

OPINION UNDER SECTION 74A

Patent	GB 2410415
Proprietor(s)	Mrs Penelope Mary Townsend
Exclusive Licensee	
Requester	Mrs Penelope Mary Townsend, on 7 July 2006
Observer(s)	Mr Dave Niblock
Date Opinion issued	3 October 2006

The request

1. This opinion relates to a request as to whether the sale in the UK of a certain sock by Hunter Boot Ltd infringes claims 1, 7, 8, 11 and 12 of the Patent.

2. The request is accompanied by the following items:

item I: a sample pair of socks as sold by Wellywarmas Ltd, of which company the Requester is a director;

item II: a sample pair of the socks in question, offered for sale by Hunter Boot Ltd;

item III: a colour photocopy of two sides of the box in which the Hunter socks were sold, according to the Requester, and

item IV: a colour print of a screen display from the Hunter Boot Ltd website <http://www.wellie-boots.com/ukmofcart/accessories.html> on 4 July 2006 referring to their Welly Warmers and a print of the “large picture” of the Welly Warmers referred to on that page. (I note that, as I write in early September 2006, this url no longer exists, having been replaced by <http://www.wellie-boots.com/hunter-welly-warmers.htm> which seems to give similar information and images.)

3. To avoid confusion between the names “Welly Warmers” and “Wellywarmas” I shall refer to the products as the “Hunter socks” and the “Wellywarmas socks” respectively.

Observations

4. Observations dated 1 August 2006 have been filed by H David Niblock of Hunter Boot Ltd. They give some background information, such as that their

“Welly-Warmers” were designed and launched to complement their new range of brightly coloured boots in the middle of 2004, and some comments on the differences between their product and the Wellywarmas product. I shall refer to those comments in due course.

5. Observations in reply were filed by the Requester on 29 August 2006 and I shall refer to them at appropriate points in the following discussion.

Discussion

6. The patent was granted on 15 February 2006 and is still in force (the earliest date of the application being 30 March 2004). Thus the patent was in force in when the Hunter socks were being offered for sale (including in the UK) via their website.

7. The Patent relates to a removable sock for a boot, eg a Wellington boot, that is, according to the specification, intended to eliminate or mitigate the problems that *“when wearing a Wellington boot, they can often feel cold, they do not fit tightly, and often especially with young children the sock inside slips down to their toes. This is uncomfortable”*.

8. The specification’s sole independent claim has not been amended since the Patent was granted and reads as follows:

“A sock of flexible fleece fabric material for removably fitting in a boot, the sock including a lower, foot portion of flexible, fleece fabric material, for fitting snugly within the boot, an upper portion of flexible, fleece fabric material, for fitting snugly around the inside of the upper portion of the boot and an outer portion of flexible, fleece fabric material that extends downwardly from the top of the upper portion for fitting snugly around the outside of the top of the boot and for defining a channel between the outer portion and the upper portion in which the top of the boot is, in use, received, the sock comprising a plurality of pieces of material stitched together, the lower, foot portion being formed of a piece of flexible, fleece fabric material and the upper portion being formed of a further piece of flexible, fleece fabric material.”

9. Being able to handle and inspect the actual Hunter sock has helped me greatly in assessing the extent to which it possesses the features required by claim 1 of the Patent. I should add that I find the sample Wellywarmas sock to be fully consistent overall with what is shown, described and claimed in the Patent and I note that the Requester says of the sample sock that *“The item is the subject of my Patent with minor differences only between the item and the example of the invention described with reference to the drawings.”*

10. Before addressing claim 1, I can see straight away that the Hunter sock is made exclusively from pieces of flexible fleece fabric material stitched together. The sock has a foot part, consisting of a single piece of material, and a tubular leg part that also consists of single piece of material seamed at the back. The same material appears to have been used for both the foot part and the leg part. The leg part terminates upwardly in a cuff-like top part of similar material but of greater

thickness; I can tell (by being able to pull them apart) that this top part consists of two layers of the same material as used for the foot part and for the leg part. A line of stitching runs around the sock between the leg part and the top part so that although a first glance could suggest that these two parts were initially separate I am sure from a close examination that the top part of the Hunter sock was formed by turning over a length of the leg part back on itself. Concerning the stitching, the Observer states that "Hunter stitching is to the inside of the foot, GB2410415 is to the outside" but I do not need to dwell on this point since the manner of stitching is not a feature of any of claims 1, 7, 8, 11 and 12.

