

OPINION UNDER SECTION 74A

Patent	GB 2389824 B
Proprietor(s)	Paul Sinclair
Exclusive Licensee	
Requester	Paul Sinclair
Observer(s)	Motorcycle Hearse Limited
Date Opinion issued	26 September 2018

The request

1. The comptroller has received a request from Paul Sinclair (the requester and patent proprietor) to issue an opinion as to whether GB 2389824 (“the patent”) is infringed by certain actions in respect of a motorcycle sidecar hearse (“the product”) of Motorcycle Hearse Limited (MHL) and Payne & Sons Funeral Directors (P&S). The request is accompanied by photographs of the product taken from MHL’s Facebook (RTM) page and publicity material of P&S.
2. Observations, together with an additional photograph of the product and a statutory declaration of John Harris (director of MHL), have been received from Baron Warren Redfern on behalf of MHL. The statutory declaration states that MHL has built a motorcycle sidecar hearse and loaned it to P&S for the launch of a branch in Eastbourne on 15 June 2018, but the sidecar hearse has not been hired to anybody. Observations in reply have been received from Barker Brettell on behalf of the requester.

The patent

3. The patent was granted on 24 August 2005 and remains in force. The patent relates to a funeral vehicle in the form of a sidecar for a motorcycle, a side view of which is illustrated below. The sidecar superstructure 8 provides a covered reception area for accommodating a coffin or casket 12. It also includes an access door, illustrated as a hatchback 22 located at and hinged to the rear end of the sidecar superstructure in the figure below, through which the coffin or casket may be inserted into and removed from the reception area. The sidecar thus affords a weatherproof vehicle intended to be attached to a motorcycle that enables a casket or coffin to be easily manoeuvred into and out of the reception area.

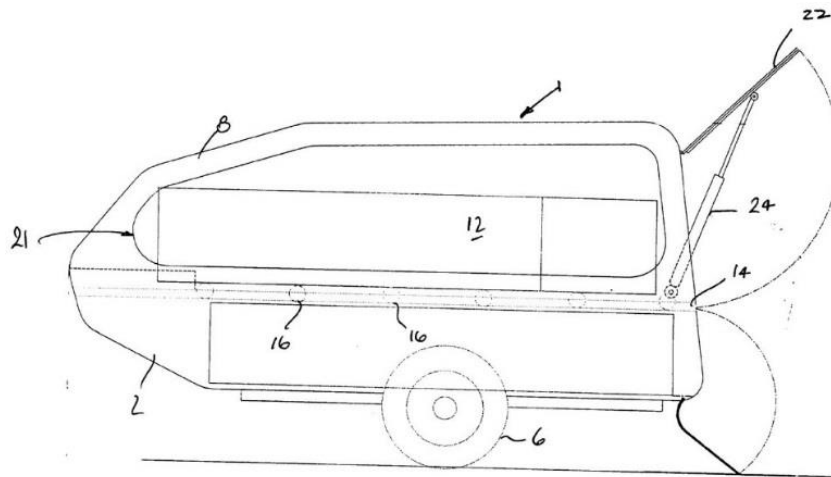


FIGURE 6

4. Claim 1 of the patent is the only independent claim and is outlined below with features identified using the same lettered references as used in the request:
- (a) *“A funeral vehicle in the form of a sidecar*
 - (b) *having a wheeled chassis*
 - (c) *provided with a sidecar superstructure*
 - (d) *defining a covered reception area for the mortal remains of the deceased*
 - (e) *and including an access door through which the mortal remains may be inserted into and removed from said area.”*

The sidecar hearse product of MHL

5. The photographs of the product that accompanied the request show the sidecar hearse with its cover both in place and removed from the sidecar. However, these photographs do not provide a clear indication of how a coffin or casket is slid into and out of its reception area. Nevertheless, the additional photograph of MHL’s sidecar hearse provided by the observer shows the cover in a raised position for the purpose of placing a coffin on the sidecar. This additional photograph is shown below.



Infringement

6. Section 60 of the Patents 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) 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.

7. As the claims relate to a product, only part (a) of section 60(1) is relevant. Section 60(1)(a) and 60(2) cover the certain actions to which the request for opinion on infringement is addressed.
8. In the Supreme Court in *Actavis v Eli Lilly*¹, 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?*
9. If the answer to either issue is “yes”, there is infringement; otherwise there is not.

Does the product infringe as a matter of normal interpretation?

10. I shall start by considering whether the product infringes the patent as a matter of normal interpretation. This means interpreting the claims in the light of the description and drawings as instructed by Section 125(1). In doing so, I must interpret the claim 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 claim to mean. This approach has been confirmed in the recent decisions of the High Court in *Mylan v Yeda*² and the Court of Appeal in *Actavis v ICOS*³.
11. 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.
12. It appears that both requester and observer agree that the product has features (a) to (d) of claim 1, as outlined in paragraph 4 above. Hence, the only part of claim 1 whose construction seems to be in issue is feature (e), namely that the funeral sidecar includes “an access door through which the mortal remains may be inserted into and removed from” the covered reception area.
13. In their request, the patent proprietor refers to a series of photographs of the product with its cover both removed and in place on the sidecar. However, they acknowledge that “a door is not clearly seen in the attached photographs”, but “one

¹ *Actavis UK Limited and others v Eli Lilly and Company* [2017] UKSC 48

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

³ *Actavis Group & Ors v ICOS Corp & Eli Lilly & Co.* [2017] EWCA Civ 1671

must be present in order to allow a coffin to be slid into and out of the reception area... we presume that, with the cover in place..., there is a door in the rear of the cover.” They also suggest that “there could be the option to lift the lid up”, but “this would be cumbersome” and “would not be practical”.

