



PATENTS ACT 1977

BETWEEN

Allied International Trading Limited

Claimant

and

Covco (H.K) Limited

Defendant

PROCEEDINGS

Revocation under section 72 in respect of GB2521248 B

HEARING OFFICER

Phil Thorpe

Michael Hicks for the claimant instructed by Bromhead Johnson LLP

Henry Ward for the defendant instructed by Carpmaels LLP

Hearing date: 28 September 2021

DECISION

Introduction

1. The patent was filed on the 5th September 2014, claiming a priority date of 13th December 2013. It was published as GB2521248A on the 17th June 2015 and subsequently granted on the 3rd May 2017. The proprietor at grant was Mr John Joseph Furlong however rights to the patent were transferred to Covco (H.K) Ltd by virtue of an assignment dated 11th January 2018.
2. In October 2020, Allied International Trading Limited (“the claimant”) made an application to the comptroller under sections 72(1) of the Patents Act 1977 (“*the Act*”) for revocation of the patent on the grounds that the invention claimed is neither novel nor does it involve an inventive step over the prior art, and that the matter disclosed in the specification of the patent extends beyond that disclosed in the application as filed.
3. On 22nd December 2020, Covco (the defendant) filed a counterstatement resisting the allegations that the patent was invalid. I will return to the pleadings shortly as they were the subject of much discussion at the hearing.
4. The normal evidence rounds followed and the matter came before me on 28th September 2021 where the claimant was represented by Mr Michael Hicks instructed by Bromhead Johnson LLP. The defendant was represented by Mr Henry Ward for the defendant instructed by Carpmaels & Ransford LLP.

5. I very much regret the delay in issuing this decision.

The law

6. The comptroller's powers to revoke a patent on the application of another person are set out in section 72(1) of the Act, the relevant part of which reads as follows:

72.-(1) Subject to the following provisions of the Act, the court or the comptroller may by order revoke a patent for an invention on the application of any person ... on (but only on) any of the following grounds, that is to say –

(a) the invention is not a patentable invention;

(b) ...

(c) ...

(d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed...

7. An invention is patentable if it meets the conditions set out in section 1(1) of the Act, namely that the invention is new, it involves an inventive step, it is capable of industrial application and is not excluded.
8. Sections 2 and 3 of the Act define what is meant by “new” and “inventive step” respectively. Section 2 states that an invention shall be taken to be new if it does not form part of the state of the art and goes on to define the state of the art as comprising anything made available to the public before the priority date of the invention. Section 3 states that an invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art.
9. The Courts have provided guidance as to how the question of whether a patent discloses matter not disclosed in the application as filed. In *Bonzel v Intervention No 3*¹ Aldous J said:

The decision as to whether there was an extension of disclosure must be made on a comparison of the two documents read through the eyes of a skilled addressee. The task of the Court is threefold:

(a) To ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly in the application.

(b) To do the same in respect of the patent as granted.

(c) To compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition.

The comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly.

10. Floyd LJ in *AP Racing v Alcon Components*² also noted that:

“In the end the question is the simple one posed by Jacob J (as he then was) in Richardson-Vick Inc's Patent [1995] R.P.C. 568 at p.576 (approved by him as Jacob LJ in *Vector Corp v Glatt Air Techniques Ltd* [2007] EWCA Civ 805, [2008] R.P.C. 10

¹ *Bonzel v Intervention No 3* [1991] R.P.C. 553

² *AP Racing v Alcon Components* [2014] EWCA Civ 40

at [4]): 'I think the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification.'

The witnesses

11. The evidence includes witness statements for the claimant from Mr Baskaran Govindasamy, Mr James Hull, Mr Arsalan Sultan and Mr Michael Spencer and for the defendant Ms Gillian McGuire. None of the witnesses were cross-examined.

The invention

12. The invention is concerned with a method of manufacturing an ambidextrous working glove having textured inner and outer surfaces, and a glove having such surfaces. In particular, the glove's inner and outer surfaces are provided with a "fishscale-textured" pattern which promotes good grip: externally, especially when handling items that may be slippery and difficult to grip with a smooth surfaced glove, and internally by reducing the likelihood of slippage of the wearer's hand that can be caused by perspiration. Working gloves of this nature may be used for food processing, chemical handling, pesticide spraying, and the like. With such uses in mind, the thickness of the glove should not hamper tactile sensation but need to be sufficiently thick to resist rupture.
13. Figure 1 of the application provides an overview of the method used to form the gloves:

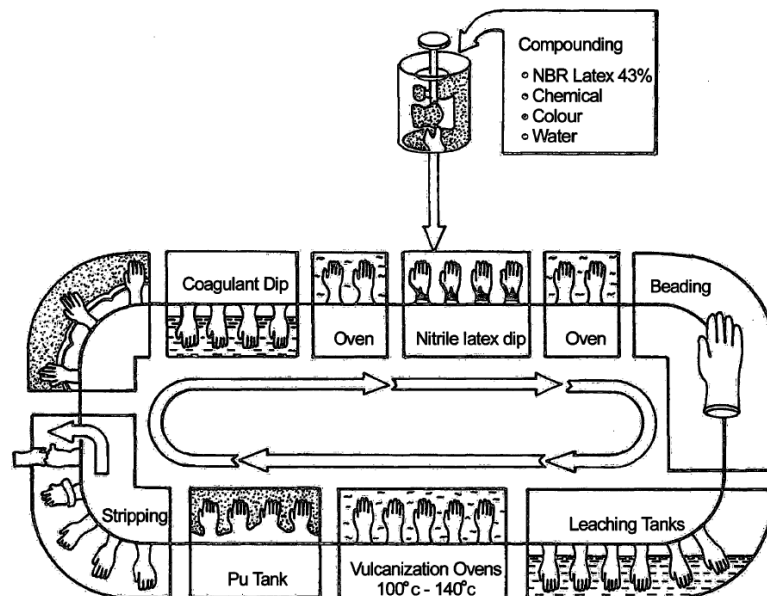


Figure 1

Ambidextrous Textured Glove

14. The glove is produced through a multi-stage dipping and curing process with a textured former dipped in a first coagulant solution then in two successive

polymer solutions, with a drying stage at particular points. Figure 9 below shows the glove still on the former, prior to stripping. In this figure, the visible surface becomes the inner surface of the glove when used. Figure 11 shows the glove during stripping; the surface visible here is the external surface of the glove in use:

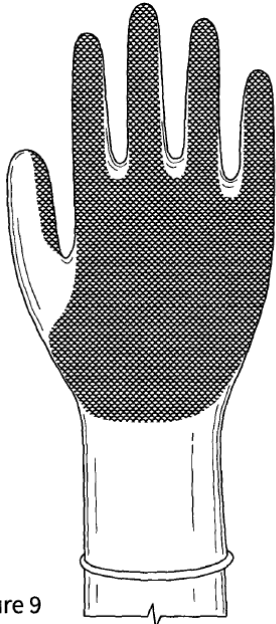


Figure 9

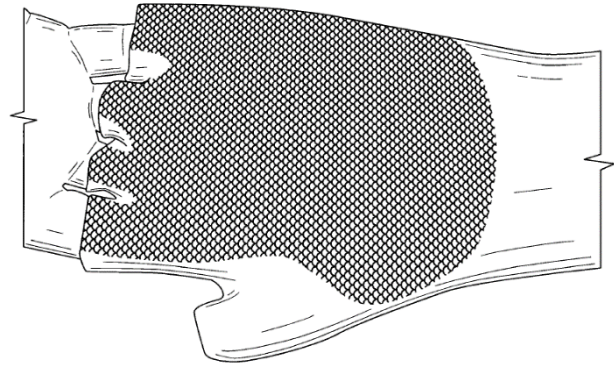


Figure 11

15. The patent was granted with 47 claims. The invention of claim 1 relates to a method of making an ambidextrous glove having fishscale-textured inner and outer surfaces. Claim 2 to 11 are dependent method claims.

16. Claim 12 is what you might now refer to as an 'old-fashioned' omnibus claim and is directed to a method of making an ambidextrous glove.

17. Claim 13 is a further omnibus claim which reads:

An ambidextrous working glove having textured inner and outer surfaces substantially as described herein with reference to Figures 9 to 16.

18. Independent claim 14 and dependant claims 15 to 47 relate to an ambidextrous glove. Claim 14 reads as follows:

An ambidextrous working glove made of polymer material, said glove having an external moulded fishscale-textured gripping pattern on both sides of the glove in at least part of the area of each of the palm, finger and thumb regions, the reverse of said pattern in each said area being present on the inside surface of the glove for contact with a wearer's hand.

19. Claim 14 causes no great difficulty in terms of construction with the parties agreeing that the expression "both sides" refers to the front and the back faces of the glove when worn rather than the inside or outside surfaces.

20. The validity challenge is against claims 13 onwards. Claims 1 to 12 are not challenged.

The Pleaded Case

21. It is necessary to discuss the pleadings in some detail given the arguments subsequently advanced by the parties.

The original statement of case

Attack on priority date

22. In their statement of grounds, the claimant initially challenged the patent's claim to priority, observing that the priority document, a US patent application, did not exist. Thus, with an effective priority date of 5th September 2014, they went on to argue that:

- i) all of the claims of the patent lack novelty over PCT Patent Application No. PCT/US 2013/074919; a disclosure citable under Section 2(3) of the Act.
- ii) claim 13 lacks novelty under section 2(3) on the grounds that the drawings of European Design Registration Number 001402432-0001, registered 13th December 2013, are identical to those appearing in the patent.

23. These two attacks highlighted an error with how priority details had been recorded by the IPO; an error that was subsequently put right by way of a correction of the Register. As a result, these novelty attacks fell away, as did an inventive step attack raised by the claimant against claims 14 to 47, an attack which relied upon the disclosure of the Registered Design.

Lack of Novelty – Annex 10

24. The statement of case refers also to a "Lack of Novelty in view of Annex 10". This annex contains a witness statement from Mr James Hull, President of Summit Gloves Inc, in which he claims that gloves made according to US8286264 (referred to hereinafter as Hull I), which was published on 16th October 2012 in the name of Hull, were sold in 2010. Annexed to this witness statement are pictures of a former that according to Mr Hull was used to produce the gloves.

