

8 NEW SQUARE
INTELLECTUAL PROPERTY

CIPA FOUNDATION LECTURES

Claim Construction & Scope of Protection

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Interpretation and meaning of words

Living for Sabina meant seeing. ... Cemeteries in Bohemia are like Gardens. The graves are covered with grass and colourful flowers. Tombstones are lost in the greenery. When the sun goes down, the cemetery sparkles with tiny candles. It looks as though the dead are at a children's ball. ...

For Franz a cemetery was an ugly dump of stones and bones.

A Short Dictionary of Words Misunderstood
The Unbearable Lightness of Being by Milan Kundera

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European Patent Convention

Article 69(1), EPC 2000

- (1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

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European Patent Convention

Protocol on the interpretation of Article 69, EPC 2000

Article 1 – General Principles

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. ...

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European Patent Convention

Protocol on the interpretation of Article 69, EPC 2000

Article 1 – General Principles

... Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. ...

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European Patent Convention

Protocol on the interpretation of Article 69, EPC 2000

Article 1 – General Principles

... On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

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European Patent Convention

Protocol on the interpretation of Article 69, EPC 2000
'Article 2 – Equivalents

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.'

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Catnic v. Hill and Smith [1982] RPC 183

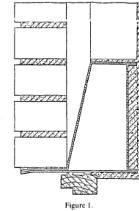
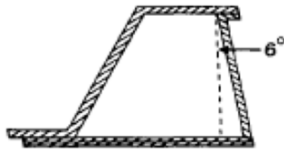


Figure 1

A lintel for use over apertures in cavity walls having ...
... and a second rigid support member extending vertically
from or from near the rear edge of the first horizontal plate
or part to join with the second plate or part adjacent its rear edge.

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Catnic v. Hill and Smith [1982] RPC 183



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Catnic v. Hill and Smith [1982] RPC 183

"Put in a nutshell the question to be answered is:

Would the specification make it obvious to a builder familiar with ordinary building operations that the description of a lintel in the form of a weight-bearing box girder of which the back plate was referred to as "extending vertically" from one of the two horizontal plates to join the other, could not have been intended to exclude lintels in which the back plate although not positioned at precisely 90° to both horizontal plates was close enough to 90° to make no material difference to the way the lintel worked when used in building operations?

No plausible reason has been advanced why any rational patentee should want to place so narrow a limitation on his invention. On the contrary, it would render his monopoly for all practical purposes worthless, since any imitator could avoid it and take all the benefit of the invention by the simple expedient of positioning the back plate a degree or two from the exact vertical."

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Improver v Remington [1990] FSR 181

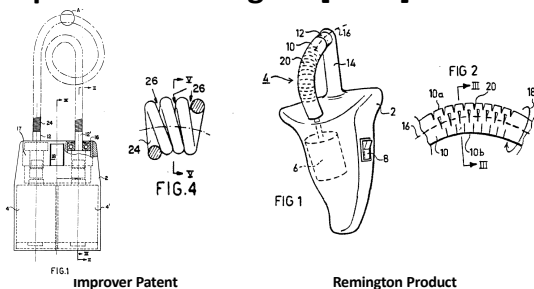


FIG 3
Improver Patent

FIG 1
Remington Product

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Improver v Remington [1990] FSR 181

- (1) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no —
- (2) Would this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art? If no, the variant is outside the claim. If yes —
- (3) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, the variant is outside the claim.

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Improver v Remington [1990] FSR 181

On the other hand, a negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a figurative meaning (the figure being a form of *synecdoche* or *metonymy*) denoting a class of things which included the variant and the literal meaning, the latter being perhaps the most perfect, best-known or striking example of the class.

