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Breaking news: UK Supreme Court decision on pemetrexed – Eli Lilly’s patent held to be directly and indirectly infringed

Brian Cordery (Bristows) · Friday, July 7th, 2017

By Gregory Bacon

The UK Supreme Court announced this morning that it has allowed Eli Lilly’s appeal and held that Actavis’ pemetrexed products directly infringe Lilly’s European patent to pemetrexed disodium in the United Kingdom, France, Italy and Spain. The Court has also dismissed Actavis’ cross-appeal and held that Actavis’ products would also indirectly infringe Eli Lilly’s patent to the extent held by the Court of Appeal.

As readers may recall, the Patents Court (Arnold J) had originally granted Actavis a declaration of non-infringement (DNI) in relation to the UK, French, Spanish and Italian designations of Lilly’s European patent. The claim at issue was a Swiss-type second medical use claim relating to pemetrexed disodium, and the proposed active ingredient in Actavis’ product was one of pemetrexed dipotassium, pemetrexed ditromethamine or pemetrexed diacid (the ‘AIs’). In June 2015, The Court of Appeal (Floyd LJ giving the leading judgment) upheld Arnold J’s finding of no direct infringement but overturned his finding of no indirect infringement due to the AIs generally being dissolved in saline solution which provided a source of sodium ions.

The appeals raised important points of patent law construction, including in relation to equivalents under EPC 2000 and the role of ‘manufacture’ in determining infringement of Swiss-type second medical use patents. My colleague Nicholas Round summarised the arguments presented to the Supreme Court [here](#), and we look forward to analysing the Supreme Court’s judgment once it is handed down on Wednesday 12 July 2017, including the treatment of the question of construction under French, Italian and Spanish law in addition to that of the UK.

As a postscript, the UK outcome is in contrast to the rulings on the equivalent patent in Germany, where the Regional Court of Düsseldorf held that the use of pemetrexed dipotassium instead of pemetrexed disodium constituted an infringement under the doctrine of equivalence, a decision that was reversed on appeal by the Higher Regional Court of Düsseldorf, which held that that patent was neither infringed under direct infringement nor under the doctrine of equivalence. On further appeal, the Federal Court of Justice has set aside the decision of the Higher Regional Court and remitted the case back to the Higher Regional Court for reconsideration, and we await with interest to see whether the Higher Court will follow the UK Supreme Court’s approach (once known).

Details of the appeal result are available on the Supreme Court’s [website](#).

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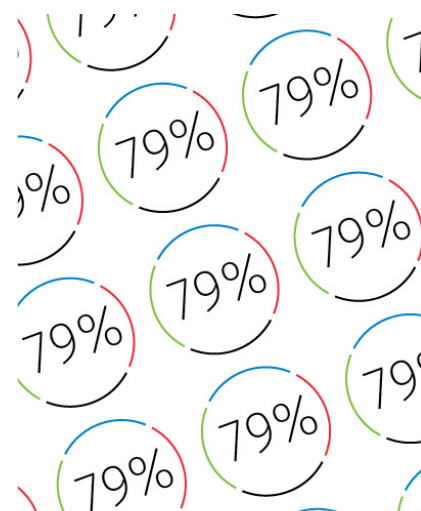
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