25. The Statement did not say that the actual Summit Gloves had a pattern on the inside and outside as required by claim 14. Rather it notes that if the material to make the gloves is thin, it will ultimately result in the reverse of the fishscale pattern to be printed on the inside of the glove. This is a technical consequence that the skilled person of the art is aware of while making tests to choose the correct material for making the gloves. Therefore, according to the statement a number of the claims of the patent including Claim 14 are not novel.

Lack of Novelty - Annex 11

26. The statement goes on to contend that the patent lacks novelty in light of Annex 11. This annex includes a witness statement from Mr Govindasamy Group Managing Director of Brightway Holdings, a Malaysian manufacturing company. Mr Govindasamy contends formers according to US8286264 were produced in late 2009 and used to supply gloves to Summit Gloves Inc. He notes that Summit placed the first order for the gloves in January 2010. He contends that he was aware that Summit Gloves started sales commercial sales of gloves according to the patent in May 2010.
27. Again, there is no statement that the Summit gloves had a pattern on the inside and outside. In substance Annex 11 does not introduce a new ground rather it seeks to add weight to the claim based on Annex 10.

Added Matter

28. The attack on added matter is presented as a relatively simple one. It is that there is no basis in the application as filed for the statement in claim 14 that

“the reverse of said pattern in each said area being present on the inside surface of the glove for contact with a wearer’s hand”.

29. There is an element of a squeeze argument here from the claimant in that if this feature is implicitly disclosed in the patent, then it argues it would also be implicitly disclosed in the prior art documents relied on to attack the validity of the patent.

Lack of Inventive Step

30. The statement of case also contends that the invention lacks an inventive step “in view of European Patent Application No. 13899233.4”. That European Application is the corresponding EP application to the patent in issue here hence in itself is not the document upon which the obviousness attack is based. Rather as the statement goes on to explain the EPO objected to that application on the basis of US2006/0041991 (Kim Sim), published on March 2nd, 2006, in the name of Kim Sim. The statement observes that that objection stated that it was implicit that the pattern texture in Kim Sim would be present on the inside of the gloves when thin gloves are produced.

Lack of inventive step in view of US 8286264 (Hull I)

31. In addition to the claim that gloves according to US 8286264 were made prior to the priority date, the statement also contends that the claimed invention is obvious considering this prior art. It notes that whilst US 8286264 is silent on the pattern being on the inside of the glove it would be implicit that the reverse of the pattern disclosed would be present on the inside.

Lack of inventive step in view of US 8495764 and US 7356852

32. The statement goes on to note that the argument made in respect of US 8286264 applies also to both US 8495764 (Hull II) and US 7356852 (Thai). US 8495764, also in the name of Hull was published on July 30th 2013. US7356852, in the name of Thai, was published on 15th April 2008.

The Counter Statement

33. In addition to denying the various attacks on the validity of the patent, the counter statement raises a number of issues with the statement. It deals firstly with the attack on the priority date explaining the error made by the IPO in both the A and B published specifications.
34. On annex 10, it notes firstly that there is no explicit or implicit disclosure that the “widely sold gloves” of this annex had a pattern on the inside of the glove. It also notes that the mould shown in Annex 10 bears the date “22 FEB 2012” which post-dates the gloves alleged to have been sold. The counter statement also recognises the considerable overlap between Annexes 10 and 11.
35. It goes on to argue that the exact nature of the various inventive step objections is unclear. It nevertheless sets out why the patent is not obvious having regard to US 8286264, US 8495764 and US 7356852
36. The added matter objection does not appear to give rise to any clarity concerns though it is denied.

Response to the counterstatement

37. The claimant in response to the counterstatement filed a further submission in which it dropped its claim that the patent was not entitled to its priority date. All objections conditional on that were also dropped.
38. The response also comments on the statements made by the defendant. It recognises that the mould was not the mould used to make the order of gloves in 2009 or 2010 but that it was “nevertheless part of the prior art” and that gloves “produced from 22 February 2012 are still prior art”. It notes that to aid discussion that an “example of their glove” has been forwarded.
39. In response to receipt of the examples of the glove, the defendant sought further clarification as to the providence of the gloves provided by the claimant.
40. The attorney for the claimant, Mr Michael Spencer, provided a witness statement and exhibits, noting that the glove provided to the claimant were SuperTouch PG-900 Blue Ambidextrous Nitrile Grip Gloves. One of the exhibits was a data sheet downloaded on 16th March 2021. Mr Spencer also provides a copy of a letter from the defendant to the claimant dated 14th September 2018 in which it claims that the importation of the PG 900 gloves infringes inter alia GB 2521248.
41. The defendant’s evidence in chief comprises of a witness statement from Ms Gillian McGuire, of Carpmaels and Ransford LLP, which refers to exhibits of photographs and a sample of a glove referred to as the defendant’s Grippaz glove. The photographs below show the outside (left picture) and the inside of the glove.



42. The final round of evidence was the claimant's evidence in reply consisting of a witness statement with exhibits from Mr Arsalan Sultan, Financial Controller of Allied International Trading Limited (Supertouch). In his statement he asserts Supertouch was selling gloves, referred to as Nitrile N10, since at least 2010.
43. The admissibility of the evidence of Mr Sultan was challenged on the basis that it was evidence strictly in reply.
44. The defendant contends that Covco then sought to shift their case both in their skeleton and in the course of the hearing.

