



SCHRÖDINGER'S SEED DRILL

A CONSIDERATION OF THE RECENT CASES INVOLVING PRIOR USE IN PATENT LAW

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INTRODUCTION

Dr. Erwin Schrödinger's "thought experiment" was that if a cat was placed in a box with a single radioactive atom, which had the capacity to kill it, then until the box was opened, it was conjecture as to whether the cat was alive or dead, and as such, it was, in a sense, in both of those states. It was not until it was observed that its status was ascertained.

On similar lines, it was in June 1883 that the magazine *The Chautauquan* posed the question, "If a tree were to fall on an island where there were no human beings, would there be any sound?" The proposition was reworded slightly more elegantly in the 1910 book "*Physics*" by Mann and Twiss, who wrote, "When a tree falls in a lonely forest, and no animal is nearby to hear it, does it make a sound?" Their answer was "no" because, they say, a sound does not become a sound until it is recognised by the auditory organs of a being which register the vibration caused by the falling tree.

Finally, it was Einstein who reputedly asked, "Do you really believe that the moon only exists if you look at it?"

WHAT AMOUNTS TO DISCLOSURE?

In the recent cases of *Mishan v Hozelock*¹ and *Claydon v Mzuri*², the courts of England and Wales have considered in some depth the question of what amounts to disclosure for the purposes of prior use, anticipation or obviousness arguments. The judges have turned it into an exercise in thought experimentation, in an increasingly hypothetical environment. This article attempts to navigate through the reasoning.

In so far as it is possible to extract any kind of principle of general application from the combined works of Nugee J and HHJ Hacon, in the *Hozelock* and *Claydon* cases respectively, it is something like this.

If a member of the public, acting lawfully and not infringing any property right or duty of confidentiality, could have witnessed or had access to a disclosure which, to the eyes of the skilled person, would have disclosed the invention sufficiently clearly to constitute either anticipation or obviousness, then it does not matter that no member of the public actually knew about or took up the opportunity – a disclosure has occurred which may result in the invalidity of a patent granted in relation to the disclosed invention. There is no requirement as to the duration of the disclosure: a fleeting glimpse might be enough.

There are various glosses relating to the availability of technology to enhance the observation of the disclosure, and the ability of the inventor (if it was indeed he or she who was making the disclosure) to stop the disclosure before proper observation had occurred.

However, it seems that the answer to the thought experiment is this. The disclosure exists whether it was observed by any human or not. That cat was either dead or alive – not both.

Is that right?

THE BACKGROUND LAW – PRE 1977

The *Hozelock* and *Claydon* cases were, of course, by no means the first decisions to grapple with this issue. Indeed, the origins of the concept of prior use go back as far as Section 6 of the Statute of Monopolies 1623³. In *Bristol-Myers Application*⁴, Lord Diplock, giving the leading judgment in the House of Lords, said:

"From earliest times it had been taken for granted that by that phrase – that was the phrase in the Statute of Monopolies, 'such manufacturers which others at the time of making such letters patents and grants shall not use' – it was intended to declare unlawful the grant of any patent which would put it into the power

of the grantee to prevent any trader from doing whatever he had done before in the course of his trade"

Lord Diplock went on to elaborate, saying that it was not just prior use by a third party which would invalidate a patent:

"If the inventor, after discovering how to make it, had himself dealt with the substance commercially before applying for a patent for it, he would be disqualified from obtaining a grant; but this was not because of any prior use of it by others, but for the different reason that the invention having been put to him by "public use" was no longer a manner of new manufacture within the meaning of the Statute of Monopolies."

Lord Diplock's use of the expression "public use" is noteworthy in itself. In the *Bristol-Myers* case, the underlying law was by then the Patents Act 1949. Section 14(1) (d) described one of the grounds of opposition to the grant of a patent as:

"that the invention, so far as claimed in any claim of the complete specification was used in the United Kingdom before the priority date of that claim".

When the *Bristol-Myers* case had been before the Court of Appeal⁵, the Master of the Rolls, Lord Denning, was very clear on the meaning of Section 14(1) (d). He said:

"Section 14(1) (d) of the 1949 Act says that any person interested may oppose the grant of a patent on the ground that the invention, so far as claimed in any claim of the complete specification, was used in the United Kingdom before the priority date of that claim. The statute does not define what is meant by "used". But one thing is quite clear. The statute does not say "publicly used", nor "used in a public manner". Nor does it say "knowingly used" or "intentionally used". I see no reason whatsoever for introducing any of those glosses into the statute."

In the House of Lords, as we have seen, Lord Diplock did indeed use the expression "public use", and that apparent divergence of views was addressed by Lord Justice Lawton in *Wheatley's Application*⁶. Addressing an argument that Lord Diplock's construction of "used"

as "publicly used" over-ruled Lord Denning's very clear statement, Lawton LJ said:

"Because of the subject matter of the Bristol-Myers case and Lord Diplock's well-known approach to statutory construction, I doubt whether he intended to put a gloss on a statutory word like "used". In that case the issue was not whether the product had been used – that was never in issue – but whether the use had been accidental or secret. The discussion about "public use" was in contrast to "secret use"."

