Patents Act 1977 **Opinion Number** **14/18**

OPINION UNDER SECTION 74A

Patent	GB 2456085
Proprietor(s)	Spomb Fishing Limited
Exclusive Licensee	
Requester	Boult Wade Tennant
Observer(s)	Spomb Fishing Limited
Date Opinion issued	07 August 2018

The request

1. The comptroller has been requested to issue an opinion as to whether GB 2456085 is invalid on the basis that claim 1 lacks novelty and/or inventive step according to Section 1(1) of the Patents Act. The Requestor provided three documents as evidence of the prior art:

D1 German Utility Model DE 20 2005 006 500 U1 (published 2006)

E1 a translation of the above;

D2 Patent US 3163957 (published 1965).

Observations

2. The proprietor has filed observations in response, and the requestor has filed observations in reply. The observations raise some preliminary issues about the nature of the request and admissibility of evidence. I confirm I have considered the contents of all these observations carefully.

Preliminary Issues

What the Request should cover

3. Firstly there is a question of whether the request is making a new case. Both the request and the observations note that D1 and D2 formed part of evidence in revocation proceedings commenced at the Intellectual Property Enterprise Court. However, these proceedings were the subject of a Tomlin order and thus are stayed with the agreement of both parties. Consequently the court has not considered the issue of validity based on these documents and there is therefore no reason to refuse the request.

4. Secondly, the proprietor has argued that inventive step should not be considered because no reasoned argument was put forward in the request. I agree with this point as the only relevant part of the submission I can find in the request is :

> *In case claim 1 from the Patent is somehow considered to be novel, the claim is in any case devoid of an inventive step based on disclosure from each of D1 and D2 when combined with common general knowledge available to the skilled person.*

I do not consider this is sufficient detail to allow me to reach an opinion on inventive step.

5. I will therefore give my opinion on the matter of validity, but only through lack of novelty of claim 1.

Admissibility of Evidence

6. The proprietor notes that the requester has not provided a certified translation of document D1 but instead seeks to rely on a machine translation (E1). The Proprietor contends that a certified translation is necessary given the scant description in D1, the poor quality of the drawings and the inadequacies of the machine translation provided. It suggests I should disregard the translation provided. I am not persuaded that it would be appropriate to do so. The opinion service is intended to be a low cost and simple process for obtaining an opinion on issues of validity and infringement. A requester is generally free to decide what evidence it wishes to rely on when making its request. If the requester decides to rely on a machine translation rather than a certified translation then it is open to the observer in its observations to challenge the accuracy of any parts of the translation relied on by the requester.

7. The proprietor has had the opportunity to say in their observations what they consider are possible errors and misleading aspects in the translation. I confirm that I have taken these into account.

8. I will allow document E1 along with document D1.

The Patent

9. The patent was filed on 04 February 2009 with an earliest priority date of 04 February 2008 and granted on 17 May 2011.

10. The invention is a bait container that can be held on a fishing line so that bait is initially contained, but is released when the container reaches the water. The bait may be placed out of reach, such as by an angler casting the container away from themselves to land at a location to be fished. The bait container has a hinged compartment held closed, but with a mechanism that opens the compartment when hitting the water to release the bait. Different shaped containers and types of release mechanisms are used in the various embodiments; not all are reproduced here.

11. Figures 2 and 3 from the Patent are reproduced below, each showing a bait dispenser after it has impacted water. Figure 2 shows a bait container with angled

fins 17 that form a concavity deflecting some of the initial 'upward' impact force of the water sideways to help drive the container open. Figure 3 shows rebated ends in the place of fins that provide a similar effect. Figure 2 has the container attached to an elongate float 30, such that the container remains submerged. Figure 3 shows one half of the container with a float 43, and the other half with a weight 44 such that the hinged container will tend to adopt a semi-submerged 'wide open' position shown. I consider the skilled reader will appreciate the float and weight in figure 3 will act to drive the container open. The latter is said to be suitable for *'surface fishing'*, the former is *'intended for fishing a little distance below the surface of the water'*.