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Kirin Amgen v. Hoechst Marion Roussel [2005] RPC 9 (HL)

There is only one compulsory question:

‘What would a person skilled in the art have understood the patentee to have used the language of the claim to mean?’ [69]

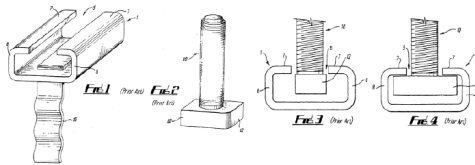
Equivalents as a guide to construction:

the Improver Questions were guidelines, more useful in some cases than in others, ... ‘which will in appropriate cases help to decide what the skilled man would have understood the patentee to mean’ [52].

Construction

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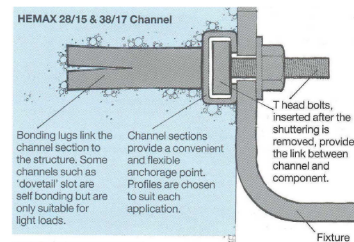
Ancon v. ACS Stainless Steel Fixings [2009] All ER (D) 148 (CA)



Construction

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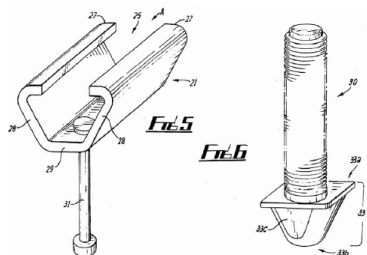
Ancon v. ACS Stainless Steel Fixings



Construction

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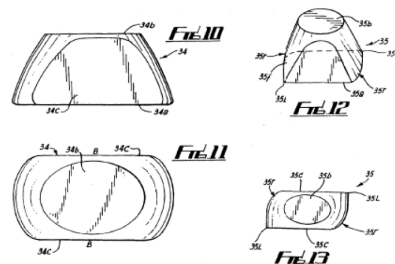
Ancon v. ACS Stainless Steel Fixings



Construction

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Ancon v. ACS Stainless Steel Fixings



Construction8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**Claim 1 – **Channel assembly** comprising

- [v-shaped channel]
- [fixing having a **head with inclined sides**]

*'characterised in that**the head has a generally elliptical cone shape'***Construction**8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**

- alleged infringement

**Construction**8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**

Cross examination of Ancon's Expert

Q. "...this cannot be a generally elliptical cone?"

A. "Yes."

Construction8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**

Mr Justice Patten

'the phrase "generally elliptical cone shape" is used to describe shapes, all of which retain the essential feature of an ellipse. ...'

'Although construction is a matter for me, it is not without significance that Mr Harrison was clear in his evidence that what the Patent was teaching the skilled addressee was that some form of elliptical head was required.'

Construction8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**

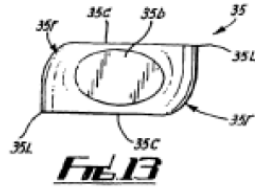
Arguments on appeal

- What skilled addressee would have understood patentee to be using the words of the claim to mean
 - Checking that interpretation using Protocol Questions
 - Taking 'due account' of equivalents in accordance with Art 2 of the Protocol
- all pointed in the same direction

Construction8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**

Lord Justice Jacob

'it is just like an example of fig 13 of the patent but with the top of the head filed down so that there is no ellipse on the top.'

Construction8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings****Construction**8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**

Lord Justice Jacob

'All turns on what Lord Hoffmann called the compulsory question: "what would a person skilled in the art have understood the patentee to have used the language of the claim to mean?" (*Kirin –Amgen* at [69]).'

Construction8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**

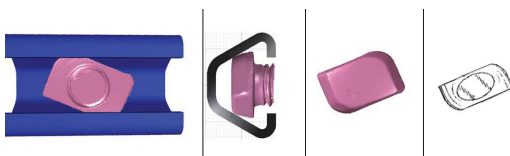
Lord Justice Jacob

'To gain an idea of what such a skilled reader would have understood the patentee to convey by "generally elliptical cone" one needs to think like him.'

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Lord Justice Jacob

'As the bolt is turned, two things happen ...
First the corners (particularly those of fig 13) ***would prevent the head simply rotating*** in the channel – like the rounded corners of the prior art.
Secondly as the head turned there would be the ***camming action*** by which it was forced forward against the inside of the channel.
He would never have seen anything like it before.'