It went further than that. Not only was it the case that any "use", public or otherwise, could constitute prior use for the purpose of invalidating the patent, but the disclosure of the "use" did not need to be enabling, to use current parlance.

In the House of Lords' decision in *Bristol-Myers*, Lord Cross, who agreed with Lord Diplock on the "use" construction, said:

".....and it is, to my mind, more satisfactory to hold that if a man by selling the article in question puts it out of his power to prevent a purchaser from discovering, if and when he can, the presence in it of the substance in question he has made a "non-secret" use of the substance whatever be his own state of mind and whether or not analysis is, in the existing state of knowledge, possible".

So as at the eve of the coming into force of the Patents Act 1977, the law was very clear. Any prior use by the patentee, regardless of whether it was public or if it actually disclosed the inventive concept in an enabling manner, constituted grounds for revocation of the patent in suit.

THE BACKGROUND LAW – POST 1977

The effect of the 1977 Act⁷ was to wipe the slate clean as far as previous principles relating to prior use were concerned. It stated that an invention shall be taken to be new if it does not form part of the 'state of the art'. The state of the art in the case of an invention 'shall be taken to comprise all matter...which has at any time before the priority date of that invention been made available to the public...by written or oral description, by use or in any other way'.

¹ *E.Mishan & Sons Inc v Hozelock Limited & Ors* [2019] EWHC 991 (Pat)

² *Claydon Yield-O-Meter Limited v Mzuri Limited & Anr* [2021] EWHC 1007 (Pat)

³ Provided alsoe That any Declaracion before mencioned shall not extend to any tres Patents and Graunt of Privilege for the tearme of fowerteene yeares or under, hereafter to be made of the sole working or makeinge of any manner of new Manufactures within this Realme, to the true and first Inventor and Inventors of such Manufactures, which others at the tyme of makeinge such tres Patents and Graunts shall not use, soe as alsoe they be not contrary to the Lawe nor mischievous to the State, by raisinge prices of Commodities at home, or hurt of Trade, or generallie inconvenient; the said fourteene yeares to be from the date of the first tres Patents or Grant of such priviledge hereafter to be made, but that the same shall be of such force as they should be if this Act had never byn made, and of none other.

⁴ *Bristol-Myers Company (Johnson's) Application* [1975] RPC 127

⁵ [1973] RPC 157

⁶ *Wheatley's Application* [1985] RPC 91 – the case post-dated the 1977 Patents Act, but involved facts which predated the coming into force of the Act.

⁷ Patents Act 1977 section 2 (1) and section 2 (2)

It is worth noting here, and will arise again later, that the wording of the 1977 Act is not consistent with the wording of the European Patent Convention, which it was intended to enact. EPC Article 54(2) states:

"The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application."

The key addition to the 1977 Act is the inclusion of the phrase "has at any time". This could have significance in relation to the question of disclosure. Section 2 of the 1977 Act is one of the provisions stated in s.130(7) to be framed as to have, as nearly as practicable, the same effects in the UK as the corresponding provision of the EPC. In *Yeda v Rhone-Poulenc*⁸ the Court of Appeal held that s.130(7) meant that another of the provisions referred to (s.37(5)) had to be read in the same way as the corresponding provision of the relevant convention.

Following the 1977 Act coming into force, the first case of any note on the topic was *Lux v Pike*⁹, a decision of Aldous J in the Patents Court.

The judge opened his consideration of the law in this area with the following points:

"It is settled law that to invalidate a patent a disclosure has to be what has been called an enabling disclosure. That is to say the disclosure has to be such as to enable the public to make or obtain the invention."

Further:

"...it is settled law that there is no need to prove that anybody actually saw the disclosure provided that relevant disclosure was in public. Thus an anticipating description in a book will invalidate a patent if the book is on a shelf of a library open to the public, whether or not anybody read the book and whether or not it was situated in a dark and dusty corner of the library. If the book is available to the public, then the public have the right to make and use the information in the book without hindrance from a monopoly granted by the State."

Aldous J then summarised the change represented by the 1977 Act succinctly:

"Prior to the 1977 Act, patents were invalidated by prior use of an invention which included use in secret and use which did not involve disclosure of the details of the invention to the public. Thus agreement to sell a product before applying for a patent invalidated a subsequent patent covering that product because the inventor was using the invention to reap benefits and thereby prolonging his statutory monopoly. That was one of the vices the Statute of Monopolies 1623 was intended to prevent. The 1977 Act changed the law. Patents are now only invalidated if prior to application, the invention formed part of the state of the art which comprises all matter which has been made available to the public anywhere in the world, by inter alia use or any other way."

Aldous J twice referred to "settled law". The *Lux* case was the first in this area after the coming into force of the 1977 Act, so this would seem to be settled law under the 1949 Act, but is it right to say that it is settled law under the new regime?

