

# Kluwer Patent Blog

## Anan Kasei v Neo Chemicals – Court of Appeal clarifies “uncertainty” insufficiency and excessive breadth insufficiency

Kate O’Sullivan (Bristows) · Tuesday, October 15th, 2019

On 9 October 2019, the Court of Appeal dismissed an appeal against the finding that a patent directed towards ceramic compounds was sufficient and allowed two procedural appeals on issues of liability.

Anan Kasei and Rhodia (“Rhodia”) are respectively the proprietor and exclusive licensee of a patent for ceric oxide compounds for use in catalytic converters. Claim 1 of the patent claimed “*A ceric oxide consisting essentially of a ceric oxide, and wherein said ceric oxide has a specific surface area of not smaller than 30.0 m<sup>2</sup>/g when subjected to calcination at 900°C for 5 hours*”, i.e. it claimed a product defined by functional limitations. Rhodia brought infringement proceedings against Molycorp, who counterclaimed for revocation. At first instance, the judge rejected Molycorp’s arguments and found the patent valid and infringed.

Following judgment, Rhodia applied to join Neo’s parent company, Neo Canada, to the proceedings on the basis that it was a joint tortfeasor. Rhodia also argued Neo Canada was liable for acts of Neo’s previous parent company, Neo Cayman. Neo Canada was joined, on the basis that the allegation of joint tortfeasance was arguable, but its liability would be limited to specific infringing acts. Further, Neo Cayman’s liabilities had not transferred to Neo Canada on the evidence presented to the Court.

On appeal, Molycorp, now known as “Neo”, appealed the judge’s findings on insufficiency on two grounds. Rhodia appealed the procedural decisions.

On sufficiency, Neo first contended that the term “consisting essentially of” rendered the claim invalid for ambiguity insufficiency. Relying on a “materiality test”, Neo argued that the skilled person would not be able to tell whether an added ingredient had a material effect on the functions of the product and was thus infringing.

In the judgment, Floyd LJ noted that this type of insufficiency is often mislabelled “ambiguity” insufficiency, whereas it ought to be described as “uncertainty” insufficient. The claim must be conceptually uncertain, not merely defined by a fuzzy boundary. The Court of Appeal held that Neo’s insufficiency attack failed. The insufficiency test is not whether a purchaser of the product could determine whether the product infringed the claim. Instead, it is whether the specification of the patent discloses the invention clearly and completely enough for it to be performed by the

skilled person. Floyd LJ found that Neo had failed to make out on the evidence that it would be an undue burden for the skilled person to determine whether a product was inside or outside the claim.

Neo's second challenge to the sufficiency concerned the breadth of claim 1. Neo contended that Rhodia's contribution to the art was simply one method of making ceric oxide with desirable characteristics and it should therefore not be permitted to claim the entire class of compounds.

Floyd LJ revisited the leading cases of **Biogen v Medeva** [1997] and **Generics v Lundbeck** [2009] on breadth of claim insufficiency. The underlying rule is that the patentee cannot claim more than it has enabled. Floyd LJ held that whilst Neo was correct to say that the patent only enabled the structures which would be made by the methods disclosed in the specification, it had to go further to establish insufficiency. Neo had to positively show that there were structures covered by the claim that could not be made with the benefit of the teaching of the patent. On the evidence adduced at Court, Neo had failed to do this. The argument was therefore rejected and the sufficiency appeal dismissed.

On the procedural appeals, Floyd LJ noted that the evidence suggested that Neo Cayman had stepped beyond the sphere of constitutional control when it was Neo's parent company and was arguably involved in the infringing acts, namely the import and export of the goods when it had knowledge of the pending litigation. Floyd LJ found it arguable that Neo Canada had assumed Neo Cayman's liabilities on acquisition and there was sufficient evidence to go to trial on the matter. Floyd LJ thought it was wrong that Neo Canada's liability would be limited to specific acts, prior to holding trial on common design. The Court therefore allowed both procedural appeals.

This case is interesting as it clarifies and confirms some aspects of the various branches of the law of insufficiency which are applied in UK patent law. In light of Floyd LJ's decision, what many UK practitioners referred to as "insufficiency by ambiguity" will now have to be renamed "insufficiency by uncertainty" although the principles are unchanged.

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