

United Kingdom

*Lionel Bently and Sir Richard Arnold*A. THE JURISDICTION OF THE COURTS TO GRANT INJUNCTIONS
IN PATENT CASES

Most UK patent litigation takes place in England and Wales, where it is heard by either the Patents Court (larger, more complex and/or more valuable cases) or the Intellectual Property Enterprise Court (smaller, less complex and/or less valuable cases). These are both specialised courts. It is normal in both courts for issues of infringement and validity of the patent to be heard together. The intellectual property bar in England and Wales consists of a considerable number of highly specialised and skilful advocates, most of whom have a Science, Technology, Engineering and Mathematics (STEM) degree as well as a legal qualification. They are instructed by both large multinational firms and small boutique firms of lawyers, and they are well known for being innovative, particularly with regard to procedural questions. Although there is a reasonable volume of UK patent litigation, disputes concerning injunctions are relatively infrequent.

Section 61(1) of the Patents Act 1977 provides:

Subject to the following provisions of this Part of this Act, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made –

- (a) for an injunction or interdict restraining the defendant or defender from any apprehended act of infringement.

This jurisdiction is not new. Injunctions have been granted in cases of infringement of patents since (at the very least) the eighteenth century.¹ Until the second half of the nineteenth century, such relief was only granted by the Court of Chancery, whereas patent cases were tried in Courts of Law. After the Judicature

¹ For an early treatment, see Hindmarch 1846, 361.

Acts, all branches of the High Court could grant injunctive relief. This jurisdiction is now recognised by section 37 of the Senior Courts Act 1981,² which states that the High Court “may by order (whether interlocutory or final) grant an injunction . . . in all cases in which it appears to the court to be just and convenient to do so”. Provided the court has *in personam* jurisdiction over the person against whom an injunction, whether interlocutory or final, is sought, the court has power to grant it.³ Nevertheless, the grant of injunctive relief is frequently described as being an “equitable remedy”, and therefore as being discretionary. This does not mean that injunctions are granted arbitrarily; they are granted in accordance with established principles. It does mean that those principles have evolved over time and can be adapted to deal with new situations.⁴

1. *Final Injunctions*

In *Coflexip SA v. Stolt Comex Seaway MS Ltd*, Aldous LJ explained the basic principle that a patentee who succeeds in establishing infringement will normally be entitled to a final injunction (also known as a permanent injunction, although such an injunction will expire when the patent expires, as discussed in Section H.1):⁵

Where a patentee has conclusively established the validity of his patent and that it had been infringed, as a general rule an injunction will be granted. However that will not happen as a matter of course as an injunction is a discretionary remedy. It is for that reason there have been cases where injunctions have been refused, for example, where the defendant satisfied the court that further infringement was not likely.

A final injunction may also be granted, even if the defendant has not yet infringed, if there is a sufficiently strong probability that the defendant will infringe unless restrained.⁶

2. *Interim Injunctions*

Interim injunctions (also known as interlocutory injunctions, preliminary injunctions or temporary restraining orders) are also available even though infringement

² See *Fourie v. Le Roux*, [2007] UKHL 1, [2007] 1 WLR 320, [25] (Lord Scott of Foscote).

³ *Id.* [30].

⁴ See in particular *Cartier International AG v. British Telecommunications plc* [2018] UKSC 28, [2018] Bus LR 1417 (holding that the High Court had power to grant injunctions requiring internet service providers to block access by their subscribers to infringing websites regardless of European law).

⁵ [2001] RPC 182, 186. For the suggestion that the Court of Chancery had a duty to award an injunction where validity and infringement of a patent had been established at Law, see *Bridson v. McAlpine* (1845) 8 Beav 229, 230, 50 ER 90, 90 (Lord Langdale MR) and *Davenport v. Jepson* (1862) 4 De G F & J 440, 446, 45 ER 1252, 1257 (Turner LJ).

⁶ See *Merck Sharp & Dohme Corp. v. Teva Pharma BV* [2013] EWHC 1958 (Pat), [2014] FSR 3.

has yet to be established. Historically, such relief was granted quite readily.⁷ Today interim injunctive relief may be granted on the basis of the principles elaborated in *American Cyanamid Co. v. Ethicon Ltd.*⁸ In *American Cyanamid* the claimant sought interim relief to restrain the defendant from infringing the claimant's patent for surgical sutures. The defendant company planned to argue at trial either that it had not infringed or that the claimant's patent was invalid. When considering whether to grant interim relief, the High Court and the Court of Appeal said that the key question was whether the claimant had established a strong prima facie case. In the High Court, Graham J found that the claimant had established a strong prima facie case and that the balance of convenience favoured the grant of interim relief. In the Court of Appeal, where argument had lasted for two weeks, Russell LJ held that no prima facie case of infringement had been proved, and so did not go on to consider the balance of convenience.⁹ Overturning this approach, the House of Lords rejected previous suggestions to the effect that a prima facie case must be established before a court could grant interim relief. Instead, the Lords laid down a reduced threshold requirement: for a court to be vested with the discretion to grant an interim injunction, it was only necessary for a claimant to establish that there was "a serious question to be tried". Once a claimant has established this, the House of Lords said that the court should then go on to consider a series of other matters. First, it should compare the possible effects of granting and not granting the injunction on the defendant and the claimant. Lord Diplock explained that this involved deciding whether the claimant's or defendant's interests were capable of being satisfied solely by financial means. If these considerations do not produce a clear indication of the best course of action, the court should consider the "balance of convenience". Finally, if there is no clear result from considering the balance of convenience, the court should look at the merits of the case.

The goal of *American Cyanamid* was to reduce the number of mini-trials that occurred at the interim stage and thereby speed up the process of granting interim

⁷ See Bottomley 2014. For an early example, see *Boulton v. Bull* (1796) 3 Ves 140, 30 ER 937 (Lord Loughborough LC) (maintaining injunction granted to Boulton even after inconclusive trial of action at law). Eldon LC made it a prerequisite that the patent had been in existence for some time: *Harmer v. Plane* (1807) 14 Ves Jr 130, 33 ER 470 (stating that an injunction would usually be granted if the plaintiff could demonstrate "reasonably long and undisputed possession under color of the patent", but that any such relief would be dissolved where there was "such strong doubt" as to the validity of the patent). In *Hill v. Thompson and Foreman* (1817) 3 Mer 622, 624–25, 36 ER 239, 240 Eldon LC again indicated that preliminary injunctive relief might be appropriate in the case of "an exclusive possession of some duration" but not if the patent were "of yesterday", in which case the Chancery court would send the patentee to a court of law while requiring a defendant to keep an account of sales. From the 1840s, courts became even more cautious, focusing on "balance of inconvenience". Soon after, it became normal for a court to require the plaintiff seeking interim relief to give undertakings to compensate the defendant for losses. See, e.g., *Bridson v. McAlpine* (1845) 8 Beav 229, 230, 50 ER 90, 90 (Lord Langdale MR).

⁸ [1975] AC 396.

⁹ [1974] FSR 312.

relief. In turn, it was thought that this would avoid duplication and produce a more efficient judicial process.

While the general applicability of *American Cyanamid* to intellectual property cases has been accepted, a number of exceptions have been introduced to the *American Cyanamid* approach. The most important of these was the recognition of the principle that, where the interim decision would be determinative of the action, the approach in *American Cyanamid* is not appropriate.¹⁰ This is because the problem which *American Cyanamid* seeks to redress, namely to minimise the harm when a preliminary decision turns out to have been incorrectly made, does not arise where the preliminary decision is going to be the only decision. In such cases the court should simply do its best to resolve the legal and factual issues on the material available.

In general, however, when considering the grant of interim relief the court should operate in two stages. First, the court should decide whether there is a serious question to be tried. In other words, if the evidence reveals that the claimant does not have any real prospect of succeeding in its claim for a permanent injunction at trial, the court will not even consider the balance of convenience. According to Lord Diplock, when determining whether there is a serious question to be tried, the court should only investigate whether a known cause for action is revealed. In so doing it should take account of points of law that necessarily arise on the facts that are revealed at the interlocutory stage. However, the courts should not embark upon mini-trials of disputed questions of fact or difficult questions of law.

Second, if the court decides that this threshold has been passed, it should then go on to consider whether to exercise its discretion to grant an injunction. That is, it will consider whether it would be fair to grant interim relief. The aim is to reduce the chances of the provisional decision providing an unjust result. In so doing, the court will focus on three factors: whether damages would be an adequate remedy for each party, the balance of convenience, and the relative strength of the parties' cases.

