



PATENTS ACT 1977

BETWEEN

Tek-Dek Ltd

Claimant

and

Flexiteek International A/S

Defendant

PROCEEDINGS

Application under section 71(1) of the Patents Act 1977 in
respect of European patent (UK) number EP 1 196 672 B2

HEARING OFFICER

A C Howard

Mr Simon Church of the patent attorneys Wilson Gunn represented the Claimant

Mr Yann Robin of the patent attorneys Marks & Clerk LLP represented the
Defendant

Hearing date: 5 November 2013

DECISION

Introduction

- 1 These proceedings concern an application (“the application”) by Tek-Dek Ltd (“Tek-Dek”) for a declaration of non-infringement in respect of European patent (UK) number EP 1 196 672 B2 (“the patent”) in the name of Flexiteek International A/S (“Flexiteek”).
- 2 The application was initially filed on 20 January 2012, and an amended statement of case and further evidence filed on 9 February 2012. The papers were served on Flexiteek, who was invited to file a counterstatement by 30 March 2012.
- 3 A preliminary decision issued on 10 August 2012¹, refusing a request by Flexiteek that the substantive proceedings be stayed, and refusing a separate request by Flexiteek that the application be struck out or amended. Flexiteek duly filed a counterstatement opposing the application.

¹ BL O/311/12

- 4 A second preliminary decision issued on 13 March 2013², allowing Tek-Dek to amend their statement of case in response to arguments put forward by Flexiteek in their counterstatement. Tek-Dek filed a consolidated amended statement of case on 19 March 2013 and Flexiteek filed an amended counterstatement on 17 April 2013.
- 5 A hearing on the substantive question took place on 5 November 2013, at which Tek-Dek was represented by Mr Simon Church of Wilson Gunn, and Flexiteek was represented by Mr Yann Robin of Marks & Clerk LLP.

The patent

- 6 The patent was granted on 29 November 2006, and derives from international patent application number PCT/SE2000/001302 having a filing date of 19 June 2000.
- 7 The patent was maintained in amended form with effect from 16 November 2011 following a decision of the Opposition Division of the European Patent Office (EPO).
- 8 The patent relates to a surface covering suitable for covering a boat or yacht deck, and has ten claims. Claim 1 is the only independent claim, and reads as follows:

“A shape conforming surface covering useful for covering a boat or yacht deck, said surface covering being made of a flexible plastic or resin material that can be laid in curved formations, like PVC, having a colour and luster imitating the grain effect of a wooden material like teak, mahogany, pine, Oregon pine, redwood, etc, and which, at the upper surface of the covering, is roughened, for instance sanded or filed, so as to imitate any unique grain effect of wooden material, in which

- *the surface covering is made up by plank strips (1,2),*
- *in which the surface covering is formed with caulking strips (3) intermediate each pair of planks (1,2), and*
- *in which the planks (1,2) are of a colour and luster imitating the colour and grain structure of a wooden material, and the caulking strips are of a different colour, preferably a dark colour,*

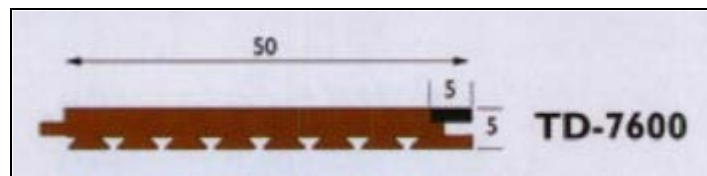
characterized in

- ***that*** *the plank strips are formed with matching male and female means at opposite longitudinal edges for interconnecting same aside of each other thereby forming, with caulking strips between each pair of planks, an assembled surface covering an optional length and width, and*
- ***that*** *the caulking strips (3) are formed with a male connection part and the mating edge of the adjacent plank with a female connection part, or vice versa.”*

² BL O/120/13

The claimant's products

- 9 Tek-Dek's products comprise two ranges of composite deck coverings: Tek-Dek Professional (hereafter "the Professional range") and Tek-Dek Flexible (hereafter "the Flexible range").
- 10 The Professional range comprises plank sections and other parts which are hard and relatively inflexible, and have plain edges. In their amended counterstatement of 17 April 2013, Flexiteek acknowledged that the products within the Professional range did not fall within the scope of the patent.
- 11 The Flexible range comprises plank sections and other parts of various sizes made of a flexible PVC compound formed to imitate the appearance of teak. Some of the plank sections include tongue and groove formations along opposite longitudinal edges to allow them to be joined together to form a surface covering, and a co-extruded strip along one longitudinal edge, of a darker colour than the rest of the plank.
- 12 A cross-section of a typical such plank section from the Flexible range is shown below:



- 13 There is no dispute that many of the features of Flexiteek's patent would be exhibited by Tek-Dek's products when assembled into a covering for a boat or yacht deck. The issue at hand essentially boils down to the question of whether or not they have planks/plank strips and caulking strips within the meaning of these terms as used in claim 1.

The law

- 14 Section 60 of the Patents Act ("the Act") is relevant to infringement and reads:

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;

[...]

(2) Subject to the following provisions of this section, a person (other than the proprietor of the patent) also infringes a patent for an invention if, while the

patent is in force and without the consent of the proprietor, he supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.

- 15 Section 71(1) of the Act provides for the making of a declaration of non-infringement and reads:

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.

- 16 The principles of claim construction are governed by section 125 of the Act, which reads:

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.

[...]

(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.

The application for a declaration of non-infringement

- 17 The conditions of section 71(1)(a) and (b) of the Act must be met in order for the comptroller to issue a declaration of non-infringement. The preliminary decision of

10 August 2012 concluded that Tek-Dek's application complied with section 71(1) of the Act, and there have been no further submissions on this point, so I do not need to consider this matter any further.

- 18 Tek-Dek initially only sought a declaration that the marketing in the UK of their products did not infringe the patent. However, at the hearing Mr Church requested a declaration covering all of the acts specified in section 60(1)(a) and 60(2) of the Act. Furthermore, notwithstanding Flexiteek's earlier acceptance that the Professional range does not infringe the patent, Mr Church requested that any declaration made should cover that range. Mr Robin did not oppose these requests.
- 19 Accordingly, the subject-matter of this decision is whether the doing of any of the acts specified in section 60(1)(a) and 60(2) of the Act in respect of either range of Tek-Dek's products would constitute an infringement of the patent.

