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Headphones Case Underlines Importance of Fact Evidence

Brian Cordery (Bristows) · Thursday, June 14th, 2018

by Claire Phipps-Jones

On 24 April 2018, Roger Wyand QC (sitting as a deputy judge in the High Court) held that a patent belonging to Freebit was invalid and not infringed by Bose's flexible in-ear earpieces. The key points of interest in the decision concerned construction and the fact evidence relied on in relation to the alleged prior publication of the Freebit H1.

The usual principles of purposive construction were applied to determine that the patent claims were limited to the shape of the earpiece before it was inserted into the ear, rather than to include earpieces that may be compressed on insertion and/or shaped by the ear canal. This led to a finding that the patent was not anticipated and was not infringed by Bose's somewhat soft and flexible earpieces, which adopted the patented shape only after insertion into the ear. The judgment did not deal with infringement on the newly established basis of equivalents and it is, perhaps, noteworthy that the Judge quoted Jacob LJ in **Virgin**: *"[…] it further follows that there is no general 'doctrine of equivalents"*. It is not clear if the Judge was seeking to distinguish a "general" doctrine of equivalence from the doctrine of equivalence formulated by the Supreme Court in **Actavis**.

A further issue of interest was the fairly scathing analysis from the Judge concerning Freebit's choice of fact witness. Freebit had adduced evidence of fact into the case from a Mr Sandanger in relation to the public availability of an alleged prior use. However Mr Sandanger had not been employed by the company at the time and the Judge held: *"[…] In other words, although Mr Sandanger [one of Freebit's fact witness] was the least well placed in terms of setting out the facts as they occurred in 2006 before he arrived, he was the best placed to know what needed to be said in the context of the litigation."* The English Court can – and in this case did – draw an adverse inference on the basis that potential fact witnesses who had first hand knowledge of the Freebit H1 (which was allegedly disclosed prior to the priority date of the patent in suit) were available to Freebit, but were not called. He went on to say: *"It is not enough for the patentee to sit back and say the onus is on the party alleging prior publication. The patentee is the party with the best access to the facts and it is incumbent on them to establish those facts either by documents or witness evidence or both once a case to answer has been raised."*. In addition, Freebit did not have any documentary support showing the shape of the shape of the various earpieces disclosed before the priority date. Consequently it was held that, on the balance of probabilities, there was a prior publication by the Freebit H1 which anticipated the patent.

This case clearly demonstrates the need for the patentee to ensure wherever possible that those

individuals with actual knowledge of any prior disclosure are called, especially in cases where the documentary evidence alone is not sufficient.

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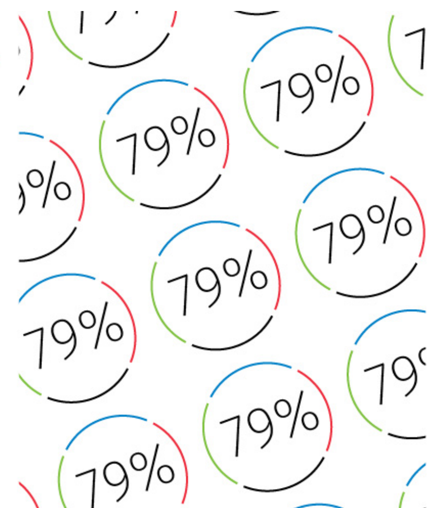

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