

OPINION UNDER SECTION 74A

Patent	GB 2479938 B
Proprietor(s)	Dick Beijen, Pauline Kathleen Eaton
Exclusive Licensee	
Requester	Made by Koa
Observer(s)	
Date Opinion issued	24 October 2024

The request

1. The Comptroller has received a request from Made by Koa ('Koa') (the requester) to issue an opinion covering whether GB 2479938 B (the patent) is infringed by the 'koa pillow' (the product).
2. The patent has a filing date of 30 April 2010 and no claim to an earlier priority date. The patent was granted on 18 December 2013 and it remains in force. The proprietors are Dick Beijen and Pauline Kathleen Eaton.
3. No observations were received.

The patent

4. The patent describes a cushion case and also a cushion itself. The claims of the patent comprise three independent claims, two of which are formatted as omnibus claims
5. Claims 1, 12 and 15 of the patent read:
 1. *A cushion case comprising: a first compartment having a pocket; a second compartment; and a hinge region operatively connecting the first and second compartments, wherein the cushion case is movable from a first configuration in which the first and second compartments are substantially unfolded about the hinge region to a second configuration in which the second compartment is at least partially inserted into the pocket such that the first compartment and the second compartment are held in overlapping engagement by the pocket; wherein the cushion case is elongate and the hinge region extends across the width of the cushion case thereby defining*

the first and second compartments either side of the hinge region, the hinge region having a width separating the first and second compartments which is not less than a filled thickness of the first compartment and/or the second compartment.

12. *A cushion case substantially as described herein with reference to the drawings.*

15. *A cushion substantially as described herein with reference to the drawings.*

Infringement

6. Section 60 of the 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) ...

(c) ...

(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. 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?

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

8. If the answer is “yes”, there is infringement; otherwise, there is not.

Claim construction

9. Before I can determine whether there would be infringement of the claims of the patent I must first construe them. This means interpreting them in light of the description and drawings as instructed by Section 125(1) of the Patents Act 1977. In doing so I must interpret the claims 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 claims to mean. This approach has been confirmed in the decisions of the High Court in *Mylan v Yeda*² and the Court of Appeal in *Actavis v ICOS*³.
10. The most pertinent of the claims granted in the patent is claim 1, given that this claim is the only non-omnibus-style independent claim and, *prima facie*, is of broadest scope. Claim 1 of the patent, set out in paragraph 5 of this opinion, defines a cushion case having two compartments, the first of which has a pocket and wherein the hinge region has a width separating the first and second compartments which is not less than a filled thickness of the first compartment and/or the second compartment. It is clear from, e.g. page 1 line 5 and page 4 line 21, that the phrase ‘cushion’ should be construed in a broad context to include what is, in everyday terminology, referred to as a pillow.
11. Regarding the phrase ‘hinge region’, lines 35 and 36 of page 4 of the patent disclose that ‘Each hinge region 20, 22 is defined between a first seam 24 and a second seam 26’. The next sentence of the patent then discloses that the seams secure together two panels of material and *may* be stitched. As far as it is necessary to construe the scope of claim 1 of the patent as it relates to non-stitched hinge regions, the region can be understood as the area in which filling material is excluded. Such construction fits with a standard construction of the phrasing ‘hinge region having a width separating the first and second compartments.’

Does the product infringe claim 1 of the patent as a matter of normal interpretation?

12. As the requester sets out, the product, which they market as ‘Koa pillow’, has hinge regions featuring press studs and which is defined by the outer edge of each compartment/unit and a seam which prevents filler entering the hinge region. As per the comments filed along with the request, this region has a width of 18 mm while the filled depth of each section of the product is 60 mm. As such, the product does not infringe claim 1 of the patent as a matter of normal interpretation as the product has a width separating the first and second compartments which is less than a filled thickness of the first compartment and/or the second compartment.

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

Does the product infringe claim 1 because it varies from the invention in a way or ways which is or are immaterial?

13. In *Actavis v Eli Lilly*¹, see especially [66] thereof, the Supreme Court provided a reformulation of the three questions in *Improver*⁴ to provide assistance in determining whether a variant infringes. 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 the variant achieves substantially the same result as the invention, that it does so 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?*
14. 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 is “yes” and that the answer to the third question is “no”.
15. Before answering the first of the revised *Improver* questions it is necessary to elucidate the inventive concept revealed by the patent. HHJ Hacon, at [222] of *Regen v Estar*⁵, summarised what is meant by inventive concept and also distinguished the inventive concept from the invention as a whole. HHJ Hacon put that:
- Thus, the distinction between the invention as a whole and the inventive concept matters. The invention is that which is claimed, see s.125(1) of the Patents Act 1977. I take the inventive concept or core of the invention to be the new technical insight conveyed by the invention – the clever bit – as would be perceived by the skilled person.*
16. Following the view of HHJ Hacon, while the width of the hinge region being less than the thickness of at least one of the filled compartments may be part of the invention as claimed, it does not necessarily mean that this integer forms part of the inventive concept. Lines 5-12 of page 1 of the patent set out that the problem to be overcome is to provide a cushion/pillow of less bulk to aid in the ease of cleaning and drying. This is achieved in the patent by the use of at least two sections that may be folded atop one another wherein, as per lines 3-7 of page 5 of the patent, this is facilitated by the width of the hinge region(s) being sufficient to allow adjacent compartments to be folded against each other about the respective hinge regions without excessive impingement of the compartments in the vicinity of the hinge regions. Lines 15-17 of

⁴ *Improver Corporation v Remington Consumer Products Ltd* [1990] FSR 181

⁵ *Regen Lab SA v Estar Medical Ltd* [2019] EWHC 63 (Pat)

page 5 of the patent disclose that the absence of filler in the hinge regions allows them to exhibit a greater flexibility than the filled compartments.