11. The Observer remarks that:

"This product (the Hunter sock) is designed to be pulled on to the foot to full height, the foot inserted to boot & the top of the sock pulled over the boot as a collar. This has the effect of being an integral part of the boot however it is removed when the foot is removed and does not form a lining for the boot. In effect it is a sock or stocking as described on the packing. The invention described under GB2410415 is designed to be inserted to the boot as a liner prior to the foot; this would be difficult, if not impossible without wrinkles wearing the Hunter Socking type product."

The Wellywarmas sock is certainly intended to be inserted into the boot prior to the foot because it is stated in the Patent (page 2, lines 38-41) that *"In use a person places the sock in the boot in the position shown in figure 2 and then inserts his or her foot into the sock."* but in her observations in reply (paragraph b), the Requester makes the point that the way the product is used is *"somewhat irrelevant as all the claims of my patent are directed to a product, not the way of using the product"* but she goes on to say that *"I think it is clear that the Hunter product and the product of my patent do not differ in any material respect in terms of the extent to which each might be regarded as a liner for a boot or a sock for a foot."* I agree fully with the latter comment, although I would comment that claim 1 includes explanations of how the sock is related to the boot in use and that claim 11, which is directed to a combination of boot and sock, could be regarded as amounting to a claim to a way of using the product.

12. I shall now compare in detail the sample Hunter sock with claim 1 of the Patent. The first part of the claim reads as follows:

"A sock of flexible fleece fabric material for removably fitting in a boot, the sock including a lower, foot portion of flexible, fleece fabric material, for fitting snugly within the boot, an upper portion of flexible, fleece fabric material, for fitting snugly around the inside of the upper portion of the boot"

It can be seen from what I have said concerning my initial inspection of the Hunter sock that I am in no doubt that it satisfies this part of the claim. My only caveat is that I am not sure how much attention to pay to the requirement for the sock to fit the boot *"snugly"*, partly because this would depend in practice also on the size of the boot, but I do not think that this is likely to be a significant feature; indeed, the Hunter sock would not differ from the Wellywarmas sock (or any other sock of this general kind) in this respect.

13. The last part of the claim requires the sock to comprise:

“a plurality of pieces of material stitched together, the lower, foot portion being formed of a piece of flexible, fleece fabric material and the upper portion being formed of a further piece of flexible, fleece fabric material.”

Again, there is no doubt from my initial inspection that the Hunter sock satisfies this part of the claim.

14. I now come, lastly, to the middle part of claim 1 which requires:

“an outer portion of flexible, fleece fabric material that extends downwardly from the top of the upper portion for fitting snugly around the outside of the top of the boot and for defining a channel between the outer portion and the upper portion in which the top of the boot is, in use, received”.

Does this just mean that the top (or outer) portion of the sock can in use be turned down to form a channel for receiving the top of the boot – which, I note, is the argument put forward by the requester - or should it alternatively be construed to have the more restrictive meaning that there is something inherent in the sock that means that the outer portion extends downwardly from the upper portion?

15. This question arises because (a) in the only embodiment described and illustrated the sock is made by placing a distinct outer portion around the upper portion and then stitching it into place so that it extends downwards and (b) the passage at page 1, lines 37 to 41 tells the reader:

“The sock may in its natural (unstressed) state have the outer portion extending upwardly from the upper portion; in that case a user may fold the outer portion down over the top of the boot before inserting a foot into the combination of the boot and sock. Preferably, however, the outer portion extends downwardly from the upper portion in the natural state of the sock.”