Although strictly persuasive rather than binding on English courts, the Privy Council¹¹ decision in *National Commercial Bank Jamaica Ltd v. Olint Corp* usefully explains the rationale for the approach taken to interim injunctions (albeit in a case concerned with bank accounts). It has been treated as authoritative in patent cases, at least by the High Court.¹² Lord Hoffmann giving judgment for the Privy Council stated:¹³

The purpose of such an injunction is to improve the chances of the court being able to do justice after a determination of the merits at the trial. At the interlocutory

¹⁰ *NWL Ltd v. Woods* [1979] 1 WLR 1294.

¹¹ The Judicial Committee of the Privy Council is the final court of appeal for Commonwealth countries that choose to retain it. It is composed of the same judges who formerly sat in the House of Lords and now sit in the UK Supreme Court.

¹² *Warner-Lambert Company LLC v. Actavis Group PTC EHF* [2015] EWHC 72 (Pat), [90]; *Warner-Lambert Company LLC v. Sandoz GmbH* [2015] EWHC 3153 (Pat), [82]; *Warner-Lambert Company LLC v. Sandoz GmbH* [2016] EWHC 3317 (Pat), [71] (Arnold J).

¹³ [2009] UKPC 16, [2009] 1 WLR 1405, [16].

stage, the court must therefore assess whether granting or withholding an injunction is more likely to produce a just result. As the House of Lords pointed out in *American Cyanamid Co v Ethicon* [1975] AC 396, that means that if damages will be an adequate remedy for the plaintiff, there are no grounds for interference with the defendant's freedom of action by the grant of an injunction. Likewise, if there is a serious issue to be tried and the plaintiff could be prejudiced by the acts or omissions of the defendant pending trial and the cross-undertaking in damages would provide the defendant with an adequate remedy if it turns out that his freedom of action should not have been restrained, then an injunction should ordinarily be granted.

He went on:¹⁴

In practice, however, it is often hard to tell whether either damages or the cross-undertaking will be an adequate remedy and *the court has to engage in trying to predict whether granting or withholding an injunction is more or less likely to cause irreparable prejudice* (and to what extent) if it turns out that the injunction should not have been granted or withheld, as the case may be. The basic principle is that the court should take whichever course seems likely to cause the least irreparable prejudice to one party or the other.

Lord Hoffmann listed a number of matters which the court may take into account:¹⁵

[T]he prejudice which the plaintiff may suffer if no injunction is granted or the defendant may suffer if it is;

the likelihood of such prejudice actually occurring;

the extent to which it may be compensated by an award of damages or enforcement of the cross-undertaking;¹⁶

the likelihood of either party being able to satisfy such an award; and

the likelihood that the injunction will turn out to have been wrongly granted or withheld, that is to say, the court's opinion of the relative strength of the parties' cases.

In practice, interim injunctions are relatively rare in patent cases these days, because the courts' preference is to order a speedy trial instead. The principal situation in which interim injunctions are granted is where a generic version of a pharmaceutical product is launched for the first time, since it is generally accepted that this will quickly cause the patentee irreparable harm.¹⁷ In such cases the grant of an interim injunction is frequently combined with an order for a speedy trial.

¹⁴ *Id.*, [17] (emphasis added).

¹⁵ *Id.*, [18].

¹⁶ If there is doubt about whether the claimant will have funds available to compensate the defendant pursuant to its cross-undertaking, a possible solution is to require the claimant to fortify the cross-undertaking in some way, e.g., by obtaining a bank guarantee or insurance bond.

¹⁷ See in particular *SmithKline Beecham plc v. Apotex Europe Ltd* [2003] EWCA Civ 137, [2003] FSR 31. For an exception to this general rule, see *Neurim Pharmaceuticals (1991) Ltd v. Generics UK Ltd* [2020] EWCA Civ 793.

In *Novartis AG v. Hospira UK Ltd* the Court of Appeal granted an interim injunction pending an appeal in a case where the patent had been held invalid at first instance (no interim injunction had been granted or was necessary prior to the judgment because the party attacking the patent had given a voluntary undertaking). Floyd LJ explained that, provided the appeal stood a real prospect of success, the principles to be applied in such circumstances were similar to the *American Cyanamid* principles.¹⁸

3. *Enforcement of Injunctions: Contempt of Court*

If an injunction is granted, breach of the injunction is a contempt of court, which renders the defendant (or in the case of a corporate defendant, its directors) liable to be committed (i.e. imprisoned) for up to two years or have its assets sequestered or fined. Whether the injunction has been breached is an objective question. The defendant's intention (or lack of it) is generally relevant only to the sanction, but the court can dismiss a committal application where it is a disproportionate reaction to a trivial or blameless breach of an order.¹⁹ Because breach of the injunction can be punished in this way, it is not the practice of courts in the United Kingdom to specify in advance payments which must be made in the event of non-compliance, as in some member states of the EU such as France and Germany.

The courts have sometimes expressed discomfort where a motion for committal ends up as, in essence, a question of patent interpretation.²⁰ Instead of bringing an application that the defendant be committed, a party may apply for a declaration of non-compliance. In *Hotel Cipriani Srl v. Fred 250 Ltd*,²¹ Arnold J described this as "a low key method of enforcing [an] Injunction", where penal sanctions were clearly inappropriate. Such an application is particularly likely to be appropriate in a case where there is a genuine dispute as to whether the defendant is in breach, e.g., where the defendant has redesigned its product in an attempt to work around the injunction.

B. FORM OF COURT ORDERS IN WHICH INJUNCTIONS ARE GRANTED

1. *Final Injunctions against Primary Infringers*

In *Coflexip SA v. Stolt Comex MS Ltd*,²² Laddie J granted an injunction that specified the zone of prohibited behaviour:

¹⁸ *Novartis AG v. Hospira UK Ltd* [2013] EWCA Civ 583, [2014] 1 WLR 1264, [41]

¹⁹ *Adam Phones Ltd v. Goldschmidt* [2000] FSR 163.

²⁰ See *Multiform Displays Ltd v. Whitmarley Displays Ltd* [1956] RPC 143, 154 (Birkett LJ), 157–58 (Romer LJ), [1957] RPC 260, 262 (Viscount Simmonds).

²¹ [2013] EWHC 70 (Ch), [2013] FSR 34, [7]. See also *Illumina Inc. v. TDL Genetics Ltd* [2019] EWHC 2405 (Pat).

²² [1999] FSR 473.

The Defendants and each of them be restrained . . . from using or offering for use in the United Kingdom (or in an area designated by Order under section 1(7) of the Continental Shelf Act 1964) a process for laying flexible conduit employing a Flexible Lay System of the design installed in the Seaway Falcon and described in the Defendant's Product and Process Description dated 27th March 1997 which process includes at least one occasion on which the flexible conduit being laid incorporates a rigid accessory (whether made from joined end fittings or not) within its length.

In *Nutrinova Nutrition Specialities & Food Ingredients GmbH v. Scanchem UK Ltd* (No. 2),²³ Pumfrey J granted an injunction in a narrow form against a good-faith infringer:

It seems to me that if an order in the wide form is made there is a substantial possibility that a difficult question of infringement would have to be decided on a motion to commit. I agree with paragraphs 27 and 28 of Laddie J's judgment in the *Coflexip* case in thinking that it is no answer to this objection to say that it is always open to the defendant to approach the court for a decision that his new course of action does not fall within the scope of the wider form of injunction. To advocate such a course is to assume tacitly that it is more likely that the infringer who has been guilty once will be guilty again. If the facts do not otherwise justify this assumption, it should not be made. I do not think that Scanchem is a willing infringer, and I do not consider that it is guilty of taking a Nelsonian approach to the process operated by its supplier. Since I do not consider that Scanchem has conducted itself in bad faith, I have come to the conclusion that a narrower form of injunction is appropriate. The injunction will be against importing acesulphame K from Beijing Vitasweet. There will be an express liberty to apply to both parties.

On appeal in *Coflexip*, Aldous LJ reasserted the traditional English approach and explained why the normal form of the injunction – that the defendant “be restrained from infringing patent number” – was to be preferred.²⁴

It is important that an order, such as an injunction, is drafted so as to set out, with such clarity as the context admits, what may not be done. It is for that reason that the standard form of injunction is in the terms restraining the defendant from infringing the patent. Such an injunction is limited in term and confined to the right given by section 60(1) and (2) of the Patents Act. It also excludes acts, carried out by the defendant and which fall within the ambit of the monopoly, but are excluded from infringement by the Act; for example private use coming within section 60(5)(a) of the Act. Such an injunction is confined to the monopoly as claimed. The claim has been construed by the court with the aid of the parties and in the context of the acts alleged by the plaintiff to infringe and any other potentially

²³ [2000] EWHC 124 (Pat), [2001] FSR 43, [20].

²⁴ *Coflexip SA v. Stott Comex Seaway MS Ltd* [2001] RPC 9, [14].

infringing acts which the defendant wishes to bring before the court. Of course a dispute can arise as to whether acts, not brought before the court, amount to a breach of the injunction. But such a dispute arises against the background where the ambit of the claim and therefore the injunction has been the subject of consideration by the court and has been construed by it.

