

OPINION UNDER SECTION 74A

Patent	GB 2340073
Proprietor(s)	Mr Jonathan Horler
Exclusive Licensee	
Requester	Mr James Black, on 18 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 31/09) 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 specific embodiment described in GB2436210?

Observations

2. Strictly speaking no observations in response to the request were received. However, observations were received in response to related request for opinion 31/09 from Barker Brettell on behalf of Mastermailer and observations in reply from Everseal. Some of the those observations relate to the patent and so it may be helpful to deal with them here.
3. The observations suggest that the request for opinion 31/09 should be refused, since the requester had not provided a copy of the patent, but rather had provided a copy of a PCT application claiming priority from the patent and a copy of the claims of the PCT application. The same PCT application was filed with the request for this opinion. 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. 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 saw no need to refuse the request for opinion 31/09 and I came to an opinion based upon the claims of the granted patent. I will do the same in this opinion.

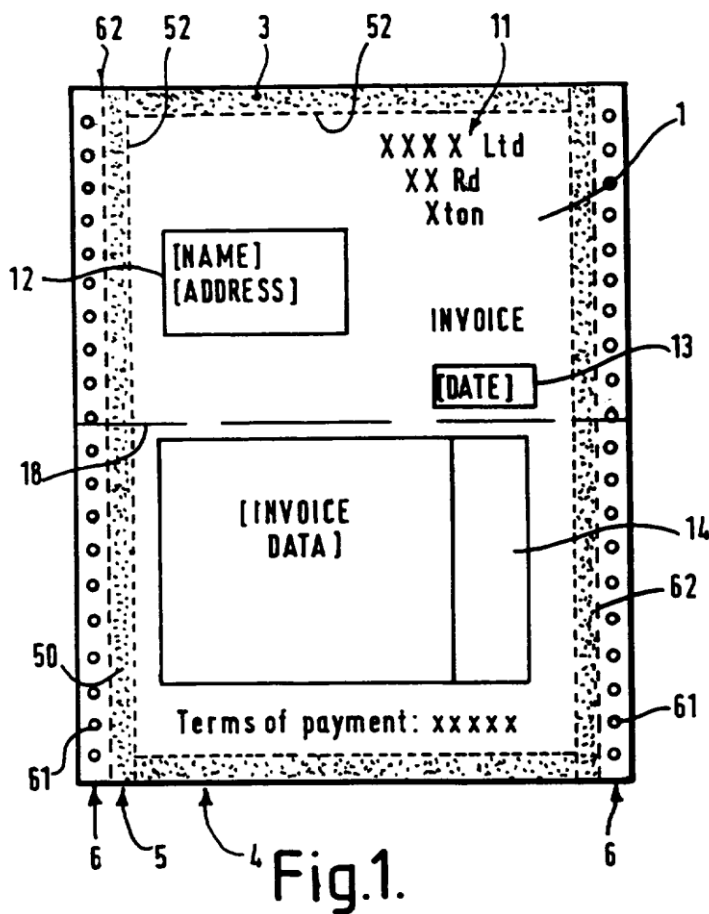
4. There is a suggestion in the observations that the request for opinion 31/09 should be refused as frivolous and vexatious since the requester is allegedly aware of prior sales of articles invalidating the patent. The observations go on to suggest that the patent is invalid based upon common general knowledge at the priority date and also based upon a prior patent publication.
5. The question being dealt with in each of opinions 31/09 and 32/09 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 have not considered 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 also saw no grounds for refusing the request for opinion 31/09 as frivolous or vexatious simply because there is an allegation that the requester was aware of potentially invalidating prior sales.

The patent

6. 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*”.
7. 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.

8. 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.



