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More on Pemetrexed: the new “equivalence” test takes us back to the basics

Miquel Montaña (Clifford Chance) · Wednesday, July 26th, 2017

In paragraph 54 of its judgment of 12 July 2017, the UK Supreme Court wrote that “[...] notwithstanding what Lord Diplock said in *Catnic* [1982] RPC 183, 242, 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, ie the person skilled in the relevant art. Those issues are: (i) does the variant infringe any of the claims as a matter of normal interpretation; and, if not, (ii) does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial?” This focus on “immateriality” has begged the question in other posts published on this blog as to whether this judgment marks the return of the “pith and marrow doctrine” (please see the post published by Brian Cordery on 13 July 2017).

The conclusions reached by the Court in this case have triggered not only the “pith and marrow doctrine” but, more generally, the “doctrine of equivalents”, to return to the territory of English case law. This should not come as a surprise. As explained in paragraph 42 of this judgment, in paragraph 37 of *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9, Lord Hoffmann explained that the doctrine of equivalents had been developed in the United States. In that case, Lord Hoffmann quoted Jackson J in *Graver Tank & Manufacturing Co Inc v Linde Air products Co* 339 US 605, 607 (1950) to illustrate that “the United States courts had «allow[ed] the patentee to extend his monopoly beyond his claims», so as to prevent «the unscrupulous copyist [from making] unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of the law.”

The judgment of 12 July 2017 appears to have brought us back to the very origins of patent law. For example, in 1814 Harvard professor Joseph Story, while sitting on the bench of the Court of Appeal of Massachusetts, wrote that “Mere colourable differences, or slight improvements, cannot shake the right of the original inventor.” In fact, the first patent law (Venetian Patent Law of 19 March 1474) prevented third parties from “[...] far alcun altro artificio, ad imagine et similitudine di quello, senza consentimento et licentia del auctor, fino ad anni X”. As readers may have noticed, the use of the word “similitudine” (i.e. similar) was already designed to capture embodiments which fell beyond the literal wording of the claims.

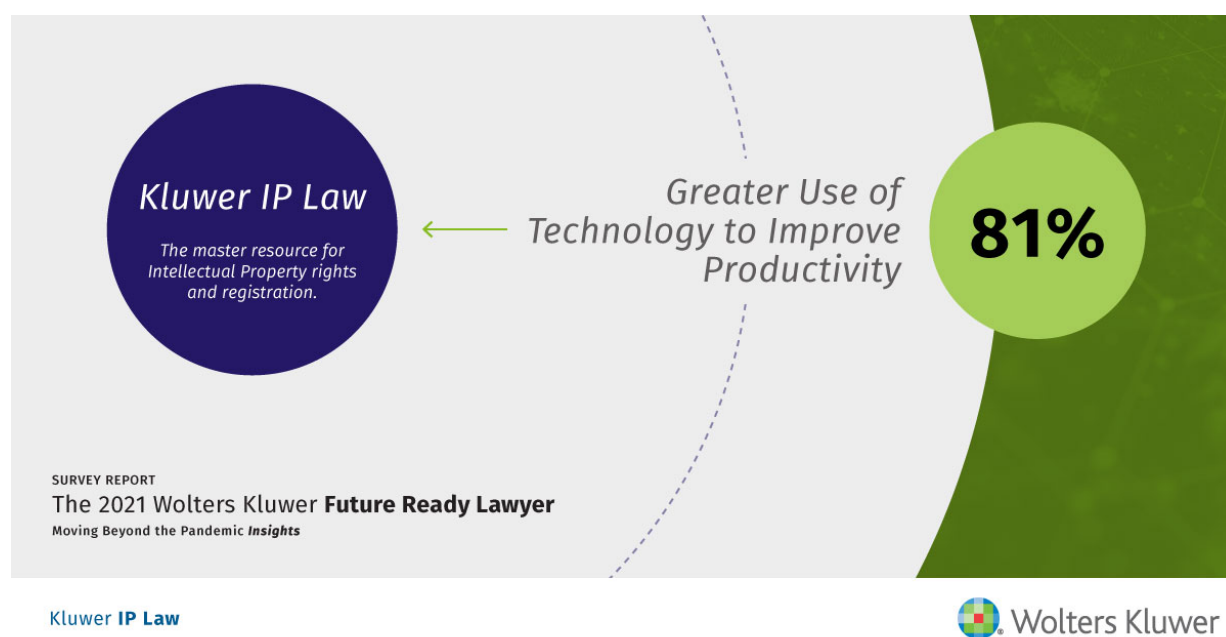
All in all, the judgment of 12 July 2017 appears to have taken the “doctrine of equivalents” back to the basics.

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