Later he added:²⁵ “The usual form of injunction which protects the right established by the patentee, with its ambit construed by the court, does in general provide a fair solution. However each case must be determined on its own facts and the discretion exercised accordingly.” Although this is the orthodox form of the injunction, different forms may be appropriate where infringement is, for example, by importation.

In *Sun Microsystems Inc. v. M-Tech Data Ltd*, a trademark case concerning parallel imports, Kitchin J awarded an injunction qualified so that the defendants could be informed whether the parts had previously been placed on the market in the EU. In the Supreme Court, Lord Sumption described it as follows:²⁶

In the form that Kitchin J granted it, the injunction restrained only the marketing by M-Tech within the EEA of Sun’s trade-marked goods which had not previously been marketed there by Sun or with its consent. There is a proviso designed to ensure that Sun does supply information about the provenance of goods potentially affected by the injunction. Its effect is that the injunction is not to apply to goods marketed by M-Tech unless Sun have confirmed within ten days of being told the serial and part numbers of the goods in question that their records show that they have not been put on the EEA market by them or with their consent.

There is no reason to think the same form of injunction would not have been appropriate had importation of the computer parts been patent-infringing.

Although the Court of Appeal suggested in *Warner-Lambert Company LLC v. Actavis Group PTC EHF* that an injunction might be qualified (or even refused) in cases involving infringement of a Swiss form claim by the marketing of a generic pharmaceutical under a so-called skinny label (a marketing authorisation for the old, off-patent use of the drug, but not for the patented second medical use),²⁷ this suggestion has been rejected by the Supreme Court as a solution to the difficulties posed by such cases, since there would remain problems with the financial remedies which flow from a finding of infringement.²⁸

²⁵ *Id.*, [20].

²⁶ *Sun Microsystems Inc. v. M-Tech Data Ltd* [2012] UKSC 27, [2012] 1 WLR 2026, [10].

²⁷ *Warner-Lambert Company LLC v. Actavis Group PTC EHF* [2015] EWCA Civ 556, [2015] RPC 25, [130] (Floyd LJ). See also *Generics (UK) Ltd v. Warner-Lambert Company LLC* [2016] EWCA Civ 1006, [2017] RPC 1, [187] (Floyd LJ).

²⁸ *Generics (UK) Ltd v. Warner-Lambert Company LLC* [2018] UKSC 56, [2019] Bus LR 360, [80] (Lord Sumption and Lord Reed), [159] (Lord Briggs), [188] (Lord Hodge), [203] (Lord Mance).

2. Final Injunction against Indirect Infringer

In *Grimme Landmaschinenfabrik GmbH & Co. KG v. Scott*, Jacob LJ considered whether a different form of injunction was appropriate in a case of indirect infringement, but concluded that normally it would not be appropriate:²⁹

It might be suggested . . . that [the court's] practice should be different in the case of contributory infringement where what is sold by the defendant does not itself infringe and has a non-infringing use. The suggestion might be that the court should modify the injunction so as to try to spell out what it is that the defendant can do. We would not have thought that normally appropriate: it will be up to the defendant to work out how to ensure that there is no ultimate infringement. Of course, if he does take reasonable steps but they turn out unexpectedly to be ineffective, enforcement of the injunction by launching proceedings for contempt of court instead of a fresh action for infringement may be inappropriate: see *Multiform Displays v. Whitmarly Displays*.

3. Interim Injunctions

In contrast with the form of order granted in final injunction cases, in interim injunctive relief cases it is normal for the court to draw up something more specific. *Terrell on Patents* explains:³⁰

With any injunction or undertaking pending trial, it is desirable that the defendant should know, with as much certainty as possible, what they may, or may not do. This is also in the claimant's interest as any breach is easier to identify and enforce. Accordingly the injunction should be directed towards restraining a specific act in relation to a particular product or process rather than infringing the claimant's patent generally.

Terrell relies on the authority of *Staver Co. Inc. v. Digitext Display Ltd*, a decision of Scott J in a copyright case. There, Scott J had granted an interim injunction against the defendant ordering it not to infringe copyright. Having redesigned its product, the defendant sought to vary the injunction, claiming that the redesign did not infringe. In effect, to determine whether the variant avoided infringement, the court was being asked to rule on the substantive issue. As a result, it was clear to the judge that the original form of the injunction was inappropriate. He explained:³¹

These difficulties arise out of the form of the injunction. . . . Mr. Thorley tells me that the form is one commonly used for interlocutory injunctions in breach of

²⁹ *Grimme Landmaschinenfabrik GmbH & Co. KG v. Scott* [2010] EWCA Civ 1110, [2011] FSR 7, [134].

³⁰ [2020], 19–261.

³¹ *Staver Co. Inc. v. Digitext Display Ltd* [1985] FSR 512, 519.

copyright cases. In my judgment, however, the form is not satisfactory. It is essential that a party who is subject to an interlocutory injunction should know what he can and cannot do pending trial. An order which makes the identification of what is permissible and what is prohibited depend on what happens at trial does not satisfy this requirement . . .

The discussion in this case has satisfied me that there are grave objections in principle to the granting of interlocutory injunctions in a form that appears to anticipate the plaintiff's success at trial. In my view, interlocutory injunctions ought, in cases like the present, and perhaps in many other types of case, to identify the prohibited acts in a manner which is not dependent on the resolution of factual triable issues.

The order was varied so that it prevented the manufacture and sale by the defendant of the particular items (which had been made by the defendant) which the plaintiff claimed to be infringing copies or of any colourable adaptation thereof. Since *Staver v. Digitext* this practice has generally been followed when granting interim injunctions in intellectual property cases.³² Thus the order will specify precisely the particular acts which are prohibited (such as selling particular identified goods) rather than merely prohibiting infringement in general terms.

C. DENIAL OF A FINAL INJUNCTION, BUT GRANT OF REMEDIAL MEASURES

Where the defendant has committed an infringement but there is no evidence of an intention to infringe again, no injunction will be granted. Thus in *Proctor v. Bayley*, the Court of Appeal reversed the grant of an injunction on the basis that it was unlikely that the defendant would infringe again, since it had already stopped the infringing acts for other reasons. Cotton LJ said:³³

Where a patent is infringed the patentee has a *prima facie* case for an injunction, for it is to be presumed that an infringer intends to go on infringing, and that the patentee has a right to an injunction to prevent his doing so. Again if there has not been any infringement, but an intention to infringe is shewn, an injunction will be granted. In the present case the Defendants have infringed the patent, but we must look at all the circumstances to see whether there is any ground for inferring that they intend to continue to infringe it. . . . Now the circumstances are that the Defendants used four of these [infringing] stokers for a short period, and the use of them was finally discontinued in 1883 on the ground that the Defendants found the machines to be useless. Under these circumstances is there any probability that the Defendants will again infringe the patent? I should say certainly not.

³² See *Celgard, LLC v. Shenzhen Senior Technology Material Co. Ltd* [2020] EWCA Civ 1293, [2021] FSR 1 [47] (Arnold LJ) (a trade secrets case).

³³ *Proctor v. Bayley* (1889) 42 Ch 390, 398.

Fry LJ said,³⁴ “an injunction is granted for prevention, and where there is no ground for apprehending the repetition of a wrongful act there is no ground for an injunction”.

D. GRANT OF ONGOING ROYALTY/DAMAGES IN LIEU OF FINAL INJUNCTIONS

Section 50 of the Senior Courts Act 1981 now provides: “Where the Court of Appeal or the High Court has jurisdiction to entertain an application for an injunction or specific performance, it may award damages in addition to, or in substitution for, an injunction or specific performance.” This jurisdiction is normally traced back to Lord Cairns’ Act.³⁵ It enables the courts to refuse an injunction and award damages instead.

Until recently, the applicable principles were established by the late nineteenth-century nuisance case, *Shelfer v. City of London Lighting Co. Ltd*, where the Court of Appeal reversed a decision in which Kekewich J had awarded the lessee of a public house damages rather than an injunction against an electric company in relation to noise and structural damage caused by the latter’s engines. There, A. L. Smith LJ said that it was “a good working rule” that:³⁶

- (1) If the injury to the plaintiff’s legal rights is small,
- (2) And is one which is capable of being estimated in money,
- (3) And is one which can be adequately compensated by a small money payment,
- (4) And the case is one in which it would be oppressive to the defendant to grant an injunction: – then damages in substitution for an injunction may be given.

On the facts, the court thought it was clearly not a case of exceptional circumstances justifying an award of damages in lieu. Although some of the criteria established by the Court of Appeal are open-textured, and thus imply some judicial flexibility, the fact that they are cumulative produces the opposite effect.