Covco's Skeleton Argument

45. The skeleton notes that "it is inevitable or at least highly probable" that the creation of the textured outer surfaces of the glove disclosed in Kim will result in correspondingly textured inner surfaces. The skeleton however goes on to note that Kim does not add substantially to the Applicant's case since Thai makes explicit what the skilled person would understand from reading Kim.
46. The skeleton then goes on to highlight for the first time parts of Thai, most notably claim 1 which reads with highlight added by the claimant:

1. A surgical glove constructed from a latex material and having an opening comprising: **an interior surface**; an exterior surface; a palm section; a plurality of finger sections; a band, the band being located around the opening and being encased by the latex material, the band ensuring a proper fit and prevents the glove from rolling upwards; **an embossed surface, the embossed surface extending from the interior surface to the exterior surface and having an interior side and exterior side**, respectively, the embossed surface being a raised, geometric-textured surface dis-posed on at least 50% of the palm section and at least 20% of the finger sections, the raised geometric-textured surface being formed from a plurality of geometric shapes that lie adjacent and touch each other, the interior side providing tactile sensitivity to a user and an exterior side providing a non-slip surface that inhibits water retention to a working surfaces whereby the glove is of unitary construction and uniform composition.

47. It notes that claims form part of the disclosure referring to section 130(3) of the Act and paragraph 97 of *European Central Bank v. Document Security Systems Inc*³ which reads:

97. A number of points emerge from this formulation which have a particular bearing on the present case and merit a little elaboration. First, it requires the court to construe both the original application and specification to determine what they disclose. For this purpose the claims form part of the disclosure (s.130(3) of the Act), though clearly not everything which falls within the scope of the claims is necessarily disclosed.

48. It concludes that “Thai is novelty destroying of some of the product claims of the Patent. Moreover, all the product claims of the Patent lack inventive step over Thai”. Hence whereas the statement of case referred to the patent lacking an inventive step over Thai, the defendant was now arguing lack of novelty over Thai.

49. The skeleton in discussing obviousness focussed primarily on Hull II maintaining the earlier argument that it would be inevitable if the glove of Hull II was made thin that the exterior pattern would be imparted to the inside of the glove.

50. The nature of the added matter objection was also perceived by the defendant to have changed in the skeleton argument. Whereas the statement of case focussed on the pattern being on both the inside and outside of the glove, the skeleton refers instead to:

“Claim 14 discloses for the first time a glove which is made by any method and which can have a single layer or a double layer. When read as a whole, the application only disclosed a particular method and therefore a particular type of glove (2 layers made by the method disclosed). Claim 14 of the Patent fundamentally alters the disclosure.”

Arguments advanced at the hearing

51. Mr Hicks attempted to narrow the arguments at the hearing. He noted that:

“In my skeleton, I have identified five items of prior art which I have called Kim Sim, Thai, Summit glove Hull I and Hull II. In fact, my submission is going to focus on Thai and Hull II, because our proposition is that really Kim Sim does not add anything to Thai and now one has seen the way the case has developed it does not appear to us that Summit glove or Hull I themselves add anything to what one can see in Hull II. So my submissions are going to being focused primarily on Thai and Hull II.”

52. Mr Ward refers to the guidance in the IPO’s Patent Hearings Manual⁴. He highlights the comments of Vice Chancellor, Sir Richard Scott, in *Julian Higgins’ Trade Mark Application*⁵ who in commenting of the pleadings at p326 states:

Part of the problem, in my view, is the procedural practice that seems to have grown up in the past - although I am very relieved to hear from counsel that it is in the process of being, if it has not already been, cured - of not preparing proper pleadings

³ *European Central Bank v. Document Security Systems Inc* [2007] EWHC 600 (Pat)

⁴ [Patents Hearing Manual](#)

⁵ *Julian Higgins’ Trade Mark Application* [2000] RPC 321

with proper particulars of the parties' contentions. If the pleadings do not identify the right issues, the issues the parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing. The pleadings are supposed to identify the issues to which evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise.

53. In commenting on the initially pleaded case by Allied, Mr Ward notes that it was carefully crafted so that it relied on a priority point that would have knocked out all the claims, were it a good one, an anticipation by inevitable result, which they thought they could make good from submissions that Covco had allegedly made, and an added matter obviousness squeeze, which is premised entirely on submissions that have allegedly been made by Covco. He goes on to note that the way that the case had been pleaded by Allied meant that Allied did not need to provide any evidence, in particular expert evidence.
54. This approach however meant that Covco also did not put forward any evidence as it was satisfied it could rebut the allegations without it. He contends that Allied now seeks to recast its case in a way that clearly prejudices Covco. He notes that if the case now advanced by Allied had been advanced from the start, then Covco would have had to adduce expert evidence. Obviously, it was not, and they have not done so and hence it was important that Covco were not prejudiced by that.
55. It is clear that in advance of the hearing and at the hearing Allied did seek to shift the focus of their case. Some of this was the usual focussing on the perceived stronger aspects of the case and the abandonment or downplaying of duplicate or less strong arguments. This often happens especially when Counsel become involved in the proceedings. Ideally this should happen much earlier in the proceedings, before the case is even launched ideally, but that it happens late in the day is still not something to discourage as it can lead to a shorter and more focussed hearing. Examples of that in this case is the recognition that the arguments relating to the prior supplied gloves did not really add anything to the objections arising especially from Thai and Hull II.
56. As Mr Ward noted, and as Mr Hicks accepted, at no point during the proceedings had it been suggested that the prior supplied gloves referred to by Mr Hull and Mr Govindasamy had a pattern on both the inside and outside of the glove as required by the claims. Hence this was never a classic case of prior use anticipation. Rather it was an extension of the "inevitable result" obviousness argument being run using the cited prior art.
57. Other aspects of Mr Hicks' "refocussing" however did attempt to move the case beyond that which was clearly pleaded. This includes the attempt to argue that the claims were anticipated by Thai rather than just being obvious in light of that document. The argument on added matter also shifted to focus to a different aspect of the claims. I will consider whether it is fair to consider these shifts in the pleaded case when I come on to consider the individual arguments in more detail. I would add that no formal request to amend the pleadings was made at any time by Allied.

