

PATENTS ACT 1977

BLO/079/95

IN THE MATTER OF
an application under Section 71
by W.R. Grace & Co.-Conn
for a declaration of non-infringement of
European Patent (UK) No 0026772
in the name of Inpaco Corporation

DECISION

European Patent (UK) No 0026772 is dated 20 March 1980 and was granted on 9 January 1985 to the inventor Mr William C Christine. In 1992 the patent was assigned to the present registered proprietor Inpaco Corp, a company registered in Ohio, USA.

On 8 July 1994, W.R. Grace & Co.-Conn ("the applicant") applied for a declaration of non-infringement. On 2 November 1994 the applicant filed a statement identifying the apparatus in respect of which it sought the declaration, and on 7 March 1995 agents for the proprietor wrote to the Patent Office to say that the proprietor had decided not to file a counterstatement. In consequence, the facts that are stated by the applicant are not disputed.

The patent is concerned with the manufacture of plastic pouches, and the specification describes apparatus in which thermoplastic sheeting is drawn downwards from a roll and passes over a curved former so that the ends of the sheet meet. The edges are welded together to form a continuous tube which then passes between transverse heating and cutting bars which convert the continuous tubing into a series of sealed pouches. Each pouch is filled with product at the point in the process when the bottom transverse seal of the pouch has been made and the top seal has not yet been made. The product is poured through a tube that passes through the former.

The invention is concerned with an improvement in such apparatus in which each pouch is fitted with a dispensing spout or fitment. Each fitment is carried by a transfer mechanism to

the outside of the continuous tube before the transverse seals are formed. The fitment is pressed against the tube material, which is supported by a support block attached to the former, and welded in place by the application of heat from a heated portion of the support block. As I understand it, when it is desired to dispense product from the pouch, a spout or other connector is applied to the pouch so that in one operation it perforates the wall of the pouch within the fitment and also is sealingly coupled to the fitment.

The patent has one main claim, claim 1, and four claims appendant to it. I am therefore only concerned with the monopoly defined by claim 1, which reads (omitting the reference numerals):

Apparatus for attaching a fitment to a sleeve of thermoplastic material comprising a body receiving fitments, means for moving said body and a fitment to a position adjacent to said sleeve, means for removing said fitment from said body, means for pressing portions of said fitment against said sleeve and heating means located in alignment with said pressing means, characterised in that the heating means are located within the sleeve and that the means for removing the fitment includes a pilot pin engaging in a bore in the fitment and means for slidably extending and retracting said pilot pin.

As will become clear, the important features of the claim for the purposes of these proceedings are that:

- (a) that the heating means are located within the sleeve; and
- (b) that the means for removing the fitment includes a pilot pin engaging in a bore in the fitment and that there are means for slidably extending and retracting said pilot pin.

The apparatus in respect of which the declaration is sought is known as the On-Pack 2000 vertical form-fill-machine. This is similar in operation to the machine described in the patent specification, but the fitments are applied to the inside of the tube rather than the outside, and the transport arrangements for the fitments are therefore necessarily different.

At this point I must describe the material submitted to me by the applicant. The statement has attached to it a letter which was sent by the applicant's Patent Department in South Carolina to Steadman & Simpson the U.S. Patent Attorneys dealing (I assume, on behalf of the proprietor) with allegations of infringement by the applicant, a letter sent by the applicant's British patent agents J A Kemp & Co to the proprietor's British patent agents Marks & Clerk, and also a letter dated 11 January 1983 filed at the European Patent Office on behalf of the then patent applicant in response to the examining division's official action. I am treating these three letters as part of the statement.

In addition there is evidence in the form of a statutory declaration by Dr Stephen Ronald Kessel, an engineer employed by W R Grace Ltd in England. Dr Kessel says he spent several months working on the On-Pack 2000 machine modified to take Drester dispensing fitments attached to the inside of the pouch. (Drester dispensing fitments are stated in the applicant's statement to be the fitments shown in US Patent No 4603793.) He produces as Exhibit SRK1 a video recording of the On-Pack 2000 machine in operation supplying pouches fitted internally with the Drester fitments. I have watched this particular recording, which lasts for about eight minutes. It is a promotional video showing the use of the pouches with semi-liquid foodstuffs such as ketchup, but contains a brief view of the On-Pack 2000 machine in operation. It is possible to see the fitments falling down a chute within the tube and being stopped at a point above the transverse cutting station, but is not clear to me what stops them nor how they are applied to the wall of the tube. However, since the facts given in the applicant's statement are not disputed, I can take it as accepted that the construction of the applicant's apparatus is as described in paragraphs 6 to 8 of the statement, viz:

"6. As shown in the video recording (which did after all initiate the exchange of correspondence in November of 1992) the Cryovac Model 2000-A (On-Pack 2000) VFFS machine takes flat film web from a supply roll and passes it over a forming shoe where the film is wrapped around the central column of the VFFS machine as it embarks on a vertically downward path in tubular configuration.

