INFRINGEMENT

INFRINGEMENT

Even Defendant's allegations confirm infringement

Defendant’s Product fulfills all features of claim 1

Size of the through hole is not a feature of the claim.

Donkey admits that excess water can be removed from by the through hole when their product is used. Thus, if the same hole would be used in a container of the cited prior art, the identical problem (water hitting the flap) would occur.

Duration of removing water again not included in the claim

VALIDITY OF THE PATENT

VALIDITY

Obviousness by applying hindsight

„Defrosting“ is different from „heating“

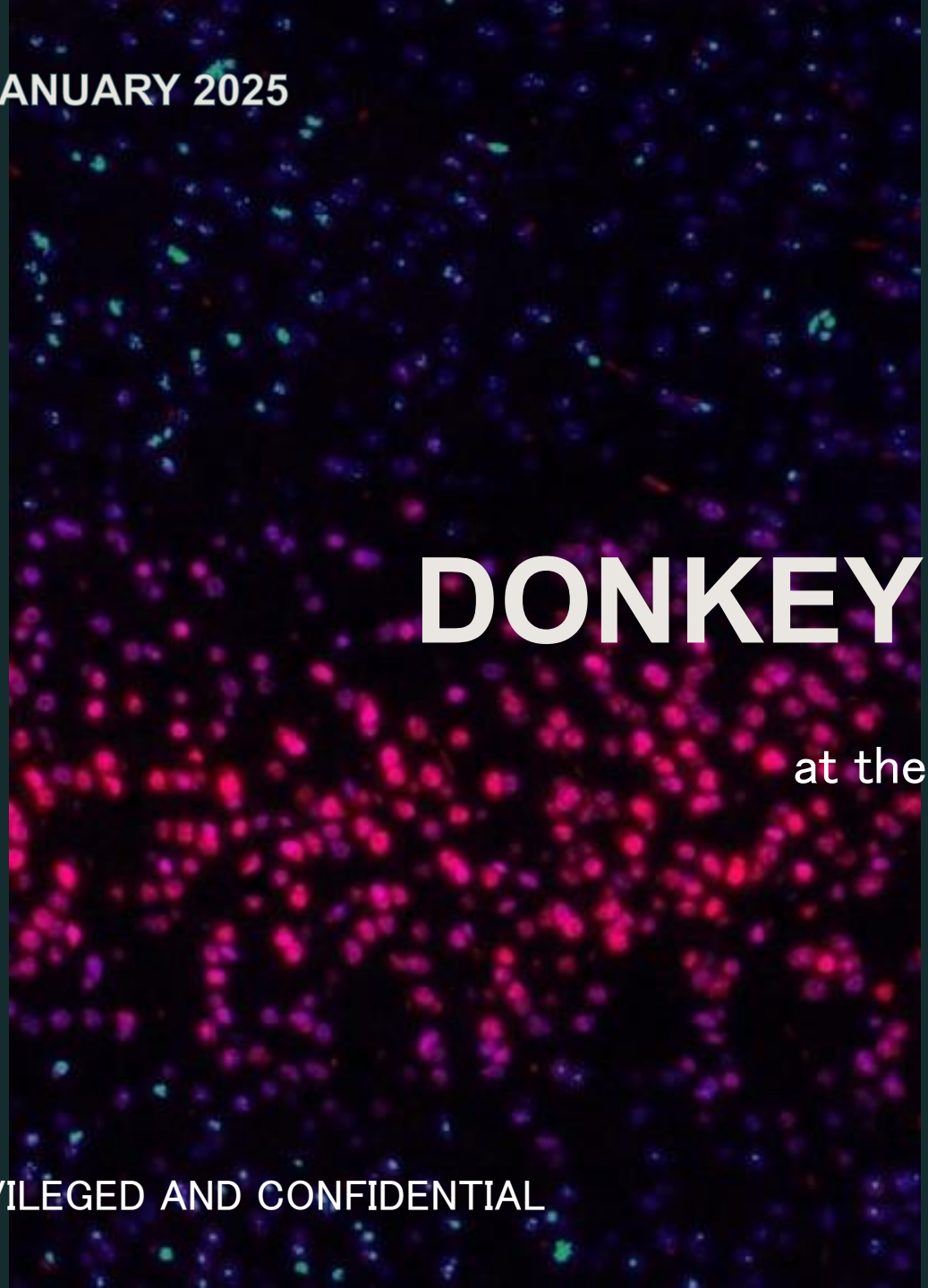
Flap of first citation does not disclose a protrusion (undisputed)

