

D YOUNG & CO

PATENT

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Vexed pemetrexed UK Supreme Court rewrites the law on scope of patent protection



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We're enjoying interesting times in the field of patent law with reports this month concerning both UK and US Supreme Court decisions that significantly revise patent law - in the US the law regarding patent exhaustion has been updated, and in the UK the scope of patent protection has been redefined. We also bring to you the latest news regarding the patentability of essentially biological processes, first reported in December last year. We also take another look at the recent *Unwired Planet v Huawei* case, where previously we examined FRAND issues and this time consider patent validity in more detail. We hope you find this edition a useful and interesting update.

Editor:

Anthony Albutt



Events



17-19 September 2017

IPO Annual Meeting, US

Garreth Duncan, Darren Lewis and Matthew Dick will be attending the annual Intellectual Property Owners Association (IPO) annual meeting in San Francisco. Partner solicitor Matthew Dick will be speaking during the International Trademark Issues session on 19 September.

16-17 November 2017

CIPA Life Science Conference, UK

Kirk Gallagher and Simon O'Brien, partners in our biotechnology, chemistry & pharmaceuticals team, are attending the premier annual educational and networking event for patent and IP professionals active in the pharmaceuticals, medical technology and biotechnology sectors.

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UK scope of patent protection

Vexed pemetrexed UK Supreme Court rewrites the law on scope of patent protection

In a ground-breaking decision (*Actavis v Eli Lilly*'), the UK Supreme Court found Actavis' proposed generic pemetrexed product to directly infringe Eli Lilly's patent (EP 1313508), overturning the findings of the lower courts who found no direct infringement. The case brings a doctrine of equivalents into UK patent law, as well as a limited doctrine of file wrapper estoppel, and will change the way in which the scope of protection conferred by a UK patent is assessed.

Background

Pemetrexed is an anti-cancer drug developed by Lilly. However, when used on its own, the drug can cause serious side effects: Lilly found that these side-effects could be reduced if the drug was administered together with vitamin B12. Pemetrexed is marketed by Lilly as Alimta®, with the label stipulating administration with vitamin B12. The pemetrexed basic patent and supplementary protection certificate (SPC) expired in 2015. However, based on the above finding, Lilly obtained a second patent, expiring in 2021, covering the combination, which was the subject of the litigation.

Prosecution history

The claims of the patent application as filed were drafted broadly, defining both pemetrexed and vitamin B12 in terms of their mechanism of action. These were objected to by the European Patent Office (EPO) on the grounds of insufficiency and lack of clarity. To attempt to address these objections, Lilly amended the claims to recite pemetrexed generally - but the EPO objected that these claims added subject matter, as the application as filed disclosed pemetrexed only in the form of its disodium salt. Lilly further limited the claims to recite pemetrexed disodium, and the EPO allowed the application.

Article 69 EPC and its Protocol, and prior UK case law, on scope of protection

The scope of protection of a patent is governed by Article 69 of the European Patent Convention (EPC) and its Protocol. Article 1 of the Protocol aims to find a compromise position between defining the scope of protection according to the strict,

literal meaning of the claim wording (using the description and drawings only to resolve an ambiguity in the claims) and extending beyond the claim wording to cover the broader inventive concept (using the claims only as a guide), combining a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties. Article 2, added when the EPC was revised in 2000, requires due account to be taken of equivalents when determining the scope of protection.

For over 150 years, UK patent law has allowed, in varying forms, the scope of protection conferred by a patent to extend beyond its literal wording to ensure that infringement is not avoided by items which differ from the claim wording only as an immaterial variation. In *Catnic v Hill & Smith*² the House of Lords ruled that a patent requires a "purposive construction" rather than "a purely literal one derived from applying to it the kind of meticulous verbal analysis which lawyers are too often tempted by their training to indulge" - thereby finding a steel lintel to infringe a patent claim even though its supporting structure deviated by 6 to 8 degrees from the vertical and the claim recited "vertical". The *Catnic* test was refined further in *Improver v Remington*³ where the Patents Court formulated the following three questions:

1. Does the variant have a material effect upon the way the invention works?
 - If yes, the variant is outside the claim. If no – go to question 2.
2. Would this have been obvious at the date of publication of the patent to a skilled reader?
 - If no, the variant is outside the claim. If yes – go to question 3.
3. Would the skilled reader nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention?
 - If yes, the variant is outside the claim. If no, the variant infringes the patent.