Section 14(1) (d) of the 1949 Act applied where the invention was used, whereas s.2 of the 1977 Act applies where the invention is *made available to the public* in some way, for example by use. Upon the language of section 2, use of the invention (alone) is not enough. Does the fact that a disclosure takes place in public necessarily mean that the information 'disclosed' is thereby made available to the public? In the case of an inventor who, before filing their patent application, reads it into the wind in the middle of an isolated moor - arguably not. In which case Aldous J's statement - that it was settled law that there is no need to prove that anybody actually saw the disclosure provided that relevant disclosure was in public - would be conflating the tests applicable under s.14(1) (d) of the 1949 Act and s.2 of the 1977 Act. This reasoning would appear to be a hangover from 1949 Act reasoning, importing the legal fiction of library shelf disclosure into 'made available to the public by prior use' disclosure. But is this consistent with article 54(2) and does it set the judicial consideration of the new law off on the wrong track right from the start?

In considering the facts of the *Lux* case, Aldous J had no English authority upon which to call for support. He turned to the decisions of the European Patent Office as the 1977 Act was designed to cement the provisions of the European Patent Convention into English law.

He considered three cases, *Luchtenberg*¹⁰, *Telemecanique*¹¹, and *Union Carbide*¹². Of these, it is the Union Carbide case which is perhaps the most significant to the recent cases before the courts of England and Wales. The invention was a form of vaporiser, and whilst it was clear that no product featuring the patented invention had been sold, it was submitted in evidence that they could be seen over a fence. The Board concluded that whilst there might be circumstances where such a disclosure could have invalidated the patent, on the facts of this case it did not, as such observation would not have disclosed the features of the invention to the skilled person clearly and unambiguously.

Following his consideration of these cases, Aldous J concluded:

"There is a difference between circumstances where the public have an article in their possession to handle, measure and test and where they can only look at it. What is made available to the public will often differ in those circumstances. In the latter case it could be nothing material; whereas in the former the public would have had the opportunity of a complete examination."

He went further in describing the task of the court confronted with a case of alleged prior disclosure, saying:

"In the case of a written description, what is made available to the public is the description and it is irrelevant whether it is read. In the case of a machine it is that machine which is made available and it is irrelevant whether it is operated in public. A machine, like a book, can be examined and the information gleaned can be written down. Thus what is made available to the public by a machine.....is that which the skilled man would, if asked to describe its construction and operation, write down having carried out an appropriate test or examination. To invalidate the patent, the description that such a man would write down must be a clear and unambiguous description of the invention claimed."

I would argue that this actually sets the bar quite high. Nevertheless, identifying the legal test applied by Aldous J is not entirely straight forward. He agreed, though, with *Lux* (the patentee) that the correct test was: What is made available to the public?

The prototype traffic lights in the *Lux* case were made available to contractors on a number of occasions over the course of five months and used on "commercial jobs". Aldous J's reasoning does not suggest that it was in issue between the parties whether the use was in public - the judge's reasoning appears to have proceeded on the basis that it was. Certainly it may be implied from Aldous J's judgment, and it has been said in subsequent judgments, that the use in question was on public roads. The question for Aldous J was therefore whether the use amounted to an enabling disclosure.

Lux submitted that the correct approach was to decide what the interested skilled man would have seen and thereafter decide whether the events observed gave a clear disclosure of the claimed invention. Pike submitted that it was sufficient if a contractor operating a site could test the equipment, and upon such a test the claimed invention would be made available to it.

The judge found that the contractors (i.e. who used the prototype) were free in law and equity to examine it, but would not have had access to the control panel. There were aspects of the operation of the machine which could not be ascertained from an external inspection.

But when considering what could be observed when the lights were in use, the judge slipped his reasoning to what was made available to the (hypothetical) "skilled person". He said:

"If a skilled man had taken the time to test the way the lights worked, using the prototype controller, he would have seen that the system used standard lights and standard detectors. The detectors had at their back a light which was normally lit, but which went out when a demand was registered. He would also have appreciated that the system worked in a standard manner, except that in circumstances equivalent to those encountered when a vehicle stalled or red runners took place, the green period was longer. He would see that the vehicle had been detected as the light behind the detector would have gone out. He would also see

⁸ *Yeda Research and Development Company Limited v Rhone-Poulenc Rorer Internatinal Holdings Inc and others* [2007] UKHL 43

⁹ *Lux Traffic Controls Limited v Pike Signals Limited* [1993] RPC 107

¹⁰ T 84/83 1979-85 EPOR 796

¹¹ T 482/89

¹² T 245/88 1991 EPOR 373

that the vehicle detected had not moved off. In essence, he would have understood that an extended green period was provided. He must, I believe, conclude that the extended green period was a consequence of the controller recording the demand from the vehicle and not receiving a signal of any vehicle movement thereafter."

Aldous J concluded that such an examination would be sufficient to disclose the invention of claim 1, and so the patent was found to be invalid.

Lux v Pike is therefore a case in which it was not disputed that the use in issue was public, but rather the reasoning addressed whether the matter made available by that use amounted to an enabling disclosure.

In *Merrell Dow v Norton*¹³, in the context of a prior use challenge, Lord Hoffmann noted that article 54 EPC made clear that:

"... to be part of the state of the art, the invention must have been made available to the public. An invention is a piece of information. Making matter available to the public within the meaning of section 2(2) therefore requires the communication of information. The use of a product makes the invention part of the state of the art only so far as that use makes available the necessary information."

