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Case No: HP-2021-000042

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
PATENTS COURT

Royal Courts of Justice, Rolls Building
Fetter Lane, London, EC4A 1NL

Date: 7 November 2024

Before :

HIS HONOUR JUDGE HACON
(sitting as a Judge of the Patents Court)

Between :

SAFESTAND LIMITED
- and -
(1) WESTON HOMES PLC
(2) WESTON (LOGISTICS) LIMITED
(3) WESTON GROUP PLC

Claimant

Defendants

Henry Edwards (instructed by **DLA Piper UK LLP**) for the **Claimant**
Nick Zweck (instructed by **Birketts LLP**) for the **Defendants**

Hearing dates: 15 October 2024

Approved Judgment

This judgment was handed down remotely at 10.30am on 7 November 2024 by circulation to the parties or their representatives by e-mail and by release to the National Archives.

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HIS HONOUR JUDGE HACON

Judge Hacon :

Introduction

1. On 19 December 2023 I handed down judgment in these proceedings. I found that three patents owned by the claimant ('Safestand') are valid and that the defendants (collectively 'Weston') have infringed the patents by the marketing of builders' trestles.
2. Weston have now modified the design of their products in two ways and say that the new trestles ('the Modified Trestles') do not infringe.
3. Weston's trestles in both original and modified form use brackets to secure kickboards. Kickboards are boards of low height, like a plank on its side, placed at the edge of a platform to prevent a person from accidentally stepping over the edge. They are held in place by brackets. In the judgment I found that the brackets used by Weston infringe one of the patents in suit. Of the two modifications made by Weston, one is directed to the design of their brackets ('the Modified Brackets'). The other goes to the design of the trestles more broadly.
4. In March 2024 Weston filed a Re-Amended Defence and Counterclaim seeking a declaration of non-infringement ('DNI') in respect of their Modified Trestles and Modified Brackets. The DNIs are sought in relation to two of the three patents in suit at the trial, the other having expired.
5. One of the surviving patents, European Patent No. 1 660 738 B1 ('EP 738') claims a builders' trestle having certain features. The other, UK Patent No. 2 420 822 ('UK 822'), claims a kickboard bracket with stated features. I will refer to them collectively as 'the Patents'.
6. Safestand filed a Re-Re-Amended Reply and Defence to Counterclaim stating that the Modified Trestles and Modified Brackets still infringe. It is not asserted that they infringe on a normal construction of the Patents, only under the doctrine of equivalents.
7. Weston served a Reply in which they say:
 - (1) the Modified Trestle does not infringe EP 738 because Weston have a Formstein defence: the Modified Trestle is neither new nor involves an inventive step over either or both of two items of prior art:
 - (a) UK patent application GB 2 364 733A, known as 'Kelk', and
 - (b) an alleged prior disclosure by Safestand ('the Safestand Prior Disclosure');
 - (2) the Modified Bracket does not infringe UK 822 because it does not involve an inventive step over the Safestand Prior Disclosure.
8. Safestand's case on infringement in relation to the modified designs will now go to trial, subject to applications made by each side.

The applications

9. On 29 May 2024 Safestand filed an Application Notice seeking an order striking out Weston's Formstein defences. Safestand say that Weston's arguments on novelty and inventive step in relation to Kelk amount to a rerun of an issue decided in my judgment of 19 December 2023 and should be struck out on the ground of issue estoppel or abuse of process. As to Weston's arguments based on the Safestand Prior Disclosure, Safestand say that this amounts to an attempt to resurrect a dismissed reliance on this allegation and is an abuse of process.
10. On 6 June 2024 Weston filed an Application Notice seeking an order striking out Safestand's allegations of infringement by equivalence in their entirety and for judgment to be entered in favour of Weston's case for declarations of non-infringement. Weston contends that Safestand is now presenting its case based on inventive concepts of the Patents which are different from the inventive concepts relied on at the trial. They say that Safestand's case on equivalents should be struck out (a) on the ground of estoppel, (b) because it contravenes the principle that a party is not entitled to approbate and reprobate or (c) because it is an abuse of process.
11. At the hearing of both applications Henry Edwards appeared for Safestand, Nick Zweck for Weston.

