

OPINION UNDER SECTION 74A

Patent	GB 2219386
Proprietor(s)	Metro Products (Accessories & Leisure) Ltd
Exclusive Licensee	
Requester	G. F. Redfern & Co., on 20 February 2007
Observer(s)	Metro Products (Accessories & Leisure) Ltd
Date Opinion issued	10 May 2007

The request

1. The Comptroller has been requested to issue an Opinion as to whether a proposed new dipped beam deflection patch (hereinafter "the New Product") infringes claim 1 of patent GB 2219386 in the name of Metro Products (hereinafter "the Metro patent") and, if so, whether the Metro patent is valid in light of GB 2208538 in the name of Harper (hereinafter "the Harper patent application"). A sample of the New Product has been provided and is discussed in a statement accompanying the request.

Observations

2. Observations were filed on behalf of the proprietor submitting that the Requester had not proven that the Harper patent application forms prior art with respect to the Metro patent and that there is insufficient factual material on the New Product for an Opinion of non-infringement to be given.

Observations in reply

3. Observations in reply to the observations of the proprietor were filed by the Requester asking for an Opinion based on the assumption that the Harper patent application forms prior art and submitting that there is sufficient factual material for an Opinion of non-infringement.

The approach I shall take

4. The Requester seeks an Opinion on infringement first, and only if I consider the patent infringed, to go on and assess validity. However, in view of the non-binding nature of Opinions, and the consequent fact that I make no formal finding as to validity or infringement, I will consider both. It seems logical to consider the issue of validity first.

The Metro patent

5. The Metro patent has a filing date of 26th May 1989 and claims a priority date of 1st June 1988. It relates to a light-deflecting patch for a motor vehicle headlamp. The patch is attached to the outside of the headlamp lens and deflects the dipped headlamp beam so as to make the vehicle suitable for driving in countries where vehicles are driven on the opposite side of the road. The patch comprises a wedge shaped optically transparent deflecting material through which the dipped headlamp beam passes. The deflection properties are provided by a number of parallel grooves extending from the top to the bottom of the surface of the optically deflecting material to give a series of prisms across its width in the manner of a Fresnel lens.

6. Claim 1 is the sole independent claim and reads:

“A light-deflecting patch for attachment to a headlamp surface through which a dipped beam and a full beam are alternatively projected, which patch comprises a transparent optically deflecting material shaped to cover the portion of the headlamp surface through which the dipped beam is projected but not to extend beyond this portion in a way that would deflect substantial other portions of the full beam.”

7. There are two points worth noting about the form of claim 1. Firstly, the claim is directed to a light-deflecting patch for attachment to a headlamp, i.e. a patch suitable for attachment to a headlamp. Secondly, the claim defines the shape of the optically deflecting material of the patch by reference to the headlamp surface.

The Harper patent application

8. Before I consider the Harper patent application in detail, I will look at the relevant publication and priority dates. The application was filed on 1st August 1988 (after the claimed priority date of the Metro patent) claiming a priority date of 31st July 1987 (before the claimed priority date of the

Metro patent) and was published on the 5th April 1989 (between the claimed priority date and the filing date of the Metro patent).

9. The observations filed on behalf of the proprietor submit that claim 1 of the Metro patent is entitled to its claimed priority date of 1st June 1988 and refer to paragraph 3 on page 5 of the priority document for support. Having the benefit of the Metro patent case file in front of me including the priority document, I am satisfied that claim 1 of the Metro patent is entitled to its priority date of 1st June 1988. Thus the Harper patent application does not form prior art by virtue of Section 2(2) of the Patents Act 1977 because it was published after the earliest date of the Metro patent.
10. The question arises whether the Harper patent application forms part of the prior art by virtue of Section 2(3) of the Act, i.e. whether it has an earlier priority date than that of the Metro patent and is therefore potentially citeable for the purposes of novelty. In their statement the Requester treats the Harper patent application as relevant for the purposes of Section 2(3) on the basis of its claimed priority date but does not provide any evidence to support its entitlement to this date. This point has been picked up in the observations. The case file for the Harper patent application has been destroyed in line with Office policy and so unfortunately it is not possible without further evidence to arrive at a firm conclusion one way or the other. Rather than reject outright the request for an opinion on validity as called for in the observations, I feel the best approach is nevertheless to form a view on the validity of claim 1 of the Metro patent. After all, if my view is that the Metro patent is valid, the priority date becomes irrelevant. If on the other hand I consider the Metro patent to be invalid in light of the Harper patent application, that must remain a provisional view for the purposes of this Opinion. I will proceed on this basis and will now look at the teaching of the Harper patent application in detail.
11. The Harper patent application is also concerned with converting a vehicle headlamp beam so that it is suitable for driving on the opposite side of the road. The disclosure is broadly as set out in claim 1 which reads:

“Means for diffusing a preselected portion of a dipped headlamp beam, the diffusing means being applied to the exterior surface of the lamp and the preselected portion being that portion of the beam which would otherwise dazzle on-coming drivers on the opposite side of the road.”
12. The description provides guidance on what is meant by “the preselected portion” of the dipped headlamp beam. In one embodiment the diffusing means “is a sheet of flexible plastics material having an adhesive

backing, the sheet being shaped to define, or having delineated thereon, a translucent area of generally trapezoidal shape. After cutting the translucent area to the required size and peeling away a release backing, the translucent material is *adhesively bonded to that portion of the headlamp lens which produces the upwardly inclined edge portion of the dipped beam*" (emphasis added). The description also states that in the case of a universal headlamp converter kit, the converter is cut to suit the size and/or type of the headlamp "so that only the relevant part of the headlamp beam is diffused".

13. Although the claim is directed to a means for diffusing, which I take to mean defocusing and dispersing, a preselected portion of a dipped headlamp beam, in a preferred embodiment the diffusing means takes the form of a Fresnel lens so that the beam is refracted (deflected) as well as diffused.
14. The Harper patent application therefore teaches a patch comprising transparent optically deflecting material shaped to cover only a preselected portion of the headlamp surface through which the dipped beam is projected, the preselected portion being that portion which produces the upwardly inclined edge portion of the dipped beam.

The validity of claim 1 of the Metro patent

15. I agree with the Requester that the relevance of the Harper patent application hinges on the interpretation in claim 1 of the Metro patent of the phrase "a transparent optically deflecting material shaped to cover the portion of the headlamp surface through which the dipped beam is projected". The Requester puts forward two possible interpretations: a first interpretation which includes a patch covering only a portion of the area of the headlamp surface through which the dipped beam is projected, and a second interpretation in which the patch covers the whole of this area.
16. In order to determine the proper construction to put upon this passage I shall follow the standard principles of claim construction as set out in *Kirin-Amgen and others v Hoechst Marion Roussel Limited and others [2005] RPC 9*. I must put a purposive construction on claim 1, 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. Put simply, and as emphasised by Hoffmann LJ in that judgment, 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.
17. Looking at the wording of the claim I am not sure why the Requester has

raised the possibility of interpreting the claim to mean a patch (or more correctly the optically deflecting material of the patch) covering only a portion of the area through which the dipped beam is projected. The claim says “to cover the portion of the headlamp surface through which the dipped beam is projected” (emphasis added) and so the natural interpretation is that it covers the whole of the area.

18. Turning to the description of the Metro patent, there is a consistency clause adopting the exact wording of claim 1 followed later by an explanatory passage which reads:

“The optically deflecting material should have an area and shape that will cover substantially all of the portion of the headlamp surface through which the dipped beam is projected but should not extend beyond this portion in a way that would deflect substantial other portions of the main beam. According to the invention this is achieved by making the optically deflecting material of generally wedge shape.”

19. A brief passage towards the end of the description is also helpful:

“The user selects a patch of suitable type and size and attaches it to the front of a headlamp so as to cover the segment through which the dipped beam emerges. Surface markings on the headlamp glass usually clearly indicate the required position.”

20. These passages support the natural interpretation of the wording of the claim. Thus I conclude that the correct construction to place on claim 1 is one in which the transparent optically deflecting material is shaped to cover all, or substantially all, of the portion of the headlamp surface through which the dipped beam is projected. I have included the possibility “or substantially all” because I think a skilled person reading the specification would understand that a small degree of leeway in coverage is permissible, perhaps even unavoidable.
21. Following this interpretation there is a clear distinction between claim 1 of the Metro patent in which the optically deflecting material covers all (or substantially all) of the portion of the headlamp surface through which the dipped beam is projected and the Harper patent application in which the material covers only the preselected portion of the surface through which the upwardly inclined edge portion of the dipped beam is projected. Therefore I consider claim 1 of the Metro patent to be novel over the disclosure of the Harper patent application. There is no possibility that the Harper patent application could be relevant for inventive step in view of the relative dates of the two patents as noted above. Since I consider Metro to be novel, the question of whether the Harper patent application is entitled to its priority date becomes

irrelevant.

