

OPINION UNDER SECTION 74A

Patent	GB 2262308
Proprietor(s)	Securistyle Limited
Exclusive Licensee	
Requester	Trojan Hardware & Designs Limited, on 26 May 2009
Observer(s)	
Date Opinion issued	26 August 2009

The request

1. Trojan Hardware & Designs Ltd (“the requester”) made a request on 26 May 2009 for the comptroller to issue an opinion under section 74A(1)(a) as to whether patent number GB 2262308 (“the patent”), which is in the name of Securistyle Ltd, is infringed by a product described in the request.
2. A request was also made under section 74A(1)(b) as to whether the patent is valid in the light of a prior art document, US 4571776 (“Anderberg”), which is referred to on the first page of the patent specification itself.

The patent

3. The patent was filed on 5 December 1991 and does not claim priority. It was granted on 27 April 1994 and is still in force.

Observations

4. The patentee filed observations on 29 June 2009 and the requester filed observations-in-reply on 10 July 2009. Subsequently, the patentee had concerns about some of the issues raised in the requester’s observations-in-reply and filed a further letter on 16 July 2009. In response to that the requester contacted the Office to enquire whether this further set of observations was allowable and, if so, could it make further submissions

5. Part 1 section (d) of the Office's opinions manual discusses the timing of observations governed by rule 96 and it is clear that it does not allow for a further set of observations and observations-in-reply because there is a three month target for issuing an opinion and so strictly I should ignore these further observations. Indeed, I understand an official letter was sent the parties outlining the Office's position.
6. However, it would be ridiculous to suggest I did not look at this further correspondence when it became clear that, at least in part, it related to a disagreement over the likely time-table for infringement proceedings which have recently been initiated by the patentee against the requester in the Patents County Court.
7. As I shall discuss in more detail later, the patentee's observations focussed on its wish for the Office to refuse the request. In its observations-in-reply, the requester suggested that the court hearing would not take place until mid-2010 and so the opinion would be issued many months before court proceedings come to a conclusion.
8. However, the patentee has suggested that the hearing would take place either in December 2009 or January 2010. Regardless of who is correct, and bearing in mind that proceedings of this nature often tend to take longer than initially expected, it seems to me that a court hearing is unlikely to take place before the New Year.
9. I have considered the timing of the court case because it would clearly be of little value for me to issue a non-binding opinion if the same issues had already been heard or they were about to be heard immanently by the court. However, this opinion is due to be issued by 26 August 2009 and that is some four months before the very earliest likely hearing date. So issuing the opinion may serve a useful purpose.
10. One use of the opinions service is to allow a party or parties to obtain an independent assessment of the issues which will be raised in future proceedings or those which might have only just got underway. Though it can be ignored, an opinion might help the requester to focus on the most appropriate arguments, it may act as a trial run or it might provide an impetus for settlement.
11. Of course, parties do obtain confidential advice from patent attorneys, IP solicitors or barristers. However, if the requester does not mind the issues being made public, this statutory procedure has the advantage that it allows an impartial opinion to be given which takes account of an observer's differing views. Nobody is obliged to use this service, but in this case the requester has, knowing that he was likely to be defending

an infringement action in the near future. On the face of it, this would seem to be a reasonable course of action, however, the patentee has specific reasons for a taking a different view and I shall consider those later.

12. I make these comments merely to put this non-binding opinions process in some kind of perspective before considering specifically whether the request should be refused.

Should the Office refuse the request?

13. The patentee's observations focus on why the request should be refused on the grounds that it is inappropriate in all circumstances to issue an opinion and that the request is vexatious. The legal basis for refusal is set out in section 74A(3) of the Act and rule 94 of the Patent Rules, which read as follows:

74A(3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so –

(a) in such circumstances as may be prescribed, or

(b) if for any reason he considers it inappropriate in all the circumstances to do so.

94(1) The comptroller shall not issue an opinion if—

(a) the request appears to him to be frivolous or vexatious; or

(b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.

(2) The comptroller shall not issue an opinion if the requester gives him notice in writing that the request is withdrawn.

(3) If the comptroller intends at any time—

(a) to refuse the request because the condition in paragraph (1)(a) or (b) is satisfied; or

(b) to refuse the request because, in accordance with section 74A(3)(b), he considers it inappropriate in all the circumstances to issue an opinion,

he shall notify the requester accordingly.

14. As far as the request being inappropriate in all circumstances, the patentee says that there are two reasons. Firstly, they argue that

proceedings before the Patents County Court cover the same issues and, secondly, the prior art which is relied upon is referred to in the patent specification and it must have been considered sufficiently pre-grant.

Patents County Court

15. Quite some time after the deadline for making observations had expired, the Office received copies of letters exchanged between the solicitors representing the parties. Again, I should not consider further observations but these letters raise an issue which cannot be ignored.

16. The patentee's solicitor, Wragge & Co, sent a letter to requester's solicitor, Shakespeare Putsman, on 4 August 2009 which appeared to refer to a preliminary hearing before His Honour Judge Fysh on 29 July 2009. The last paragraph of the letter says:

"...we believe it is important to record for the benefit of the IPO Judge Fysh's comment during the telephone hearing referred to above that the IPO would not issue an opinion in this matter, given the concurrent proceedings currently being heard in the Patents County Court."