17. Regarding questions (i) and (ii) of the reformulated Improver questions, the answer is 'yes'; the product achieves the same outcome as the invention defined by the patent of having a pillow of a depth that is comfortable for use, being easier to clean and quicker to dry by virtue of having less thickness and/or bulk and this being achieved through a number of foldable sections. It would be obvious to the skilled person that a substantially similar result would be achieved through a substantially similar way.
18. Turning to the third question, I must assess whether the reader of the patent would 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. In this regard, I note that HHJ Hacon, in *Regen v Estar*⁵ quotes from paragraph 65 of *Actavis v Eli Lilly*¹ and, at [224] of *Regen v Estar*⁵, himself says that:

The third Improver question requires the court to consider whether the relevant integer, that corresponding to the alleged equivalent, would have been regarded by the skilled person as an essential part of the inventive concept. It is clear from Lord Neuberger's judgment [in Actavis v Eli Lilly] that having done so, it is possible for the court to reach a view that even though the language of the claim does not on any sensible reading cover the variant, this is not of itself enough to justify answering yes to the third question.

19. I note that the patent does not on a sensible reading cover the variant forming the product, but as HHJ Hacon directs me, this is not enough to show that the applicant intended strict compliance with the literal meaning of claim 1. To determine how I can reach a conclusive answer to the third Improver question I have considered the words of Caddick QC of *Vernacare Ltd v Moulded Fibre Products*⁶ in which he considered the Formstein defence (of relevance to the present question of determining infringement by equivalents), as well as earlier comments of Birss LJ⁷ in relation to the Formstein defence, before concluding, at paragraph 67 of *Vernacare v Moulded Fibre Products*⁶:

In the alternative, it seems to me that for the same reasons, the third Improver question would be answered in MFP's favour in that the skilled person would have concluded that the patentee did intend a strict compliance with the literal (i.e. normal, purposive) meaning of claim 1, because the claim would otherwise be invalid for obviousness

20. To answer this question about if the patentee intended strict compliance, I am stepping outside the documents filed with the request. I believe that such an approach is valid as doing so provides a definitive answer to the third *Improver* question as it shows that strict compliance with the literal meaning was intended to overcome obviousness. During the examination process that led to the patent being granted, the applicant, via their representative, stated, in a letter to the Office of 01

⁶ *Vernacare Ltd v Moulded Fibre Products (MFP)* [2022] EWHC 2197 (IPEC)

⁷ See [201] of *Facebook v Voxer* [2021] EWHC 1377

February 2013, that *'The hinge region between the compartments is at least as wide as the filled thickness of the compartments...This minimum width of the hinge region allows the filled compartments to be folded into the pillow configuration without requiring any cushion material to be compressed, thereby making the process of folding the compartments and inserting one compartment into the pocket easy to perform...Further, there is no disclosure or suggestion [in the prior art] of a pillow case having a hinge region with a width no less than the thickness of the filled compartments....Accordingly, we submit that the invention defined in independent claim 1 is both novel and inventive over the cited prior art.'* I also note that all other features present in claim 1 of the patent were objected to as lacking novelty and/or inventiveness within the first issued GB exam report. Thus, with reference to both the first issued GB exam report, dated 01 October 2012, and the agents letter of 01 February 2013, it is clear that the feature of the hinge region having a width separating the first and second compartments which is not less than a filled thickness of the compartments is present because claim 1 of the patent would otherwise lack novelty and/or inventiveness. Consequently, following the words of Nicholas Caddick QC given at the end of paragraph 19 of this opinion, the third of the reformulated *Improver*⁴ questions must be answered 'yes'.

21. Given that, at [66] of *Actavis v Eli Lilly*¹, Lord Neuberger pointed out that:

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'.

I must conclude that there is no infringement of claim 1 of the patent on the basis of equivalence.

Consideration of omnibus claims present in the patent

22. The patent comprises two omnibus claims, numbered as claims 12 and 15. Noting that omnibus claims are now rarely granted, guidance on how to properly construe an omnibus claim is not readily forthcoming and it is widely accepted that the scope of protection of an omnibus claim is difficult to ascertain.⁸
23. To the extent that claims 12 and 15 are construed as covering the products covered by the drawings, they are not infringed by the product. Figures 1 and 2 of the patent disclose a product comprising two pockets, reference numerals 14 and 30. Whilst lines 7 and 8 of page 6 of the patent disclose that Figure 3 of the patent comprises a single pocket, Figures 3 and 4 both comprise sewn seams as a means of joining separate compartments. Figures 5-7 of the patent are alternate views of the cushion already shown in earlier figures. The Koa pillow, insofar as it comprises poppers to join compartments (cf Figures 3 and 4 of the patent which shows sewn seams) and only one pocket (cf Figures 1 and of the patent which shows two pockets), does not infringe the patent having regard to the omnibus claims relating to the embodiments of the figures.

⁸ See, e.g., [68] of *Environmental Recycling Technologies Plc v Upcycle Holdings Ltd* [2013] EWPC 4

Opinion

24. In my opinion the product does not fall within the scope of the claims as a matter of normal interpretation.
25. Further, I do not believe that the product infringes the scope of the claims of the patent under a doctrine of equivalents.

Application for Review

26. 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

Robert Goodwill
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.