Although originally formulated in a nuisance case, the *Shelfer* principles have been applied in other cases concerning real property, and also (by analogy with real property) to intellectual property cases.³⁷ In *Navitaire Inc. v. easyJet Airline Co. Ltd* (No. 2)³⁸ (a copyright case) Pumfrey J refused to grant an injunction on this basis, saying: “My understanding of the word ‘oppressive’ in this context is that the effect of

³⁴ *Id.*, 401.

³⁵ The Chancery Amendment Act 1858 (21 & 22 Vict c. 27).

³⁶ *Shelfer v. City of London Lighting Co. Ltd* [1895] 1 Ch 287, 322–23.

³⁷ For example, *Banks v. EMI Songs Ltd* (No. 2) [1996] EMLR 452 (a copyright case).

³⁸ [2005] EWHC 282 (Ch), [2006] RPC 4, [104]. This statement was cited with approval in *Virgin Atlantic Airways Ltd v. Premier Aircraft Interiors Ltd* [2009] EWCA Civ 1513, [2010] FSR 15, [25] (Jacob LJ).

the grant of the injunction would be grossly disproportionate to the right protected. The word ‘grossly’ avoids any suggestion that all that has to be done is to strike a balance of convenience.”

In *HTC Corp. v. Nokia Corp. (No. 2)*,³⁹ Arnold J recognised that, in principle, the case law of Court of Justice of the European Union,⁴⁰ interpreting the intellectual property rights (IPR) Enforcement Directive,⁴¹ required the English courts to deviate from the relatively inflexible *Shelfer* principles:⁴²

In my view, the time has come to recognise that, in cases concerning infringements of intellectual property rights, the criteria to be applied when deciding whether or

³⁹ [2013] EWHC 3778 (Pat), [2014] RPC 30, [27]. This is unaffected by the Court of Appeal’s reversal of another part of this judgment: [2013] EWCA Civ, [2014] RPC 31. See also *Sky Ltd v. Skykick UK Ltd* [2020] EWHC 1735 (Ch), [2020] ETMR 50, [27]–[32] (Arnold LJ) (a trademark case).

⁴⁰ See Case C-275/06 *Productores de Musica de Espana (Promusicae) v. Telefonica de Espana SAU* [2008] ECR I-271, [68]–[70]; Case C-235/09 *DHL Express France SAS v. Chronopost SA* [2011] ECR I-2801, [58]; Case C-324/09 *L’Oreal SA v. eBay International AG* [2011] ECR I-6011, [140]–[144]; Case C-70/10 *Scarlet Extended SA v. Societe Beige des Auteurs, Compositeurs et Editeurs (SABAM)* [2011] ECR I-11959, [36] and Case C-360/10 *Belgische Vereniging van Auteurs, Componisten en Uitgevers CVBA (SABAM) v. Netlog NV* [EU:C:2012:85], [34]. See also four more recent cases: Case C-314/12, *UPC Telekabel Wien GmbH v. Constantin Film Verleih GmbH* [EU:C:2014:192], [46]; Case C-580/13 *Coty Germany GmbH v. Stadtsparkasse Magdeburg* [EU:C:2015:485], [34]–[35]; Case C-494/15 *Tommy Hilfiger Licensing LLC v. Delta Center as* [EU:C:2016:528], [32]–[36]; and Case C-484/14 *McFadden v. Sony Music Entertainment Germany GmbH* [EU:C:2016:689], [83].

⁴¹ Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights [2004] OJ L195/16 (IPRED). Case-law decided by the CJEU under that Directive prior to 1 January 2020 remains “retained case-law” binding on the lower courts of the United Kingdom as regards the interpretation of “retained EU law” (e.g. EU-derived legislation), though capable of being deviated from by the Court of Appeal or Supreme Court: European Union (Withdrawal) Act 2018 (as amended) (EU(W)A), ss. 2–4 (on “retained EU law”), s. 6(3) (“retained EU case-law”) s 6(4) and European Union (Withdrawal) Act 2018 (Relevant Court) (Retained EU Case Law) Regulations 2020 (SI 2020/1525) (on power to deviate). While Article 3(2) of the EU Enforcement Directive had not been expressly implemented (so is not “retained EU law” by virtue of EU(W)A, s. 2), because that Article was directed at the courts, it had so-called “vertical direct effect” to bring it within EU(W)A, s. 4. Moreover, although based on the Directive, that direct effect had been recognised by the courts which had treated it as binding and applied in domestic case-law. As a result, there can be no doubt that Article 3(2) of IPRED, in general, and the proportionality requirement more specifically, constitute “retained EU law”. If there were any doubt, it is notable too that Article 3(2) of the IPRED is replicated in the UK–EU Trade and Cooperation Agreement, Article 256, and, this is automatically implemented in UK law through the European Union (Future Relationship) Act 2020, s. 29.

In contrast, the United Kingdom had not implemented the optional provision in Article 12 of the Directive, but being optional, there was no direct effect and it is not retained EU law.

⁴² Another factor which supported the same conclusion was Article 16 of the Charter of Fundamental Rights of the European Union (freedom to conduct a business) and the case law of the CJEU holding that a fair balance must struck between this and intellectual property rights protected by Article 17(2): see in particular Case C-484/14 *McFadden v. Sony Music Entertainment Germany GmbH* [EU:C:2016:689], [80]–[101].

not to grant an injunction are those laid down by Article 3(2): efficacy, proportionality, dissuasiveness, the avoidance of creating barriers to legitimate trade and the provision of safeguards against abuse.

However, looking more closely at the effect of a decision to decline injunctive relief, and the rules on compulsory licensing in the Agreement on Trade Related Aspects of Intellectual Property (TRIPS), Arnold J concluded that the difference between *Shelfer* and the approach under the Enforcement Directive in patent cases is probably not that significant:⁴³

Drawing these threads together, I consider that Article 3(2) of the Enforcement Directive permits and requires the court to refuse to grant an injunction where it would be disproportionate to grant one even having regard to the requirements of efficacy and dissuasiveness. Where the right sought to be enforced by the injunction is a patent, however, the court must be very cautious before making an order which is tantamount to a compulsory licence in circumstances where no compulsory licence would be available. It follows that, where no other countervailing right is in play, the burden on the party seeking to show that the injunction would be disproportionate is a heavy one. I suspect that the practical effect of this approach is little different to Pumfrey J's test [in *Navitaire v. easyJet*] of "grossly disproportionate".

On the specific facts of the case, he concluded that an injunction should be granted. He summarised his reasons as follows:⁴⁴

Taking all of the factors relied on by the parties into account, ... I am not persuaded that this is a case in which I should exercise my discretion to award damages in lieu of an injunction. Nokia has a legitimate interest in seeking a final injunction to prevent further exploitation of the patented invention by HTC without its consent. This is not a case in which the injury to the patent is small, capable of being estimated in money and adequately compensated by a relatively small money payment. If an injunction were refused, it would have to be on the basis of an order for a running royalty. In those circumstances, refusal of an injunction would be tantamount to imposing a compulsory licence on Nokia in circumstances where HTC could not obtain a compulsory licence by the proper route.⁴⁵ Most importantly, the grant of a final injunction would not be disproportionate. The grant of an injunction will not deliver HTC over to Nokia "bound hand and foot, in order to be made subject to any extortionate demand" Nokia may make, because HTC already has some non-infringing alternatives available to it, could have had more non-infringing alternatives available to it by now if it had acted promptly when first sued by Nokia and will in any event have more non-

⁴³ *HTC Corp. v. Nokia Corp.* [2013] EWHC 3778 (Pat), [2014] RPC 30, [32]. This statement was followed in *Evalve Inc. v. Edwards Lifesciences Ltd* [2020] EWHC 513 (Pat), [57] (Birss J).

⁴⁴ *Id.*, [74].

⁴⁵ Under the Patents Act 1977, s. 48A which gives effect to Article 31 of TRIPS.

infringing alternatives available to it in a period which is significantly shorter than the remaining term of the patent.

It can be seen from this reasoning that an important consideration is the availability to the defendant of ways to work around the injunction.

In *Napp Pharmaceutical Holdings Ltd v. Dr Reddy Laboratories (UK) Ltd* Arnold J considered the application of *HTC v. Nokia* to a hypothetical situation in which the court concluded on the balance of probabilities that production variables meant that the defendant would sell 2,000 infringing products randomly distributed among 1,998,000 non-infringing products, and also concluded that that quantity could not be discounted as *de minimis*.⁴⁶

I consider that an injunction would be both disproportionate and a barrier to legitimate trade. It would be disproportionate because the harm to the patentee from infringement on such a small scale would be indistinguishable from the harm caused by wholly non-infringing acts. It would be a barrier to legitimate trade because the practical effect of such an injunction would be to require the defendant to operate even further outside the boundaries of the claim, and thus would effectively extend the scope of the patentee's monopoly. In such a case, the appropriate remedy would be a financial one.