No motivation of the skilled person to change “automatic” system depending on pressure to a reliable closing mechanism with protrusion

Discharging water possible with “automatic” system as well
Skilled person knows that air will return if hole is not immediately closed
Pony’s allegation substantiated; Donkey’s objection unsubstantiated

31 JANUARY 2025

DE BRAUW
BLACKSTONE
WESTBROEK



DONKEY V. PONY

at the UPC

PRIVILEGED AND CONFIDENTIAL

ARGUMENTS DONKEY

overview

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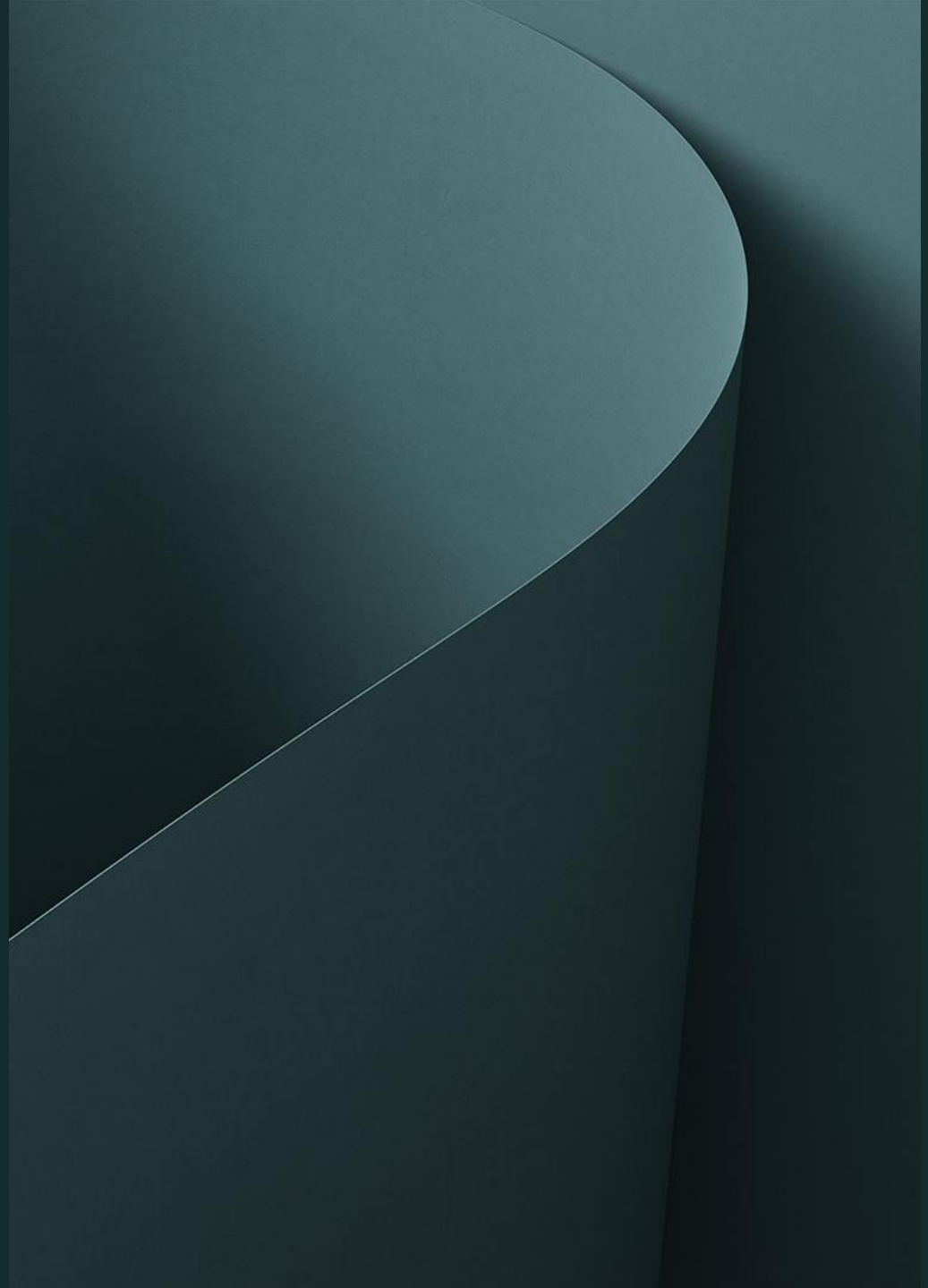
WESTBROEK