The "Improver questions" (later rebranded the "Protocol questions" by the Court of Appeal in *Wheatley v Drillsafe*) were used for the next

1. [2017] UKSC 48
2. [1982] RPC 183
3. [1990] FSR 181

15 years to determine whether a variant of a claimed item infringes a patent. However, the House of Lords once again considered the scope of protection conferred by a patent in *Kirin-Amgen* - simply by posing one question: “what would the person skilled in the art have understood the patentee to be using the language of the claim to mean?” This was a re-statement of the principle of purposive construction, which the Lords considered gave effect to the Protocol. The Improver questions were not dispensed with completely, but were considered merely guidelines, more useful in some cases than others.

In all of the above, the UK courts have consistently been reluctant to apply a general doctrine of equivalents as used in the US and other jurisdictions. Indeed, in *Kirin-Amgen* the House of Lords opined that Article 69 “firmly shuts the door on any doctrine which extends protection outside the claims”. In the case of *Virgin Atlantic v Premier Aircraft*, the Court of Appeal, summarising *Kirin-Amgen*, explicitly stated “it follows there is no general ‘doctrine of equivalents’”.

The lower courts’ decisions

Actavis wished to market pemetrexed in the form of the free acid or a different salt. They sought a declaration of non-infringement of the patent, covering not just the UK but also France, Italy and Spain. Throughout the proceedings, Lilly argued that the scope of protection conferred by the patent extends to other salts of pemetrexed, at least by virtue of equivalents. Actavis counter-argued that it did not, and that the amendments made by Lilly before the EPO estopped them from making this argument in litigation.

At first instance, the Patents Court granted the declaration, on the grounds that the scope of protection was limited to pemetrexed disodium: the court also hinted at a doctrine of file wrapper estoppel, considering that patentees accepting a narrow form of claim during prosecution and then arguing that it covers something broader during litigation may be an abuse of the system.

The Court of Appeal agreed with the Patents Court’s finding that there was no

Press summary from the UK Supreme Court: <http://dycip.com/ukscpressjuly2017>



direct infringement, applying the Improver questions and answering “no” to both questions 1 and 2. The court did find Actavis’ product would indirectly infringe the patent, on the grounds that, when reconstituting the product in saline, the disodium salt would be formed in situ. However, the Court of Appeal disagreed with the Patents Court’s view on file wrapper estoppel.

The Supreme Court judgment

The Supreme Court reversed the lower courts’ finding and ruled Actavis’ product would directly infringe the patent. Importantly, the Supreme Court ruled that Article 2 of the Protocol means that there is at least potentially a difference between the interpretation of the wording of the claim and the scope of protection conferred by it - specifically indicating equivalents must be taken into account. The court ruled that two issues must be considered in order to determine whether an equivalent, or variant, falls within the scope of protection:

- i. Does the variant infringe any of the claims as a matter of normal interpretation? 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 Supreme Court ruled that such an approach complies with Article 2 of the Protocol, as issue (ii) above “squarely raises the principle of equivalents”. This would appear to depart from *Kirin-Amgen* and to bring a general doctrine of equivalents into UK law.

The Supreme Court considered that issue (i) involves solving a problem of interpretation, according to “normal principles of interpreting documents”. Significantly, the court opined that, according to these normal principles, the Actavis products would not infringe under issue (i), as the free acid or alternative salts of pemetrexed could “in no sensible way” be said to fall within the term “pemetrexed disodium”.

[continued overleaf]

Vexed pemetrexed - UK Supreme Court rewrites the law on scope of patent protection

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In order to determine issue (ii), the Supreme Court revived the Improver questions in a revised form, as follows:

1. 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, ie, the inventive concept revealed by the patent?
 - If no, no infringement - if yes, go to question 2.
2. 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?
 - If no, no infringement - if yes, go to question 3.
3. 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?
 - If yes, no infringement - if no, the variant infringes the patent.

Answering “yes” to questions 1 and 2 and “no” to question 3, the Supreme Court found Actavis’ product directly infringing under issue (ii).