Shortly after the decision in *HTC v. Nokia*, the Supreme Court held in *Lawrence v. Fen Tigers Ltd*⁴⁷ that the approach to be adopted by a judge when being asked to award damages in lieu of an injunction in a nuisance case should be much more flexible than that suggested by earlier Court of Appeal authorities such as *Shelfer*. The leading judgment was given by Lord Neuberger, who said that the court's power to award damages instead of an injunction involved a classic exercise of discretion which should not, as a matter of principle, be fettered.⁴⁸ He went on:

[123] Where does that leave A. L. Smith LJ's four tests? While the application of any such series of tests cannot be mechanical, I would adopt a modified version of the view expressed by Romer LJ in *Fishenden* . . . First, the application of the four tests must not be such as "to be a fetter on the exercise of the court's discretion". Secondly, it would, in the absence of additional relevant circumstances pointing the other way, normally be right to refuse an injunction if those four tests were satisfied. Thirdly, the fact that those tests are not all satisfied does not mean that an injunction should be granted.

[124] As for the . . . public interest, I find it hard to see how there could be any circumstances in which it arose and could not, as a matter of law, be a relevant factor. Of course, it is very easy to think of circumstances in which it might arise but did not begin to justify the court refusing, or, as the case may be, deciding, to award

⁴⁶ *Napp Pharmaceutical Holdings Ltd v. Dr Reddy Laboratories (UK) Ltd* [2016] EWHC 1517 (Pat), [170].

⁴⁷ [2014] UKSC 13, [2014] AC 822.

⁴⁸ *Id.*, [119]–[120].

an injunction if it was otherwise minded to do so. But that is not the point. The fact that a defendant's business may have to shut down if an injunction is granted should, it seems to me, obviously be a relevant fact, and it is hard to see why relevance should not extend to the fact that a number of the defendant's employees would lose their livelihood, although in many cases that may well not be sufficient to justify the refusal of an injunction.

In *Evalve Inc. v. Edwards Lifesciences Ltd*,⁴⁹ Birss J held that *Lawrence* required a more flexible approach than that adopted in *Shelfer*, but that, when considering whether an injunction should be denied on public interest grounds, it was still necessary for the court to take into account the considerations identified by Aldous J in the earlier case of *Chiron Corp. v. Organon Teknika Ltd (No. 10)*,⁵⁰ namely the nature of patent monopolies and the fact that the Patents Act already places limits on patents in order to safeguard the public interest by virtue of the provisions for compulsory licensing, Crown use and exceptions to infringement.

Where damages are awarded in lieu of an injunction, they are to be assessed "once and for all" in respect of all future infringements.⁵¹ The quantum of such damages will be the amount of money which could reasonably have been demanded by the claimant for consent to such acts (sometimes referred to as "negotiating damages"⁵²). It appears that this enables the court to order damages assessed as an ongoing royalty,⁵³ but possibly not to order an account of (the defendant's) profits (which is an alternative remedy to damages in English law).⁵⁴ There is no English patent case yet in which such damages have been assessed, but in principle it appears that they would fall to be assessed in the same way as ordinary damages for patent infringement: if the patentee exploits the patent through marketing products, then it can recover lost profits caused by the infringement; if the patentee exploits the patent through licensing, then it can recover the licensee fees the defendant should have paid; otherwise the patentee can recover a reasonable royalty which represents what a willing licensor and a willing licensee would have agreed (based, for example, on comparable licences).⁵⁵ Assessing such damages is hard enough (because it tends to involve difficult questions of causation and complex financial evidence) for past infringements, but it would appear likely to be even more challenging in the case of future infringements.⁵⁶

⁴⁹ [2020] EWHC 513 (Pat), [47]–[58].

⁵⁰ [1995] FSR 325. See also *Biogen Inc. v. Medeva plc* [1993] RPC 475 and *Kirin-Amgen Inc. v. Transkaryotic Therapies Ltd (No. 3)* [2005] FSR 41, [27] (Neuberger J).

⁵¹ See *Jaggard v. Sawyer* [1995] 1 WLR 269, 280–81 (Sir Thomas Bingham MR), 285–86 (Millett LJ).

⁵² See *Morris-Gamer v. One Step (Support) Ltd* [2018] UKSC 20, [2018] 2 WLR 1353.

⁵³ *HTC Corp. v. Nokia Corp.* [2013] EWHC 3778 (Pat), [2014] RPC 30, [14].

⁵⁴ See *GlaxoSmithKline UK Ltd v. Wyeth Holding LLC* [2017] EWHC 91 (Pat).

⁵⁵ See in particular *General Tire & Rubber Co. Ltd v. Firestone Tyre & Rubber Co. Ltd (No. 2)* [1975] 1 WLR 819.

⁵⁶ See *Evalve Inc. v. Edwards Lifesciences Ltd* [2020] EWHC 513 (Pat), [59]–[66] (Birss J).

E. PARTIAL DENIAL OF INJUNCTIVE RELIEF FOR A SUB-GROUP
OF INFRINGING ACTS

In *Edwards Life Sciences LLC v. Boston Scientific Scimed Inc. (No. 3)*,⁵⁷ the High Court recognised that there may be circumstances where carve-outs to an injunction are required in the public interest. There, the High Court found that the ELS's transcatheter heart valve (THV) called the Sapien 3 infringed BS's patent.⁵⁸ Although HHJ Hacon granted an injunction, he expressed the view that, if the matter were going no further, he would "certainly be limiting that injunction by reference to the cohort of patients whose lives or health would potentially be put at risk by the grant of an injunction". His conclusion on infringement was upheld by the Court of Appeal, which remitted the issue of whether the injunction should be limited to the High Court.⁵⁹ At the hearing before the High Court, it was common ground that the injunction should be stayed for a period, and then qualified for a further period, with respect to supplies of the Sapien 3 in the public interest having regard to the impact that the injunction would have upon the health of patients with aortic stenosis. The disputes were as to (i) the length of the stay and (ii) the scope and duration of the qualification.

So far as issue (ii) was concerned, Arnold J held that the court must strike a balance between the patentee's interest in maintaining the monopoly conferred by the patent and the public interest in ensuring that patients with aortic stenosis receive appropriate treatment. Having found that there was a small but growing number of patients for whom the Sapien 3 was the only suitable device, he held that an exception to the injunction was justified by the need to protect the health of those patients. These would be identified by requiring an appropriate declaration from the responsible clinician to the effect that the patient fell into one of the groups for whom there was no alternative to the Sapien 3. Recognising that non-infringing alternatives might come onto the market, the judge gave the patentee permission to apply to terminate the exception should it no longer be essential to the treatment of the relevant groups of patients.

F. DENYING INJUNCTIVE RELIEF AGAINST A CERTAIN TYPE
OF DEFENDANT AS SUCH

1. *The Crown*⁶⁰

Patent law applies to the Crown, which has no immunity from claims for infringement. Thus section 129 of the Patents Act 1977 states that "This Act . . . binds the Crown". Moreover, section 3 of the Crown Proceedings Act 1947 provides:

⁵⁷ [2018] EWHC 1256 (Pat), [2018] FSR 31.

⁵⁸ *Edwards Life Sciences LLC v. Boston Scientific Scimed Inc. (No. 3)* [2017] EWHC 755 (Pat).

⁵⁹ *Edwards Life Sciences LLC v. Boston Scientific Scimed Inc. (No. 3)* [2018] EWCA Civ 673, [2018] FSR 29.

⁶⁰ In this context "the Crown" means the government.

Civil proceedings lie against the Crown for an infringement committed by a servant or agent of the Crown, with the authority of the Crown, of:–

- (a) a patent, . . . but save as provided by this subsection no proceedings lie against the Crown by virtue of this Act in respect of an infringement of any of those rights.

However, while an action for damages for patent infringement may be brought against the Crown, it seems no injunctive relief is available. Section 21 of the Crown Proceedings Act states (emphasis added):

- (1) In any civil proceedings by or against the Crown the court shall, subject to the provisions of this Act, have power to make all such orders as it has power to make in proceedings between subjects, and otherwise to give such appropriate relief as the case may require:

Provided that:–

- (a) where in any proceedings against the Crown any such relief is sought as might in proceedings between subjects be granted by way of injunction or specific performance, *the court shall not grant an injunction or make an order for specific performance, but may in lieu thereof make an order declaratory of the rights of the parties*; and . . .
- (2) The court shall not in any civil proceedings grant any injunction or make any order against an officer of the Crown if the effect of granting the injunction or making the order would be to give any relief against the Crown which could not have been obtained in proceedings against the Crown.

It appears that the rationale underlying this provision is that the Crown has a duty to obey the law as declared by the courts, and no injunction is necessary.⁶¹ In practice, the use of an invention by the Crown is normally dealt with under the provisions of sections 55–59 of the Patents Act 1977, which enable the terms for such use to be settled by the courts in the event of dispute. These provisions could be regarded as a form of compulsory licensing, and their compatibility with TRIPs remains to be tested.

