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Vernacare Limited v Moulded Fibre Products Limited [2022] EWHC 2197 (IPEC)

Background

The Claimant, Vernacare Limited (“Vernacare”), and the Defendant, Moulded Fibre Products Limited (“MFP”), both manufacture and sell washbowls, which are made from moulded paper pulp as used in hospitals, care homes and nursing homes. The Vernacare washbowl has enjoyed considerable commercial success.

In this action Vernacare, claims that its patents, GB 2446793 (the “793 Patent”) and GB 2439947 (the “947 Patent”) have been infringed.

The 793 Patent is concerned with the shape (or configuration) of washbowls whereas the 947 Patent is concerned with their composition. The products with which the patents are concerned are intended to be used once and then disposed of in a macerator. The patents were both filed on 31 July 2006.

In the case of the 793 Patent, MFP denies that the MFP washbowl falls within the claims of the 793 Patent and it also asserts that the 793 Patent is invalid.

In the case of the 947 Patent, at trial, MFP accepts that its washbowl falls within claims 1, 3, 9 and 12. Its defence is that the 947 Patent is invalid.

The Witnesses

Each party called four witnesses, two experts (one each for the 793 Patent and 947 Patent) and two fact witnesses who gave evidence in relation to long felt want and

commercial success.

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The Technical Background

The moulded paper pulp sector is a branch of the wider paper and paper board industry. Various chemicals can be added to the pulp. The chemicals added to the wet pulp are known as 'wet end' or 'internal' additives "process chemicals" (or "control additives"). Some additives assist in the manufacturing process, others are functional in that they produce properties that are desirable in the end product. Examples of these are "binding agents" or "binders" which enhance the structural tensile strength of the moulded paper pulp product and "sizing agents" or "sizers" which make the product more resistant to penetration by liquids.

The judge, in paragraph 19 of the judgement, noted that it was common ground that detergent increases the ability of a liquid to penetrate a moulded pulp product and causes it to disintegrate. Further, use of a fluorocarbon sizing agent increases resistance to penetration by detergent. What was not common ground was the extent to which this fact was something that would have been within the common general knowledge of the skilled person in the moulded paper pulp sector or even in the wider paper and paperboard industry as at 2006.

The Skilled Person

The judge decided the issue of the extent of the knowledge to be attributed to the skilled person.

In paragraph 23, the judge set out the requirements for a skilled person or team for both patents as:

- a. is a designer of single use maceratable paper pulp products;
- b. understands how such products would be stored, used and disposed of in, for example, hospitals;
- c. has an understanding of the moulding techniques needed to achieve particular shapes;
- d. does not have a particularly broad chemistry background or knowledge, but has a working knowledge of the ingredients typically used in the pulp formulations used to make moulded paper pulp products (including the sizing agents, binding agents and biocides that were in use in the moulded paper pulp sector);
- e. would be interested in the wider world of paper pulp products but would, in general, be unlikely to question the status quo with regard to matters of pulp composition used in the moulded paper pulp sector; and

- f. would, if a technical issue arose regarding, in particular, pulp formulation, seek specialist advice.

The judge rejected MFP's argument that the skilled person (or team) for the 947 Patent would include a "Skilled Paper Chemist" (paragraphs 24-25 of the judgement). The judge in paragraph 27 decided that "no-one in the moulded paper pulp sector had previously thought of using an additive to provide detergent resistance, so the very fact that it sought specialist advice as to whether there was an additive that would achieve this (possibly an additive outside those already known to those operating in the moulded paper pulp products sector) was inventive".

The 793 Patent

The principal issue between the parties is whether the MFP washbowl falls within integers 1.f to 1.k of the 793 Patent, that is, whether it has:

"an enclosing wall comprising recesses located on opposite sides of the liquid-receiving volume below the upper periphery of the enclosing side wall and forming grip means located below the upper periphery of the enclosing wall for facilitating lifting."

Vernacare needed to establish that the MFP washbowl has the requisite recesses and that those recesses form grip means for facilitating lifting of that washbowl.

The judge noted that the claims of the 793 Patent had previously been construed by HHJ Birss, as he then was, in earlier proceedings against a different defendant. Adopting that construction, the judge found that the bowl did not have recesses of the type required by the claim and so did not infringe. He also considered an invalidity squeeze argument that to be infringed the claims would have to be construed broadly enough to include something that was within the common general knowledge and held that this succeeded.

In paragraphs 63-67, the judge goes on to consider infringement by equivalence and the Formstein defence. He endorsed the view of Birss LJ in *Facebook v Voxel* [2021] EWHC 1377 and found that the skilled person is unlikely to construe a claim as applying to a variant (an equivalent) to the inventive concept of that claim where that variant was not inventive but was, rather, a part of that skilled person's common general knowledge

In summary, the judge decided that the 793 Patent is valid and that none of its claims are infringed by the MFP washbowl.

The 947 Patent

The 947 Patent is focused on solving the problem whereby traditional moulded paper pulp products were not suitable to be used as washbowls for patients, because the

presence of detergent or soap in the water caused them to disintegrate very quickly. The inventive concept in claim 1 lies in the solution it provides for ensuring that a washbowl made from moulded paper pulp was detergent resistant.

It was accepted that the MFP washbowl does fall within the scope of claims 1, 3, 9 and 12 of the 947 Patent. Accordingly, MFP's defence to infringement was one of invalidity on the ground of obviousness. Two Japanese patent applications were pleaded as prior art, referred to as Shimooka and Sugimoto.

In assessing inventive step, the judge considered the four steps of the Pozzoli test.

The judge made four findings about the skilled person's common general knowledge at 2006 and why it was not part of that knowledge that the addition of a fluorocarbon to a pulp mix used to make a mouldable paper pulp product would make that product detergent resistant.

The first is that medical staff tended to use plastic bowls when washing patients as existing moulded pulp bowls became soggy and were liable to disintegrate. The second is that there is no evidence as at 2006 of any product being made from moulded paper pulp whose composition included a fluorocarbon.

Third, it was known in the wider paper/paperboard industry that adding a fluorocarbon to a pulp mix would make the paper/paperboard more resistant to oil, water and grease, but this would not have been part of the common general knowledge of the skilled person within the moulded paper pulp sector

Fourth, even if the skilled person in the moulded paper pulp sector had been aware of the use of fluorocarbon in the wider paper/paperboard industry (for example in grease proof paper), that skilled person would not have known that such use of a fluorocarbon would also or was likely to provide detergent resistance.

The judge compared the inventive concept of the 947 Patent to the prior art and concluded that there was nothing in Shimooka or Sugimoto that would have made it obvious to the skilled person to add a fluorocarbon to the pulp mix in order to make a moulded paper pulp washbowl.

The judge found that claim 1 of the 947 Patent was valid as were claims 3, 9 and 12 which had been said by Vernacare to be independently valid.

Also of interest is that the judge went on to consider the question of long felt want / commercial success. He considered the factors as set out by Laddie J in *Haberman v Jackel* [1999] F.S.R. 683 and concluded that Vernacare's product has been a

success. However, he was not convinced that this, of itself, supported the case of lack of obviousness. Further, the evidence provided of long felt was not of any assistance,

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The judge declared that:

- a. The 793 Patent is valid but is not infringed by the MFP washbowl; and
- b. The relevant claims of the 947 Patent are valid and are infringed by the MFP washbowl.

A link to the judgment is [here](#).

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