1. Introduction
2. No infringement
3. Invalidity
4. Conclusion



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1. INTRODUCTION

INTRODUCTION

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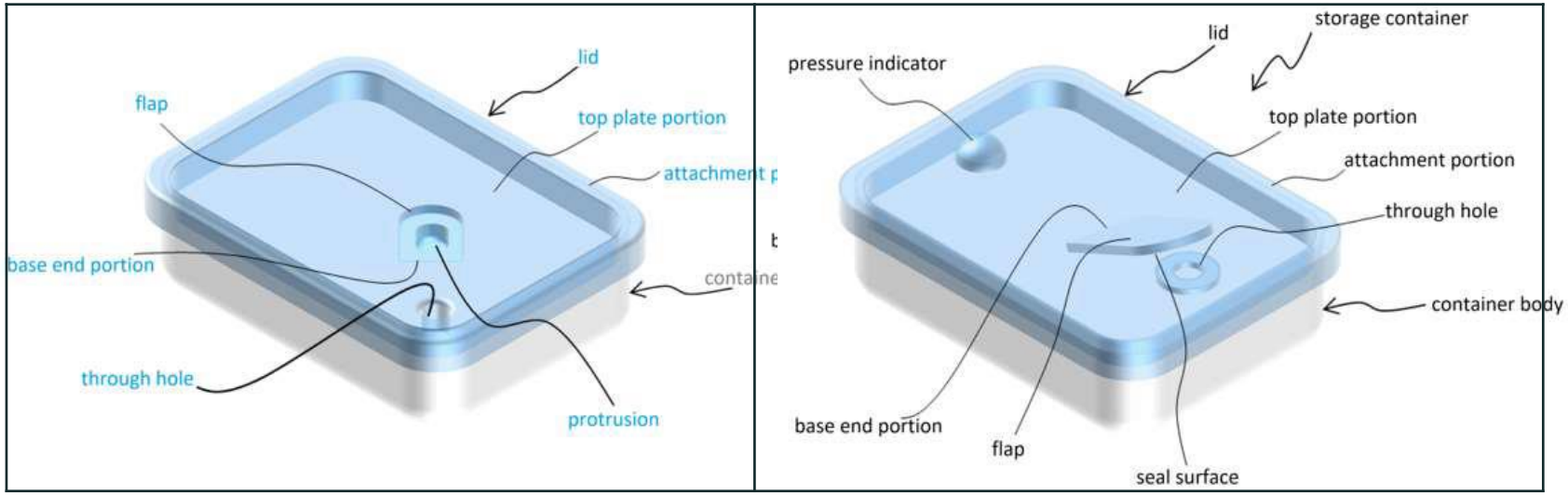
- This case is about a Patent that claims a particular lid: a lid on the top of a container that has a hole that can be closed with a flap

