Patent Litigation in the UK

A brief overview

England & Wales - Patents Court

- **Patents Court**
  - Higher value/higher complexity cases - to trial within ~12 months
  - Shorter Trial Scheme (STS) available
    - < 4 day trial
    - Limited or no disclosure
    - Docketed to a judge
- **Intellectual Property & Enterprise Court (IPEC)**
  - Typically, lower value (£500k damages cap) and/or lower complexity
  - Trial length typically 1-2 days within 6-12months

- **Single judge panels - a number of Patents Court judges have dual technical and legal backgrounds**
- **Costs shifting - in all of the Courts but capped in IPEC and STS**

UK procedure (filing of claim → trial)

- **Pleadings**
  - Increasingly greater particularisation required
  - Several rounds of pleadings covering claim construction / infringement / validity
  - Proposed amendments to the claims
- **Interim hearings**
  - Case Management Conference (CMC) and Pre-Trial Review (PTR) common
  - Other hearings can be heard for specific applications
- **Disclosure**
  - Usually replaced by Product and/or Process Description (PPD)
- **Fact evidence / witness statements**
  - Typically limited, though exceptions
- **Experiments**
  - Strict procedure requiring formal notices
  - Includes work-up experiments
  - Witnessed repeats can be required
- **Expert Evidence**
  - Forms bulk of evidence at trial
  - Typically 2+ reports per expert (1-3 experts typical)
- **Statement of common general knowledge (CGK)**
  - Assist Judge to understand scope of issues on CGK (and with judgment)
- **Opening skeletons**
  - Sets out summary of parties' submissions, supplemented orally at trial

UK procedure (trial)

- **A typical timetable for a 5-day trial in Patents Court.**
- **In STS or IPEC, greatly compressed, e.g. cross examination limited to specific issues.**

Day	AM	PM
1	Pre-reading	Opening submissions
2	Cross examination (Claimant's expert 1)	Cross examination (Claimant's expert 2)
3	Cross examination (Defendant's expert 1)	Cross examination (Defendant's expert 2)
4	Preparation of written closing submissions	Exchange of written closing submissions
5	Closing submissions	Closing submissions

Inventive Step / Obviousness

s.3 Patents Act:

"*An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art*"

The Court frequently applies a structured test from the ***Pozzoli*** case – summarised as follows:

1) **Identify skilled person + CGK**

2) **Identify inventive concept of the claim of the Patent**

3) **Identify differences between the prior art and the inventive concept of the Patent**

4) **Are the differences obvious to the skilled person in light of the CGK?**

The Typical Structure of a UK Patents Court Judgment

Setting the scene:

Introduction – parties, summary of the issues for determination.

Initial findings:

Skilled Person/Team, Relevant Technical Background/Common General Knowledge.

Disclosure of each piece of Prior Art to the Skilled Team:

The Patent and its teaching:

Claim Construction/Claim Scope:

Validity: Novelty, Obviousness, Insufficiency, Added Matter, Excluded Subject-Matter

Infringement: (1) on a 'normal' i.e. purposive construction and (optionally) (2) applying the doctrine of equivalents

Overall Result:

The Mock Trial (UK)

- **The experts have been cross-examined**
- **Written closing submissions have been exchanged**
- **We will now hear oral closing submissions (slightly compressed)**

Day	AM	PM
1	Pre-reading	Oral opening submissions
2	Cross examination (Claimant's expert 1)	Cross examination (Claimant's expert 2)
3	Cross examination (Defendant's expert 1)	Cross examination (Defendant's expert 2)
4	Preparation of written closing submissions	Exchange of written closing submissions
5	Oral closing submissions	Oral closing submissions

Submissions

Obviousness over US7XX

Pony's Submissions - heating

- Claim of the Patent requires heating
- Disclosure of US7XX directed to creating (and confirming) vacuum condition for storing food
- No **motivation** for skilled person to apply teaching in microwave heating context

A lid used as a part of a storage container in which stored food can be heated in a microwave oven, the lid comprising:

US7XX - Claim

A lid used as a part of a storage container for storing food in a vacuum condition, the lid comprising:

US7XX - Background

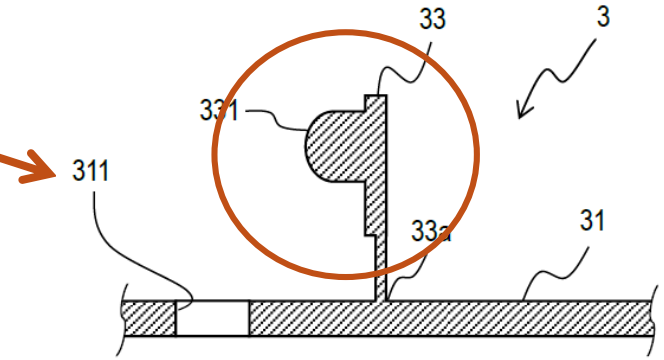
According to the present disclosure, a lid that allows a user to know whether a vacuum condition is being maintained inside a storage container can be provided.

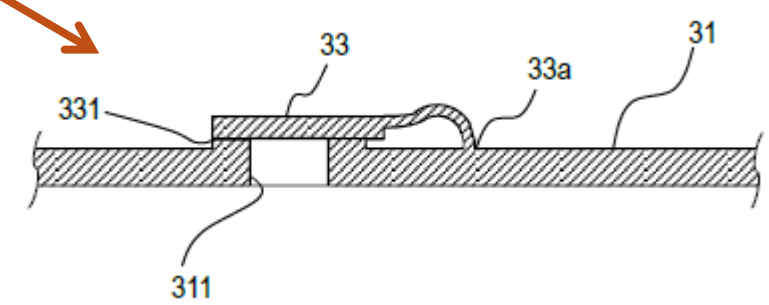
Pony's Submissions – the protrusion

- A key feature of the Patent's claim
- Entirely absent from US7XX, in which flap is maintained over through hole by pressure differential
- Different technical solution
- Different approach, user has control of flap opening / closing
- Applying *Pozzoli*, clear that skilled person would not consider the protrusion in context of teaching relating to pressurised storage
- Pozzoli (iv) : **no hindsight** "without knowledge of invention"

D a flap that is provided to be elastically deformable to rotate with respect to the top plate portion, and has a protrusion that can close the through hole,

E wherein the flap is configured such that the protrusion is spaced apart from the through hole in a natural condition and the through hole is maintained in a closed state by the protrusion, and





Donkey's Submissions - heating

- US7XX [0008] discloses:
  - (i) defrosting in a microwave; and
  - (ii) heat-resistant temperature range

  ⇒ Active heating in a microwave is disclosed

  ⇒ Defrosting = subset of heating

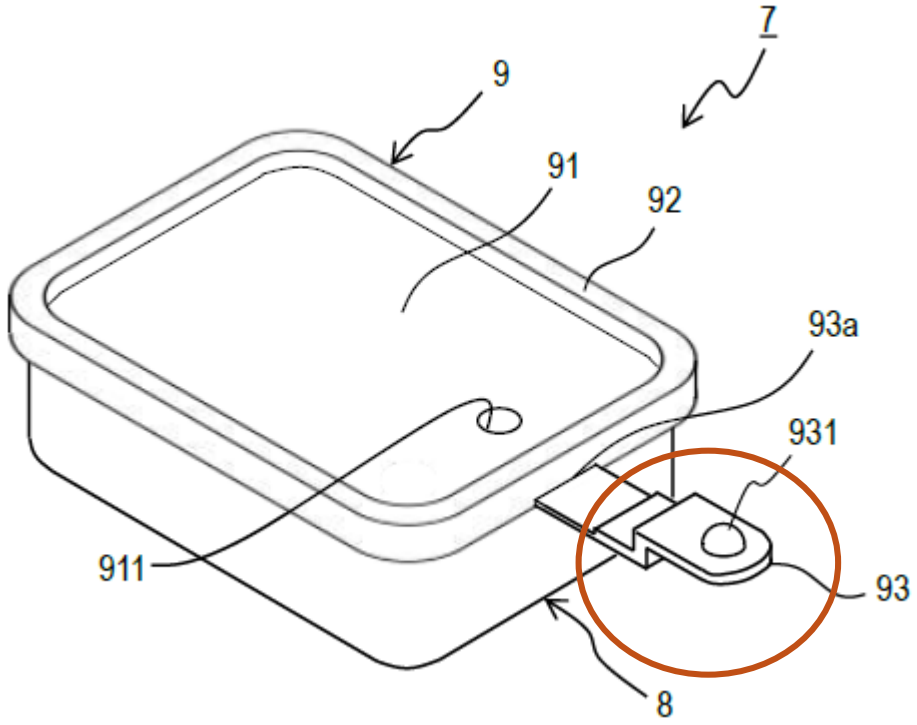
- Applying US7XX in heating context is **obvious**
  - Heating is immaterial to the **inventive concept** of the Patent, which concerns the positioning of the through hole and flap so as to avoid discharged fluid hitting the flap
  - Simply require use of a material suitable for heating to higher temperatures
  - Examples of such materials known as part of skilled person's **CGK**