2. *Compulsory Licensing and Licences of Right*

A patentee may voluntarily choose to make licences available “as of right” and the patent fees offer a (mild) incentive to do so.⁶² As a result of such a declaration, any person that wishes to become a licensee under the patent is so entitled on “such terms as may be settled by agreement or, in default of agreement, by the

⁶¹ See *R v. Secretary of State for Transport ex p. Factortame Ltd* [1990] 2 AC 85, 150 (Lord Bridge of Harwich); but see also *Re M* [1994] 1 AC 377 (holding that an injunction may be granted against a minister acting in his official capacity).

⁶² Patents Act 1977, s. 46(1). The renewal fees are halved: s. 46(3)(d).

comptroller". If, after a patent has been endorsed in this way, a patentee brings infringement proceedings and the defendant undertakes to take a licence on such terms, no injunction shall be granted against the defendant.⁶³ In addition, the amount (if any) recoverable against the defendant by way of damages shall not exceed double the amount which would have been payable as licensee if such a licence on those terms had been granted before the earliest infringement.⁶⁴

Compulsory licences are available under sections 48–53 of the Patents Act 1977 (as amended).⁶⁵ Although it is difficult to epitomise these provisions,⁶⁶ in essence, section 48A provides for the possibility of such licences being granted when a patented invention is not being exploited so as to meet "demand in the United Kingdom . . . on reasonable terms",⁶⁷ where as a result of refusal to grant a licence on reasonable terms, exploitation of other inventions are being hindered, or are insufficient,⁶⁸ or where the refusal to license or the conditions imposed on licensees prejudice local production or commercial activities.⁶⁹ No such application may be made until three years after the date of grant of a patent. Sections 50A and 50B also permit compulsory licensing as a remedy to certain anti-competitive practices.

In response to an application under these provisions, the comptroller may order a licence in favour of the individual applicant or even order the patent to be licensed as of right (with the same effect as if the patentee had voluntarily done so).⁷⁰ If the patentee is a World Trade Organization (WTO) proprietor, section 48A(6) sets a number of conditions on the terms of the order or entry (that the patent is licensed of right) (implementing Article 31 of the TRIPs Agreement). These include "conditions entitling the proprietor of the patent concerned to remuneration adequate in

⁶³ Patents Act 1977, s. 46(3)(c).

⁶⁴ Cf. Copyright, Designs and Patents Act 1988, s. 239 (remedies for infringement of UK unregistered design right in cases where licences are available as of right and a defendant undertakes to take a licence), which also prohibit orders for delivery up.

⁶⁵ Note also compulsory licences available under the Patents and Plant Variety Rights (Compulsory Licensing) Regulations 2002, SI 2002/247, implementing Directive 98/44/EC.

⁶⁶ A distinction is drawn between the grounds on which such licences can be granted against a WTO (section 48A) and non-WTO patent proprietor (section 48B). Here we mention only the former.

⁶⁷ Patents Act 1977, ss. 48A(1)(a), 48B(1)(b)).

⁶⁸ Patents Act 1977, s. 48A(1)(b)(i) ("the exploitation in the United Kingdom of any other patented invention which involves an important technical advance of considerable economic significance in relation to the invention for which the patent concerned was granted is prevented or hindered"). Under s. 48A(4), such an order is conditional on the comptroller being satisfied that the proprietor of the patent for the other invention is able and willing to "cross-license" on reasonable terms.

⁶⁹ Patents Act 1977, s. 48A(1)(b) (ii), s. 48A(1)(c) ("that by reason of conditions imposed by the proprietor of the patent concerned on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the United Kingdom, is unfairly prejudiced").

⁷⁰ Patents Act 1977, ss. 48(1)(b), 53(4).

the circumstances of the case, taking into account the economic value of the licence”: section 48A(6)(d).

Although the provisions on remuneration differ as between WTO proprietors and non-WTO proprietors,⁷¹ the appropriate methodology seems to be much the same. As a result, both likely require a determination of “the royalty that would be agreed between a willing patentee and a willing licensee having regard to the other terms of the proposed licence”.⁷²

While the relationship between licences of right and remedies is expressly mentioned in the Act,⁷³ nothing is said about the interaction between compulsory licensing and infringement actions.⁷⁴ Theoretically speaking, this presents an inconsistency because infringement is defined in relation to actions “without the consent of the proprietor” (section 60(1)), and in most compulsory licensing situations the patentee has not consented to the acts in question. From the point of view of common sense, it must be the case that a compulsory licensee does not infringe. This result would most likely be achieved by treating “consent” to include the licence/permission the patentee has been ordered to grant (the reasons why the licence was granted being irrelevant.)

In contrast with the provisions on licences of right there is also no guidance on what the relationship is between the court’s jurisdiction to grant remedies and pending applications for compulsory licences. If a defendant faced with an infringement action makes an application to the comptroller seeking a compulsory licence then, in principle, that might be considered in deciding whether to award interim or final injunctive relief.⁷⁵ That scenario does not seem to have arisen as yet. Indeed, the number of applications for compulsory licences is miniscule, and no such application has been made for many years.

3. Other Cases

It does not appear that there are any other cases in which English courts will refuse an injunction purely based on the identity of the defendant.

⁷¹ Under section 48A(6), in relation to WTO proprietors, the royalty must confer *adequate remuneration*, whereas the criterion under section 50(1)(b) of the Patents Act 1977, which relates to the determination of the terms of licences required to be granted by non-WTO proprietors), is to ensure that “the inventor or other person beneficially entitled to a patent shall receive *reasonable remuneration* having regard to the nature of the invention”.

⁷² *Smith, Kline, French Laboratories Ltd’s (Cimetidine) Patent* [1990] RPC 203, 236 (Lloyd LJ); *American Cyanamid’s (Fenbufen) Patent* [1991] RPC 409, 411 (Dillon LJ) (both under a provision equivalent to that applicable now to non-WTO proprietors).

⁷³ Patents Act 1977, s. 46(3)(c).

⁷⁴ Patents Act, s. 60(6) (making a person entitled to use an invention under section 55 a person entitled to work the invention for section 60(2) on indirect infringement) (presumably a compulsory licensee is a “licensee” within that provision).

⁷⁵ Of course, to succeed in obtaining a licence, it would be necessary for the applicant to have made efforts to obtain a licence from the proprietor: Patents Act 1977, s. 48A(2)(a) (where the proprietor is a WTO proprietor).

G. DENYING INJUNCTIVE RELIEF TO A CERTAIN TYPE OF PLAINTIFF

So far, the English courts have not considered whether injunctive relief may be denied to so-called non-practising entities (NPEs). It seems unlikely that an injunction would be refused purely because the patentee is an NPE, but its non-practising status may be relevant to some of the considerations affecting the grant of injunctions (e.g. because it does not manufacture products protected by the patent and therefore is not suffering lost profits). In interim injunction cases, it seems that relief might well be refused if it is established that damages would be an adequate remedy to the patentee. In final injunction cases where an NPE establishes infringement, it might be that damages would be awarded in lieu of an injunction under *Shelfer/Lawrence* principles, or on proportionality grounds under Article 3 of the Enforcement Directive.

H. ISSUING INJUNCTIONS FOR LIMITED TIME PERIODS ONLY

1. *The Standard Rule: For the Life of the Patent*

In *Coflexip*, Aldous LJ explained that one of the advantages with injunctions formulated in general terms (e.g. “do not infringe the patent”) was that they were limited to the term of the patent. Similarly, in *Smith & Nephew plc v. ConvaTec Technologies Inc. (No. 2)*,⁷⁶ Birss J recognised that “In a patent case a normal final injunction is time limited in that it will only last until the patent expires”.

2. *Post-Expiry or “Springboard” Injunctions*

However, the courts have been willing occasionally to grant injunctions applicable after the patent expires, but formulated as a remedy for activities of the defendant that infringed during the patent term. These are sometimes called “springboard” injunctions and can be traced back to the early case of *Crossley v. Beverley*, in which Lord Lyndhurst LC granted an injunction to restrain sale of meters (for measuring the supply of flammable gas) which had been manufactured by the defendant during the patent term.⁷⁷ In 1834, in a case brought by the same patentee though against a different defendant,⁷⁸ Lord Brougham LC confirmed the jurisdiction:

⁷⁶ [2013] EWHC 3955 (Pat), [2014] RPC 22, [115].

⁷⁷ *Crossley v. Beverley* (1829) 1 Russ & M 166 n, 39 ER 65, 1 Websters Patent Cases 119 (Lord Lyndhurst LC).

⁷⁸ The bill in the case was filed on 28 November 1829, and the patent expired on 9 December of the same year.

