Gowling WLG’s intellectual property experts discuss infringement and related actions as part of their 'The basics of patent law' series.

The articles cover, respectively: Types of intellectual property protection for inventions and granting procedure; Initiating proceedings; Infringement and related actions; Revocation, non-infringement and clearing the way; Trial, appeal and settlement; Remedies and costs; Assignment and Licensing and the Unified Patent Court and Unitary Patent system.

The articles underpin Gowling WLG's contribution to Chambers' Global Practice Guide on Patent Litigation 2017, for which Gordon Harris and Ailsa Carter wrote the UK chapter.

**Venue for infringement claims**

In the UK, claims for patent infringement are governed by section 61 of the Patents Act 1977 ("PA"). They must be brought in the court unless the parties agree to refer the dispute to the Comptroller-General of Patents, Designs and Trade Marks (the "Comptroller").

Upon such a reference, the Comptroller only has jurisdiction to hear and determine claims for damages and claims for declarations as to the validity or infringement of the patent. If it appears to the Comptroller that the question referred to him would more properly be determined by the court, he may decline to deal with it and the court shall have jurisdiction.
For more on court venue, please see our article on initiating proceedings.

Claimants

A claim for infringement of a patent may be brought by the proprietor (i.e. owner) of the patent and/or an exclusive licensee. Where the patent is jointly owned a joint owner may make a claim alone, but the co-owner(s) must, if not co-claimants, be made defendants to the action. In this capacity the defendant co-owner shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings. Where the claim is brought by the exclusive licensee, the proprietor(s) of the patent should similarly be joined (s.66 PA).

In order to maximise the recovery of damages for infringement, corporate litigants should ensure that licensing arrangements enable the relevant operating entity or entities to be claimants.

Acts of patent infringement

Pursuant to s.60(1) PA, it is an infringement of a patent to do any of the following in the UK while the patent is in force without the consent of the proprietor of the patent:

a. where the invention is a product, making, disposing of, offering to dispose of, using or importing the product or keeping it whether for disposal or otherwise;

b. where the invention is a process, using the process or offering it for use in the UK, with knowledge, or when it is obvious to the reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent;

c. where the invention is a process, disposing of, offering to dispose of, using or importing any product obtained directly by means of that process or keeping any such product whether for disposal or otherwise.

The above are considered to be acts of 'direct' or 'primary' infringement.

Pursuant to s.60(2) PA, it is an infringement of a patent to supply or offer to supply in the UK a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect, with knowledge, or when it is obvious to a reasonable person in the circumstances, that the means supplied are suitable for putting, and are intended to put, the invention into effect. Section 60(2) infringement is known as 'contributory', 'indirect' or 'secondary' infringement.

Further, it is an act of joint tortfeasance to assist the commission of an act of direct or
contributory infringement by another pursuant to a common design with that person (Sea Shepherd v Fish & Fish [2015] UKSC 10; Vertical Leisure v Poleplus [2015] EWHC 841 (IPEC), Glaxo v Sandoz [2016] EWHC 2743 (Ch)).

**Assessment of infringement**

In accordance with the above, in order for the court to make a finding that a patent has been infringed, it must be satisfied (at least) that an act of infringement has been committed (i.e. making, offering to dispose of, using, supplying) in respect of a product, process or direct product of a process which is within the scope of at least one claim of the patent.

The law regarding the assessment of infringement has developed recently with the decision of the UK Supreme Court in Actavis v Eli Lilly [2017] UKSC 48. According to that jurisprudence, a question of infringement is best approached by addressing two issues, each of which is to be considered through the eyes of the national addressee of the patent in suit, i.e. 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 (i.e. 'literal infringement'); 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? If the answer to either issue is "yes", there is an infringement; otherwise, there is not.

The first issue raises a question of interpretation, whereas the second issue would normally have to be answered by reference to the facts and expert evidence. When determining the second issue, the following questions may be of assistance:

a. Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e. the inventive concept revealed by the patent?

b. Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?

c. Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

In order to establish infringement in a case where there is no literal infringement, a patentee would, by this approach, have to establish that the answer to questions a) and b) was "yes" and that the answer to question c) was "no".
Accordingly, there is a doctrine of equivalents in the UK, meaning a patentee can now potentially succeed in a patent infringement claim where the alleged infringing product or process does not fall within the literal scope of the claims of the patent but varies from the literal scope in a way or ways which are immaterial.

