

Setting the Scene
The Law of Patent Infringement in the UK

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Royal Society of Chemistry

serle court

Patent Infringement: construction of the claims

- **Patents Act 1977 (as extensively amended)**
- **Section 60**
- *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9, HLs
- *per Lord Hoffmann:*
 - *“Construction is objective in the sense that it is concerned with what a reasonable person to whom the utterance was addressed would have understood the author to be using the words to mean.”*

Direct Patent Infringement

■ Section 60(1)

- **Product: makes, disposes of, offers to dispose of, uses or imports the product, or keeps it whether for disposal or otherwise**
- **Process: uses the process, offers it for use in the UK when he knows (or obvious to a reasonable person) would be an infringement**
- **Process: disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process, or keeps any such product whether for disposal or otherwise**

Contributory Patent Infringement

- **PA 977 s 60(2):**
- **supplies or offers 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 when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the UK**

Patent Infringement by a Joint Tortfeasor

- ***CBS Songs v Amstrad* [1988] RPC 567, HLs**
 - **procuring**
 - **authorising**
 - **inducing**
- **but not facilitating or enabling**
- **nor mere directorship or investment**

Selected Defences

- **s 60(5)(b): experimental purposes relating to the subject matter of the invention:**

“to discover something unknown or to test a hypothesis or even to find out whether something which is known to work in specific conditions, , will work in different conditions” (Monsanto Co. v Stauffer Chemical Co. [1985] RPC 515 at 542)

- **s 60(5)(i): an act done in conducting a study, test or trial which is necessary for and is conducted with a view to the application of [Directive 2001/82/EC or Directive 2001/83/EC] – *Bolar* exclusion**

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- All areas of IP law and practice, in particular patents, trade marks, copyright and designs. Over 75 reported cases since 2000, of which two thirds were appeals or judicial reviews. Appeared often before the GC and CJ on appeals and Art. 267 references (over 25 times), and in the EPO (Legal and Technical BoA). Acted for the Comptroller-General of Patents (*Yeda*, HLs, CA, PatCt), the Registrar of Trade Marks (*General Cigars* and *Land Securities*, both appeals to the ChD) and the UK government (*adidas*, ECJ). Extensive copyright and design practice (both registered and unregistered, UK and Community).