

PATENTS ACT 1977

01/5/93

IN THE MATTER OF an application under Section 71 by Brevet Hospital Products (UK) Limited for a declaration of non-infringement of European Patent (UK) No 0071818 in the name of Weihermüller & Voigtmann GmbH & Co KG

DECISION

The applicants, Brevet Hospital Products (UK) Limited (hereafter Brevet), have applied to the Comptroller for a declaration that "the manufacture, disposal of, offer to dispose of, use or importation of an anti-embolism stocking having the characteristics of that of Exhibit C which accompanied the statement does not constitute an infringement of the Patent" on the ground that the said stocking "is not within the scope of any claim of the Patent". This is disputed by the patentees in their counterstatement filed under Rule 74(2) and the matter came before me at a Hearing on 18 December 1992 at which Mr H Carr, instructed by Messrs Haseltine Lake & Co, appeared as Counsel for the applicants and Mr R Hacon, instructed by Messrs M'Caw & Co, appeared as Counsel for the proprietors of the Patent.

The patent in suit, which relates to a "thrombosis-prophylaxis stocking", was granted on 22 May 1985 and is in force in the UK. The granted patent is in German with a published English translation of the single claim thereof as follows:-

"Thrombosis preventive stocking (1) with provision for a reduced control opening (4) in the toe area and enlarged circumference in the instep area (2), the latter involving the same number of stitches, with greater mesh size and matched extension of the pressure weft yarn to enlarge the instep circumference, wherein the instep area (2), enlarged in circumference is reinforced in that section of it (3) assigned to the heel, by an additional thread similar to the other knitted threads, and wherein, preferably in the centre of the reinforced area of the heel (3), with the aid of another distinguishable thread to secure the heel in the direction of the stocking

circumference, a narrow strip (5) is knitted additionally at a height of approximately 2 to 20 mesh rows and at a width of a quarter to a half of the instep circumference."

The applicants' stocking (Exhibit C) is of generally similar appearance to that shown in the Figures of the patent in suit, having the same "reduced control opening (4)" in the toe area and "enlarged circumference" in the instep area (2). It is the nature of this latter area however, and especially of the "narrow strip (5)" therein which constitutes the crux of the present dispute.

As a preliminary matter, Mr Hacon sought to file two further statutory declarations, one in the name of Mr G Collyer, the expert witness for the proprietors, and the other in the name of Mr H Funge of the firm of patent agents acting for the proprietors. The first of these further declarations concerns a correction to paragraph 7 of Mr Collyer's original statutory declaration filed in evidence to the effect that Mr Collyer now agrees with Mr Smirfitt, the expert witness for the applicants, with respect to the dual function of the "narrow strip" and I admitted this further declaration in the absence of any objection by Mr Carr and on Mr Hacon's assurance that it would be sworn as soon as possible. The second of the further declarations sought to file as evidence samples of the proprietors' stocking, of the applicants' modified stocking and of an earlier form of such modified stocking. In the face of objections from Mr Carr that he had not had an opportunity to verify the nature of these exhibits and since the proprietors' stocking is fully described in the patent in suit, I refused to admit this declaration.

Turning to the nature of the narrow strip, Mr Carr explained that the three points of argument between the parties are set out in integers (f), (g) and (h) of paragraph 4 of Mr Smirfitt's first declaration on behalf of the applicants, that is does the Brevet stocking have a narrow strip which is knitted additionally, does it have a narrow strip with a height of approximately 2 to 20 mesh rows, and does the narrow strip, assuming there is one, have a width of one quarter to one half of the instep circumference? It was accepted by Mr Hacon that the dimensions of the strip of the applicants' stocking are such as to fall outside the literal meaning of the language of the claim. According to Mr Smirfitt's first statutory declaration, this strip is by his estimation of 32 mesh rows in height while constituting 5-10%

of the instep circumference. These figures were not disputed by Mr Hacon or by the proprietors' expert witness, Mr Collyer, in his evidence.