The prior use challenge in the *Merrell Dow* case was about volunteers being given terfenadine capsules for the sole purpose of swallowing them, without knowing their composition or that of the acid metabolite then produced within their bodies. It was said not to be at the forefront of the arguments about anticipation in the case, and was dismissed without detailed reasoning by the House of Lords. However, the requirement that disclosure requires "the necessary information" to be "made available" is noteworthy.

The need for the actual disclosure to be enabling was re-iterated in the somewhat light-hearted judgment of Michael Fysh QC, sitting as a deputy judge, in *McGhan v Nagor*¹⁴. The case concerned technology involved in the manufacture of silicone breast implants. There was evidence that visitors to the factory where the items were made were shown the products and rejects were frequently taken home by staff

from the factory and given to and discussed with their friends. The judge commented:

"I was puzzled.....as to why breast implants should have become quite such recherché objects in Roseville, Minnesota".

Concluding that having and holding the objects in question and having the manufacturing process described did not amount to an enabling disclosure of the claimed manufacturing process, the judge said:

"It is in my judgment in the highest degree improbable that the ordinary folk in Roseville, Minnesota, on being handed a breast implant by {the witness} as a present for use as a paperweight, would be remotely interested in the details of the process by which it was manufactured."

A few years later, the judgment of another Deputy Judge, Peter Prescott QC, in *Folding Attic Stairs v Loft Stairs*¹⁵, is interesting for the distinction drawn between information made available to the public at large and information made available to specific individuals without restriction as to their onward use of it.

In this case, before realising the novel aspects and benefits of a new design of loft ladder, the manufacturer sought to publicise the product by inviting a politician, the Irish Minister for Trade and Tourism, and a photographer from The Irish Times newspaper to see the product in action. The event was duly reported in the press, with several photographs, before a subsequent patent application was made.

The judge was faced with two arguments of alleged disclosure. First, based on the photographs, which were widely published in the newspaper. Secondly, based on the disclosure of the prototype itself to the Minister and the photographer.

In relation to the photographs, the judge considered what had been made available by their publication to the person skilled in the art. He decided, as a matter of fact, that a relevant aspect of the claimed invention – the varying width of the inner and outer frames – would not have been discerned. The invalidity case based on the photographs therefore failed.

In relation to the disclosure of the prototype to the Minister and the photographer, the judge considered the law clear that, inasmuch as the public had a right to be there, they were deemed to have had the right to access the information – citing the *Lux* case as authority.

However, on the facts of the *Folding Attic Stairs* case, the prototype had not been made available in a public place: it had only been made available for viewing by the Minister and the photographer. The legal position in respect of the disclosure of the prototype was therefore distinct from that in respect of the published photographs and the use of the prototype on public roads in Lux.

Drawing upon the text of article 54 EPC, which refers to anything that has been 'made available to the public' in any way, the judge said:

"...it seems to me that if information that is available for viewing on private premises by a small and defined class of visitors is to become part of the state of the art, otherwise than by a legal fiction, that information must be actually imparted to at least one human mind which is free in law to divulge it to anyone else as he pleases. It should not be enough that [it] could have been imparted, but was not."

... there is no irrebuttable presumption of law that information that is capable of being perceived by persons who are on private premises is in fact perceived by them, if the circumstances are such as to make it unlikely that those persons were interested in the subject-matter. For that would be to invent a legal fiction without necessity."

No terms of confidentiality had been imposed, so in law the Minister and the photographer were free to impart to others whatever they did perceive and were able to recall. But what did they perceive? They were not persons skilled in the art. There was no evidence that the photographer or the Minister did in fact inspect the prototype in any detailed sort of way and the judge thought it unlikely they would have had any interest or motivation to do so. This was despite the fact that the photographer could have gazed at parts of the prototype as much as he wanted to. The judge observed:

"So, for that matter, might the minister, although I believe that he was in the main part of the factory at the time, chatting to the employees – they were potential voters."

However, the judge concluded that on balance they would not, at the end of their visit, have been able to describe the key features of the claimed invention. He said:

"On the balance of probabilities I would infer that if some officious person had stopped them on the way out and asked them to describe the test unit, it is unlikely that they would have been able to describe the presence of the inner frame with side beams spaced from the sides of the ladder. I say that because there is no reason why a normal human being, not being interested in the manufacture of folding ladders, could care less."

Therefore the invalidity case based on the disclosure of the prototype to the Minister and the photographer failed too.

The *Folding Attic Stairs* case therefore suggests that if the use in issue was not in public, but merely to individuals who were free in law and equity to use the matter thereby made available, what exactly was made available depends upon the identity and perceptions of the individuals to whom the matter was disclosed.

The reference to the ability of the two witnesses to the demonstration to be able to describe the invention is very much in line with Aldous J's requirement that the skilled person be able to write down what they had seen in a way which would amount to enabling disclosure of the invention.