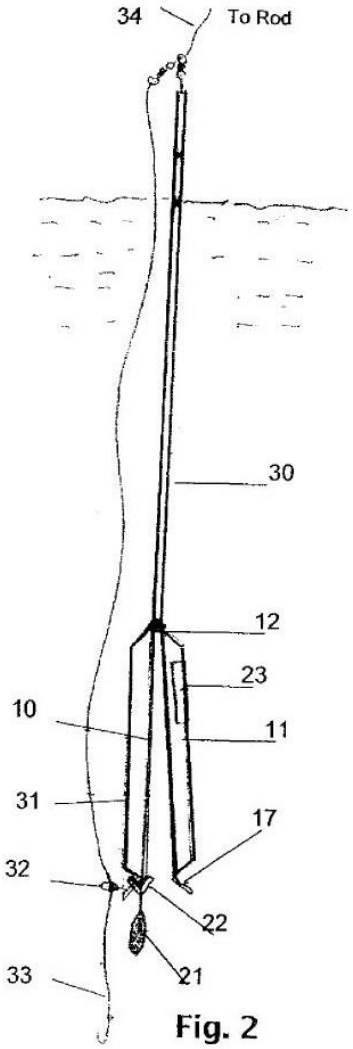


Fig. 2

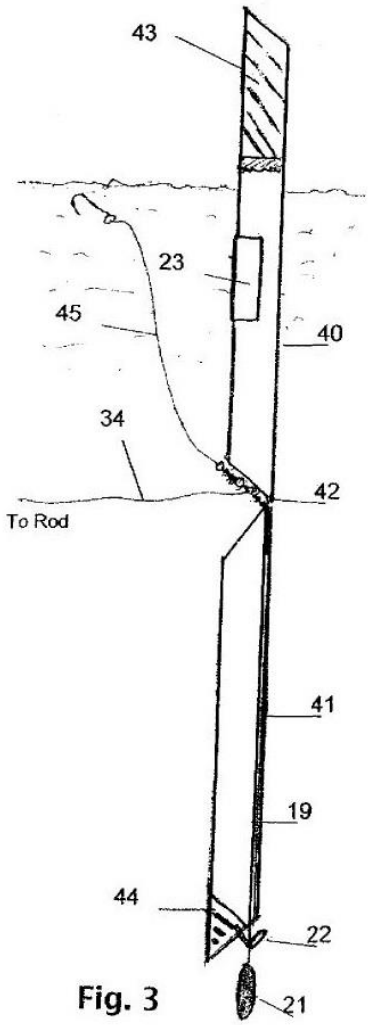


Fig. 3

In both embodiments a catch 22 is said to operate (pages 6 and 7) thus:

> *Upon impact with the water the weight 21 continues to enter the water while the fins 16, 17 first hold the container back to cause the catch 22 to release then cause the two halves 10, 11 of the container to fly open and release their contents.*
>
> *…*
>
> *Upon impact with the water the catch 22 is pulled away from the container as the container is somewhat arrested while the weight 21 continues onward. The force of the water upon the rebated end surfaces of the halves 40, 41 drives those ends apart and allows dispensing of the container contents.*

12. The embodiments of figures 7 to 15 show, instead of the concave shaped ends above, a convex ended shape and also show an alternative release mechanism. I reproduce figures 7 and 9 below and note that page 8 of the description states the following :

> *In the embodiment illustrated in figures 7 to 11 the opening of the dispenser is brought about by the impact of a plunger with the water when the line has been cast.*
>
> *…*
>
> *The body half 100 carries a line link 105 in which cords 106 are anchored to the two halves 100,101.*
>
> *…*
>
> *At the distal, or bow end, the body half 100 carries a platform 107 upon which is centrally mounted a plunger holder 108. The plunger holder 108 carries a plunger 109 and incorporates a spring 110 and a spring stiffness adjuster 111. The plunger 109 has a flange 112 which is arranged to engage on a detent 113 formed in the body half 101. As shown the distal, bow or lead end of the two body halves are formed with a mouth to which the plunger 109 forms a continuum.*