The Supreme Court also ruled that a “sceptical, but not absolutist” approach should be taken to considering the prosecution history when interpreting the scope of protection conferred by a claim. The court considered that reference to the prosecution history would only be appropriate in the following circumstances:

- a. the point at issue is truly unclear from the specification and claims of the patent when read on its own, and the prosecution history unambiguously resolves the point; or
- b. it would be contrary to the public interest for the prosecution history to be ignored.

Specifically, the court indicated that an example of (b) would be where the patentee

had made it clear to the EPO that it was not seeking to contend that the patent, if granted, would extend its scope to a particular sort of variant, and then later argues that the variant infringes. This would appear to bring a limited form of file wrapper estoppel into UK law.

Comments

It could be argued that justice may have been served in this particular case - Lilly’s invention was the addition of vitamin B12, not the particular salt of pemetrexed. Given the Supreme Court’s answer on issue (i) above, it is unlikely that Lilly would have won under Kirin-Amgen: they therefore had to make new law to prevail. However, this may be at the cost of years of uncertainty ahead interpreting the scope of UK patents in all technical fields.

Prior advice concerning infringement in the UK may now require revision.

This may particularly be the case in chemistry in view of the difference in scope of protection which the Supreme Court considered as regards issues (i) and (ii), and in which cases are generally drafted in compositional rather than functional terminology.

Although the validity of the patent was not in dispute in this case, there also remains the question of whether immaterial variants should fall within the scope of the claim when considering novelty and/or inventive step - it is a long standing principle that a patent claim should be construed the same when considering both infringement and validity. This raises the prospect of a “squeeze” argument - in other words, if the scope of the patent covers the alleged variant, then it is invalid for lack of novelty and/or inventive step.

In the parallel German litigation, the German Supreme Court indicated that the use of a chemical name in a patent claim does not necessarily rule out that the “semantic content” of the claim excludes compounds which fall outside its literal meaning, but having equivalent effect. Whether and to what extent this is to be confirmed depends on the facts of

that particular case. The case has been sent back to the lower courts to look at infringement under the doctrine of equivalents again.

The potential for file wrapper estoppel is a warning to patentees to be careful what they say before the EPO - both in written proceedings and at oral proceedings.

Opponents in opposition proceedings should take note of any statements made by the patentee in the proceedings and ensure any points made by the patentee in oral proceedings about the scope of protection are minuted by the Opposition Division or Board of Appeal.

Author:

Garreth Duncan

Postscript

It would be interesting to consider whether one additional line in the specification as filed - an intermediate fallback position reciting “pemetrexed or a pharmaceutically acceptable salt thereof” - may have saved the parties from years of litigation.

For applicants preparing PCT specifications for clients’ business critical inventions, it is always worth asking a European patent attorney to review the text before filing with future EPO prosecution in mind - the small additional cost of this simple check can save applicants from much larger expenses down the line.

We would be happy to carry out a pre-filing review of PCT specifications - please do get in touch, whether by email to mail@dyoung.com or by contacting your usual D Young & Co advisor, if this is of interest.

Impression Products v Lexmark International US Supreme Court changes the law on patent exhaustion

A surprise decision from the US Supreme Court appears to have fundamentally altered the law on patent exhaustion in the US.

Background to the case

The case concerned the “remanufacture” of print cartridges. In the US Lexmark offered consumers two different options when buying printer cartridges. Consumers could opt to pay for a “full price” cartridge, or could instead purchase a discounted “Return Program” cartridge which came with a contractual obligation to return the cartridge to Lexmark.

Impression is a company which engages in the remanufacture of empty cartridges. They would refill the empty cartridges with toner and resell them. Impression acquired the empty cartridges from a number of sources, including Lexmark Return Program cartridges sold in the US, and cartridges sold by Lexmark abroad which were subsequently imported by Impression into the US.

Lexmark, which owns a number of patents that cover the cartridges, sued Impression for infringement of those patents in respect of the two groups of cartridges. For the US-sourced Return Program cartridges, Lexmark argued that because contractual obligations with the consumer expressly prohibited the reuse and resale of these cartridges, Impression Products had infringed the Lexmark patents when it refurbished and resold them. For the cartridges sold by Lexmark abroad and imported into the US Lexmark argued that, as it had never given anyone authority to import these cartridges, Impression

was infringing its patents by doing so.