Admissibility of Mr Sultan's evidence

58. I took as a preliminary issue the question of the admissibility of Mr Sultan's evidence. Mr Hicks asserted that the claimant was not looking to use Mr Sultan's evidence as a starting point for challenging validity, rather it was to demonstrate that even with quite robust gloves, the pattern formed on one side can go through to the other side.
59. Mr Ward first point in response was that this evidence does not go to anything in Covco's evidence and hence it is not evidence in reply. He then went on to note that there was little or no technical information on for example the properties of the nitrile used to make the glove or how the glove was manufactured and hence it was difficult to see what purpose it served.
60. I am satisfied that the glove referred to by Mr Sultan is a different glove to that referred to by Mr Spencer and submitted with his evidence. I am therefore satisfied that the evidence of Mr Sultan's evidence is not evidence strictly in reply and therefore it will not be considered.

Added matter

61. I will consider first the added matter argument that was pleaded which was that there is no basis in the application as filed for the statement in claim 14 that "the reverse of said pattern in each said area being present on the inside surface of the glove for contact with a wearer's hand". I would note that Mr Hicks said almost nothing on this at the hearing or in his skeleton. Mr Ward did however address me on it and it only right that I consider it.
62. Mr Ward's response highlights that the wording objected to by Allied has two elements. The first is that there is a pattern on the interior, as well as the exterior of the glove. The second is that the interior pattern is the reverse of the exterior pattern. It argues that there is clear basis for both in the application as filed. The first element is the very idea at the heart of the invention as can be seen from the original summary of the invention which reads:

SUMMARY

The present invention provides an ambidextrous working glove having textured, especially fish scale-textured, inner and outer surfaces and methods of making same.

63. According to Mr Ward, basis for the second element can be found in p5 lines 13–15 which read:

In one embodiment, the at least one former has a fish scale-textured surface for imparting this scale-textured inner and outer surfaces to the ambidextrous working glove

64. Whilst there is no explicit disclosure that the inner and outer patterns are formed in a single process, it is clear that is what the application as filed teaches. Mr Ward notes that whilst it is not inevitable that a former that provides an exterior pattern will impart a pattern on the interior, but if it does, it

is inevitable that the patterns will be the reverse of each other. Mr Ward notes that the application as filed refers to the process of forming both patterns with one former as the “direct transfer function” – the application notes that:

In one embodiment, the textured inner and outer surfaces of the ambidextrous working glove of the present invention is formed by the direct transfer function of the surface texture of the at least one former. A preferred textured former surface for the ambidextrous working glove of the present invention has been found to be provided by at least one former that has a fish-scale textured finish.

Transfer texturing from such a surface provides a highly desirable textured interior and outer surfaces. The textured interior surface provides a highly desirable hand-engaging surface, and the textured exterior surface provides highly desirable grip.

One of ordinary skill in the art can readily appreciate that the ability of the at least one former to impart or transfer a texture to both the inner and outer surfaces of the ambidextrous working glove of the present invention can vary in response to a variety of factors including, but not limited to the polymer forming the film of the working glove, the thickness of the working glove, and the shape and/or depth of the texture of the at least one former.