Construction of the claims

- 20 In order to determine whether the products in question infringe the patent, it is first necessary to properly construe the claims.
- 21 Both parties submitted that the claims should be interpreted by applying a purposive construction, as set out in *Kirin-Amgen*.³ I agree that this is the correct approach. That is, I must decide what the person skilled in the art (hereafter "skilled person") would have understood the patentee to be using the language of the claim to mean.
- 22 In addition, in accordance with section 125(3) of the Act, the Protocol on the Interpretation of Article 69 of the European Patent Convention ("the Protocol") applies. The protocol states:

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

³ *Kirin-Amgen and others v Hoechst Marion Roussel Limited and others* [2005] RPC 9

equivalent to an element specified in the claims.

Arguments concerning construction of the claims

Relevance of the prosecution history of the patent

- 23 Before considering the substantive arguments regarding construction of the claims, there are some points which I must address regarding the prosecution history of the patent before the EPO.
- 24 In his submissions regarding the construction of claim 1, Mr Church noted that during the pre-grant prosecution of the patent application, the Examining Division of the EPO (“the Examining Division”) had deleted a claim which explicitly referred to co-extruded planks and caulking strips. He argued that, since Flexiteek had accepted its deletion, they must not have intended for the claims to cover that embodiment. Moreover, the patent was maintained in amended form following a decision of the Opposition Division of the EPO (“the Opposition Division”). The Opposition Division proceedings concerned requests by two separate parties that the patent be revoked for lack of novelty and inventive step, amongst other things. While Flexiteek argued that the patent should be maintained as granted, they also filed first and second auxiliary requests comprising amendments to the claims, and the patent was maintained in amended form based on the first of these requests.
- 25 I was referred by Mr Church to *Furr and CD Truline*⁴ and *Wesley Jesson v Coopervision*⁵, Mr Church arguing that these authorities provide some basis for referring to the prosecution file when construing the claims.
- 26 *Furr and CD Truline* concerned the construction of claims which had been amended by the applicant to meet objections raised by the Patent Office. In that case the patentee had made a clear “admission against interest” during prosecution of the patent application and was not later allowed to argue for a wider interpretation as justification for the grant of an interlocutory injunction. In *Wesley Jesson v Coopervision* the judge referred to amendments made to claims before the EPO but in the event this was not an important factor in the decision.
- 27 The overall picture is, however, as pointed out to me by Mr Robin, that there is no principle of prosecution history estoppel in the UK. The courts have generally not approved of the notion that the addressee of a patent claim should be expected to consult the file when attempting to construe claims (see for example Lord Hoffman at paragraph 39 of *Kirin-Amgen*). The most I can take from the authorities cited is that it may be appropriate to do so in certain special cases or to add weight to other arguments.
- 28 That said, opposition proceedings are not the same as pre-grant proceedings in that they are *inter partes* and are conducted after the notification of grant of the patent. However, they are still administrative proceedings before the EPO involving examiners. The Opposition Division is not a court of record, and nor could it in my view be assimilated to one. Opposition proceedings could not therefore give rise to

⁴ *Furr and CD Truline* [1985] FSR 553

⁵ *Wesley Jesson Corp v Coopervision Ltd* [2003] RPC 20

an estoppel (whether cause of action or issue) and I see no reason to regard them any differently for the present purposes to pre-grant proceedings.

29 I shall therefore not accord any weight to admissions made by Flexiteek in the course of either the pre-grant or opposition proceedings when construing the claims of the patent.

Substantive arguments concerning construction of the claims

30 I have already commented that two features of claim 1, namely “plank strips” and “caulking strips”, provide the key to the resolution of the question before me, and I heard very extensive argument about how these expressions should be construed. Not surprisingly, therefore, a major part of what follows focuses on these two points.

Plank strips

31 The central question here is whether the terms “plank strips” and “planks” in claim 1 have the same meaning. In short, Mr Church argued that the skilled person would consider the term “plank strips” in claim 1 to be coterminous with the term “planks”, and therefore that claim 1 is limited to a surface covering where the planks and caulking strips are separate. On the other hand, Mr Robin argued that the skilled person would consider the term “plank strips” to be a generic term describing a repeat unit of the surface covering, which could include the caulking strip. Most significantly, on this interpretation, the caulking strips could be either integral with or separate from the planks.

32 Broadly speaking, the arguments put forward by both parties in respect of “plank strips” focused on four points, which I will deal with in turn:

- (i) A plain reading of claim 1 in light of the description.
- (ii) The scope of claim 2 and its effect on the reading of claim 1.
- (iii) The preferred embodiments.
- (iv) The application as filed.

Plain reading of claim 1 in light of the description

33 I have recited claim 1 above. However, it is worth recalling in particular those parts of the claim which refer to the terms “plank strips” and “planks”:

- (i) In the pre-characterising portion:
 - “the surface covering is made up by **plank strips**”
 - “the surface covering is formed with caulking strips intermediate each pair of **planks**”
 - “the **planks** are of a colour and luster imitating the colour and grain structure of a wooden material”

(ii) In the characterising portion:

- *“the **plank strips** are formed with matching male and female means at opposite longitudinal edges for interconnecting same side of each other thereby forming, with caulking strips between each pair of **planks**, an assembled surface covering”*
- *“the caulking strips are formed with a male connection part and the mating edge of the adjacent **plank** with a female connection part, or vice versa”*

[Emphasis added]

34 Mr Church argued that the skilled person would conclude that, whilst claim 1 lacks clarity, on balance the terms “plank strips” and “planks” are intended to mean the same thing.

35 To support this interpretation, Mr Church pointed to the wording of the claim itself, noting in particular that:

- (i) There is nothing in the language to suggest that the term “plank strips” refers to a subset of the covering including a plank and caulking strip.
- (ii) The skilled person would consider “planks” to be an abbreviation of “plank strips”.
- (iii) There is no antecedent for “each pair of planks”.
- (iv) The characterising portion of the claim follows the same pattern as the pre-characterising portion, with the full term “plank strips” used initially and the abbreviated term “planks” used thereafter.
- (v) The characterising portion requires the caulking strip to have a male or female connection part, which is additional to the feature that the plank strips are formed with matching male and female means at opposite longitudinal edges.