- I will explain to you today that this Patent is invalid for lack of inventive step: **such lids already existed**



INTRODUCTION

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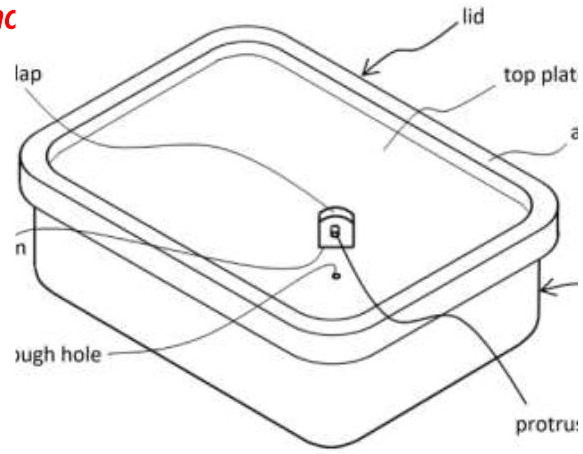
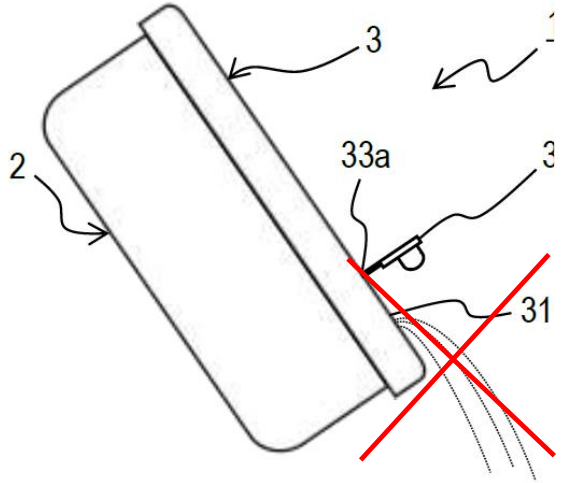
- Moreover, even if the Patent would be held valid, there is still no infringement because the tiny hole in the lid of the Defendant's Product is **far too small** to allow a smooth discharge of water, as the Patent requires