[0008]

The storage container 1 according to an embodiment shown in Fig. 1 is for storing food in a vacuum condition and comprises a container body 2 and a lid 3. The container body 2 and the lid 3 are made of plastic with a heat-resistant temperature range of -40 to 100°C. Therefore, a user can preserve food in the storage container 1 in a freezer and can also defrost the stored food in a microwave oven as it is.

Donkey's Submissions – the protrusion

- Alleged invention is concerned with the positioning of the through hole and flap so as to avoid discharged fluid hitting the flap
- The precise means by which the through hole is closed by the flap is not material to the alleged inventive concept
- Simply a **design choice with no technical significance** for the invention
  - ⇒ Use of a protrusion was a common feature of other devices widely known in the art = **CGK** (as recognised in the Patent – see e.g. Fig 5)
  - ⇒ Manual operation / user choice simply reflecting the function of the through hole, which skilled person would understand
- Skilled person would recognise the utility of applying US7XX to the known problem of excess water hitting a flap, and **obvious workshop modification** to use a different means (protrusion) to close the through hole



Judgment

Mr Justice Mellor

Pony Corp. v Donkey Corp. [2024] EWHC 999 (Pat)

The Judgment (UK) - (1)

Skilled Person & CGK: a mechanical engineer with experience in product design and production techniques of an array of known food containers.

Disclosure of US7XX: the hole and its flap operate automatically, being opened and closed by differential pressure

The Patent and its teaching:

Claim construction – relevant principles applicable re Art 69 & protocol: purposive construction

(1) Overall: what would the skilled person understand the patentee to mean?

(2) The role of the specification: Specification & claims should be read together, since the *purpose* is usually to be found in the specification – *Brugger v Medicaid*. The specification is NOT only consulted to resolve ambiguity.

(3) *Nokia v IPCom*: additional limitations cannot be read into the claim.

The Judgment (UK) - (2)

Purposive construction:

‘heated’ / (heating):

- **no particular limitation, but understood in the context of (domestic) microwave use**

‘a through hole’:

- **to allow the passage of gas or fluid (air, steam, water). NOT limited by the preferred dimensions provided it fulfils its purpose.**

‘protrusion’:

- **some form of stopper inserted into the through hole to prevent the passage of gas or fluid**

The Judgment (UK) - (3)

Validity:

Step (1): skilled person & CGK identified

Step (2): the inventive concept:

Step (3): differences: **(1) defrosting/heating; (2) protrusion to close the through hole**

Step (4): without knowledge of the Patent, was it obvious for the skilled person to move from the starting point in the prior art to something which falls within claim 1?

(1) **It would have been obvious to apply the prior art arrangement for heating food.**

(2) **It would not have been obvious to alter the prior art arrangement of flap and hole. It would be counterintuitive to throw away the automatic operation of the flap and hole in favour of a CGK arrangement of hole and stopper (protrusion)**

Patent held valid

The Judgment (UK) - (4)

Infringement: (No equivalents argument)

Is there infringement on a normal construction of the claim?

Evidence: the experiments are not determinative:

- **P's experiment, because the lid was not sealed to the container, as it would be in normal use: not probative**
- **D's experiment, because the volume of water was high, but the hole still performed its purpose (even if poorly)**

Finding:

D's product has a 'through hole' – it allows the passage of air/steam/water

Therefore, infringement on a normal construction.

Patent valid and infringed.