17. In the requester's reply of 5 August 2009, it was said that:

"At the hearing, Judge Fysh did not make any Order relating to the opinion. This is not surprising since he was not being asked to consider the opinion and he would not have had any papers relating to it. The application before him was for an extension of time....."

18. I note that the patentee's solicitor falls short of saying that the Judge had ordered the Office not to issue a non-binding opinion. Also, it is usual for the court to inform the Office of such an order and this does not seem to have happened. To clear the matter up the Office contacted the patentee's representative who confirmed that no such order was made.

19. Therefore, there is nothing that the court has ordered which impels me to refuse this request.

Is it inappropriate, frivolous or vexatious?

20. Although it is clear that infringement proceedings may have been anticipated by both parties for some time, and it would seem the patentee gave two weeks advanced warning of its intention to file an

infringement claim, these proceedings were not launched until 27 May 2009, that is, the day after the form 17 was filed for this request.

21. The patentee also points out that no warning was given regarding the request. Politeness apart, there is no requirement, as far as I am aware, to notify an interested party until the opinions request is actually made and with regard to prior notification we must also accept that there is a substantial difference between court proceedings and a non-binding opinion request.
22. The patentee argues that the court proceedings cover the same issues with respect to infringement and that it is inconceivable that the requester will not file a counterclaim for invalidity based on a prior art document. Therefore, the request should be refused.
23. The patentee also refers to Opinion 5/06 in which it was decided not to refuse the request for being vexatious as the observer had requested because the parties and argument in the opinion were found to be different to those in concurrent revocation proceedings.
24. I accept that in some circumstances this leaves open the way for a request to be refused when there are concurrent proceedings and, as I have suggested, if the issues were about to be heard immanently, I would have to seriously consider if it was inappropriate in all the circumstances to issue an opinion.
25. The patentee also refers to paragraph 5 in the part of the opinions manual which deals with refusal and mentions the situation where there are simultaneous proceedings. It reads as follows:

5. A request may also be refused where related proceedings (either in the UK or at the EPO) are underway but not completed - although whether it is appropriate to refuse the request would depend on all the circumstances. For example, an opinion issued to parties already involved in proceedings could sometimes be helpful, and the courts may encourage or could direct parties to seek such an opinion.
26. The patentee submits that although the manual acknowledges that it may be helpful to issue an opinion in some circumstances, it is not so in this case and the court has not actually ordered the parties to seek an opinion. Although the patentee is quite correct about this, it is also the case, as we have already established, that the court has not made an order to the contrary.
27. It is clear that this dispute has been building up for some two years and it seems that the patentee is also questioning why an opinion request

has been made now and not earlier. Of course one might argue that there is no need for an alleged infringer to seek an opinion until infringement proceedings seem likely to be launched by the patentee and this appears to be what has happened here.

28. The patentee also suggests that the requester has produced two types of infringing hinges but the request only relates to the second of these. It is suggested by the patentee that this is tacit acceptance that the first hinge infringes the patent. The requester counters by saying that new product is a very recent one and at paragraph 20 of its observations-in-reply it says that:

“Samples were provided for discussion with the patentee at a meeting (without prejudice) on 12 May 2009. The Opinion Request was made promptly on 26 May 2009. It was therefore legitimate for the Opinion Request to be made in relation to the new product.”

29. The patentee argues that this is not a suitable forum because an understanding of common general knowledge at the priority date will be required and this will need to be done using a considerable amount of evidence and cross-examination of witnesses, but, as the requester points out in its observations-in-reply, this is usually the case in any dispute relating to validity or infringement.
30. I agree that these issues are difficult to resolve, but if the Office were to refuse on these grounds then it might have to refuse the vast majority of requests and that was clearly not what was intended when the system was introduced after some considerable consultation with stakeholders.
31. The requestor also suggests that the opinions system is useful in that it allows an opinion to be obtained before major costs are incurred in court proceedings. Clearly, the requester hopes that the opinion will go in its favour and will encourage settlement or lead to alternative dispute resolution. This motive is entirely reasonable, although it is yet to be seen if the opinion will favour the requester, and I also consider that there is nothing unusual about the timing of the request when taking all the circumstances into account.
32. Therefore, I do not conclude that it is *inappropriate in all the circumstances to issue an opinion* or that the request is *frivolous or vexatious*. Considering everything, I believe that issuing an opinion on infringement would be helpful, especially since the court hearing is still some months off.

Was “Anderberg” previously considered?