36 Accordingly, Mr Church argued, the skilled person would understand that the patentee intended to define a surface covering in which the connection part on the caulking strip is additional to and different from the male and female means on the plank strips, and so would reject the possibility that the term “plank strips” refers to a subset of the surface covering comprising a plank and a caulking strip.

37 Mr Church further argued that the skilled person would look to the description and drawings to help interpret the language of the claim, and he made a number of submissions in this respect:

- (i) The description does not contain an explicit definition of the term “plank strips”, and in particular it does not appear in the list of reference numerals in paragraph 24 of the specification, or in the specific description of the preferred embodiments. Therefore the skilled person would conclude that the term was not intended to have any special meaning other than being a reference to the planks.

- (ii) The term “plank strips” is only used in those parts of the description which correspond to the claims, and in the discussion of prior art which refers to “a covering [...] made of plank strips of a flexible material, which plank strips are laid side by side and have a recess for caulking material”. Mr Church argued that the skilled person would understand that what is being described in that phrase as “plank strips” are planks with recesses for receiving caulking material.
- (iii) The skilled person would note that different terminology is used throughout the patent specification to refer to the planks, and so could not reliably conclude that different terms in the claims were intended to have different meanings.

- 38 Mr Robin argued that, while one instance of a different term might be seen as an error or inconsistency, the fact that there are two instances of the term “plank strips” and four instances of the term “planks” would be more likely seen by the skilled person as an intention to differentiate those terms. In response, Mr Church reiterated that the same form was used in both parts of the claim, and that it is common in claims to find a term slightly abbreviated and for that terminology to be repeated.
- 39 Furthermore, Mr Robin highlighted two particular features of claim 1: that “the surface covering is made up by plank strips” and that “the surface covering is formed with caulking strips intermediate each pair of planks”. He noted that claim 1 does not specify whether or how the caulking strips and the planks may be connected together, and argued that the language used can only be reasonably construed by the skilled person as meaning that caulking strips are provided between planks, while plank strips is a generic term describing a more general repeat portion of the surface covering. He also noted that, while the same reference integers have been used for both of the terms “plank strips” and “planks”, these are non-limiting.
- 40 Mr Robin argued that it follows that the term “plank strips” refers to the general unit which is formed with caulking strips and planks as described in claim 1. Acknowledging Mr Church’s submission that the claims would be read in the context of the description, Mr Robin argued that “through the description there are many examples and it is very clear that the unit comprises both the planks and the caulking strips”.
- 41 In response to Mr Robin’s arguments, Mr Church noted that a lot had been made of “this mythical unit in the surface covering”, arguing that “there is no such unit defined in the patent or in the application as filed” and “no basis in the application as filed for the term ‘plank strips’ to be alleged to mean this mythical sub-unit of the surface covering”.
- 42 It seems to me that, on encountering two different terms in a claim, the skilled person’s first assumption would be that the terms define different parts. In *Virgin Atlantic Airways*⁶, it was held that the skilled person “is taken to suppose that the patentee knew some patent law”. While the decision of the Court of Appeal in that case did not directly address the matter of differing terms in claims, my view is that it follows that the skilled person would understand the patentee to be using different

⁶ *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors UK Ltd* [2009] EWCA Civ 1062

terms to refer to different parts.

- 43 While this would, in my view, be the skilled person's first assumption, they would of course not stop there. Rather, they would seek to determine which parts each term refers to, by reading the claim as a whole and by referring to the description.
- 44 On reading the claim as a whole, the skilled person would note that there does not appear to be any antecedent for "each pair of planks", i.e. the first instance of the term "planks". To my mind there are two possible explanations for this: either the antecedent was simply omitted, or the term "planks" is to be read as "plank strips". Either explanation could be the result of poor drafting.
- 45 I note that, in his submissions, Mr Church made a point of highlighting the errors and inconsistencies in the patent specification as a whole, commenting that "it is poorly drafted" and "trying to construe it is very difficult because there are just so many inconsistencies in the language". However, even if the skilled person accepts that the patent specification is poorly drafted, it seems to me that both of the above explanations are equally viable, and as such the skilled person gets no closer to determining whether "plank strips" and "planks" have the same meaning.
- 46 While Mr Robin did not dispute that there were inconsistencies in the specification as a whole, he pointed to the repetition of the term "plank strips" as an indication that use of that term in particular was deliberate, rather than an error or inconsistency. I do not think much weight can be placed on this argument. To my mind, if a claim is inconsistent in its terminology then it is very possible that an inconsistent term will be repeated, especially when, as noted by Mr Church, the same pattern is used in both parts of the claim. Therefore, in interpreting the term "plank strips", I do not consider its repeated use to be significant.
- 47 As outlined above, both sides made further arguments regarding the wording of the claim, and in particular the relationship between the caulking strips and the planks. In short, Mr Church submitted that there is nothing in the language to suggest that the term "plank strips" refers to a subset of the covering including a plank and caulking strip, and argued that the connection part on the caulking strip is additional to and different from the male and female means on the plank strips. Therefore, he argued, the skilled person would reject the possibility that the term "plank strips" refers to a subset of the surface covering comprising a plank and a caulking strip.
- 48 On the other hand, Mr Robin noted that claim 1 does not specify whether or how the caulking strips and the planks may be connected together, and argued that the language used can only be reasonably construed by the skilled person as meaning that caulking strips are provided between planks, while "plank strips" is a generic term describing a more general repeat portion of the surface covering.
- 49 It seems to me that neither interpretation argued by the parties is manifestly incompatible with the wording of the claim. However, in applying a purposive construction, I must decide what the skilled person would have understood the patentee to be using the language of the claim to mean.
- 50 It is clear that claim 1 does not explicitly define the "plank strips" as each comprising a plank and a caulking strip. In fact, all that the wording of the claim tells the skilled

person about the plank strips is that “the surface covering is made up by plank strips”, and “the plank strips are formed with matching male and female means at opposite longitudinal edges”. Therefore, even if the skilled person suspects that the terms “plank strips” and “planks” are not synonymous, I find nothing in the wording of the claim to suggest that the “plank strips” comprise a plank and a caulking strip.

51 The characterising portion of the claim states that the plank strips are interconnected aside of each other, “forming, with caulking strips between each pair of planks, an assembled surface”, and that the “caulking strips are formed with a male connection part and the mating edge of the adjacent plank with a female connection part, or vice versa”.