Infringement

22. I will now go on to consider the infringement aspect of the request.
23. The proposed new dipped beam deflection patch ("the New Product") provided by the Requester is a generally oval shaped piece of flexible, transparent plastic and fits roughly in the palm of the hand. Formed in the middle is a 90 degree wedge shaped arrangement containing a number of fine concentric ridges. The Requester indicates that the wedge shaped arrangement acts as a Fresnel lens to optically deflect light.
24. In their statement the Requester explains that in use the New Product is attached by an adhesive on its inner surface to a modern vehicle headlight towards the bottom left and is deliberately sized and shaped to cover only a preselected portion of that part of the headlight surface through which a dipped beam is projected. Although not made explicitly clear, I assume the New Product would be fitted to each headlight on a right hand drive vehicle. The Requester states that the Fresnel lens arrangement is shaped and adapted to optically deflect only the upper left hand part of the dipped beam which would be directed towards oncoming traffic when the vehicle is abroad, and not to affect any other part of the dipped beam. The Requester stresses that in all cases of intended use the whole of the New Product is always smaller in size than the portion of the headlight surface through which the dipped beam is projected.
25. When discussing the infringement position the Requester refers to a difficulty in interpreting the scope of claim 1 of the Metro patent brought about by its reference to the headlight (or headlamp) surface and changes in headlight design since the date of the Metro patent. The Requester asserts that the area of a modern headlight surface through which a dipped beam is projected is far larger than a headlight of 20 years ago. Consequently a preselected portion of that area of a modern headlight might be comparable in size to the whole of that area of an older headlight. The Requester puts forward two possible interpretations of the Metro claim: i) that the claim should be interpreted as covering only patches which are designed for use with headlights dating around the time of filing of the patent (the late 1980's), or ii) that the claim should be interpreted as covering only a patch which covers the whole area through which the dipped beam is projected on a modern day headlight. In either case the Requester argues the New Product should be considered not to infringe.

26. I note that the Requester has not provided any evidence to support the comments on how headlights have changed over the last 20 years. That said, the proprietor does not dispute them. For the purposes of my discussion I will assume the comments are well founded.

27. To assist in determining the scope of claim 1 I will again turn to the description of the Metro patent. Of particular note is a passage on page 10 of the description:

“The invention offers the advantage over the opaque patch system that selection from a small standard range of sizes of patch can accommodate virtually every size and shape of headlamp.”

28. At the time of drafting the patentee therefore recognized the need for a range of differently sized patches to cover variations in headlamp shape and size. I find further evidence of this in the passage quoted at paragraph 19 above. Furthermore, there is nothing in the description to suggest that the invention is limited to a particular type of headlamp. In addition, although I am assuming the Requester’s comments are correct, I am not sure if they provide a complete picture. No doubt, although headlamp design may have evolved towards larger dipped portions, as the Requester asserts, there also exists a range of different overall sizes and geometries of headlamp today as there did in the late 1980’s. Consequently I do not think a skilled person would interpret claim 1 as covering only patches for headlamps from a particular era but would have in mind that the claim would include a range of patches suitable for headlamps of different shapes, sizes and ages.

29. Having established that claim 1 is not limited to a patch for a specific type of headlamp, I will now assess the New Product against the feature of claim 1 that is at issue, namely whether it comprises a transparent optically deflecting material shaped to cover the portion of the headlamp surface through which the dipped beam is projected but not to extend beyond this portion in a way that would deflect substantial other portions of the full beam.

30. As described the New Product is intended for a modern day headlight and is designed so that the Fresnel lens covers only the preselected portion of the headlight surface through which the upper left hand part of the dipped beam is projected. When put into use in the way intended it seems to me that the reasoning adopted with respect to the Harper patent application applies and so the New Product would not infringe claim 1 of the Metro patent which requires the deflecting material to cover the whole portion.

