#### **OPINION UNDER SECTION 74A**

Patent	EP(UK) 2019796 B1
Proprietor(s)	DOT-IT Restaurant Fulfillment, LLC
Exclusive Licensee	
Requester	DOT-IT Restaurant Fulfillment, LLC
Observer(s)	Direct Independent Imports Ltd T/A Direct Imports UK
Date Opinion issued	13 February 2020

### The Request

- 1. The comptroller has been requested by DOT-IT Restaurant Fulfillment, LLC ("the requester") to issue an opinion as to whether their patent EP(UK) 2019796 B1 ("the patent") is infringed under section 60 of the Patents Act 1977 ("the Act") by making, disposing of, offering to dispose of, using or importing of the product as shown in Annex 3 of the request.
- 2. The request was received from the requester's representative, Barker Brettell LLP, on 29 November 2019. It was accompanied by a statement explaining the request, copies of the supporting documents below, as well as a sample of the alleged infringing product shown in Annex 3.
  - **Annex 1:** Images of a label dispenser sold by licensee of the patent
  - **Annex 2:** Images of a product made available by at least some of the alleged infringers
  - **Annex 3:** Images of the allegedly infringing product
  - **Annex 4:** Screen grab of a webpage of the alleged infringing product (29 November 2019)

#### **Observations**

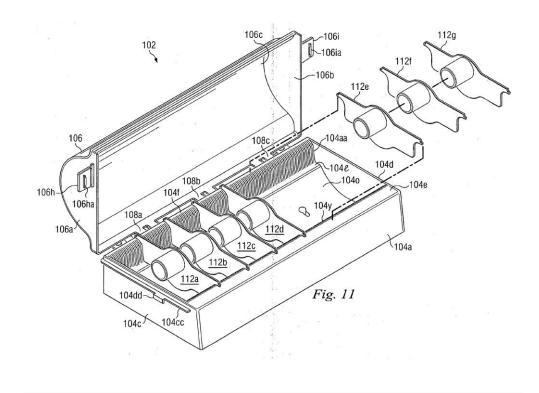
3. Observations were received from the observer's representative, Swindell & Pearson Ltd, on 20 December 2019.

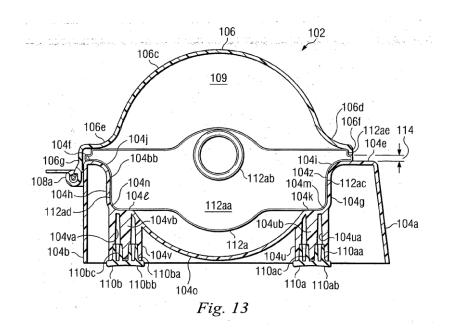
# **Observations in reply**

4. Observations in reply were submitted by the requester's representative on 15 January 2020.

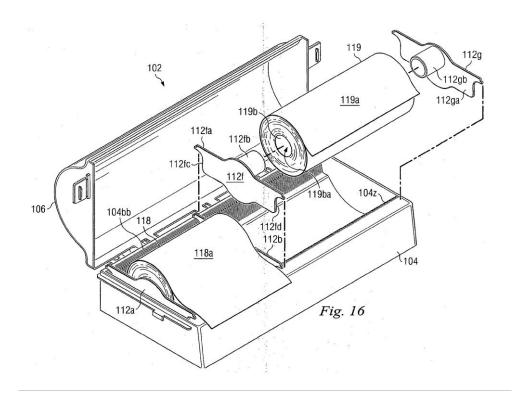
### The Patent

- 5. The Patent entitled "Container for dispensing material from a roll" was filed on 17 May 2007 and was granted on 10 August 2016. The patent remains in force in the United Kingdom.
- 6. The patent relates to a container for storing and dispensing material from a roll comprising a core. Figures 11 and 13, reproduced below, depict an embodiment of the claimed invention. The container 102 comprises: a base (104); a lid (106) coupled to the base (104) which defines a cavity (109) when the container (102) is closed; and at least one divider (112a-g) removably engaged with the base (104).



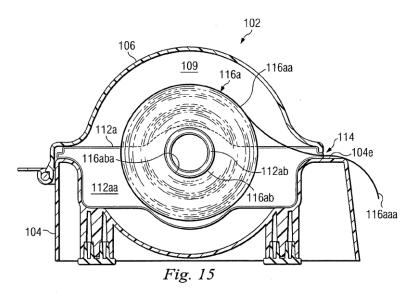


7. The divider (112a-g) comprises a wall having a first edge (112ac) and a second edge (112ad), which are removably engaged with corresponding facing grooves (104z) and (104bb) on the base (104), respectively. The patent explains that because the divider is removably engaged within grooves, the divider can be removed by simply pulling it out. Thus, when a roll of material needs to be replaced or refilled, the divider holding that roll can be removed and the roll replaced, without the need to remove any other rolls held in the container. In addition, the divider can be positioned within any pair of corresponding grooves and thus the container (102) can be configured to accommodate rolls in a variety of sizes as shown in figure 16.