33. The other ground for refusal is that the prior art in question was mentioned on page one of the patent specification and, therefore, it would have been considered by the examiner during the search and examination process.
34. Rule 94(1)(b) indicates that a request may be refused when “*the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.*” I have no doubt that this phrase covers the substantive examination process and , furthermore, the Office’s Opinions Manual makes it clear that the Office does not issue opinions where the arguments merely repeat those made pre-grant, but, what constitutes an argument made pre-grant?
35. The patentee’s observation is anticipated by the requester who argues that Anderberg was not listed on the section 17 search report of 2 April 1992 and so was not considered or discussed at the substantive examination stage. The requester suggests the description of Anderberg in the patent specification is inaccurate and as a result this may have misled the search examiner. Thus, it was not considered at the time and therefore should be considered now.
36. To some extent this is speculation and the patentee points this out in the observations. The fact is that we simply do not know the precise reason why the search examiner did not cite Anderberg, not even as a category “A” citation. However, it is standard Office practice for a search examiner to look at prior art mentioned in a patent application and then cite it on the search report if he or she thinks it is of sufficient relevance. In this case it was not cited.
37. It is also clear that the section 18(3) report, issued on 19 January 1994 by a different examiner, makes no mention of Anderberg. Although we do not know for sure whether the examiner considered this document when he carried out his substantive examination, he would have expected it to have been cited on the search report if it was relevant. Since it was not cited, he may not have considered Anderberg because it had been completely dismissed by the search examiner. What is certain is that it was clearly not the subject of any detailed discussion between the examiner and the patentee and his attorney.
38. The patentee refers to the Office decision in *Automation* (BL O/370/07) where the Office had informed the requester that it intended to refuse the opinion request on the grounds that it appeared to solely relate to a question that had been considered during the examination of the patent application prior to grant. *Automation* took the opportunity to be heard on the issue. The hearing officer suggested that an opinion request relating a new question or new argument could be considered whereas one

relating to a question or argument considered previously could not. Specifically, the patentee points to parts of paragraph 32, which reads as follows:

But what is “a new question or argument”? Mr. Wallin suggested that a new question “just has to be something that you can see from the prosecution history has not been considered before”. I agree with this statement, although I think I probably differ with him over the detail of what it means in practice. It is an intrinsic part of the substantive examination process to assess the novelty and obviousness of the claims, as properly construed, in the light of the prior art. In this context, “prior art” means documents cited in the search report (at least under category “X” or “Y”, which indicate possible relevance to novelty or inventive step) as well as material which has come to the examiner’s attention in some other way. I think it reasonable to suppose in general that the examiner will have done his or her job properly in the absence of indication to the contrary, and I see no reason why this assumption should not apply even if the examiner has decided not to raise objection on the basis of any of the citations at substantive examination.

39. I also note that at paragraph 35, the hearing officer goes on to say:

“My conclusion from the above is accordingly that a request for an opinion on validity which argues on the basis of prior art that was cited as category “X” or “Y” in the search report, or as part of a substantive objection at any other time in the examination procedure, is, other than in exceptional circumstances, unlikely to clear the hurdle of raising a new question or argument.”

40. Therefore, new arguments, for examples those not made during the substantive examination process are allowable. Also allowable are arguments made in relation to documents cited as category “A” on the search report or those which were not cited at all. Therefore, I consider that I am entitled to look at Anderberg and give my opinion on the validity of the patent.

The Law

41. Having decided that it is appropriate to issue an opinion of both validity and infringement, it seems worth pointing out that the relevant legislation is set out in section 74A(1) of the Patents Act 1977 reads as follows:

The proprietor of a patent or any other person may request the comptroller to issue an opinion -

(a) as to whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;

(b) as to whether, or what extent, the invention in questions is not patentable because the condition in section 1(1)(a) or (b) above is not satisfied.

The monopoly

42. Having discussed in detail why the opinion request should be refused, it is unfortunate that the patentee has declined to comment on the requester's submissions with regard to validity and infringement, other than making it clear that the requester's submissions are denied. However, I shall look at the issues objectively.
43. In coming to an opinion as to whether the patent has been infringed, or is valid in view of prior art, I must determine the scope of the claim in order to be able to assess whether the described apparatus or that disclosed in the prior art falls within its scope.
44. Claim 1 is the only independent claim and it reads as follows:

An egress hinge for supporting a vent between a closed position in which it lies within a fixed frame and an open position in which it extends substantially perpendicularly to the fixed frame, the egress hinge comprising:

a first slider and a second slider mounted in a support track,

a vent arm attached to the first slider via a thrust link and to the second slider via a control link and,

a brace joining the first slider to a midpoint of the control link,

wherein restricting means act between the first slider and the support track to limit motion of the first slider along the support track during opening of the hinge, thereby dictating the position of the vent arm in relation to the support track when the hinge is fully open, the restricting means being releasable, when the hinge is in an open position, to allow the first slider and hence the vent arm to move relative to the support track to a position for cleaning a vent mounted, in use, on the vent arm, and

wherein stop means are provided against which the second slider bears as the hinge is closed such that the restricting means automatically relocates in its active position.

45. There are also a number of dependent claims and I shall discuss these claims at a later stage if I need to.

Claim construction

46. In determining the scope of a patent claim, I am required to use the principles set out by Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9. A purposive construction must be put on the claim, as interpreted in the light of the description and drawing as instructed by section 125(1). However, in determining the extent of protection, he said that account must be taken of the Protocol to Article 69 of the EPC. At paragraph 69 he summarized this approach when he said the question to be asked is:

“what would the person skilled in the art have understood the patentee to have used the language of the claim to mean?”

47. There is no debate over the meaning of the claim 1 and having read the description and considered the content of the figures, I am satisfied that the claim clearly defines the essential features of the invention.
48. For the benefit of the impartial reader, the egress hinge comprises a vent arm 7 for supporting a vent or a window such that it allows egress or escape from a building via the vent when it opens to one side of the frame.
49. Figure 1 shows the vent in a half open position. A first slider 3 and a second slider 5 are mounted on a support track 1. The vent arm 7 is attached to the first slider 3 via a thrust link 9 and to the second slider 5 via control link 11. A brace 13 also joins the first slider to a mid-point of the control link.