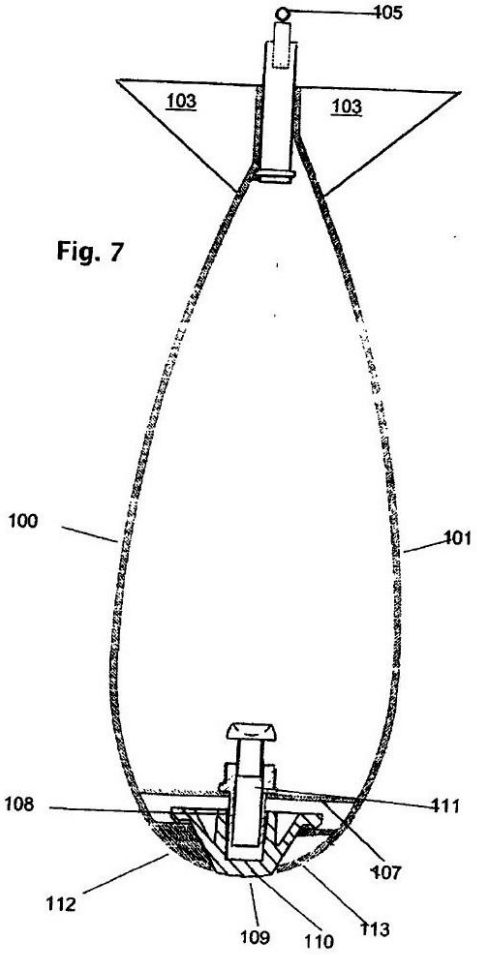


Fig. 7

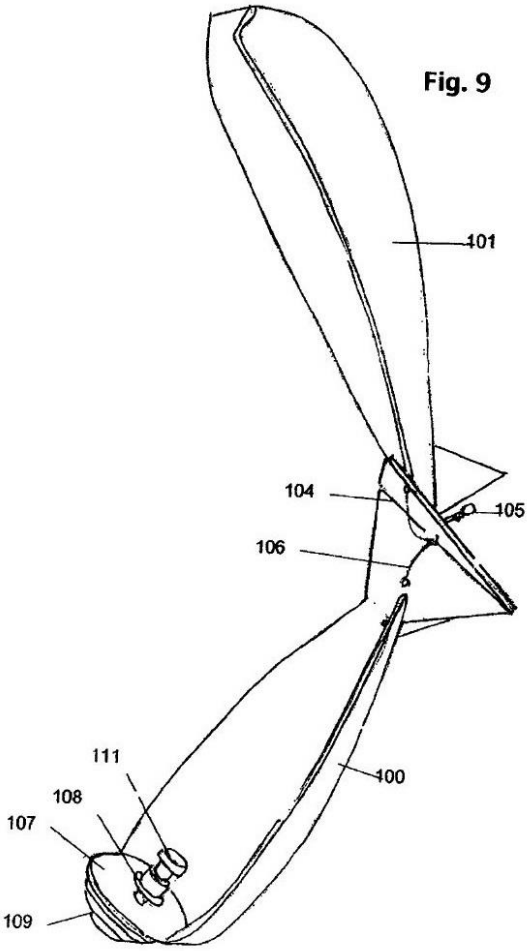


Fig. 9

13. Here, when the container impacts downwards in the sense of figure 7, the plunger moves relatively upwards, implicitly against the force of the spring and releases the half 101 of the container, unlatching it from the retaining ‘catch’ part of the plunger.

Claim Construction

14. The scope of the invention is defined by the claims which are interpreted according to Section 125, the relevant parts reads :

> *125 (1) 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.*

15. When construing claim 1, I must follow principles of construction in *Actavis UK Limited and others v Eli Lilly and Company*[1]. I must read the claim while taking into account the specification as a whole and consider what the words of the claim would mean in this context to the notional addressee.

16. I should give a purposive construction to what is written, in the sense of the person skilled in the art interpreting the claims having regard to the fact that the patentee's purpose was to describe and claim an invention. This approach has been confirmed in the recent decisions of the High Court in Mylan v Yeda[2] and the Court of Appeal in Actavis v ICOS[3].

17. To do this I will consider who the skilled addressee is. They will be a manufacturer and/or designer of fishing tackle bait containers for attachment to a fishing line so they may be cast.

18. Claim 1 of the Patent reads as follows where, for ease of discussion, I have added labels A to D to refer to the different features as did the requestor :

> **(A)** *A bait dispenser for use by an angler and comprising a container into which bait can be loaded,*
>
> **(B)** *the container comprising a plurality of members hinged one to the other*
>
> **(C)** *and attachable to a line at a proximal end thereof*
>
> **(D)** *and having a distal forward or bow end thereof means by which the dispenser will burst open upon impact with the water.*

19. Features A to C can be readily construed. They define a hinged bait container able to be attached to a line and suitable for use by an angler. There is no limitation given as to the type of bait, nor the size of the container. It is understood that *'line'* includes a fishing line and that an angler will expect to be able to cast the container using a fishing rod. The position of the hinge is not specified; whilst the

---

[1] Actavis UK Limited and others v Eli Lilly and Company [2017] UKSC 48

[2] Generics UK Ltd (t/a Mylan) v Yeda Research and Development Co. Ltd & Anor [2017] EWHC 2629 (Pat)

[3] Actavis Group & Ors v ICOS Corp & Eli Lilly & Co. [2017] EWCA Civ 1671

embodiments all show a hinge at the proximal end, the claim is silent on this point and it is not reasonable to infer any limitation on the hinge position. There is also no limitation to the shape of the members forming the container.

