WARNING! – Does your business design around the patents of others?

The test for assessing whether a product, process or use infringes a patent in the UK has changed significantly.

The balance of power has been tipped toward patent owners. The scope of protection that is provided by many patents has expanded. While this change has the potential to increase the value of many patent portfolios, the task of designing around the patents of others has become significantly more difficult and higher risk.

In 2017 the UK Supreme Court introduced a 'Doctrine of Equivalents' test for assessing infringement of patents in the UK. This has resulted in the infringement of patents now occurring with increasing regularity in cases that would not have been infringement prior to 2017.

The new equivalence test considers whether an allegedly infringing product/process/use falls within the scope of a patent by representing a mere 'immaterial variation' of the inventive concept of the patent, even if the product/process/use falls outside of the explicit features required by the claims.

Essentially, this new test asks – does the alleged infringement take the 'clever bit', the inventive core, taught by the patent?

When faced with a potentially blocking patent of a competitor, some businesses have historically adapted the n-1 approach to getting around these patents. If 'n' represents all of the features of claim 1 of the competitor's patent, a business may take a view that if it can do without one of these claim features in their product/process/use then their activities will fall outside of the patent. It also seems that it is not uncommon for businesses to adopt this approach without consulting professional patent attorney council. This kind of approach to dealing with a competitor's patent can be especially prevalent in the chemical industry, where claims are often defined in easier to grasp structural or quantitative terms, rather than the more nebulous functional language that can be more commonly found in other fields.

This approach has always carried some risk, however in view of the introduction of a formal Doctrine of Equivalents in the UK, it now represents a very high risk.

What does this mean in practice? Here are a few examples where there may have seemed to be a straightforward way to design around a claim pre-2017, but which now represent unviable options:

- A competitor's patent relates to a new cancer treatment using an antifolate in combination with vitamin B12.
  - ***Claim 1 of the patent requires inter alia the use of a disodium salt of an antifolate active agent.***
  - ***You design your product to use a dipotassium salt of the same antifolate active agent.***
- A competitor's patent relates to a way of preparing blood plasma using a new type of thixotropic gel.
  - ***Claim 1 of the patent requires that a buffer solution is used at 0.10M.***
  - ***You design your product to use the same type of thixotropic gel, but with a 0.13M buffer solution.***
- A competitor's patent relates to a new way of tilting a freight container for loading/unloading using a unique tilting arm system.
  - ***Claim 1 of the patent requires attachment of the arms to a side wall of the container.***
  - ***You design your product to use the same titling arm system but with attachment to the front wall of the container.***

These are all examples from real UK High Court decisions post-2017 which found that the attempted 'design around' products infringed claim 1 of the patents despite the absence of an explicitly required claim feature.

Designing around the patents of others without infringing is now much harder. The litmus test has shifted from "do we have all of the required claim features" to "are we copying the clever bit". If you find that your business is being blocked by a competitor's patent, we strongly advise that you seek the assistance of a patent attorney to develop a viable way forward.

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