8. As shown in figure 15 reproduced below, the divider (112a-g) may further comprise

at least one spindle (112ab) extending from the wall (112aa) and adapted to extend in the internal passage defined by the core (116ab) of a roll (116a-g). The patent explains that dispensing material from a roll can cause the core of the roll to migrate or move such that the material dispensed from one roll is dispensed along a path that intersects with the path of material being dispensed from another roll held in the container thereby causing the material to jam. In circumstances where a roll is used the spindle reduces the potential for such jamming by holding the respective roll in place. In other examples the patent contemplates that the divider does not need to have a spindle, for example, where the roll comprises material wound around a core with supporting sides, such as a spool. In this example a spool may be placed in the container and the supporting sides on the spool would serve to keep the roll from shifting forward inside the container, generally achieving the same result as the spindle achieves for rolls without supporting sides.



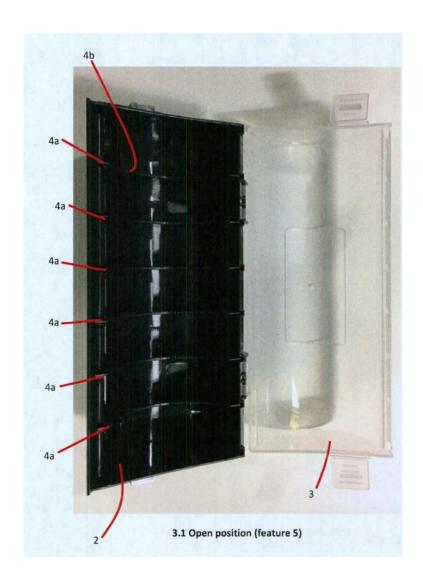
- 9. In use the material is dispensed through a gap (114) provided between the base (104) and lid (106) when the container (102) is in a closed position. The divider (112a-g) contacts the lid (106) such that the contact between the divider (112a-g) and the lid (106) resists any sliding of the material over the divider as the material is being dispensed from the container, thus preventing material being dispensed from one roll interfering and becoming intertwined with material being dispensed from an adjacent roll.
- 10. The patent has five claims, including one independent claim, claim 1.
- 11. Claim 1 reads as follows with the features separated out using the notation as provided by the requester:

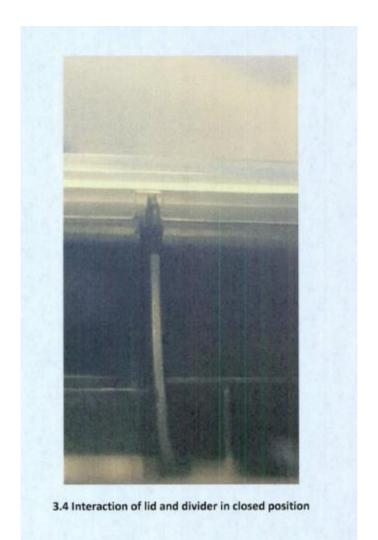
(1)	A container (102) for dispensing material from a roll (116a-g) comprising a core (116ab) defining an internal passage (116aba), the container (10) comprising:
(2)	a base (104);

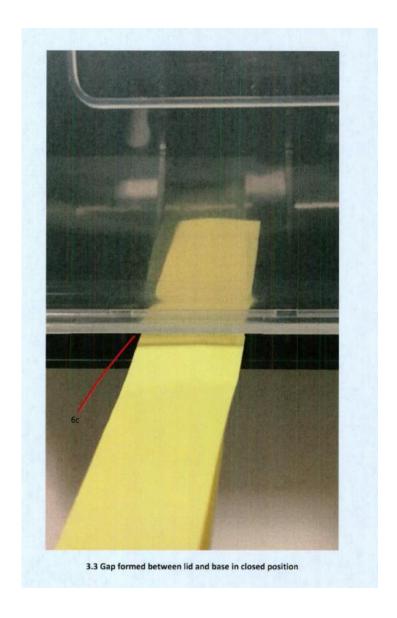
(3)	a lid (106) coupled to the base (104); and
(4a)	at least one divider (112a-g) removably engaged with the base (104), the divider (112a-g) comprising:
(4b)	a wall (112aa); and
(4c)	at least one spindle (112ab) extending from the wall (112aa) and adapted to extend in the internal passage (116aba) defined by the core (116ab) of the roll (116ag)
	characterized by the container (102) having:
(5)	an open position; and
(6a)	a closed position in which:
(6b)	a cavity (109) is defined by the base (104) and the lid (106);
(6c)	a gap (114) is defined between the lid (106) and the base (104), wherein the material is adapted to be dispensed from the roll (116a-g) through the gap (114); and
(6d)	the divider (112a-g) contacts the lid (106), wherein the contact between the divider (112a-g) and the lid (106) is adapted to resist any sliding of the material over the divider (112a-g)

# **The Alleged Infringing Product**

12. Whilst the photographs of the alleged infringing product provided in Annex 3 of the request and shown below have not been reproduced well I have had the benefit of a sample of the alleged infringing product which I have examined thoroughly. The alleged infringing product shows a container comprising a base 2 and a lid 3 having a plurality of fixed dividers 4a each of which hold a roll of a material, such as a roll of tape. The material is dispensed through a gap 6c formed between the lid 3 and base 2.