Construction8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings****Construction**8 NEW SQUARE
INTELLECTUAL PROPERTY**Ancon v. ACS Stainless Steel Fixings**

Lord Justice Jacob

'Unlike the "Brighton Rock" of a seaside candy, the oval shape does not run through what is shown: save for very close to the top, the cross sections are not complete ovals – they have the vestiges of an oval.'

Person skilled in the art

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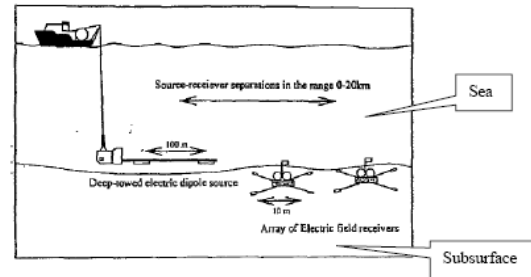
Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

- Controlled Source Electromagnetic surveying – method of detecting hydrocarbon layers
- Is the skilled person the same for all purposes?
- Skilled team – geophysicists, controlled source electro-magnetism specialists or both?

Person skilled in the art

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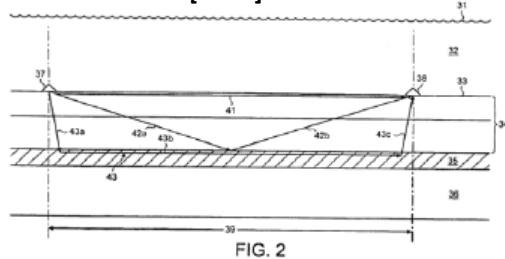
Schlumberger v. Electromagnetic Geoservices [2010] RPC 33



Person skilled in the art

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Schlumberger v. Electromagnetic Geoservices [2010] RPC 33



Person skilled in the art

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Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

Mann J relied on Lord Diplock's speech in *Catnic*
 "The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular word [etc]'

Person skilled in the art

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Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

Jacob LJ

- 'I do not agree that this well-known passage is relevant at all to the point in issue.'
- 'The "person skilled in the art" is explicitly referred to three times in the European Patent Convention'
- '... the Protocol to Art. 69, Art 83 and Art 56'.

Person skilled in the art

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Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

- 'Art 69 and its Protocol are concerned with the scope of the claims – how they are to be interpreted'
- 'Art 83 is concerned with sufficiency of description'
- 'Art 56 is concerned with something different. The question it poses is whether there was an "inventive step"... "having regard to the state of the art" ... So Article 56 is about the position pre-patent.'

Person skilled in the art

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Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

- Jacob LJ reviewed the English and EPO case law.
- 'In none of these cases was it said that there was some sort of universal rule about the nature of the team. In each case it was treated as essentially one of fact depending on the problem in hand.'
- 'for the purposes of obviousness [the Court] will have the regard to reality of the position at the time ... the **combined skills (and mind-sets) of real research teams** is what matters'

Person skilled in the art

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Schlumberger v. Electromagnetic Geoservices [2010] RPC 33

- This is not a different construction being given to the phrase "person skilled in the art" in different Articles of the European Patent Convention.
- The phrase is being applied to different situations.
- The flaw in that argument is to assume that 'the art' is necessarily the same both before and after the invention is made.
- Some inventions are themselves art changing.

Person skilled in the art

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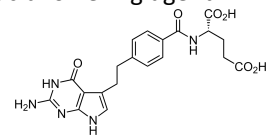
Virgin Atlantic v. Premium Aircraft Interiors [2010] RPC 8 (CA)

- How much patent law and practice is the skilled reader supposed to know?
- Reference numerals.
- Two-part claim.
- Divisional applications.