9. 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

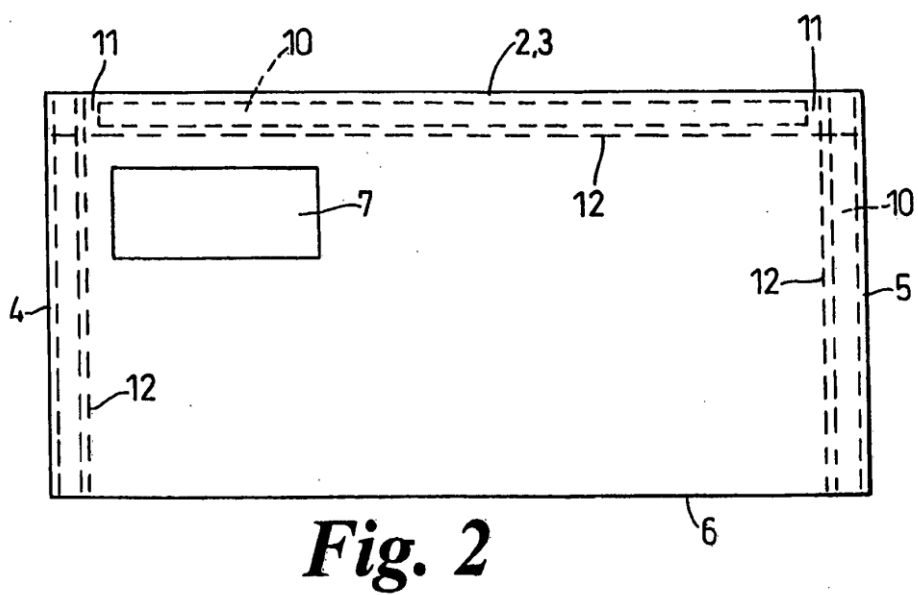
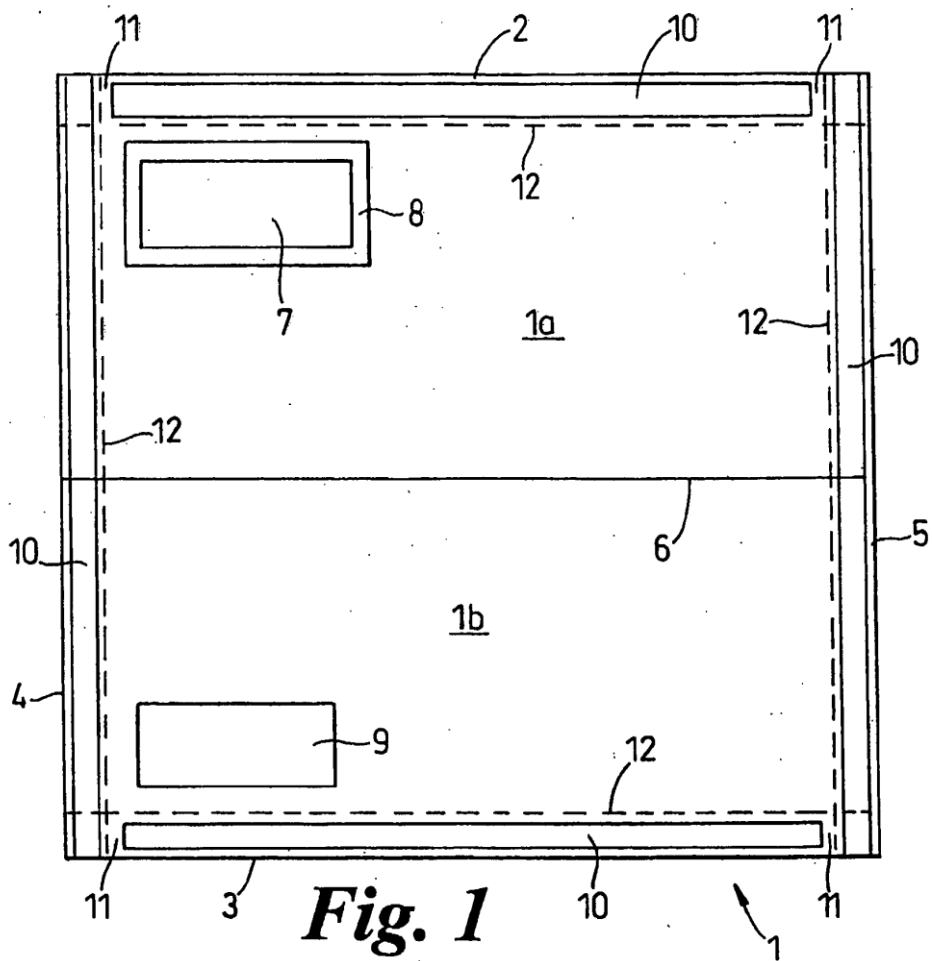
10. Before considering the request I need to construe the claims of the patent, following the standard principles of claim construction set out in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9. I should put a purposive construction on the claims and follow section 125(1) of the Patents 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.

