Intellectual
Property
Office

BL O/500/17

11th October 2017

PATENTS ACT 1977

	Ninefields Holdings Ltd	Claimant

PROCEEDINGS

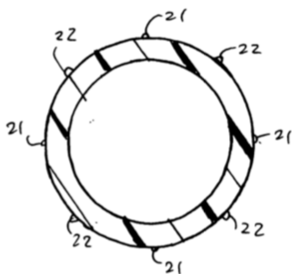
Application under section 74B for
review of Opinion 30/16 in respect of
GB 2350394B

HEARING OFFICER Stephen Probert

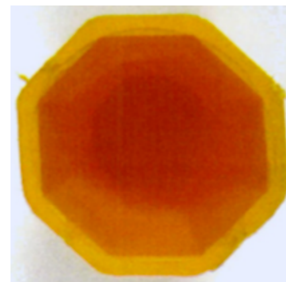
DECISION

Introduction

1. Ninefields Holdings Ltd ("Ninefields") is the registered proprietor of UK patent GB 2350394B ("the patent"), which concerns end caps for scaffolding poles. Opinion 30/16 was requested by Ninefields, asking whether the patent is infringed by a product known as the 'Octiknob' — manufactured or imported by Caspian Access and Plant Hire Ltd. The examiner's opinion was that the Octiknob does <u>not</u> infringe. Ninefields has requested a review of the opinion under section 74B.



The Patent



The Octiknob

2. The observer participated during the opinion process, but chose not to become a party to these review proceedings. The Office wrote to Ninefields on 19 July 2017 drawing their attention to the recent judgment of the Supreme Court in *Actavis v Eli Lilly* [1], which has significantly changed the way in which infringement is now decided in the UK. This Supreme Court judgment was issued after opinion 30/16, and it

[1] Actavis UK Ltd & others v Eli Lilly and Company [2017] UKSC 48

appeared to the Office that an opinion on infringement based on the old law may now be of little or no assistance to the parties — regardless of whether or not the opinion was consistent with the law as it applied at the time the opinion was issued. Nevertheless, I understand that Ninefields has opted to proceed with this review.

3. Ninefields has provided a very clear statement of grounds in respect of this review, which I have considered along with all the other documents on the official file. They have not requested an oral hearing.

The Claim(s)

4. Claim 1 of the patent (with my emphasis) reads:-

> 1. An end cap for plugging the end of a scaffold tube, the end cap comprising:
>
> a tubular portion tapered so as to be larger in diameter at a first end;
>
> a blocking member extending transversely across the tubular portion at a position spaced from the first end; and
>
> **ribs** extending substantially longitudinally **on the outer surface** of the tubular portion,
>
> the end cap being capable of complete insertion into a scaffold tube to form, in use, an interference fit therein.

5. There is a second independent claim, claim 14, which was considered in the opinion. As far as this review is concerned, the difference is that claim 14 is directed to a scaffold tube having an end cap fitted therein. The end caps of claim 1 and claim 14 are the same.

The Grounds for Review

6. There are two specific grounds put forward by Ninefields for setting aside opinion 30/16:-

    i) The examiner erred in the claim construction, specifically when applied to the feature '"ribs", which resulted in an incorrect conclusion that the Octiknob does not infringe the patent.

    ii) Even if the narrow interpretation of "ribs" as in the opinion is correct (which Ninefields submits it is not) the examiner erred by failing as requested to properly consider the question of infringement under "purposive construction".

7. I can understand why Ninefields has presented its case in this way, but it is too similar to the 'dual approach' that was expressly disapproved in *Catnic.*[2] Before the House of Lords judgment in that case, infringement was often determined by considering firstly the strict literal meaning of the claims, and then secondly a broader interpretation that came to be known as the 'pith and marrow' doctrine. Referring to this 'dual approach', Lord Diplock said (p 242 line 25):-

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[2] Catnic v Hill & Smith [1982] RPC No. 9 at p183

> "My Lords, in their closely reasoned written cases in this House and in the oral argument, both parties to this appeal have tended to treat "textual infringement" and infringement of the "pith and marrow" of an invention as if they were separate causes of action, the existence of the former to be determined as a matter of construction only and of the latter upon some broader principle of colourable evasion. There is, in my view, no such dichotomy; there is but a single cause of action and to treat it otherwise, particularly in cases like that which is the subject of the instant appeal, is liable to lead to confusion."