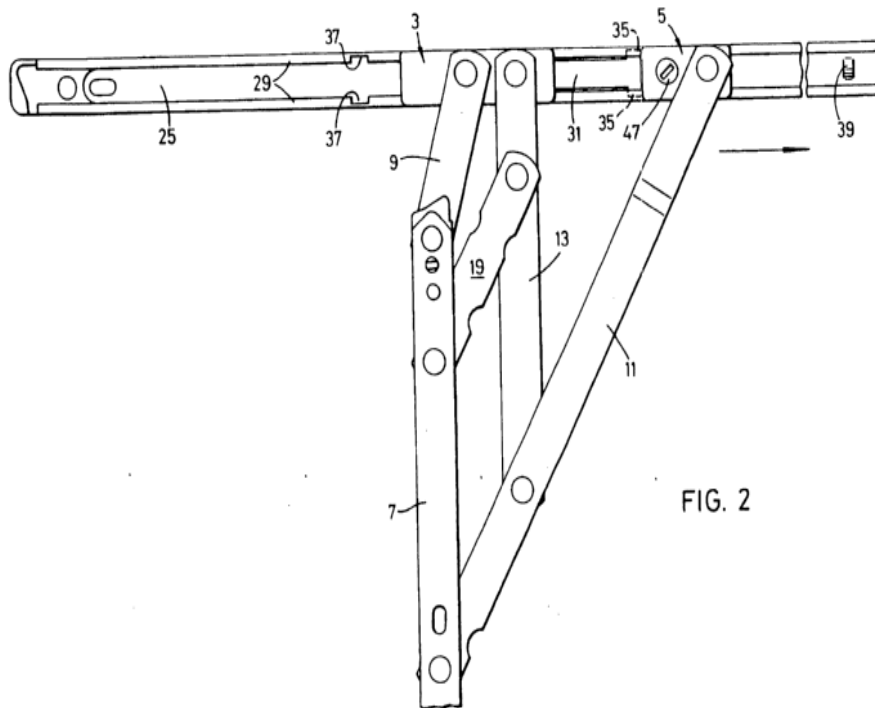


FIG. 2

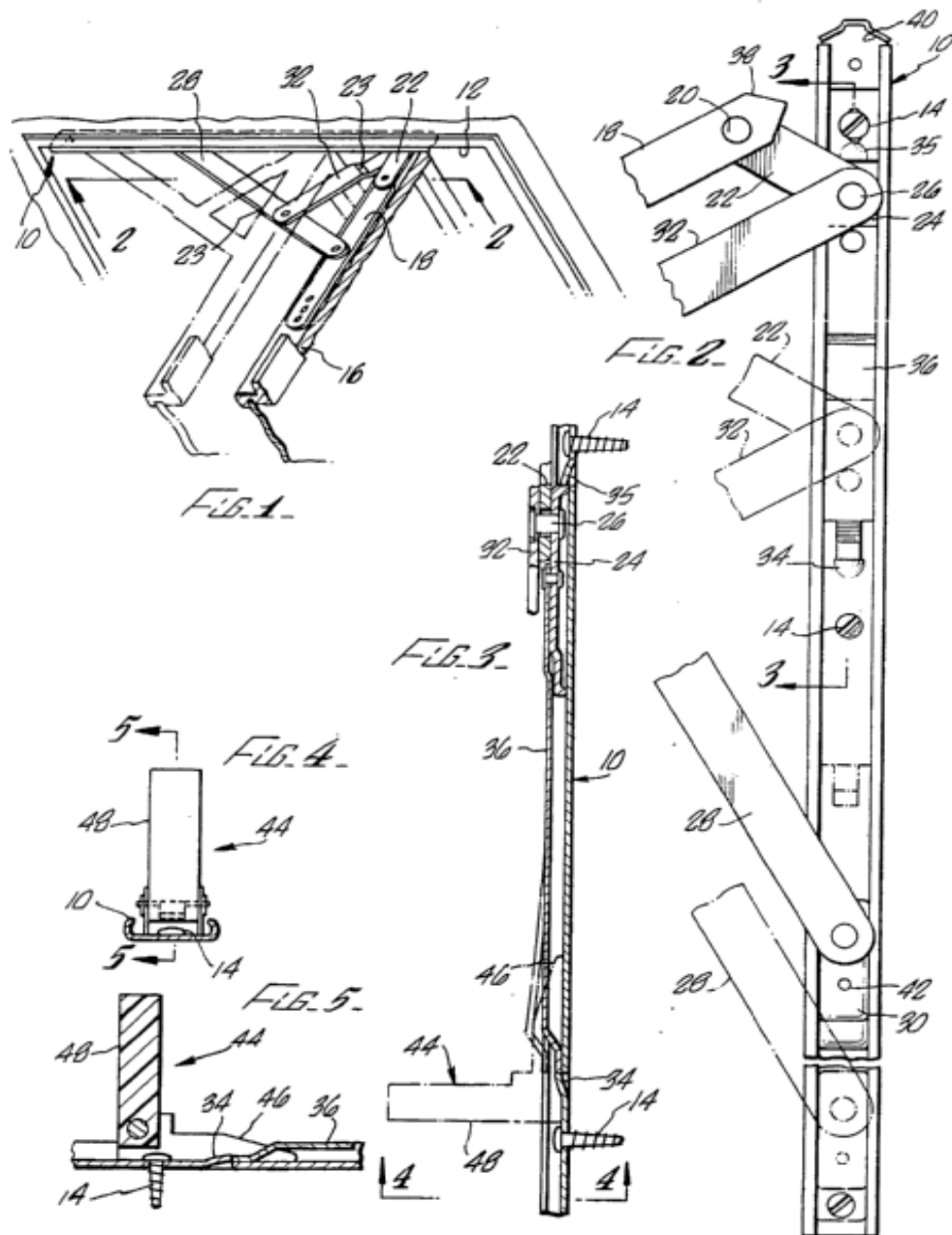
52. There is no suggestion that this not conventional and it appears that the inventive aspect lies in the use of a stop means 39 which allows the vent to be more easily closed. As the vent is closed the first and second sliders move in opposite directions until the second slider engages the stop means and its motion is halted. The first slider then continues to move to its original position where the restricting means engages and the vent is fully closed.
53. On page 6 of the patent, at paragraph 2, the patentee says:

“As will be appreciated if the stop means 39 is not present, as in the prior art case, the restricting means does not automatically relocate in its active position, but requires considerable effort on behalf of the user of the hinge to re-engage the restricting means before the hinge can be closed.”

Does Anderberg anticipate the patent?

54. Anderberg clearly discloses a releasable hinge which allows a window to provide ventilation and it allows escape in an emergency. A release mechanism also allows the hinge to be moved so that the exterior surface of the window to be cleaned. Therefore, I have no doubt that the prior art document relates to a hinge used for the same purpose as that of the patent.
55. Referring to figure 1, I shall use the terminology used in Anderberg

where the direction in which the window opens (to the right hand side in figure 1) is described as the "outboard" direction. The opposite direction (to the left hand side in figure 1) is described as the "inboard direction".



56. The figures show a window mounting bracket 18 which is equivalent to the vent arm 7 of the invention. The arrangement also comprises a thrust link 22, a brace 32, a rail 10 mounted support slider 24 and a friction slider 30 which are all equivalent to the claimed features of the invention. Furthermore, the strut 28 which links the bracket to the friction slider acts in the same manner as the control link 11 of the invention. Anderberg's

hinge lacks the reinforcing link shown in the patent but that feature is not claimed in claim 1 of the patent.

57. Anderberg also discloses a stop 35 which prevents motion of the support slider in the outboard direction and another stop 34 which together with a leaf spring 36 attached to the support slider also limits the motion of the support slider in the inboard direction and so maintains the support slide in the normal operating position.
58. In this position the support slider remains stationary whilst the window is opened. As the window opens, the friction slider moves towards the support slider, i.e. in the outboard direction.
59. When the window is open, the leaf spring may be raised, with the aid of a tool, allowing the support slider to be moved in the inboard direction. Clearly the friction slider also moves with it. The description of Anderberg (column 3 line 28 to column 4 line 5) says the following:

*Further motion of the tool 44 towards the support slider 24 will raise the leaf spring 36 above the first stop 34 and enable the support slider 24 and the friction slider 30 to move inboard to a position where the support slider 24 is in contact with the first stop 34 **or the friction slider 30 engages another convenient stop, not shown**. By so doing, an additional space is created between the outboard side of the window frame and the exterior of the window so as to facilitate the cleaning of the outside of the window. When it is desired to return the window to its normal operating position, an outboard force applied to the window sash 16 will move the window outboard so that the leaf spring 36 reengages with the first stop 34.*

60. It is well established that to anticipate a claim, a prior art document is required to disclose all the essential features of the invention explicitly or implicitly.
61. The requester argues that with the presence of a “convenient stop”, Anderberg must in practice disclose the invention. It suggests that if one makes the invention with a convenient stop, the stop may be in one of three possible positions. A first position in which it is too close to the outboard side and where on attempting to close the window the two slides cannot move far enough apart. Thus, the window could not be closed and it would be immediately apparent that the stop should be moved in the inboard direction. It is argued that a skilled person would not put a stop in that position and I accept this.
62. Then there is what I might call an ideal position, or to use the requester’s words, “a convenient position for the stop”. This is where on closing the

window, the motion of the friction slider is halted by the convenient stop which is positioned such that the support slider moved away from it and the leaf spring relocates as the window closes.

63. Finally, if the convenient stop is moved too far in the inboard direction then on attempting to close the window, the skilled person would find that the window cannot close fully without some further manual intervention. Therefore, the requester argues that the skilled person on making the invention would put the stop in this ideal position because it conveniently allows the window to be closed in one motion.
64. Having read Anderberg, it seems to me that it quite simply does not explicitly disclose how the claimed invention works. Although there might be an ideal position for the stop, Anderberg does not disclose this position or the precise mode of operation that results from it.
65. Whereas the position too close to the outboard side can be eliminated because it prevent the window closing, the position in which the stop is placed further to the outboard side, or too far away, will still allow the window to be closed albeit with a further action being required. Therefore, this position cannot be eliminated as being part of the disclosure and so the ideal position is not implied.
66. All we are told is that there may be a convenient stop. Therefore, I do not consider that Anderberg discloses, either explicitly or implicitly, the essential features of the invention claimed in claim 1 and its dependent claims.