20. Feature D needs to be considered in more depth. Firstly, I need to decide what *'a distal forward or bow end thereof'* means. The word distal is used in comparison to the 'proximal end' and thus distal means distant of the part of the container where the line attaches. The words *'forward or bow'* are understood, given that the rest of feature D says *'upon impact with water'*, to mean an end of the container that is expected, in use, especially if cast, to impact the water first. I consider 'forward or bow' to substantially mean the same thing here, the end of the dispenser that is intended to head into the water first.

21. Secondly I need to decide what '*having … means by which the dispenser will burst open upon impact with the water'* means. This is the key point of contention between the parties, especially how 'burst open' should be construed. This is effectively 'a definition by result' where the claim defines a feature, not by the technical parts, but by the resulting function of the feature in use. I will construe this broadly to be any means that can achieve the result. It can be understood from the specification that impact of the distal end with water will cause the closed dispenser to open releasing bait. It is more difficult to understand the scope of 'burst open'.

22. The word 'burst' is not used very often in the description, it is present in the summary of the invention on page 2 where it says:

> *Among the means for achieving bursting open of the container upon impact with the water are fins, suitably disposed flotation devices or chambers, spring means and making the container or part thereof of a rapidly soluble material. Any one or combination of these may be suitable for a given form of fishing. Where fins are used these may be splayed outwards at an acute angle and arranged so that faces thereof impact the water and thus drive the container members apart. The fins may, if there is to be a catch in the region thereof, straddle the catch and may lightly retain the catch in place by means of friction.*

23. The word 'burst' is also used when describing the embodiment of figures 15 to 16 (very similar to figures 7 and 9 reproduced above) where on page 11 it firstly describes use of the dispenser :

> *When the line is then cast, upon striking the water the plunger is pushed into the body S halves 300, 301 against the spring 310, releasing the detent 313. Ingress of water between the plunger and the body halves assists in urging the body halves apart, to allow the bait to exit the dispenser.*

and then says :

> *It has been found that with appropriate spring lightness and plunger size this dispenser will burst open upon impact with water even if it is not the plunger that hits the water first.*

24. The request does not say much about construction apart from paragraph 3.8 which (whilst in relation to D1) says :

> *In so far as claim 1 requires the dispenser to 'burst' open upon impact with water, this relates to the operation of the container from the patent opening upon impact with the water as opposed to sometime later on (eg once the container has reached the waterbed).*

25. The proprietor's observations include a number of dictionary definitions of 'burst'. They say that 'burst open' must mean more than just 'open' and that 'burst' needs to be give some significance. The proprietor further argues that:

> *Because the skilled man is aware of the need to dispense bait in a very short time to attract surface feeding fish, he will appreciate that bursting open means some sort of explosive opening to maximise the rate at which bait can exit the dispenser. Bursting open means that the bait is almost instantaneously freed from the expanding container members.*

26. The requestor's observations in reply state that the dictionary definitions could support a narrow or broad meaning to 'burst', but that the definition given by the patent is the important one. They argue burst must be construed to cover all the possibilities given in page 2 (specifically the parts of page 2 of the Patent I quote above).

27. I agree that the dictionary definitions of burst should not be given much weight as they are not directed to the context of the patent.

28. I consider the skilled reader will understand the patentee to have been using the term 'burst' to mean something between the suggestions put forward by the requester and proprietor. It does not mean simply 'opens upon impact' or 'unlatched/unlocked upon impact'. Neither does it mean an 'explosive opening' nor does it refer to the rate at which bait exit is maximised. Further, it does not mean that the contents of the container themselves are forced to rupture or break through the container, in the sense of a balloon bursting for example. As noted by the requestor, there is nothing in the patent about explosive opening. I also do not find anything about maximising bait exit, or the dispersion of the bait, nor of any specific timescales or speeds for opening or emptying the container of bait.

29. On the basis of what is disclosed in the patent, in particular the range of possible embodiments described including those on page 2 of the description, I believe that "burst open" should be construed as meaning that the dispenser is arranged so that it opens quickly and sufficiently to *allow* bait to be released and this opening is triggered at the time of impact.

