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Mexichem v Honeywell [2020] EWCA Civ 473: Arrow Declarations – How broad can they be?

Jonathan Ross (Bristows) · Friday, April 3rd, 2020

On 1 April 2020, the Court of Appeal, led by Floyd LJ, handed down [judgment](#) concerning the strike out of an *Arrow* declaration in litigation between Mexichem and Honeywell.

Honeywell owns six patents that focus on the use of two refrigerants (*ze* and *yf*) in mobile air-conditioning systems (“**MACs**”), often used in cars, with a further four divisionals undergoing examination at the EPO.

Mexichem launched revocation proceedings in the UK, and to counter the divisionals, sought an *Arrow* declaration. By the earliest priority date of the patents a Japanese patent application (“Inagaki”) that disclosed *ze* and *yf* had been made available to the public. Accordingly, the *Arrow* declaration sought was that by the priority date it was obvious, in light of Inagaki, to use *ze* or *yf* in the manufacture of a product for use as a refrigerant in a MAC.

Honeywell applied to strike out the *Arrow* declaration, arguing that there was no real prospect of success, as the declaration was not sought in relation to a specific product or process, and that it was so broad that it would lack utility. This application was refused by HHJ Hacon at first instance judgment ([2019] EWHC 3377 (Pat)). He found that general declarations could still serve a useful purpose as they would provide “*a finding of obviousness which can serve as an unchallenged foundation for argument on the inventive step of inventions claimed in patents which may be granted to the defendant in the future*”.

Honeywell appealed this decision with two main submissions. First, it maintained that a declaration of such extreme breadth lacked utility. Second, HHJ Hacon’s view that the declaration could provide a “*foundation*” for inventive step arguments went against the well-established view that obviousness should not be assessed on a step-by-step basis (see for example the warning in *Technograph v Mills & Rockley* [1972] RPC 346).

Floyd LJ reviewed the case law on *Arrow* declarations to establish that there was no requirement for the declaration to identify all the features or a product or process, or that the applicant must have a product in production. A strike-out can be avoided, if it can be shown that there is a real prospect of establishing at trial that a declaration would be useful if specified features of the product were declared old or obvious. The breadth of the declaration may affect that utility, but that is a matter for the trial judge.

Floyd LJ found greater force in the step-by-step arguments. The issue was whether Mexichem could deploy the declaration in the context of more complex combination inventions (such as the inclusion of other components in the refrigerant mix). He agreed with Honeywell that such a stepwise approach to obviousness had been firmly rejected. Therefore, a trial judge may well conclude that the declaration sought was just in respect of a single step and provided no useful purpose. However, Floyd LJ made two further points. First, in cases where a research programme of several steps can be ascertained without hindsight, then a step-by-step analysis may be required, and that in those circumstances a declaration about a particular step would serve a useful purpose. Second, if the patentee is seeking to protect a broad inventive concept, then the declaration could be useful in countering that concept.

Floyd LJ assessed the patents in suit, and found that, despite some patents possessing narrower claims, the group as a whole was designed to protect the idea of using specific refrigerants in MACs. Further, Honeywell had launched infringement proceedings in Germany in a manner suggesting that it did not accept that using *yf* or *ze* in a MAC was obvious. Accordingly, a declaration in such broad terms would be useful in fighting off similar claims.

Finally, Floyd LJ turned to the issue of shielding patents from judicial scrutiny. Honeywell had hinted that the court will have to make a finding on the broad inventive concept at trial, and so a declaration would serve no further purpose. However, Floyd LJ recognised that the current issues may not remain until trial. Mexichem had pleaded that Honeywell had adopted a litigation strategy of abandoning patents to avoid adverse judgments, as evidenced by Honeywell seeking to surrender the UK designation of one of the patents in suit. Accordingly, the declaration would allow Mexichem to remain in procedural control of the issues relating to the inventiveness of the broad concepts, regardless of Honeywell's actions.

Floyd LJ, with whom Lewison LJ agreed, therefore dismissed the appeal.

Although this litigation is not in the life sciences field, any judicial commentary on *Arrow* declarations is of interest, given their previous use by generic and biosimilar companies in seeking to clear the way prior to launch. This case explores the potential breadth of *Arrow* declarations and their use to prevent a patentee from shielding broad inventive concepts from judicial scrutiny.

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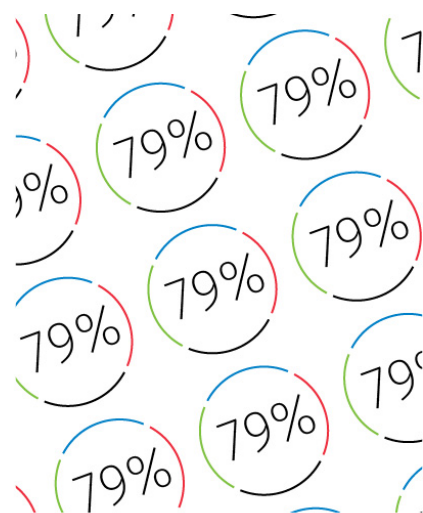
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