8. Moreover, the protocol to Article 69 (which is expressly given force in the UK by section 125(3) of the Act) says that the scope of a claim is not defined by the strict literal meaning of the wording used in the claim. This feels rather like the 'narrow interpretation' in the claimant's grounds. I will therefore treat the claimant's grounds as a single issue — ie. did the opinion examiner correctly construe the claim(s) of the patent in accordance with the law as it was, and as it was understood to be, at the time that she issued her opinion.

The Law

9. Reviews of statutory opinions are permitted by section 74B of the Act, and prescribed by rules 98 to 100 of the Patents Rules 2007 (as amended). As far as this review is concerned, the most relevant parts read as follows:

> **Review of opinion**
>
> 98. (1) The patent holder may, before the end of the period of three months beginning with the date on which the opinion is issued, apply to the comptroller for a review of the opinion.
>
> (2) …
>
> (3) …
>
> (4) …
>
> (5) The application may be made on the following grounds only—
>
> (a) …
>
> (b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.
>
> **Outcome of review**
>
> 100. (1) On completion of the proceedings under rule 99 the comptroller shall either—
>
> (a) set aside the opinion in whole or in part; or
>
> (b) decide that no reason has been shown for the opinion to be set aside.
>
> (2) ….
>
> (3) ….

10. As far as the ground(s) of the review are concerned, the most important section of the Act is section 125. The Protocol on Interpretation of Article 69 of the EPC is also relevant. I reproduce them both here for convenience:-

> **Extent of invention**
>
> 125. -(1) 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.

(2) It is hereby declared for the avoidance of doubt that where more than one invention is specified in any such claim,, each invention may have a different priority date under section 5 above.

(3) The Protocol on the Interpretation of Article 69 of the European Patent Convention (which Article contains a provision corresponding to subsection (1) above) shall, as for the time being in force, apply for the purposes of subsection (1) above as it applies for the purposes of that Article.

Protocol on Interpretation

Article 1 - General principles

Article 69 should not be interpreted as meaning 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. Nor should it be taken to mean 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 patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

Article 2 - Equivalents

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

11. At the time opinion 30/16 was issued, the leading case on ‘purposive construction’ in the UK was *Kirin-Amgen.*[3] In that case, Lord Hoffman said (para 34):-

> “Purposive construction” does not mean that one is extending or going beyond the definition of the technical matter for which the patentee seeks protection in the claims. 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. And for this purpose, the language he has chosen is usually of critical importance. The conventions of word meaning and syntax enable us to express our meanings with great accuracy and subtlety and the skilled man will ordinarily assume that the patentee has chosen his language accordingly. As a number of judges have pointed out, the specification is a unilateral document in words of the patentee’s own choosing. Furthermore, the words will usually have been chosen upon skilled advice. The specification is not a document *inter rusticos* for which broad allowances must be made. On the other hand, it must be recognised that the patentee is trying to describe something which, at any rate in his opinion, is new; which has not existed before and of which there may be no generally accepted definition. There will be occasions upon which it will be obvious to the skilled man that the patentee must in some respect have departed from conventional use of language or included in his description of the invention some element which he did not mean to be essential. But one would not expect that to happen very often.

12. The examiner has summarised the position, fairly in my view, at the end of paragraph 15 of her opinion, using the words of the second sentence of the above extract from *Kirin-Amgen.* She wrote:-

> *“Simply put, 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.”*

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[3] Kirin-Amgen Inc v Hoechst Marion Roussel Ltd [2005] RPC 9 at page 169.

13. To be clear, this is how the land lay at the time the opinion was issued. As indicated above, the landscape has changed following *Actavis v Eli Lilly,* but that is not my concern here. As I understand my task in this review, I should only set the opinion aside if I believe that the examiner made an error of principle or reached a conclusion that is clearly wrong on the basis of the law as it was then. (See paragraph 22 of *DLP Limited* [4]*.)*

The Issue

14. Ninefields agrees with the examiner's statement in the opinion that the "crux of the matter" concerns how a particular term in the claims — "***ribs** extending substantially longitudinally* **on the outer surface** *of the tubular portion*" — is to be interpreted.

15. The Octiknob has an octagonal profile, and the examiner's opinion was that the vertices of the octagonal profile do not fall within the meaning of "ribs … on the outer surface" as required by the claims.

16. Ninefields takes issue with the examiner's interpretation that the term must mean "*an elongate raised piece of material provided <u>on</u> the surface*." [5] (Their emphasis.) They submit that the use of the underlined word has unfairly and inappropriately distorted the meaning away from what was meant by the applicant at the time of drafting, and that which would have been understood by the skilled addressee. They also say that the examiner was wrong to state that the ribs "*are <u>clearly distinct from the surface</u> of the tubular portion from which they up stand*". [5] In their view, there was no reason based on the wording of the specification for this "*further categorisation and limitation to a normal meaning of the term 'rib'* ".

