

Kluwer Patent Blog

Saint-Gobain Adfors SAS v 3M Innovative Properties Co [2022] EWHC 1666 (Pat), 28 Jun 2022 (consequential decision) and Saint-Gobain Adfors SAS v 3M Innovative Properties Co [2022] EWHC 1018 (Pat), 9 May 2022 (substantive judgment)

David Hemming (Bristows) · Thursday, July 7th, 2022

Michael Tappin QC (sitting as a deputy judge of the High Court)

It is common in English patent litigation for patentees to make an application to amend a patent post grant and in the course of litigation pursuant to section 75 of the Patents Act 1977 – for example in order to delete invalid claims in order to remove dependencies or to hone the claims in order to make them more impregnable as a validity challenge. What is less common, however, is amendment of a patent post *judgment*. A recent decision by Michael Tappin QC, sitting as a deputy judge of the High Court, confirms that post-judgment amendment remains very difficult to achieve and may well even be viewed by the court as an abuse of process. The underlying jurisprudence behind this approach is that it would be unjust to force a defendant to relitigate points on which it had succeeded at trial. The upshot is clear: patentees must make any amendments before trial. After this time, it will invariably be too late.

Before examining the more recent decision which considered the application to amend, first a summary of the facts in the substantive proceedings (which were also heard by Michael Tappin QC). The neutral citation is **[2022] EWHC 1018 (Pat) 9 May 2022** and a link to the judgment can be found [here](#).

This was a claim for revocation of European Patent (UK) 2 373 755 (“the Patent”) by Saint-Gobain (“SG”). 3M was the holder of the patent, which was titled “Dish-shaped abrasive particles with a recessed surface” and had a priority date of 17 December 2008.

The Claimant (SG) argued:

- Lack of novelty over another 3M patent (US 5,366,523, referred to as “Rowenhorst”);
- Lack of inventive step over Rowenhorst; and
- Insufficiency (uncertainty and undue burden to produce something within the claims)

The judge held that the patent was *not* invalid on these grounds. The invalidity argument due to uncertainty type insufficiency failed as well as the case that it would require an undue burden to produce something within the claims (see paragraphs 232-234). However, it was held that the Patent should still be revoked on grounds of insufficiency because “*the skilled person could not*

without undue burden, make dish shaped abrasive particles within an average Tc/Ti ratio towards the upper end of the claim.”, i.e. it would require an undue burden to produce particles across the scope of the claims (see paragraphs 233 and 234 (iii)).

3M subsequently sought permission to appeal. It also applied to amend the patent (should its permission to appeal the substantive judgment be rejected or any appeal be dismissed), and asked for the amendment application to be dealt with at the same time as the costs hearing and appeal application. Given the possible knock-on effects to arguments in these areas, the judge agreed to hear the issues on the same date. This was the subject of the consequential judgment, which has neutral citation [2022] EWHC 1666 (Pat), 28 Jun 2022 and can be found [here](#).

The claim integer subject to the amendment application was integer 6 of Claim 1, which stated that the thickness ratio (Tc/Ti) of the dish-shaped abrasive particles was to be between 1.25 and 5.00. The requested amendment was to change this ratio to between 1.25 and 2.32 or, if refused, to between 1.55 and 2.32.

SG resisted the application to amend the patent, stating that it would not be ready to deal with the application.

Summarising the case law (see paragraph 8 of the consequential decision), Michael Tappin QC noted that in both *Nokia Corp v ICom GmbH & Co KG* [2011] EWCA Civ 6 and *Nikken Kosakusho Works v Pioneer Trading Company* [2005] EWCA Civ 906, the Court of Appeal addressed applications to amend a patent after trial:

- In *Nikken*, Jacob LJ identified several distinct scenarios concerning applications to amend a patent and stated that in one of these classes, where all claims have been held invalid but the patentee wishes to amend in order to validate the claims post-trial (and more specifically, where said claims have not been under attack nor could they have been prior to trial), it would be improper to allow amendment because all issues to be brought before the court must be brought up prior to trial, in accordance with the CPR and the overriding objective.
- Similarly, in *ICom* the true test was deemed to be “abuse of process – procedural fairness”. It was held that this would occur if a party did not advance a case that it could have advanced much earlier and without justification.

