Patents Act 1977 **Opinion Number** **31/09**

OPINION UNDER SECTION 74A

Patent	**GB 2340073**
Proprietor(s)	Mr Jonathan Horler
Exclusive Licensee	
Requester	Mr James Black, on 13 November 2009
Observer(s)	Mr David Wightman
Date Opinion issued	19 February 2010

The request

1. This request (one of two filed by the requester, see also opinion 32/09) initially caused some difficulty as it sought opinions on several questions. Ultimately it was agreed that this opinion would address the following question: would GB2340073 ("the patent") be infringed by the Mastermailer (RTM) product supplied?

Observations

2. Observations in response to the request were received from Barker Brettell on behalf of Mastermailer and observations in reply from Everseal.

3. The observations suggest that the request should be refused, since the requester had not provided a copy of the patent, but rather had provided a copy of a PCT application (Appendix 2 of the request) claiming priority from the patent and a copy of the claims of the PCT application (Appendix 3 of the request). The description and figures of the patent and the PCT application are effectively identical, although the PCT application does not appear to be a direct facsimile of the patent. Although Appendix 3 is marked "Claims in Patent No. GB2340073B", in fact the claims provided are those from the PCT application. However, claims 1 and 2 are the same in the patent and the PCT application and in any event the requester was permitted to correct the oversight and subsequently provided a copy of the granted patent. I see no need to

refuse the opinion request for this reason and I will therefore come to an opinion based upon the claims of the granted patent.

4. The observations query what the sealed samples of the Mastermailer provided actually show, but I will deal with this later.

5. There is a suggestion in the observations that the request should be refused as frivolous and vexatious since the requester is allegedly aware of prior sales of articles invalidating the patent. The observations go on to suggest that the patent is invalid based upon common general knowledge at the priority date and also based upon a prior patent publication.

6. The question being dealt with here is one of infringement. The observations have introduced further questions of validity. The Opinions Manual gives me some direction here (see paragraph 5 under the heading Drafting Opinions at http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-manual/p-manual-opinion-content/drafting-opinions.htm). The first example given in the Manual seems to apply: it is suggested that, following a request for a infringement opinion, an observation that questions the validity of the patent "is most likely not to be taken into account unless that question has a direct bearing on the infringement issue, for example by throwing light upon how a claim … should be construed". Therefore I will not consider the questions of validity, although I note that the observers are free to pursue that question, for example through a request for a further opinion. I can also see no grounds for refusing the request as frivolous or vexatious simply because there is an allegation that the requester was aware of potentially invalidating prior sales.

The patent

7. GB2340073 was filed on 31 July 1998 with no priority claim. It was granted on 1 May 2002 and remains in force. The patent is concerned with business forms with adhesive closures and the manufacture thereof, especially with sealable mailers, defined in the specification as "*forms or letters which have at least one printable region and which are to be folded after printing or the other appropriate mode of completion and sealed in the folded condition by means of one or more adhesive regions provided on the form, so as to be suitable for sending by post, or in some other manner in which it should remain sealed in the folded condition*".

8. One exemplary embodiment is described, as shown in figure 1 below. It is a printable invoice form made up of a single rectangular sheet with

pre-printed fields 11 to 14, some of which provide areas in which data will be filled. The form includes side strips 6 having perforations 61 for engagement with the sprockets of a form feed drive such as that of a printer. The side strips 6 may be detached from the form at fine perforations 62. The periphery of the form is provided with adhesive 50 in the form of a thin, continuous layer of dry-seal contact adhesive in a 5mm wide strip 3. Perforations 52 are provided to detach the strip 3 bearing the adhesive 50 from the remainder of the form.

9. The adhesive 50 is said to be applied as an essentially tack-free layer such that parts of the adhesive region 3 will adhere with one another under finger pressure only. An exemplary adhesive is said to be a natural rubber latex adhesive stabilised with ammonia, such as L516/4 supplied by Sealock (RTM). After completion the form should be folded about line 18 to superimpose the adhesive regions which are then sealed using finger pressure and the side strips 6 are detached and discarded. This produces a mailer for posting with the data in fields 11 to 14 concealed until strips 4 and 5 are detached along perforations 52.

