By Michelle Round

At the start of this month, the UK Supreme Court took a break from its recent post-Brexit work interpreting EU law to consider the proper interpretation of a patent claim regarding the use of pemetrexed. The case, a challenge to a decision of the Court of Appeal in the UK, was an opportunity for the Court to consider the principles of claim construction and the relevance of the prosecution history in determining the scope of a patent claim.

Lilly, the patentee, had been granted a patent on a composition of matter comprising pemetrexed, a pyrimidine antimetabolite used to treat non-small cell lung cancer. The patent was granted in 2003 and was for a method of treating cancer using pemetrexed. The patent was challenged by Actavis, who argued that the patent was invalid because the claim was not clear and specific enough to define the invention.

The Supreme Court had to consider whether the claim was for the pemetrexed salt-form claimed in the patent or for the particular salt-form claimed in the patent. Lilly argued that the claim was for the particular salt-form claimed in the patent, while Actavis argued that the claim was for the pemetrexed salt-form in general.

The Supreme Court held that the claim was for the particular salt-form claimed in the patent. This was because the prosecution history showed that Lilly had been required to set out a specific salt-form as a condition of the grant of the patent. The Court also considered the doctrine of equivalents and found that the claim was not infringed by Actavis' products.

The Court also considered the doctrine of prosecution history estoppel, which prevents a patentee from arguing for a broader claim than what was originally claimed. The Court held that this doctrine applied in this case and that the claim should be narrowly construed to reflect the prosecution history.

The Court's decision was seen as a significant victory for patentees and a blow to defendants who had argued that the doctrine of equivalents should be applied more widely. The decision was also seen as a rejection of the "will soon be a recurring phrase for UK patent litigators when setting out their arguments" principle applied in some other jurisdictions.

The Supreme Court's decision is expected to have a significant impact on patent litigation in the UK and may lead to a more consistent approach to claim construction and prosecution history estoppel across the EU.