Impression moved to dismiss in respect of both groups on the grounds that Lexmark’s sales, both in the US and abroad, had exhausted Lexmark’s patent rights in the cartridges and accordingly Impression should be free to import, refill and resell them.

The District Court granted the motion to dismiss for the domestic Return Program cartridges but denied the motion for the imported cartridges. Subsequently, the Federal Circuit ruled for Lexmark, refusing the motion to dismiss with respect to both groups of cartridges.

US Supreme Court decision

In a near-unanimous decision, the Supreme Court reversed the Federal Circuit on both the Return Program cartridges (8-0) and the imported cartridges (7-1).

On the Return Program cartridges, the court rejected Lexmark’s contention that the contractual obligations on the cartridges granted them the right to sue under patent law, stating:

“We conclude that Lexmark exhausted its patent rights in these cartridges the moment it sold them. The single-use/no-resale restrictions in Lexmark’s contracts with customers may have been clear and enforceable under contract law, but they do not entitle Lexmark to retain patent rights in an item that it has elected to sell.”

In other words, while the existence of a contractual obligation may well allow for an action under contract law, it does

not prevent the sale from exhausting the patent rights in the cartridge.

Similarly, in respect of the imported cartridges the court held that patent exhaustion holds up even in respect of foreign sales. The court drew an analogy to a recent US Supreme Court case, *Kirtsaeng v John Wiley & Sons*, which held that it was legal to import foreign textbooks into the US despite the publisher’s contention that the importation infringed copyright.

The court succinctly summarised their decision stating:

“In sum, patent exhaustion is uniform and automatic. Once a patentee decides to sell – whether on its own or through a licensee – that sale exhausts its patent rights, regardless of any post-sale restrictions the patentee purports to impose, either directly or through a licensee.”

Conclusion

This judgment is likely to have far reaching consequences in how inventors seek to protect their intellectual property. What is especially notable is that the court did not appear to place any geographic restrictions on patent exhaustion, in marked contrast to the position in the UK where patent exhaustion only applies to authorised sales within the European Economic Area.

The judgment did, however, leave a number of questions unanswered. In particular, the Court did not rule on the role that patents may continue to play when an incomplete transfer of a good or service has occurred under various licensing agreements such as product-as-a-service business models which have become increasingly popular in recent years.

Author:
Anton Baker



This case concerned the “remanufacture” of print cartridges



An illusion of clarity

The new Rule 28(2) EPC

The European Patent Office has amended its rules in relation to the patentability of products derived from essentially biological processes.

In December 2016, we reported on events at the EU and at the EPO in relation to the subject matter of plants or animals obtained by an “essentially biological process”.

To summarise:

- 08 November 2016 – The European Commission issued its comments *inter alia* on how they believed Article 4 of the “Biotech Directive” 98/44/EC should be interpreted; their interpretation went against to that decided on by the Enlarged Board of Appeals in G2/12 and G2/13 (the “Tomato” and “Broccoli” cases)
- 12 December 2016 – The EPO stayed all pending proceedings in respect of patents and applications directed to plants or animals obtained by an “essentially biological process”

Changes to Rules 27 and 28 EPC

The Administrative Council of the EPO on 29 June 2017 amended Rules 27 and 28 EPC, with effect from 01 July 2017.

Essentially, Rule 28 EPC gained a new paragraph (2):

Rule 28(2) EPC: “(2) Under Article 53(b), European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process.”

Rule 27 EPC has been amended to simply reflect the change to Rule 28:

Rule 27(b) EPC: “(b) without prejudice to Rule 28, paragraph 2, plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety;”

The intention is quite clear – these changes essentially bring the interpretation of the Biotech Directive (which is itself implemented into the EPC) into line with that suggested by the European Commission.

As a result, the stay of proceedings at the EPO has been lifted, and pending examination and opposition proceedings will continue in light of the new rules.

An uncertain future

Prior to the decision of the Administrative Council, CIPA had already submitted their own comments on the proposed changes (www.cipa.org.uk). A key issue discussed is the fact the uncertainty over Article 4 of the Biotech Directive – which is at its heart a piece of EU legislation applicable to EU member states – has not been settled by the Court of Justice of the European Union (CJEU). However, its interpretation under new Rule 28(2) EPC can lead to the denial of a right (a patent) to individuals filing within an EU member state by a body which has no competency to refer a question to the CJEU. This can be seen as a contravention of Article 267 TFEU.