31. The situation becomes more complicated however if the New Product could be used on a headlight whose shape and size are such that substantially more than the preselected portion would be covered by the Fresnel lens to the point where the whole or substantially the whole of the portion of the headlight through which the dipped beam passes was covered. Conceivably the New Product could then fall within the scope of the Metro patent. There is no evidence to suggest the New Product couldn't be used in this way. On the other hand the shape of the active part of the New Product patch may in all cases render it ineffective to cover the whole portion of whatever headlight it might be attached to.
32. Although the Requester places emphasis on the intended use of the New Product, I do not think this necessarily prevents the New Product from falling within the scope of claim 1 of the Metro patent if used improperly. The wording "shaped to cover" in the claim relates to the geometry of the deflecting material (albeit in relation to an unspecified headlamp surface) and does not carry with it the intentions of the manufacturer. Furthermore, as noted above, the claim only requires the patch to be suitable for the purpose.
33. In the observations in reply the Requester indicates that the New Product will be provided with literature which clearly instructs the user to only ever affix the New Product such that a small pre-selected portion of the headlight surface through which the dipped beam is projected is covered. Again, I do not think this necessarily prevents the New Product from falling within the scope of the Metro patent. A user will still be at liberty to use the New Product to cover more than this area.
34. The Requester also states in the observations in reply that if the New Product were used to cover the whole of the area through which the dipped beam is projected then this would constitute a misuse of the New Product and it would not function correctly. Presumably such use would nevertheless result in the deflection of the offending portion of the dipped beam and potentially make the vehicle suitable for driving abroad.
35. I am therefore drawn to the view that the infringement position will depend upon the relationship between the New Product and the headlight to which it is attached. That is to say, a New Product when properly used with the headlight which it is intended for would not infringe; but if it were possible for a patch to be used with a different headlight, which it was not designed for, in such a way that the active part covered the whole portion of the surface through which the dipped beam is projected but did not extend beyond this in a way that deflected substantial other portions of the full beam, then it would infringe. As I say, this requires that such unintended use were possible. If the shape of New Product patches and headlight layouts is such as to preclude this

possibility, infringement could not arise in this way.

36. From the information provided by the Requester, the main threat of infringement would appear to be in relation to old style headlights with dipped beams projecting through a smaller area of the headlight surface compared to more recent headlight designs. The New Product is said to be designed for mass market modern day headlights but no information has been provided on what would constitute a “modern day” headlight. If the New Product is intended for use with only the very latest vehicle headlight designs then this would perhaps increase the potential for infringement.
37. This odd situation comes about, it seems to me, from the form of the Metro claim, which, as noted above, defines the shape of the optically deflecting material of the patch by reference to the portion of the headlamp surface through which the dipped beam is projected. A patch according to the invention is therefore not defined absolutely within the terms of the claim; for a complete definition it is necessary to consider the patch in relation to the particular headlamp that it is designed for. The question of infringement can consequently only be determined by considering a patch in relation to a particular headlamp and the way in which it is applied to the headlamp.
38. Having reached this conclusion, it may be worth observing that if the question of infringement in a particular case is unclear because of uncertainties in the scope of the claim arising from the form in which it is drafted, it might be thought unlikely that the question would be resolved in favour of the patentee.
39. Consequently, although a technical risk of infringement appears to exist, in practice it seems unlikely that any actionable infringement would arise from use of the New Product.

Sufficiency

40. Lastly I note that the Requester also raises the issue of whether claim 1 of the Metro patent is insufficient because of the way in which it defines the technical features of the invention by reference to something which is not part of the invention, namely the headlamp. I should point out that sufficiency is not an issue I can consider in an Opinion. A request for an Opinion as to validity can be made only on the grounds of novelty and/or inventive step, as provided in Section 74A(1)(b). Consequently I will say no more on the sufficiency or otherwise of the Metro patent.

Opinion

41. I conclude that claim 1 of the Metro patent is novel over the Harper patent application. As regards whether the New Product infringes claim 1 of the Metro patent, my view is that use as intended will not infringe. If it is possible for a “New Product” patch to cover the whole of the dipped beam part of any headlight, there appears to be a technical risk of infringement arising through incorrect use. However it appears unlikely that any actionable infringement would arise in practice.

Application for review

42. Under section 74B and rule 77H, the proprietor may, within three months of the date of issue of this opinion, apply to the comptroller for a review of the opinion.

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 Patent Office.

Matthew Nelson
Examiner