

OPINION UNDER SECTION 74A

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| Patent | EP (UK) 1738030 C |
| Proprietor(s) | Rack Armour Limited |
| Exclusive Licensee | |
| Requester | Franks & Co Limited |
| Observer(s) | |
| Date Opinion issued | 18 February 2015 |

The request

1. The comptroller has been requested by Franks & Co Limited (the requester) to issue an opinion as to whether acts in relation to an impact protection device for a racking installation, identified as 'Rack Shield 800G' (the product) in the request, infringe the claims of patent EP (GB) 1738030 C ("the patent").
2. The request includes annexes 1 and 2. Annex 1 contains photographs of the product and annex 2 contains freeze frames taken from videos on Youtube® of the product. Annex 2 also lists links to three videos of the product on Youtube®¹.

Observations

3. No observations were received.

The Patent

4. The proprietor's patent, EP (GB) 1738030 C, is titled "Pallet Rack Impact Protector". It was filed on 18th April 2005, published on 3 January 2007 and granted on 20 June 2014. The patent was amended post grant under section 117 of the Patents Act on 21 August 2014. The patent remains in force.
5. The patent describes a pallet racking upright protection device to prevent or reduce the likelihood of damage to racking uprights. The aim of the protection device is to mitigate actual damage to racking uprights to the lowest levels so far as is reasonably practicable. Figure 3 is shown below:

¹ http://youtu.be/4uwL_2yHP8; <http://youtu.be/ETchiKHdoWk>; <http://youtu.be/TJSWNJd-V0A>

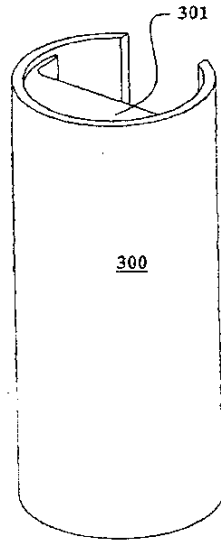


Figure 3

6. As described in the patent, the column protector device comprises an elongate tubular outer shell 300 of a substantially part cylindrical shape, having in cross section, a substantially circular "C" shape; and, an inner liner 301 which fits inside the outer shell, and in use fits between the outer shell and a column upright of a racking system, which the column protector device attaches to. The outer shell is slideable with respect to the inner liner, so that the outer shell can be slid upwardly when grasped by a person, allowing for visual inspection of the inner liner and/or the racking upright to which the device is fitted, without having to remove the whole device. Consequently, routine visual checking for damage of the uprights along a row of bays can be achieved quickly by a single person. The outer shell 300 is intended to protect the inner liner 301 against direct impact from mechanical handling equipment, vehicles or the like. Any impact from external sources, in general will not penetrate the outer shell 300. However, the outer shell in general will transfer force of impact to the inner liner 301, which acts to absorb and diffuse the energy resulting from any impact incident on the outer shell, by spreading that energy and force over a relatively large area.
7. As can be seen in figure 3 above and figure 6 below the inner liner comprises an elongate solid body having an outer surface comprising a substantially cylindrical portion, and a substantially "U" shaped channel portion. The substantially "U" shaped channel resides within part of the substantially cylindrical shaped outer portion to provide first and second wall surfaces respectively which face opposite each other.
8. Referring to figure 6 below there is illustrated schematically in cut away cross section from above, a column post 600 of a racking system, having the column protector device installed. The outer shell 300, when fitted to the column, surrounds the front member 601, the first and second outer side members 602, 606 and the first and second connecting members 604, 607, thereby protecting them from direct impact with vehicles and the like, and partially surrounds each of the first and second inner side members 603, 608. The outer shell also surrounds the inner liner 301, which resides, in use between the substantially cylindrical inner surface of the outer shell

300 and an outer face of the front member 601, an outer face of the first outer side member 602 and an outer face of the second outer side member 606. The pallet racking protection device directly encapsulates the external frontage and lateral sides of an aisle facing frame upright. The device does not require any additional fastening devices to secure it in place due to the innate elastomeric properties of the material it is manufactured from. Rather, the column protector device simply 'clips' onto a column upright and without the need for any separate fixings or fasteners.

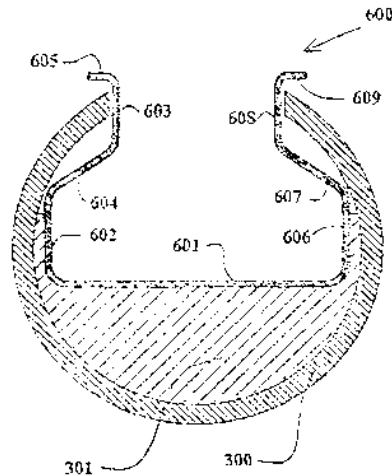


Figure 6

9. Figure 8 below, shows an example of a single bay of a racking system fitted with two column protector devices. The racking frame consisting of a plurality of uprights 800, each having a standard footplate 801 and a plurality of diagonal cross bracings 802, and a plurality of horizontal cross bracings 803. The racking bay is fixed to floor with mechanical anchor bolt fixings through the footplates.