11. 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.
12. All that said the language of the claims seems to me to be clear on plain reading and to require little interpretation. The only parts of the claims that merit further discussion are the sealing pressure requirements and the nature of contact adhesive. 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/m² or 10 bar and the requester equates this pressure with the pressure found inside a steam boiler. The requester notes 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.
13. 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 nor the request 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 take 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.
14. The adhesive of claim 1 is required to be a contact adhesive. The patent offers no definition of the term. It seems clear to me that such an adhesive should bond upon the application of pressure. What is less clear to me is whether the term “contact adhesive” as used in the patent precludes activation by e.g. heat. The only direct reference to heat in the patent appears to be on page 4 lines 18 to 23, as follows: *“Preferably therefore the paper sheet is printable, especially laser-printable and the dry self-sealing contact adhesive can withstand printer*

conditions, in particular high temperature, without detaching or becoming tacky so as to contaminate the printing machine.”. Although this suggests that the contact adhesive of claim 1 is preferably not activated by heat, the fact that this aspect of the adhesive is only preferable might suggest that the writer did not intend the term “contact adhesive” to specifically preclude an adhesive which is activated by heat. However, I believe the skilled man would understand the writer to be using the term contact adhesive to mean an adhesive that bonds by the use of pressure alone and requires no additional activation, such as wetting or heat. I base this on the contrast that is made in the introductory part of the patent between the invention and the prior art that uses water activated adhesives or adhesives with a release layer and also on the description of prior art contact adhesives employing only pressure to effect a bond.

The specific embodiment described in GB2436210

15. In GB2436210 a single embodiment is described, as shown in figures 1 and 2 below. The stationery form 1 comprises a single A4 sheet compatible with laser printing and provided with a transparent window 7 for viewing address field 9 when the form is folded along fold line 6 for sealing and mailing. A narrow strip of adhesive 10 is applied along each edge on one side of the form 1. The adhesive 10 is based on a latex dispersion stabilised with ammonia and blended with an acrylic solution which is dried after application to the form to provide a low tack dry adhesive. The adhesive is activated by exposure to a heat source to allow the adhesive sections to adhere to one another, after activation the adhesive is said to have properties similar to a contact adhesive (page 3 lines 25 and 26). The bond formed is said to be substantially irreversible even at low pressures such as finger pressure. To avoid activation at ambient temperatures the adhesive is said to be activated at a temperature of over 35°C, preferably above 40°C and more preferably above 60°C. A suitable adhesive is said to be available from National Adhesive as No.135009A/1. Perforations 12 are provided alongside the strips of adhesive 10 to allow the bonded sections to be removed from a sealed form.



Infringement

16. 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

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(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;

- ...*
17. One patent does not infringe another, since the publication or grant of a patent is not necessarily associated with any of the infringing acts above, such as making or importing. For the purposes of this opinion I am considering whether a product corresponding to the specific embodiment in GB2436210 would infringe the patent were it to be the subject of a potentially infringing act such as making or importing.
18. Taking the requirements of claim 1 in turn, the embodiment described in GB2436210 is a business form with an adhesive closure having one or more adhesive regions for holding the form in a folded condition. The adhesive used is a non-tacky layer of a dry adhesive (see page 7 lines 10 to 20). After activation, the adhesive self-seals irreversibly using finger pressure (see page 7 line 24). 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 seal at a pressure below one MPa.
19. This leaves one requirement of claim 1: that the adhesive should be a contact adhesive. I have said above that I believe contact adhesive as used in claim 1 to mean an adhesive requiring no additional activation by e.g. heat or wetting. It is clear that the adhesive in GB2436210 is heat activated, see e.g. page 7 lines 22 to 28, and as such is not to my mind a contact adhesive as required by claim 1 of the patent. Thus the specific embodiment in GB2436210 does not show all of the

requirements of claim 1.

20. Claim 2 requires the adhesive to self-seal irreversibly under a pressure between 10 kPa and 300 kPa. There is no discussion in GB2436210 of the specific pressure at which the adhesive described therein might self-seal, apart from a reference to sealing under finger pressure (see page 7 line 24). However, the patent is also concerned with sealing under finger pressure and the pressure values in claims 1 and 2 are intended to exemplify such pressure (see page 2 lines 14 to 17). Therefore since the patent suggests that a pressure between 10 kPa and 300 kPa corresponds to finger pressure, then it must follow that the specific embodiment in GB2436210 shows all of the requirements of claim 2.
21. The specific embodiment in GB2436210 is made up of 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.
22. Claim 6 requires the sheet to be laser printable and the adhesive to be an elastomer latex adhesive. Both of these appear to be shown by the specific embodiment in GB2436210 (see page 5 line 23 and page 7 line 10), as is the natural rubber latex adhesive stabilised with ammonia (see page 7 lines 10 and 11) that is required by claim 7.

Opinion

23. Since all of the later claims depend on claim 1, I conclude that none of the claims of the patent would be infringed by a product corresponding to the specific embodiment in GB2436210, were such a product to be the subject of any of the infringing acts set out in section 60 of the Patents Act 1977 as amended.

Application for review

24. Under section 74B and rule 98, the proprietor may, within three months of the date of issue of this opinion, apply to the comptroller for a review of the opinion.
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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 Whitfield
Examiner