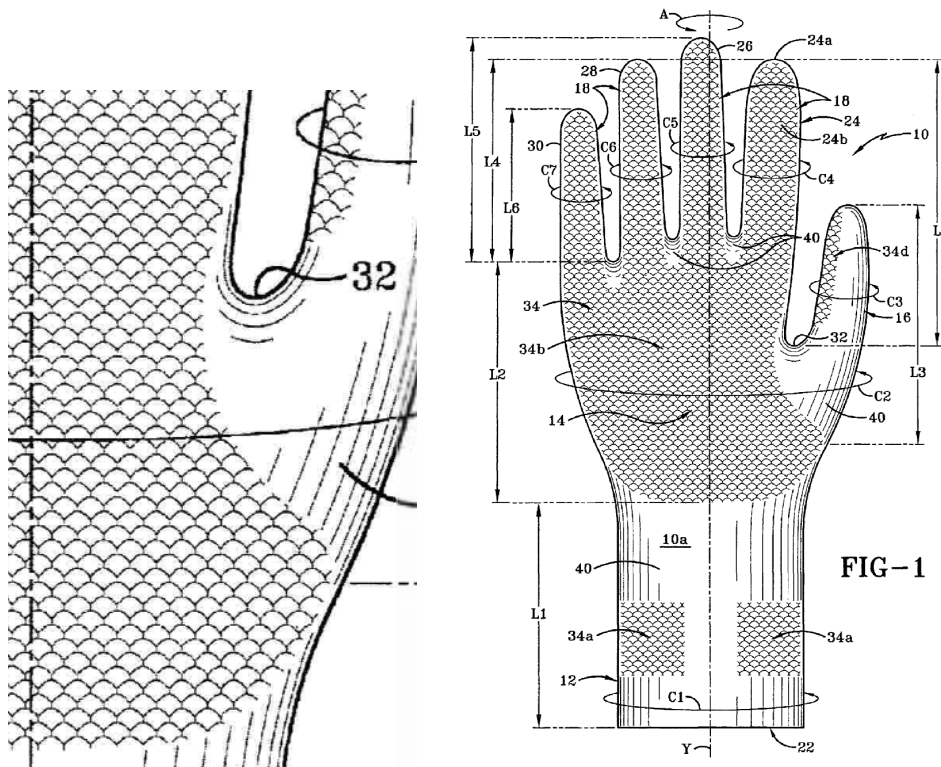
65. I am satisfied that the skilled person would not learn anything new from the statement in the amended claim 14 that “the reverse of said pattern in each said area being present on the inside surface of the glove for contact with a wearer’s hand” from what was disclosed in the application as filed. There is no added matter in this statement in the claim.
66. I turn now to the allegation of added matter that Mr Hicks did seek to rely on in his skeleton and at the hearing. This is that claim 14 discloses for the first time a glove which is made by any method, and which can have a single layer or a double layer. This was not pleaded nor was any request made by Mr Hicks to amend the pleadings to reflect this new argument.
67. Unsurprisingly Mr Ward objected strongly to this shift in case. It is he argued not legitimate for parties to change their stance at the last minute because it deprives the opponent of the opportunity to adduce evidence which it could otherwise have adduced. Justice he submits is absolutely not served by trying to guess what the evidence might have been or just making a best effort and answer in the absence of any evidence.
68. I agree. As noted in *Julian Higgins' Trade Mark Application* discussed above, proper pleadings are necessary even in a less formal tribunal such as the Comptroller in order to avoid the sort of situation seen here. Whilst the construction of the application as filed and patent as granted is a matter for me, I must look at those documents through the eyes of a notional skilled addressee. Hence the position of the skilled person may be helpful although not determinative⁶. Whether such expert evidence would have proved helpful in this case is not really the issue. What matters is that the respondent was not given an opportunity to even consider whether such evidence should be provided. Consequently, it is simply not open for the claimant to run a

⁶ *Siegfried Demel (Trading As Demotec Siegfried Demel) v C & H Jefferson (A Firm) and Another* [1999] F.S.R. 204.

completely different added matter objection to the one pleaded so late in the day. I therefore reject it.

69. The attack on added matter both as pleaded and un-pleaded therefore fails.

Obvious over Hull II (US 8495764)



71. The claimant contends that Hull II differs from claim 14 only in that it does not disclose the fishscale pattern being produced also on the inside of the glove. However, it argues that Hull II tells you that you can make a glove as thin as “3 ml”. This was agreed to be a reference to the imperial unit thousandths of an inch, hence the thickness is 0.076mm. Hull II also tells you to put a textured pattern on the outside, and the skilled person will know that depending upon the depth of the texture, because it is a thin glove, it will either come through or if you make it a very shallow texture, it might not. So, from an obviousness point of view, the skilled person can immediately see that one possible product is to make a thin glove with quite a significant texture and that is an obvious product to make. It is not the only product one can make, but it is one of the obvious ones. Such a glove would have a

pattern on both the inside and outside. Even if it is not an inevitable result case, it is a likely case, and in that case, this sort of product is obvious.

72. The claimant notes that a patent is anticipated if the result of following an earlier teaching is something which falls within the scope of the claims of a patent. It refers to *Synthon BV v SmithKline Beecham plc*⁷ where it was said at 22—

[22] If I may summarise the effect of these two well-known statements, the matter relied upon as prior art must disclose subject-matter which, if performed, would necessarily result in an infringement of the patent. That may be because the prior art discloses the same invention. In that case there will be no question that performance of the earlier invention would infringe and usually it will be apparent to someone who is aware of both the prior art and the patent that it will do so. But patent infringement does not require that one should be aware that one is in-fringing: “whether or not a person is working [an] ... invention is an objective fact independent of what he knows or thinks about what he is doing”: *Merrell Dow Pharmaceuticals Inc v H N Norton & fgv Co Ltd* [1996] RPC 76, 90. It follows that, whether or not it would be apparent to anyone at the time, whenever subject-matter described in the prior disclosure is capable of being performed and is such that, if performed, it must result in the patent being infringed, the disclosure condition is satisfied. The flag has been planted, even though the author or maker of the prior art was not aware that he was doing so.

