


Worth the risk?

The case

 *Jerome Canady v Erbe Elektromedizin GmbH (1), Erbe Medical UK Limited (2), Keymed (Medical and Industrial Equipment) Limited (3) and Olympus Corporation (4)*
 E&W Patents Court
 21 December

Is it worth giving up an invalidity claim to limit a trial to infringement issues? **Alastair McCulloch, Jones Day**, reviews a recent case where two companies, on seeking a preliminary hearing, did just that

The patent in this case concerned an argon beam coagulator for use in combination with typical endoscopes. On 25 July 2005, Pumfrey J on an application by the third and fourth defendants ordered a separate trial on the issue of infringement. Trial on infringement (effectively as a preliminary issue as it would dispose of the dispute between the claimant and the third and fourth defendants) took place on 7 and 8 December 2005.

Pumfrey J made the order following two submissions by the third and fourth defendants. First, they considered that they had a compelling argument on non-infringement which (importantly) did not depend for its force on the prior art. Secondly, they made it clear that they did not want to conduct a full trial on validity if it could be avoided. Their non-infringement argument must have been compelling because they accepted a separate trial on the issue of infringement despite Pumfrey J ordering them to withdraw their allegations of invalidity. The withdrawal was softened though by the fact that validity remained in issue between the claimant and the first and second defendants.

A strategy for the brave

In terms of its general application, the procedure adopted by the third and fourth defendants and Pumfrey J's treatment of the proposal are interesting. As cases on infringement and validity are so often intertwined in patent actions, trials on infringement alone as a preliminary point are fairly rare in the UK. The simple arguments unrelated to validity put forward on non-infringement by the third and fourth defendants are an example of when this strategy can be utilised. Further, Pumfrey J's approach (even though it followed representations that they did not want to go through and incur the cost of a full validity trial) in making the third and fourth defendants withdraw their allegations of invalidity makes it a bold strategy if this condition of withdrawal is to be applied generally. Pumfrey J's comments on the role of expert evidence in what at face value is an infringement case about an ordinary English word are also noteworthy.

The alleged infringement was the sale of flexible probes for endoscopic applications of the argon plasma coagulation technique. At face value, the infringement issue was simple. The integer of claim 1 of the patent in suit which sparked the application and was the subject of the infringement case is:

"a handle (18) attached to said tube (10) adjacent the proximal end (14) of the tube (1) for manoeuvring said tube..."

The allegedly infringing products, it was said, did not have a handle and thus did not infringe.

The claimant argued that they contained a part that was specifically formed to be grasped by the hand. The part included the provision of indents shaped to facilitate the grip of the thumb and first finger. Further, the provision of such indents was an adaptation of the handle to allow the surgeon to control the movement of the device more accurately. The contrary argument was simple: the claim requires a handle suitable for manoeuvring the tube and adapted to do so. The plastic part at the end of the allegedly infringing products was merely a connector plug, which was neither suitable for manoeuvring the tube nor adapted to do so. The issue therefore was: what did the claim mean when it referred to a "handle"?


This is where the need for expert evidence arises, even though the issue (the presence or absence of an apparently straightforward integer) would seem at first sight to be easily resolvable. Pumfrey J applied the principles of construction set out by Lord Hoffman in *Kirin Amgen v Hoechst Marion Roussel* [2005] RPC 9. The specification is construed through the eyes of the skilled addressee, so the identity of the skilled addressee must be established. All four experts in this case agreed that "handle" had no special meaning in the field and Pumfrey J proceeded to construe the integer

accordingly. He found no infringement. The claim for infringement was dismissed and the fourth defendant was granted a declaration of non-infringement for the probes described in its product description. In coming to his conclusion, Pumfrey J concentrated on what the handle was required to do in the context of the functional requirement that it be "[suitable] for manoeuvring [the] said tube...". He held that it must perform some function over and above merely connecting.

Cost effective

This case shows that an application for a separate trial on infringement as a preliminary issue can, if successful, be a cost effective and quick resolution. When contemplating such a course, it is important to consider the following factors:

- 1) Does the infringement case interact in any way with validity arguments?
- 2) If Pumfrey J's approach is to be followed, would you give up your validity attack to run the argument? There may not always be the comfort of two other defendants continuing with the application to revoke the patent.
- 3) Might the patent cause any difficulty in terms of product or process development in the future if the opportunity to knock it out is passed up?

If the answer to 1 and 2 is "yes" and to 3 is "no", it is an approach to consider as it can dispose of an infringement claim in a quick and cost effective way. There is after all nothing new to hearing infringement separately from validity – it is the standard approach in Germany. However, if the patent is not to be knocked out, the success will be limited to the products which are the subject of the action. Going forward, the patent could still remain an issue for product or process development. 

About the author

Alastair McCulloch (amcculloch@jonesday.com) is the partner in charge of the intellectual property group in Jones Day's London office. He is a specialist patent litigator.