Actavis v Eli Lilly [2017] RPC 21 (SC) EP 1 313 508

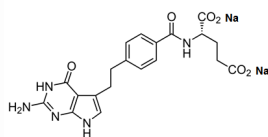
'Combination containing an antifolate and methylmalonic acid lowering agent'

Particular antifolate
- Pemetrexed



Alimta

pemetrexed disodium and vitamin B12
for inhibiting tumour growth



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EP 1 313 508

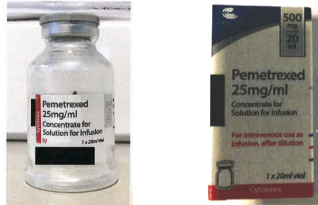
Claim 1

1. Use of **pemetrexed disodium** in the manufacture of a medicament for use in combination therapy for inhibiting tumor growth in mammals wherein said medicament is to be administered **in combination with vitamin B12** or a pharmaceutical derivative thereof ...

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Actavis Proposed Products

pemetrexed diacid, pemetrexed dipotassium,
pemetrexed ditromethamine - with vitamin B12



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Actavis's claim

for declarations of non-infringement (DNIs)
of UK, French, Italian and Spanish designations



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Facts and background

- Pemetrexed disodium had been known for some time to have therapeutic effects on cancerous tumours but with adverse side-effects. The essential disclosure of the patent in issue – European Patent (UK) No 1 313 508 and its corresponding designations in France, Italy and Spain – was that side-effects could largely be avoided if it was administered together with vitamin B12.
- Actavis sought declarations that its proposed products, which were not pemetrexed disodium, did not infringe because Actavis's products instead contained: (a) pemetrexed diacid; (b) pemetrexed ditromethamine; and (c) pemetrexed dipotassium.
- Actavis sought declarations with respect to the UK, Spanish, French and Italian designations where they were planning to launch a rival product.

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Key arguments and decisions of lower courts

- Actavis argued that their products did not infringe because the claims of the patent were limited to a specific pemetrexed salt, namely pemetrexed disodium.
- Lilly argued that the Actavis products infringed because they were medicaments to be used as a treatment for cancer consisting of pemetrexed diacid, or a pemetrexed salt, with vitamin B12, which represents the essence of the teaching and claim of the patent.
- The High Court of England and Wales and Court of Appeal found no difficulty in rejecting the suggestion that there would be infringement: it was not predictable whether (or, if so, which) other salt would work or what its properties would be and, in any event, the language of the claims clearly excluded any such other options.
- The Court of Appeal and High Court thought it unnecessary to refer to the prosecution history and the Court of Appeal leaned strongly against doing so.

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Actavis v Eli Lilly in the Supreme Court

- Scope of protection – due account of equivalents
- Prosecution file history
- Direct infringement in France, Italy and Spain
- Contributory infringement

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Actavis v Eli Lilly in the Supreme Court

- EPC 2000 travaux préparatoires
- Comparative law – France, Italy, Spain, Germany, Netherlands, Switzerland, Ireland and AIPPI
- Academic and extra judicial analysis – Prof. Laddie, Dr Fisher, Dr Meier-Beck, AG van Peursen, Judge Kalden
- English case law - Walton v Potter & Horsfall (1843), Clark v Adie (1877), Beecham v Bristol Labs (1978), Catnic (1982), Improver (1990), Kirin Amgen (2005)

Actavis v Eli Lilly in the Supreme Court

The Key Question

Old

"the question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean" (*Kirin-Amgen* at [34])

New

... a problem of infringement is best approached by addressing two issues:

- (i) does the variant infringe any of the claims as a matter of normal interpretation; and, if not
- (ii) does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial?

If the answer to either issue is "yes" there is infringement; otherwise, there is not. (*Actavis v Eli Lilly* at [54])

Actavis v Eli Lilly in the Supreme Court

What is "normal interpretation"?