Inventive step

67. The requester goes on to argue that even if the patent's claim is considered to be novel over Anderberg, it lacks an inventive step. Unfortunately, the requester does not adopt the *Windsurfing* approach for dealing with inventive step as reformulated by Jacob LJ in *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588. I shall apply this approach to the following discussions and the reformulated approach is as follows:
 - (1)(a) Identify the notional "person skilled in the art"
 - (1)(b) Identify the relevant common general knowledge of that person;
 - (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
 - (3) Identify what, if any, differences exist between the matter cited as

forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

68. Applying the *Windsurfing/Pozzoli* test, the skilled person can be considered to work in the field of manufacturing hinges for windows or installing them. That person could be a technician or a tradesman. He or she should be taken to be a person who has the skill to make routine workshop developments but not to exercise inventive ingenuity or think laterally as indicated, for example, by Laddie J in *Pfizer Ltd's Patent* [2001] FSR 16 at paragraphs 62 and 63.
69. Such a person can be expected to be familiar with previously known egress hinges and how they operate so that windows can be cleaned from the inside.
70. The inventive concept is set out clearly in claim 1 and has already been discussed in some detail. The difference between it and the prior art is in placing a stop in a position which allows the egress hinge (and the vent) to be closed directly from the cleaning position because a stop prevents motion of the second slider (friction slider) and forces the first slider (support slider) to move away from it and into a position in which it engages the restricting means to go back to its normal operating position.
71. The question to answer is whether this difference is obvious to the skilled person without the benefit of hindsight or does it constitute an inventive step?
72. The arguments put forward by the requester are similar to those made in relation to novelty. It is suggested that an operator, who manipulates an Anderberg hinge whose convenient stop is “too close or too far away” from the outboard side, would realize that the position of the stop is significant to the closing operation. Too close and the window cannot close, too far away and the window would not close fully and requires a further manual intervention step. Thus, according to the requester, the skilled person would “immediately realize” that the stop should be moved to a position in which the window can be closed without further manual intervention, in order to be in a convenient position.
73. Why would the skilled person, without knowledge of the invention, “immediately realize” this? I have considered whether there is any

disclosure in Anderberg which points toward the improvement and thus suggests it is obvious. Looking again at the part of Anderberg that I have already recited in paragraph 59 of this opinion, it is clear that “... to return the window to its normal operating position, an outboard force applied to the window sash 16 will move the window outboard so that the leaf spring 36 reengages with the first stop 34.”

74. The application of such an outboard force seems to me to be consistent with the manual intervention suggested by the requester because it is applied towards the position where the leaf spring re-engages the first stop. This appears to be in a different direction to an initial closing force which can be applied to the hinge.
75. The same passage also suggests that releasing the leaf spring enables “...the support slider 24 and the friction slider 30 to move inboard to a position where the support slider 24 is in contact with the first stop 34 or the friction slider 30 engages another convenient stop, not shown.”
76. The use of the word “or”, and the fact that the convenient stop is not shown in the figures, might suggest that it is not an essential feature of the Anderberg hinge. If that is the case, as it seems to be, then the convenient stop is not intended to play a major part in closing the hinge or window from the cleaning position.
77. Overall, I consider that the disclosure points away from the invention claimed in the patent and the requester has not convinced me that the identified step is obvious to a skilled person. Therefore, claim 1 is not obvious in the light of the disclosures of Anderberg.

Infringement

78. I shall now consider whether a new hinge, described in the request, infringes the patent. Infringing acts are defined by section 60 of the Patents Act 1977 and the subsection which is relevant to this request reads as follows:
 - (1) *Subject to the provision 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.

The new product

79. I have already said that I consider claim 1 to clearly define the invention but it seems that whereas the validity issue revolves around the position of a stop and how it affects closing the hinge, the issue of infringement also encompasses the definition of the hinge linkages and specifically the difference between how the features on the new hinge which are equivalent to the patent's first slider and vent arm interact with each other.