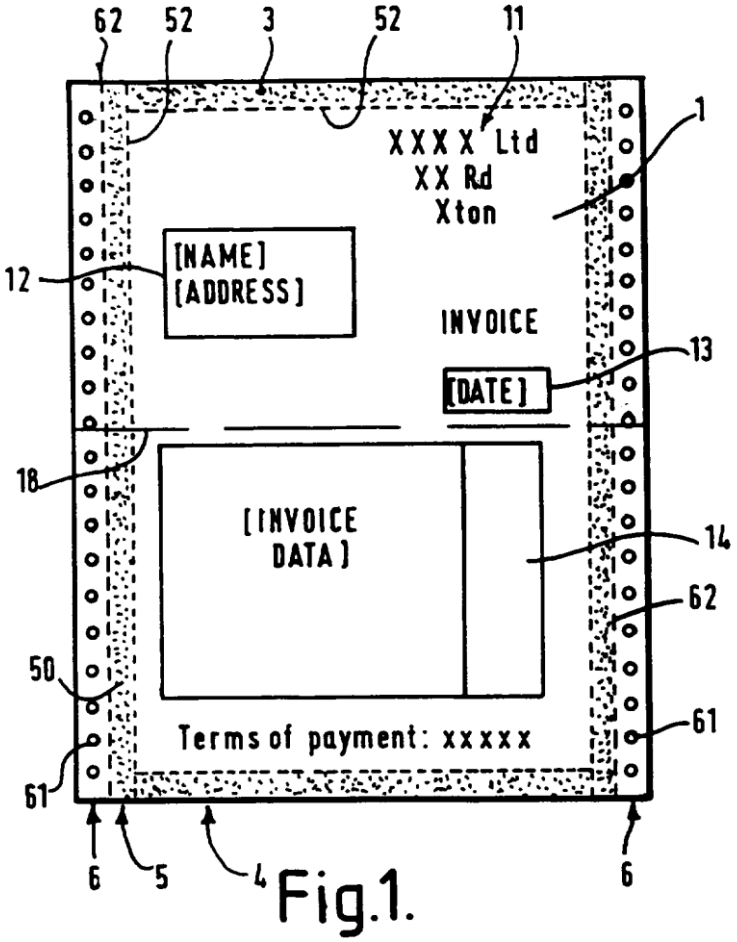

Fig.1.

10. The claims of the granted patent are as follows:

1. A business form with an adhesive closure having one or more adhesive regions for holding the form in a folded condition, characterised by the use on the adhesive region of a non-tacky layer of a dry self-sealing contact adhesive, which in the folded condition self-seals irreversibly to an opposed adhesive region also carrying a said contact adhesive, the adhesive being selected to self-seal irreversibly under a pressure of one MPa or less.

2. A business form according to claim 1 in which said contact adhesive is selected to self-seal irreversibly under a pressure between 10 kPA and 300 kPA.

3. A business form according to claim 1 or claim 2 which is a single thickness continuous sheet.

4. A business form according to any one of claims 1 to 3 which the adhesive region is provided as a border around a paper sheet constituting the form.

5. A form according to any one of the preceding claims in which the adhesive region is provided as one or more adhesive strips extending right across the paper sheet constituting the form, and a line of weakness is provided along and adjacent a said adhesive strip for separating the region having the adhesive strip from the region on the other side of the line of weakness by tearing.

6. A business form according to any one of the preceding claims made from a paper sheet which is laser-printable in which said contact adhesive is an elastomer latex adhesive.

7. A business form according to claim 6 in which the adhesive is a natural rubber latex adhesive stabilised with ammonia.

Claim construction

11. Before considering the request I need to construe the claims of the patent, following the standard principles of claim construction set out in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9. I should put a purposive construction on the claims and follow section 125(1) of the Patents Act 1977 and the Protocol on the Interpretation of Article 69 of the European Patent Convention by interpreting the claims in the light of the description and drawings. In other words, the question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean.

12. It seems to me that the person skilled in the art would be engaged in the design and production of pre-printed stationery, including perforations, and appropriate adhesives. It seems likely that the skilled person would in fact be several individuals or a team of people.

13. All that said the language of the claims seems to me to be clear on plain reading and to require little interpretation. The only part of the claims that merits further discussion here is the sealing pressure requirements. Claim 1 requires that the adhesive should self-seal irreversibly under a pressure of one MPa or less. One MPa is equivalent to 1,000,000 N/m^2 or 10 bar and the requester equates this pressure with the pressure found inside a steam boiler. Both the requester and the observer note that this is a high pressure in the context of a mailer that is intended to be sealed by hand using finger pressure (see lines 14 to 17 on page 2 of the patent). Therefore it seems that any adhesive that will self-seal irreversibly using manually applied pressure would inevitably meet this requirement of claim 1.

