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Vernacare's patent c-hallen-ged at the Court of Appeal by Hallen v Brabantia principle

Jonathan Ross, Florence Plisner (Bristows) · Monday, July 24th, 2023

On 18 July 2023, the Court of Appeal handed down its judgment in *Vernacare Limited v Moulded Fibre Products Limited* [2023] EWCA Civ 841, an appeal from the decision of Nicholas Caddick QC (sitting as a Deputy High Court Judge in the Intellectual Property Enterprise Court). The Court of Appeal, with Sir Christopher Floyd giving the leading judgment, and Arnold LJ and King LJ in agreement, allowed the appeal, overturning the first instance decision and finding the patent at issue invalid. The judgment primarily focusses on questions of claim construction and formulation of the inventive concept.

First Instance Decision

The First Instance Decision, [reported by Bristows in September last year](#), addressed the validity of two of Vernacare Limited's ("**Venacare**") patents, GB 2446793 (the "**793 Patent**") and GB 2439947 (the "**947 Patent**"), and the infringement of the 793 Patent. Nicholas Caddick QC found that the 793 Patent was valid but not infringed via the first application in the UK of the 'Formstein Defence'. The 947 Patent was also found valid, and infringement of this patent was admitted by Moulded Fibre Products Limited ("**MFP**"). The appeal related to the trial judge's conclusion that claims 1 and 9 of the 947 Patent were valid.

The 947 Patent claims an open-topped, detergent resistant washbowl made from moulded paper and pulp such as that used in packaging inserts and egg boxes. Such washbowls are typically used in hospitals and similar settings. Resistance to detergents is conferred by the addition of a fluorocarbon to the paper pulp during the manufacturing process. This ensures that the moulded washbowls do not disintegrate when in contact with soap or detergent.

Claim 1 claims a mouldable paper pulp composition wherein the article is an open-topped washbowl comprising a detergent resistant binding agent which is a fluorocarbon.

Claim 9 adds that the detergent resistant binding agent is present in the mouldable paper pulp composition is an amount from 10 mL to 200 mL per Kg dry weight of base material.

A prior art publication, termed Shimooka, discloses that a wide range of shaped articles, including tableware, can be made by moulding paper pulp and that if a fluorocarbon is added the shaped articles will have enhanced water, oil and grease resistance. Shimooka says nothing about resistance to soap or detergent.

There was a dispute between the parties as to the inventive concept. Vernacare contended that the inventive concept was that a detergent resistant washbowl can be made using a fluorocarbon agent in the composition from which it is made. MFP contended that the inventive concept was an article with the following features: (1) an open topped receptacle capable of being used as a washbowl in the sense that it can hold a volume of water and can be dipped into by the user, (2) made from mouldable paper pulp and (3) pulp composition including a detergent resistance agent that comprised a fluorocarbon such that the article is in fact detergent resistant. The judge accepted Vernacare's contention.

Applying *Pozzoli* [2007] EWCA Civ 588 – the conventional 4-stage test used to assess inventive step in UK patent cases – the trial judge stated that, whilst Shimooka disclosed the use of a fluororesin (which the parties agreed was the same as the fluorocarbon in the claim) to give oil and water resistance to a “simple food container”, claim 1 disclosed the use of a fluorocarbon to give *detergent resistance* to a *washbowl*. The skilled person would not have a particular need to think about oil and water resistance and, given the common general knowledge, no reason to think that the use of fluorocarbon to make a food container resistant to water or oil may be relevant to the issue of making a *detergent resistant washbowl* from moulded paper pulp. There was therefore nothing in Shimooka which would have led the skilled person to try adding fluorocarbon to the pulp mix as a means to address that issue.

In relation to claim 9, the judge found that there was nothing in Shimooka to render the claim obvious. MFP was not permitted to adduce a case of the claimed range being arbitrary under T939/92 *Agrevo* in its closing submissions as its pleaded case was simply one of obviousness over Shimooka.

Grounds of Appeal

The Court of Appeal considered in detail two of MFP's grounds of appeal. The first was that the judge wrongly formulated the inventive concept of claim 1. The second was that the judge wrongly found claim 9 to be independently inventive.

Claim 1

MFP argued that the trial judge introduced an illegitimate purpose-based element into the claim. The consequence was that the judge's construction wrongly excluded a detergent resistant washbowl which was made for reasons other than achieving detergent resistance.

MFP cited *Hallen v Brabantia* [1991] RPC 195 to support its argument that, if it was obvious to make an article fitting the description “washbowl” from a fluorocarbon containing pulp for the purposes of achieving oil and water resistance, then it was irrelevant that it was not obvious that detergent resistance would also be achieved. The skilled person carrying out Shimooka would do so in the expectation of obtaining an article with oil, water and grease resistance. It did not matter that Shimooka did not disclose the additional benefit of detergent resistance. Vernacare argued that such an approach was constructed artificially and with the benefit of hindsight.

