

EIP



UK High Court rules that an argument for equivalents needs more than just a “Like” in Facebook v Voxer

At a pre-trial review (“PTR”), heard on 19 March 2021, Lord Justice Birss, sitting down from the Court of Appeal, had to decide whether an infringement case based on the doctrine of equivalents which was brought after the initial Particulars of Infringement and Statement of Case on Infringement were served could be relied on by the patentee. In doing so, the Court also provided judgment on a point of principle about the way reliance on the doctrine of equivalents in patent cases should be pleaded.

Background

The case is a patent revocation action brought by Facebook Ireland Limited against the patentee Voxer IP LLC under the Short Trials Scheme (“STS”) (CPR Part 57A and PD57AB, Section 2). Voxer allege that the Facebook Live and Instagram Live live-streaming features infringe its patent. The trial under the STS is due to start on 13 April 2021. There is parallel litigation in Germany and in the United States.

In relation to Voxer’s case on infringement, Voxer served their Particulars of Infringement and following an order, at the case management conference, to serve further particulars, further served a Statement of Case on Infringement. In neither document was a reference made as to whether infringement was advanced based on the doctrine of equivalents (Actavis v Eli Lilly [2017] UKSC 48).

Issue

Relatively recently, Voxer served a draft amended Statement of Case on Infringement and sought to expand their infringement case in two respects based on the doctrine of equivalents. Facebook were prepared to accept one of the two new points but contended at the PTR that Voxer should not be permitted to advance the second one.

Facebook sought to rely on the IPEC case *Kwibolt v Airbus* [2019] EWHC 2450 (IPEC) (paragraph 14) arguing that one would normally expect a case under the doctrine of equivalents to be pleaded, including proper identification of the inventive concept. Voxer argued that there was no pleading requirement previously laid down in any decision of the Patents Court. Voxer added that *Kwibolt* was irrelevant because it was an IPEC case and in IPEC (by contrast with the STS) "all the facts and arguments" on which the party serving a pleading relies must be pleaded (CPR r63.20(1)).

The Court was clear that Voxer's submission on this was wrong but nevertheless went on to permit Voxer to run the new argument on case management grounds. However, the Court went on to lay down a point of principle about pleading reliance on the doctrine of equivalents for future patent cases. As a starting point, the Court made clear that reliance on the doctrine of equivalents as part of an infringement case must be set out in the Particulars of Infringement, with reference to CPR Part 63 r.63.6 and Practice Direction 63, paragraph 4.1. Although equivalents is not specifically mentioned in PD63 paragraph 4.1, it would be erroneous to think otherwise.

The Court also made reference to CPR Part 16 about Statements of Case in general. Rule 16.4(1)(a) provides that Particulars of Claim must include "a concise statement of the facts on which the claimant relies". The Court pointed out that a case based on the doctrine of equivalents inevitably involves an assertion or assertions of fact which are distinct from the general questions of fact arising in relation to infringement on a normal construction. The first and the second **Actavis** questions necessarily include such distinct issues of fact. Therefore, by the application of the general rule 16.4, equivalence to a particular claim feature must be pleaded.

Take away points

The Court has provided a clear judgment for future patent cases that reliance on the doctrine of equivalents is to be pleaded but stopped short of setting out details on how fully this needs to be done at the outset.

It seems enough, as per CPR r.16,4, for the Particulars of Infringement to contain a statement, by reference to each relevant claim that equivalence is relied on. Although, and probably as expected, if a patentee makes such an assertion which it cannot later explain in a claim chart or statement of case then no doubt the assertion will be struck out.

Additionally, for a normal multi-track Patents Court case, the time for a patentee to articulate their case on inventive concept and the other aspects of the test in Actavis would be when claim charts or a Statement of Case on Infringement is produced.

The judgment is available [here](#).

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