



Neutral Citation Number: [2021] EWHC 657 (Pat)

Case No: HP-2020-000020

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
PATENTS COURT (ChD)
SHORTER TRIALS SCHEME

The Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Date: 19th March 2021

Before:

LORD JUSTICE BIRSS
(Remotely via Teams)

Between:

FACEBOOK IRELAND LIMITED	<u>Claimant</u>
(a company incorporated in Ireland)	
- and -	
VOXER IP LLC	
(a company incorporated under the laws of the State of Delaware)	<u>Defendant</u>

MARK VANHEGAN QC and JAANI RIORDAN (instructed by **Freshfields Bruckhaus Deringer LLP**) for the **Claimant**

DR. BRIAN NICHOLSON QC and CHRISTOPHER HALL (instructed by **Quinn Emanuel Urquhart & Sullivan UK LLP**) for the **Defendant**

Hearing dates: 16th March 2021

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

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Lord Justice Birss:

1. This judgment deals with a point which arose at a pre-trial review in a patent case. These proceedings concern EP (UK) 2 393 259 entitled “Telecommunication and Multimedia Management Method and Apparatus” with a priority date of 28th June 2007. The patentee, Voxer, contends that certain functionality offered by Facebook, known as Facebook Live and Instagram Live, infringes the patent. Facebook denies infringement and contends that the patent is invalid. The matter started as a claim for revocation by Facebook brought in this jurisdiction following the commencement of infringement claims against Facebook by Voxer in Germany and the USA. The action proceeded here in the Shorter Trials Scheme (STS). The trial under the STS is due to start on 13th April 2021. Nevertheless I have not taken the STS into account in this judgment. I am looking at the issue on the footing simply that this is a patent case proceeding in the Patents Court under CPR Part 63, Section I.
2. The parties’ cases were pleaded out in a more or less conventional manner. In the Particulars of Infringement served with Voxer’s Defence and Counterclaim, the patentee identified the particular things said to infringe the patent and the claims said to be infringed. The Particulars of Infringement (produced in August 2020) did not go into any further detail to explain how the patentee contended the claims covered the products or processes alleged to infringe. Later on, in November 2020 and pursuant to an agreed order made at the case management conference, the patentee produced claim charts which identified the claim integers of each relevant claim and identified where those features were alleged to be found in the alleged infringement. Either when they were served or at a later date (it does not matter) Voxer described these claim charts and the document in which they were provided as a Statement of Case on Infringement. That is a fair description.
3. No reference was made in either the Particulars of Infringement or in the original Statement of Case on Infringement to whether infringement was advanced based on the doctrine of equivalents (*Actavis v Eli Lilly* [2017] UKSC 48).
4. Relatively recently, Voxer has served a draft amended Statement of Case on Infringement which sets out, in two respects, an infringement case based on the doctrine of equivalents. Voxer also led evidence on that topic in the reply expert’s report of its expert witness. Facebook was 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. The details of the argument do not matter. Voxer’s new case, on the second point as articulated in the draft amended Statement of Case on Infringement, is that even if the operation of the alleged infringing method falls outside claim 1 in relation to the particular feature on a normal interpretation of that feature, its operation is equivalent to the operation of the relevant aspect of claim 1. A case is then pleaded (briefly) stating what the inventive concept is which will be relied on and putting the case on the three limbs of the *Actavis* test.
5. The question I had to decide at the PTR was whether to permit this point to be run. Facebook objected to it on various grounds whereas Voxer contended I should allow it. Much of the debate at the hearing related to the conventional case management questions, the overriding objective and the particular way the rules relating to the STS worked. As part of this question a point of principle arose about the way patent cases should be pleaded. Facebook argued that one would normally expect a case under the

doctrine of equivalents to be pleaded, including proper identification of the inventive concept (citing HHJ Hacon in *Kwibolt v Airbus* [2019] EWHC 2450 (IPEC) at paragraph 14). Facebook contended that the issue to be decided should be looked at in that light. Voxer argued that there was no pleading requirement previously laid down in any decision of the Patents Court. Moreover Voxer contended 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)).

6. At the hearing I decided that Voxer’s submission on the point of principle was wrong but nevertheless went on to permit Voxer to run the new argument on case management grounds. I gave brief reasons orally. This judgment only sets out my reasons on the point of principle because the parties indicated it would be helpful to have a fuller judgment on the issue. That is because litigators have been in doubt on the point since the law was changed by *Actavis* to re-introduce the doctrine of equivalents into UK patent law. I use the word re-introduce simply as an excuse to justify the following brief citation of what I believe is the oldest telecommunications patent case in this jurisdiction. It is the judgment of Parker J in *Marconi v British Radio Telegraph and Telephone Co. Ltd* [1911] RPC 181. Notably at p217 the judge held that what I will call (with a modern eye) the inventive concept of Mr Marconi’s invention lay in the idea itself rather than the particular means for carrying it out. Then the judge summarised the law at p217 ln 39 as follows “*It is a well known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations.*” The fact that broad statement does not coincide with the modern principles as articulated in *Actavis* does not matter.
7. The question is whether reliance on the doctrine of equivalents ought to be pleaded. In my judgment the answer is simply – yes. In fact the issue before HHJ Hacon in *Kwibolt* was not as stark as that because his concern was about a plea which did expressly assert an infringement case which relied on the doctrine of equivalents but did not make any effort to identify the inventive concept to be relied on. His point was that for a case being transferred to IPEC, it should. I agree.
8. In my judgment a patentee (whether in the Patents Court, IPEC or the STS) who wishes to rely on the doctrine of equivalents as part of its case of infringement must say so in the Particulars of Infringement. CPR Part 63 r63.6 provides that a Statement of Case in a patent case must set out the matters in Practice Direction 63. PD63 paragraph 4.1 sets out matters which must be pleaded in the Particulars of Infringement. It might be thought, although Voxer did not take this point, that because equivalents are not mentioned in paragraph 4.1, it follows that equivalents need not be mentioned at all, but that would be an error. These provisions all function in an overall context governed by 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”. 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.

9. Furthermore even though patent pleadings are terse, nevertheless in order to ensure the alleged infringer knows what case they have to meet it is necessary for the patentee to state in terms that equivalence is relied on and to do so by reference to the particular feature of the claim. It is not a serious burden to patentees to have to do this. The burden is no different from the burden on the party challenging validity when pleading its case on insufficiency or added matter.
10. In coming to this conclusion I do not have to decide whether all the details necessarily have to be pleaded out fully from the outset. Nor is it necessary to decide now whether the inventive concept has to be characterised in the Particulars of Infringement. I would think the answer to both questions is no. In IPEC things will be different, as Judge Hacon held in *Kwibolt* but that is another matter. In the normal multitrack in the Patents Court (not IPEC nor the STS) it seems to me that the time when claim charts or a Statement of Case on Infringement is produced would be an appropriate time to articulate the patentee's case on inventive concept and the other aspects of the test in *Actavis*.
11. The minimum required to satisfy CPR rule 16.4 is for the Particulars of Infringement to contain a statement, by reference to each relevant claim feature (and claim), that equivalence is relied on. 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.