In 2016 the Court of Appeal gave noteworthy obiter guidance on the so called "mental element" of a second medical use claim and the assessment of infringement of such a claim (Warner-Lambert v Generics [2016] EWCA Civ 1006).

**Defences**

In accordance with the definitions of infringing acts in s.60, an act is only capable of infringing a patent if it is done without the consent of the proprietor (express or implied) and is in respect of a claim of the patent that is not invalid.

A party alleged to infringe a patent may claim by way of defence that the patent is invalid and may seek revocation of it. The grounds for revocation of a patent are considered in our article on [Revocation, non-infringement and clearing the way](#).

A party alleged to infringe may claim by way of defence that its acts benefited from the proprietor's consent.

Where goods are first placed on the market in the EEA by the proprietor of the patent or with his consent (e.g. by a licensee), the doctrine of exhaustion prevents the enforcement of the patent in the UK in respect of the imported goods (Centrafarm v Sterling C-15/74).

In some situations, compulsory licences or licences of right may be available, providing a defence to a claim of infringement (s.48-48B, s.46 PA).

In some contexts, a defence may be available that the enforcement of the patent breaches antitrust law. This remains a developing area of the law, with ongoing litigation in the UK and elsewhere in the context of patents that must be implemented in order to comply with an industry standard, for example in the telecommunications sector (see, for example, Huawei v ZTE C-170/13 and Unwired Planet v Huawei [2017] EWHC 711 (Pat)).

The Patents Act (section 60(3) & (4)) also provides that an act that would constitute an infringement of the patent will not do so if (broadly):

- it is done privately and for purposes which are not commercial;
- it is done for experimental purposes relating to the subject matter of the invention (which
encompasses anything done in or for the purposes of a medicinal product assessment);
- it is done in conducting a study, test or trial which is necessary for and is conducted with a view to obtaining marketing authorisation or complying with regulatory requirements;
- it consists of the preparation in a pharmacy of a medicine for an individual in accordance with a prescription;
- it consists of use on a ship or on an aircraft temporarily in the territorial sea or airspace of the UK;
- it consists of a specified use by a farmer of the product of his or her harvest or an animal purchased with the consent of the proprietor of the patent; or
- it is the supply or offer to supply of a staple commercial product, unless the supply or offer is made for the purpose of inducing infringement (as defence to s.60(2) contributory infringement only).

**Innocent infringement**

Although not a defence to liability, no damages or account of profits can be awarded in respect of infringing activities if the infringer can prove that at the date of the infringement, or each infringing act, it was not aware, and had no reasonable grounds for supposing, that the patent existed (s.62 PA). The burden of proof is on the party asserting the defence. It rarely succeeds because patents are available on a public register (see, for example, Collingwood v Aurora [2014] EWHC 228 (Pat)).

**Crown use**

Historically, the Crown was entitled to use patented inventions without the consent of or compensation to the patentee. Since 1883, the rights of the Crown have been curtailed, and are defined in s.55-59 PA. In short, any government department, and any person authorised in writing by a government department, may, for the services of the Crown, do any of the acts listed in s.55(1) in relation to a patented invention without the consent of the proprietor. The acts are similar to the acts of infringement set out in s.60. However, except for the purposes of foreign defence or for production or supply of specified drugs and medicines, permissible sale or offer to sell a product is limited to situations where this would be incidental or ancillary to making, using, importing or keeping the product. The proprietor or exclusive licensee of a patent is entitled to compensation by the Crown where the Crown use provisions are invoked, and may claim for patent infringement where the permissible acts are exceeded (although the availability of injunctive relief is limited).
Jurisdiction of the Comptroller to issue an opinion

Additionally, s.74A PA provides that the proprietor of a patent or any other person may request that the Comptroller issue an opinion on a prescribed matter in relation to the patent. Such issues include questions of infringement (or non-infringement). These opinions are not binding for any purposes. The proprietor or exclusive licensee of the patent may seek a review of the decision before the Comptroller. A decision by the Comptroller not to set aside an opinion is a decision from which appeal lies to the Patents Court.

Declarations of non-infringement

The Patents Act and common law permit a party to apply to the court for a declaration of non-infringement. As an action intended to 'clear the way' (i.e. to remove the effect of a patent), this is discussed in our article on Revocation, non-infringement and clearing the way.