# Infringement

- 13. Section 60 of the Act governs what constitutes infringement of a patent:
  - (1) Subject to the provisions 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) ...
    - (c) ...
  - (2) 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 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.

- 14. In the Supreme Court in *Actavis v Eli Lilly*<sup>1</sup>, Lord Neuberger stated that the problem of infringement is best approached by addressing two issues, each of which is to be considered through the eyes of the notional addressee of the patent in suit, i.e. the person skilled in the relevant art. Those issues are:
  - (i) does the variant infringe any of the claims as a matter of normal interpretation; and, if not,
  - (ii) does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial?
- 15. If the answer is "yes", there is infringement; otherwise there is not.

### Claim construction

- 16. Before I can determine whether there would be infringement of the claims of the patent I must first construe them. This means interpreting the claims in light of the description and drawings as instructed by section 125(1). In doing so, I must interpret the claims in context through the eyes of the person skilled in the art. Ultimately, the question is what the person skilled in the art would have understood the patentee to be using the language of the claims to mean. This approach has been confirmed in the recent decisions of the High Court in *Mylan v Yeda*<sup>2</sup> and the Court of Appeal in *Actavis v ICOS*<sup>3</sup>.
- 17. 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.

- 18. Neither the requester nor the observer has submitted a definition of the person skilled in the art.
- 19. In my view the person skilled in the art is a product designer of material dispensers for storing and dispensing a material wound around a core.
- 20. Aside from the general comment by the requester that the construction of the

<sup>&</sup>lt;sup>1</sup> Actavis UK Limited and Others v Eli Lilly and Company [2017] UKSC 48

<sup>&</sup>lt;sup>2</sup> Generics UK Ltd (t/a Mylan) v Yeda Research and Dev. Co. Ltd & Anor [2017] EWHC 2629 (Pat)

<sup>&</sup>lt;sup>3</sup> Actavis Group & Ors v ICOS & Eli Lilly & Co. [2017] EWCA Civ 1671

features of claim 1 is generally straightforward, neither the requester nor the observer have made any specific comments in relation to the construction of the claims or how they should be interpreted.

- 21. I agree with the requester that claim 1 is generally clear and straightforward to construe however there are some points that I believe are worthy of consideration.
- 22. Point 4d above of claim 1 defines "at least one divider (112a-g) removably engaged with the base (104)". Paragraph [0023] of the patent states "Because the divider is removably engaged within grooves 42, 44, the divider 54 can be removed from the cavity 18 by simply pulling it out" and paragraph [0024] states "the divider 54 can be positioned within any pair of corresponding grooves 42 and 44 within cavity 18, and therefore the container 10 can be configured to store rolls in a variety of sizes". Figures 3, 5, 11, 14 and 16 show how the dividers can placed within any of the corresponding grooves depending on the size of roll used.
- 23. In view of the teaching of the patent I consider that the person skilled in the art would construe the wording "at least one divider (112a-g) removably engaged with the base (104)" to mean that the/each divider can be positioned within any of the multiple positions within the base such that the position of the divider is not fixed.
- 24. Point 6d above of claim 1 defines "the divider (112a-g) contacts the lid (106), wherein the contact between the divider (112a-g) and the lid (106) is adapted to resist any sliding of the material over the divider (112a-g)". Paragraph [0026] of the patent states "The top edge 70 [of the divider] is proximate or in contact with at least a portion of the top member lip 22 [of the lid] proximal to the terminal edge 23 of the lip 22. In several examples, the top edge 70 may be proximate or in contact with the terminal edge 23, and/or the lip 22". The contact between the divider and lid is further depicted in figures 4a and 4b, which show the divider and lid being proximate to one another, and figures 13 and 15 which show the divider and lid being in direct physical contact to one another.
- 25. Therefore, I consider that the person skilled in the art would construe the term "contact" to mean that the divider and lid are configured, either by direct contact or by being proximate to one another, to resist sliding of material over the divider.

