Intellectual Property Office

BL O/077/17
20 February 2017

PATENTS ACT 1977

CLAIMANT	The BVG Airflo Group Limited
DEFENDANT	Dyson Technologies Limited
PROCEEDINGS	Application under section 71(1) for a declaration of non-infringement of UK Patent Number GB2440109B
HEARING OFFICER	H Jones

PRELIMINARY DECISION

1 The claimant (hereafter "BVG") has applied to the comptroller for a declaration of non-infringement under section 71 in respect of the defendant's patent to a handheld cleaning appliance. A separate application for revocation of the patent has also been made. This preliminary decision is concerned with a request by the defendant (hereafter "Dyson") to strike out BVG's application under section 71. The facts and grounds relied upon by Dyson are set out below:

- BVG's patent attorney, Mr Richard Halstead, wrote to Dyson on 5 July 2016 explaining that his client had decided to "replace its existing Maxi Vac cleaner with a corded version of the cordless vacuum cleaner pictures below". The letter included two photographs apparently of a cordless vacuum cleaner branded "Beldray" and went on to explain how it was Mr Halstead's view that the vacuum cleaner did not include certain features called for in claim 1 of the patent. Mr Halstead ended the letter by saying that he had advised his client that "importation and sale of this product does not infringe your clients patent and in the event that you disagree you are invited to explain your reasons."

- Dyson's solicitors, Gowling WLG (UK) Ltd, replied to this letter on 21 July 2016 saying simply that "Dyson reserves its rights in relation to the machine referred to in your letter".

- Dyson says that the product depicted in the photographs (a cordless vacuum cleaner) was apparently not the same product (a corded vacuum cleaner) proposed to be marketed by BVG. It says that no information was provided as to how and where on the products it was proposed for the cord to be attached, or as to whether the battery pack of the cleaner would be removed and what effect this might have. It says that the photographs were insufficient to establish whether or not the patent was infringed, even if the product had been the same. The letter did not seek an acknowledgement of non-

infringement of the patent and did not invite a response within any particular timeframe. In sum, the letter of 5 July 2016 and accompanying photographs did not furnish Dyson with the full particulars of the act in question required by section 71(1)(a).

- BVG argues that Dyson's letter of 21 July 2016 in which it said it reserved its position must have meant it was reserving its position regarding the issue of infringement. BVG says that Dyson did not indicate that it was lacking sufficient information to form a view on infringement and that by not acknowledging non-infringement it was making it clear that it would not cooperate. BVG claims that having stated that it wished to reserve its position, the implication is that Dyson had sufficient information to form a view on the issue of infringement but simply did not wish to give the claimant the benefit of what that view was. Mr Halstead says that it was in these circumstances that BVG commenced proceedings under section 71, in the belief that the defendant was unwilling to concede non-infringement of the patent.

- Dyson says that it is not true that by simply reserving its rights it has somehow admitted that the claimant has complied with section 71.

2 Both sides have said that they are content for me to decide the issue of strike-out on the basis of the papers.

The law

3 Section 71 of the Patents Act 1977 states that:

> *71(1) Without prejudice to the court's jurisdiction to make a declaration or declarator apart from this section, a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown -*
>
> *(a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and*
>
> *(b) that the proprietor has refused or failed to give any such acknowledgment.*

4 Dyson says that BVG has failed to comply with section 71 of the Act and/or there are no reasonable grounds for bringing the application for a declaration of non-infringement, and that the application should therefore be struck out under the relevant provisions of rule 83 of the Patents Rules 2007:

> *83.-(1) A party may apply to the comptroller for him to strike out a statement of case or to give summary judgment.*
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> *(2) If it appears to the comptroller that—*
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> *(a) the statement of case discloses no reasonable grounds for bringing or defending the claim;*
>
> *(b) the statement of case is an abuse of process or is otherwise likely to obstruct the just disposal of the proceedings; or*

(c) there has been a failure to comply with a section, a rule or a previous direction given by the comptroller,

he may strike out the statement of case.

5 Dyson argues that BVG has failed to comply with the requirements of section 71(1)(a) by not providing full particulars in writing of the act in question or asking for a written acknowledgement of non-infringement. With respect to the former requirement, i.e. the full particulars, Dyson refers to Floyd J's comments at paragraph 91 in *WL Gore & Associates GMBH v Geox Spa*[1]:

> "In *Consafe Engineering v Emtunga (UK) Limited* [1999] RPC 154 Pumfrey J (as he was then) interpreted "full particulars of the product or process alleged to infringe" in the context of the disclosure-avoidance provision in the former Order 104 rule 11 as
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> "particulars sufficient to enable all issues of infringement to be resolved. The description must be complete in all relevant areas. A description of the product either in general terms or including tendentious assertions is not acceptable."
>
> I have no doubt that exactly the same applies to the term "full particulars in writing of the act in question" in Section 71 of the Patents Act 1977, the section which provides the basis for a statutory declaration of non-infringement."