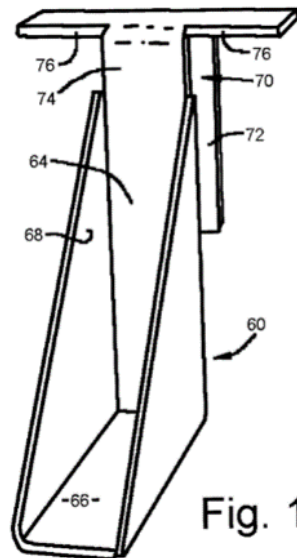
The Modified Trestle and Bracket

12. This is an illustration of Weston's original trestles from the judgment:



13. The invention claimed in EP 738 is a safety feature which concerns the horizontal rails on the working side. In the photograph they are above the wooden platform and on the side of the trestles adjacent to what looks like a metal door. These (grey) horizontal rails and the (blue) uprights to which they are attached are removeable.

14. Weston's original infringing trestles have removeable horizontal rails and uprights. The Modified Trestles have removeable horizontal rails but the uprights are fixed.
15. The kickboard brackets of UK 822 are shown in Figure 1:



16. The feature marked 70 at the back of the bracket hooks over a kickboard on the long side of the platform. A plank is slotted into the space or socket marked 64 to form a transverse kickboard. Weston's infringing brackets have the features just mentioned and also the lateral extensions on each side at the back of the bracket, marked 76 in the figure.
17. Weston's Modified Brackets do not have the lateral extensions, otherwise they are the same as before.

The new inventive concepts and equivalence

18. In Safestand's pleaded case on equivalence relating to EP 738 this is the stated inventive concept:

'The inventive concept of the '738 Patent is the incorporation of a selectively removable barrier on the working side of a builder's trestle with selectively removable horizontal rails, enabling walls or other structures to be built with fewer lifts of the trestle while ensuring that the safety barrier can be removed when not needed.'

19. Summarising Safestand's case, it argues that the presence of fixed uprights in the Modified Trestles does not affect the key advantage provided by the inventive concept. Applying the *Actavis* questions (*Actavis UK Ltd v Eli Lilly & Co* [2017] UKSC 48, at [66]) leads to the result that the Modified Trestle infringes EP 738 as an equivalent.
20. This is Safestand's pleaded case on the inventive concept of UK 822:

‘The inventive concept of the ‘822 Patent is a bracket comprising a socket dimensioned to receive an end of a transverse kickboard and a clip for securing the bracket to a second longitudinal kickboard with a back wall between the transverse and longitudinal kickboards, enabling the positioning of the transverse kickboard away from scaffolding poles or other uprights.’

21. Safestand argues that removing the lateral extensions makes no difference in that the Modified Bracket still provides all the advantage of the inventive concept. As with the Modified Trestle, its pleading sets this out in more detail, running through the *Actavis* questions which are said to lead to infringement by equivalence.

Weston’s Formstein defences

22. The Formstein defence was explained in *Technetix BV v Teleste Ltd* [2019] EWHC 126 (IPEC) at [85]-[100]. In brief, a product or process which would nominally fall within the scope of a claim as an equivalent pursuant to the law on equivalents as explained in *Actavis UK Ltd v Eli Lilly & Co* [2017] UKSC 48 will be deemed to fall outside the claim’s scope if the equivalent would have lacked novelty or embodied no inventive step over the prior art at the priority date of the patent in suit.
23. The two items of prior art relied on by Weston in their Formstein defence, Kelk and the Safestand Prior Disclosure, both featured in the judgment of 19 December 2023.
24. In the pleadings in the substantive action Weston alleged that EP 738 is invalid and one pleaded ground was that EP 738 lacks an inventive step over Kelk. The obviousness of EP 738 over Kelk is discussed in the judgment.
25. The Safestand Prior Disclosure became part of the case on the first day of the trial when Weston applied to amend their pleading on novelty and inventive step to introduce reliance on the Safestand Prior Disclosure. I dismissed the application, giving reasons in the judgment.
26. I should add that in the DNI case Weston has pleaded arguments alternative to the ones I have mentioned: the scope of a patent claim is for all purposes expanded to include all equivalents; if in its expanded form the claim is not new or lacks inventive step over the prior art, an assertion of infringement by an equivalent must fail. Nothing was made of these alternative arguments at the hearing.

Weston’s application

27. Weston pointed out that at the trial Safestand’s formulation of the inventive concept of EP 738 included the feature of removeable uprights, the very feature which the Modified Trestles do not have. That feature has now been dropped from Safestand’s inventive concept.