16. The most up-to-date authority on claim construction is Hoffman LJ in *Kirin-Amgen and others v Hoechst Marion Roussel Limited and others* [2005] RPC 9. Following that authority, 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. To put it simply, 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.

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.”

while the Protocol on the Interpretation of Article 69 of the EPC states that:

“Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties”.

17. To my mind the passage at page 1, lines 37 to 41 can be construed in two ways. Either both sentences relate to constructions that are intended to be covered by claim 1 – which I shall call the first interpretation - or the first sentence is intended to relate to constructions which are commonplace, well known with many ordinary boot socks, and only the second sentence relates to the invention of claim 1 – which I shall call the second interpretation. I assume that the “natural state” of the sock is the one pertaining just after the parts have been sewn together and the sample Wellywarmas sock is entirely consistent with this assumption, it being clear to me that a distinct outer portion was placed around the upper portion before stitching.

18. There is no doubt in my mind that the top of the Hunter sock is intended to be turned down to form a channel for receiving the top of the boot provided that the sock is long enough and wide enough (I observe here that the claimed sock is for use in any boot, not just in (tall) Wellington boots). Hence under the first interpretation the Hunter sock would clearly satisfy this part of the claim. However, the top of the Hunter sock does not *inherently, or in its natural, unstressed state* extend downwardly, if my assumption about the meaning of the “natural state” is correct, so under the second interpretation the Hunter sock would not satisfy this part of the claim.

19. Although I find the second interpretation attractive in the light of the passage at page 1, lines 37 to 41, the following important considerations point the other way:-

(a) the presence of claim 2 which reads:

“A sock according to claim 1, in which the outer portion is formed of a still further piece of flexible, fleece fabric material joined to the upper portion by stitching”

It follows logically from this that the outer portion of claim 1 need not be a separate piece, contrary to what appears to be required for the outer portion to extend downwardly *inherently* or in its *natural state*. The requirement for the outer portion to be a distinct piece of material was in appendant claim 7 in the claims as originally filed, but was incorporated into claim 1 in the voluntarily amended claims filed 16 May 2005 and published in the A-document. This remained the case in the

next amended claims, filed 19 July 2005 in response to the Combined Search and Examination report, but the requirement was removed from claim 1 in the last, voluntary, amendments that were filed 1 November 2005. From this I conclude that the presence of claim 2 is unlikely to be a matter of accident.

(b) the lack of any mention in claim 1 of the adjectives “natural” or “unstressed” for the state of the sock that would have linked the claim clearly to the passage at page 1, lines 37 to 41.

20. The point is a finely balanced one, and it seems to me that neither interpretation would clearly present itself as the preferred one to a skilled person. However, to go with the second interpretation would require the skilled person to assume that neither the passage at lines 37 to 41 of page 1 nor claim 2 means what it says. Moreover, although claim 1 refers to the outer portion extending downwardly, it does not require this to be in the natural or unstressed state of the sock, so that, for example, the Wellywarmas sock would not itself satisfy claim 1 when its outer portion is unfolded with the outer portion extending upwardly. Thus I believe that the skilled reader, faced with the two interpretations, would have greater misgivings about assuming that the patentee had used the language of the claim according to the second interpretation. Having so construed claim 1, I conclude that the Hunter sock does satisfy the middle part of the claim.

21. Having come to the conclusion that the Hunter sock satisfies the requirements of claim 1 of the Patent I now turn to the appendant claims 7, 8, 11 and 12.

22. Claim 7 reads as follows:

“A sock according to any preceding claim, in which different portions of the sock are formed of materials of different weights.”