Validity and Novelty

30. Section 1(1) of the Act reads:

> *1(1) A patent may be granted only for an invention in respect of the following conditions are satisfied, that is to say –*
> *(a) the invention is new;*

…

Section 2(2) and 2(3) of the Patents Act 1977 state:

> *(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.*
>
> *(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say -*
>
> *(a) that matter was contained in the application for that other patent both as filed and as published; and*
>
> *(b) the priority date of that matter is earlier than that of the invention.*

31. If the requestor's evidence of the state of the art provides enabling disclosure of the invention of claim 1, showing it is not new, then the Patent will be invalid.

Analysis of the prior art

32. Two prior art documents were raised by the requestor and I will consider what they disclose in turn and what the requestor and proprietor say about them. D1 and D2 were both published before the patent's earliest priority date. I will consider D2 before D1.

US 3,163,957 (D2) *(published 1965)*

33. D2 shows a bait casting device with a bait chamber that opens when the device lands on water. Figures 3 and 4 (reproduced below) show an embodiment of the device, closed and then open on the water The device has a door 14 connected to the main body 12 via a hinge 24 so that it can swing open once latch mechanism 16 is released. The door is helped to open by a spring 26, the description saying:

> *Door 14 may be biased toward the open position such as by means of a spring 26 which is compressed when the door 14 is in the closed position but which expands, as shown in FIGURE 2, when the door swings in the open position.*

I note the spring is also shown expanded in figure 4. The latch mechanism is shown in the latched closed state in figure 3, and in the unlatched state in figure 4 where pressure plate 36 has moved inwards, pivoting so that hook 34 moves away from latch bolt 38. The description further says:

> *Any pressure exerted against the pressure receiving portion 36 of the latch lever 30 pivots the hook portion 34 away from bolt 38 to release door 14 allowing spring 26 to push it open.*
>
> *…*

When the device 10 encounters the water at the end of an arched trajectory after being cast, the water exerts a force against the pressure receiving portion 36 of latch lever 30 pivoting it to release door 14.

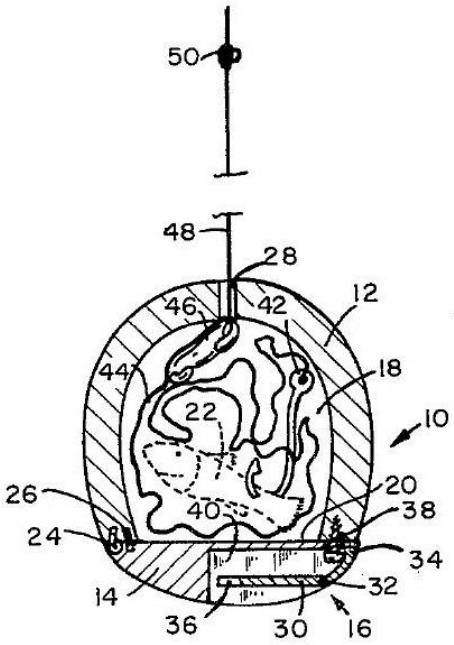


FIG. 3

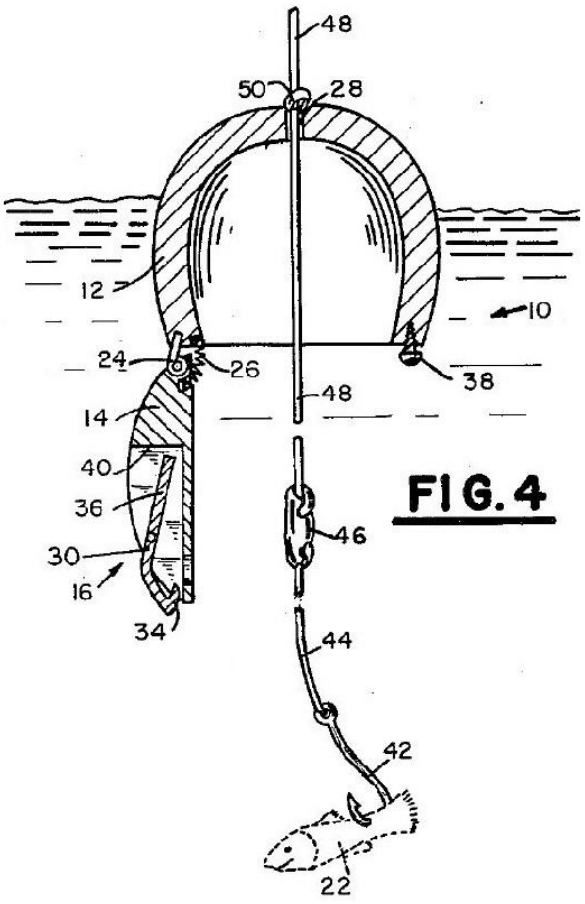


FIG. 4

34. The example given is casting bait comprising a minnow fish 22 on a hook 42 and line 44 with weight 46 all contained in the device; The description says:

> *As soon as the device hits the water and door 14 opens weight 46 will fall downwardly through the water by the force of gravity, pulling the minnow 22, hook 42, and leader 44 with it …*
>
> *…*
>
> *Throughout this description reference has been made to the utilization of the device for casting minnows. It is to be understood that the device is equally adaptable for casting other types of bait, such as blood bait and so forth, and that reference to its use to cast minnows is only by means of illustrating one facet of its use.*

35. The Proprietor argues that feature A of claim 1 is not disclosed because D2 is a 'bait protector' and not a bait dispenser. I am not persuaded by this argument and agree with the requestor that D2 does show a bait dispenser as claim 1 requires. The claim does not limit the type of bait nor does it exclude bait being retained by a line to the dispenser. I note in particular that a broadly similar arrangement of a baited hook is envisaged by the patent which says on page 3 :

> *Upon impact with the water the catch is released and the fins force the*

container open and the contents thereof spill out. The container is then withdrawn and detached from the line, to which the hook (which expression includes other fish catching devices) is attached ready for the line to be recast. However the container may be arranged to contain both the ground bait and the baited hook or hooks and may be arranged also to be buoyant, even to act as, or be attached to, a float.

I note also that figure 3 of the patent has a hook 45 assembly attached to the dispenser.

36. I agree with the requestor's argument that D2 discloses the features B to C of claim 1. The proprietor also concedes that these features are disclosed. The door and body of D2 do fall within the scope of *'a plurality of members hinged one to the other'* and the device clearly is *'attachable to a line at a proximal end'* given that a fishing line is shown passing through hole 28.

37. Considering feature D of claim 1, the parties agree D2 shows a means at a distal end that causes the device to open when it hits the water. What is disputed is whether D2 will 'burst open' as the claim requires, and in essence what meaning should be given to 'burst'.

38. The proprietor argues that the position of the door and hinge will inhibit bursting open as the door opens against the force of the water. They also argue that D2 does not use the word 'burst' or an equivalent word, and say that '*the spring depicted is hardly sufficient to drive the lid open'*. Further the proprietor says that if the door of D2 were to burst open *'the minnow would likely be swept off the hook which would obviate the whole purpose of the bait casting device'*. The proprietor argues that 'burst' has been construed too broadly by the requestor.

39. Looking at D2, it is clearly stated that a spring can drive the door open, and I believe the skilled addressee will expect this to occur relatively quickly. I also consider that the opening of D2 is likely aided, to some degree, by the weighted line. This release is not instantaneous, but I consider the claim does not require that.

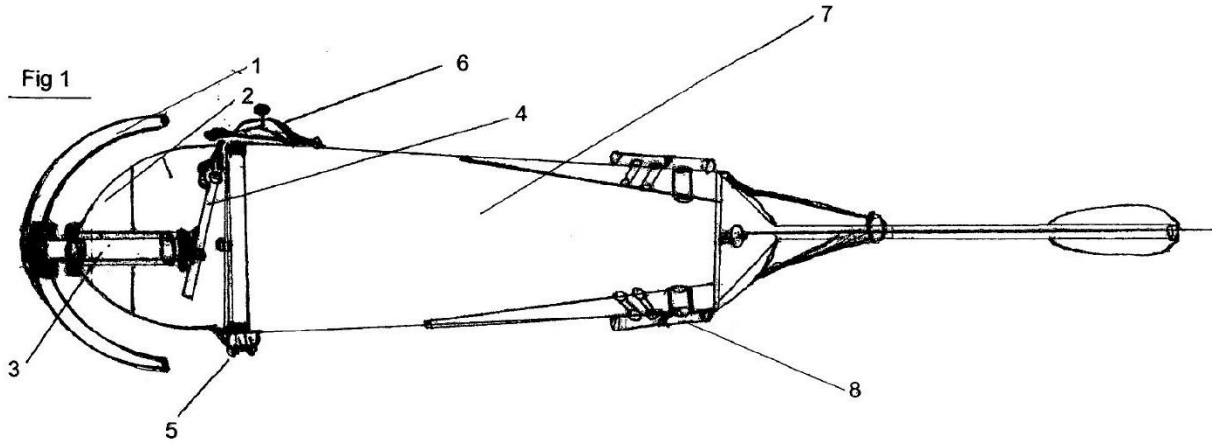
40. It is my opinion that the door of D2 commences to open when the container hits the water and will have opened sufficiently to allow bait to be released shortly thereafter. The timescale is sufficiently fast for D2 to be considered to 'burst open' given the construction I have explained above and thus D2 discloses feature D of claim 1.