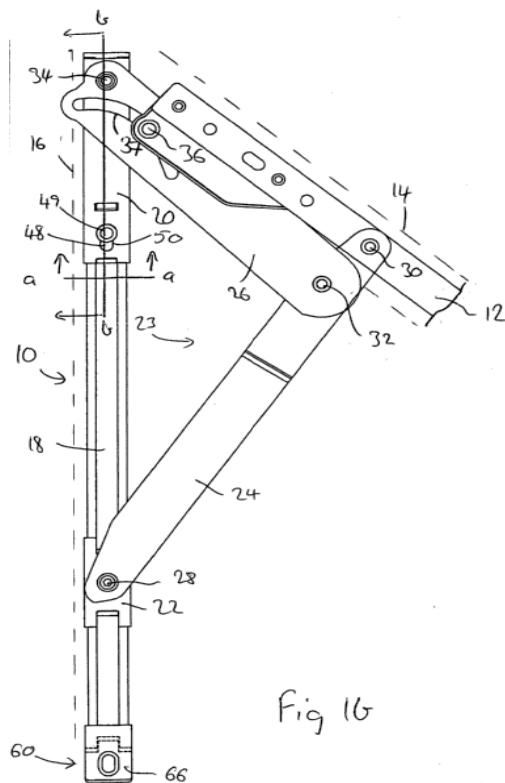
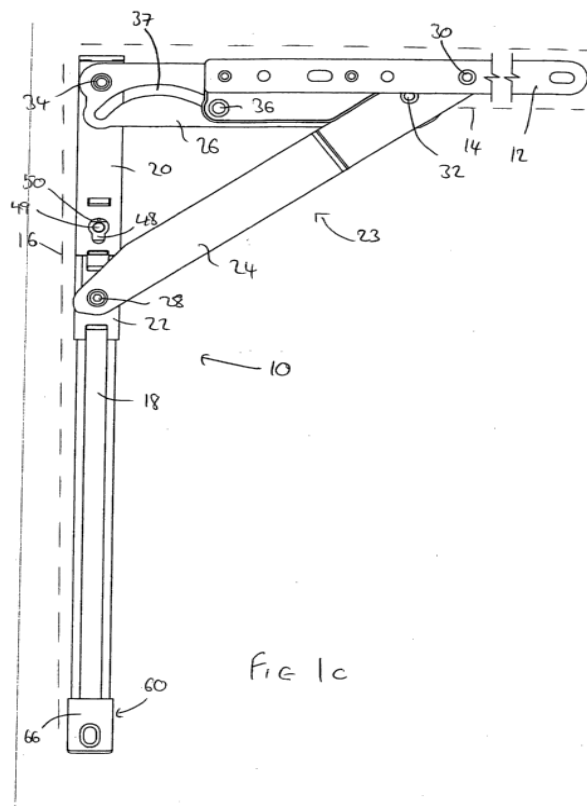
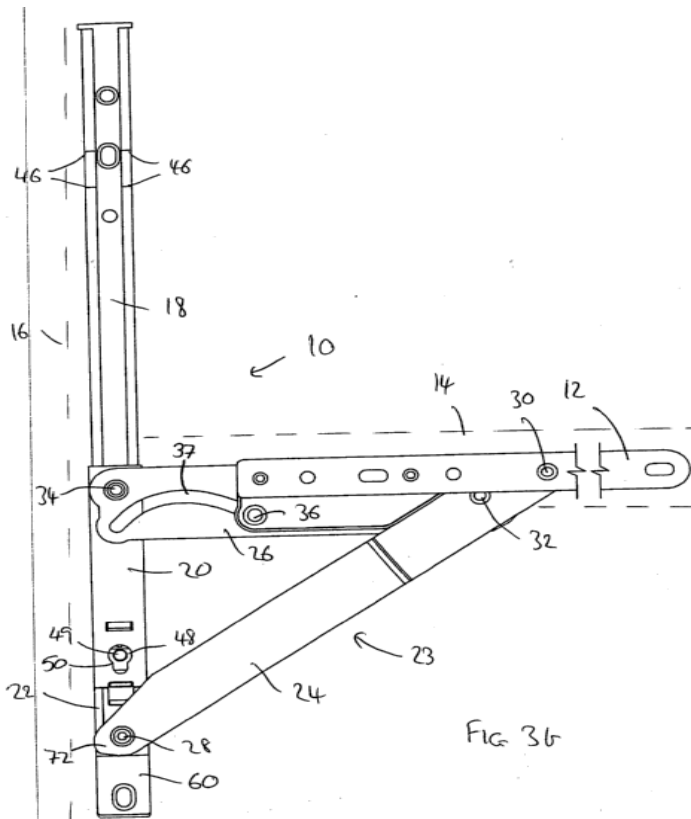


Fig 16



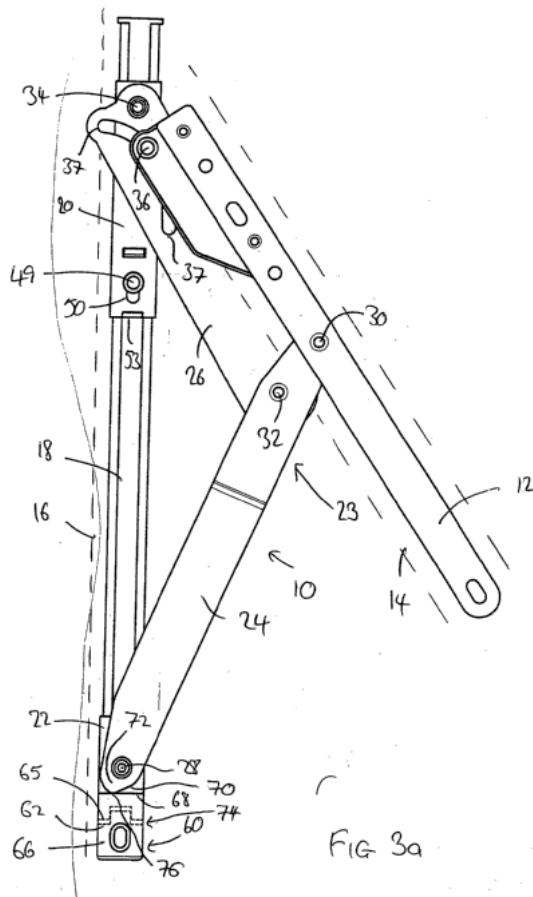
80. The requester's submissions include a document which describes the new hinge. Figures 1b and 1c illustrate the mechanism and it can be seen that it has many equivalent features to those of the claimed invention and for clarity I have put the names of the patent's equivalent features in brackets.
81. A sash (vent) arm 12 is coupled with a first carriage 20 (slider) via a sliding pivot 36 which moves within curved slot 37 in a first intermediate arm 26 (brace). The sash arm is also connected pivotally to a second carriage 22 (slider) by a second intermediate arm 24 (control link) and the two intermediate arms connect at a pivot 32 placed between the sash arm and the second carriage, but much closer to the sash arm.
82. The first carriage has a locking arrangement 48, 49, 50 to restrict its motion and the molding 60 provides a stop arrangement against which the second carriage appears to bear, as shown in figure 3b, to facilitate closing from the cleaning position.

