Panel Discussion

Mr Justice James Mellor

My background

- Studied Engineering & Production Engineering at King's College, Cambridge - before, during and after University, worked in industry in UK, France, Germany, Somalia, the Congo & Iraq.
- 1 year conversion course studying law (also at King's, Cambridge)
- 1 year Bar School, 1 year pupillage.
- Practised as a barrister (Chambers of Robin Jacob/Hugh Laddie) 1987-2021, QC in 2008.
- Full range of IP&IT litigation – Patents, Copyright, Trade Marks, Confidential Information, Designs, Technical Contractual Disputes. Several references to the CJEU & cases in the GCt

Judge of the Chancery Division since February 2021

One of two Category 4 & 5 Patents Judges (with Mr Justice Meade)

We spend most of our time in trials of the most technically complex patent cases – mobile phones, pharmaceuticals, biosimilars, medical devices, mechanical inventions etc.

Plus FRAND rate determinations, often global (e.g. *InterDigital v Lenovo* (2023), *Panasonic v Xiaomi* (current))

In the UK Patents Court, we try any case involving patents, along with all other issues – inventorship disputes, patent license disputes, competition defences etc.

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) **Without hindsight, were the differences obvious to the skilled person at the priority date in light of the CGK?**

Claims of Invalidity – Rules and Practices (1)

The Rules (based on many years of experience) are set out in the Civil Procedure Rules Part 63 (Intellectual Property Claims) rule 63.6, as supplemented in the Part 63 Practice Direction.

A Claim of Invalidity:

- **Can be brought as a claim for revocation (Claimant seeking to clear away the Patent), although the patentee often counterclaims for infringement.**
- **Or as a counterclaim to an infringement claim.**

The Statement of Case must [CPR Part 63 Practice Direction para 4.2 (1) & (2)]:

- **Contain particulars of the remedy sought and of the issues *except* those relating to validity of the patent**
- **Have a separate document attached headed 'Grounds of Invalidity'**

Claims of Invalidity – Rules and Practices (2)

The Grounds of Invalidity must [CPR Part 63 Practice Direction para 4.2(2)]:

(a) Specify the grounds on which validity of the patent….is challenged; and

(b) Include particulars that will clearly define every issue (including any challenge to any claimed priority date) which it is intended to raise; and

(c) A copy of each document referred to in the Grounds of Invalidity, and where necessary a translation of the document, must be served with the Grounds of Invalidity.

Furthermore:

Para 4.3(1): If challenged for lack of novelty or lack of inventive step, the particulars must specify details of the matter in the state of the art relied on, as set out in para 4.4

Para 4.4(1): if in a document, the date on which and the means by which it was made available to the public.

Claims of Invalidity – Rules and Practices (3)

And

Para 4.3(2): If insufficiency is alleged, the particulars must state, if appropriate, which examples of the invention cannot be made to work and in which respects they do not work or do not work as described in the specification

Para 4.4(2): If a prior use is alleged, the details required are (a) the date or dates of such use, (b) the name of all persons making the use, (c) the place of the use, (d) any written material which identifies the use, (e) the existence and location of any apparatus employed in such use and (f) all facts and matters relied on to establish that such matter was made available to the public.

Para 4.5: the Court may order inspection of any apparatus or machinery

Para 4.6: if commercial success is relied upon (against an allegation of obviousness), the grounds of it must be set out in the statement of case.

Claims of Invalidity – Rules and Practices (4)

The Rules in CPR 63 PD are the minimum requirements.

Frequently, parties will be ordered to exchange additional statements of case on specific issues, and these may comprise claim charts, divided into the integers of each claim.

For example:

Novelty: which passages in a long document are relied upon, against each integer of the claim

Inventive step: which integers of the claim are disclosed in each piece of prior art

[cf similarly with infringement:

On a normal construction: what is said, in the alleged infringement, to satisfy each integer of the claim

On equivalents: which features are said to be equivalent (and why) – *Facebook v Voxxer*

My Recent Judgments – the pattern of work

InterDigital v Lenovo [2023] EWHC 172 (Pat). Trial C. Sending of Scheduling Information in HSUPA

InterDigital v Lenovo [2023] EWHC 538 & 539 (Pat). Trial E. FRAND trial setting a global rate for 2007-end2023.

Astellas v Teva [2023] EWHC 2571 (Pat). Modified release formulation of mirabegron

[Lifestyle Equities v RCB Polo Club [2023] EWHC 2923 (Ch). Dispute between 2 'polo' brands]

Abbott v Dexcom [2024] EWHC 36 (Pat). Trial A. 4 patents. Glucose monitoring devices

[COPA v Wright [2024] EWHC 1198 (Ch). Was Dr Craig Wright 'Satoshi Nakamoto', the inventor of Bitcoin?]

Abbott v Dexcom [2024] EWHC 1664 (Pat) Trial B. 1 patent. Glucose monitoring devices.

Pfizer v GSK [2024] EWHC 2523 (Pat). Vaccine for Respiratory Syncytial Virus.

Accord v Astellas [2024] EWHC 2524 (Pat). Whether a patent for enzalutamide was obvious over some very close prior art.

Sandoz v Biogen [2024] EWHC 2567 (Pat). Method of assessing risk of Progressive Multifocal Leukoencephalopathy in Multiple Sclerosis patients treated with natalizumab