# Does the container as depicted in Annex 3 infringe as a matter of normal interpretation?

- 26. I shall start by considering whether the container as shown in Annex 3 would infringe the patent by making, disposing of, offering to dispose of, using or importing, as a matter or normal interpretation.
- 27. Both the requester and observer appear to be in agreement that the container as shown in Annex 3 does not infringe the patent as a matter of normal interpretation of the claims.
- 28. The container as defined in claim 1 of the patent differs from the container as shown in Annex 3 in that:

- (a) Claim 1 requires that the at least one divider (112a-g) is removably engaged with the base (104) (feature 4a), whereas the dividers of the container of Annex 3 are fixed:
- (b) Claim 1 requires that the divider comprises at least one spindle extending from the wall (112aa) which is adapted to extend into the internal passages defined by the core (116ab) of the roll (116ag) (feature 4c), whereas the dividers of the container of Annex 3 do not comprise a spindle on the wall of the divider; and
- (c) Claim 1 requires that the divider (112a-g) contacts the lid (106), wherein the contact between the divider (112a-g) and the lid (106) is adapted to resist any sliding of the material over the divider (112a-g), whereas the dividers of the container of Annex 3 are spaced from the lid when the lid is in the closed position.
- 29. I am satisfied that as a matter of normal interpretation the container, as shown in Annex 3, does not comprise features 4a, 4c and 6d as defined in claim 1 of the patent. Therefore, in my opinion, the container as shown in Annex 3 does not infringe claim 1 of the patent as a matter of normal interpretation in accordance with section 60(1)(a) of the Act.

# Does the container as shown in Annex 3 infringe because it varies from the invention in a way or ways which is or are immaterial?

- 30. In *Actavis v Eli Lilly*<sup>1</sup>, the Court provided a reformulation of the three questions in *Improver*<sup>4</sup> to provide assistance in determining whether a variant infringes. These reformulated questions are:
  - (i) Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e. the inventive concept revealed by the patent?
  - (ii) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing the variant achieves substantially the same result as the invention, that it does so substantially the same way as the invention?
  - (iii) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?
- 31. To establish infringement in a case where there is no literal infringement, a patentee would have to establish that the answer to the first two question is "yes" and that the answer to the third question is "no".

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<sup>&</sup>lt;sup>4</sup> Improver Corporation v Remington Consumer Products Ltd [1990] FSR 181

- 32. As I have discussed above I consider that the container as shown in Annex 3 differs from the container as defined in claim 1 of the patent in that (a) the dividers are fixed; (b) the dividers do not include a spindle on the wall of the divider; and (c) the dividers are spaced from the lid in a closed position. To ascertain whether the container as depicted in Annex 3 would infringe the patent I must determine whether these differences (a)-(c) (variants) are immaterial using the reformulated questions (i)-(iii) provided in *Actavis v Eli Lilly*<sup>1</sup> for guidance.
- 33. In answering question (i) I must consider the inventive concept revealed by the patent. I will therefore begin by determining the inventive concept of the patent.
- 34. The requester submits that the inventive concept resides in "...providing a tape dispensing container where the tape is dispensed through a gap between the base and the lid, but where the gap is divided to prevent lateral sliding of material in the gap. As a result of this, the separate materials do not cross over or become entangled".
- 35. In their consideration of the inventive concept the requester asserts that "Claim 1 further requires that the interaction of the dividers and lid is "adapted to resist any sliding of the material over the divider".
- 36. The observer disagrees with the requester's comment arguing that "claim 1 does not require, refer nor recite "the interaction of the dividers and lid" being so adapted" as suggested by the requester, instead the observer considers that "claim 1 recites that "the contact between the divider and the lid is adapted to resist any sliding of the material over the divider". The observer further asserts that "claim 1 does not recite nor refer to the generic provision of "means adapted to resist any sliding of the material over the divider" (i.e. it does not broadly claim/cover any such means), but, instead, the claim specifically recited (in the characterising portion of the claim no less) a particular structural configuration to resist sliding of the material over the divider, namely "the divider (112a-g) contacts the lid (106), wherein the contact between the divider (112a-g) and the lid (106) is adapted to resist any sliding of the material over the divider (112a-g)"".
- 37. I agree with the observer on this point. In my opinion the patent does not provide any other means of preventing sliding of the material over the divider other than by means of the contact between the divider and lid. I shall return to the significance of this when I reach my own conclusions on the nature of the inventive concept.
- 38. The observer submits that the inventive concept resides in "...a container for dispensing material from a roll comprising a core, the provision of: a spindle 112ab of a [removable] divider 112a, and contact between the divider and lid of the container, wherein the contact between the lid and the divider is adapted to resist any sliding of the material over the divider".
- 39. The requester argues that "when dealing with the Actavis questions for each variant, the interested party appears to be suggesting that each and every feature of the claim (or at least each and every feature that is not found under the literal interpretation) forms part of the inventive concept. However, in doing this, the interested party appears to have taken the description of the function of a feature and argued that this must form part of the inventive concept, rather than considering

the contribution of the invention as a whole. Instead, the overall contribution of the invention should be considered". I have some sympathy with the requester on this point.

