Eli Lilly UK Supreme Court Decision: 7 Key Questions Answered

Background

Whether or not you have any granted or pending patents in place, you should take note of an important Supreme Court decision, **Eli Lilly v Actavis UK [2017] UKSC 48**, issued in July 2017.

It has effectively made patents more enforceable, and hence more valuable, in the UK.

Here we answer **7 key questions** relating to the decision.

1. Is this an important decision?

Absolutely. It is without doubt one of the most important decisions in over 35 years regarding how to interpret the scope of protection provided by UK patents.

2. What's the background?

In layman's terms, a product or process will infringe a patent if each and every one of its features is present in an independent claim. However, it is not uncommon for there to be varying degrees of ambiguity in claim language. It has always been the case that, when interpreting the meaning of a patent claim, a balance must be struck between the conflicting requirements of:

a) Providing a patent owner with reasonable protection for his/her invention; and

b) Providing the general public with legal certainty as to the scope of a patent monopoly.

3. What has changed?

The Supreme Court decision sweeps away many long-established principles regarding the manner in which patent claims are to be interpreted.

In a very general sense, the scope of protection provided by patents will now increase because it is now allowable, in certain circumstances, to expand the meaning of terms appearing within patent claims to include their equivalents (whether or not known at the patent filing date), even if those equivalents as a matter of ordinary language go beyond the literal or contextual meaning of those terms.

The decision has the potential to significantly shift the balance in favour of the interests of the patent owner and thereby reduce, to a degree, legal certainty for the general public.

4. Will a new legal test now be applied?

Yes. The Supreme Court decision sets out a new three-part test as an aid to assessing the question of whether something falls inside or outside the scope of a claim notwithstanding the fact that they do not do so upon a purely literally interpretation.

The test is a reformulation of the pre-existing test which the judge deemed to be deficient in several respects.

5. What is the purpose of the new test?

The above test primarily seeks to answer the question of whether a "variant" (i.e. a non-literal equivalent to a term appearing in the claim) achieves substantially the same result in substantially the same way as the invention. If the answer to that question is no, then there is no infringement.

However, if the answer is yes then it provides a sound initial basis for concluding that the variant may infringe, provided that the remaining two parts of the above-mentioned three-part test are satisfied.

6. Did anything else change?

Yes. For the first time in the UK, the Supreme Court decision concluded that it *is* acceptable to look to the prosecution case history (i.e. the pre-grant written submissions to the patent office) in cases where there is a genuine ambiguity that could be resolved. However, there remains a presumption against doing so. This is a relaxation of the previous approach which positively discouraged reference to the prosecution case history.

7. What is the net effect of these changes?

The practical effect of the Supreme Court decision is that more patents will now be infringed under the new approach to be adopted in future by UK courts. This will inevitably be a considerable advantage to the owners of those patents and a considerable problem for anyone making or using products which might infringe a patent. On the flip side, it may also mean that more patents may be invalid because there is a greater chance of conflict with previous publications.

Can we help you?

Please **contact Avir Patel** to discuss the implications of this decision for your business or to arrange a free intial consulation.

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