41. I conclude that document D2 does provide an enabling disclosure of all the features of claim 1 and so claim 1 lacks novelty.

DE 20 2005 006500 U1 (D1) *(published 2006)* & translation **(E1)** *(no date given)*

42. D1 is a German language document, with a computer generated 'machine' translation E1 sourced by the requestor from the Espacenet website provided by the European Patent Office. The proprietor argues that the D1 document is not an enabling disclosure as there is too much ambiguity as to its function and construction; I will take care to consider this issue.

43. Figure 1 of D1 is reproduced below with a bait container 7 attached to a fishing line on the right side so it may be cast, and a means on the opposite left side that is expected to strike water. It is agreed that the figure shows the device closed.

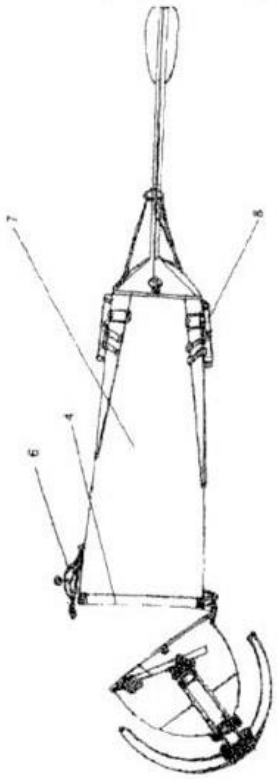


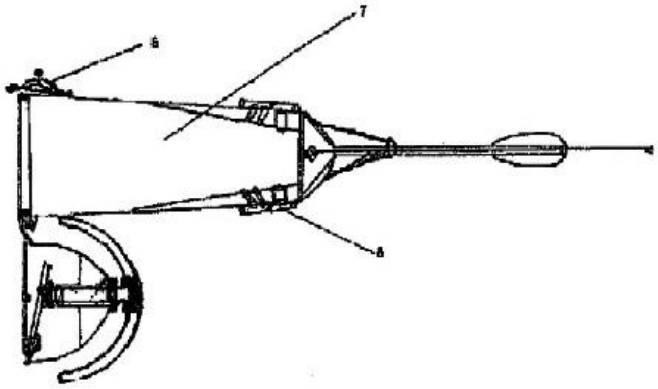
There is no drawing of the device in an open state. Looking at figure 1 and considering the machine translation of E1, it appears that part 1 is expected to impact water when cast and that it will move part 3 to cause part 4 to pivot and move latch assembly 6, seemingly into an unlatched state. Part 2 is a weighted end, translated as 'Hemispherical lead-filled attachment' by E1. Part 8 is translated as a 'bait rinsing system' by E1, (Köderspülungssystem is the term used, I note Google Translate defines the word 'Spülung' to include flush, rinse and irrigation). The parties broadly agree that the left part of the device (looking at figure 1) is likely to unlatch and thus causes a lid of container 7 to open. Although D1's description does refer to a lid, it does not say where a lid is nor what shape or size it might be, and no lid is specifically indicated in the drawings.

44. The function of the part labelled 5 is argued by the requestor to be a hinge such that the whole assembly next to part 7 rotates away, and causes a lid to open. The proprietor however argues that part 5 is merely 'articulated' and how it moves is not stated. They argue D1 does not specifically disclose a hinge nor is a single specific axis of rotation disclosed. Both parties seem to accept part 5 has a 190 degree movement but disagree as to how much movement will occur in use.

45. I reproduce below each party's own drawings of how they imagine the opened device might look if hinged. The proprietor calls their drawing 'speculative' and the requestor's drawing 'hypothetical'. Both have the same parts moving at the same 'hinge position', but through a different angle. The proprietor argues that as part 2 is weighted, the requestor's drawing is unrealistic. Instead, their drawing is meant to show how the front 'nose cone' part might hang if the device were in the, as shown,

vertical orientation. The proprietor's drawing is left (vertical) and the requester drawing is right (horizontal).