- A problem of interpretation which is familiar to all lawyers concerned with construing documents
- The applicable principles are tolerably clear and were recently affirmed by Lord Hodge in *Wood v Capita Insurance Services* [2017] 2 WLR 1095
- ascertain objective meaning of language in context of factual background at the time – bearing in mind nature, formality and quality of drafting

Actavis v Eli Lilly in the Supreme Court

As to what was meant by "normal" interpretation, now see

- *Liqwd Inc v. L'Oreal (UK) Ltd* [2018] EWHC 1394, Birss J [58]
- *Fisher & Paykel v. Resmed* [2017] EWHC 2748, Richard Meade QC [82]
- *Illumina v. Premaitha* [2017] EWHC 2930, Henry Carr J [202]
- *Generics v. Yeda* [2017] EWHC 2629 [2018] RPC 2, Arnold J [135]
- *Icescape v Ice-World* [2019] FSR 5 (CA) [60]

- See also *Saab Seaeye v. Atlas Elektronik* [2017] EWCA Civ 2175 Kitchin LJ, Floyd LJ at [18]-[19] - no dispute about principles which apply to the construction of patent claims – familiar 11 point summary in *Virgin Atlantic v Premium Aircraft* [2010] RPC 8 with point (ix) read in the light of *Actavis*

Actavis v Eli Lilly in the Supreme Court

Assessment of Equivalents

Old (*Kirin Amgen* at [51])New (*Actavis v Eli Lilly* at [60] and [66], *Icescape v Ice-World* at [66])

- Q.1 Does the variant have a material effect on the way the invention works?

If yes, the variant is outside the claim. If no -

Notwithstanding that it is not within the literal [that is to say ... normal] meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e. the inventive concept revealed by the patent?

(If yes -)

Actavis v Eli Lilly in the Supreme Court

Assessment of Equivalents

OldNew (*Actavis v Eli Lilly* at [61]-[64], [66])

- Q.2 Would this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art?

If no, the variant is outside the claim. If yes -

Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?

(If yes -)

Actavis v Eli Lilly in the Supreme Court

Assessment of Equivalents

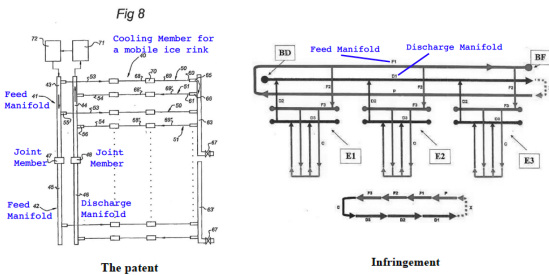
OldNew (*Actavis v Eli Lilly* at [65], [66])

- Q.3 Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention?

If yes, the variant is outside the claim.

Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

(If 'yes', outside the claim; if 'no', may be infringement)

Icscape v Ice-World [2019] FSR 5 (CA)**Icscape v Ice-World [2019] FSR 5 (CA)**Claim1

A cooling member for a mobile ice rink ...

characterised in that:

- A. the cooling member comprises at least two elements, each with a feed manifold (43, 45) and a discharge manifold (44, 46) ...
- B. two rigid sections ... connected by a joint member ([70])
- C. wherein by moving the joint members ([70]) a first series of parallel pipe sections can be placed in a transport position ... at an angle with respect to oneanother

Icscape v Ice-World [2019] FSR 5 (CA)

Lord Kitchin, Floyd LJ and Longmore LJ

- clear that the approach to infringement adopted by the Supreme Court in *Actavis v Eli Lilly* was markedly different from that which the courts had adopted since *Catnic v Hill & Smith* (which effectively conflated two issues into one single issue of construction)
- the first, whether variant infringed any of the claims of the patent as a matter of normal interpretation, was a problem of interpretation
- however, issue of equivalence was addressed in the second, was essentially what it was that made a variant immaterial

Icscape v Ice-World [2019] FSR 5 (CA)