Continuing, he also noted that in *Warner-Lambert Co LLC v Generics (UK) Ltd (t/a Mylan)* [2018] UKSC 56, the Supreme Court “upheld the distinction drawn between amendments to delete claims that have been held to be invalid and amendments designed to make good a claim not thus far advanced in the amended form”, in other words confirming that what the Court of Appeal had said in *ICom* and *Nikken* was correct.

After summarising what the amendment request proposed by 3M entailed, the judge concluded, using the same wording as Lord Briggs in *Warner-Lambert*, that the proposed amendments to the range of thickness ratios were clearly “*designed to make good a claim not thus far advanced in the amended form*” (paragraph 13).

He then summarised 3M’s position, which was that in the trial judgment, he (Michael Tappin QC) had established that the Patent as proposed to be amended was valid; that no further trial would be required and consequently there could be no abuse of process; and that the present case would fall into the category of being covered in the main litigation (another of the categories identified by Jacob LJ in *Nikken*).

However, at paragraph 24, the judge stated that 3M had been incorrect in its belief that, in the substantive trial, he had deemed that the Patent was valid subject to its proposed amendments and therefore was arguable in the trial. In fact, the subject of the proposed amendment had not been an issue in the trial and a further trial would have been required in order to address this point.

Consequently, the judge refused the application, stating that 3M could and should have made the application before trial, had it wanted to contend that the claims would be valid in an amended form. If he had allowed the application, then it would have been unfair to SG and would have been an abuse of the process of the court (see paragraph 30). Both SG and the court had no prior warning that 3M would seek to contend that *“the skilled person could, without undue burden make particles across the range of the proposed claims”*. Returning to the issue of patent validity, it was noted that even if 3M’s contention that the patent was valid subject to the amendment had been correct, *“it would still have been an abuse of process to apply to amend the Patent after judgment. The purposes behind the requirement that a party should bring forward its whole case for adjudication include giving the opposing party notice of the case that it needs to address and the court notice of the issues that it needs to decide.”* Clearly, upholding the principle of fairness to both parties remains of the utmost importance in the eyes of the court.

As a final point, Michael Tappin QC said that 3M’s draft grounds of appeal on both the substantive judgment and the consequential amendment judgment did not have a real prospect of success, and the judge refused permission to appeal (paragraphs 59 and 60).

As noted in the introduction to this post, what is clear from this judgment is that amending a patent post judgment remains a very difficult thing to do. Any requests for amendments to a patent should be made prior to this stage, in order to avoid falling foul of the court and be deemed to be abusing the process of the court. 3M had argued that had it applied sooner, there would have been procedural objections, however it is notable that at paragraph 27 of the judgment, it was stated that had this been the case, then the court would have been able to consider the matter and decide on case management directions as required.

In keeping with the overriding objective of enabling the court *“to deal with cases justly and at proportionate cost”*, and more specifically concerning CPR r. 1.1 (a), which states that this involves *“ensuring that the parties are on an equal footing and can participate fully in proceedings”*, clearly the court holds the view that bringing all issues for dispute forward in good time, and with sufficient notice for both the opposing side and the court itself, remains of the utmost importance. An application to amend a patent post judgment when it could have been raised sooner is not in keeping with this aim. Any such applications should be brought up early in proceedings if so desired, rather than holding off until after the judgement.

Regarding whether 3M will approach the Court of Appeal and, if so, whether the appeal judges will make any further comments on this topic, watch this space.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe [here](#).

Kluwer IP Law

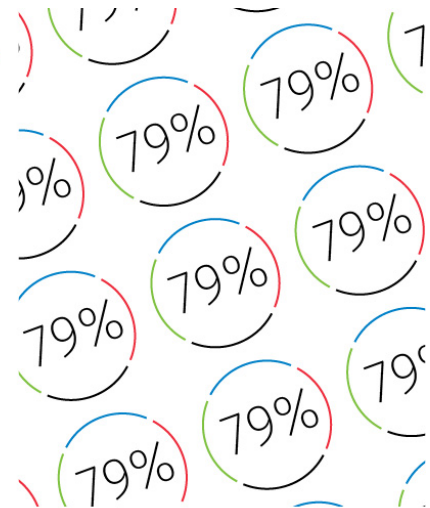
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Thursday, July 7th, 2022 at 4:15 pm and is filed under [G 1/93](#), OJ 1994, 541) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*“>Amendments, [Case Law](#), [Patents](#), [United Kingdom](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. Both comments and pings are currently closed.