Before considering these integers in greater detail Mr Carr addressed me on the matter of interpretation of the language of claims having regard to the decision in the case of Improver Corporation v Remington Consumer Products Limited [1990] FSR 181. In that decision, Hoffmann J referred to the proper approach to the interpretation of patents being that explained by Lord Diplock in Catnic Components Ltd and another v Hill & Smith Ltd [1982] RPC 183, that is that the language should be given a "purposive" and not necessarily a literal construction. Hoffmann J then went on to set out the three questions framed by Diplock L J that the court should ask itself if the issue was whether a feature embodied in an alleged infringement which fell outside the primary, literal or acontextual meaning of a descriptive word or phrase in the claim ("a variant") was nevertheless within its language as properly interpreted, these three questions being as follows:-

- (i) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no -
- (ii) Would this (ie that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art. If no, the variant is outside the claim. If yes -
- (iii) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention. If yes, the variant is outside the claim.

Although Mr Hacon was of the view that there was very little between himself and Mr Carr on the law to be applied, Mr Carr emphasised that, in applying a purposive construction to the claim, I should not depart from the language of the claim; he went on to say that, as Diplock L J had stated in the Catnic case, the patent specification uses words of the patentees' own choosing and the question to be answered is whether the words are capable

of meaning what the patentees say they mean when construed purposively.

Returning to the matter of integers (g) and (h), that is the requirement in the claim for the narrow strip to have a height of approximately 2 to 20 mesh rows and a width of a quarter to a half of the instep, Mr Carr was quite prepared to accept the point made by Mr Hacon that the limits are not essential to the operation of the invention and recognised that the patentees had left themselves some leeway; he took the view, however, that to extend the limits to the degree necessary so as to embrace the dimensions of the strip in the applicants' stocking would be to put a meaning upon the language which it is not capable of bearing and would render the limitations on the ranges within the claim completely pointless.

As Mr Hacon pointed out, although there is speculation in paragraphs 18 and 19 of Mr Smirfitt's first declaration, there is no clear evidence of commercial advantage with a stocking having a tall thin strip as opposed to a short fat strip, as Mr Hacon put it, nor is there evidence from a medical practitioner or a patient to say whether one strip has advantages over the other either in the positioning of the heel or in the comfort given to the user. In this respect I have to agree with Mr Hacon and if this were the end of the argument, I might have some difficulty in answering the questions posed by Diplock L J with any great confidence. In the absence of clear evidence to the contrary it is not apparent that the dimensions of the strip alone do have a material effect upon the way in which the invention works and this may well have been obvious to a reader skilled in the art at the date of publication of the patent. Nevertheless, although the skilled reader may well have understood from the language of the claim that the patentees did not intend that strict compliance with the dimensions of the strip as specified in the claim was essential, it seems to me to be doubtful whether, in reading the claim, the skilled reader would have envisaged that the definitions could be stretched to the extent of embracing a strip some 32 mesh rows in height and constituting only 5 to 10% of the circumference of the instep. Thus on the first two of Diplock L J's questions going to the facts of the case I should be steered in the direction of a finding of infringement but, on the third question going to construction, I should lean towards the opposite view.

That is not the end of the matter, however, because Mr Carr invited me to consider the purpose of the limitations in the claim of the patent and also the remaining integer (f) referred to in Mr Smirfitt's declaration, that is the issue of the narrow strip being knitted additionally.

Relying on the sworn translation of the specification and on paragraphs 6 and 13 of Mr Smirfitt's first declaration, Mr Carr's argument in summary was that the object of the invention is to produce a stocking with a quasi heel, that is one which simulates and has the advantages of a real heel so that the stocking can be fixed sufficiently (in the words of the patent), whilst largely overcoming a number of disadvantages of the known stockings. In order to produce a real heel, Mr Carr explained, the rotation of the circular knitting machine has to be interrupted to "swing in" the heel by a reciprocating action whereas the advantage of the invention, that is the narrow strip which creates the effect of a real heel, is that the number of swingings in is reduced significantly and, as a consequence, the rotation of the circular knitting machine is interrupted for a shorter period of time. Mr Carr went on to say that the reference in the claim to the narrow strip being knitted additionally using another distinguishable thread in order to create the quasi heel meant that a further thread is being swung in, that is that this particular bit of knitting is additional to the knitting of the remainder of the stocking; this is distinct from the corresponding strip in the Brevet stocking which is not swung in but which is formed integrally with the remainder of the stocking without interruption of the circular action of the knitting machine.

