Kluwer Patent Blog

A Brave New World?

Rachel Mumby (Bristows) · Thursday, October 26th, 2017

Patent lawyers in the UK have spent the last three months pondering, debating and at times indulging in an element of despair (to put it mildly) about what might be the impact of the judgment of the Supreme Court in **Actavis v Eli Lilly** [2017] UKSC 48 on issues of validity (see here). Today they got the first glimpse from the High Court of what this new world might look like. It arrived in the form of the judgment of Arnold J in Generics (UK) Ltd v Yeda [2017] EWHC 2629 (Pat), the latest in a serious of judgments relating to patents concerning Teva's highly successful Copaxone medicine.

On novelty, Arnold J held (albeit obiter) that, at least before the Supreme Court has a chance to say anything different, this new world looks very similar to the old world. He agreed with the view put forward by the patentee that, as previously, a claim will only lack novelty if it discloses subject-matter which falls within the claim on its proper interpretation – it is not sufficient that the subject-matter would infringe the claim applying the doctrine of equivalents. He noted that this is consistent with the jurisprudence of the Boards of Appeal of the EPO, and that the decision of the Supreme Court in **Actavis v Eli Lilly** was based on Article 2 of the Protocol on the Interpretation of Article 69 EPC "*which is concerned with the extent of protection of a patent or patent application, that is to say, with infringement and not with validity.*"

So has this just been months of unnecessary worrying? Absolutely not. Instead, UK patent lawyers are now faced with the reality of having to re-programme their minds to adjust to a brave new world where novelty and infringement are not necessarily two sides of the same coin. Indeed, Arnold J is of the view that a claim does not necessarily lack novelty even if a prior publication discloses subject-matter which, if performed, would necessarily infringe the claim. It did not arise in this case, but it will be interesting to see how this falls out in a case where previously there would have been a clear squeeze between novelty and infringement.

Also at stake was a request for an Arrow Declaration. Arnold J found the patent to be novel but obvious – something which he held was a necessary foundation for the relief sought, but not sufficient. He went on to consider the factors set out by Henry Carr J in **Fujifilm v AbbVie** [2017] EWHC 395 (Pat) (see here) in deciding whether to grant such discretionary relief. He held that on the facts of this case, the reasoned judgment he had provided was sufficient for the Claimants and therefore declined to grant the declaration.

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This entry was posted on Thursday, October 26th, 2017 at 4:31 pm and is filed under EPC, EPO, literally fulfil all features of the claim. The purpose of the doctrine is to prevent an infringer from stealing the benefit of an invention by changing minor or insubstantial details while retaining the same functionality. Internationally, the criteria for determining equivalents vary. For example, German courts apply a three-step test known as Schneidmesser's questions. In the UK, the equivalence doctrine was most recently discussed in Eli Lilly v Actavis UK in July 2017. In the US, the function-way-result test is used.">Equivalents, Inventive step, Litigation, Novelty, Pharma, Pharmaceutical patent, Prior art, Revocation, Second Medical Use, United Kingdom, Validity
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