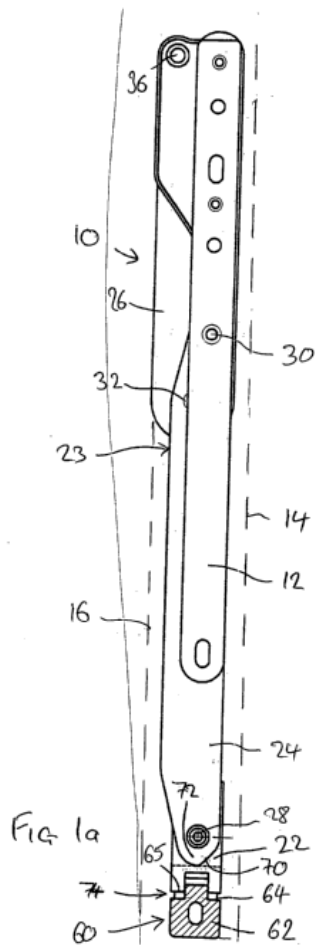


83. It is suggested that this new hinge lacks the thrust link of the claimed invention which is effectively replaced by the pivot 36 and curved slot 37 within the first intermediate arm 26. I note that the requester also points out that if the first intermediate arm is considered to be a thrust link, then the new arrangement lacks a brace. Either way I accept that the arrangement is different but I consider the former to be a better description of the difference.
84. It is also argued that in the patent, the thrust link of the invention maintains a constant distance between the end pivot of the vent arm and the first slider whereas in the new hinge the distance between pivots 34 and 36 varies as the latter travels along the curved slot 37. The path that the end of the sash follows is clearly different and the requester maintains that the new arrangement it is not just a mere variant and the features required by lines 7-12 of the patent's claim are not present.
85. Although the requester makes a good point, and the path followed is different, the result is similar and it does seem to me that the new arrangement is functionally equivalent to that of the patent. However, is this enough for it to be considered to fall within the patent's claim?
86. I have already mentioned the leading case, *Kirin-Amgen*, in which the

court asked the question: “*what would the person skilled in the art have understood the patentee to have used the language of the claim to mean?*”

87. There might be many suitable arrangements which could provide a similar function to the thrust link and brace. The new hinge provides such an example. However, it was the patentee who chose the wording of the claim having sought expert advice and its meaning is very clear. The reference to the thrust link and the brace provide a deliberate and clear limitation to the monopoly. There may have been a good reason for that limitation but regardless of whether there was a good reason or not, I do not think it is correct to disregard that limitation. It is also well established that the principle of purposive construction is not an invitation to re-write or re-interpret the claim to cover a variant not thought of at the time of filing but which the patentee would now like the claim to cover.





88. The requester also suggests that although the carriage initially bears against the stop, as the hinge continues to close the interaction of the cam surfaces 70, 68 of the intermediate arm and the stop (see figure 3a and 1a) causes the carriage to move away from the stop, creating a small gap 74 between the stop and the carriage. Therefore, it does appear that the carriage cannot bear against the stop “...as the hinge is closed such that the restricting means automatically relocates in its active position.” Again, this does not strictly comply with the claim and the skilled reader might have expected strict compliance to be necessary given the choice of words and their clarity.
89. Taking these points together, without having the benefit of any comment from the patentee, I consider that the new hinge described by the requester does not fall wholly within the claim and if the requester carried out any of the acts set out in section 60(1)(a) in respect of it, the new hinge would not infringe the patent’s claim.

Opinion

90. Based on arguments presented to me, I consider that GB2262308 is valid (novel and inventive) in the light of US 4571776. Furthermore, I consider that the new hinge described by the requester does not infringe claim 1 of GB2262308.

Application for review

91. Under section 74B and rule 98(1), the proprietor may, within three months of the date of issue of this opinion, apply to the comptroller for a review of the opinion. However, under rule 98(2) such proceeding for a review may not be brought, or continued, if the issue raised in the review has been decided in other relevant proceedings.
92. Under rule 98(5), such an application for review may be made only on the grounds that, by reason of its interpretation of the specification of the patent, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

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.

Eamonn Quirk
Examiner