There is also the possibility of challenges to the applicability of Rule 28 EPC under the EPC.

The decision of the Administrative Council does not make any reference to G2/12 or G2/13. Under Article 112 EPC, decisions of the Enlarged Board of Appeal are binding, and thus in theory “Tomato” and “Broccoli”

remain binding for the interpretation of Article 53(b) EPC. As Article 53(b) EPC itself has not changed, and Article 164(2) EPC states that the Articles prevail over the Rules of the EPC upon conflict, questions will remain over the ultimate effect of the present change.

There is no doubt that this subject will remain in the spotlight for years to come as both examination and opposition cases finds their way to the Boards of Appeal.

Future applications

Notwithstanding the ongoing discussion around the legality of patents directed to plants and animals produced through “essentially biological processes”, it should be expected that applications and patents with claims towards such matters still in pending proceedings before the EPO will likely be refused or revoked respectively unless the offending claims are removed. Despite this, it is still important to highlight that the new rule only relates in a broad sense to products made through classical breeding and selection (see decisions G2/07 and G1/08 for previous interpretations of “essentially biological process”).

- Transgenic plants and animals with a particular trait characteristic which are not defined by a particular variety or species remain eligible for patent protection, provided the requirements for patentability are met. Similarly, the biotechnological processes used to make them are also eligible.
- If plants and animals created through breeding remain commercially important, it may still be relevant to include passages pertaining to such products in the claims and/or the description, as different national laws exist on the matter.
- Plant variety rights can also be important to protect varieties generated through plant breeding.

Further advice

We remain committed to protecting your commercial interests so please do not hesitate to get in contact with us if you have any further questions in light of this rule change.

Author:
Feng Rao



Rules 27 & 28 EPC have been amended by the EPO with effect from 01 July 2017



First technical appeal decision Unwired Planet v Huawei

➤ Case details at a glance

Jurisdiction: England & Wales

Decision level: Court of Appeal (Civil Division)

Parties: Unwired Planet International Ltd

v Huawei Technologies Co Ltd & Ors

Date: 12 April 2017

Citation: [2017] EWCA Civ 266

Decision: <http://dycip.com/ewcaciv266>

This appeal was brought by Huawei in respect of the decision of [2015] EWHC 336 (Pat) in which it was held that Unwired Planet's patent was both valid and infringed.

The patent is one of a series purchased by Unwired Planet from Ericsson relating to LTE 4G telecommunications; in particular, this patent concerned a method of polling a receiver for a transmitted-information status report after a predetermined amount of data, measured in Protocol Data Units (PDUs), has been transmitted. The appeal covered three main areas relating to the validity of the patent: priority, novelty and obviousness.

Novelty

It was agreed by all parties that the document 'Ericsson TDoc' would be novelty-destroying for the patent if it were determined to be a part of the state of the art at the time of filing. Ericsson TDoc was uploaded to a Europe-based public server at 08:36CET on 08 January, while the priority document was filed at the USPTO fourteen hours later (16:59EST/22:59CET on 08 January).

Huawei argued that Ericsson TDoc was uploaded early enough that it was still the previous day (07 January) in some parts of the world, including parts of the US in the GMT-10 time zone, whereas the priority document was filed late enough that it was no longer 07 January anywhere in the world. Huawei submitted that as the TDoc was in principle accessible by residents of Hawaii on 07 January (and thus before the priority document's filing date), the TDoc formed a part of the state of the art for the purpose of novelty.

The appeal judge held that 'the date is determined in the time reference of that patent office', and that the filing/priority date is the 24-hour period (ie, day) in that time zone. Therefore the fact that the document was available to some members of the public on 07 January was irrelevant, as no member of the public **as measured in the time zone of the USPTO** was able to access this document before 08 January.

While this decision may be detrimental to those who genuinely publish documents in

[2017] EWCA Civ 266, 12 April 2017 relates LTE 4G telecommunications



these earlier time zones, as the published documents may not be citeable against competitor's applications filed the next day, it appears to be a logical conclusion on the matter. To take the alternative view would allow the publication of documents **after** the filing of an application that could be treated as a part of the state of the art for assessing patentability.