Lord Kitchin, Floyd LJ and Longmore LJ

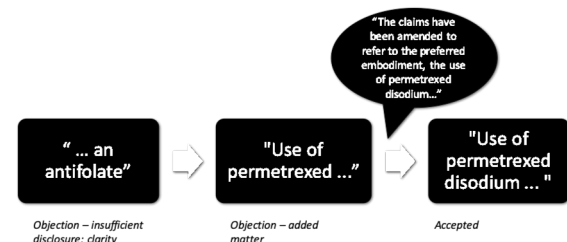
- it is appropriate to ask whether the component at issue is an "essential" part of the invention
- that is not the same thing as asking if it is an "essential" part of the overall product or process of which the inventive concept is part
- here regard must be had to the inventive concept or the inventive core of the patent

**EValve v Edwards Life Sciences
[2020] EWHC 514 (Birss J) at [315]**

'one should examine
what is the problem underlying the invention
and how does the patent solve the problem'

Actavis v Eli Lilly in the Supreme Court

Prosecution History



Actavis v Eli Lilly in the Supreme Court

Prosecution History

Old

'The Courts of the United Kingdom, the Netherlands and Germany **certainly discourage, if they do not actually prohibit**, use of the patent office file in aid of construction'

(*Kirin Amgen* at [35])

New

'it is appropriate for the UK courts to adopt a **sceptical, but not absolutist, attitude** to a suggestion that the contents of the prosecution file of a patent should be referred to when considering a question of interpretation or infringement, **along ... the same lines as the German and Dutch courts**'

(*Actavis v Eli Lilly* at [87])

Actavis v Eli Lilly in the Supreme Court

Prosecution History

Old

'the **meaning of the patent should not change** according to whether or not the person skilled in the art has access to the file and

in any case **life is too short** for the limited assistance which it can provide.'

(*Kirin Amgen* at [35])

New

'... reference to the file would only be appropriate where

(i) the point at issue is **truly unclear** if one confines oneself to the specification and claims of the patent, **and the contents of the file unambiguously resolve the point**, or

(ii) it would be **contrary to the public interest** for the contents of the file to be ignored.'

(*Actavis v Eli Lilly* at [88])

Actavis v Eli Lilly in the Supreme Court

- First 'issue' involves purposive construction
- Second 'issue' involves equivalents outside that meaning – better referred to as 'scope of protection'
- Post-priority knowledge that variant works is OK
- But not post-priority investigation of the way it works

Actavis v Eli Lilly in the Supreme Court

- Can exclude equivalents by clear wording
- Must take care over prosecution file history – during and after prosecution
- Impact on validity likely to be the subject of argument – do equivalents within the scope of protection anticipate?

Saab Seaeye v Atlas Elektronik
[2017] EWCA Civ 2175 (Kitchin LJ, Floyd LJ)

There was no dispute about the principles which apply to the construction of patent claims. Both parties relied, as did the judge, on the summary in this court's judgment in *Virgin Atlantic v Premium Aircraft* [2010] RPC 8 at [5].

Saab Seaeye v Atlas Elektronik
[2017] EWCA Civ 2175 (Kitchin LJ, Floyd LJ) at [18]

- The first overarching principle is that contained in Art.69 of the European Patent Convention.
- ... the extent of protection is determined by the claims. It goes on to say that the description and drawings shall be used to interpret the claims. In short the claims are to be construed in context.
- It follows that the claims are to be construed purposively—the inventor's purpose being ascertained from the description and drawings.

**Saab Seaeye v Atlas Elektronik
[2017] EWCA Civ 2175 (Kitchin LJ, Floyd LJ)**

- (iv) It further follows that the claims must not be construed as if they stood alone—the drawings and description only being used to resolve any ambiguity. Purpose is vital to the construction of claims.
- (v) When ascertaining the inventor's purpose ... he may have several purposes depending on the level of generality of his invention. Typically ... one, generally more than one, specific embodiment as well as a generalised concept. But there is no presumption that the patentee necessarily intended the widest possible meaning consistent with his purpose be given to the words that he used: purpose and meaning are different.