52 Notwithstanding Mr Robin’s argument that the claim does not specify whether or how the caulking strips and the planks may be connected together, in my view it is implicit – from the final clause of the claim at least – that the caulking strips and planks are to be connected together using the male and female connection parts. It is however left open whether these connection parts are provided on only one side of the plank and one side of the caulking strip, or on both sides of each.

53 In light of those parts of the claim which state that the surface covering is formed with caulking strips between each pair of planks, and in the absence of anything in the claim to suggest that the planks and caulking strips can be connected in any other way, on balance I believe the skilled person would conclude – on a plain reading of claim 1 – that connection parts are provided on both sides of the planks and caulking strips.

54 The skilled person would then be left to consider the meaning of the term “plank strips”. In the absence of anything to explicitly define this term in the claim, I can see no reason why the skilled person would conclude that it defines a subset of the surface covering comprising a plank and a caulking strip. Therefore, it seems to me that on a plain reading of the claim, the skilled person would either consider the term “plank strips” to be synonymous with “planks”, or would at least consider the term to be ambiguous. Either way they would look to the description to resolve any ambiguity.

55 I have already set out the arguments submitted by both sides regarding the use of “plank strips” in the description. In short, Mr Church argued that the description does not contain an explicit definition of the term “plank strips”, while Mr Robin stated “through the description there are many examples and it is very clear that the unit comprises both the planks and the caulking strips”.

56 While Mr Robin did not expand on his assertion regarding the “unit”, I note that in the patent specification the term “unit” is used twice:

- (i) In paragraph 13 which describes caulking strips “formed with equivalent male and female connection means arranged so that a set of planks and intermediate caulking strips provide an integral unit”.
- (ii) In paragraph 15 which states that the “planks are preferably formed by a plastic material which is stiff enough for keeping the planks and caulking together as an integral unit”.

57 In both cases, it seems to me that the term “unit” is being used in relation to embodiments where the planks and caulking strips are distinct parts. Therefore I do not see how this provides any support for the contention that claim 1 should be construed to cover embodiments where the planks and caulking strips are integrally formed. Nor can I see in the patent specification even an implicit definition of the term “plank strips”.

58 In the absence of any such definition, in my view the skilled person would have to consider – on a plain reading of claim 1 in light of the description – that the term “plank strips” does not have its own particular meaning and simply refers to the “planks” mentioned elsewhere throughout the specification. In other words, the skilled person would be led to consider that the terms “planks” and “plank strips” are synonymous.

The scope of claim 2 and its effect on the reading of claim 1

59 Mr Robin argued that it is a basic principle of claim construction that different claims should be construed as having different scopes. He argued that, if the terms “plank strips” and “planks” had the same meaning, claim 2 would not further limit the scope of claim 1.

60 Claim 2 reads:

“A surface covering according to any of the preceding claims, characterized in that the planks (1, 2) and the caulking strips are formed with mating interconnection means, preferably a male connection means (4) along one longitudinal edge and a female connection means (5) along the opposite longitudinal edge.”

61 Mr Robin argued that claim 2 requires both the planks and the caulking strips to be formed with connection means, such that the planks and caulking strips must be separate. He argued that the skilled person would understand the phrase “plank strips are formed with matching male and female means at opposite longitudinal edges [...], with caulking strips between each pair of planks” in claim 1 to be broader, such that it encompasses both embodiments where the planks and caulking strips are separate, and embodiments where they are integrally formed.

62 Mr Church argued that, contrary to Mr Robin’s submission, claim 2 does not require the planks and caulking strips to be separate. Noting that some features in the claim are optional, Mr Church argued that in its broadest sense all the claim requires is that the surface covering is characterised in that the planks and caulking strips are formed with mating interconnection means. It does not, he argued, necessarily require the planks and caulking strips to be separate. Therefore, Mr Church argued, claim 2 does not in any event have a narrowing effect on claim 1 and so cannot be used to support Mr Robin’s argument.

63 I agree. I can see nothing in claim 2 which explicitly requires the planks and caulking strips to be separate. As noted by Mr Church, all the claim requires is that the planks and caulking strips are formed with “mating interconnection means”. To my mind this is already implicitly required by the final clause of claim 1, which requires that “the caulking strips are formed with a male connection part and the mating edge

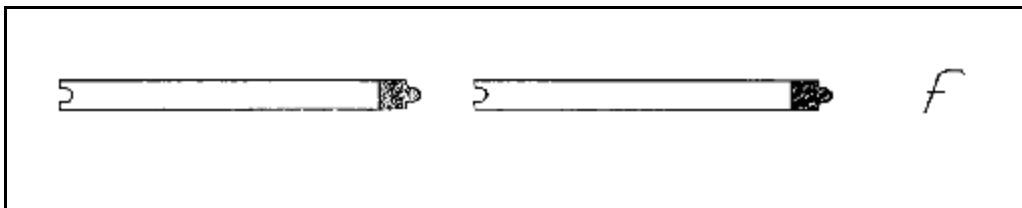
of the adjacent plank with a female connection part, or vice-versa". Therefore it seems to me that claim 2 is consistent with claim 1, regardless of which construction is placed on claim 1, but does not have a narrowing effect in this regard.

64 This arguably leads to a dilemma, as I agree that other things being equal, the skilled person will attempt to construe a claim more narrowly than one to which it is subordinate, and so might seek to interpret claim 1 more broadly based on their interpretation of claim 2.

65 However, as has already been noted, the patent specification as a whole is not particularly well drafted. Against this background, where the skilled person is confronted with language in claim 2 that does not on its face appear more limited than claim 1, then it is in my view likely that they would put this down to poor drafting and would not attempt to force a broader interpretation on claim 1 than can be supported by the wording and context.

The preferred embodiments

66 Mr Robin argued that the skilled person would reasonably construe independent claim 1 as encompassing all embodiments disclosed in the patent as being part of the invention, whenever possible. Therefore, he argued, the skilled person would interpret "plank strips" in such a way that it encompasses the embodiment of Figure 5f (shown below), where the planks and caulking strips are co-extruded.



67 To further support this argument, Mr Robin noted that claim 13 of the application as filed had been directed to a surface covering comprising a co-extrusion of planks and integral caulking strips, which he argued confirmed that the embodiment of Figure 5f was intended to be covered.