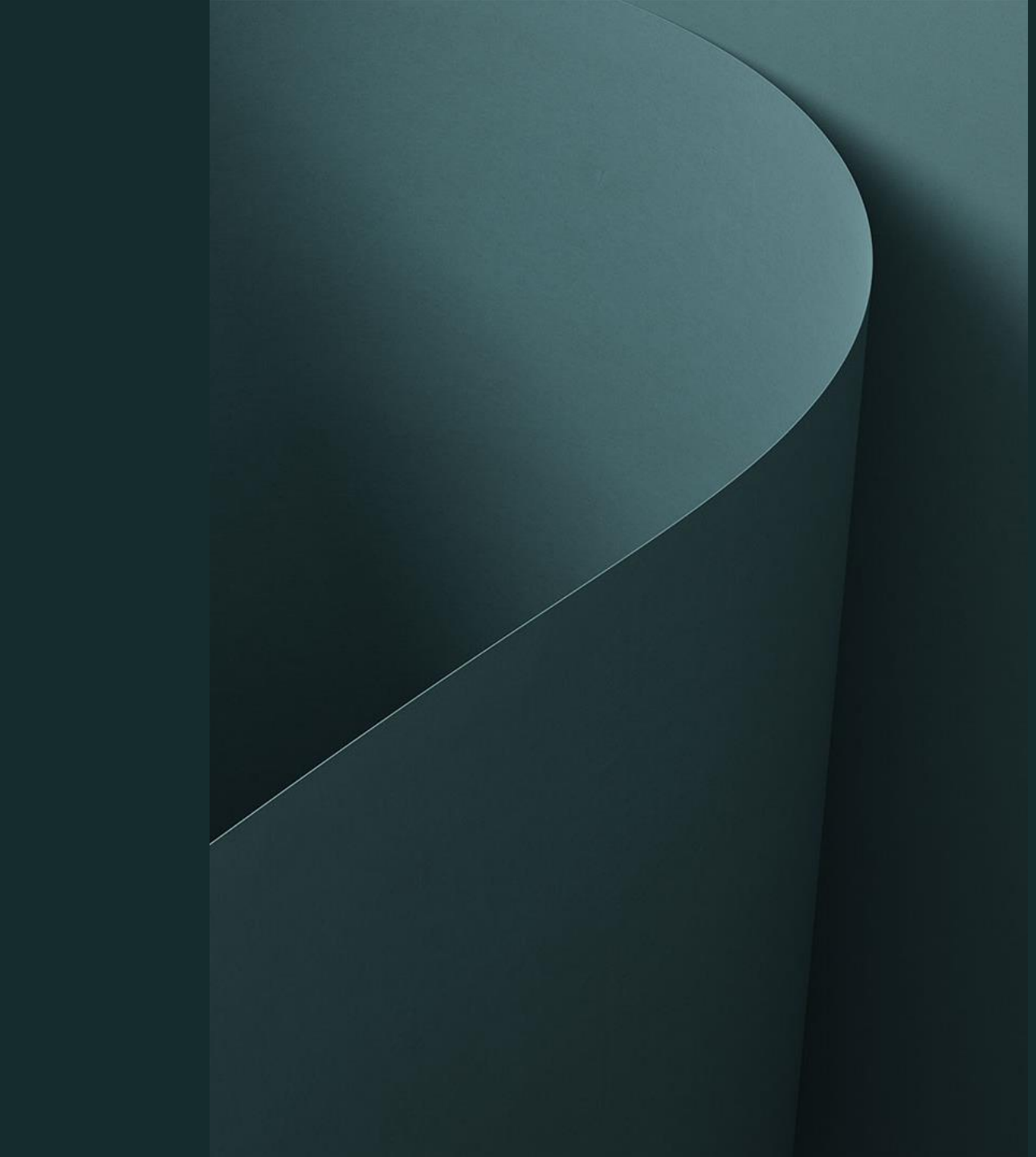
Defendant's Product

Defenc



Patent if applied to





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2. NO INFRINGEMENT

NO INFRINGEMENT

Claim 1

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- Claim 1 of the Patent requires a through hole (311, see figure 1)
- That through hole is used for discharging excessive water (figure 4, para. [0011])

Patent, fig. 1

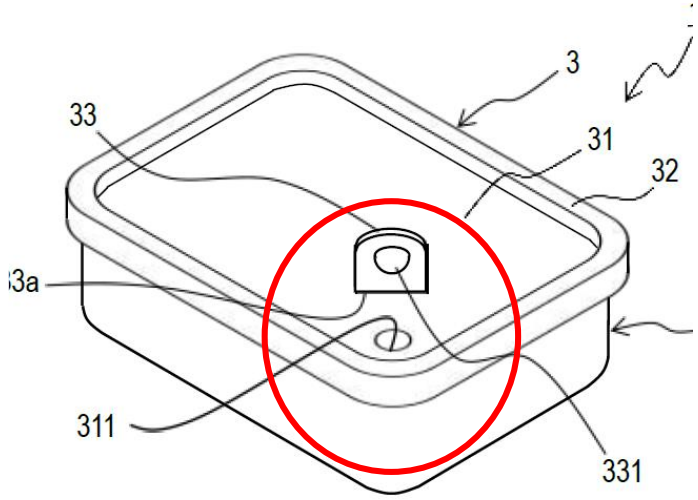
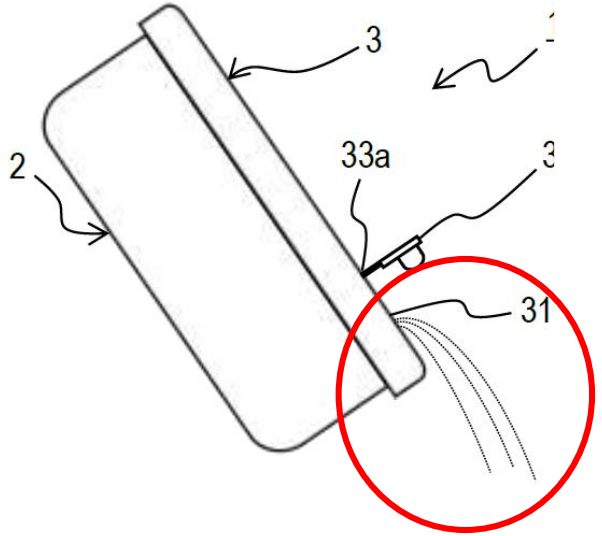