It was objected, that the Court would not interfere, just on the eve of the expiration of a patent, and grant an injunction which would only last a week. The point has never yet been decided; but I am of the opinion that the Court would interfere, even after a patent has expired, to restrain the sale of articles manufactured previous to its expiration in infringement of a patent right; and that a party would not be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the market with the produce of his piracy; and thus reaping the reward of his improbable [*sic*] labour in making it. The Court would, I say, in such case restrain him from selling them even after the expiration of the patent.⁷⁹

These injunctions sit uneasily with the oft-repeated claim that injunctions are only granted to prevent infringement, since the aim is really to prevent a defendant from benefiting from past infringements.

In *Smith & Nephew plc v. ConvaTec Technologies Inc. (No. 2)*,⁸⁰ Birss J reviewed the authorities, and considered the EU Enforcement Directive, and found there was jurisdiction to award injunctions after expiry. He set out five factors that a court should consider before doing so:

- i) Caution is required before a final injunction is granted restraining an otherwise lawful activity. Nevertheless in a proper case it will be.
- ii) The nature of any unwarranted advantage relied on should be identified. The precise relationship between the unlawful activity in the past and the later acts which are said to exploit that unwarranted advantage needs to be considered.
- iii) If an injunction is to be granted it must be in an appropriate form and for a duration which is commensurate with the unwarranted advantage relied on.⁸¹
- iv) The court must be particularly careful not to put the claimant in a better position than it would be if there had been no infringement at all, especially if otherwise lawful competitive activity will be restrained.
- v) In considering what relief to grant, the availability of other remedies apart from an injunction needs to be taken into account, not only damages but . . . the availability of an account of profits should be considered too.

On the facts of the case, he declined to grant a springboard injunction, finding that any advantage which Smith & Nephew had obtained from its infringement had already come to an end.

⁷⁹ *Crossley v. The Derby Gas Light Co.* (1834) 4 Law Journal (Ch) 25, 26.

⁸⁰ [2013] EWHC 3955 (Pat), [2014] RPC 22, [133].

⁸¹ This factor now finds an echo in Article 13(1) of the EU Trade Secrets Directive (Directive 2016/943/EU of the European Parliament and of the Council of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure [2016] OJ L157/1).

3. *Conditional Injunctions: The New FRAND Injunction*

In *Unwired Planet Int'l Ltd v. Huawei Technologies (UK) Co. Ltd*, Birss J created a new form of injunction, called a “FRAND Injunction”. These are awarded in cases where a defendant is found to infringe a patent, but the patentee has offered a licence on FRAND terms. In such cases, an injunction should be awarded unless the defendant agrees to enter into the FRAND licence. As the judge explained:⁸²

A FRAND injunction should be in the normal form to restrain infringement of the relevant patent(s) but ought to include a proviso that it will cease to have effect if the defendant enters into that FRAND licence. If, as in this case, the FRAND licence is for a limited time, shorter than the lifetime of the relevant patents, then the injunction should also be subject to an express liberty to either party to return to court in future to address the position at the end of the term of the FRAND licence. In any case the FRAND injunction should also be subject to an express liberty to apply in the event the FRAND licence ceases to have effect for any other reason.

The effect of “liberty to apply” mentioned here is that the parties do not have to initiate new proceedings: they can simply make an application in existing proceedings.

The order made in the *Edwards v. Boston* case discussed previously was to some extent a conditional injunction in that it provided that the exception to the injunction would cease to apply in the event that a suitable non-infringing alternative THV became available.

I. DELAYING/STAYING INJUNCTIONS IN TIME

1. *Pending Appeal*

In general, if a court has found infringement and granted an injunction, the injunction should be maintained even pending appeal.⁸³ Recognising that such an injunction may be seriously damaging to a defendant who succeeds on appeal, the court may well require an undertaking that the patentee compensate the defendant for loss caused by the injunction (referred to as a “cross-undertaking in damages” and comparable to the undertaking which must be given by a patentee seeking an interim injunction). However, the courts recognise that this will not always do justice, and a court will look closely at the circumstances of the case to ascertain the “balance of convenience”.

⁸² *Unwired Planet Int'l Ltd v. Huawei Technologies (UK) Co. Ltd* [2017] EWHC 1304 (Pat), [2017] RPC 20, [20].

⁸³ Cf., in the pre-judicature era, *Hill v. Thompson and Foreman* (1817) 3 Mer 622, 631, 36 ER 239, 242 (Eldon LC refused an injunction following the verdict at law at Nisi Prius, where evidently there was a legal ground for a new trial).

The basic position was stated by Jacob LJ in *Virgin Atlantic Airways Ltd v. Premier Aircraft Interiors Ltd*:⁸⁴

It should be noted the question is not the same when one is considering what to do on an application for an interim injunction pending trial. In that case the patentee has yet to establish his right, whereas after successful trial he has *prima facie* done just that. So in general, when an appeal is pending, the patentee will get his injunction provided he gives a cross-undertaking in damages against the possibility that the defendant's appeal would be successful. The question, however, remains one of a balance of convenience.

In *Novartis AG v. Hospira UK Ltd*,⁸⁵ Floyd LJ emphasised that whether a stay should be granted, and if so upon what conditions, was dependent on the balance of hardships or convenience and that the court should endeavour to arrange matters so that the Court of Appeal is best able to do justice between the parties once the appeal is heard.

The balance of convenience can (it seems) include the public interest. In *Leeds Forge Co. Ltd v. Deighton's Patent Flue and Tube Co. Ltd*,⁸⁶ following a finding of infringement of the claimant's patent for a boiler flue or furnace, counsel for the defendant asked for an injunction to be suspended pending appeal, in part because the patentee had stood by while the defendant developed its factories, but also because granting the injunction with immediate effect would lead to the laying off of seventy workers. The High Court granted the stay pending an application to appeal to the Court of Appeal, and following that application the Court of Appeal ordered a further stay until the appeal had been heard.

2. Selling Off/Fulfilling Existing Orders

Sometimes injunctions have been stayed for a period allowing the defendant to sell off existing stocks or fulfil existing orders. These are usually cases where an appeal is pending, and so are part of the assessment of the balance of convenience in that context.⁸⁷ A recent example is in *Virgin Atlantic Airways Ltd v. Premier Aircraft Interiors Ltd*, where the Court of Appeal created a carve-out enabling the defendant to complete existing contracts. As Jacob LJ explained:⁸⁸ "All the above seem to me perfectly in accordance with the exercise with the balance of convenience approach.

⁸⁴ [2009] EWCA Civ 1513, [2010] FSR 15, [22].

⁸⁵ [2013] EWCA Civ 583, [2014] 1 WLR 1264, [39].

⁸⁶ (1901) 18 RPC 233, 240.

⁸⁷ See *Lyon v. Goddard* (1893) 10 RPC 121, 136 (suspending operation of injunction pending appeal in relation to orders taken by the defendant but not executed, but with duty to keep account of profits); *Duckett v. Whitehead* (1895) 12 RPC 187, 191 (stay of injunction pending appeal on same terms).

⁸⁸ *Virgin Atlantic Airways Ltd v. Premier Aircraft Interiors Ltd* [2009] EWCA Civ 1513, [2010] FSR 15, [36].

They are a carve-out to the injunction which is the least likely to cause injustice if the Supreme Court grants permission to appeal and our decision is subsequently reversed.”

3. Redesign

In the mid-1970s, in *Illinois Tool Works Inc. v. Autobars Co. (Services) Ltd*,⁸⁹ having found infringement of the claimant’s patent, Graham J withheld the injunction for a period of three months to give the defendant time to launch a non-infringing product. This was explained on the basis of the public interest concerning the possibility of the loss of employment in times of great economic stress, a consideration that had been treated as relevant in some older authorities. Thirty-five years later, in *Virgin Atlantic Airways Ltd v. Premier Aircraft Interiors Ltd*,⁹⁰ Jacob LJ stated that he was “not entirely convinced that one would go quite that far these days”.

A similar order staying an injunction to allowing for redesign for a period of two and a half weeks was, however, made in *Adaptive Spectrum and Signal Alignment Inc. v. British Telecommunications plc*. Here, BT’s Rate Adaptive Monitoring Box (RAMBo) in its Dynamic Line Management System which controlled its broadband access network was found to have infringed ASSIA’s two patents relating to methods for controlling the operation of a digital subscriber line (DSL) for sending digital information over telephone. Floyd LJ stated:⁹¹

In these circumstances an injunction would normally be granted. However, we are narrowly persuaded that it would be right to stay the injunction on terms. ASSIA has made it clear that it is primarily interested in a financial remedy, as its business lies in licensing its inventions. That does not mean that it is not entitled to seek an injunction when BT has never sought a licence: otherwise it would never be able to bring a prospective licensee to the table. But it does mean that it will suffer no lasting harm if, for a short period, BT is granted a stay in order to cease use of the invention. On the other hand, given BT’s large market share, the public would suffer if an injunction were granted disrupting or reducing the quality of the BT service.