In view of this decision, there is no real impact to filing strategy for new applications; as ever, the earliest filing date possible should be sought for time-sensitive applications. That said, it may be beneficial to file first at the EPO rather than the USPTO for these applications so as to secure an 'earlier' 24-hour window as the filing date. In this case, if the Ericsson TDoc had been uploaded three hours earlier then it could have been prior art as assessed at the USPTO (as the publication time would have been 23:36 EST on 07 January) but not at the EPO (as this was 05:36 CET on 08 January). Therefore for an application filed at 16:59EST/22:59CET on 08 January (as in this scenario), the TDoc would be prior art for an application filed at the USPTO (as it was uploaded on 07 January in the USPTO's time zone) – but not if filed at the EPO (as it was uploaded on 08 January in the EPO's time zone).

Priority

This was a question of how the skilled person would interpret the teaching of a priority document. The priority document disclosed the feature of 'counting the number of transmitted data units', which had been held at first instance to include embodiments in which the counting was performed before transmission.

Huawei argued that this disclosure should be limited to embodiments in which the counting was performed after transmission, on the grounds that for this to be performed the data units must have been transmitted (otherwise they would be data units to be transmitted). In response to this, Unwired Planet argued that the skilled person would not be concerned with such a level of detail, and would adopt the approach known from common general knowledge in the absence of specific teaching to the contrary (broadly in line with the opinion of the judge in the first instance).

The appeal judge noted that "the exercise of determining priority involves asking whether the invention is directly and unambiguously derivable from the priority document, not whether every possible embodiment is so derivable". This position was seen as more reasonable than the alternative; to expect the patentee to describe every possible embodiment would not be reasonable.

The judge went on to state that the priority document should not be read in a vacuum, and that common general knowledge should be used to provide context for the disclosure. This approach seems reasonable, as the use of the common general knowledge at the priority date in interpreting a document cannot be seen to be adding to the disclosure in an inventive or non-obvious manner.

In summary, the appeal judge took the view that the skilled person would indeed...

[Continued overleaf]

Continued from page 07...

First Technical Appeal Decision Unwired Planet v Huawei

...interpret the priority document as having the broader meaning, as to ignore the well-known conventional approach would be to interpret the document in a vacuum. It was also emphasised that the threshold for entitlement to priority is significantly lower than that for determining the novelty of a claim.

Inventive step

This aspect of the appeal related to the judge's use of secondary evidence in the first instance. A document (Motorola TDoc) which had been submitted to the 4G standards body for consideration was relied upon as prior art. Motorola TDoc disclosed a polling method that uses a trigger based on byte count, rather than a PDU count. Huawei argued that at the time of the priority date, the skilled person would be concerned with a problem that required the counting of PDUs and therefore would combine the teachings of Motorola TDoc with a PDU counter known from the 3G standard.

Considering secondary evidence, such as minutes of the meetings of the standards committee, the judge determined that the method of Motorola TDoc had already been dismissed at the time of the priority date and that the committee were moving away from the idea of using a PDU counter generally. Huawei argued that the primary evidence (Motorola TDoc and expert witnesses' evidence) would lead to a conclusive determination of a lack of inventiveness, and that no amount of secondary evidence could override this.

The appeal judge noted that an appeal court is usually reluctant to interfere with any fact-based

finding on obviousness at the first instance unless there is an error of principle (in line with *MedImmune v Novartis* [2012] EWCA Civ 1234). The judge also went on to state that the arguments for a lack of inventiveness by Huawei (based on the primary evidence only) were not persuasive, as it was considered that there was a reliance on hindsight.

The use of hindsight was evidenced by the fact that only the byte counter was taken from Motorola TDoc, and as such the arguments from Huawei appeared to be more an identification of individual components from different sources rather than a coherent argument of obviousness. The judge also noted that the expert evidence appeared to take no account of a number of technical facts, and so was not persuasive.

The judge found that it was appropriate to turn to the secondary evidence in assessing the obviousness in this case; the judge at first instance had made it clear that they were aware of the evidential limitations of the secondary evidence, and had expressly warned against relying on this evidence too heavily. In any case, it was held that the secondary evidence suggested the same conclusion as the primary evidence and as a result the use of the secondary evidence was not unduly relied upon.

Summary

Huawei's appeal was dismissed in respect of each ground, and therefore Unwired Planet's patent was held to be both valid and infringed.

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