The Court of Appeal concluded that the inventive concept of claim 1 is a washbowl made from paper pulp containing a fluorocarbon. By formulating the inventive concept as the appreciation that a detergent resistant washbowl can be made from pulp containing a fluorocarbon, rather than as a detergent resistant washbowl so made, the trial judge introduced an additional element into the claim in error. Properly construed, there was no requirement in the claim that the fluorocarbon be

added for the purpose of conferring detergent resistance, or that the maker of the washbowl appreciates that the fluorocarbon is added for that purpose. The claim would be infringed whether or not the fluorocarbon was added for that purpose and whether or not the infringer appreciated that the consequence of adding the fluorocarbon was to achieve detergent resistance.

The relevant question under *Pozzoli* was therefore whether a washbowl made from paper pulp containing a fluorocarbon was obvious to a skilled but unimaginative person armed with Shimooka and the common general knowledge. Attention therefore turned to whether the skilled person following Shimooka would arrive at a washbowl.

Vernacare argued that a washbowl had multiple requirements, such as the ability to hold a specific volume of water and a definable feature to enable carrying around a hospital. However, the Court of Appeal disagreed, finding that any bowl able to hold enough water to be useful for washing could constitute a washbowl. Vernacare's own evidence (which was made in support of its case at first instance that its products' commercial success supported the validity of the patent) referred to prior wash bowls that were approximately the size of a cereal bowl. Therefore, following the teaching of Shimooka which related to tableware, the skilled person would be motivated to make a bowl with all the requirements of claim 1.

Claim 9

The Court of Appeal noted that the trial judge did not consider the question of obviousness of claim 9 on the basis of MFP's inventive concept. Further, the judge did not consider the evidence of one of MFP's experts which asserted that the dosages stated in claim 9 would be obvious to try to the skilled person. Therefore, the Court of Appeal was entitled to re-evaluate the issue of obviousness.

Although the use of fluorocarbons to impart detergent resistance was not part of the common general knowledge of the skilled person, the skilled person would, if a technical issue arose regarding formulation, consult a specialist for advice. This would be so whatever purpose the skilled person had in view for the addition of the agent.

Further, it was common ground that an article made following the teaching of Shimooka would in fact be detergent resistant. This shows that it is unlikely that there is any difference between the amounts of fluorocarbon needed to achieve water, oil and grease resistance on the one hand and detergent resistance on the other. In these circumstances, it does not matter that the expert's evidence was given on the basis of imparting detergent resistance rather than water, oil and grease resistance. The expert's evidence that the wide range of relative volumes in claim 9 would be obvious ones to try was therefore fatal to claim 9.

Therefore, the Court of Appeal found the 947 Patent invalid.

Comment

The Court of Appeal noted that it was unfortunate that the trial judge was not referred to *Hallen v Brabantia*. *Hallen* is known to English patent practitioners as the leading case on "bonus effects" i.e. the proposition that if a product or process is obvious for one reason, it does not matter than an additional, unexpected benefit is also achieved. The invention in *Hallen* was a cork-screw coated with a friction-reducing material. It was obvious that this coating would aid insertion of the screw into the cork and that was sufficient to render the patent obvious notwithstanding the fact that the

coated screw aided removal of the cork and this further effect was not foreseeable. Had *Hallen* been cited at first instance, Sir Christopher Floyd considered that the trial judge may well have reached a different conclusion.

This is a case in which application of the EPO's problem-solution approach may offer a diverging outcome. Formulating the objective technical problem as the desire to make a detergent resistant washbowl, with the solution as use of a fluorocarbon, may have led to the finding that the solution was not obvious, notwithstanding the disclosure in Shimooka.

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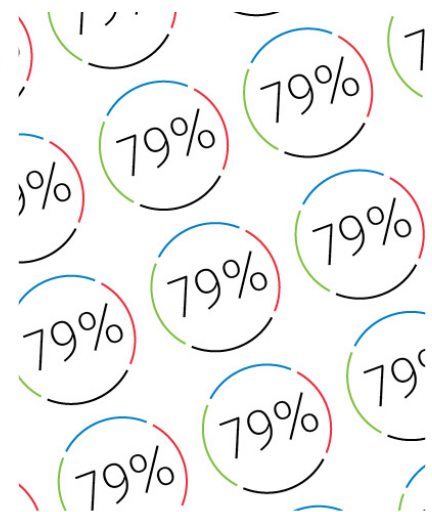
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