

# Court of Appeal gives Ice-World the cold shoulder

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On 10 October 2018 the Court of Appeal handed down its judgment in the matter of **Icescape Limited v Ice-World International BV & Ors\***. Three discrete issues were considered by the Court and, although the decision of the Lord Justices of Appeal ultimately did not change the effect of the first instance judgment, the opinions given on Priority, Infringement (further to the supreme court decision in **Actavis v Eli Lilly\*\***), and Threats are worthy of note.

## Priority

Ice-World's patent was for an improved mobile ice rink. The improvement was to use sufficiently flexible joints on the pipes carrying the cooling fluid such that these pipes could be folded up on top of themselves during transportation and then unfolded during operation of the rink. Other than the use of such flexible joints, the patented system was found to be completely within the common general knowledge. The patent validity rested on whether it could properly claim priority from a Dutch patent application. The Court therefore had to decide whether, as per article 87(1) of the European Patent Convention, the Dutch patent application was "in respect of the same invention" as the patent in suit.

In answering this question the Court found that the key inventive concept of the patent was disclosed by the priority document. However, other elements of the invention were not expressly or implicitly disclosed. Following decision G2/98 of the EPO Enlarged Board of Appeal it was "irrelevant" whether these elements "were essential elements of the claimed invention or not". Interestingly, the Court was prepared to accept that the skilled person would readily appreciate the undisclosed elements in so far as, using their common general knowledge together with the priority document, they **could** have made a mobile rink with all of the elements of the invention. However, Lord Kitchin (one of the panel of three judges who heard this appeal before his elevation to the Supreme Court) concluded that the "claim to priority depends upon the express or implicit disclosure of those features in the priority document and, since there is no such disclosure, the claim to priority must fail".

## Infringement

Since Icescape's rink used an arrangement where the cooling pipes were connected in parallel and not in series, as the Court determined the patent specified, it did not fall within Ice-World's patent claim under a purposive construction. The Court therefore gave consideration to what Lord Kitchin denoted the "Actavis questions" further to the Supreme Court decision in **Actavis v Eli Lilly**. The first of these questions was to decide whether, notwithstanding it was not literally within the patent claim, the Icescape rink "achieved substantially the same result in substantially the same way as the [Ice-World] invention". As set out above, the Court had already determined that the core of the Ice-World invention was the use of sufficiently flexible joints so as to allow the rink to be transported more easily. Icescape's rink also achieved this in substantially the same way, answering the first **Actavis** question in the affirmative. The second **Actavis** question: whether it would be obvious to the skilled person that the Icescape rink achieved the substantially the same result in substantially the same way as the Ice-World invention was also answered in the affirmative.

This left the third **Actavis** question: "would the skilled reader of the patent have concluded that Ice-World nonetheless intended that strict compliance with the literal meaning of the claim ... was an essential element of the invention?" The Court of Appeal thought not. Kitchin LJ concluded the "inventive core of the patent has nothing to do with ... whether the fluid flows through [the coolant pipes] in series or parallel" and that there was therefore no reason why the skilled reader would have thought that strict compliance with this element of the invention was necessary. The Court of Appeal therefore overturned the first instance decision by finding that Icescape's rink would have infringed Ice-World's patent, subject to the question of the validity.

Counsel for Icescape contended that, further to the Supreme Court decision in **Actavis**, Icescape should be able to rely on the prosecution history of Ice-world's patent and that this showed that the patent could not have been granted if Ice-World had not limited themselves to a claim in which all of the elements of claim 1 were present. Accordingly, the elements which were now said to be inessential were in fact necessary and, since the Icescape rink did not have these elements, it could not be held to infringe. The Court considered this argument lacked merit stating that "the contents of the file do not unambiguously resolve the point with which we have to deal ... and it would not be contrary to the public interest for the contents of the file to be ignored".

## Threats

At first instance it was found that the letters Ice-World wrote to Icescape's customers alleging infringement of Ice-World's patent were actionable under the threats legislation. Ice-World contended that it had a defence under s.70(2A) of the Patents Act 1977\*\*\* in that it had no reason to suspect that its patent was invalid. The first instance judge had found against Icescape on this issue and the Court of Appeal did not overturn this decision. From the judgment it appears that this was because there were reasons for Ice-World to suspect that its patent may be invalid and Icescape had provided no evidence at trial, for example from its directors, to support the stance that it did not have any reason to doubt the patent's validity. This lack of evidence seems determinative as the Court concluded that Ice-World "had failed to make good the defence under s.70(2A) of the 1977 Act".

## Comments

This is the first Court of Appeal decision to address the **Actavis** questions head-on. Not unexpectedly, the senior patent judges in the Court of Appeal have paid respect to the decision of the Supreme Court whilst making it clear that the claims continue to have an important function and are the starting point for the analysis of variants. The prohibition in the Protocol to Article 69 EPC - that the claims serve only as a guideline - continues to be enforced.

Whilst the case will be remembered for the treatment of the Actavis questions, the commentary on priority and threats is worthy of study for practitioners interested in these issues.

\*[2018] EWCA Civ 2219

\*\*[2017] UKSC 48

\*\*\*The Court noted that the law was amended by the Intellectual Property (Unjustified Threats) Act 2017, but the decision was made under the old law