40. In *Generics v Lundbeck*<sup>5</sup>, as referred to by the requester, Lord Walker explained that there is a difference between the "inventive concept" of a claimed invention and its "technical contribution to the art". He stated at paragraph 30:

""Inventive concept" is concerned with the identification of the core (or kernel, or essence) of the invention – the idea or principle, of more or less general application (see Kirin-Amgen [2005] RPC 169 paras 112-113) which entitles the inventor's achievement to be called inventive. The invention's technical contribution to the art is concerned with the evaluation of its inventive concept – how far forward has it carried the state of the art? The inventive concept and the technical contribution may command equal respect but that will not always be the case"

- 41. The first stage in identifying the inventive concept of a claim involves a purposive construction of the claim what does it mean to the person skilled in the art? It is the essence of the claim that should be identified when considering the inventive concept.
- 42. The requester argues that "the divider is only related to the inventive concept in how it divides the cavity and the gap between the lid and base. Therefore, the claim language related to variants 1 and 2 can be treated, essentially, as struck out" citing the case of Marflow v Cassellie<sup>6</sup>, and asserts "Therefore, by emphasising the "core of the inventive concept or core of the invention", the case law in this area does indeed suggest that claim language which did not appear to make a difference to the inventive concept may in some cases be treated, essentially, as struck out". However, I do not entirely agree with the requester's comments on this point of law. It would appear to me that the requester in fact meant to refer to HHJ Hacon's other recent infringement case Regen v Estar.
- 43. In *Regan v Estar*<sup>7</sup> HHJ Hacon observed that, before *Actavis*, purposive construction did not mean:

"that an integer can be treated as struck out if it does not appear to make any difference to the inventive concept. It may have some other purpose buried in the prior art and even if this is not discernible, the patentee may have had some reason of his for introducing it" [paragraph 219 quoting Step v Emson<sup>8</sup>]

44. HHJ Hacon further noted however that the judgement of *Actavis* revealed a significant change:

"First, although "the language of the claim" is important, consideration of the third question certainly does not exclude the specification of the patent and

<sup>7</sup> Regen Lab SA v Estar Medical Ltd [2019] EWHC 63 (Pat), [2019] RPC 7

<sup>&</sup>lt;sup>5</sup> Generics (UK) Limited and others v H Lundbeck A/S [2009] UKHL, [2009] RPC 13

<sup>&</sup>lt;sup>6</sup> Marflow Engineering Ltd v Cassellie Ltd [2019] EWHC 410

<sup>&</sup>lt;sup>8</sup> Société Technique de Pulverisation Step v Emson Europe Ltd [1993] RPC 513 at p.522

all the knowledge and expertise which the notional addressee is assumed to have. Secondly, the fact that the language of the claim does not on any sensible reading cover the variant is certainly not enough to justify holding that the patentee does not satisfy the third question....Thirdly, when considering the third question, it is appropriate to ask whether the component at issue is an "essential" part of the invention, but that is not the same thing as asking if it is an "essential" part of the overall product or process of which the inventive concept is part"

45. HHJ Hacon, as confirmed in *Icescape*<sup>9</sup>, observed that the focus should no longer be on claim language, but should be directed to the inventive concept of the claim:

"This mirrors a similar shift in the application of Improver question 1, which as revised concerns whether the inventive concept is exploited in substantially the same way to achieve substantially the same result, no longer whether the variant has a material effect on the way the invention as a whole works"

46. HHJ Hacon considered the inventive concept or core of the invention to be:

"the new technical insight conveyed by the invention – the clever bit – as would be perceived by the skilled person. This will be assessed by reference to the specification and the evidence"

47. In relation to the third revised *Improver* question and *Step*<sup>8</sup> HHJ Hacon noted that:

"now, as before Actavis, it is not legitimate just to disregard an integer of a claim without further reasoning"

48. And:

"The third Improver question requires the court to consider whether the relevant integer, that corresponding to the alleged equivalent, would have been regarded by the skilled person as an essential part of the inventive concept"

49. This issue was considered in *Marflow v Cassellie*<sup>6</sup> where the claim required the feature "the body of the mounting member providing in or thereon, a locking member" and was treated as a non-essential feature because:

"The specification contemplated the possibility of other locking means. Any suitable locking means known to the person skilled person would have been treated as an alternative way of implementing the locking part of the inventive concept, but no particular locking means would have been seen as part of the inventive concept" [paragraph 62]

50. In assessing the inventive concept, I must therefore decide what features would be regarded by the person skilled in the art to be an essential part of the invention and thus form part of the inventive concept.

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<sup>&</sup>lt;sup>9</sup> Icescape Limited v Ice-World International BV & Ors. [2018] EWCA Civ 2219

### Is the spindle essential?

51. The requester argues "it is noted that the patent does contemplate embodiments without a spindle (see [0021])". I agree with the requester. Whilst the main teaching of the patent is directed to the divider wall comprising a spindle, paragraph [0021] nonetheless states "In another example of the container 10, the divider 54 does not have an axle 56. Such an example would be particularly useful with rolls comprising material wound on a core with supporting sides, such as a spool. For example, a spool of ribbon may be placed in a container such as the container 10, and the supporting sides on the spool would serve to keep the roll from shifting forward inside the container, generally achieving the same result that the axle 56 achieves for rolls without supporting sides". In view of this paragraph the person skilled in the art would consider that there are instances where the spindle is not necessary and thus in my opinion the person skilled in the art would not consider the provision of a spindle on the divider wall to be an essential feature of the invention.