In seeking to clarify the boundaries of the issue of prior disclosure Peter Prescott QC said:

"The law must draw the line somewhere, as I have said, and it does so by adopting the rule that inasmuch as the public had the right to be there, they are deemed to have the right to access the information. In the same way, if it is proven that all sorts of members of the public could enter private factory premises, no obligation as to confidentiality being imposed, the law will consider that whatever could be seen there has become part of the state of

¹³ *Merrell Dow Pharmaceuticals Inc & Anr v H. N. Norton & Co Ltd* [1996] RPC 76 at 86 per Lord Hoffman

¹⁴ *McGhan Medical UK Limited v Nagor and another* [2001] EWHC Patents 452

¹⁵ *Folding Attic Stairs Limited v Loft Stairs Co Limited and another* [2009] EWHC 1221 (Pat)

the art. In those circumstances the law cannot start speculating about who did or did not see a thing."

This reasoning would seem consistent with Aldous J's statement in *Lux* that it was settled law that there was no need to prove that anybody actually saw the disclosure provided that the relevant disclosure was in public. Indeed, earlier in that paragraph the Deputy Judge drew upon Aldous J's reasoning in *Lux*. But again, it does not address the legal test of s.2 of the 1977 Act: this being whether the *invention was made available to the public*. As Lord Hoffmann noted in *Merrell Dow*, the invention is information, and making it available to the public therefore requires communication. The state of the art, as defined in s.2(2) is not described as comprising matter used in a publicly accessible space (which could, of course, be isolated), but as comprising matter *made available to the public*.

The subsequent judgment of Henry Carr J in *Fujiflim Kyowa Kirin Biologics v Samsung Bioepsis*¹⁶ would seem consistent with the approach taken by Peter Prescott QC in respect of the disclosure of the prototype loft stairs to the Minister and the photographer. Anticipatory prior uses were found to have occurred by the use of a medicament for the treatment of two patients' chronic plaque psoriasis, coupled with the disclosure to the patients of the treatment regime used.

The next significant case in this area was *E. Mishan v Hozelock*¹⁷, decided at first instance by Nugee J. This case involved tests of an expanding water hose carried out by the inventor in the back and side gardens of his home in a quiet cul-de-sac. The cul-de-sac was a road open to the public.

The judge opened his consideration of the law with the statutory provisions, from which it followed that the relevant question was whether matter had been made available to the public by use. The use itself must make the necessary information available to the public. The information need not be widely disseminated. If it is actually communicated to a single person who is free in law and equity to use it that suffices (*Bristol-Myers*). And for a product to be made available it is sufficient if it is available to be examined. Nugee J re-iterated Aldous J's statement in *Lux* that:

"It is settled law that there is no need to prove that anybody saw this disclosure provided the relevant disclosure was in public."

Nugee J agreed with the patentee (E. Mishan) that the onus was on the person seeking to invalidate the patent to establish that the notional recipients of the information would have been free in law and equity to use the information they saw. However, he acknowledged that the under English law (which he assumed was the same as the law in Florida where the use in issue took place), information is not confidential unless there is some particular reason to treat it as such. The mere fact that something is done on private property does not necessarily mean it is confidential if it is in full view of a public street.

Having reviewed some earlier authorities (including *Lux*), the judge said that they illustrated that:

"...it is not necessary to prove that anyone has in fact examined the article, or instructed an expert to do so, or would have had any reason to do so. An article that can be examined by a member of the public without any obligation of confidence is made available to the public and amounts to a disclosure of the information that could be obtained by such an examination, and it does not matter that no such examination in fact took place, just as it does not matter that a publication in a library is not in fact read."

I would just highlight the use of the words "examined" and "examination". I will return to their relevance later.

The judge then sought to differentiate types of disclosure. He asserted that it was one thing to say that the public is given access to information if that information is made available to the public: then it does not matter that no member of the public in fact took up the opportunity. It is quite another thing to say that the law treats the information as available to the public when no member of the public could in fact have accessed it.

In the case before him, Nugee J was taken with the inventor's statement that, if he had observed a bystander watching, he would have taken the prototype out of sight. Accepting this, the judge said:

"If anyone had tried to observe him [the inventor] they would not have seen anything because he would have packed everything up. In other words, although any member of the public could have turned up at Skylark Point and stopped to look, had anyone done so, whether a skilled person or anyone else, he would not have been given access to any information."

As a result, the information in issue was not "made available to the public". The invalidity attack based upon the inventor's prior use in his garden therefore failed. For good measure, the judge also found that (had the use in issue made matter available to the public) the information gleaned by the skilled observer on any single day would not have invalidated the patent.

Therefore the *E. Mishan v Hozelock* case was one where it was in issue between the parties both whether the use had made matter available to the public, and if so what matter had been made available.

To Nugee J, the disclosure in this case was well away from the idea of a book in a dusty corner of a library.

This does not address the position had the inventor been so engrossed in his work that he had not actually seen an observer, who, as they would have been fully entitled to do, took still or video photographs of the experiment. Even if the inventor then observed the bystander, the cat would have been out of the bag.

