
Kluwer Patent Blog

To cite or not to cite?

Brian Cordery (Bristows) · Tuesday, October 12th, 2010

When challenging the validity of a patent, a decision needs to be made early on as to grounds on which to rely. When it comes to allegations of anticipation and obviousness, the challenger and its advisers will need to consider whether to rely on just one or two prior art citations or to include a multiplicity of references.

At the present time, there is a stark contrast between practice in the English Patents Court and that in the EPO.

The starting point for the analysis is that in neither forum is there presently a legal restriction as to the amount of prior art citations that can be raised in the pleadings. Thus, subject to strategic considerations, a challenger is given a free rein.

However, this is more or less where the similarities in practice between the EPO and the English Patents Courts end. Let's look at the EPO first. Here the leading decision of G10/91 held that there is no guarantee that a party will be able to raise an attack at a later stage in the opposition. Moreover, at the Opposition Hearing there is no sanction applied or even adverse comment made if a multiplicity of references is relied upon. The only factor to bear in mind is that the panel forming the Opposition Division are human and as such, will only have a limited attention span and focus.

In contrast, the English Court will generally expect a party to rely on its best two or three citations. If a multiplicity of citations is pleaded, and particularly maintained and pursued at trial, there is a good chance that it will attract adverse comments from the trial judge. Thus, in *Honeywell v ACL* [1996] Jacob J. observed:

“One always has to be suspicious when several obviousness attacks are run ... I was always taught that ‘too many shots at the target make for subject matter’”.

The point was reinforced in *Corus v Qual-Chem* [2008] where Jacob LJ (now sitting in the Court of appeal) observed:

“Although Corus pleaded many more points originally, the trial judge had to deal with what, by my count, were no less than 10 discrete points or sub-points. The taking of many points is often the mark of a party which does not feel that it has a single “killer”. So it proved before the Judge who rejected all of them.”

The same thinking has been adopted by other Judges. Recently, in *Fosroc v Grace* [2010], Floyd J.

observed (when rejecting an allegation of obviousness over four items of prior art): “*a case of obviousness is seldom enhanced by the citation of multiple prior art references. This case was not an exception*”. That said, in *HTC v Yozmot* [2010] (where five items of prior art were relied upon for novelty and obviousness allegations and the validity of the patent had been challenged in numerous other ways): “*HTC has raised a plethora of objections to validity. It relies upon no less than five items of prior art. If that was not enough, it also relies upon allegations of insufficiency, added matter and not a patentable invention. One is tempted to conclude that the Patent must be valid if HTC has to advance so many different arguments against it, but that is not a substitute for analysis of the merits of each argument.*”.

Another point to note is that if a party seeks a speedy trial in the English Court, it may often be forced to rely on its best prior art only. Thus, in *KCI v Smith & Nephew* [2009] the defendant elected to pursue only one piece of prior art in return for the concession of a speedy trial.

Overall, the picture is clear – less is often more in the English Patents Court. Moreover challengers in the English Court are almost always able to amend their Statements of Case at a later stage in the case. It is not uncommon for a challenger to seek to introduce new prior art in the week before the trial or during the trial itself. Subject to allowing the other side appropriate time to consider and respond to the allegation, the new prior art is nearly always allowed in. The only sanction is in costs. Therefore a party should not be anxious about relying on only its best citations before the English Court, nor that its case in the EPO looks different from that in England.

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