6 Although not specifically referred to by Dyson, I find that the words of Floyd J in the preceding paragraph are also relevant to the circumstances of this case:

> "The purpose of a declaration of non-infringement is to clear away disputes about infringement of a patent on the basis of a clear description of the product. Statements in argumentative or conclusory terms based on one side's disputed interpretation of a term used in the claims simply cannot achieve this object. What is needed is a precise technical description of what is present, so that the court can firstly interpret the disputed terms, and then decide whether the relevant feature is present."

Assessment

7 I shall deal with the question of whether BVG has failed to comply with the requirements of section 71 first.

Furnished full particulars

8 Claim 1 of the patent specifies various features of a handheld cleaning device and their physical relationship with respect to each other, in particular the formation of a planar surface common to the cyclonic separator and the main body of the cleaning appliance which together provide a surface for supporting the cleaning appliance on a flat surface. The reference to a handheld device limits the patent to battery powered cleaners.

9 What Mr Halstead appears to be saying in his letter of 5 July 2016 is that the device illustrated in the enclosed photographs does not include a particular feature required by claim 1 of the patent and that importation or sale of the said device cannot therefore result in infringement. The feature in question is the planar surface formed by the base of the cyclonic separator and the base of the main body. The device shown in the photographs is said to be a cordless vacuum cleaner but Mr Halstead explains that the intended product would be a corded version, presumably powered

[1] [2008] EWHC 2311 (Pat)

by mains electricity, suggesting a further distinction from claim 1 of the patent.

10 Although Mr Halstead does not specify in his letter which part of the device in the photographs represents the cyclonic separator and the main body of the cleaning appliance, Dyson takes no particular issue with this other than to say that the photographs are insufficient to establish whether the patent is infringed or not. It says also that no information has been provided as to how and where on the products it is proposed for the electrical cord to be attached, or as to whether the battery pack of the cleaner would be removed and what effect this might have. Dyson says that the photographs are insufficient to establish infringement even if the act in question had been in relation to the unmodified corded version.

11 Floyd J's comments above indicate that the full particulars required under section 71 are those particulars necessary for all issues of infringement to be resolved. In the letter of 5 July 2016, BVG focusses its attention on one particular integer of claim 1, i.e. the planar surface of the cleaning appliance which supports it on a flat surface, the suggestion being that the absence of this particular integer will be determinative of non-infringement of the patent. To the extent that this is true, it would seem unnecessary then for BVG to have to explain whether the remaining features of claim 1 are present in its device if it has already demonstrated that the claim is not infringed.

12 On the face of it, the particulars provided by Mr Halstead provide a sufficiently precise technical description of the product to allow a determination to be made of whether the relevant feature is present or not and for the question of non-infringement to be decided one way or the other. If it is found at full hearing of the issue that the particular feature is present in the product then clearly I will not be able to make a declaration of non-infringement, but I think that is a decision for then and not now. At present, I find that Mr Halstead has provided Dyson with full particulars of the act in question, which may well be determinative of non-infringement.

Written acknowledgement

13 In his letter of 5 July 2016, Mr Halstead says that he had advised his client that the product does not infringe Dyson's patent and invites Dyson to explain its reasoning in the event that it disagreed. Although no deadline for response is provided and no indication given of what action BVG might take if no reasons are provided, e.g. the initiation of proceedings under section 71, the invitation to respond is clearly being made in the context of non-infringement, with an implicit understanding that the response would be made in writing.

No reasonable grounds

14 I have already found that the particulars provided by Mr Halstead provide a sufficiently precise technical description of the product to allow the question of non-infringement to be answered one way or the other. It follows that BVG's statement of grounds discloses a reasonable ground for requesting a declaration of non-infringement and I offer no opinion whatsoever at this point on the merit of its case.

Conclusion

15 I find that BVG has complied with the formal requirements of section 71(1)(a) and that there is no basis for me to strike out the application for a declaration of non-infringement under rule 83(c). BVG has presented an arguable case for non-infringement of Dyson's patent which ought to be addressed at a full hearing of the issue, so strike-out of BVG's application is not justified under rule 83(a).

Appeal

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

H Jones
Deputy Director, acting for the Comptroller