Fig.1

Patent, fig. 4



UPC CoA (UPC_CoA_335/2023)

- UPC CoA: the **interpretation** of a patent claim **does not depend solely on the strict, literal meaning of the wording used**; rather, the **description and the drawings must always be used as explanatory aids** for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim

Claim construction

- Only through holes that **prevent water splattering**, and thus have **sufficient size** are covered by the Patent – see **description** and **drawings**

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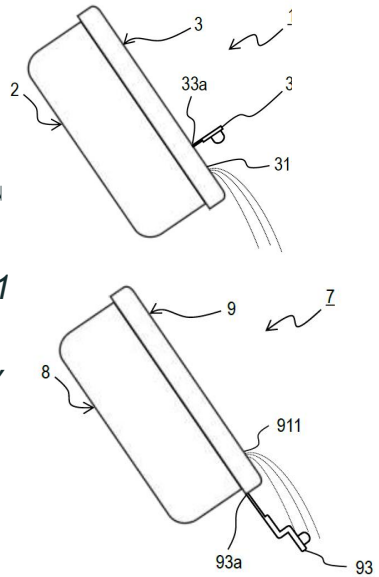
Claim construction

- Only through holes that **prevent water splattering**, and thus have **sufficient size** are covered by the Patent – see description and drawings

  - the lid *"can prevent water from hitting the flap while discharged from the through hole"* ([0014], [0012])
  - this allegedly solves the problem that *"the water drained from the through hole (…) hits the flap and splatters"* (which is what would happen if the container in fig. 8 would be used) ([0011])
  - this water splattering solution is designed to remove the discomfort that may arise when using the throu hole to remove excessive water from the storage container ([0011])
  - *"the through hole 311 is designed to have such a size that the water inside the storage container 1 can be smoothly discharged (…)"* ([0019])
  - *"When the through hole 311 is circular, its diameter is preferably within the range of 10 to 20 mm."* ([0019])
  - This is also illustrated in the drawings: figure 4 (top) shows the removal of excessive water from *"a through hole in the storage container of the embodiment"* and figure 8 (below) shows such from a *"storage container of the prior art"*.



NO INFRINGEMENT

Defendant's Product does not contain the claimed through hole

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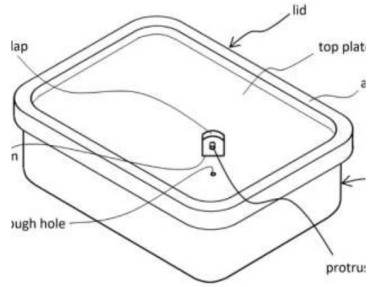
Through hole Defendant's Product far too small

- Merely meant to release excessive pressure building on the inside of the container while heated and designed accordingly
- Size of the through hole of the Defendant's Product is limited to just 3 mm in diameter: through hole Patent is at least three and possibly over six times as large
- Through hole Defendant's Product therefore does not effectively discharge water