68 Mr Church noted that in *Merck & Co v Generics*⁷, the Judge reviewed the requirements of the Protocol and stated:

"It seems to me that what the Protocol requires is that the monopoly should cover all embodiments, whether explicitly mentioned in the claims or not, which the notional skilled reader would conclude, with reasonable confidence, the inventor wanted to cover. Where it is clear that the patentee did not intend to obtain protection for particular variants, it is not open to the court to extend the monopoly to cover them. Similarly, if a notional skilled addressee cannot conclude with reasonable confidence that the inventor wanted to obtain

⁷ *Merck & Co Inc v Generics (UK) Ltd* [2004] RPC 31

protection for a particular embodiment, it must follow that the patent conveys the message that the patentee might well have intended to exclude that embodiment.”

69 Mr Church also noted that the general principles of claim construction in the UK were set out in abbreviated form in *Virgin Atlantic Airways*. Mr Church highlighted a number of the principles set out by the Judge, but for the purposes of this decision I think it is sufficient to note the following one in particular:

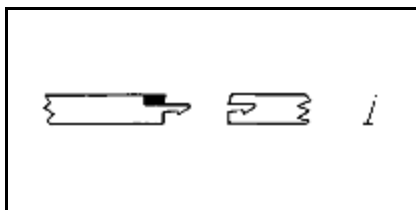
“It follows that if the patentee has included what is obviously a deliberate limitation in his claims, it must have a meaning. One cannot disregard obviously intentional elements.”

70 Mr Church argued that the case law makes clear that it is not possible to ignore limitations introduced in the claims to cover embodiments in the application as filed, and that the only embodiments covered were those which the skilled person would construe with reasonable confidence were intended to be covered. I agree with this interpretation of the authorities.

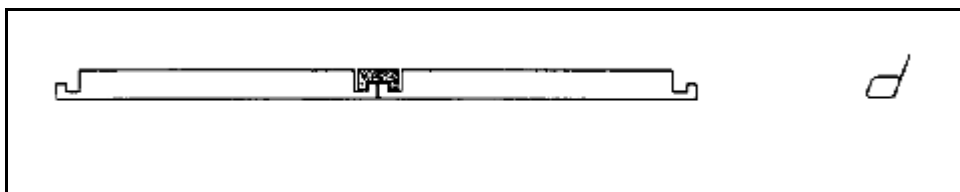
71 Mr Church noted that, while original claim 13 had referred to a co-extrusion of planks and caulking strips, such a claim is not included in the granted patent. Therefore, he argued, the skilled person would conclude that the patentee did not intend to cover this embodiment.

72 Furthermore, Mr Church argued that the patent specification includes a number of embodiments that are excluded from the scope of claim 1, even by Mr Robin’s own construction, in particular:

- (i) The embodiment described at column 3, lines 36-38 which Mr Church argued describes a surface covering without caulking strips.
- (ii) The embodiment shown in Figure 5i (shown below) which Mr Church argued shows a caulking strip without a male or female connection part.



- (iii) The embodiment shown in Figure 5d (shown below) which Mr Church argued shows interconnection of planks and caulking strips using overlapping portions of planks and caulking strips rather than male or female connection parts.



73 I agree that each of these embodiments falls outside the scope of claim 1, regardless

of which construction is accepted. Because some embodiments are clearly outside the scope of the claims, this undermines the argument that the skilled person would seek to interpret the claims as encompassing all embodiments. As such, I cannot accept Mr Robin's argument that the skilled person would necessarily interpret "plank strips" such that it encompasses the embodiment of Figure 5f.

74 I should note that, in their submissions regarding original claim 13, both parties made detailed and complex arguments regarding the original dependencies of the claims. In my view it is not necessary to consider these arguments in detail. The point here is that original claim 13 explicitly included the feature of co-extruded planks and integral caulking strips, but the granted claims do not. I have commented above that the courts have not approved of the notion of consulting the pre-grant prosecution file as an aid to construing claims, but in any event I do not consider that the explicit reference to co-extrusion in claim 13 as filed is of great assistance to either side.

The application as filed

75 Mr Church argued that the skilled person would also refer to the application as filed to see if it provides any clarity regarding the term "plank strips", and would note that the term is used only once, in original claim 8. Again, a note of caution is needed here with regard to consulting the file, but I agree that faced with inconsistencies and drafting issues in a granted claim, the skilled person may well be induced to do so. I shall therefore consider the arguments on this point.

76 Original claim 8 reads:

*"A surface covering according to any of the preceding claims, **characterized** in that the surface covering is made up by plank strips (1,2) having a colour and luster imitating the grain effect of a wooden material like teak, mahogany, pine, oregon pine, redwood, etc., which planks are formed with matching male and female means at opposite longitudinal edges for interconnecting same."*

77 Mr Robin disputed that this was the only occurrence of the term "plank strips" in the application as filed, noting that the original description described the invention as being "formed by strips of flexible material". Mr Robin argued that the skilled person would see that the term "strips" refers to the unit of flexible material which, he argued, is then further described later as comprising the planks and the caulking strips.

78 Responding to this point, Mr Church noted that "strips of flexible material" is not the same as "plank strips" which is the term used in claim 1, and argued that there is nothing to suggest that the "strips" to which Mr Robin referred were intended to refer to a sub-unit of the surface. I agree – contrary to Mr Robin's argument, I can find no suggestion in the description as filed that the "strips of flexible material" comprise the planks and the caulking strips.

79 Mr Church further argued that "which planks" in the second clause of original claim 8 was a reference back to "plank strips", and therefore the terms "plank strips" and "planks" were being used synonymously. Alternatively, Mr Church submitted that the term may have been intended to define individual plank strips, rather than planks being part of a sheet, noting that the original application included such embodiments.

Furthermore, Mr Church argued that since neither original claim 8 nor any of the preceding claims included the feature of a caulking strip, the skilled person would reject any notion that the term “plank strips” could have been intended to refer to a subset of the surface covering comprising a plank and a caulking strip.

80 Mr Robin argued that, since claim 8 is dependent on claim 1, “which planks” in claim 8 could refer to the “planks” formerly defined in claim 1. Therefore, he argued, “plank strips” and “planks” were not being used synonymously. Responding to this point, Mr Church argued that it was clear that “which planks” in claim 8 referred to “plank strips” earlier in the claim, and that it would not be natural to refer back to the “planks” in claim 1.