46. The skilled reader given D1 and E1 will understand that the device is cast to hit the water, submerge a distance and then return to the surface where it will eventually rest floating. When it hits the water, the part 1 does two things, it triggers the latch mechanism to release, and it's size effects how deep the device will submerge before returning to the surface. The 'rinsing' part 8 also does something when the device impacts, it is said to let water enter and pass though channels into the container 7 where it rinses out the contents of the container. I quote a portion from the translation document E1 (third paragraph on page 2):

> *The fall of the device on the water surface is vertical. As a result of the impact, the axle (1.3) penetrates through the tubular opening (1.2) and pushes the pin (1.4) inwards, as a result of which the shutter (1.6) opens and thus opens the lid. At the same time, the water penetrates into the bait-spooling system (1.8) and passes through channels into the bait container (1.7) where it rinses out the contents. The same happens without pressure in the opposite direction, so when the device is on its way to the surface.*

47. The proprietor also notes the above paragraph, saying for this bait rinsing function to work, the 'nose cone' must be submerged and thus the dispenser of D1 will thus open submerged. The drawings are ambiguous in showing how part 8 achieves this 'rinsing' function. The skilled reader of D1 will understand that bait will likely exit when the lid opens, but I do not think that it is disclosed if any bait exits part 8.

48. I concur with the requestor that D1 does disclose feature A of claim 1. There does not seem to be a counter-argument from the proprietor.

49. The requestor argues feature B of claim 1 is disclosed, as there is a hinged lid. The proprietor argues there is no enabling disclosure of this. On the balance of probabilities, I consider the skilled reader would conclude from D1 that a lid and hinge, arranged as the two parties have drawn above, is meant as this is the only reasonable way for the parts to be constructed. I conclude this because of the opposing position of parts 5 and 6 and how part 6 would work as a latch, as this implies a rotation axis, as drawn, is expected. I do not think the latch 6 suggests a different axis of rotation for the lid as the proprietor suggests is practicable. I consider D1 does disclose an arrangement as feature B of claim 1 requires.

50. I consider that feature C of claim 1 is disclosed. This is not disputed by either party.

51. The requestor argues that, because the device opens due to water impact, and then bait leaves the container, this is enough to be within the scope of 'burst upon impact' and so D1 discloses feature D of claim 1. The Proprietor however argues the lid opens slowly as it will be submerged and the described rinsing only occurs once the device is submerged. The lid thus does not open at the instant of impact, but sometime later. They argue this is not bursting open as feature D requires. They again note that the word burst or equivalent is not used in D1.

52. I consider that the device of D1 does open a latch of a lid upon impact with water, and that the distal end mechanism causes this. I also consider that, at some later time, the lid of the container does open and will be able to subsequently release bait.

53. However, what I cannot tell from the disclosure of D1 is what the timescale and the location in the water of the lid opening is likely to be. The skilled reader would understand that the unlatched device may well be submerged for a time before it will return to settle floating on the surface, but they are not told when, during this process, the lid should be expected to open. It seems equally conceivable either that the lid may open shortly after impact to release bait, or that it may remain unlatched but still substantially closed, only opening to release bait sometime later. I do not think the described rinsing / flushing helps to decide this. It is difficult to tell from D1 if the impact force of the water will tend to open the lid or tend to, at least temporarily whist the lid remains unlatched, keep it closed. It is not said nor illustrated in D1 what the expected arrangement of parts and orientation of the device is when it is finally floating. Considering the weighted part 2, the skilled reader is not told what the function of this is. They are not, for example, told that this weight somehow aids in opening the lid (as either side of the hinge might have different buoyancy) such as figure 3 of the Patent shows.

54. Ultimately, it is unclear what the speed of opening of the device of D1 might be and thus I cannot conclude if it is quick as I have construed the phrase "burst open". Hence I am unable to form an opinion of whether D1 demonstrates a lack of novelty.

55. In relation to the proprietor's arguments about lack of an enabling disclosure of D1, I think the skilled reader is enabled to make something approaching the embodiment shown in the figures of D1, despite the issues of the lid, the hinge and what the drawings show of part 8. They would be able to provide a lid, hinge and the described latch mechanism. As far as part 8 goes, they are told that there need to be channels to aid rinsing of bait and they would be able to work that concept at least. I conclude that the skilled reader would be able to make something broadly as

D1 shows.

Opinion

56. It is my opinion that US 3,163,957 provides an enabling disclosure, before the priority date of the patent, of all the features of claim 1 and these will function, in use, as the claim requires. Thus claim 1 lacks novelty.

57. I am unable to come to an opinion of whether DE 20 2005 006500 U1 does disclose all of the features of claim 1 or not. This is because it is unclear if the device will function, in use, as the claim requires.

58. Thus, in my opinion, claim 1 is invalid for lack of novelty.

Application for review

59. 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.

Gareth Lewis
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.