14. The observer has provided the additional photograph of the product illustrated in paragraph 5 above, showing a hinged cover that may be raised for the purpose of placing a coffin on the sidecar. The observer states that the hinged cover of their sidecar hearse product cannot be described as a door and does not include one. Furthermore, they state that their product does not include a ‘doorway’ through which mortal remains may be inserted into and removed from the covered reception area.
15. In response, the requester submits that the hinged cover of the product is a door. To support their submission, they have provided an entry for the word “door” from the Collins English Dictionary. In particular, one definition of a “door” is “a hinged or sliding panel for closing the entrance to a room, cupboard, etc.” They submit that the hinged lid allows access to the reception area and that the mortal remains can be passed through the opening defined when the lid is open in order to insert or remove the mortal remains.
16. In considering the normal interpretation of the claims, I note that the courts have cautioned against too heavy a reliance on dictionary definitions, which are “shorn of any relevant context” – see *Kirin-Amgen Inc. v Roche Diagnostics GmbH*⁴. Instead, as already indicated in paragraph 10 above, the meaning of words is what the skilled person would have understood the author to mean by using these words.
17. Nevertheless, having considered the description and drawings of the patent, I am of the opinion that there is no specific indication or definition anywhere in the specification that would lead a skilled person – whether they be a designer of motorcycle sidecars or funeral vehicles in general – to interpret the expression “an access door” in claim 1 in any other way than its ordinary definition. For example, at page 2 lines 9 to 13, the patent describes the “access door” as of “hatchback design” and further, at page 4 lines 25 to 29, the “glazed hatchback 22 is located at and hinged to the rear end of the superstructure and is so mounted as to facilitate opening and closure”. Hence, in this case, I am of the opinion that the dictionary definition of “door” provided by the requester is an appropriate aid for construing claim 1. I consider that the “access door” of the patent is to be construed as a panel that does open and close the entrance to the reception area for the coffin.
18. However, thus construed, I am of the opinion that the hinged cover of the product does not constitute a door. Whilst it is true that the cover is hinged, as per the “access door” of the patent, I consider that the hinged cover is not a panel that opens and closes an entrance to the reception area. Rather, I am of the opinion that the hinged cover is itself part of the “sidecar superstructure defining a covered reception area” and so the product does not have “an access door” as required by claim 1 as a matter of normal interpretation.

⁴ *Kirin- Amgen Inc. v Roche Diagnostics GmbH* [2002] RPC 1

Does the product infringe because it varies from the invention in a way or ways which is or are immaterial?

19. According to *Actavis v Eli Lilly*¹, this is the second issue to address when considering whether there is infringement. The Court provided a reformulation of the three questions in *Improver* to provide guidelines or helpful assistance in connection with this second issue. 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 that the variant achieves substantially the same result as the invention, that it does so in 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?*
20. In order 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 questions was “yes” and that the answer to the third question was “no”.
21. In their observations in reply, the requester has suggested that the answer to the first two questions should be yes. Whilst I agree with the requester that the variant achieves substantially the same result, namely providing a weatherproof vehicle for attachment to a motorcycle that enables a casket or coffin to be easily manoeuvred into and out of a covered reception area, I am of the opinion that the variant does not achieve this result in substantially the same way as the invention. I consider that the moveable part of the product is a portion of the “sidecar superstructure defining a covered reception area” that lifts to provide access to the “reception area” – it is not an immaterial variant of “an access door”. Hence, I believe that the variant does not operate in substantially the same way as the invention. I also consider that the requester’s suggestion, in their request, that “the option to lift the lid up... would be cumbersome” and “would not be practical” is a further indication that a skilled person would not consider the variant to operate in substantially the same way as the invention. Therefore, I would answer “no” to the first two questions above. For completeness, I would also answer “yes” to the third question since the “access door” is essential to the invention to enable the casket or coffin to enter the (fixed) reception area of the invention.
22. Since I have concluded that infringement cannot be established, there is no need for me to consider the details of each of the certain actions outlined in the request. Furthermore, as I have concluded that claim 1 is not infringed, I do not need to consider any of the remaining claims, each of which is dependent upon claim 1.

Opinion

23. In my opinion, the sidecar hearse product of MHL does not fall within the scope of the claims as a matter of normal interpretation, nor does it vary from the claims in a way that is immaterial. Accordingly, it is my opinion that the actions outlined in Sections 60(1)(a) and 60(2) of the Patents Act in respect of MHL's sidecar hearse product do not infringe GB 2389824 B.

Application for review

24. 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.

Dan Hickery
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.