81 I am not sure that this detailed point helps a great deal. Even if the skilled person came to the view that, on the face of it, the terms “plank strips” and “planks” in original claim 8 were not being used synonymously, they would still be left to determine the actual meaning of the term “plank strips”. The mere use of “plank strips” in original claim 8 does not constitute a definition for the term, and there is no definition for it elsewhere in the application as filed.

82 Therefore, I do not think that the skilled person would be any further equipped to construe claim 1 of the patent having referred to original claim 8, or indeed the whole of the application as filed, and so I cannot see how it would alter their interpretation of claim 1.

Overall conclusion regarding the term “plank strips”

83 In my view, based on reading claim 1 in light of the description, the skilled person would conclude that the term “plank strips” in claim 1 has the same meaning as the term “planks”, for the reasons discussed above. While the skilled person would look to particular aspects of both the granted patent specification and possibly the application as filed to inform their interpretation, they would not, in my view, find anything which would lead them to conclude that the term “plank strips” refers to a subset of the surface covering comprising a plank and a caulking strip. On the contrary, they would conclude that the planks and caulking strips must be separate.

Caulking strip

84 This is the second of the two important expressions in claim 1 around which this dispute revolves. The question here is whether the “caulking strip” of claim 1 must form a watertight seal, as argued by Mr Church, or whether the term includes imitation caulking strips which do not need to form a watertight seal, as argued by Mr Robin.

85 Broadly speaking, the arguments put forward in respect of “caulking strip” focused on three points:

- (i) The limiting effect of “useful for covering a boat or yacht deck”.
- (ii) The technical definition of the term “caulking”.
- (iii) Use of the term “caulking strip” in the patent specification as a whole.

86 I will consider each of these points in turn.

The limiting effect of “useful for covering a boat or yacht deck”

87 Mr Church submitted that, in accordance with generally accepted principles of claim construction, the term “useful for” should be taken to mean “suitable for”, citing a number of cases⁸ to support this viewpoint. As such, he argued that claim 1 is not strictly limited to surface coverings when used on boat or yacht decks, but would encompass any surface covering which is suitable for use on a boat or yacht deck having the features defined in claim 1.

88 According to this view, the phrase “useful for covering a boat or yacht deck” in claim 1 meant that the surface covering must be watertight, and the skilled person would understand that the patentee intended the term “caulking strip” to mean strips which in themselves ensure a watertight connection between adjacent planks, since this is the only feature in claim 1 which can provide a watertight seal between adjacent planks. The skilled person would not, Mr Church argued, consider that the term was intended to cover surface coverings including only ornamental strips which replicate the appearance of a traditional caulking strip but do not provide a watertight seal.

89 Mr Robin did not dispute that “useful for” should be taken to mean “suitable for”, and acknowledged that the invention is a surface covering for covering a boat or yacht deck. However, he argued that modern decks are typically made of a continuous metal, polymeric or composite surface which is itself watertight. He added that this was well known in the industry at the time of the invention, so the skilled person would be aware that the surface to be covered is already watertight. Therefore, Mr Robin argued, there was no requirement for the surface covering to be watertight.

90 I agree that the phrase “useful for covering a boat or yacht deck” quite simply requires that the surface covering is useful or suitable for that purpose. As such, it must be able to withstand getting very wet. However, I tend to Mr Robin’s view that this, of itself, does not necessarily mean that it must be entirely waterproof.

The technical definition of the term “caulking”

91 Mr Church argued that the term “caulking” is generally understood to refer to material which provides the function of a seal, citing an excerpt from *Odhams Practical and Technical Encyclopaedia*⁹. I note that this describes “caulking” as a “method of making joints water- or steam-tight”, giving examples in the field of ship-building.

92 In response, Mr Robin questioned the relevance of a definition published in 1947, arguing that such a definition may no longer reflect the normal meaning of this term at the time of the invention in 1999, and that the nature and structure of typical boat and yacht hulls between the two times may be very different. In particular, Mr Robin once again noted that while the surface covering of a traditional wooden deck may have needed to be waterproof, modern decks typically comprise a continuous and

⁸ *L’Air Liquide Societe’s Application* 49 RPC 428; *Adhesive Dry Mounting Co Ltd v Trapp* 27 RPC 341; *Coflexip SA v Stolt Comex Seaway MS Ltd* [2001] RPC 9; *FNM Corp v Drammock International* [2009] EWCH 1294 Pat. Ct.

⁹ 1947. *Odhams Practical and Technical Encyclopaedia*. London: Odhams Press Limited

waterproof surface, such that the surface covering may imitate the appearance of a wooden deck without providing a waterproof seal.

- 93 Mr Robin submitted a definition from the *Collins English Dictionary*¹⁰, arguing that it supported his interpretation of “caulking strip” as encompassing strips which imitate the appearance of a caulking strip without providing a watertight seal. Mr Robin noted that the dictionary provides two possible definitions for the term “caulk”, and that while the second definition indicates leakage prevention, the first defines “caulk” as “to stop up (cracks, crevices, etc.) with a filler”. Therefore, he argued, the provision of a watertight seal is not a necessary function of the term “caulk”. Acknowledging that the second definition is labeled “*Nautical*”, Mr Robin argued that the definition relates to planks at the bottom of a vessel, in contrast to the invention of claim 1.
- 94 Regarding the age of the excerpt from *Odhams*, Mr Church argued that this simply shows how long the term has been used in relation to nautical applications. Regarding the *Collins* definition, Mr Church argued that, while the “nautical” definition refers to the bottom of a boat rather than a deck, it shows that in a nautical application the term “caulking” has a more particular meaning.
- 95 I thus have before me one definition of the term “caulk” (the first *Collins* definition) which does not mention or imply waterproofing. On the other hand, I have two definitions (the second *Collins* definition and the *Odhams* definition) which do imply that “caulk” or “caulking” has a waterproof effect, particularly in the nautical field, albeit in relation to the bottom of boats.
- 96 I should make clear that, in construing the claim, dictionary definitions may be of assistance but cannot in themselves be determinative. In my view the skilled person would consider the context in which the term “caulking” is being used, i.e. that it is being used in relation to a surface covering “useful for covering a boat or yacht deck”. Therefore, the question I must ask myself is, what would the term “caulking” imply to the skilled person confronted with the problem of covering a boat or yacht deck?
- 97 I note that while the first *Collins* definition does not imply a waterproofing effect, it defines “caulk” as “to stop up (cracks, crevices, etc.) with a filler”. It is evident, on reading the specification as a whole, that the invention does not relate in any way to stopping up cracks or crevices with a filler. Therefore, in my view, this particular definition is irrelevant.
- 98 While the other definitions which were referred to me relate to waterproofing on the bottom of boats rather than decks, they do nevertheless provide a indication that the term “caulking”, when used in the nautical field, implies a waterproofing effect.

