

EDS v Synergy and Gravitas [2014] EWHC 1306

This recent decision of the Intellectual Property Enterprise Court (IPEC) demonstrates the importance of parties being clear in their pleadings about the technical field of the skilled person when seeking to invalidate a patent for obviousness in the UK. It also highlights problems that can arise in selecting expert witnesses.

Facts

Environmental Defence Systems Ltd (“EDS”) sued Synergy Health plc (“Synergy”) and Gravitas (International) Limited (“Gravitas”) for infringement of its patent covering a method of manufacturing barrage units, which are used for flood defences in a similar way to sandbags. The barrage units of the patent comprise absorbent pads to absorb flood water.

Synergy is a manufacturer of healthcare products, including incontinence pads. Synergy had been making absorbent pads according to the method described in the patent since 1994. Until at least 2007, Synergy’s pads had been used solely for healthcare purposes. Between July 2008 (before the priority date of the patent) and June 2011, Synergy manufactured barrage units according to the method of the patent and supplied them to EDS by agreement.

Gravitas is a manufacturer and supplier of flood defence products. A number of the products which were made and sold by Gravitas included absorbent pads supplied by Synergy which had been manufactured according to the method described in the patent.

Both Synergy and Gravitas made a counterclaim of invalidity. Synergy also pleaded prior use and lack of entitlement. At the case management conference (CMC), it was decided that since all the points turned on the issue of inventiveness, this should be the subject of a trial as a preliminary point, thereby saving cost and time.

Technical field of the skilled person

The parties did not dispute that the method of manufacture of absorbent pads described in the patent was known for healthcare purposes before the priority date. The issue in question was whether it would have been inventive to use this known method in a process for making barrage units.

Generally in the UK, inventiveness is judged by whether the claimed invention is obvious to a skilled person in view of a single piece of prior art in the light of his common general knowledge. In this case, His Honour Judge Hacon discusses differences between UK and EPO procedure regarding identification of the skilled person. The approach in the EPO is that the skilled person

considering inventiveness must come from the same technical field as the prior art unless there is an indication in that prior art pointing to another technical field. In contrast, in the UK the skilled person considering inventiveness could come from any technical field but the party seeking to invalidate a patent needs to nominate the technical field from which the skilled person is drawn. The selection of the technical field dictates the common general knowledge of the skilled person. Thus, the patentee defending against an allegation of invalidity for lack of inventiveness needs to address the extent of the common general knowledge of the skilled person drawn from the technical field selected by the defendant.

By the time of the CMC, Synergy’s grounds of invalidity had made no mention of the skilled person. Gravitas’s grounds stated that the skilled person was a manufacturer of water-absorbing products without saying whether he came from the personal hygiene or flood defence industry. EDS’s defence against the invalidity counterclaim stated that the skilled person was interested in environmental protection with a focus on barrage units.



Expert witnesses

Judge Hacon gave permission for each side to call one expert witness but did not state the technical subject matter to be addressed by the experts.

Following the CMC, and in preparation for trial, EDS called an expert in the personal hygiene business with expertise in absorbent pads for that purpose, along the lines proposed in Gravitas's pleaded case. EDS's expert was unfamiliar with the field of flood defences. Meanwhile, Synergy and Gravitas abandoned Gravitas's pleaded case and called an expert in the field of flood management

As a consequence, when it came to the trial EDS did not have an expert witness who could provide testimony about the common general knowledge of a skilled person in the technical field nominated by the defendant. The Judge expressed some sympathy with EDS, who had called their expert in response to Gravitas's pleadings, but commented that EDS had not challenged the skilled person's technical field at the CMC.

Outcome

The Judge had to make a decision based on the arguments presented at the trial. He found that a skilled person interested in how barrage units can be made, would have found it obvious to include the prior art personal hygiene pads in a barrage unit thus arriving at the claimed method without inventive skill and so the claims of the patent were found to lack inventive step.

Comment

It is clear from the Judgment that Judge Hacon regretted not appreciating the discrepancy in the technical fields proposed by EDS and Gravitas at the CMC. This case illustrates that by the time of the CMC, the parties' contentions with regard to the technical fields of experts must be clear so that the court is in a position to rule on whether expert evidence may be given and to identify the technical field to which that evidence relates. From the CMC onwards these matters should be fixed. This case also highlights the importance of selecting the correct expert witnesses, particularly in IPEC proceedings where the number of witnesses that may be called is restricted.

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