No smooth discharge water: proof

- third party experiment confirms: no smooth discharge
- it took very long (over 60 seconds) to drain just 100 cc of water

CONCLUSION: NO THROUGH HOLE AS REQUIRED BY CLAIM 1 OF THE PATENT

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3. INVALIDITY

INVALIDITY

Lack of inventive step

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Skilled person

- Engineer with several years of experience in developing and designing storage containers using heat-resistant plastic materials
- With (commercial) interest and motivation to find practical alternatives for storage container lids

Closest prior art

- US Patent No. 2006/0077XX (the "Prior Art Document")
  - Teaches a lid as part of a storage container on which a through hole is located on the outer periphery of the top plate portion
  - It concerns a storage container suitable for heating in a microwave oven
- The Prior Art Document relates to the same technical field as the claimed invention and is a realistic starting point

Closest prior art - difference

- The only differentiating features between the Patent (shown above) and the Prior Art Document (shown below) are, arguably, that
  - (i) the Patent discloses a container to heat food in a microwave oven, while the Prior Art Document is used to defrost food in a microwave oven and
  - (ii) the Patent has a protrusion 'that can close the through hole, which is spaced from the through hole in the natural position

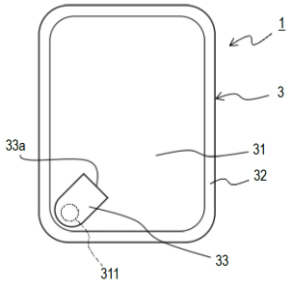

Fig.2

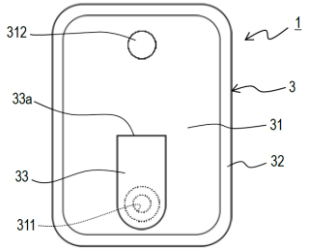

Fig.2

Heating

- Heating in a microwave oven
  - the Prior Art Document expressly mentions that it concerns *"heating in a microwave oven"* (para. [0012]); and
  - mentions that the container needs to be *"heat-resistant"* and needs to be able to resist temperatures of up to 100 degrees Celsius (para. [0008])

The flap

- Both the Patent and the Prior Art Document do not have a flap located below the through hole, but rather a flap located on the top plate portion. This is claimed to be key to the invention, as this way the *"splattering problem"* is solved: because of the flap location, water discharged from the through hole will not hit the flap (para. [0012])

- Small, difference with the Prior Art Document: the natural position of the flap which has a protrusion (that can close the through hole) and which is manually adjustable in the Patent (into a position closing the through hole, the natural position being open).

- Such would, however, have been a mere, obvious, design matter for the skilled person which he would have had an incentive to arrive at

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The flap – incentive and CGK

- Incentive
  - When one wishes to remove excess water that has accumulated (which naturally occurs when heating), it is advantageous to have a flap that can be manually adjusted, either in the open or closed position
  - If the lid would automatically return to its natural closed position: difficult to smoothly discharge the excess water
  - Skilled person would wish to have the possibility to manually open the flap (without it having the inclination to close); and, once the discharge of water has been completed, close it

- Common General Knowledge:
  - flap that can be manually opened and closed is designed by applying a protrusion to the flap that can close the through hole
  - In fact, such solution is acknowledged in the Patent.

