



BL O/078/07

16 March 2007

PATENTS ACT 1977

APPLICANT Ms Penelope Mary Townsend

ISSUE Review of Opinion 07/06 - Whether
 patent GB 2410415B is infringed

HEARING Mr S J Probert
OFFICER

DECISION

- 1 This is a review of an opinion (“the opinion”) under section 74B of the Patents Act. The opinion was requested by the proprietor of GB 2410415 (“the patent”), Ms Penelope Mary Townsend. The opinion concerned an alleged infringement of the patent, which relates to a removable sock for a boot. No observations were submitted on the request for an opinion, and there is no third party involved in the present review.
- 2 The opinion found that a sample of the alleged infringing sock (provided by Ms Townsend) did not infringe the patent. The opinion indicated that Ms Townsend (as proprietor of the patent) could apply for a review under section 74B and rule 77H(5) if she thought that, by reason of its interpretation of the patent specification, the opinion wrongly concluded that the alleged infringing sock did not infringe.
- 3 The purpose of a review such as this has been explained in at least one earlier review¹, but it is worth repeating here that opinions are not binding for any purpose. If the whole or part of the opinion remains in place after this review, it will still not be binding for any purpose. I am also approaching this review on the basis that my task is to consider whether the examiner has erred in reaching the conclusion stated in the opinion. I am not providing a second opinion.

The Patent

- 4 The opinion describes the invention that is the subject of the patent in a fair amount of detail, and also describes the alleged infringing product — a sock

¹ Roger Colston Downs patent, BL O/025/07, dated 18th January 2007. See paragraphs 5-7.

offered for sale by Hawkshead Ltd. They are both fleece socks intended for removably fitting in a boot, eg. a Wellington boot. I can easily imagine that they would make wearing 'wellies' a much more comfortable experience.

The 'Grounds' of the Review

- 5 Ms Townsend has asked for a review of one specific aspect of the opinion - the interpretation that the examiner placed upon the following words (defining the construction of the foot portion of the sock) found in claim 1:

“formed of a piece of flexible, fleece fabric material”

- 6 The examiner concluded that this meant that the foot portion must be formed of a single piece of material. This conclusion is significant because the foot portion of the Hawkshead sock (the alleged infringing sock) is clearly formed from three pieces of flexible, fleece fabric material — the three pieces corresponding to sole, the upper, and the toe piece.

- 7 Ms Townsend disagrees with the examiner's interpretation for two reasons:

- a. The plain English meaning of the term “... formed of a piece of flexible, fleece fabric material”
- b. The correct purposive construction to be given to the term.

- 8 The first point questions whether the examiner was correct to equate the indefinite article “a” to “just one”. Ms Townsend illustrates her first point very effectively using an example as follows:

If you have two pound coins in your purse and somebody asks you: “Do you have a pound coin in your purse?” Would you say “Yes, I have two” or “No, I have two”. Of course you would answer in the affirmative because as a matter of plain English you have a pound coin in your purse. The answer would of course be entirely different if you were asked “Do you have just one pound coin in your purse?”. Then it would be right to say “No, I have two”. Thus, the meaning of “a” and “just one” are entirely different.

- 9 In the context of a casual conversation this is a perfectly reasonable, and compelling argument. But in the context of a formal legal document establishing the precise scope of a commercial monopoly, which is essentially what a claim in a patent specification is, different rules apply. In particular, as Ms Townsend recognises in relation to her second 'ground', the Courts have given specific guidance on how the terms of a patent claim are to be construed. Moreover, there are provisions in patent law² that also govern how the claims of a patent shall be interpreted. These provisions, and the guidance of the Courts relating to them, are the correct starting point for construing claims in a patent. Therefore I am not persuaded on the basis of

² Section 125(1) of the Patents Act, and the Protocol on the Interpretation of Article 69 of the European Patent Convention.

Ms Townsend's "plain English" point that the examiner erred in interpreting the term in question.

- 10 Turning to Ms Townsend's second 'ground', her point is that if the correct purposive construction is followed, one does not inevitably arrive at a sock in which the foot portion is formed from a *single* piece of material. She suggests that the examiner made this assumption as his starting point because the embodiment illustrated in the patent specification shows a sock with a foot portion "formed from just one piece of fleece fabric material". According to Ms Townsend, it would be obvious to the skilled reader that the foot portion may be formed in a number of ways (without being limited to a single piece of material), and that these variations clearly have no effect on the way the invention works.
- 11 I have looked at the examiner's opinion in detail, and I can find no basis for Ms Townsend's suggestion that he has not applied the correct principles of purposive construction. On the contrary, the examiner states in paragraph 13 that he must put a purposive construction on claim 1. He also cites the most up-to-date authority on claim construction³ and says that he is following it.
- 12 Of course, it does not necessarily follow that just because the examiner says that he is adopting a purposive construction, that that is what he has in fact done. However, the examiner has explained in the opinion how he has applied the principles of purposive construction in this case. As my school teachers used to say, he has "shown his working out". I have therefore been able to trace the steps he took to reach his conclusion, and I cannot see any flaw in his reasoning; in particular I cannot find any indication that he has not adopted a purposive construction.
- 13 Moreover, it appears to me that the conclusion that the examiner reached in the opinion is not an unreasonable one having regard to the description of the invention, and the established principles governing claim construction (eg. purposive construction) that the examiner has followed. Consequently I am not going to set the opinion aside on this ground either.

Conclusion

- 14 I have considered the two reasons (or grounds) suggested by Ms Townsend for putting the opinion aside, but I have not been persuaded by either of them.
- 15 Ms Townsend requested a review of the opinion specifically in relation to the finding that claim 1 was not infringed. Only if my review had disturbed the examiner's opinion in relation to claim 1 has Ms Townsend requested that I go further and consider whether claims 11 and 12 are also infringed. (The opinion does not consider the infringement or otherwise of claims 11 and 12 separately because these claims are both dependent on claim 1.) In the circumstances I do not need to consider claims 11 and 12 as part of this review.

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

- 16 Although Ms Townsend disagreed with one particular aspect of the examiner's opinion for two reasons (as stated in paragraph 7 above), I have also considered whether there are any other grounds for setting aside the whole or part of the opinion, but I found none.
- 17 I therefore decide that the opinion correctly interpreted the claims and description of the patent in the present case, and I make no order to set the opinion aside.

Appeal

- 18 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days of the date of receipt of this decision.

S J Probert

Deputy Director acting for the Comptroller