### Is the divider removably engaged with the base essential?

52. I can find no teaching in the patent which suggests that the dividers may have an alternative configuration with the base aside from being removable. Whilst I note that paragraphs [0004] and [0005] of the patent discuss the at least one divider without also referring to it being removably engaged with the base, these paragraphs equally do not suggest that the divider is fixed or may have nay other configuration. Moreover, the requester has not presented me with any arguments or evidence which clearly indicates that the person skilled in the art would not consider the feature of at least one divider removably engaged with the base to be essential.

# The inventive concept

- 53. I note that paragraph [0024] states "In addition, the divider 54 can be positioned within any pair of corresponding grooves 42 and 44 within the cavity 18, and therefore container 10 can be configured to store rolls in a variety of sizes" and paragraph [0028] states "in addition the extension of ridges 51a, 51b and the projection 60 over at least a portion of the shelf 46, and the spanning front faces 55a and 55b, and the facing edge 74 between the shelf 46 and the lip 22, prevent material from being dispensed through the gap 50 in an area other than the portal". Based on the teaching of the patent it would seem to me that the key advantage is ensuring that regardless of where the divider is mounted within the container the material of a roll is prevented from interfering with material of an adjacent roll when it is dispensed through a gap between the base and lid.
- 54. The requester argues that "As appears to have been substantially agreed by both parties, the inventive concept of the patent relates to preventing jamming of rolls of material. It is the presence of the sidewalls that achieves this function. Whether or not they are removable has no bearing on whether they are able to prevent jamming". However, owing to the nature of the interaction between the divider and the lid which defines the gap through which material is dispensed and which brings about the resistance of movement of material over the divider I do not believe that this allows me to define the inventive concept "revealed" by the patent as being the

broad concept as suggested by the requester.

55. In my opinion the inventive concept "revealed" by the patent resides in a container having a base, a lid, and at least one divider removably engaged with the base, a gap being defined between the lid and the base to dispense material therethrough, and wherein the divider contacts the lid, such that the contact is adapted to resist any sliding of the material over the divider.

# Question (i)

- 56. I will now consider question (i) as set out in *Actavis v Eli Lilly*<sup>1</sup>. As I have discussed above the alleged infringing product of Annex 3 differs from the container as defined in claim 1 of the patent in that (a) the dividers are fixed; (b) the dividers do not include a spindle on the wall of the divider; and (c) the dividers are spaced from the lid in a closed position. There are therefore three variants I must consider.
- 57. In *Regen v Estar*<sup>7</sup>, HHJ Hacon considered whether multiple differences should be assessed separately, or taken together:

"Particularly if there is some interaction between the relevant elements of a claim, the answers to the revised Improver questions could lead to one result if the equivalents are considered separately and the opposite result if considered together. In my view only the later result is relevant. The question is whether the accused product or process is a variant falling within the scope of the claim taking all equivalents into account. Of course, it will often be convenient to consider equivalents one by one, but there must be a single overall answer in relation to each accused product or process"

- 58. Thus, my reading of this follows that whilst the equivalents may be considered separately in reaching my answer to question (i) the differences should be considered together given that the question is whether an alleged infringing product or process as a whole is a variant of the claimed invention.
- 59. In their analysis of question (i) the requester considers variant a (fixed divider) and variant b (no spindle) together and submits that "Omitting the spindle and having fixed dividers still achieves the same result in the same way. The gap between the lid and the base is still divided and so the material dispensed is still prevented from crossing over and tangling".
- 60. With respect to variant a the observer argues that as disclosed in paragraph [0062] of the patent "the provision of a divider removably engaged with the base gives rise to the result that "the container 102 may be configured to hold a wide variety of rolls of material having a wide variety of sizes by, for example, adding additional dividers to hold smaller-sized rolls of material, and/or removing dividers in order to hold larger sized rolls of material". Thus, clearly, variant a (i.e. the provision of a divider that is fixed/integral to the base) does not achieve such a result".
- 61. With respect to variant a I do not consider that the fixed divider of the alleged infringing product achieves the advantages and thus the result of the inventive concept revealed by the patent. I consider that the flexibility of the dividers being

removably engaged with the base not only allows the position of the divider to be varied to accommodate different sized rolls of material, but also, more importantly, jamming and interference between adjacent rolls is still prevented regardless of where the divider is positioned in the base. In this respect the lid does not have to be altered or reconfigured to account for any changes in position of the divider. Regardless of where the divider is placed in the container the lid will still contact it such that any sliding of material over the divider is prevented. This flexibility is not a result which is achieved by variant a.

