

CARPMAELS & RANSFORD

Why Do You Want a Patent?

Monday 22nd March, 2021

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What Do You Want a Patent For?

- Prestige
- Licensing
- Defensive Portfolio
- Keep others off the market

Infringement

- Mainly governed by Patents Act 1977, Section 60
- 2 main subsections
 1. Direct Infringement
 2. Indirect Infringement
 - (aka Contributory Infringement)

Infringement

- Who?
- How?
- When?
- Where?
- What?

Who?

- Section 60 (1)

“... a person [who] does ... things ... in relation to the invention ...”

Who?

- Section 60 (2)

“... a person (other than the proprietor of the patent) [who does things] ... for putting the invention into effect”

Who?

- Proprietor can also infringe under Section 60 (1) if he has granted an exclusive licence (see Section 67).

Who?

- Do you sue the Company, the person or both?

How?

- Subsections (1) and (2):

“... without the consent of the proprietor ...”

- Licences ?
- Implied licences ?
- Repair ?

When?

- Subsections (1) and (2)

“... while the patent is in force ...”,

- but remember that ...

When?

- Infringement can take place before a patent is granted – see Section 69 – rights arising from publication of an application
- Cannot start an action for infringement until after the patent has granted
- Claims as published and as granted must both be infringed

When

- You can sue after a Patent has expired but only for acts which took place before the Patent expired – see Limitation Act 1980. Can only go back 6 years (5 in Scotland) prior to date of the claim.

Where?

- Subsections (1) and (2)
- “... in the United Kingdom ...”
- Not as simple as it looks ...

What? - Section 60 (1)

- Makes, disposes of, offers to dispose of, uses, imports or keeps a product
- Uses or offers for use a process
- Disposes of, offers to dispose of, uses or imports the direct product of a process

What?

- PRIMARILY
- What it says in the claims
- Must construe the claims – Amgen – what the skilled person would think the Patentee is claiming
- EXCEPT we now have to consider EQUIVALENTS

Equivalents – The Protocol to Article 69 EPC

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.

Infringement by equivalents

- Actavis v Lilly [2017] UKSC 48
- Supreme Court (formerly House of Lords)
- Lord Neuberger
- Claim said “pemetrexed sodium + vitamin B12”
- Actavis aimed to sell pemetrexed diacid or non-sodium salt and vitamin B12
- Supreme Court held that wording of claim 1 was clear and so scope of claim was met only if pemetrexed sodium was used
- Supreme Court therefore considered how to determine scope of protection and therefore whether there was infringement

Infringement by equivalents

- Three Step Test – similar to Protocol Questions but with variations
- i) Notwithstanding that it is not within the literal 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, ie the inventive concept revealed by the patent? If YES, then ...
- ii) 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, then ...
- iii) 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 NO, then INFRINGEMENT

Infringement by equivalents

- Lilly won – Actavis' products were held to infringe as equivalents
- New ball game in the UK
- Case Law will develop

What? – Section 60 (2)

- Supplies or offers to supply a means relating to an essential feature of the invention ... provided that ...
- He knows or it was obvious that the means are suitable and intended.

Exceptions

- Specifically for 60 (2), no infringement if the “means” is a staple commercial product ... unless there is inducement.

Exceptions – Section 60 (5)

- (a) – private and non-commercial
- (b) – experiments relating to the invention
- (c) – pharmacists

Exceptions – Section 60 (5)

- (d) to (f) – ships, aircraft, hovercrafts, vehicles
- (g) and (h) – farmers
- (i) – clinical trials

What do you do?

- Sue for infringement at:
- Patents Court – you need barristers and solicitors (unless you are a PAL)
- Intellectual Property Enterprise Court (ex-PCC)
- Comptroller
- Unified Patents Court ???

What can you get?

- Injunction
- Delivery up or destruction
- Damages
- Account of profits
- Declaration of Validity and Infringement

What can the Infringer do?

- Usually counterclaims for revocation and/or a declaration of non-infringement

Is it worth it?

- Can be very expensive – not just legal costs
- Very time consuming as it is much faster than the EPO
- Not for the faint-hearted. If you can avoid litigation, do so!

Why Should You be Interested Now?

- Drafting Skills – need to be aware of Pitfalls
- Amendment Skills
- FD4 Finals Paper

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Any questions?

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