14. Claim 2 qualifies the pressure requirement of claim 1 by requiring that the adhesive should self-seal irreversibly under a pressure between 10 kPA and 300 kPA, clearly significantly lower pressure than the one MPa limit imposed by claim 1. Neither the patent, the request nor the observations discuss these lower pressures in any detail. However, the following passage appears on lines 7 to 17 on page 2 of the patent: "*What we now propose is a new and useful business form or mailer of the type described above which uses, as the or each adhesive region, a non-tacky layer of a dry self-sealing contact adhesive which self-seals irreversibly to an opposed adhesive layer of the same kind, when the form has been folded to its folded condition, under a sealing pressure applied on that region which is a finger pressure, or alternatively stated, a pressure of 1 MPa or less, preferably 500 kPa or less or 300 kPa or less, but preferably at least 10 kPa.*". From this I believe that the skilled man would understand the writer of the patent to mean that a pressure of between 300 kPa and 10 kPa equates to finger pressure. Therefore once again it seems that any adhesive that will self-seal irreversibly using manually applied pressure would inevitably meet this criterion.

The Mastermailer (RTM) product

15. Several examples of the relevant product have been supplied. These are unidentified beyond being marked "©copyright 2004 Patent Approved Mastermailer™". Also supplied is a sheet of storage and printing advice for Mastermailers (RTM).

16. The sample mailers supplied are also marked with instructions. The peripheral strip carrying the adhesive is marked “fold and press firmly to activate adhesive” and “for best results seal when still warm from the laser printer”. There are also instructions for the order in which the adhesive strips should be removed by tearing along the perforated strips in order to open a sealed mailer.

17. Some of the samples provided have been sealed and are marked as having been sealed at pressures of 1 MPa, 500 kPa and 300 kPa. Of those some have been opened by separating the adhered sections and some remain sealed. The intention of the requester is to show that the adhesive used in the samples will seal irreversibly at these pressures, i.e. that attempting to separate the adhered sections would result in damage to the mailer.

18. The observations express some doubt as to what these sealed samples show. Taken at face value the samples indeed appear to demonstrate that, when sealed at the pressures indicated, the adhesive employed will seal irreversibly. However, I will treat this information with caution, not because I have any reason to doubt what the request details, but because I do not think that the sealed and subsequently opened samples add anything over the directions printed on the unsealed samples and the storage and printing advice. In other words my opinion does not change whether or not I take into account the sealed samples.

Infringement

19. Patent infringement is dealt with in section 60 of the Patents Act 1977 as amended. Relevant parts of section 60 read as follows:

Meaning of infringement

60.-(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;

...

(5) An act which, apart from this subsection, would constitute an infringement of a patent for an invention shall not do so if -
(a) it is done privately and for purposes which are not commercial;
(b) it is done for experimental purposes relating to the subject-matter of

the invention;
...

20. In the absence of any evidence I will assume that the samples supplied to me are made, used or imported in the United Kingdom and that the exceptions in section 60 such as private or experimental use do not apply. In other words I will assume that if the samples fulfill the requirements of one or more claims in the patent then they would infringe that claim or claims.

21. Taking the requirements of claim 1 in turn, the sample provided seems to be a business form with an adhesive closure having one or more adhesive regions for holding the form in a folded condition. The adhesive used seems to be a non-tacky layer of a dry self-sealing contact adhesive. That it is dry and non-tacky is apparent from examining the sample and that it is a contact adhesive I take from the instruction "fold and press firmly to activate adhesive". This leaves two requirements of the adhesive: irreversible self-sealing and a sealing pressure under one MPa. Since the mailer includes instructions to tear away the adhesive strips in order to open a sealed mailer it would appear that the adhesive will seal irreversibly. I have commented above that one MPa is a high pressure and that it seems to me that any adhesive that self-seals manually would self-seal at a pressure below one MPa. It seems clear that the sample is to be sealed by hand from the instruction "fold and press firmly to activate adhesive". Thus the sample seems to show all of the requirements of claim 1.

22. I also noted above that I believe that any adhesive that will seal using manually applied pressure would inevitably meet the criterion in claim 2 that the adhesive should self-seal irreversibly under a pressure of between 300 kPa and 10 kPa.

23. The Mastermailer (RTM) sample is a single-thickness continuous sheet as required by claim 3 and the adhesive is provided as a border around the form as required by claim 4. The adhesive is also applied in strips along and adjacent which are formed lines of weakness as required by claim 5.

24. Claim 6 requires two things: the sheet to be laser printable, which the Mastermailer (RTM) printing tips sheet makes it clear applies to the Mastermailer (RTM), and the adhesive to be an elastomer latex adhesive.

25. I have no basis on which to judge the chemical nature of the adhesive used in the Mastermailer (RTM) samples, therefore I cannot say that the adhesive used is an elastomer latex adhesive, as required by claim 6, or

a natural rubber latex adhesive stabilised with ammonia, as required by claim 7.

Opinion

26. It is my opinion that claims 1 to 5 of the patent would be infringed by the Mastermailer (RTM) samples provided.

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.

Karl Whtifield
Examiner