Use of the term “caulking strip” in the patent specification as a whole

- 99 Mr Robin argued that the skilled person would interpret “caulking strip” in its normal meaning based on the features recited in claim 1, and that the structural limitations in the claim define the caulking strip within the context of the invention.

¹⁰ 1985. *Collins English Dictionary*. Glasgow: William Collins Sons & Co. Ltd.

- 100 Furthermore, Mr Robin argued that the skilled person would interpret the claims as encompassing all embodiments disclosed as being part of the invention, whenever possible, pointing to a number of passages in the granted patent specification and the application as filed which he argued do not refer to sealing properties of the caulking strips, but instead recite in several places the word “imitating”:
- (i) Paragraph 13 of the patent specification and the corresponding part of the application as filed, where it is noted that adhesive may be used in the joint between plank and caulking strip if necessary. Mr Robin argued that the optional use of adhesive indicates that the caulking strip is not required to function as a watertight seal.
 - (ii) Paragraph 14 of the patent specification and the corresponding part of the application as filed, which recites “The caulking strips preferably are made of another colour than the planks, for instance a black colour imitating the rubber material seams in the seamed decks of yachts”. Mr Robin argued that this passage confirms that the term “caulking strip” relates to its appearance rather than to any sealing function.
 - (iii) Paragraph 16 of the patent specification and the corresponding part of the application as filed, which refers to assembly of the embodiment of Figure 5i “with or without the caulking part of the co-extrusion being under compression upon joining”. Mr Robin argued that the optional compression of the caulking part upon joining indicates that the caulking strip is not required to function as a watertight seal.
- 101 Regarding the references to the caulking strips being a different colour, imitating rubber material seams in decks of yachts, Mr Church argued that the passages merely teach that the choice of a contrasting dark colour enables the assembly to resemble a traditional deck, but do not imply that the strips do not function to provide a watertight seal.
- 102 Regarding the description of the embodiment of Figure 5i, Mr Church argued that this embodiment is not covered by claim 1 for the reasons already discussed in relation to “plank strips”, and submitted that part of the function of the watertight seal is that the caulking strip itself has to have a male or female connecting part.
- 103 Mr Church also drew attention to paragraph 8 of the patent specification, which states that one of the advantages of the surface covering according to the invention is that it is “completely waterproof”.
- 104 Noting that, as he had already argued, the patent includes numerous embodiments which fall outside the scope of the claims, Mr Church argued that the skilled person would know that they cannot interpret the claims to cover all embodiments. Furthermore, he argued that, while the application as filed was directed to surface coverings useful for a broad range of applications, by limiting claim 1 to a surface covering useful for boat and yacht decks the patentee had indicated a very specific application in which a watertight seal is required.
- 105 In my view, the particular parts of the specification to which Mr Robin referred do not do much to assist the skilled person in coming to a view on the meaning of the term

“caulking strips”. While I accept that none refers to sealing properties of the caulking strip, neither am I persuaded that any of them implies that “caulking strip” can refer to an imitation caulking strip without a sealing function.

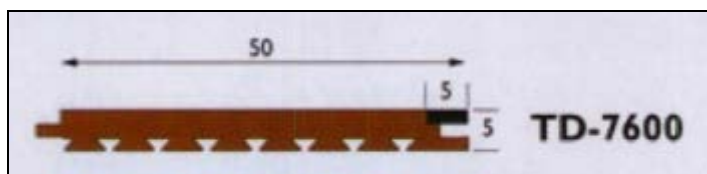
- 106 On the other hand, paragraph 8 states that the surface covering according to the invention is completely waterproof. While it is not stated explicitly how the surface covering is to be made waterproof, this paragraph provides further context for the use of the term “caulking strip” in claim 1. In my view, in light of this context, the skilled person would interpret the term “caulking strip” to mean a strip which provides a watertight seal.

Overall conclusion regarding the term “caulking strips”

- 107 While I do not consider that the phrase “useful for covering a boat or yacht deck” necessarily requires the surface covering to be entirely waterproof, in my view the skilled person would nevertheless have to conclude that the surface covering of claim 1 must be waterproof, given the explicit statement to this effect in paragraph 8 of the granted patent specification. In this context, they would construe “caulking strip” to have its usual meaning when used in relation to nautical applications, i.e. they would interpret “caulking strip” to mean a strip which provides a watertight seal.

Infringement

- 108 Having construed the contentious elements of the claim, I must now consider whether any of the products in the Flexible range infringes the patent.
- 109 The Flexible range is described in Mr Andrew Oats’ witness statement of 12 January 2012 (Exhibit 6), supplemented by evidence in the form of a technical specification (Exhibit AO2) and instructions entitled “A Guide to Laying Tek-Dek” (Exhibit AO3).
- 110 According to Mr Oats’ witness statement, the Flexible range comprises extruded plank sections TD-7600, TD-7601, TD-7602, TD-7603, TD-7604, TD-7605, TD-7606, TD-7608¹¹, TD-7609 and TD-7610. The Flexible range also comprises spacers TD-7607 and TD-8607, block material TD-7612 and welding rod TD-7613 (as shown in Exhibit AO2).
- 111 I shall focus on plank section TD-7600. As I have said, the Flexible range includes a number of products which vary in their size and shape but there was no dispute that the arguments in relation to this particular item of the range could equally be applied to the others. Samples of TD-7600 plank sections (Exhibit AO4) accompanied Mr Oats’ witness statement, and a cross-section is included in the technical specification, which is reproduced below again for ease of reference.



- 112 The TD-7600 plank section is extruded from a flexible PVC compound, with a main

¹¹ Not shown in Exhibit AO2.

plank portion, a co-extruded ornamental strip along one edge in a contrasting colour, and tongue-and-groove formations along its edges to allow a number of similar plank sections to be joined together.