28. Likewise, Weston said, the lateral extensions of the invention in UK 822 featured in Safestand's inventive concept for that patent at the trial. Now that this feature has been discarded in the Weston's Modified Brackets, it is also missing from Safestand's new inventive concept.
29. At the hearing Weston advanced its argument in support of striking out Safestand's pleadings on equivalents by reference to the law on approbate/reprobate, accepting that if they did not succeed under this head, they would not succeed by reference to the law of estoppel or abuse of process.
30. *Express Newspapers plc v News (UK) Ltd* [1990] 1 WLR 1320 concerned a dispute between two newspapers, the Daily Express and Today. The plaintiff brought a claim against the defendant which had substantially copied a report in the claimant's newspaper without acknowledging the source of the story. The plaintiff obtained summary judgment for infringement of copyright. There was a counterclaim in which the defendant complained that the plaintiff had copied a story in the defendant's newspaper, described by the court as the mirror image of the plaintiff's claim. The defendant sought summary judgment on its counterclaim.
31. The plaintiff ran a defence to the counterclaim based on a custom in the press of adopting stories which have appeared in rival newspapers. Sir Nicholas Browne-Wilkinson V-C held that the plaintiff had an arguable defence based on this alleged custom. Nonetheless he granted summary judgment because the plaintiff's ground for resisting summary judgment was wholly inconsistent with its case in the main claim, a claim based on legally indistinguishable facts. He identified the point of law at 1329:

‘There is a principle of law of general application that it is not possible to approbate and reprobate. That means you are not allowed to blow hot and cold in the attitude that you adopt. A man cannot adopt two inconsistent attitudes towards another: he must elect between them and, having elected to adopt one stance, cannot thereafter be permitted to go back and adopt an inconsistent stance.

To apply that general doctrine to the present case is, I accept, a novel extension. But, in my judgment, the principle is one of general application and if, as I think, justice so requires, there is no reason why it should not be applied in the present case.’

32. *Express Newspapers* was considered by Veronique Buehrlen QC in *MPB v LGK* [2020] EWHC 90 (TCC). Having quoted from the Vice-Chancellor's judgment, she said:

‘[57] Both parties also referred me to a number of cases in which the doctrine has been raised in the context of adjudication. In particular, I was referred to *PT Building Services Ltd v ROK Build Ltd* [2008] EWHC 3434 (TCC), *Twintec Ltd v Volkerfitzpatrick Ltd* [2014] EWHC 10 (TCC), *Rob Purton t/a Richwood Interiors v Kilker Projects Ltd* [2015] EWHC 2624 (TCC), *RMP Construction Services Ltd v Chalcroft Ltd* [2015] EWHC 3737 (TCC), and *Skymist Holdings Ltd v Grandlane*

Developments Ltd [2018] EHC 3504 (TCC). Save in relation to the PT Building Services case to which I refer further below, I have not found these decisions particularly pertinent. That is because they are concerned with challenges to an adjudicator's jurisdiction on enforcement based, for instance, on whether the underlying construction contract was mis-described by the referring party or on whether the contractual provision relied upon to make the referral existed at all. This is not such a case.

[58] All the same, certain principles arise from the case law taken as a whole:

- i) The first is that the approbating party must have elected, that is made his choice, clearly and unequivocally;
- ii) The second is that it is usual but not necessary for the electing party to have taken a benefit from his election such as where he has taken a benefit under an instrument such as a will;
- iii) Thirdly, the electing party's subsequent conduct must be inconsistent with his earlier election or approbation.

In essence, the doctrine is about preventing inconsistent conduct and ensuring a just outcome.'

33. In my judgment Weston's application should be dismissed for reasons which can be shortly stated. I accept that Safestand has modified its case on the inventive concepts of the two patents. However, Safestand's case at the trial did not constitute an election between options in the sense indicated by Sir Nicholas Browne-Wilkinson or Ms Buehrlen, or rather not an election by which it is now bound. That is because Safestand must now argue its case on infringement based on my findings in the judgment, subject only to contrary findings on appeal. I do not decide here whether Safestand is correct to say that its new formulations of the inventive concepts are consistent with the contents of my judgment, but it is certainly arguable and the point must go to trial.
34. I can see that if a party were to advance one formulation of an inventive concept in a claim and an inconsistent one in a counterclaim in the same proceedings, the doctrine of approbate/reprobate may have application. That is not this case.
35. Weston's application is dismissed.

Safestand's application – Kelk

36. The law on issue estoppel is well established and was not in dispute. In *Arnold v National Westminster Bank plc* [1991] 2 AC 93 Lord Keith said, at 105:

'Issue estoppel may arise where a particular issue forming a necessary ingredient in a cause of action has been litigated and decided and in subsequent proceedings between the same parties involving a different cause of action to which the same issue is relevant one of the parties seeks to re-open that issue.'

