

Why do you want a Patent anyway?

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Why Do You Want a Patent?

- Prestige
- Licensing
- 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 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?

- What it says in the claims
 - Must construe the claims – what is the scope of the claim the skilled person would see from the words in the claim read in context (Amgen)
- What is the scope of protection provided by the claim
 - Must consider whether a variant which does not fall within the scope of the claim is an equivalent (Actavis)

What? – Section 60 (2)

- Supplies or offers to supply a means relating to a “means essential” to the invention ... provided that ...
- He knows or it was obvious that the means are suitable and intended ...
- Double territoriality
- Actavis can also apply

Actavis

- There are three questions:
 - a) 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, i.e. the inventive concept revealed by the patent? If yes:
 - b) 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:
 - c) 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?

Exceptions Section 60(3)

- Specifically for 60 (2), no infringement if the “means essential” 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
- (j) and (k) – UPC
- There are complications in 60 (6) onwards

What do you do?

- Sue for infringement at:
- Patents Court – you need barristers (unless you are an advocate) and solicitors (unless you are a PAL)
- Intellectual Property Enterprise Court (IPEC)
- 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

- Thank you for listening.
- Any questions?