In his evidence on behalf of the patentee Mr Collyer puts forward an alternative explanation to that given by Mr Smirfitt which is that an extra feeder with the further thread is introduced (or swung in without a reciprocating action, as I understand it) for only a given percentage during the knitting of the circumference of the stocking. This would necessitate that the machine is slowed down during the swinging-in process and hence, although being slower than knitting a straight tube, would offer a considerable advantage as regards the rate of production as compared with the creation of a conventional reciprocated heel. Mr Collyer goes on to say that, in his view, the stripe of the Brevet stocking is knitted additionally to

the extent that the threads additional to those necessary to form the stocking per se are included and that the additional threads in the Brevet stocking are the direct counterpart to those in the patentees' stocking and are introduced in the same way.

In his first declaration it was Mr Collyer's view that the further distinguishable threads provided in the reinforced area of the heel of the patentees' stocking are intended to function as a marker to enable the user to align the heel region of the stocking accurately with the heel of the patient's foot but concedes in his second declaration that they also serve to create a heel shape for a better fit when worn.

Mr Hacon drew support for Mr Collyer's approach from Mr Smirfitt's second declaration where, in paragraph 2, Mr Smirfitt explains that he had considered the alternative interpretation of additional knitting put forward by Mr Collyer. In his view Mr Smirfitt had clearly thought that Mr Collyer's explanation was a perfectly possible interpretation of the meaning of the term swing-in but had rejected it in view of the translation of the corresponding German term.

In challenging Mr Smirfitt's equation in his evidence of "knitted additionally" with "swinging-in" and hence a reciprocating or oscillating motion, Mr Hacon explained that Mr Smirfitt had relied on the translation of the German verb pendeln. While Mr Hacon accepted this translation, he pointed out that the word used in the original German text was eingependelt which is the past participle of the verb einpendeln; he went on to produce an extract from Collins German-English dictionary showing the word einpendeln as meaning "to commute in" or introduce. Thus, in Mr Hacon's submission, Mr Smirfitt had translated the wrong German verb and incorrectly, as a consequence, had equated swinging-in with a reciprocating movement.

In the absence of evidence from a language expert regarding the translation of the German words in question, I am unable to reach a conclusion on the correct English equivalent. Although Mr Hacon cast doubt on whether the verb einpendeln used in the original German of the patent translates correctly as swinging-in, I note, as Mr Carr pointed out, that Mr Hacon was relying on a non-technical dictionary which may or may not take account of

the subtleties of the term as used in the knitting art. If I understood him correctly, Mr Hacon was not challenging directly the accuracy of the sworn translation, only Mr Smirfitt's translation. The fact remains, however, that the sworn translation uses the term swinging-in and, if the patentees were unhappy with the translation, they should have challenged it earlier in the proceedings since it forms the basis for the evidence of both parties.

The question I have to decide is whether the term swinging-in as used in the specification implies a reciprocating action as Mr Carr would have me believe. Although in his evidence Mr Collyer offers an alternative explanation suggesting the contrary, he does not contradict the evidence in paragraph 6 of Mr Smirfitt's first declaration where he says that the term swinging-in is generally understood in the art to mean the formation of a heel by stopping the circular unidirectional knitting over a number of rows and separately knitting with a reciprocating action a segment of additional material over a proportion of the circumference. Nor, to my mind, does Mr Collyer's alternative offer a convincing explanation of how the objective of the invention, that is the production of a quasi heel while overcoming the disadvantages of the prior art procedures, is achieved.

Accordingly, it seems to me that not only does the strip of the applicants' stocking differ significantly in its dimensions from that of the proprietors' stocking but it is produced by a different and advantageous method of manufacture whereby the interruption to circular knitting required by the patent in suit is eliminated. In the former respect, it further appears to me that the restriction placed upon the dimensions of the strip in the claim of the patent in suit constitutes an essential feature of that claim for the reasons advanced by Mr Carr and that the combination of the dimensions of the strip of the applicants' stocking together with its different method of manufacture constitutes a variant having "a material effect upon the way the invention works". Having thus answered the first of Diplock L J's three questions referred to earlier in the affirmative, it follows that I find that the applicants' stocking does not infringe the claim of EP(UK) 0071818 and that the applicants are entitled to the declaration of non-infringement that they seek.

Taking account of all of the circumstances of this case, I award the applicants, Brevet Hospital Products (UK) Limited, the sum of £600 (six hundred pounds) as a contribution towards their costs and I direct that this sum be paid to them by the proprietors of the patent in suit, Weihermüller & Voigtmann GmbH & Co KG.

Dated this 1st day of February 1993



Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE