

OPINION UNDER SECTION 74A

Patent	GB 2350394 B
Proprietor(s)	Ninefields Holding Ltd.
Exclusive Licensee	
Requester	Ninefields Holding Ltd.
Observer(s)	gunnercooke llp
Date Opinion issued	13 February 2017

The request

1. The comptroller has been requested by Sanderson and Co. on behalf of Ninefields Holding Ltd (“the Requester”) to issue an opinion as to whether GB 2350394 B (“the Patent”) is infringed by a product manufactured or imported by Caspian Access and Plant Hire Limited known as the Octiknob (“the Product”).
2. The request was received on 16 November 2016. A flyer showing the potentially infringing Product was included with the request. The request further includes photographs of the Product.

Observations and observations in reply

3. Observations were received from gunnercooke llp (“the Observer”) on 16 December 2016. The observations refute the infringement position and further assert that the patent is not valid and contains added matter.
4. Observations in reply were received on 30 December 2016.

Matters to be considered by this Opinion

5. Section 74A of the Patents Act provides for the procedure where the Comptroller can issue, on request, non-binding opinions on questions of validity relating to novelty, inventive step, added matter, sufficiency and excluded matter amongst other things and on questions of infringement. Any observations should be confined to the issues raised by the request and should not broaden the scope of the opinion by raising new issues. Consequently if an observer wishes to explore validity issues not raised

by the requestor then they must file a separate request.

6. I will therefore not consider the matters of validity and added matter raised in the observations.

The Patent

7. The Patent entitled "End caps and arrangements" was filed 01 December 1999, granted on 19 December 2001 and is currently in force.
8. The Patent is concerned with end caps for use with scaffold poles. Figure 3 is reproduced below as figure 1. The end cap comprises a tapered tubular portion 11 and a plugging member 13 for insertion into the open end of a pipe or scaffold tube. The tubular portion includes ribs 21, 22 extending longitudinally on the outer surface thereof. Further ribs 23 are provided extending circumferentially on the inner surface of the tubular portion.

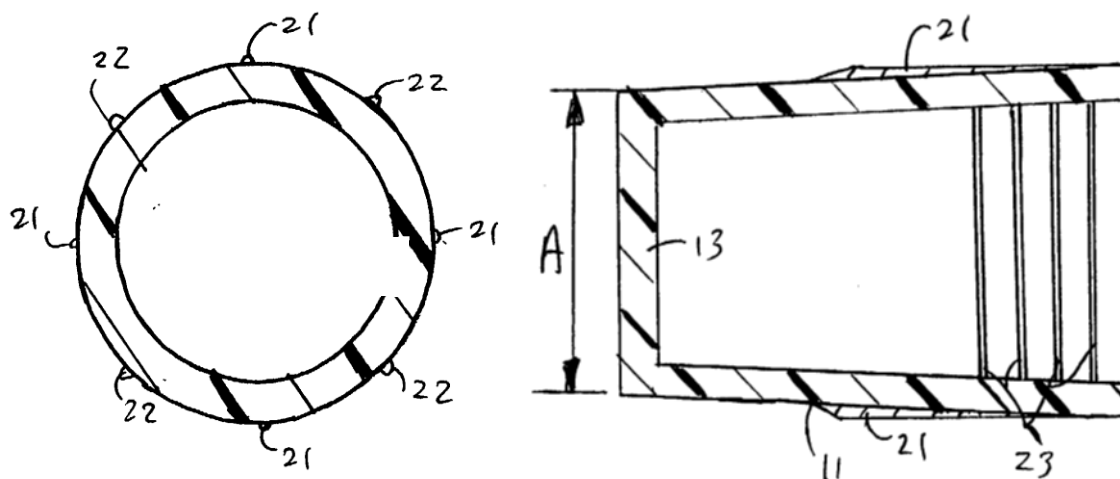


Figure 1: Figure 3 of the Patent

9. The Patent has 28 claims with two independent claims 1 and 14, 25 dependant claims and 1 omnibus claim. Claim 1 reads as follows:
 1. *An end cap for plugging the end of a scaffold tube, the end cap comprising:
a tubular portion tapered so as to be larger in diameter at a first end;
a blocking member extending transversely across the tubular portion at a position spaced from the first end; and
ribs extending substantially longitudinally on the outer surface of the tubular portion,*

the end cap being capable of complete insertion into a scaffold tube to form, in use, an interference fit therein.