The flap: no inventive step

- Applying this knowledge, the skilled person would thus easily arrive at the Invention as claimed in the Patent

- If Pony would argue that such design change would interfere with the suction system of the Prior Art Document and, in short, prevent automatic closing when suction ends:
  - Pony has not substantiated this allegation, which Donkey disputes
  - And, of course the manual operation of the flap enables closing the flap: thus, as desired the flap can be closed (e.g. when heating) – but also opened for discharging excess water. In fact, both the Patent and the Prior Art Document (also) show a closed flap

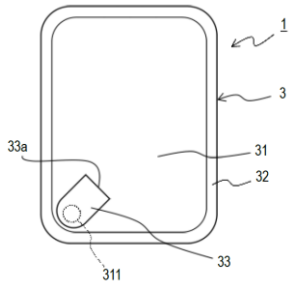

Fig.2

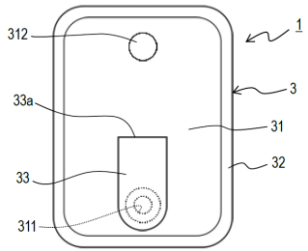

Fig.2

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4. CONCLUSION

CONCLUSION

No infringement and Patent invalid

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To conclude, Donkey requests the court to:

- Dismiss Pony's claims;
- In the counterclaim, revoke the Patent; and
- Award Donkey's legal costs

Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Mock Trial “Pony vs. Donkey”

Case assessment

Dr Klaus Grabinski, President of the UPC Court of Appeal

Judicial Symposium on Intellectual Property (JSIP) 2024, Tokyo, 24 October 2024

All written and said is my personal view and not a communication of the UPC Court of Appeal.

I. Claim interpretation

Claim interpretation

- Element F of patent claim 1 requires that the through hole of the top plate is formed outside a base end portion of the flap in plan view of the lid.
- The technical purpose of this design is to allow water to drain through the through hole without hitting the flap and splattering (patent specification, paragraphs 12 and 14).
- Patent claim 1 must, therefore, be interpreted to allow water to be removed through the through hole.
- However, there are no requirements as to the size of the through hole as long as it allows water to be removed from the storage container.

II. Infringement

Infringement

- It follows from the claim interpretation that all features of patent claim 1 are realized in the attacked storage container.
- This is also true with regard to feature F contested between the parties as the through hole allows water to be discharged through the through hole.
- The fact that it takes 60 seconds for the water to be removed does not alter this assessment as there is no minimum requirement regarding the size of the through hole as long as it allows the removal of water.

III. Validity – Inventive step

Person skilled in the art

- Art. 56 European Patent Convention (EPC) – Inventive step

  An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. …

Person skilled in the art

- In the case-at-hand, a person skilled in the art (psa) would be an engineer with several years of experience in developing and designing storage containers using heat-resistant plastic materials.

Problem to be solved

- Starting point for such a psa would be a storage container with a lid as known in the prior art and shown in Figures 5-8 of the patent specification.
- In such a container food can be heated in a microwave.
- The container comprises a lid with a flap that has a protrusion that can close a through hole in the lid by which excess water can be removed.
- The flap is arranged below the through hole at an outer periphery of the lid.
- The configuration known in the prior art results in the problem that the water drained from the through hole, when it is not closed by the flap, hits the flap and splatters.

Prior art of interest

- For the psa, trying to solve this problem, the US patent application 2006/0077XX would be of interest as it also concerns
  - a storage container with a lid
  - made of plastic with a heat-resistant temperature range of -40 to 100° C.
  - so that frozen food in the storage container can be defrosted in a microwave oven and
  - the lid is provided with a flap and a through hole outside a base end portion of the flap.

Different technical functions of the flap in the prior art

- However, the flap
  - does not have a protrusion that allows to close or open the through hole depending on whether excessive water is to be removed from the container.
- The function of the flap disclosed in the US patent application is rather that of a non-return valve after vacuuming the container through the through hole by a vacuum pump
  - as the flap is pressed to an annular area around the through hole when the pressure inside is lower than the pressure outside the storage container.

No pointer to the claimed invention

- In view of this different functional context, the psa had no reason to consider the position of the flap as disclosed in the US patent application to solve his problem of preventing excess water draining from the open through hole from hitting the flap and splatting.

Conclusion

- It follows that it was not obvious for a psa who was supposed to solve the problem underlying the invention to come up with a solution including element F of claim 1 of the patent-in-suit.

Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Thank you for your attention