73. The claimant also notes that even if this test is not satisfied, the fact that a very likely result of following an earlier teaching is something which falls within the scope of the claims of a patent can lead to a finding of obviousness. It refers in this respect to *Terrell*⁸ at paragraph 11-77 which notes:

Thus, where the directions are capable of being carried out in a variety of ways, some of which fall within the claim and others do not, then there is no clear and unambiguous direction but at best a signpost (though it may lead to an alternative finding of obviousness).

74. I would note that the originally pleaded case relied more on the inevitability of the pattern being formed on both sides of the glove when the glove is particularly thin and in that respect the claimant was seeking to rely on admissions apparently made to that effect by the defendant during the prosecution of the corresponding EP application.

75. Mr Ward’s response on the prior statements made by Covco is that in the absence of any estoppel – and none has been pleaded - any admissions made elsewhere are not relevant. He adds in any event that Covco did not admit to the EPO that it would be inevitable for particularly thin gloves that have a pattern embossed on one side of the glove for that pattern to be transferred to the other side. Rather the admission was that if that did happen then the pattern on the other side would be the reverse.

76. I would also add that the inventive step argument based on either *Hull II* or indeed on any of the other prior art has not been presented using the normal *Pozzoli*⁹ steps. That is unfortunate though not fatal. Great care is however

⁷ *Synthon BV v SmithKline Beecham plc* [2006] RPC 10

⁸ *Terrell on the Law of Patents* 19th Ed

⁹ *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

needed to avoid falling into the trap of using hindsight and failing to properly distinguish what was known from what was common general knowledge.

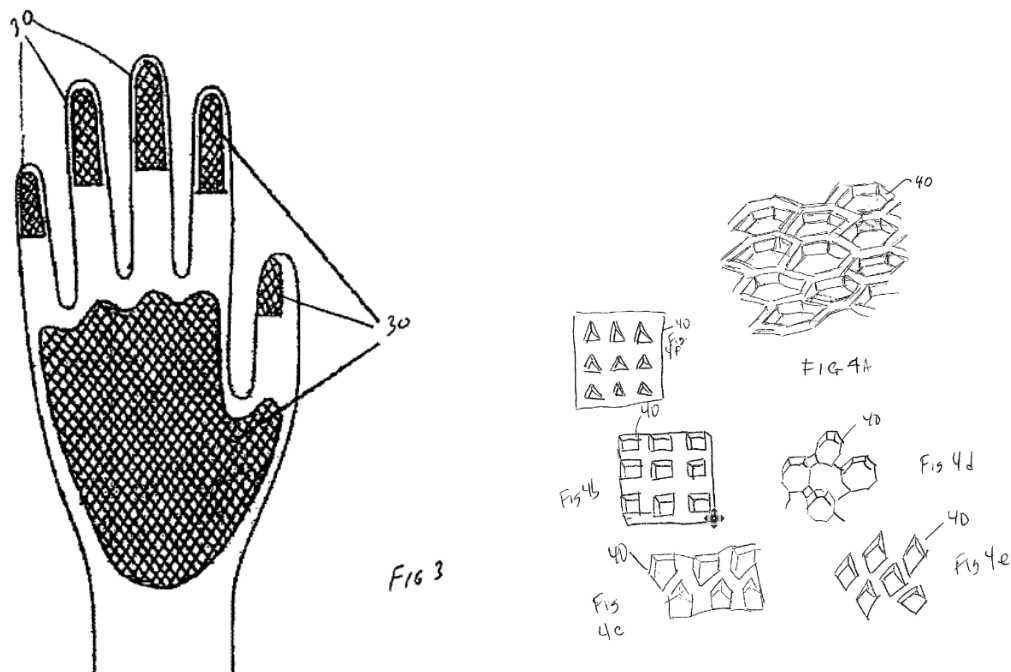
77. There was up until the hearing no discussion of who the skilled person is, or what common general knowledge they possess. At the hearing Mr Hicks did suggest that the skilled person is clearly a glove manufacturer. He was silent on the common general knowledge. What was more was that there was clearly no expert evidence to assist me with determining what that common general knowledge was. Mr Ward cautioned that only where there was agreement between the parties should I infer anything on common general knowledge.
78. Mr Ward went on to explain that there are many factors that can impact whether a pattern on the external side of the glove is also evident on the inside of the glove. The thickness of the glove is just one factor. But even with gloves that are as thin as 0.076mm, it is not inevitable that the pattern on one side would be transferred to the other. He notes that the claimant does not even claim this to be the case. Mr Ward highlighted other dependent factors such as the shape and depth of the pattern on the former and how the gloves are manufactured. He concluded by noting that it is far from inevitable that a particularly thin glove would have the feature of the pattern discernible on the outside and inside of the glove. In the absence of expert evidence to this he argues it would be unsound for me to reach any other conclusion.
79. Even without such evidence I am satisfied that you need at least a certain difference between the depth of the profile on the former and the thickness of the glove in order to achieve the required effect. What that difference is will also be dependent on other factors. There is nothing in Hull II that to me points to the inevitability of this required effect nor is there anything that would in my opinion lead obviously to such a combination of factors. It is possible with the advantage of expert evidence that I might reach a different conclusion, though I suspect not. In any event that evidence is not before me and therefore I must proceed on the basis of what I can safely read from Hull II and that is not that the invention claimed is obvious.

