
*Actavis v. Eli Lilly*¹: Back to the Future—The UK Supreme Court Changes the Test for Patent Infringement

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The UK Supreme Court rarely hears patent cases, and will only hear cases that it considers to be fundamentally important. The court's July 12 judgment is most significant for changing the test for infringement in the United Kingdom, widening the scope for infringement by equivalence. But it also opens the door for relying on patent prosecution history in litigation; emphasizes the importance of judgments of other European courts, thus showing that the UK court is seeking a common European patent law; and demonstrates that the UK court is willing to adjudicate on infringement of patents of other European states.

A new test for the scope of protection

The court set out an approach to infringement in line with its interpretation of Article 69 of the European Patent Convention, and the Protocol on its interpretation.

First, it is necessary to establish whether a variant infringes the claim as a matter of “normal” interpretation. Second, the most important aspect of the judgment is the new test² for the scope of protection in relation to a variant on what is literally required by the claim, summarized as follows:

- “i) Notwithstanding that it is not within the literal [i.e. contextual] 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?
- 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?
- 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?”

Under the new test, variants may now infringe even if the skilled addressee did not know in advance that they would work, and even if it was not obvious that they would work. The new test assumes that

the skilled addressee knows that the variation works (to the extent that it actually does work).

Prosecution history may be admissible in some circumstances

In relation to patent prosecution history, the UK Supreme Court has diluted a previous rule that excluded its use in litigation. References to the file are still discouraged but “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.” The court goes on to explain that the second case “*would be exemplified by a case where the patentee had made it clear to the EPO that he was not seeking to contend that his patent, if granted, would extend its scope to the sort of variant which he now claims infringes.*”⁴ The court considered that the fact that a limitation is introduced in response to an objection during prosecution of lack of disclosure or added matter would not affect the scope of protection.

In the future, depending on how this is subsequently interpreted by the Patents Court and the Court of Appeal, it should be assumed that prosecution history will play a greater role in UK litigation than it has to date, and this should be borne in mind during prosecution.

UK law continues to harmonize with the law in other European states

The judgment makes extensive reference to the case law of Germany, France, Italy, Spain and the Netherlands, and notes that the test above, particularly at point 2, is “*consistent with the approach of the German, Italian and Dutch courts.*”⁵ It also notes that the reformulated test set out above, while differing in at least one respect from the German test of infringement, will usually produce the same results.

UK courts assess infringement of French, Spanish and Italian patents

The court went on to apply French, Spanish and Italian law, finding infringement in each case. In relation to Spain, this proceeded on the basis that as the Spanish courts had followed the UK approach in the past, they would be likely to follow the new judgment of the UK Supreme Court.

The finding of infringement of patents in other European states is another demonstration of European patent courts increasingly integrating in approach and procedure, perhaps as a precursor to the introduction of the Unified Patent Court, which is expected to open in 2018.

¹ [Actavis v. Eli Lilly \[2017\] UKSC 48](#).

² In fact, this is a reinstatement, with changes, of an old test that had fallen out of favor. It especially differs from that old test in relation to the second limb. The House of Lords in *Kirin-Amgen Inc. v. Hoechst Marion Roussel Ltd* [2005] RPC 9 had generally discouraged the use of the old test, first formulated on pre-European Patent Convention law in the House of Lords decision *Catnic Components Ltd v. Hill & Smith Ltd* [1982] RPC 183, and applied in post-EPC cases at first instance in *Improver Corp v. Remington Consumer Products Ltd* [1990] FSR 181, approved by the Court of Appeal in *Wheatley v. Drillsafe Ltd* [2001] RPC 7.

³ *Ibid.*, para. 66.

⁴ *Ibid.*, Para. 88

⁵ *Ibid.*, Para. 62.

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