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Im-Promptu submissions on display – Supponor v AIM [2024] EWCA Civ 396

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On 23 April 2024, the Court of Appeal handed down its judgment in the appeal arising from the January 2023 decision of Meade J in *AIM v Supponor* [2023] EWHC 164 (Pat). AIM is the proprietor of EP (UK) 3 295 663, which relates to technology that allows TV broadcasters of live events to superimpose new advertising material on top of electronic display boards in the venue.

This can be useful, for example, when the event is being broadcast in other countries and the broadcaster wishes to expose viewers to different advertisement content in different countries. The patent relates in particular to what happens when an object (such as a player or the ball) blocks the TV camera’s view of the display boards. At first instance, Meade J found the patent valid and infringed by Supponor’s system.

On appeal, Birss LJ wrote the lead judgment, which, although not replete with new law, is of interest in particular for its commentary on practice and procedure. Before turning to that, it is worth mentioning one point on construction and the information which may (or may not) be taken into account when construing a claim. In particular, Birss LJ noted that “*If matter is not set out in the patent and is not part of the common general knowledge then it is not relevant to construction*”. Applying this, the Court rejected several of Supponor’s submissions (including a sadly-unexplained reference to the “*Where’s Wally?*” series of books) which were held to be “related to hypothetical examples” rather than part of the CGK of the skilled person at the priority date.

Supponor also appealed on a ground referred to in the Judgment as the *Promptu* point, after the decision of Meade J in *Promptu v Sky* [2021] EWHC 2021 (Pat) which Supponor claimed supported their contention. In a letter around a month before the first-instance trial, AIM’s solicitors wrote to Supponor’s solicitors seeking to narrow the issues in dispute. The letter included the wording:

“Our client no longer contends in these UK proceedings that claim 1 of EP(UK) 3 295 663 B1 as granted is valid. Claim 12 is therefore the only granted claim which falls to be considered at trial”.

Supponor’s solicitors responded arguing that, since there was no real difference between claim 1 and claim 12, the consequence of AIM’s concession on claim 1 was that claim 12 was also invalid and the patent must be revoked. At first instance, Meade J had rejected this argument, characterising Supponor’s conduct as “opportunistic and a distraction” and noting that it would be extremely unjust to prevent AIM from relying on claim 12. On appeal, the Court agreed with Meade J, holding :

1. AIM's letter was not an admission of invalidity – it had been a pragmatic case management proposal. Further, there had been no admission on what grounds the claim was invalid – an argument of the kind advanced by Supponor was impossible without knowing the basis on which the claim was invalid.[1]
2. Claims 1 and 12 were not identical, with the former being a method claim and the latter a product claim. It was “basic patent law” that a product claim might lack novelty while a method claim relating to the same technical material did not.

The Court therefore rejected Supponor's submissions on the *Promptu* point and upheld the validity of the patent.

The Court also agreed with the first-instance Judge that it would be unfortunate to discourage patentees from making sensible case management proposals for fear of unforeseen consequences.

As many readers will know, it is common practice in English civil litigation for the parties' legal teams to be provided with a draft of the judgment by the Court a few days before it is formally handed down and made public. The draft is provided under a very strict embargo and its purpose is for the parties to suggest minor corrections to the judgment (such as typographical errors) as well as to the parties to prepare privately for the formal handing down of the decision. As has been made clear by the Court of Appeal in cases such as *R v Foreign Secretary (No. 2)* [2010] EWCA Civ 158, the purpose of providing an embargoed draft to the parties is not to enable them to re-argue the merits of the case. In a postscript to the Supponor case, the Court noted that both parties had sought to go beyond this permitted remit. AIM's solicitors were said to have made “*fairly transparent attempts to adjust the wording of the draft judgment for its own purposes*”, while Supponor's solicitors had filed submissions asking the court to either revise the judgment and allow one of its grounds of appeal, or to remit consideration of that ground to the High Court. The Court of Appeal dismissed these changes requested by the parties.

This decision is a reminder of some pitfalls in seeking to manage cases – the Court noted the importance of making sure that the precise basis and extent of an expression is made clear – and in bearing in mind that if your opposition has appeared to cede the entire case to you on a technicality, it may be worth pausing before taking it to the Court of Appeal. It also serves as a salient reminder that the Court will generally favour those parties who take a pragmatic approach and which seek to narrow the issues before the Court. The second author of this post had the pleasure of attending the Judges' panel at the Fordham conference in New York earlier this month. The message from all the panellists was clear – run your best points, run them clearly and succinctly. Don't dilute your good points with bad ones. The same message was delivered by the Deputy Patents Court Judges at a session held last week in London which the first author attended. There is a short English phrase – not suitable for print – but featuring the word “cake” that sums this principle up nicely.

[1] When reading this point, the authors were reminded of the decision of Vos J in *Fresenius v Carefusion* [2011] EWHC 2969 in which it was held that if a patentee consented to the revocation of its patent, it was not appropriate for it to be compelled to state the grounds on which it had agreed to revocation.

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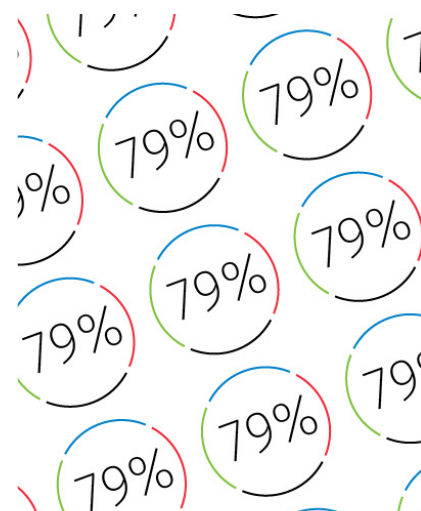
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This entry was posted on Friday, April 26th, 2024 at 10:32 am and is filed under [G 1/93](#), [OJ 1994, 541](#)) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*“>Amendments, [Patents](#), [Procedure](#), [United Kingdom](#)

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