**Saab Seaeye v Atlas Elektronik
[2017] EWCA Civ 2175 (Kitchin LJ, Floyd LJ)**

- (vi) Thus purpose is not the be-all and end-all. One is still at the end of the day concerned with the meaning of the language used. Hence the other extreme of the Protocol—a mere guideline—is also ruled out by Art.69 itself. It is the terms of the claims which delineate the patentee's territory.
- (vii) It follows that if the patentee has included what is obviously a deliberate limitation in his claims, it must have a meaning. One cannot disregard obviously intentional elements

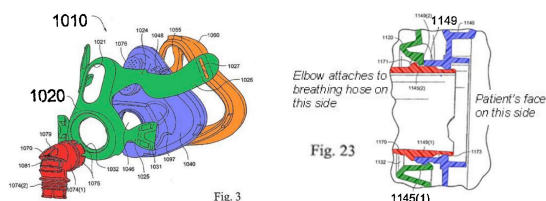
**Saab Seaeye v Atlas Elektronik
[2017] EWCA Civ 2175 (Kitchin LJ, Floyd LJ)**

- (viii) It also follows that where a patentee has used a word or phrase which, a contextually, might have a particular meaning (narrow or wide) it does not necessarily have that meaning in context.
- (ix) [It further follows that there is no general "doctrine of equivalents."]

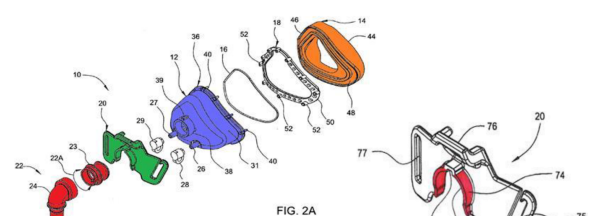
Sub-paragraph (ix) must now be read in the light of the Supreme Court's judgment in *Actavis v Lilly* [2017] UKSC 48, which explains that, at least when considering the scope of protection, there is now a second question, to be asked after the patent claim has been interpreted, which is designed to take account of equivalents.

**Saab Seaeye v Atlas Elektronik
[2017] EWCA Civ 2175 (Kitchin LJ, Floyd LJ)**

- (x) On the other hand purposive construction can lead to the conclusion that a technically trivial or minor difference between an element of a claim and the corresponding element of the alleged infringement nonetheless falls within the meaning of the element when read purposively. This is not because there is a doctrine of equivalents: it is because that is the fair way to read the claim in context.
- (xi) Finally purposive construction leads one to eschew the kind of meticulous verbal analysis which lawyers are too often tempted by their training to indulge.

**Novelty and Obviousness after *Actavis v Lilly*
Fisher and Paykel v ResMed at [176]-[182]**

Claim 12. The mask system (x10) according to any of the preceding claims, wherein the collar (x49) includes one or more protrusions adapted to engage the respective snap fingers (x45) provided to the shroud (x20).

**Novelty and Obviousness after *Actavis v Lilly*
Fisher and Paykel v ResMed at [176]-[182]**

8 NEW SQUARE
INTELLECTUAL PROPERTY

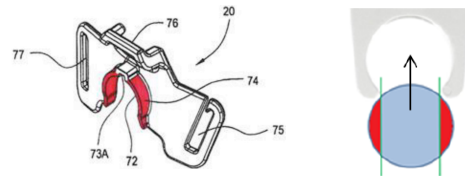
Novelty and Obviousness after *Actavis v Lilly*
Fisher and Paykel v ResMed at [176]-[182]

- Geist would not anticipate claim 12 on a truly literal meaning because it does not have protrusions on the collar, which is smooth and circular.
- However, FPH argued that it would anticipate on a proper purposive interpretation (the relevant standard), or as an equivalent.

