

# Kluwer Patent Blog

## LG Electronics Inc v Sony Europe Limited and others [2011] EWHC 2319 (Pat)

Brian Cordery (Bristows) · Monday, October 17th, 2011

**The English High Court has refused to grant summary judgment to LG Electronics in relation to validity of certain patents, holding that, due to the uncertainty of the legal issue concerning the confidentiality of the prior disclosure relied on, the matter was not relevant for summary judgment.**

LG Electronics (“LG”) sued Sony for infringement of three patents relating to Blu-Ray technology (technology which involves optical disc storage media designed to supersede the DVD format). Sony defended the claim on the grounds that all three patents were invalid and counterclaimed for revocation.

The earliest priority date of the patents in suit was March 2003. In Sony’s grounds of invalidity, one of the items of prior art it relied upon (in two cases depriving LG’s patents of novelty and in the third of obviousness) was a DVD specification (the “document”) dated December 1997. Obviously, in order for Sony to be in a position to rely upon the prior art, the document had to have been made available to the public prior to the priority date. LG argued that this was not the case since the document was confidential and therefore it had not been made available. It contended inter alia the following:

- (1) On the face of it, the document contained a confidentiality notice; and
- (2) The document was only available by paying a fee (\$5,000) and signing a non-disclosure agreement.

LG relied on Floyd J’s judgment in *Qualcomm Inc v Nokia Corp* [2008] EWHC 329 (Pat), para 12:

*“Nokia submitted that, where a document is effectively circulated to every person having an interest in it, it should be treated as made available to the public, even if individual recipients were supplied the document in confidence. I cannot accept that submission”.*

Against that, Sony argued that the document was extremely widely disseminated and in particular hundreds of companies in the DVD industry had obtained copies of it. Further, Sony relied on three cases brought before the Technical Board of Appeal at the European Patent Office which were not cited by Floyd J in *Qualcomm*. In particular, it relied on case T50/02 *Daikin Industries*, para 2.5.3:

*“The Board sees... ‘being made available to the public’ as the information being available to any interested person, who having once obtained the information should then be free to exploit the*

*information for his own purposes in an industrial application...”*

Here, Arnold J held that there was room for debate as to the correct test to apply. In light of the EPO cases raised by Sony he felt that the position in law may not be quite so clear as it appeared to Floyd J in *Qualcomm* and that this was one of those situations where it was necessary to determine what the facts were first before reaching a view as to the law. In the circumstances it seemed that Sony had a real prospect of establishing the factual basis upon which it relied. Further, there were other compelling reasons for the issue to be disposed of at full trial – Sony argued that the contents of the document were not merely made available to the public but they were also common general knowledge.

Accordingly, Arnold J held this was not a matter fit for summary judgment.

---

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

## Kluwer IP Law

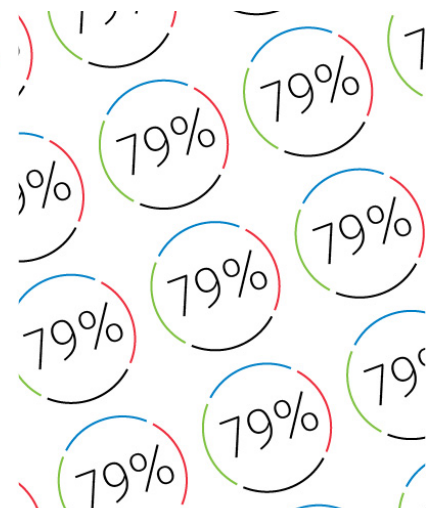
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred 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 Monday, October 17th, 2011 at 11:15 am and is filed under [\(Indirect\) infringement](#), [Public prior use](#), [United Kingdom](#), [Validity](#)

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