

## Patent for exhaust catalysts survives attack: the perils of hindsight and the benefits of fuzzy boundaries

The UK Patents Court has recently reiterated the perils of hindsight when attacking patents on the ground of obviousness. In upholding the patent, the decision also shows how fuzzy boundaries can defeat ambiguity attacks.

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In a recent judgment<sup>1</sup>, the UK Patents Court has reiterated the perils of hindsight when attacking a patent for obviousness and the importance of proving “would” and not just “could”. In upholding the patent in suit and finding that it was infringed, the decision also rejects ambiguity attacks - under construction and insufficiency - and comes out on the side of the claim having a permissible “fuzzy boundary”. In the latter respect, the court adopted a construction consistent with established rules of claim interpretation according to European Patent Office (EPO) case law, thereby demonstrating the increasing prevalence of the case law of the Boards of Appeal before the UK Courts.

### Background

This case was about the validity of a patent for the substance “ceric oxide” and its method of production, in particular in relation to its surface area and characteristics at high temperatures as they convey favourable properties for catalysts used to clarify exhaust gases.

Anan Kasei (now Solvay) owns the patent, which it exclusively licensed to Rhodia in various European countries. Rhodia sued Molycorp (now Neo) for patent infringement on the basis of products it imported into the UK from a Chinese company (also within the Neo group). Neo denied infringement and counterclaimed for invalidity, relying on grounds of obviousness and insufficiency (having abandoned a novelty attack based on prior use).

This case had previously attracted attention as Rhodia originally commenced proceedings in the UK for infringement of both the UK and German designations of the EP patent. However, Arnold J struck out the claim for relief in respect of the German designation<sup>2</sup> and so this became a more typical patent action concerned only with the EP(UK).

### Obviousness

Neo argued that the patent was obvious based on the prior art (called the Chopin patent), based on adapting the methods therein for making mixed oxides to ones that would produce ceric oxide with the claimed properties.

Two of the main issues considering obviousness in the judgment are:

- **The perils of hindsight** - Neo relied heavily on its expert evidence but, having made late amendments to its case, only instructed its expert to write a further report after he was very familiar with the patent. The expert confirmed that he had formulated his opinions directly referencing the patent rather than analysing the Chopin patent on its own and so the judge assessed this “was inevitably using hindsight”. The judge emphasised that “This method of dealing with this issue is unfortunate and clearly makes it difficult for the evidence not to be tainted by hindsight” and accordingly felt he could give the evidence little weight.
- **Ignorance is allowed** - Neo relied on the principle that even if the skilled person did not expect or intend to obtain a product with the claimed properties or even if she or he did not know that they had done so - this could nonetheless render the claims obvious if it would have been done. This route provides an interesting approach to obviousness given the absence of detailed scrutiny as to the skilled person’s expectation of success (which is not addressed in the judgment at all). However, the motive of the skilled person and the utility of the prior art as a starting point remain relevant factors, and in this case Neo did not overcome the evidential burden of “would”. Indeed, the judge held that even if the skilled person had wanted to arrive at the invention, it would not be obvious based on the Chopin patent.

Ultimately therefore, Neo was unsuccessful under this ground of invalidity.

## Construction / insufficiency

Neo denied infringement and argued that the patent was insufficient on grounds of ambiguity based in the integer in claim 1 for: “A ceric oxide which is an oxide consisting essentially of ceric oxide...” (emphasis added).

Neo argued that there were no directions or explanation in the patent as to what “consisting essentially of” meant and so the skilled person would not be able to implement the invention, or determine whether they had created the claimed substance, without undue effort or at all.

The patentee sought to rely on the case law of the EPO Board of Appeal, which established an approach that “consisting essentially of” meant “apart from mandatory components, no others may be present in a composition which materially affects its essential characteristics”.

Neo’s main objections to this approach were that:

- following the EPO case law was not appropriate as the decisions did not consider the practical outcome, which was understandable as EPO case law was not concerned with infringement, and
- the outcome was impractical because the skilled person needs to be able ascertain from the product alone whether they have satisfied the requirements of the claim and the skilled person might know that certain impurities may affect a product, but not exactly how or how much is required to do so.

The judge held in favour of the EPO approach and found that this construction merely created a limit at the edge of a claim where a precise limit is difficult to ascertain - a “fuzzy boundary” - and as such the patent was not insufficient.

The judge’s approach to construction continues the propensity of the UK Courts to consider and follow the case law of the Technical Boards of Appeal at the EPO, including in this instance on the matter of construction/infringement; an area of law with which the EPO is not concerned. The outcome also emphasises the high evidential burden for successfully proving ambiguity insufficiency.

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<sup>1</sup> *Anan Kasei Co. Ltd & Anor v Molycorp Chemicals & Oxides (Europe) Ltd* [2018] EWHC 843 (Pat)

<sup>2</sup> *Anan Kasei Co., Ltd & Rhodia Operations S.A.S. v Molycorp Chemicals & Oxides (Europe)* [2016] EWHC 1722

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