8 NEW SQUARE
INTELLECTUAL PROPERTY

Novelty and Obviousness after *Actavis v Lilly*
Fisher and Paykel v ResMed at [176]-[182]

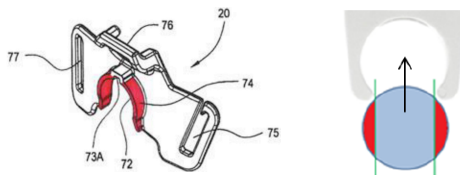
- FPH argued lower portion of the collar, where ends of items 74 grip, provide an angled surface against which the items 74 can push, holding the collar back into the recess in the bracket.



8 NEW SQUARE
INTELLECTUAL PROPERTY

Novelty and Obviousness after *Actavis v Lilly*
Fisher and Paykel v ResMed at [176]-[182]

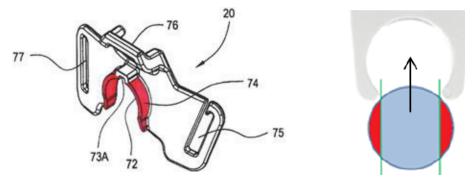
- This plainly achieves the same object as “literal” protrusions which would cause a more abrupt change in the surface of the collar.



8 NEW SQUARE
INTELLECTUAL PROPERTY

Novelty and Obviousness after *Actavis v Lilly*
Fisher and Paykel v ResMed at [176]-[182]

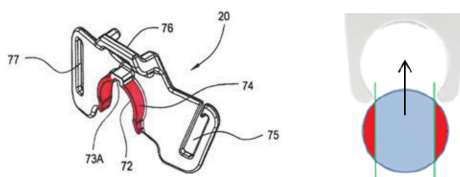
- Areas shaded red are part of the cylindrical collar, but if one had started with a straight sided collar as shown in blue ... and added the red parts one would have had no difficulty in calling them protrusions.



8 NEW SQUARE
INTELLECTUAL PROPERTY

Novelty and Obviousness after *Actavis v Lilly*
Fisher and Paykel v ResMed at [176]-[182]

- ‘I find this convincing and hold that on a proper purposive interpretation Geist has protrusions and anticipates claim 12.’



8 NEW SQUARE
INTELLECTUAL PROPERTY

Novelty and Obviousness after *Actavis v Lilly*
Fisher and Paykel v ResMed at [181]

- ‘That makes it unnecessary to consider anticipation by equivalence ...’
- ‘... but if the above argument for some reason could not be accommodated within the rubric of purposive construction, or if the jumping-off point for the Actavis questions is the truly literal meaning, then I would have held that the same logic led to anticipation by equivalence, if the law permitted it’.

Novelty and Obviousness after Actavis v Lilly
Fisher and Paykel v ResMed at [182]

- 'It is because I find anticipation of claim 12 by Geist on purposive construction, plus the fact that I find it obvious over Geist and invalid over Lovell even on a narrow interpretation, that I consider the point of law about anticipation by equivalence of no material importance to my overall decision'.

Novelty and Obviousness after Actavis v Lilly

Fisher and Paykel v ResMed [2017] EWHC 2748
Richard Meade QC, 10Nov17 at [82]

- Arnold J considered in *Generics v Yeda*:
 - (1) Prior to considering equivalents, the Court must apply purposive and not literal construction ([135] to [139]). ...
 - (2) There cannot as a matter of law be anticipation by equivalence ([161] to [167]). ...
- 'Both these important points are arguable and I expect will be considered by the Court of Appeal and possibly the Supreme Court in due course'.
- 'as matters stand I should follow ... Arnold J'

Equivalence & Validity**Technetix v Teleste [2019] FSR 19 (IPEC)**

Squeeze arguments and historical limits on granted monopolies

- *Gillette Defence* – *Gillette v Anglo-American* (1913) 30 RPC 465
- *Merrell Dow principle* – *Merrell Dow v Norton* [1996] RPC 76

Potential Formstein defence

- Case X ZR 28/25 *Formstein* GRUR 1986, 803 – German FSC
- *Core Distribution v Lidl* – District Court of Hague, 14 March 2012
- *Jang v Boston Scientific* (Fed Circ 2017) Opinion No 16-1275 at 14-15

Thank you