As I said in paragraph 10 when reporting my initial inspection of the sample Hunter socks, the same material appears to me to have been used for both the foot part and the leg part of the Hunter sock (there are no other parts). However, the Request contains the comment (in paragraph 6) regarding the Hunter sock that *“the outer portion is of double thickness and therefore double weight compared to the upper portion or the lower portion of the sock.”* This remark is true insofar as the outer portion is concerned but claim 7 requires different portions to be formed of *materials* of different weights. There is nothing to suggest that the *material* used in the outer (top) portion of the Hunter sock is of a different weight from that used in the foot portion, it has simply been doubled over. This is confirmed by the Observer who says that “the Hunter product has selected one fabric to be suitable for all areas of the foot and leg”. In her observations in reply (paragraph c), the Requester returns to the question of the weight(s) of the materials but merely makes the indisputable point that claim 1 of the Patent I silent about such matters. Having considered all the material before me, I am satisfied that the requirements of claim 7 are not met by the Hunter sock.

23. Claim 8 is properly appendant to claim 7 (it requires the outer portion of the sock to be formed of a material of heavier weight than the lower portion) and is

therefore not satisfied by the Hunter sock.

24. Claim 11 reads as follows:

“A boot and sock combination comprising a boot and a sock according to any preceding claim, the lower, foot portion of the sock fitting snugly inside the boot, the upper portion of the sock fitting snugly around an upper portion of the boot and an outer portion of the sock extending downwardly from the top of the outer portion of the sock and fitting snugly around the outside of the top of the boot.”

It seems clear to me that the passage of claim 11: “an outer portion of the sock extending downwardly from the top of the outer portion of the sock” is not correct and was intended to read: “the outer portion of the sock extending downwardly from the top of the upper portion of the sock”. Since this passage merely repeats what has already been established in claim 1, the last part of claim 11 could have been drafted more concisely as: “...and the outer portion of the sock fitting snugly around the outside of the top of the boot.” Since it is explained clearly in claim 1 how the sock and boot are combined in use, claim 11 (notionally corrected) does not differ significantly in scope from claim 1 and I find that the Hunter sock, when combined with a suitable boot, would also satisfy claim 11.

25. Paragraph 7 of the Request makes the following comment concerning infringement and claim 11 (the “items” referred to are as set out in paragraph 2 of this opinion):

“Claim 11 is directed to a combination comprising a boot and a sock...The sock of item II is not sold in a boot and therefore the sale of item II may not be infringement under section 60(1), but when sold to a customer in the United Kingdom I believe it is infringement under Section 60(2), especially bearing in mind both items III and IV which show boots with socks fitted in the boots in the manner defined in claim 11. A purchaser of a sock is clearly intended to place the sock in the boot in the position shown for the boots in items III and IV.”

Section 60(1) states:

“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 process...

(c) where the invention is process...”

Section 60(2) states:

“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.”

I agree with the Requester that the sale of a sock alone cannot infringe a claim to a combination of a sock and a boot under section 60(1) but can do so under section 60(2) because I believe that it would be obvious to a reasonable person that the Hunter sock is intended to be used with a boot in a way that meets fully the requirements of claim 11 of the Patent.

26. Claim 12 reads: “A boot and sock combination according to claim 10, in which the boot is a Wellington boot.” There is no doubt that claim 12 should have been appended to claim 11 instead of claim 10 because claim 10 is an omnibus claim relating to the sock *per se* and claim 11 is the only other claim directed to a boot and sock combination. Having said that, there is no doubt from the material referred to in paragraph 2(iv) above that the Hunter sock is intended to be worn with a *Wellington* boot and thus that claim 12, with its appendancy notionally corrected, is satisfied by the Hunter sock.

Opinion

27. The act of offering for sale in the UK socks having the features of the sample Hunter socks provided with the Request infringes claim 1 under s.60(1), infringes claims 11 and 12 under s.60(2), but does not infringe claim 7 or 8, of patent GB 2410415 C.

NOTE

This opinion is not based on the outcome of fully litigated proceedings. Rather, it is based on whatever material the persons requesting this opinion and filing observations have chosen to put before the Patent Office.

JOHN TWIN
Examiner

John Twin
Examiner