17. However, the claims clearly require that the ribs extend "substantially longitudinally **<u>on</u>** the outer surface of the tubular portion", so I believe it was reasonable for the examiner to interpret the claim in the way that she did.

18. Ninefields also complains that the examiner did not follow the so-called 'protocol questions' to determine the extent of the protection to which the patentee is entitled. The 'improver' or 'protocol' questions are founded in Lord Diplock's judgment in *Catnic*, and subsequently reformulated (& renamed) in later judgments of the court.[6] This set of three questions has often been used for deciding whether an equivalent is within the scope of a patent claim. Nevertheless, Lord Hoffmann made it very clear in *Kirin-Amgen* that, whereas the basic principle of purposive construction is universally applicable, the protocol questions are merely a guide that may or may not be useful in a particular case. I note for example that the courts do not always apply them — eg. *Ultraframe v Eurocell Building Plastics* [2005] EWCA (Civ) 761.

19. It seems to me that the examiner's opinion would have been more complete if she had used the protocol questions as a guideline, not least given the similarity between the issue in this case (the meaning of a 'rib) and the issue in the *Improver* case (the meaning of a 'helical spring'). Nevertheless, I am satisfied that the examiner has

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[4] DLP Limited [2008] RPC 11

[5] Paragraph 20 of the opinion.

[6] Improver Corporation and others v Remington Consumer Products Ltd and others [1990] FSR 181
Wheatley (Davina) v Drillsafe Ltd [2001] RPC 7

construed the word ‘rib’ purposively as required by the Protocol, and there is no error of principle here.

20. Neither do I consider that the examiner’s opinion reaches a conclusion that is clearly wrong. For example, the patent specification clearly indicates that the ribs around the circumference of the end cap are of two different lengths — alternately 22mm long and 20mm long — as represented by the numerals 21 and 22 in the figure above. Although this distinction is not found in claims 1 or 14, the reader skilled in the art will approach the claims with the knowledge that they have gleaned from the description of the invention, and I believe they would as a result have understood that the patentee intended a more strict compliance with the primary meaning of ‘rib’ than would allow a octagonal end cap having vertices instead of ribs.

21. Moreover, lines 26-29 of page 3 of the patent explain the function of the ribs as follows:-

> “When the end cap is inserted into a scaffold tube, the ribs 21 and 22 are crushed and shaved off by the inner surface of the scaffold tube. This assists in providing a self-securing interference fit in the scaffold tube.”

22. It seems to me that this explanation within the patent would also lead the reader skilled in the art to understand that the patentee intended that strict compliance with the primary meaning of ‘rib’ is an essential requirement of the invention. On this point, Ninefields says that the raised portions of the Octiknob [the vertices] are also “crushed <u>or</u> shaved” by insertion into a scaffold tube, and that they function in the exactly the same way as the ribs of the patent.

23. According to Ninefields, this means that the skilled reader would understand that the patentee did not intend to exclude the vertices of an octagonal end tube by using the word ‘rib’. I do not accept this argument. Although Ninefields’ statement says that the images of the Octiknob provided in the request support their argument, I could not see any images showing an Octiknob with vertices “crushed <u>or</u> shaved” as they suggest, far less “crushed <u>and</u> shaved <u>off</u>” as described in the patent. I can imagine that the octagonal profile of the Octiknob would be deformed (‘crushed’?) upon insertion into a scaffold tube, but without clear evidence on the point it is very hard to believe that the vertices would also be “shaved off”.

24. To be clear, the reference to “crushed and shaved off” is not a requirement in claim 1. The claim merely refers to an “interference fit” between the end cap and the scaffold tube; the Octiknob clearly satisfies this requirement. The relevance of the term “crushed and shaved off” goes to how the skilled reader would understand the patentee to have used the language of the claim to mean.

25. To the extent that this argument was made in the original request, the examiner dismissed it by pointing out (correctly in my view) that there was no “doctrine of equivalents” in UK patent law [at that time].

Conclusion

26. I conclude that the examiner did not make an error of principle or reach a conclusion that is clearly wrong. Consequently I make no order to set the opinion aside.

Appeal

27. Any appeal must be lodged within 28 days after the date of this decision.

Stephen Probert
Deputy Director, acting for the Comptroller