4. Other Cases

We have already noted that, in *Edwards Lifesciences LLC v. Boston Scientific Scimed Inc. (No. 3)*,⁹² the High Court limited the injunction so that it would not

⁸⁹ [1974] RPC 337.

⁹⁰ [2009] EWCA Civ 1513, [2010] FSR, [27].

⁹¹ *Adaptive Spectrum and Signal Alignment Inc. v. British Telecommunications plc* [2014] EWCA Civ 1513, [4].

⁹² [2018] EWHC 1256 (Pat), [2018] FSR 31.

affect the cohort of patients for which the patented invention was essential. The court also considered, in respect of other patients, the grant of a stay for a period in which clinicians who had been trained to use the defendant's infringing heart valve (Sapien 3) could be retrained to use alternative heart valves. Because of uncertainty as to the period required for retraining, Arnold J stayed the injunction to permit continued implantation of the Sapien 3 for a period of twelve months and granted the defendant permission to apply to extend the stay if it turned out that the period required for retraining was longer than that.

J. DENYING OR MODIFYING INJUNCTIVE RELIEF DUE TO CONSIDERATIONS OF PUBLIC INTEREST

Occasionally the courts have recognised that an injunction may be inappropriate because of public interest considerations, though in most such cases the patentee has not demanded immediate injunctive relief (presumably either recognising that the court was unlikely to grant an injunction or fearing the public relations consequences if it did). For example, in *Bonnard v. London General Omnibus Ltd*,⁹³ where the patent related to a device used on omnibuses, the patentee agreed to the injunction being suspended for a reasonable time, and the Court of Appeal suspended it for two months. In *Hopkinson v. The St James and Pall Mall Electric Lighting Co.*,⁹⁴ after the court found infringement of the patentee's patent for a method of supplying electricity to consumers, the report states that "considering the inconvenience caused to the public by suddenly stopping the use of the three wire system, it was agreed that the injunction be suspended for six months, an account of profits to be kept". In *GlaxoSmithKline UK Ltd v. Wyeth Holdings LLC*,⁹⁵ the patent related to vaccines against bacterial meningitis and was infringed by the defendant's product. The patentee decided not to seek an injunction, recognising the public health requirements for vaccines against meningitis B. We have already noted that in *Edwards Lifesciences LLC v. Boston Scientific Scimed Inc.*⁹⁶ the parties agreed that an injunction was inappropriate in relation to patients for whom the infringing heart valves were essential, the court being left to determine the precise modalities and duration of the exception.

In contrast, in *Roussel-Uclaf v. GD Searle & Co. Ltd*,⁹⁷ Graham J considered an interim application in relation to a life-saving drug, a drug for treating cardiac disease. The judge refused the injunction on the normal balance of the risk of injustice basis, but suggested that an application would be refused if the drug was

⁹³ (1919) 36 RPC 307, 325–26.

⁹⁴ (1893) 10 RPC 46, 62.

⁹⁵ [2017] EWHC 91 (Pat).

⁹⁶ [2018] EWHC 1256 (Pat), [2018] FSR 31.

⁹⁷ [1977] FSR 125, 131.

not merely life-saving but unique. This suggestion was subsequently doubted by Aldous J, however.⁹⁸

The law was recently reviewed in *Evalve v. Edwards Life Sciences Ltd* by Birss J,⁹⁹ who concluded that the power to refuse an injunction on public interest grounds “should be used sparingly and in limited circumstances”.

K. DENYING OR MODIFYING INJUNCTIVE RELIEF DUE TO PROCEDURAL CONSIDERATIONS

Interim injunctions are likely to be denied on the basis of delay, but final injunctions may be awarded despite delay in bringing proceedings as “there must be more than mere delay to disentitle a man to his legal rights”.¹⁰⁰ In contrast, such delay might be a factor favouring an award of damages in lieu of an injunction (perhaps demonstrating that the claimant is primarily interested in money or that the award of an injunction would be oppressive¹⁰¹).

The position is different if there is more than mere delay. Positive acquiescence will bar the right of the patentee to an injunction if it amounts to a representation to the defendant that they are free to do what would otherwise be an infringement. *Terrell on Patents* gives the following example:¹⁰² “Thus, if a defendant constructed machinery, for instance, in ignorance of the existence of the claimant’s patent, and the claimant, aware of such ignorance, lay by in silence and later attempted to obtain an injunction, such relief would probably be refused.”

L. THE IMPACT OF VALIDITY CONCERNS ON THE GRANT OF AN INJUNCTION

An interim injunction pending trial may be granted even if the validity of the patent is challenged and the attack appears to be a strong one. As we have already noted, the Court of Appeal granted an interim injunction pending appeal in *Novartis AG v. Hospira UK Ltd*¹⁰³ even though the patent had been found invalid at first instance.¹⁰⁴

A court may consider a stay of injunctive relief awarded in the United Kingdom if there are opposition proceedings pending before the European Patent Office (EPO). However, the jurisprudence recognises that the position is different from

⁹⁸ *Biogen Inc. v. Medeva plc* [1993] RPC 475, 483; *Chiron Corp. v. Organon Teknika Ltd* (No. 10) [1995] FSR 325, 334–35.

⁹⁹ [2020] EWHC 513 (Pat), [78].

¹⁰⁰ *C. Van der Lely NV v. Bamfords Ltd* [1964] RPC 54, 81.

¹⁰¹ See *Banks v. EMI Songs Ltd* (No. 2) [1996] EMLR 452, 459 (a copyright case).

¹⁰² [2020], 21–27.

¹⁰³ [2013] EWCA Civ 583, [2014] 1 WLR 1264.

¹⁰⁴ Note that the first-instance decision to revoke the patent was subsequently upheld by the Court of Appeal: *Novartis AG v. Hospira UK Ltd* [2013] EWCA Civ 1663, [2015] RPC 1.

stays pending appeals. In *Adaptive Spectrum and Signal Alignment Inc. v. British Telecommunications plc*, the Court of Appeal refused British Telecom's application for a cross-undertaking in damages to cater for the possibility that the EPO might subsequently revoke or materially amend one of the patents in issue. Floyd LJ stated:¹⁰⁵

A cross-undertaking is appropriate to take account of the possibility that an earlier judgment is wrong (e.g., an interim injunction or an injunction pending appeal). In the present case, revocation by the EPO would not show our judgment to be wrong, or the injunction to have been wrongly granted. A subsequent EPO revocation or amendment would mean that the injunction would become ineffective or have to be discharged from the date of revocation/amendment, but not *ab initio*. There is no reason for ASSIA to pay for the harm during the period when the injunction was rightly granted.

Nevertheless, in *Smith & Nephew plc v. ConvaTec Technologies Inc.*,¹⁰⁶ the Court of Appeal did grant such a stay. Kitchin LJ explained:

We must also consider the position pending the decision of the TBA [Technical Board of Appeal of the EPO]. We are fully conscious that this raises rather different considerations and in that regard have well in mind the decision and reasoning of this court in *Adaptive Spectrum*. However, in our view this is an unusual case in that the Patent has now been revoked by the Opposition Division and we are satisfied that the decision of the TBA is likely to be at most only a few months after the decision of the Supreme Court in relation to the application for permission to appeal. We have also come to the firm conclusion that it would be wholly disproportionate not to grant to Smith & Nephew the further suspension they seek and that such suspension should be granted in the interests of fairness and equity in light of all of the matters to which we have referred in considering the grant of a stay pending the decision of the Supreme Court in relation to the permission application. In our judgment these matters are equally apposite to the further period between the decision of the Supreme Court and the decision of the TBA.

M. MODIFYING INJUNCTIONS

An interim injunction may be set aside or varied due to a change of circumstances. The requirement is for “a material change in circumstances”; if this is established “then the Court must re-exercise its discretion in the light of the changed circumstances”.¹⁰⁷ In that case, Arnold J concluded that a decision of the Court of Appeal upholding a first-instance decision that the patent was partially invalid was a change

¹⁰⁵ *Adaptive Spectrum and Signal Alignment Inc. v. British Telecommunications plc* [2014] EWCA Civ 1513, [9].

¹⁰⁶ [2015] EWCA Civ 803, [13].

¹⁰⁷ *Warner-Lambert Company LLC v. Sandoz GmbH* [2016] EWHC 3317 (Pat), [56].

of circumstances, but not a material one, while a change of position by the patentee as to the enforcement of the patent should it be successful on a further appeal to the Supreme Court was a material change of circumstances. Reconsidering the matter in the light of the changed circumstances, however, he remained of the view that the balance of the risk of injustice favoured the maintenance of the injunction.

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