10. Claim 14, which has a slightly different scope to claim 1, reads:

*14. An arrangement comprising a scaffold tube fitted therein an end cap, the end cap comprising:
a tubular portion;
a blocking member extending transversely across the tubular portion at a position spaced from the first end thereof; and
ribs extending substantially longitudinally on the outer surface of the tubular portion,
the end cap having external dimensions such that it is retained in the scaffold tube by an interference fit.*

11. The end caps of claims 1 and 14 are essentially the same with the exception that there is no requirement in claim 14 for the tubular portion to be tapered. It should also be noted that, while claim 1 is directed to the cap itself, claim 14 is directed to a scaffold tube fitted with an end cap.

Infringement

12. Section 60 Patents Act 1977 governs what constitutes infringement of a patent; Section 60(1) reads:

(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) Where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;

(c) Where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

(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.

13. In order to decide whether there is any infringement of the Patent under section 60(1), I must first determine whether the Product of the request has all the features set out in the claims of the Patent. As stated, there are two independent claims 1 and 14. Although the scope of the independent claims is slightly different it would appear that if I find claim 1 infringed then it would follow that claim 14 would also be infringed. I will therefore consider claim 1 and only if I find this has not been infringed will I consider the other claims.
14. The request has made no indication that indirect infringement under 60(2) is to be considered.

Claim construction

15. Before considering the evidence put forward in the request I will need to construe the claims of the Patent following the well known authority on claim construction which is *Kirin-Amgen and others v Hoechst Marion Roussel Limited and others* [2005] RPC 9. This requires that I put a purposive construction on the claims, interpret it in the light of the description and drawings as instructed by Section 125(1) and take account of the Protocol to Article 69 of the EPC. Simply put, I must decide what a person skilled in the art would have understood the patentee to have used the language of the claim to mean.
16. Firstly, I considered the man skilled in the art to be the designer or team of designers of scaffolding and associated accessories.
17. Most of claim 1 is straightforward to construe. It would appear that the crux of the matter concerns how the phrase “ribs extending substantially longitudinally on the outer surface of the tubular portion” should be interpreted.
18. In the Patent the “ribs” 21 and 22 are seen to extend longitudinally along the outer surface of the tubular portion 11. They can be seen clearly in figure 3 reproduced above as figure 1. They are tapered so as to be tallest at the end furthest from the end cap. Page 3 of the description notes that:

The end cap 20 further comprises longitudinal ribs 21 and 22 extending longitudinally on the outer surface of the tubular portion 11 from the wider first end towards the plugging member end of the end cap. The ribs 21 are 22 mm long, and the ribs 22 are 20 mm long. The ribs 21 and 22 are tapered so as to be taller at their end furthest from the wider end of the end cap 20. When the end cap 20 is inserted into a scaffold tube, the ribs 21 and 22 are crushed and shaved off by the inner surface of the scaffold tube. This assists in providing a self-securing interference fit in the scaffold tube.

19. Although not included in the scope of claim 1, the description also refers to a further set of ribs 23 which are provided on the inner surface of the tubular portion. The internal ribs 23 are circumferential and are upstanding from the inner surface of the tubular member.

20. Given that no special or unusual meaning of the word “ribs” is given the description, I believe that both of the sets of “ribs” of the Patent fall within what the man skilled in the art would understand to be a normal definition of the word rib in this field i.e. an elongate raised piece of material provided on the surface. Although they are attached thereto or formed therewith, they are clearly distinct from the surface of the tubular portion from which they up stand.
21. I will now need to decide whether the Product has all the features of claim 1.

Comparison of the Product with claim 1

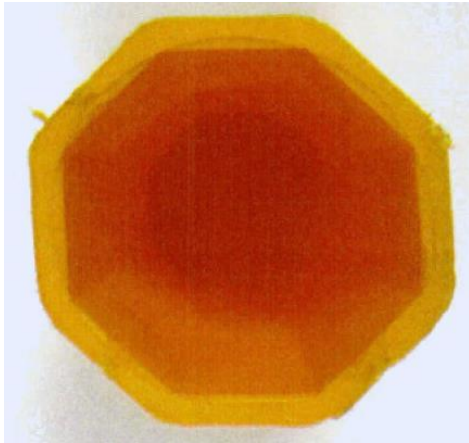
22. The Product is a scaffold end cap with an octagonal end profiles. The advert that accompanied the request states that the Product fits into a standard 4mm scaffold tube. It is best shown in the photographs included with the request some of which have been reproduced below as figure 2. The Product can be seen to taper from one end to the other and to include a blocking member extending transversely across the tubular portion at one end thereof.