Counsel drew an analogy with an inventor talking out loud in an empty place. The judge's response to this illustrates just how tangled things become when getting into hypothetical examples:

"I do not need to decide the point but on the view I take it would all depend on what he was actually doing. It is quite difficult to think of plausible scenarios where this might actually happen in the real world, but if, for example, the inventor advertised a public lecture and, even though no one came, proceeded to give it so it could be recorded for his own purposes, that would, on the view I take be an oral disclosure that was accessible, and hence made available to the public, and it would not matter that no-one in fact turned up. But that would be very different from the inventor talking out loud to himself while taking a walk along a deserted but public footpath over the moors. If in the latter case he would have stopped talking

as soon as any member of the public was close enough to hear, I do not think he would have made anything available to the public."

I find that distinction incomprehensible, for exactly the same reason that I question the reasoning over the disclosure in the inventor's front garden. This is halfway between an analysis of fact and a thought experiment worthy of Dr Schrödinger. What if a member of the public who happened to be skilled in the relevant field was walking just behind the inventor on the footpath over the moors? The core of the invention might have been disclosed before the inventor became aware of the following walker.

Another distinction drawn by the judge related to the possibility that the disclosure may have been different if the tests were observed on different days and that maybe a mosaic of disclosures would have given rise to enabling disclosure. We all know that in the context of obviousness the law in the UK sets its mind fairly and squarely against the concept of mosaicking different items of prior art, but is that also true of "disclosure in stages" in the context of a single series of tests? Nugee J found that it was not permissible to mosaic the information disclosed on different days, but went on to say that if he was wrong about that, the disclosure was such that he "would have accepted that the invention disclosed in the patents would have been obvious".

Nugee J left the door open for a higher court to look at the point, but when the case went to the Court of Appeal, the failed prior use challenge was not the subject of the appeal, which focused on a finding of obviousness in light of prior art.

The imaginative hypothetical distinctions drawn in the case law are dangerously semantic. Their tangles could be avoided if the test applied was (and the onus was on the person seeking to invalidate the patent to establish) that the relevant information had in fact been made available to at least someone. (More on this below). The position does not get any better when we approach the most recent decision in this area.

CLAYDON V MZURI

It is unusual these days for the out of favour Lord Denning to get one mention in an article, let alone two, but he was, of course, well known

¹⁶ *Fujiflim Kyowa Kirin Biologics Company Limited v Samsung Bioepsis UK Limited & Anr* [2017] EWHC 395 (Pat)

¹⁷ *E. Mishan & Sons Inc v Hozelock Limited* [2019] EWHC 991 (Pat)

¹⁸ *Hinz v Berry* [1970] EWCA Civ J0116-3

¹⁹ *Claydon Yield-O-Meter Limited v Mzuri Limited & Anr* [2021] EWHC 1007 (IPEC)

for his slightly whimsical style. He famously opened his judgment in a case¹⁸ involving a fatal road accident with the lines:

"It happened on 19th April 1964. It was bluebell time in Kent."

His Honour Judge Hacon must have looked to emulate his famous forbear when he opened his judgment in the *Claydon v Mzuri*¹⁹ case in the Intellectual Property Enterprise Court with the line:

"In 1701 Jethro Tull invented a seed drill, a mechanical device for sowing seeds with relative precision."

The patent in suit in *Claydon v Mzuri* related to an improved form of seed drill. The specification stated:

"The invention provides a seed drill and method which is different from anything currently available as it can direct drill or be used as a conventional drill over a wide set of soil conditions."

The technology giving rise to this advantage comprised two rows of tines, one behind the other in terms of the direction of movement of the apparatus, so that the soil was only disturbed in the lines along which the tines were placed, and the soil between the lines was undisturbed, helping to avoid the germination of weed seeds in that space. The full apparatus constituted a fairly large item of farm machinery.

The technique was known as "strip tillage" and there was a significant discussion in the case as to the extent to which any aspect of the technique represented common general knowledge.

However, for the purposes of this discussion, I want to concentrate on the alleged prior use giving rise to disclosure of the inventive concept. As indicated, the complete apparatus represented a substantial piece of machinery. Testing would obviously need to be done outdoors on farmland, and that is indeed what happened.

It was not in dispute that, before the priority date of the patent in suit, Claydon tested a prototype, featuring the inventive concept. It was tested in a field near their farm workshop for a total of ten hours over two days, including driving the machine to and from the workshop.

Mzuri alleged that the field was visible from nearby roads and from a footpath to which the public had access. The footpath was unmarked and unmaintained, and there was a hedge between the footpath and the field where the testing took place. The hedge was six foot tall but had gaps at three points. It was also not in dispute that there was never anyone present at the tests other than Mr Claydon and his brother.

A solicitor visited the footpath and took photographs showing that the field was visible from parts of the path, though Mr Claydon argued that the path was very little used in 2002 when the tests took place.

However, at least by trial, whether the use made matter available to the public does not appear to have been in issue between the parties. Claydon apparently accepted that the use was in public. This is because the judge stated that the live issues were: first, whether the hypothetical observer could have seen the alignment of the tines; and second, whether they could have seen strips of undisturbed soil, and if so, what would have been deduced from those strips regarding the alignment of the tines.

As such the issues for determination in the *Claydon* case are perhaps better aligned with those before the court in *Lux v Pike* than in the *Folding Attic Stairs* and *Hozelock* cases. HHJ Hacon, considered what information had been made available by the Claydons' use to the (hypothetical) skilled person. Because of the point which had arisen in the *Hozelock* case concerning the ability of the inventor to pack up his kit and move away if he saw someone watching the test, a rather artificial theory arose in the *Claydon* case as to whether it would have been possible to remove the prototype seed drill from public view if an observer had been spotted. The evidence was, perhaps not surprisingly, less than clear, but the judge concluded:

"I also note that preventing a member of the public from seeing a prototype seed drill would have been a good deal more difficult than hiding a prototype garden hose in the circumstances of Mishan."

In his witness statement, Mr Claydon said that he had had experience of patents before the prototype was tested and had learned the hard way that public prior disclosure of his invention would negatively affect his ability to patent it. It was therefore in his mind that he

would prevent anyone who happened to be nearby from seeing the prototype. He was in a tractor cab and from that vantage point could see anyone in the vicinity before they could see what was happening in the field. He discussed what to do with his brother, who was present, before the tests began. If anyone had been seen they would have moved away so that this other person would not be close enough to see any relevant detail of the prototype.

Mzuri's expert, Mr Wright, said that at a particular point, when it reached a headland, the tractor would have slowed or even stopped and the prototype would have been lifted well clear of the ground for between 15 and 40 seconds. Since the hypothetical observer was deemed to be a person skilled in the art, Mr Wright postulated that it would have been possible at that time to see the two rows of tines and to understand that one row was cultivating tines and the second was seeding tines and that they were in line. That latter observation would result from seeing the field and noticing the strips of undisturbed soil between the lines of disturbed soil where the seeds had been sown.

Claydon's expert, Dr Scarlett, said that the precise alignment would not have easily been observed and that the undisturbed soil could equally have been the result of the combined passage of the seed drill and the press wheels. To know exactly what was happening, he said, the hypothetical observer would have had to enter the field and scrape the surface of the soil. That, of course, would have been an unlawful act of trespass.

In cross-examination Dr Scarlett appeared to concede that the skilled person might have been able to observe two strips, one disturbed where the seeds had been sown and one undisturbed. He reiterated, however that the precise alignment of the tines was not observable from a distance, nor to be gleaned from an observation of the soil.

The judge noted that "precise alignment" was not a requirement of the claims of the patent: it was sufficient (for the purposes of the claims) that the tines were aligned enough for the seeds to fall below the lifted disturbed soil. On balance he concluded that an observer of the prototype being tested would have believed the tines in the first and second rows were aligned:

"There were periods, possibly many, during which it was likely that a skilled person, standing on a footpath at the point where [the witness] took his photographs, would have been able to see the prototype in action and been able to deduce from its appearance and from the appearance of the soil left in its wake, features of construction of the prototype including all the features of claim 16. If Mr Claydon or his brother had noticed such a person, I do not believe that Mr Claydon could have taken action that would have prevented the skilled person from seeing or inferring each of those features, including the alignment of the tines."

The judge concluded that, in law, the prototype was made available to the public, so the patent lacked novelty because of the prior use and was invalid. However the last sentence of the reasoning quoted above is perhaps more relevant to the question of whether the Claydons' use of the prototype made information available to the public. It is one example of many in the case law where a judge's reasoning strays to commentary on aspects of the law that are not strictly relevant to the determination of the issues in the case, yet provide later judges with commentary on hypothetical scenarios without reference to the actual issue for the court (or the legislative parameters).

In the course of the arguments, the issue had arisen as to whether the hypothetical observer might have had the assistance of a camera, including possibly a camera with a zoom lens. Possibly seeing the pitfalls in pursuing this line too far, the judge concluded that, on the evidence, in this case reliance had to be made on what could be seen with the naked eye, but not before he had observed:

"It seems to me that there is no absolute bar in law to the enablement of an invention by reason of the hypothetical skilled person having gained an understanding of it with the assistance of technical equipment."

He went on to say that if there was evidence that the skilled person habitually carried a phone with a zoom lens, then it may be that a case could go forward on the basis that the information made available included information obtained using such a phone. However, he noted, the same could not often be said of the possibility

that the skilled person could have had a fleet of drones to hand and even if he did, drone photography might give rise to privacy issues.

AND SO...

I mention those last points because they illustrate the absurdity of the position we have reached. Who is to say that the hypothetical skilled observer outside Skylark Point did not have a phone with a powerful zoom lens and was able to take a series of pictures of the prototype hose before the inventor was able to conceal it? What if the hypothetical person walking behind the mad inventor reciting details of his invention on a walk over the moors had a phone with a powerful recording device so they did not even need to remember what they heard? Will we need evidence to support the phone carrying habits of experts in different fields, and the range of recording scope?

I highlighted above the use of the words "examine" and "examination". It was clearly in the minds of previous judges that there had to be some degree of real examination possible. In *Lux*, there was such an opportunity. In *Folding Attic Stairs* there was not. In *McGhan* the ability to examine was there, but it would have yielded no relevant information. In *Union Carbide* the ability to see the disclosure was over a wall and did not give rise to the ability to examine.