- 62. With respect to variant b the observer argues that "the result achieved by the provision of an axle/spindle as per claimed feature (4c) of the invention is to reduce the potential for jamming and/or interference of a roll with an adjacent roll...The variant b., which does not comprise a spindle in the divider (indeed the alleged infringing product does not even provide a spindle at all) clearly does not achieve substantially the same result as the inventive concept revealed by the Patent (i.e. relating to the provision of a spindle for holding the roll in place to reduce the potential for jamming, and/or interference)".
- 63. The requester argues that "The use of the spindle has no bearing on preventing the cross-over of material from different rolls. Thus, this language can essentially be considered struck out. Notwithstanding this, the inventive concept discussed above (preventing cross-over of material) is achieved in the same way".
- 64. I note paragraph [0021] of the patent states that "In another embodiment of the container 10, the divider 54 does not have an axle 56... For example, a spool or ribbon may be placed in a container such as the container 10 and the supporting sides on the spool would serve to keep the roll from shifting forward inside the container, generally achieving the same result that the axle 56 achieves for rolls without supporting sides".
- 65. In Marflow v Cassellie<sup>6</sup> HHJ Hacon raised the question:

"Whether an advantage consequent upon the use of an inventive concept is invariably a "result" achieved by the inventive concept as contemplated by Lord Neuberger, in particular at paragraph 66(i) and (ii), and if so whether the variant must achieve all the advantages of the inventive concept in substantial part" [paragraph 69]

- 66. My reading of this follows that if a feature does not form part of the inventive concept then that feature does not need to possess all of the advantages associated with the inventive concept.
- 67. Therefore, whilst some advantages of the spindle arrangement are not realised in variant b, I believe that those advantages are not primarily concerned with the prevention of interference between adjacent rolls. Therefore, I consider that the skilled worker would realise that the use of a spool with a plain divider would achieve the same effect as a spindle plus a roll.
- 68. With respect to variant c the requester submits that "As shown in Figure 3.4 of the Annexes, the spacing from the lid to the dividing wall is relatively small and relatively far spaced from the gap (when considered relatively to the height of the gap/width of

- material). Therefore, the interaction of the lid and the divider is still sufficient to prevent sliding of material over the divider" and concludes that the answer to question (i) is "yes".
- 69. The observer argues that "The result to be achieved by claimed feature (6d) is to reduce potential for a roll to jam and/or interfere with an adjacent roll. The way in which this achieved in the inventive concept is via the provision of a divider which contacts the lid in a closed position and wherein such contact between the divider and lid is adapted to resist sliding of material over the divider, i.e. since there is direct physical contact between the divider and lid, the material cannot slide between the divider and the lid. By contrast, in variant c, there is no such contact between the divider and lid in the closed position, and therefore, there the variant does not achieve substantially the same result in substantially the same way as the claimed feature of the inventive concept".
- 70. I do not agree with the observer's argument that the inventive concept requires that the divider and lid are in "direct physical contact". As I have discussed above the person skilled in the art would understand the term "contact" in claim 1 to mean that the divider and lid are configured, either by direct contact or by being proximate to one another, to resist sliding of material over the divider.
- 71. The observer argues that even if variant c provides a similar result to the inventive concept, i.e. reduces jamming/interference, it does not so in a "substantially similar way".
- 72. Using a schematic representation shown in Figure 1 below, the observer asserts that "the Patent's inventive concept provides contact (one of the contact points being shown via the arrow) between a portion of the divider (shown in grey, resting on the base shown in black) and the edge of the lid (shown via the blue line) which prevents material to be dispensed (shown in yellow) sliding over the divider between the divider and the lid".

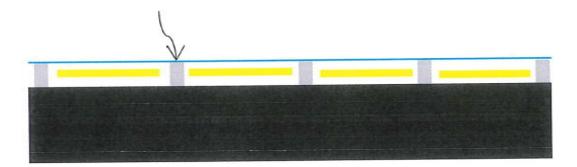


Figure 1

73. By contrast the observer argues that "in the alleged infringing device [Figure 2 below], it is not direct physical contact between the lid and the divider that resists sliding of the material over the divider (indeed there is no such contact). Significantly, the resisting of sliding of the material is achieved via a different way. In particular, the lid (shown in blue) is configured to be provided with portions (i.e. the teeth like/tab portions) that extend into the gaps between the portions of the dividers (such

portions of the dividers being shown in black as they are integral/fixed to the base which is also in black). Such tab/teeth like portions of the lid thereby urge the material to be dispensed (shown in yellow) down towards the base. Hence any sliding of the material in a direction generally transverse to the dispensing direction is resisted by a lower portion of a side facing wall of the device (as shown by the arrow)".