a)



b)



c)

Figure 2: a) First narrow end view of Product, b) side view of Product, c) Second wide end view of product

23. The Requester submits that the outer tubular surface of the Product defines 8 ridges that extend longitudinally from the first end toward the other end and that these constitute “ribs” within the meaning of the claims. The requester further contends that the fact that the ribs of the Product are part of an octagonal profile does not prevent them being interpreted as ribs, especially as the patent does not specify a circular profile. To help illustrate this they have supplied the following figure which shows an end profile image of the Product with a circle superimposed thereon to replicate the inner profile of a scaffolding pole. In this figure “the ribs”, which correspond to the individual vertices of the octagon, can be seen to protrude from the surface of the superimposed circle.

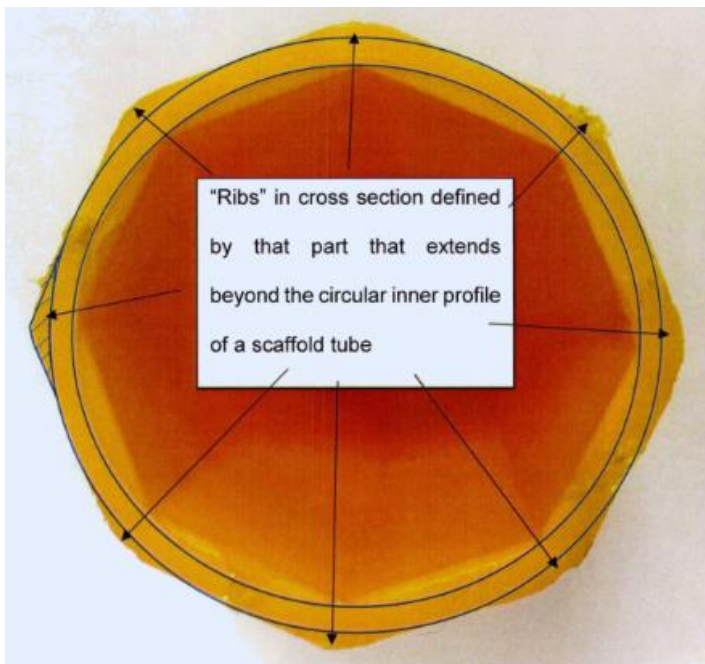


Figure 3: Cross sectional view of the Product with emphasis added

24. The Observer contends that equating the vertices of the Product to ribs would be misuse of the English language and that the word “rib” requires that the feature in question is in the form of a raised strip or ridge extending from a body.
25. In view of how I have purposively construed the “ribs” above, I am in agreement with the Observer.
26. On a normal interpretation of the word “rib” in the art, the vertices of the Product would not be considered ribs. The vertices (or ridges) of the Product are a mere consequence of where the sides of the octagonal prism meet. The vertices of an octagonal prism can not be considered to be ribs as it has been established that a requirement of being a rib is that they must up stand from the surface on which they are placed.
27. It is clear to me that figure 3 above is not a true representation of the Product and that the superimposed circle gives a false impression of the end profile of the Product. The end profile of the Product is strictly octagonal having straight internal and external edges and that the outer surface of this profile is one that it is lacking “ribs” of the form that have been construed above.

Functional equivalent

28. The Requester has stated that they consider the ridges of the product to be functionally equivalent to the “ribs” of the Patent. As discussed, for example in *Mayne Pharma v Pharmacia Italia SpA* [2005] EWCA Civ 137, there is no general “doctrine of equivalents.” under UK law and given that the patentee has deliberately and specifically referred to ribs this argument is moot.
29. The observer has also sought to distinguish the Product from the patent by arguing that the Product does not in use create a seal with the internal surface of the scaffold tube. This argument is however not relevant given that this is not a requirement of claim 1.
30. I therefore conclude that as the Product lacks one of the required features of claim 1, it does not fall within the scope of claim 1 and it therefore cannot form the basis of any infringing action.
31. Following from this, I reach the same conclusion with respect to claim 14.

Opinion

32. It is my opinion that the Product as specified and illustrated in the request does not fall within the scope of the claims. Accordingly any actions in relations to the Product do not constitute infringement of GB2350394 B.

Application for review

33. 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.

Nicola Payne
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.