There is, in my view, a world of difference between a book sitting in a dusty corner of a library, and a fleeting instance of disclosure in a field alongside an overgrown and unused footpath. What if the best view had been from the road, but that although there were no parking restrictions, it would have been dangerous to pause as it might have caused an obstruction? Would that amount to making available to the public? Does anyone carry binoculars these days? What if the hypothetical skilled person had a hobby of bird-watching and habitually carried binoculars? How closely might someone have examined the press photographs of the folding stairs? Could they have been digitally enhanced by the skilled person to reveal the inventive concept? What steps could Mr Claydon have reasonably taken? He had to test his new apparatus. There are few fields in England not flanked by either a road or a footpath, and none that

would be inaccessible to a drone. What if he did not own such a field? What was he supposed to do? He could not shut a public footpath.

Are the judges taking the additional wording in the 1977 Act – "at any time" and somehow construing that as meaning "at any moment in time" irrespective of whether any information, or the existence of any information, was communicated to anyone? We know that the skilled person is blessed with compendious knowledge and language skills, but are they also supposed to have the ability to see and digest information after a fleeting glimpse?

The recent cases have operated in a way amounting to *reductio ad absurdum*, taking increasingly unlikely scenarios and drawing conclusions and lines on flimsy evidence and purely hypothetical circumstances. The law of patents has, of course, never been afraid to embrace the hypothetical, as the very existence of the concept of the "person skilled in the art" demonstrates, but in respect of prior disclosure, it has gone too far. In the end what we have is one hypothetical postulation after another, piled on top of each other to create an unreal world which operates unfairly against the interests of patent owners.

As Peter Prescott QC said in *Folding Attic Stairs*, the law must draw a line somewhere. In my view, the line should be drawn at the point of the ability, in fact, to examine. The partly hidden library book, once found, can be read at leisure – even if translation is needed; time is not of the essence. Further, a written publication has been deliberately put in the public domain. As I have already noted above, in *Lux* Aldous J observed that:

"There is a difference between circumstances where the public have an article in their possession to handle, measure and test and where they can only look at it. What is made available to the public will often differ in those circumstances."

Returning to the judgment of Aldous J in *Lux*, he said:

"Thus what is made available to the public by a machine.....is that which the skilled man would, if asked to describe its construction and operation, write down having carried out an appropriate test or examination."

If the legal test applied was (and the onus was on the person seeking to invalidate the patent to establish) that the relevant information had in fact been *made available* to someone (free in law and equity etc.) the inconsistencies between unlikely hypothetical scenarios could be ironed out. For example, consider a draft patent application, the day before it is planned to be filed:

- The invention described would not be made available to the public if the draft was printed off and left, loose-leaf, on a windy afternoon on a small island in the middle of the River Thames, to gradually blow into the water and be eaten by ducks, unless it was established that someone actually found it before that happened. The invention would, however, be made available to the public if the draft was catalogued and left on the shelves of a library accessible to individuals free in law and equity to absorb the contents of the written document – the act of cataloguing would make it available.
- The invention described would not be made available to the public if the inventor took the draft for a lonely walk across the moors, reading it allowed as he went, unless it was established that someone actually overheard enough of the monologue. The invention would, however, be made available to the public if the inventor published an announcement of a seminar/oral disclosure on the subject, and proceeded to read the application aloud at the designed time and place – if nobody turned up to listen, the announcement would still have made the oral disclosure available to the public; without the announcement making available would only be satisfied if someone had happened to turn up and listened.
- The invention described would not be made available to the public if the inventor used a prototype in the middle of a publicly accessible space (such as a field with a public footpath running along one edge) without in fact being observed by anyone and without prior announcement of his activity. The invention would, however, be made available to the public if he had first announced in a local newspaper his intention to do so and invited observers.

Each of these contrasting scenarios illustrates the sense in requiring at least the opportunity for "*an appropriate test or examination*" to take place, and reflects Lord Hoffman's view that for the disclosure of matter to invalidate a patent the "*necessary information*" must

be "*made available*", which requires communication. This a lot more than the hypothetical possibility that a skilled person, with or without a powerful phone or camera, might have been lucky enough to be in the right place at the right time to observe a short term test of a moving item, whether it is in a suburban garden in Florida or a field in Suffolk, England.

Requiring experts to opine on what they may or may not learn from a hypothetical opportunity to catch a quick look at a piece of apparatus does not only place too much of an evidential burden on litigants. It leaves the application of the law very uncertain and, in an age of drones, increasingly unlikely to support the upholding of an otherwise valid patent for an invention worthy of reward for its (later) disclosure.

Focusing on what has in fact been made available would also clear up an anomaly. Suppose the employee inventor took the first course in any of the three scenarios described above, and nobody happened to stumble across the papers/recitation/use. The employee would not have imparted information to anyone, so they would not be acting in breach of an obligation of confidence to their employer. But should there later be a falling out, as the law currently stands the inventor could give evidence of what happened, so invalidating the resulting patent owned by their employer.

The mess needs straightening out. To require an opportunity for reasonable examination, enabling information to actually be made available, does not do harm to the principles underlying the law. It creates a more "real world" environment for the establishment of any proper assessment of the extent of any prior disclosure and its impact on the validity of potentially very valuable rights. And it respects the "patent bargain".

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