

0/145197

PATENTS ACT 1977

IN THE MATTER OF

an application under Section 71

by P McCann Limited

for a declaration of non-infringement

of Patent No GB2241926

in the name of Wordsworth Holdings Plc

DECISION

Introduction

1. Patent number GB2241926 ("the patent") is concerned with load restraint in vehicles and containers. It was granted on 21 July 1993, in the name of Aveling Barford (Machines) Plc. Following a change of name of the company, the registered proprietor is now Wordsworth Holdings Plc.

2. On 12 May 1995, through its patent agent, Laurence Shaw, P McCann Limited, trading as Simark Engineering, applied to the comptroller under section 71 of the Patents Act 1977 ("the Act") for a declaration of non-infringement. The application was made in the prescribed format and included a statement (with appendices). However, the Office objected that the statement should be amended to set out clearly the act for which a declaration is sought, and an amended statement was filed on 26 July 1995. The relief sought is stated as:

"1. a Declaration that the manufacture, disposal or offer to dispose of, or importation, use or keeping or repair of the gate shown in Appendix 6 does not infringe any claim or claims of GB patent 2241926.

2. An award of costs".

3. The proprietor, through its solicitors, Garrett & Co, filed a counterstatement on 30 October 1995, accompanied by a document variously identified as "Enclosure 1" or "Exhibit 1". The relief sought is:

"1. Dismissal of the application; and

2. An award of costs."

4. In somewhat unusual evidence rounds, the applicant filed unsworn "evidence" and the proprietor wrote confirming its intention not to file any "further evidence". A date was set for a hearing, but both sides later indicated by letter that they would not be attending. The applicant also asked for the matter to be decided on the papers already in the file. An Office letter confirmed that a decision would be made on that basis. Accordingly, I have given very careful consideration to all the papers on file in reaching this, my decision.

The (unsworn) evidence

5. Before turning to the substantive matter in issue, I feel I should consider the nature of the evidence before me and the implications that has for my decision. Rule 103(1) of the Patents Rules 1995 requires that:

"Where under these Rules evidence may be filed, it shall be by statutory declaration or affidavit."

6. In fact, there is before me in this case no such formal evidence presented by either side. The applicant has as I have said filed an amended statement, which refers to six appendices. Appendices 1, 2, 3, and 5 comprise copies of letters exchanged between the proprietor and the applicant. Appendix 4 comprises unsworn photocopies of affidavits filed in Patents County Court proceedings, while appendix 6 is a marketing leaflet for Simark Engineering. The applicant also submitted four additional photographs with its letter dated 25 July 1995 and amended statement.

7. On 9 January 1996, in response to an Office letter inviting the filing of evidence under rule 74(3), the applicant's agent filed a letter which began:

"I file as evidence in these proceedings the following documents (additional to the information already provided)."

There followed a list of five patent specifications, copies of which were enclosed, and two paragraphs of argument.

8. In response, an Office letter of 25 January 1996 pointed out that evidence in proceedings before the comptroller should be in the form of an affidavit or statutory declaration in accordance with rules 103 and 104. It also said that any documents referred to in the evidence should be exhibited. A letter from the applicant failed to address this point, so a further Office letter pointed out that the applicant's "evidence" may not be acceptable by the court in the event that the case is appealed, but again it elicited no response.

9. The proprietor has filed a counterstatement and "Exhibit 1" (actually referred to as "Enclosure 1" in the counterstatement). In response to an Office letter inviting the filing of evidence under rule 74(4), the proprietor wrote in a letter dated 11 June 1996 "we confirm that it is our intention not to file any further evidence in this matter". In addition, there has been correspondence between the parties and the Office containing, among other things, argument and observation, but no sworn evidence.

10. In view of the unsworn, and in the light of rule 103(1) unsatisfactory, nature of the "evidence" filed, an Office letter of 10 July 1996 reported that: the Hearing Officer noted that documentation had been filed by both sides which, to be strictly admissible as evidence, should have been sworn; he observed that neither side had raised objection; and he therefore inferred that both sides were content for a substantive hearing to be held on the basis that this documentation was to be taken at face value, and that neither side intended to take a preliminary point as to its admissibility. The letter also invited the parties' observations on those inferences but in the event neither side responded.

11. The High Court has held in *St Trudo Trade Mark* [1995] RPC 370 that the Registrar of Trade Marks is a tribunal bound by the strict rules of evidence, and clearly that finding also applies to the comptroller in proceedings under the Act. On this basis, it might have been open to the proprietor to argue, though it did not, that the application falls at the first hurdle, insofar as the applicant has not established a case supported by evidence which meets the rigour demanded by rule 103(1). Certainly it leaves me uneasy that I should find myself deciding a case with no sworn evidence. It seems to me that where evidence is giving an individual's recollection of events, then the best available evidence should be adduced, most preferably a sworn statement by that individual. In circumstances where that recollection is contested, or where there is the possibility that witnesses are not telling the truth, it is essential that such evidence is sworn, among other things so that there is no doubt that the sanctions of the Perjury Act are available.

12. However, that is not the situation here. In the current case, that part of the submitted documentation which is clearly not mere argument comprises photographs or copies of papers the authenticity or correctness of which has not been questioned. Indeed, much of the unsworn documentation relates to matters which are not in dispute between the parties. In these circumstances, I do not believe I would be justified, in the light of the parties' clear wish that I decide this matter on the papers already on file, in finding that the unsworn nature of the evidence was such that I should not consider it. In the absence of any dispute between the parties on this point, I proceed on the basis of accepting the documents before me at face value.

Section 71(1)(a) and (b)

13. Section 71 of the Act relates to the making of declarations of non-infringement. Sub-section (1) states:

"Without prejudice to the court's jurisdiction to make a declaration or declarator apart from this section, a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be

made by the court or the comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown -

- (a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and
- (b) that the proprietor has refused or failed to give any such acknowledgment."

I need first therefore to consider whether the requirements of sub-section (1)(a) and (b) have been met.

14. Paragraph 5 of the amended statement goes to the heart of this matter. It reads:

"On March 31, by its patent attorneys, P McCANN LTD requested an acknowledgement that there was no infringement; on April 11 and 24, 1995, there was correspondence between the parties but no such acknowledgement was provided, see Appendix 5. It will be contended that as the information in the leaflet of Appendix 6 was sufficient for Garrett & Co. To form the view that the patent was infringed and to demand undertakings, commercial information and damages, see Appendix (1), the patentee had in January 1995 full information in writing and pictures about the gate of the Applicant. It will further be contended that the patentee has refused or in the alternative failed to give the required acknowledgement. Accordingly it will be contended that the tests in Section 71 (a) and (b) are satisfied."

15. The copy letters at appendix 5 to the amended statement support this account of the exchanges between the parties, and the proprietor has not disputed it. In particular, the proprietor has in these proceedings not denied that it had been given full written particulars

of the act in question, although I note that it had done so in its letter of 11 April 1995, that is before these proceedings were launched. I also recognise some force in the applicant's contention that the leaflet of appendix 6 had been sufficient for the proprietor to form the view that the patent was infringed, and to write its letter of 24 January 1995 at appendix 1, and so had full particulars of the act the subject of the declaration sought. I might add that paragraph 3 of the counterstatement seems to me to show that it is plain to the proprietor what the features of the applicant's product are, and hence to what act the proposed declaration is referring. It is clear that in response to the particulars furnished by the applicant, the proprietor has failed to give any acknowledgement to the effect of the declaration claimed. Indeed, paragraph 3 of the counterstatement, in alleging plain infringement, is saying the reverse of that.

16. On this basis, I am satisfied that the formal requirements of section 71(1) (a) and (b) are met.

The act in question

17. Although I have not been referred to any authorities in this respect, it is well established in relation to applications for declarations of non-infringement both that the onus for establishing non-infringement rests upon the applicants and that the description of the article or process in respect of which the declaration is sought must be clear and precise. It is with these rigorous requirements in mind that I must consider the description of the act in question submitted by the applicant.

18. The act in question, which the proprietor alleges is an infringement of the patent, is identified in a marketing leaflet at appendix 6 to the amended statement. The leaflet comprises four photographs below which is the title "Aluminium Load Restraint Frame" and below that a paragraph of text. It shows within a load space a generally U-shaped load-restraining frame manufactured from 41mm square extruded aluminium. The frame is movable between a stowed and an operative position about the free ends of the U. However, it has, in addition to the basic U, a number of cross-members. As shown, the operative position is vertical, and

the leaflet's text says that the frame has no protruding parts outside of the 41mm aluminium box section, which allows the frame to be used as a false bulkhead.

19. In paragraph 6 of the statement the frame (or "gate" as it is called there) in question is also described by reference to "the article shown in GB patent publication 2275896A in Appendix 4". Also, in the applicant's letter of 9 January 1996 there is a reference to "information in the form of the pending application", while in its letter of 25 July 1995 the patent application at appendix 4 is again referred to. Four extra photographs also filed with that letter as further explanation are larger versions of the photographs appearing in the leaflet. However, I note that the terms of the formal declaration sought in the statement do not refer to this patent document or to those enlarged photographs, merely referring to appendix 6, that is the marketing leaflet. I do not therefore believe I can or should rely on information beyond that contained in the leaflet as defining the act in respect of which the declaration is being sought.

20. That said, it seems to me that the description of the act in question as contained in the leaflet forming appendix 6 to the statement is sufficiently clear and precise for me to consider the application.

The patent

21. The patent has two independent claims. The first, claim 1, reads:

"1. A vehicle or container for carrying goods having at least two rigid load restraining members, each securable in an operational position in which a first section thereof extends laterally across the vehicle or container load space at a height above the floor thereof and two second sections of the restraining member extend respectively on either side of the first section at an angle to the vertical in planes generally parallel to the sides of the load space, wherein the load restraining members, in the operational position thereof, divide the load space into two or more longitudinal regions, the first sections of the load restraining members and the front and/or rear doors together

providing longitudinal restraint of goods carried in each region and the second sections of the load restraining members providing lateral restraint of goods carried in each region."

22. Claims 2 to 10 inclusive are all appendant, directly or indirectly, to claim 1. The second independent claim is claim 11. This is of "omnibus" type and reads:

"11. A vehicle or container substantially as described herein and illustrated in the accompanying drawings."

23. In the particular description, each load restraining member comprises a first section (drawing reference 20) and two second sections (reference 22) which form a generally U-shaped frame whose free ends are rotatably attached adjacent the roof of the load space. When deployed in the operational position to restrain cargo, the first section forming the base of the U extends horizontally to provide longitudinal restraint, and the second sections which form the side limbs of the U are diagonally oriented, that is they lie at an angle to the roof, to provide lateral restraint. When retracted, the U-shaped members lie adjacent the roof of the vehicle or container.

24. In determining whether or not the claims of the patent are infringed, I first have to construe them. The parties have referred me to several authorities on the proper approach to be taken to construction. The first is *Catnic Components Limited and another v Hill and Smith Limited* [1982] RPC 183 where Lord Diplock said at page 243:

"... A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge. The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that *any*

variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.

The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked. ..."

25. The proprietor also referred me to *Assidoman Multipack Limited v. The Mead Corporation* [1995] RPC 321. I have carefully read that judgment, in which Aldous J reviewed a line of cases on the subject of construction and considered the effect of the Protocol on the Interpretation of Article 69 ("the Protocol") of the European Patent Convention which is applied by virtue of section 125 of the Act. In particular I note that Aldous J concluded that the correct approach to construction under the Patents Act 1977 is "purposive" construction and that it cannot be disputed that "purposive" construction fits squarely within the guidelines of the Protocol. I note the applicant's view that *Assidoman* has no relevance to the present case because, to paraphrase that view, the non-infringement here is so clear cut.

26. The applicant also referred me to the Patents Court judgment in *Beloit Technologies Inc and Another v Valmet Paper Machinery Inc and Another* [1995] RPC 705, which again I have considered carefully. In that case, on the matter of construction, Jacob J stated his belief that the *Catnic* purposive approach does represent the *via media* called for by the Protocol. As the applicant points out, Jacob J then went on to give a robust decision on the issue of infringement before him in that case.

27. It is clear to me on the basis of these authorities that I must adopt a purposive approach to the construction of the claims of the patent. On doing so, it seems to me that claim 1 requires a load restraining member having three parts, of which, in an operational position, one provides longitudinal restraint of goods, and two others extending "at an angle to the vertical" provide lateral restraint of goods. I have carefully read the description of the patent, and find that the document read as a whole is clear and consistent with these requirements being essential features of the invention. To construe the claim otherwise, for example to say that the lateral restraint provided by the second sections is not essential, would seem to me to

be entirely at odds with the way in which the patentee has presented his invention, and would have a material effect upon the way in which the invention worked. In short, it is not in my view a construction which can be arrived at or sustained in a manner consistent with adopting the principles laid down in the authorities.

28. As regards the construction to be placed on omnibus claim 11, I believe it is sufficient for me to say that I construe it as being considerably narrower in scope than claim 1 and as including all the essential features of that claim.

Infringement

29. As I have already said, it is the marketing leaflet at appendix 6 to the statement which defines the frame in respect of which the declaration is sought. The applicant, in its statement, submits that it is clear that the second sections of claim 1 are not present in its frame. In its letter of 9 January 1996 it asserts that it is blatant that a feature of the claim (second section 22) said to be an essential feature of the patented invention simply is not present in the product of the applicant. It follows, it argues, from the language of the patent that first means and second means are required, and that it follows from the information provided by the applicant that its gate (or frame) comprises an aluminium box section and no parts are present to restrain the goods against lateral movement. In its letter of 25 July 1995 it argues that it is plain that the frame lacks the required secondary means to hold goods within the compartments against sideways movement. Finally, I note that in its letter of 3 February 1995 at appendix 2 to the statement, the applicant contends that there is no patent infringement because it is an essential feature of the patented invention that the gate include arms set at an angle to restrain lateral movement of the load and no such arms are present in the applicant's product.

30. The proprietor's position is very briefly stated. It submits that, in taking a purposive construction of the claims, particularly claim 1, consistent with *Catnic* and a long line of cases following this including *Assidoman*, it is plain that the features of the applicant's cargo

restraining product fall squarely within the scope of the invention described (though I take it to mean "claimed") in the patent.

31. I have considered these contrary submissions very carefully. It seems to me that the applicant's frame can be said to comprise a first and two second sections in that it is, like the restraining member defined in the claim, generally U-shaped - the limbs of that U in the applicant's frame may not be explicitly termed second sections, but they could clearly be so termed. However, I can find nothing in the marketing leaflet at appendix 6 which suggests that, in an operational position to restrain a load, the applicant's frame is oriented other than vertically as shown in the leaflet. Indeed, the cross-members shown in addition to the basic U would seem to me to preclude its operation with the U-shaped member, and hence the second sections of it, other than vertical. Thus I do not see the applicant's frame satisfying the essential requirement of the claimed invention that the second sections in the operational position extend at an angle to the vertical. More than that, I do not believe that in the operational position the second sections of the applicant's frame provide lateral restraint of goods. Again, I would expect the additional cross-members to preclude this function, which is essential to the claimed invention, from being discharged.

32. Since I have found that the applicant's frame does not in its operational position provide this lateral restraint with second sections extending at an angle to the vertical, features which I have previously found to be essential to the claimed invention, I conclude that it does not infringe claim 1 of the patent. This finding also necessarily applies to omnibus claim 11 as I have construed it, and having found the independent claims not to be infringed, it follows that the appendant claims are also not infringed.

33. Although I have already reached a conclusion in its favour, I should mention that in its letter of 9 January 1996, the applicant draws attention to a number of patent specifications which it alleges anticipate the subject matter of claim 2 of the patent while in no case having a component corresponding to the second section of claim 1. I have to say that, in the absence of further argument, I do not follow the applicant's line of reasoning in drawing these specifications to my attention. I note that no attack is made on the validity of claim 1, nor

does any attack on validity form part of the pleadings. If, as asserted, these documents are only relevant to claim 2 of the patent (an assertion which I have not considered), I can see nothing which would assist me in determining the issues put in the pleadings.

34. Also, for the avoidance of doubt, I should say at this point that questions arising from the proprietor's change of name and from an action in the Patents County Court do not in my view bear on the infringement issue and I have therefore given them no weight in reaching my conclusion.

35. Before making a declaration I believe there are three points, not raised by either party, which I should address. First, I note that, according to the Register of Patents, the patent ceased (by non-payment of renewal fee) on 29 January 1996. It is therefore clear that there can be no infringement of it after that date. Nonetheless, the declaration will have effect in respect of that period during which the patent was in force.

36. Secondly, the formal declaration sought by the applicant seeks to cover "repair". "Repair" is not an act specified in section 60 of the Act as an infringement, although I can well appreciate that some of the acts listed there could form part of a repair operation. In these circumstances I feel obliged to omit the reference to repair from the declaration I grant. The resulting declaration will in any event cover any repair in which any of the mentioned infringing acts are involved.

37. Thirdly, the formal declaration sought speaks of a "gate", whereas the leaflet at appendix 6 to the statement refers to a "frame". Since the appendix defines the act in question, I believe it is preferable for the declaration to use the same language.

Declaration

38. I find therefore that the applicant has discharged the onus on it and is entitled the requested declaration, subject to the amendments I have identified. Accordingly, I declare that the manufacture, disposal or offer to dispose of, or importation, use or keeping of the frame

shown in appendix 6 to the applicant's amended statement does not infringe any claim or claims of GB patent 2241926.

Costs

39. As the applicant has been successful in obtaining a declaration largely in the terms it sought, I need to consider its request for an award of costs. It is long established practice that costs awarded in proceedings before the comptroller are not intended to compensate parties for the expense to which they may have been put, and are generally awarded on the basis of a published scale. With this in mind, and taking account of the nature of the evidence filed and the lack of an oral hearing, I award the applicant, P McCann Limited, the sum of three hundred pounds (£300) as a contribution to its costs, and order that this sum be paid to it by the proprietor, Wordsworth Holdings Plc.

Appeal

40. Since this is a decision other than on a matter of procedure, any appeal from this decision shall be filed within six weeks after the date of this decision.

Dated this 22nd day of August 1997

S N DENNEHEY

Superintending Examiner, acting for the comptroller

THE PATENT OFFICE