7. During its passage down the central column, the film has the slightly overlapping lateral edges sealed by a vertical seal bar pressed against the exterior of the central column to complete the tubular configuration of the film. At this same sealing station the Drester fitment, which has been allowed to fall freely down the central chute to

be arrested by the yieldable hook, is sealed to the interior of the tube by inward closing movement of an outer heat-sealing shoe to impart sealing heat to both the tubular wall of the film and the adjacent wall (6n in Figures 3 and 4 of US Patent 4603793) of the Drester fitment. Simultaneously a part of the same tube lower down the tube is squeezed between two nip rolls and becomes sealed transversely by horizontal transverse seal bars to close the bottom of a region of the film defining a pack. After that seal has been made, the contents of the pack are dispensed down through the central column of the VFFS machine to be arrested by the pinch rolls. 8. The pinch rolls then separate and the tube is indexed downwardly (and the upstream flat film from the supply roll indexed upwardly) by a distance equivalent to the length of a pack when measured along the tube, and the pinch rolls once again close ready for forming the next transverse seal (which is to define the bottom of the next successive pack but the top of the just-filled pack)."

In the letter to the patentee's US attorneys annexed to the statement, the applicant focuses on two features that are said to distinguish the apparatus from the claims of the patent, namely the internal positioning of the fitment and the fitment feed arrangement.

As regards the former, the letter says:

"We cannot accept that it is possible to press the fitment against both the heating means and the sleeve from within the sleeve if the fitment is itself inside the sleeve. In other words, with the heating means inside the sleeve the fitment must be outside the sleeve. The On-pack 2000 machine, as explained above, uses the reverse arrangement.

During prosecution of European Patent Application 80900631.5 it was argued, on behalf of the Applicants, that one piece of prior art (US-A-4055032) was distinguished over on the grounds that, inter alia, 'the heating means are not located within the sleeve'. It was argued that to have the fitment within the sleeve required the fitment to be attached to the film before the film is formed into a sleeve, and that this was not the invention of the European Patent Application in suit. In other words, the arrangement claimed in EP 0026772 is confined to the fitment being outside the sleeve and the heating means inside the sleeve."

I have noted the letter of 11 January 1983 to the European Patent Office, which argues for the then new claim 1 to be allowed, and I am satisfied that the passage quoted above is an accurate analysis of this particular feature of claim 1. It cannot be argued that to have the fitments applied to the inside of the tube and the heating means applied to the outside of the tube is an immaterial variation on the claimed arrangement when it is this part of the claim that distinguishes the claim from the prior art.

As regards the arrangements for applying the fitment to the tube, the letter to the patentee's US attorneys continues:

"Additionally, the pre-characterising portion of claim 1 of European Patent 0026772 furthermore has the requirement for features such as (i) 'a body receiving fitments' and (ii) 'means for moving said body and a fitment to a position adjacent to said sleeve', and (iii) 'means for removing said fitment from said body', whereas it is quite clear that in the On-pack 2000 machine the fitments slide down a chute comprising a groove machined for them in the central column; at no stage does any 'body' carry the fitment by movement along with it or have a fitment removed from it, so here is another reason to rule out infringement.

These requirements in the pre-characterising portion, taken together with the fact that the heating means are outside the sleeve with the fundamentally different type of fitment which is then provided, and taken in conjunction with the fact that the characterising portion of claim 1 of European Patent 0026772 requires the 'means for removing the fitment', to include 'a pilot pin engaging in a bore in the fitment' (whereas at no stage is a pin engaged in the bore in the fitment in the On-pack 2000), leaves us in no doubt as to our position."

As I have said, the video recording exhibited to Dr Kessel's declaration shows the fitments falling down the inside of the tube, but does not indicate clearly to me how each fitment is arrested and applied to the tube. The applicant's statement says that the fitments are arrested by a yieldable hook, and sealed to the interior of the tube by inward closing movement of an outer heat-sealing shoe. However it does not seem to me that that excludes the possibility that the fitments are moved against the wall of the tube by transport arrangements that include a pilot pin and the other features of the claim. In proceedings for a declaration of

non-infringement the applicant for the declaration has a positive obligation to satisfy the comptroller that the apparatus in question does not have the particular feature that is claimed. I do not consider that that obligation is discharged by giving an assurance in the statement that a particular feature of the claim is absent. The appropriate procedure, in my opinion, is for the applicant to describe his machine in sufficient detail for the comptroller to be able to compare the details of the machine with the appropriate claims of the patent. If that had been done in this case, I would have been able to judge for myself whether the applicant's machine has a component which could be regarded as a pilot pin. As regards the fitment feed arrangement, I am therefore not satisfied that the applicant's arrangement is distinguished from the claims of the patent. I can therefore only issue a declaration in respect of the location of the fitment and heating means.

In consequence, I declare that the On-Pack 2000 vertical form-fill-machine, insofar as it uses a fitment applied to the inner wall of the tube of pouch material and heating means applied to the outer wall, does not infringe any claim of European Patent (UK) No 0026772.

Dated this | day of May 1995

W J LYON

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE