



24 February 2009

PATENTS ACT 1977

APPLICANT Penelope Mary Townsend

ISSUE Review of Opinion 01/08 – whether
patent GB2410415 is infringed

HEARING OFFICER A.C. Howard

DECISION

Introduction

- 1 This is a review of Opinion 01/08, (“the opinion”), under section 74B of the Patents Act 1977. The Opinion was requested by Hugh David Niblock and asked the question of whether a new design of sock, the “proposed Hunter sock”, would infringe patent number GB2410415C¹ (“the patent”). The proprietor of the patent, Penelope Mary Townsend, submitted observations on the construction of the main claim and observations in reply were submitted by the requester. The opinion concluded that the lower foot portion of the sock of the patent must be just one piece of material in the overall foot portion of the sock and that the proposed Hunter sock, in which the foot portion was formed from two large pieces of material, would not infringe the patent.
- 2 The proprietor has requested that the opinion be set aside and has applied for a review under section 74B using the words of the relevant rule, rule 98, of the Patents Rules 2007, which states:

(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, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.
- 3 The purpose of a review under section 74B has been explained in several

¹ Granted as GB2410415B but reprinted to rectify errors in pages 1 and 4. The claims of GB2410415C are identical to those of GB2410415B.

previous reviews but has also been the subject of appeal². In judgment on that case Kitchen J stated, at paragraph 22:

In the case of an appeal under rule 77K, the decision the subject of the appeal is itself a review of the opinion of the examiner. More specifically, it is a decision by the Hearing Officer as to whether or not the opinion of the examiner was wrong. I believe that a Hearing Officer, on review, and this court, on appeal, should be sensitive to the nature of this starting point. It was only an expression of an opinion, and one almost certainly reached on incomplete information. Upon considering any particular request, two different examiners may quite reasonably have different opinions. So also, there well may be opinions with which a Hearing Officer or a court would not agree but which cannot be characterised as wrong. Such opinions merely represent different views within a range within which reasonable people can differ. For these reasons I believe a Hearing Officer should only decide an opinion was wrong if the examiner has made an error of principle or reached a conclusion that is clearly wrong. Likewise, on appeal, this court should only reverse a decision of a Hearing Officer if he failed to recognise such an error or wrong conclusion in the opinion and so declined to set it aside. Of course this court must give a reasoned decision in relation to the grounds of appeal but I think it is undesirable to go further. It is not the function of this court (nor is it that of the Hearing Officer) to express an opinion on the question the subject of the original request.

- 4 Consequently, I am not providing a second opinion; I am reviewing whether the examiner, by reason of his interpretation of the specification of the patent, was in error in reaching his conclusion.
- 5 A counterstatement was received from Marks & Clerk, representatives for Hunter Boot Limited, agreeing with the opinion. Both parties have agreed to a decision on the papers, in correspondence dated 12 December 2008 and 19 December 2008 respectively.

The Patent

- 6 The invention of GB2410415 is a sock for a boot, the sock having three defined parts: a lower foot portion, an upper portion for fitting snugly around the inside of the upper portion of the boot, and an outer portion for fitting snugly around the outside of the top of the boot. Claim 1 of the granted patent is as follows:

" A sock of flexible fleece fabric material for removably fitting in a boot, the sock including a lower, foot portion of flexible, fleece fabric material, for fitting snugly within the boot, an upper portion of flexible, fleece fabric material, for fitting snugly around the inside of the upper portion of the boot and an outer portion of flexible, fleece fabric material that extends downwardly from the top of the upper portion for fitting snugly around the outside of the top of the boot and for defining a channel between the outer portion and the upper portion in which the top of the boot is, in use, received, the sock comprising a plurality of pieces of material stitched together, the lower, foot portion being formed of a piece of flexible, fleece fabric material and the upper portion being formed of a further piece of flexible, fleece fabric material."

² DLP Limited [2007] EWHC 2669

Background

- 7 There have been two previous opinions and one opinion review relating to the patent. opinion 07/06, requested by the proprietor, concluded that a sock manufactured by Hawkshead Ltd. did not infringe the patent, among other things because its foot portion was formed from three pieces of material – a sole piece, a toe piece and a piece making up the top and sides. It was in this opinion that the examiner first concluded that the foot portion of the patent must be just one piece of material, by following *Hoffman LJ's* comments on purposive construction in *Kirin-Amgen*³.
- 8 The proprietor requested a review of that opinion under Sect.74(B)⁴, seeking to set aside its conclusion on the basis that the examiner misinterpreted the main claim either on plain English or on a purposive construction. In that review, the Hearing Officer decided that the examiner had appropriately followed *Kirin-Amgen* and that, on a purposive construction, it was not unreasonable for the examiner to conclude that the lower foot portion was formed from just a single piece of material and that he would therefore not disturb his finding that claim 1 was not infringed. No observations were submitted by any other party in respect of that opinion or the review.
- 9 The interpretation of the claims of the patent, in particular how the lower foot portion of the sock is constructed, has therefore already been subject to detailed analysis, with a review of that analysis. Whilst an opinion review is not binding, without significant new argument there would be no justification for departing from the conclusion of the hearing officer in that review.
- 10 Opinion 13/06, requested by the proprietor and with observations having been submitted by Mr. Dave Niblock, concluded, with reasoning in line with the earlier opinion and review, that the sock offered for sale by Hunter Boot Ltd. infringed the patent, part of the examiner's conclusion being that the foot portion was formed of one piece of material.

The Opinion

- 11 As opinion 07/06 had concluded that the Hawkshead sock did not infringe, but opinion 13/06 concluded that the Hunter sock did infringe, the Hunter design was changed to be similar to the Hawkshead design. The opinion now subject to review asked the question whether that new design of sock infringed the patent. The conclusion, as with the previous opinions, turned on whether the foot portion has to be formed from a single piece of material.
- 12 The examiner in this case again chose, in my view quite correctly, to follow *Kirin-Amgen*, the current authority on claim construction. In doing so, he considered the nature of the material used and how they were joined, that more than one piece of material was used, and the natures of the foot portion, the upper portion (that is the region corresponding to the leg between the ankle and the knee) and the outer portion. Having done so, he came to the conclusion that the proposed

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

⁴ *Ms Penelope Mary Townsend's patent*, BL O/078/07, 16 March 2007

new design met the terms of claim 1 in all but the interpretation of the foot portion and was not therefore infringing.

The Grounds of the Review

- 13 The proprietor argues that the examiner reached the wrong conclusion on infringement because he erred in his construction of the claim in respect of the lower foot portion.
- 14 Much of Ms. Townsend's statement in support of her request for a review is concerned with old ground in that it suggests that the opinion was wrong to interpret claim 1 as requiring the foot portion to consist of just one piece of material. Had that been her sole argument this time, the examiner could reasonably have relied on the earlier review⁴ (see above) for his interpretation of the foot portion and declined to issue an opinion.
- 15 However, Ms. Townsend did also raise a fresh argument, to the effect that the use of the expression "... the sock **including** a lower foot portion", on line 2 of claim 1, had not previously been considered. She said that this should be interpreted as meaning that the foot portion may have other portions.
- 16 The basis for the current review is essentially the argument that the examiner erred in his analysis of that point, resulting in an incorrect conclusion concerning the foot portion and thereby on the question of infringement.

Discussion

- 17 The examiner, in paragraph 22 of the opinion, paraphrased the proprietor's argument as being that the foot portion need not **consist** of a piece of material for it to satisfy claim 1, merely that it **comprise** a piece of material. His response to this was to point out that a foot portion necessarily must be made from one or more pieces, and that the proprietor's arguments said nothing about the foot portion that was not inevitable.
- 18 Ms. Townsend takes issue with the examiner's comments. She suggests that the wording chosen is to make it clear that different portions of the sock are formed from different pieces of material.
- 19 Ms. Townsend correctly identifies that the word "**including**" in this context is not to be understood as limiting the sock to only those items in the list. However, it says nothing about what any other, undisclosed, items might be. The examiner interpreted "**including**" in claim 1 as referring to the portions **of the sock**, not to what makes up those individual portions, and in this respect, my view is that the examiner's conclusion is a reasonable one.
- 20 Clearly, the sock has, for example, a toe, a heel, a sole and an instep, but there is nothing to suggest that they are additional to the foot portion, that the foot portion represents only one of those items, or that the foot portion does not mean the portion of sock relating to the whole of the foot. Accordingly, I can see nothing which leads me to believe that the examiner's view that claim 1 requires the foot portion to be a whole entity formed from a single piece of material, is in

any way unreasonable.

- 21 The proprietor has also argued that the examiner suggested in paragraph 23 of the opinion that a foot portion including two pieces of material would lie within the scope of the claim if one of them was small. However, that is not what the examiner said. He stated that the foot portion of the proposed Hunter sock is made from two large pieces sewn together, but that if one of the pieces had not been large but, for example, was a small shaping insert, "*there might have been a case to argue for infringement*". This is not the same as saying that such a hypothetical sock would definitely infringe.

Conclusion

- 22 I conclude that the examiner in his opinion did not make any error of principle or reach a conclusion that is clearly wrong. I therefore make no order to set aside the opinion.

Costs

- 23 Neither party has made any request for costs, and I decide to make no order in this respect.

Appeal

- 24 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

A.C. Howard

Divisional Director acting for the Comptroller