37. In *Virgin Atlantic Airways Ltd v Zodiac Seats UK Ltd* [2013] UKSC 46, Lord Sumption, with whom the remainder of the court agreed, said (at [22]) that the House of Lords' judgment in *Arnold* was authority for the following proposition, among others:

'Except in special circumstances where this would cause injustice, issue estoppel bars the raising in subsequent proceedings of points which (i) were not raised in the earlier proceedings or (ii) were raised but unsuccessfully. If the relevant point was not raised, the bar will usually be absolute if it could with reasonable diligence and should in all the circumstances have been raised.'

38. In my judgment I found that EP 738 does not lack inventive step over Kelk, making the following finding:

'To my mind, a skilled person having read Kelk in 2004 would not have contemplated the variation of having an additional safety barrier on the working side or of making it selectively removeable. Rather, to paraphrase Dr Santos a little, these together would have been seen as a neat idea. EP 738 does not lack inventive step over Kelk.'

39. Thus, an issue I decided was that a trestle with a selectively removeable safety barrier on the working side would not have been contemplated by a skilled person reading Kelk. It was a necessary part of my holding that EP 738 was not obvious over Kelk and therefore a necessary ingredient in the conclusion that Weston's cause of action for revocation of EP 738 did not succeed.

40. The Modified Trestle still has a selectively removeable safety barrier on the working side. At the present hearing I asked Weston's counsel how it could advance its Formstein defence to infringement of EP 738 by reference to Kelk without inviting the court to reconsider that same issue. He accepted that the issue would have to be reopened but said that the law on the Formstein defence was new in this country, in a process of development, and as a matter of policy it should not be restricted.

41. I cannot accept this. The Formstein defence is indeed at a formative stage in this jurisdiction but I have no doubt that however it develops it will not override the law on issue estoppel as explained at the highest judicial level. Weston's counsel rightly did not suggest that the Formstein defence falls within the exception stated by Lord Sumption, namely special circumstances that would cause injustice. Aside from anything else, I can see no injustice.

42. Weston's Formstein defence made by reference to Kelk falls to be struck out.

Safestand's application – the Safestand Prior Disclosure

43. I introduced the alleged prior use this way in my judgment:

'10. On the morning of the first day of the trial Weston filed an application notice seeking permission to re-re-amend their Grounds of Invalidity. They had discovered an article from Construction News

dated 3 June 2004 containing a passage which, Weston said, led to a strong inference that there had been prior use by Safestand of the inventions claimed in EP 738 and UK 822, so both patents are invalid for lack of novelty. Draft Re-Re-Amended Grounds of Invalidity were provided.

11. Weston gave Safestand notice of their intention to make the application and why on the first morning of the trial. Safestand resisted the application.’

44. I discussed the law on late applications of this nature, specifically the judgment of Carr J, as she then was, in *Quah Su-Ling v Goldman Sachs International* [2015] EWHC 759 (Comm) and that of the Court of Appeal in *Nesbit Law Group LLP v Acasta European Insurance Company Limited* [2018] EWCA Civ 268.

45. The judgment in *Quah* included this:

‘Applications always involve the court striking a balance between injustice to the applicant if the amendment is refused, and injustice to the opposing party and other litigants in general, if the amendment is permitted;’

46. In *Nesbit Law* the Chancellor said:

‘In essence, the court must, taking account of the overriding objective, balance the injustice to the party seeking to amend if it is refused permission, against the need for finality in litigation and the injustice to the other parties and other litigants, if the amendment is permitted.’

47. In the judgment I applied the balance identified in the two cases just mentioned to Weston’s application to amend their Grounds of Invalidity and made this finding:

‘I think it matters a good deal that there was no satisfactory reason why prior use could not have been pleaded in good time. If it did not matter much, applications to amend Grounds of Invalidity, even on the first day of the trial, would routinely be allowed on the sole basis that something has just come to light. This would be not in accordance with the overriding objective. The application to amend is dismissed.’

Weston’s argument

48. Weston argued that Safestand’s application to strike out this aspect of Weston’s Formstein defence stood or fell by the rule in *Henderson v Henderson* 3 Hare 100.

49. Referring to *Test Claimants in the FII Group Litigation v Revenue and Customs Commissioners* [2021] UKSC 31, at [74]-[77], Weston submitted that the issues were (i) whether Weston could and should have raised Formstein defences at trial and (ii) whether it is abusive to raise them in this DNI claim. Self-

evidently, Weston continued, the defences could not have been raised at the trial because the trial was not concerned with the Modified Trestle or Modified Bracket.

50. Weston further argued that the time to raise the objection now being raised by Safestand was when Weston raised its DNI claim after the trial. Having consented to the claim, Safestand could not object to how Weston made the claim.

Safestand's argument

51. Safestand argued that Weston's resurrection of its prior use allegation would be an abuse of process, whether under the rule in *Henderson v Henderson* or more generally. I was referred to the judgment of Potter LJ in *Divine-Bortey v Brent London Borough Council* [1998] ICR 886, at 898:

'The basis of the rule in *Henderson* is the avoidance of multiplicity of litigation in relation to a particular subject or set of circumstances in order to avoid the prejudice to a defendant which inevitably results in terms of wasted time and cost, duplication of effort, dispersal of evidence and risk of inconsistent findings which are involved if different courts at different times are obliged to examine the same substratum of fact which gives rise to the subject of litigation. The rule is justifiable and justified as a matter both of common sense and common justice between the parties and it is the aspects of prejudice which I have mentioned which will usually render a second bite of the cherry worthy of the description "abuse of process." They are essentially objective considerations to which the particular circumstances of the parties will generally be irrelevant; hence the need for special circumstances if the full rigour of the rule is to be alleviated.'

52. A parallel was drawn by Safestand with cases in which a party seeks to amend its claims after the court has ruled on the claims at trial. In *Generics (UK) Limited v Warner-Lambert Company LLC* [2016] EWCA Civ 1006, Floyd LJ, with whom Patten and Kitchin LJJ agreed, applied the law on abuse of process, including *Henderson v Henderson*, to an application to amend patent claims after the trial. He considered the distinction drawn by Jacob LJ in *Nikken Kosakusho Works v Pioneer Trading Company* [2005] EWCA Civ 906, at [8], between applications to amend claims (a) before the trial, (b) after the trial where the application is simply to delete claims found to have been invalid and (c) post-trial applications in which the patentee seeks to rewrite claims. Floyd LJ said:

'The reason why the jurisprudence views with hostility the rewriting of claims after judgment is that, in contrast to the case where the claim existed in some form in the unamended patent, the party attacking the patent has not had a proper opportunity during the trial to address that claim. A further trial is thus rendered necessary in order to avoid procedural unfairness to that party, and it is the imposition of that further trial which is regarded as undue harassment.'

53. Safestand submitted that the need for finality in litigation, expressly referred to in *Nesbit Law*, is exactly the need which underpins the rule in *Henderson v Henderson* and that this is clear from the judgments in *Divine-Bortey* and *Generics v Warner-Lambert*.
54. In the judgment in this case it was found that the Safestand Prior Disclosure could and should have been pleaded in good time before the trial, the judgment noting the consequence if Weston were now allowed to rely on the allegation: a further trial. That finding was not appealed. Safestand submitted that the same reasoning applies to Weston's application to run a Formstein defence based on the Safestand Prior Disclosure – again the consequence would be a further trial. Prior use allegations are notoriously factually intensive and time consuming. This court has rejected Weston's application to run the point in a second trial once; a further attempt to run the point in another trial is as unmeritorious as it was before and should be refused.

Discussion

55. I do not agree with Weston's analysis of the relevant issue now before the court. Certainly, Weston could not have pleaded the current Formstein defence before the trial because the Modified Trestle and Modified Bracket were not in play. The issue, however, is whether Weston is entitled to frame its case in relation to the DNIs now being sought in a manner which once again raises the question of the alleged Safestand Prior Disclosure.
56. Both sides argued that the resolution of that issue depends on the criteria applied in the rule in *Henderson v Henderson*.
57. On the present facts there is going to be a second trial anyway. This was not pressed by Weston at the hearing and I think for good reason. Absent the issue of prior use, it is likely that the trial of the application for DNIs, based on the findings in the judgment, will be short, requiring no evidence and only brief argument. A trial which included the resolution of the whether there was a Safestand Prior Disclosure would be substantial in terms of evidence and argument. It can always be argued that raising an issue late merely transfers the cost in time and money from an earlier trial to a later one, but courts have never been receptive to such an argument because in practice such a transfer generates extra cost in time and money and increased use of court time.
58. In my view it would not be in conformity with the rule in *Henderson v Henderson* if Weston were to be permitted to argue its case on the Safestand Prior Disclosure when, as I have already found, Weston could and should have pleaded that case in good time for it to be argued at the substantive trial. The vice entailed in having the opportunity to argue the case has not gone away. It would still be an abuse.
59. Weston once again raised a policy issue, saying that in this context too there should be no restriction imposed on the development of the law on Formstein defences. In my view this policy point lacks merit as it does in the context of the Formstein defence advanced by reference to Kelk.

60. Safestand's application succeeds on both limbs. Weston's Formstein defences will be struck out.