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Actavis v Eli Lilly: outcomes

Kirkland & Ellis associate Jin Ooi discusses the English patent doctrine following Actavis v Eli Lilly

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How does the Icescape v Ice-World case relate to Actavis v Eli Lilly?

Icescape v Ice-world is a case concerning a system for cooling mobile ice rinks. It is the first occasion in which the English Court of Appeal has had the chance to consider in any depth the effect of the Supreme Court decision in Actavis v Eli Lilly. The Court of Appeal applied the Supreme Court's decision to consider whether there was infringement: (i) as a matter of normal interpretation (which it confirmed involves purposive interpretation), and (ii) as a matter of equivalents (by asking what it termed the "Actavis questions").

What could this English patent doctrine mean for rights holders and for patent law as a whole?

The emergence of a principle of equivalents in English law following on from Actavis v Eli Lilly is generally good news for patentees, almost all of whom have enthusiastically embraced the Supreme Court decision. This is because the principle of equivalents extends a patentee's scope of protection to cover an infringing variant which may not necessarily have been caught by just construing the claims as a matter of normal, purposive interpretation. This is a significant shift in the state of English patent law as it was previously thought that purposive construction was the be all and end all when considering infringement.

Following this case, what process should be taken to access the scope of a patent?

The Supreme Court explained that a problem of infringement is best approached by addressing two issues, each of which is to be considered through the eyes of the notional addressee of the patent in suit, for example, the person skilled in the relevant art. If the answer to either issue is "yes", there is an infringement; otherwise, there is not.

1. Does the variant infringe any of the claims as a matter of normal, purposive interpretation; and, if not

2. Does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial (for example as a matter of equivalents)? In considering what makes a variation immaterial, it is helpful to consider the following three questions (which are guidelines, not strict rules):

    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, for example 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?

In order to establish infringement under the principle of equivalents, a patentee would have to establish that the answer to the first two questions was "yes" and that the answer to the third question was "no".

What could US patent law take from this important UK case?

Two things:

1. As a result of the introduction of a principle of equivalents, English courts are now much more open to finding infringement where the infringing product/process varies in an immaterial way. Expert evidence continues to be key in assisting the court to answer the "Actavis questions".

2. English courts continue 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. It remains a high hurdle. The circumstances in which it will be appropriate to do refer to the prosecution file are 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 (for example, 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). IPPro

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