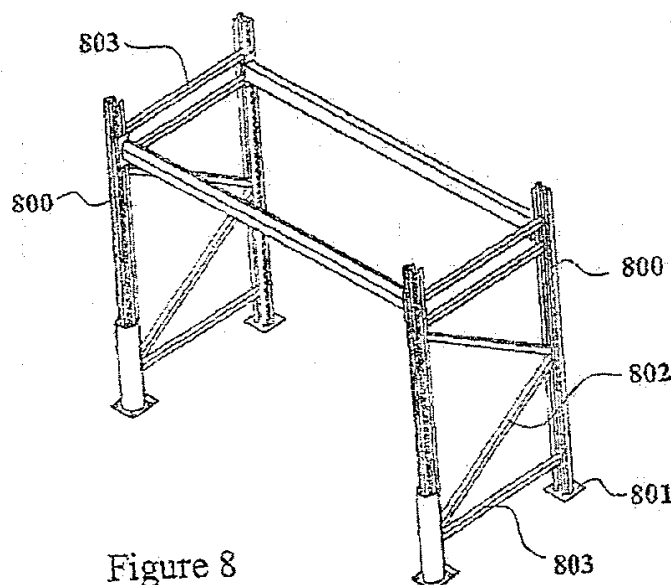


Figure 8

10. The patent has thirty one claims with claim 1 being the only independent claim. This reads as follows:

1. A column protector device comprising:

an outer shell outer shell (300) comprising a substantially cylindrical tubular member with a pair of substantially parallel opposing edges either side of a gap in said outer shell; and

an inner liner (301) shaped to fit within said outer shell;

said column protector device being a column protector device for protection of an upright column (600) of a racking system, said column of a type being channel shaped in cross section and having a substantially rectangular front portion consisting of a front member (601), and first and second side members (602, 603, 606, 608);

said column protector device being arranged to clip onto said upright column in order to grasp said upright column;

wherein said outer shell (300) is configured to fit around said upright column, such that the outer shell retains to said column in a self attaching manner without the need for any additional fixings; and

said outer shell (300) surrounds the front member (601) and partially surrounds the first and second side members (602, 603, 606, 608), thereby protecting the front member and parts of the side members; and

wherein in use said inner liner (301) is retained between said outer shell and said column; and

in which the inner liner comprises a substantially solid cylindrical member having a substantially cylindrical outer surface (501), and a substantially "U" shaped channel (502) formed on an opposite side of said liner to said substantially cylindrical outer surface and wherein the "U" shaped channel comprises opposite facing wall surfaces (504, 506) and in which, in use, said channel provides a flush interface between an inner profile of said inner liner and an external profile of said upright column in order for the inner liner to encapsulate a front face and portions of the first and second side members of said upright column,

characterised in that

the entire cross section of said cylindrical outer shell and the entire cross section of said cylindrical outer surface of the inner liner each form a continuous part of a substantially circular ring.

Claim construction

11. Before considering the arguments put forward and whether the product falls wholly within the scope of claim 1 I will need to construe the claim following the well known authority on claim construction which is *Kirin-Amgen and others v Hoechst Marion*

Roussel Limited and others [2005] RPC 9. This requires that I put a purposive construction on the claims, interpret it in the light of the description and drawings as instructed by Section 125(1) and take account of the Protocol to Article 69 of the EPC. Simply put, I must decide what a person skilled in the art would have understood the patentee to have used the language of the claim to mean.

12. Section 125(1) of the Act states that:

For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

13. And the Protocol on the Interpretation of Article 69 of the EPC (which corresponds to section 125(1)) states that:

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

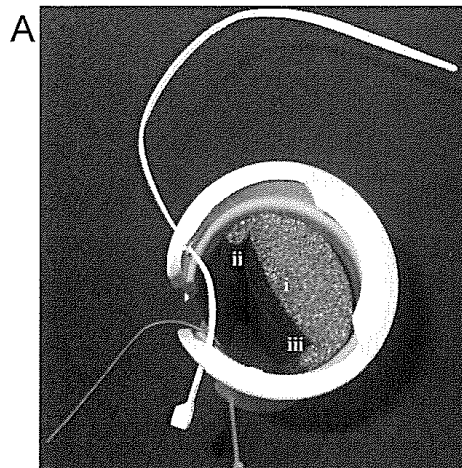
14. The requester has not provided any argument relating to the construction of the claims.
15. On the whole claim 1 is clear and a person skilled in the art would have no issue in construing the scope of the claim. I would however comment that in the third paragraph of claim 1 the column protector device is defined as being “for” protection of an upright column of a racking system. It is well established in accordance with the principles of claim construction that “for” should be interpreted as “suitable for” and thus the claim is directed to a column protector device which is suitable for connection to and protection of an upright column of a racking system that has a substantially rectangular front portion. The claim refers to additional features of column, for example that it is channel shaped in cross section that have no bearing on the scope of the claim which is directed to the protector device per se.

