The Doctrine of Equivalents – where are we now?

Doctrine of Equivalents in the UK - Taking a look at what’s happened in the three years since Actavis v Eli Lilly

While it may feel like only yesterday that the UK Supreme Court established a doctrine of equivalents for patent infringement in Actavis v Eli Lilly, as of this month, it was actually 3 years ago. This being the case, the time seemed right to us to look in overview at the impact this doctrine has had on patent infringement cases brought in the High Court and Court of Appeal. In this article, we analyse the number and proportion of patent infringement cases in which infringement by equivalence has been pleaded, the areas of technology involved in those cases and we look at how often the patent prosecution history has successfully been relied on to avoid a finding of infringement.

We have previously reported on the Actavis decision here.

Patent infringement cases where infringement by equivalence has been argued

The first case to follow Actavis and find infringement under the doctrine of equivalents was Icescape v Ice-World (which we reported on here), however, in that case, the patent in question was held invalid. We have identified 10 UK cases in which infringement under the doctrine of equivalents has been found. However, in only 4 of those 10 cases was the relevant patent also held valid, and of those 4 cases: 1 case did not turn on the equivalence finding, because the Judge had already established the patent infringed under a normal interpretation of the relevant claims; in a further case the infringement claim was successfully defended as Crown Use; and in the 2 remaining cases the Court found the relevant patents to be both valid and infringed under the doctrine of equivalents – the only 2 such cases we have identified (see Figure 1).
However, despite the limited number of cases in which infringement by equivalence has been found in respect of a patent also held to be valid, it is clear that both the number of cases in which infringement by equivalence has been pleaded and the proportion of cases in which infringement by equivalence has been pleaded is rising. As can be seen from Figure 2 (below), while there were only 2 (of 36) UK judgments addressing infringement by equivalence in 2018, there were 7 (of 43) in 2019. Given that we have already seen 4 such judgments (of 19) in the first half of 2020, this suggests we may see a still greater number (and proportion) of cases in which infringement by equivalence has been (or will be) pleaded in 2020. Figure 3 (below) shows that the percentage of patent infringement cases in which infringement under the doctrine of equivalents was pleaded increased from 6% of cases in 2018 to 21% in 2020 (so far).
Areas of technology where infringement by equivalence has been argued

While the doctrine of equivalents originated in a case concerning a patent in the life sciences sector (Actavis), it is a doctrine that has since found application across a broad range of technologies. The following chart (Figure 4) shows the different areas of technology in which infringement by equivalence has been argued (as identified from the IPC classes of the patents in dispute in each doctrine of equivalents case cited above). While the largest number of DoE cases concern patents in the life sciences sector (medical/veterinary sciences, organic chemistry and biochemistry) there are also cases concerning patents in a broader range of technologies including in the construction, engineering, computing and electronics sectors.

Figure 4: Chart showing the distribution of IPC codes in the UK’s doctrine of equivalents judgments so far (as at 21/07/2020)
Prosecution History

In *Actavis*, the Supreme Court commented on the relevance of the patent prosecution history in the assessment of the claim scope. As a reminder, typically, the UK courts have discouraged looking at the contents of prosecution files for the purposes of determining claim scope and have rarely done so (in contrast to some other European jurisdictions). Lord Neuberger described 2 situations where it would be appropriate to do so:

i. if the point at issue is unclear based on the specification, and the file unambiguously resolves the point, or

ii. if it would be contrary to the public interest to ignore the file, e.g. where a patentee has stated previously that it would not enforce the patent against a particular variant.

In practice, since *Actavis*, defendants have only attempted to plead the prosecution history in a minority of cases, with only 5 out of 14 doctrine of equivalents judgments discussing prosecution history. However, looking at the 5 cases we have identified where the prosecution history has been relied on, there were no cases in which the prosecution history was successfully used to defend an infringement claim.

Conclusions

Following our review of the doctrine of equivalents cases since *Actavis*, we have identified some key themes:

• There is an increasing number and proportion of cases in which infringement by equivalence is being pleaded;

• The doctrine of equivalents is being pleaded in patent infringement cases covering a broad range of areas of technology, however life sciences cases dominate;

• The number of cases in which patents are both found valid and infringed by equivalence is low; and

• While parties in 5 cases have sought to rely on the patent prosecution history, we have identified no instances where the prosecution history was successfully used to defend an infringement claim.

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