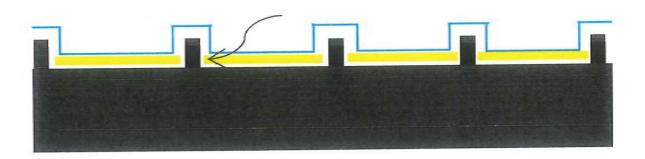


Figure 2

- 74. The observer submits that "In the inventive concept revealed by the Patent, the sliding of material over a divider is resisted by virtue of the contact between the divider and the lid. By contrast, in the alleged infringing product the lid is provided with tab-like portion/teeth that, when the lid is closed, are received between the ends of the fixed divider thereby pushing down the material to be dispensed from each slot defined by: each tab-like extension, the side-facing walls of a portion of the integral divider, and an upper surface of the base/shelf portion" and thus concludes that the answer to question (i) is "no".
- 75. The requester argues that "In discussing variant c, the interested party has suggested that the result of the inventive concept is achieved by virtue of the contact between the lid and dividers" and asserts that "the result of the invention is achieved not by the contact, but by virtue of the gap between the lid and base being split into separate parts". However, I do not agree with the requester's argument. As discussed above, I can find no teaching in the patent which indicates that the result, i.e. to prevent sliding of the material over the divider such that the material does not interfere with material being dispensed from an adjacent roll, is achieved by virtue of the gap between the lid and base being split into separate parts. The patent clearly teaches that the material is prevented from sliding over the divider by virtue of the contact between the divider and the lid.
- 76. The requester makes reference to the observer's comment "Hence, any sliding of the material in a direction transverse to the dispensing direction is restricted by a lower portion of a side facing wall of the device (as shown by the arrow) [figure 2 of the observation]" and concludes that "This is exactly the same way as the claimed invention works. Referring to figure 1 [of the observations]...it is clear that sliding will be prevented by the wall of the device. The Interested Party have alleged that it is the direct contact between the lid and the divider that prevents sliding. However, they have failed to explain why this is. It is, instead, clear that as described by the Interested Party in relation to figure 2, any sliding of the material in a direction is resisted by a lower portion of a side facing wall of the device". However, I do not

agree with the requester's argument. Whilst I accept that the wall of the divider does to some extent prevent lateral movement of material, it is the contact between the lid and divider which prevents sliding of material over the divider thus preventing interference with an adjacent roll.

- 77. As pointed out by the observer and shown in the schematic representation of the alleged infringing product in Figure 2, the lid is shaped so that its edge extends downwardly towards the base, into the area defined between each divider, to create a gap through which material is dispersed and is configured so that the maximum height of the gap is below the maximum height of the divider. This mating arrangement of the lid and divider effectively "clamps" the material in place thereby preventing movement of material over the gap. Thus, the lid and the divider of the alleged infringing product do not have to be in direct contact or proximate to one another to prevent sliding movement of material over the divider. As evidenced by the sample provided with the request there is a noticeable gap between the lid and divider. This is in contrast with the lid and divider of the claimed invention which requires the lid and divider to be in direct contact or proximate to one another to prevent movement of material over the divider.
- 78. Furthermore, I consider that owing to the mating arrangement of the lid and the dividers the alleged infringing product requires that the dividers are located at predetermined fixed positions within the base which correspond with predetermined positions on the lid. This is in contrast with the claimed invention where the divider may be positioned in any of the corresponding grooves within the base and will be in contact with the lid regardless of where it is mounted in the base to prevent movement of material over the divider. Therefore, whilst both the alleged infringing product and the patent achieve the same result i.e. to prevent sliding of the material over the divider such that the material does not interfere with material being dispensed from an adjacent roll, I do not believe that they achieve this result in substantially the same way.
- 79. I note that the observer makes further comments in relation to the functioning of the container if it were knocked or bumped (Figures 3 and 4), however, this has no bearing on the inventive concept revealed by the patent as I have determined above or its associated advantages. I also note that the requester discusses modified versions of Figures 1 and 2 above, however it is the invention as defined by the claims and the alleged infringing product which I must consider not modified versions.
- 80. I must now decide whether variants a, b and c taken together as a whole achieve substantially the same result in substantially the same as the invention i.e. the inventive concept revealed by the patent.
- 81. As I have discussed above a key advantage of the invention is that regardless of where the divider is mounted within the base it prevents jamming and interference between adjacent rolls by virtue of the contact between the base and the lid. This result is not one which is realised by the alleged infringing product owing to the fact that the dividers are required to be located at fixed positions on the base so that they correspond with set predetermined mating positions on the lid. Furthermore, the way in which jamming, and interference is prevented by the alleged infringing product is not achieved in the same way as that of the inventive concept revealed by the

patent. The alleged infringing product does not prevent movement of material over the divider by virtue of the lid and divider having direct contact or by being proximate to one another. Instead it is prevented by the complementary shape of the edge of the lid with the divider and base.

- 82. Therefore, in view of the above, taking account of variants a, b and c as a whole, my answer to question (i) is "no".
- 83. As I have answered "no" to question (i) I do not need to consider questions (ii) and (iii) further.

# **Opinion**

- 84. In my opinion the container as depicted in Annex 3, and provided as a sample, does not fall within the scope of the claims as a matter of normal interpretation.
- 85. Further, I do not believe that the container as shown in Annex 3 varies in ways which are immaterial, and thus I believe that it does not infringe claim 1 of the patent under section 60(1)(a) of the Act.

# **Application for Review**

86. 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.

Natalie Cole		
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.