- 113 I am satisfied that the TD-7600 when assembled would constitute a surface covering suitable for a boat deck imitating a wood finish and having those features of claim 1 which are not at issue (as discussed above). In my analysis below I shall therefore focus on whether the accused product has the disputed features of claim 1 as I have construed them.
- 114 I concluded above that claim 1 must be construed as requiring the surface covering to be made up by planks (also referred to as plank strips) and separate, intermediate caulking strips which provide a waterproofing effect.
- 115 In Mr Robin's submission, the co-extruded ornamental strip of the TD-7600 constitutes a "caulking strip" within the meaning of this term in claim 1. Since each of the sections is formed with matching male and female means at opposite longitudinal edges, he argued that the connection between them necessarily provides a degree of water tightness.
- 116 Furthermore, while acknowledging that, as shown, the co-extruded strip only constitutes one limb of a female interconnecting part, Mr Robin contended that since the product is used to make a surface covering which would be viewed from above, and the co-extruded strip is on the upper surface of the product and is part of the female section, it would be considered by the skilled person to satisfy the requirement of claim 1 that it must have either a male or a female connection part.
- 117 I cannot accept these arguments. In the first place, a co-extruded ornamental strip which is integral with the plank section does not in my view meet the requirement as I have construed it for a separate caulking strip intermediate the planks. Even if I am wrong on this, I do not believe that the strip could be said to be formed with a male or female connection part. I have considered Mr Robin's submission on this point but do not agree that the perspective from which the strip is viewed is relevant. If any part of the TD-7600 can be considered a "caulking strip" at all, it must in my view be only the co-extruded portion itself. This clearly lacks a (male or) female connection part.
- 118 As regards the degree of watertightness of the seal between the planks, Mr Church submitted to me that the tongue-and-groove formations are a loose fit, noting that the ornamental strip is made from the same base material as the remainder of the plank section, and so has the same mechanical properties (and would therefore be unsuitable to provide a watertight seal between adjacent planks). He made the point that in practice waterproofing between the surface covering and the underlying deck surface is instead formed by the adhesive holding the plank sections to the deck as described in Mr Oats' witness statement.
- 119 I accept the view put forward by Mr Church. Having inspected the physical exhibit and in the light of the submissions made, I have no doubt that the sections of the TD-7600 product are incapable of themselves forming a watertight seal when assembled together without the addition of an adhesive or some other sealing material.

- 120 For all the above reasons it is my view that the TD-7600 plank sections when assembled would not comprise a covering within the scope of claim 1.
- 121 As regards the other plank sections in the Flexible range, it is sufficient to note that these either all comprise a differently coloured co-extruded strip of the same form as that on the TD-7600 plank section, or do not comprise a co-extruded strip at all. Mr Robin accepted in the hearing that the products which lack a co-extruded strip do not infringe. Therefore, since I have found that an assemblage comprising TD-7600 plank sections does not fall within the scope of claim 1, it follows that the same goes for the other products in the Flexible range.
- 122 It is a consequence of the above finding that the making, disposing of, offering to dispose of, use or import of any of the products in the Flexible range, or the keeping of any of the products in the Flexible range whether for disposal or otherwise, would not infringe the patent.
- 123 I have already noted that Flexiteek no longer opposes the request in respect of the Professional range.

Validity

- 124 I should note here that it was an element of Tek-Dek's case that if Flexiteek's view of the scope of claim 1 were accepted, then the patent would be invalid for added matter and lack of inventive step over certain prior art. Given my conclusions above, I do not need to consider these arguments further.

Conclusion and declaration

- 125 I have found that, when assembled into a covering for a boat or yacht deck, none of the products presented in these proceedings within Tek-Dek's Professional and Flexible ranges of products falls within the scope of the patent.
- 126 I therefore declare that the doing of any of the acts specified in section 60(1)(a) and 60(2) of the Patents Act 1977 in respect of the following products would not constitute an infringement of European patent (UK) number EP 1 196 672 B2:
- TD-9231, TD-9245, TD-9255, TD-9280, TD-92125, TD-92125-N, TD-9215, TD9299, TD-7607-R, "gunnel section" and "infill", collectively known as Tek-Dek Professional.
 - TD-7600, TD-7601, TD-7602, TD-7603, TD-7604, TD-7605, TD-7606, TD-7607, TD-7608, TD-7609, TD-7610, TD-7612, TD-7613 and TD-8607, collectively known as Tek-Dek Flexible.

Costs

- 127 The preliminary decisions of 10 August 2012 and 13 March 2013 did not deal with costs, and so I must consider the whole of the proceedings. Tek-Dek have won at each stage of the proceedings and so are entitled to an award of costs.
- 128 In Tek-Dek's amended statement of case, they argued that Flexiteek's position in refusing to either submit detailed arguments on infringement regarding all of the

products referred to in the application, or to admit that those products for which no detailed arguments were provided did not infringe, was unreasonable and amounted to an abuse of proceedings. They argued that Flexiteek's refusal to admit non-infringement in relation to the Professional range in particular should be taken into account, given that there was no possibility of a successful case for infringement even on Flexiteek's own construction of claim 1.

- 129 In Flexiteek's amended counterstatement, Flexiteek argued that Tek-Dek's request was unjustified in the circumstances, not least because of Tek-Dek's delay in initiating the current proceedings, a judgment from the Norwegian Court (considered in the preliminary decision of 10 August 2012) which held that Tek-Dek was bound by the terms of a licence agreement between the parties, and Tek-Dek's late request for amendment of their statement of case.
- 130 While the proceedings could have proceeded more smoothly, I do not consider that the behaviour of either party was such as to warrant a costs award off the standard scale. However, in awarding scale costs, I will of course take account of all of the work required at each stage. In this regard I note that the two preliminary matters were decided on the basis of the papers on file and that the substantive hearing lasted approximately half a day with no cross-examination but a fair amount of material to consider.
- 131 Taking all this into account, I award Tek-Dek the sum of £2500 as a contribution towards its costs.
- 132 This sum should be paid within seven days of the expiry of the appeal period below. In the event of an appeal, payment may be suspended.

Appeal

- 133 Any appeal must be lodged within 28 days.

A C Howard

Divisional Director acting for the Comptroller