve inserting clarifying amendments based on portions of the description. In either case, the amendments must be based fairly on the subject matter contained in the application as filed, so as not to introduce any new information. In most cases, there will be at least one claim against which no prior art has been cited, and in this case, a potentially allowable amendment could be formulated by combining one of the main independent claims with a dependent claim against which there are no citations.

In rare cases, however, the subject matter of all of the claims may be deemed to be lacking in novelty and/or inventiveness, in which case, the Applicant's options are somewhat restricted. Moreover, there are certain cases in which the subject matter of the invention is deemed to be unpatentable, *per se*, as can happen in the fields of computer-implemented inventions, business methods, games, surgical techniques, etc.

It should also be noted that the patentability “bars” differ from country to country. For example, the UK and Europe prohibits patents for computer programs and business methods *per se*, but there is no such bar in the US, for example. In addition, whilst the UKIPO and EPO have very similar patentability requirements, the implementation of the UK Act is much stricter than in the EPO. It is therefore sometimes possible that a UK application will be refused, but that an *identical* European Patent will be granted, which is legally enforceable in the UK in exactly the same way as a “direct” UK patent. As such, even though the grant of a UK or European patent may be precluded, there may be scope for obtaining patents that are legally enforceable in other countries or via different routes. Either way, and regardless of the eventual fate of the UK/European application, the application will nevertheless provide a priority filing date to which corresponding overseas applications filed within one year can effectively be backdated.

As such, it is sometimes possible that the invention will be apparently unpatentable, in other words, the prospects of prosecuting the application to grant in a commercially useful form, are slim. So, what should the Applicant do if/when such a situation arises?

The fact that a patent application has been filed enables the Applicant to market the product to which the application relates as a “patent pending” product. This can provide a useful commercial advantage because it may deter would-be copiers from copying the technology concerned for fear that the application may grant, and their activities could be deemed to infringe.

In the UK, it is possible to keep a patent application pending for up to 4 ½ years from its filing date. Somewhat perversely, the UKIPO Examiners only have the power to grant patents, and not to refuse them. Therefore, provided the necessary steps are taken to keep the application “alive”, that is to say, the Examination fees are paid, responses are timely filed, and so forth, the application can remain “pending” until it reaches the 4 ½ year cut-off. Whilst a pending patent application does not confer any right on the Applicant to sue for infringement, the publication of an application confers “provisional protection” as of its publication date. The provisional protection effectively allows patentees to make a backdated claim for damages should the patent eventually grant, and be infringed. As a competitor wishing to copy a “patent pending” technology, this muddies the waters considerably because until such time as the application is either granted or refused, its scope is uncertain (the Applicant is allowed to amend the scope of his claims, within the ambit of the application as filed, until such time as it is granted or refused), which prevents the competitor from obtaining any degree of certainty about his/her potential liability for infringement. Indeed, it is a well-known strategy to keep at least one patent application pending precisely so that it can be amended to cover what competitors are doing. This is often achieved by obtaining a granted patent of a certain scope, but filing an identical, “divisional” application that is kept pending for as long as possible.

If one puts oneself in the shoes of a competitor wanting to go to market with a potentially infringing product, you quickly realise the value of an uncertain patent application. At the very least, the competitor will need to spend a significant amount of money seeking patent attorney's and/or counsel's opinion on the likelihood of 1) a patent ever granting in a valid and enforceable state, and 2) infringement should the application ever mature into a granted patent. In any event, the competitor will have no way to be *certain* whether what he/she plans to do may land him/her in hot water at a later date!

With that in mind, there are several ways to keep a patent application pending. The first, in the UK, is to respond to Official Actions and to pay the requisite fees when they are due. This can keep a UK application pending for up to 4 ½ years, as previously stated. In addition, a PCT application can effectively “buy more time”, extending the 1-year cut-off for filing overseas, to 30+ months (deepening on the countries concerned). A PCT application is a single application filed at the World Intellectual Property Office, which is equivalent to having filed a national/regional application in 140+ countries, including most of the major industrialised nations. At the 30-month stage, one has the option to convert the PCT application into a bundle of national/regional applications, which can themselves also be kept “pending” for several years.

All the time that there is a pending application in place, the Applicant can create uncertainty in the marketplace, which may be all that is needed to gain a competitive edge by being first-to-market. Moreover, it may be possible to obtain a granted patent in certain countries thereby securing legally enforceable rights.

Finally, there are certain jurisdictions, notably in Europe, that permit conversion of IP rights into other forms in the event of refusal. Specifically, one could apply for a patent in the UK, file a PCT application at the 1 year stage, and enter the European Regional phase at 31 months. European prosecution could take several years before the application is either granted (in which case all well and good), granted and successfully opposed, or refused outright. If the European application or patent is refused or revoked, there may still be an option to convert the “failed” European application or patent into a national right, such as a German “Gebrauchsmuster” (Utility Model).

This briefing paper is for information only and is intended to provide a basic overview of some of the procedures and options available. It is not legal advice, and should not be relied upon as such because the facts of each specific case will determine what is possible and where. For more information, please contact us.