

Kluwer Patent Blog

Prior Public Disclosure in *Claydon Yield-O-Meter v Mzuri*: a Dangerous Precedent

Enrico Bonadio (City, University of London) and Anushka Tanwar (University School of Law and Legal Studies, New Delhi) · Thursday, June 17th, 2021

On 22 April 2021 the Intellectual Property Enterprise Court (IPEC) gave a [judgement](#) in *Claydon Yield-O-Meter v Mzuri*, a UK case on patent invalidity because of prior disclosure. As is known, in order for an invention to be considered new under Section 2(2) of the UK's Patents Act 1977, it must not form part of 'the state of the art', i.e. all matter which is available to the public anywhere in the world in any manner, before the priority date.

It should be reminded that even if there is no one to observe the disclosure, just a possibility of prior public use being observed can rob an invention of its novelty. This principle was previously affirmed in *Lux Traffic Controls Ltd v Pike Signals Ltd* (1993). In that case, the invention related to a traffic signal light system. Before the filing date, field trials had been carried out by the applicant. The defendant argued that the invention had been made available to the public because a prototype had been used in public and it did not matter whether anyone observed the particular feature claimed by the patentee. It was held that the relevant claim of the patent was invalid for lack of novelty. Indeed, the court noted, a prototype was made available to a contractor and – if a skilled man had examined it – he/she would have seen how it worked. Whether such person examined it did not matter. To back up this argument the court pointed out that a book on the library shelf may be deemed a prior disclosure even if no one has actually ever opened and read it.

Background and decision in *Claydon Yield-O-Meter v Mzuri*

Claydon Yield-O-Meter Limited ('Claydon') was the claimant. Mzuri Limited ('Mzuri') and Christopher Martin Lole (sole director of Mzuri) were the defendants. The two companies are both manufacturers and sellers of agricultural equipment. Mr Jeffrey Claydon, CEO of Claydon, to whom the patents were granted, appeared as a third party to the dispute. Claydon filed a case against Mzuri claiming infringement of both its UK and European patents. The patents protected a seed drill, which is attached to tractors for precisely sowing seeds. The inventor, Mr Claydon, tested the invention prototype in his farm for ten hours over two days, before filing for the patents. There was a six-foot tall hedge surrounding the farm and the hedge had several gaps from where anyone could peep into the field. Mzuri contended that Claydon's prototype could have been seen by anyone from the footpath to which the public had access, providing enough information to enable an understanding of the invention.

Muzri therefore filed a counterclaim for revocation of both the UK and European patents for lack

of novelty due to public prior use. Mr Claydon declared that due to his prior experience of patents, he knew prior public disclosure of his invention could threaten his ability to patent it. He further explained that such experience made him take necessary measures; from the vantage point of his tractor cab, he could see anyone in the vicinity before they could even have a chance to glance at the field so if he had seen anyone, he would have moved away, making the drill prototype not visible to anyone.

The Court held Claydon's patent invalid because of prior public disclosure. Judge Hacon distinguished *E. Mishan & Sons Inc. v. Hozelock*, where it was held that a series of tests of the patented hosepipe by the inventor in his garden did not amount to prior public disclosure, as the inventor was well aware of the danger. Indeed, if the inventor had become aware of someone watching him, he would have taken the hosepipe somewhere else where it would be out of sight to everyone. As mentioned, Judge Hacon distinguished such case and found that even if the inventor had been aware of someone passing by, he would not have been able to conceal it due to the (big) size of the seed drill.

Practical and legal issues

This decision raises the practical question how inventors can confidentially test and develop large inventions outdoor at their own premises. One may note that the bigger the machinery which incorporates the invention, the more difficult it is to test and develop the technology in question.

Also, decisions like *Claydon Yield-O-Meter v Mzuri* may be detrimental to specific industries (such as agricultural machinery) where innovation processes require large scale experiments involving big products. One may even go as far as claiming that this would contravene the principle of non-discrimination based on the field of technology under Article 27 TRIPS, which states that patents shall be available and patent rights enjoyable without discrimination as to field of technology. In other words, inventions incorporated in bigger products might de facto be discriminated vis-a'-vis inventions related to smaller ones.

The concept of de facto discrimination was clarified by a 2000 WTO Panel's [report](#) in Canada – Patent Protection of Pharmaceutical Products (para 7.101):

- “[D]e facto discrimination is a general term describing the legal conclusion that an ostensibly neutral measure transgresses a non-discrimination norm because its actual effect is to impose differentially disadvantageous consequences on certain parties, and because those differential effects are found to be wrong or unjustifiable”.

It seems to us that this fits into the *Claydon Yield-O-Meter v Mzuri* scenario. Judge Hacon's finding in the ruling looks neutral as it is not formally addressed to a particular category of inventors or fields of technology. Yet, its actual effect is to impose negative consequences on inventors within industries which require large scale tests: a finding which is therefore difficult to justify and consider fair.

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

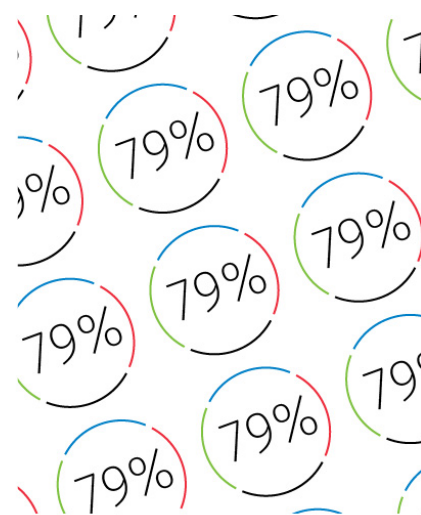
Kluwer IP Law

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, June 17th, 2021 at 11:07 am and is filed under [Case Law](#), [Novelty](#), [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.