The Product

16. The product is given in the request as a ‘Rack Shield 800G’ impact protection device for a racking installation. The requester states that the product has been supplied in the United Kingdom to the proprietor. The product is available for sale in Italy and is

manufactured by Go-Systems SRL and is advertised on their website².

17. Annex 1 contains five photographs of the product and annex 2 contains three freeze frames of videos on Youtube® of the product. Annex 2 also lists links to three videos of the product on Youtube®³. The three videos show the product being installed on a column upright of a racking system. The videos appear to have been uploaded to Youtube® on 18 March 2014. Shown below is photograph A of annex 1:



Infringement - the law

18. Section 60 Patents Act 1977 governs what constitutes infringement of a patent; Section 60(1) reads:

Subject to the provision of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say -

- (a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;*
- (b) where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;*
- (c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.*

Section 60(2) reads:

Subject to the following provisions of this section, a person (other than the proprietor of the patent) also infringes a patent for an invention if while the patent is in force and without the consent of the proprietor, he supplies or

² <http://www.go-systems.eu/rackshield/>

³ http://youtu.be/4uwL_2yHP8; <http://youtu.be/ETchiKHdoWk>; <http://youtu.be/TJSWNJd-V0A>

offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.

19. The first step in determining if there is any infringement is to consider whether product falls within the scope of the claims of the patent.

Does the product infringe the patent?

20. I must now decide whether the product falls wholly within the scope of the claims.
21. The requester has provided a detailed breakdown of claim 1 and how the product contains all of the features of the claim. I find myself agreeing with the argument put forward by the requester. From the photographs and videos the product is prima facie very similar to the device defined by claim 1 of the patent. For example photograph A of annex 1 shows the product from above and it can be seen to have an outer shell and inner liner of almost identical construction to the device illustrated in figure 6 of the patent as reproduced above.
22. The product includes an outer shell and an inner liner. The outer shell is a substantially cylindrical member having a gap therein. The videos show the product being installed on a column and appearing to clip onto the column with the outer shell retaining the device in place without the need for any additional fixings. The inner liner is shown to be retained between the outer shell and column in use. The inner liner is "U" shaped as required by claim 1.
23. The characterising part of claim 1 defines the entire cross section of the cylindrical outer shell and the entire cross section of the cylindrical outer surface of the inner liner each forming a continuous part of a substantially circular ring. As can be seen from photograph A of annex 1 the outer shell and outer surface of the inner liner of the product also have entire cross sections forming a continuous part of a substantially circular ring.
24. Therefore I consider the product to fall wholly within the scope of claim 1.
25. I turn now to the dependent claims. Details of these claims can be found on the IPO's IPSUM website⁴. From the evidence before me I consider the product to fall within the scope of claims 2-6, 24-26 and 30-31.
26. Claims 7-11 and 13-23 define sizes and material of the outer shell and inner liner. The information on the product contained in annexes 1 and 2 does not however disclose any sizes of the product or any material contained therein.
27. Claim 12 requires the outer shell to have a chamfered upper edge. From the photographs, in particular photographs A-C in annex 1 it does not appear that the upper edge of the outer shell of the product is chamfered.

⁴ <http://www.ipo.gov.uk/p-ipsu/Case/PublicationNumber/EP1738030>

28. Claim 27 requires the inner liner to be bonded to an inner surface of the outer shell to prevent relative movement there between. There is no evidence that the inner liner is bonded to the outer shell of the product. In fact one of the videos shows the inner liner being slidably inserted between the outer shell and an upright column during installation of the product.
29. Claim 28 requires the device to further include a polycarbonate outer sheath which fits around the outer shell. There is no evidence that the product includes such a sheath.
30. Claim 29 requires the device to further include a polycarbonate insert member and again there is no evidence that the product includes such an insert member.
31. Whilst the product falls within the scope of claims 1-6, 24-26 and 30-31 I have no evidence that any person(s) has actually infringed the patent. The requester states that the product has been supplied in the United Kingdom to the proprietor but does not give any details of the person who supplied the product or of the circumstances in which the product was supplied. The product is made by Go-Systems SRL and sold throughout Italy however the requester does not allege any infringing acts on the part of Go-Systems SRL.

Conclusion

32. I conclude that the product falls within the scope of claims 1-6, 24-26 and 30-31 of the patent and therefore making, disposing of, offering to dispose of, using or importing or keeping for disposal or otherwise of the product in the United Kingdom would constitute infringement of the patent under Section 60(1).

Application for review

33. Under section 74B and rule 98, the proprietor may, within three months of the date of issue of this opinion, apply to the comptroller for a review of the opinion.

Mr Marc Collins
Examiner

NOTE

This opinion is not based on the outcome of fully litigated proceedings. Rather, it is based on whatever material the persons requesting the opinion and filing observations have chosen to put before the Office.