Novelty over Thai

80. As noted, the originally pleaded case was that the invention claimed in claim 14 was obvious in light of the disclosure in Thai. At the hearing and in his skeleton Mr Hicks sought to shift this to a novelty attack. I asked Mr Ward whether given any assessment of obviousness would involve a determination of how the claims differ from the disclosure in the prior art, whether in general it was open to the Comptroller to find a lack of novelty even if only obviousness had been pleaded.
81. Unsurprisingly he thought it would be unfair to his client especially in this instance since his client has on the basis of the original pleading decided not to provide expert evidence. I can certainly see the force in that argument if an attempt was made to shift a novelty attack to one of obviousness though the reverse is not so clear cut. Mr Ward also rightly observed that Covco had been relying on Thai for a considerable time so it is especially surprising that

only at this very late stage had they considered it might anticipate the claims. There is clearly merit in what Mr Ward says however on balance I think the fact that Thai was clearly in issue and for a proper assessment of inventive step I would need to consider any differences, that it would be appropriate to consider if and how the claims in issue differ from Thai. I would add that both sides addressed me on the point at the hearing.

82. It is common ground that Thai discloses a glove with a geometric pattern on the areas of the glove corresponding with the touch portions of fingers and palm (see figures below). It is also not in dispute that the glove is made of latex material using a raised pattern former which is dipped into a compound to make the gloves.



83. Mr Hicks contends that the nub of the invention can then be found in claim 1 noting firstly that the claim refers to a surgical glove. The suggestion is therefore that these gloves are thin. More importantly the claim states that the glove comprises

...an embossed surface, the embossed surface extending from the interior surface to the exterior surface and having an interior side and exterior side, respectively...

84. This he argues means that the embossed pattern is present on both the inside and outside of the glove as required by claim 14.

85. I asked Mr Hicks if there was any further support for this assertion in the body of Thai. Mr Hicks accepted that there was nothing explicit though he did point me to lines 56-60 on page 1 which state that:

In addition, raised diamond pattern-textured gloves also provide good donning qualities. These gloves can be easily put onto the hand the usual way conventional gloves are worn.

86. Mr Hicks suggests that the reference to the donning qualities somehow suggests that the pattern is on the inside of the glove and that this assists with the donning of the glove. I do not find this argument persuasive. It is just or even more likely that the textured outside of the glove provides the donning assistance suggested. Hence, I find no support in this particular passage for Allied's interpretation of the particular part of claim 1 at the heart of this objection.

87. In response Mr Ward focuses firstly on the requirement that the product claims, claims 13 and 14, require a fishscale texture noting that there is no corresponding disclosure in Thai.

88. He also argues that under a proper construction, Thai does not disclose a pattern on the interior as well as the exterior. He describes Thai as an "odd document" consisting of some poor handmade drawings cobbled together in his view with some rather obscure description. He goes on to note that the part of the claim now relied on by Allied is even more of an oddity as it has no relation to what is described in the rest of the document. Taking me through the make-up of the document, he observes that it makes clear that the problem that the invention addresses is that of improving gripping ability especially when the gloves become wet whilst maintaining tactile sensitivity. The solution is to provide a slightly raised diamond shape pattern on the exterior of the glove. He notes the patent attaches importance to the particular shape of the textured portion, highlighting lines 33-44 of column 2 which read:

The raised diamond pattern texture offers several benefits. The most significant is an enhanced non-slip grip arising from the embossed coarser glove surface created from the effects of the raised diamond pattern texture. Feedback from users has indicated that they experience a reduction in tactile sensitivity when using other types of textured gloves. It is believed that this is because these gloves do not have a series of homogenous pattern. The pattern of raised diamond pattern-textured gloves was engineered with maximum tactile sensitivity in consideration and produced to ensure that the textured surface does not compromise this aspect. Therefore, users still maintain the same tactile sensitivity offered by conventional gloves.

89. Mr Ward accepts that the description does refer to other shapes for the textured portion referencing lines 62-64

The textured gripping surfaces preferably include raised, repeated geometric shapes such as squares, pentagons, hexagons, octagons, triangles, and any other straight-edged shape.

90. However, he notes that such a general statement cannot render known a specific profile. What is required is a specific disclosure of a fishscale pattern and Thai does not provide this.

91. Mr Ward then addresses the wording in claim 1 of Thai that is now relied on by Allied. He starts by suggesting that there is something very odd about the claims. He suggests that limiting the claims to surgical gloves is inconsistent

with the overall teaching of the document since surgical gloves are not in general ambidextrous – rather they are handed. That the claimed gloves need no longer be ambidextrous is also borne out by the absence in the claim of any reference to the patterns appearing on the front and back of the gloves which is necessary for ambidextrous gloves but not handed gloves.

92. Mr Ward describes the statement in the claim that the glove has “an embossed surface, the embossed surface extending from the interior surface to the exterior surface and having an interior side and an exterior side” as nonsense and gibberish. Whilst he argues the glove has an embossed surface, it is not at all clear whether it is the surface of the glove that has embossing on it, or whether the embossing itself has a surface. He argues, again having first reiterated that the tribunal does not have the assistance of expert evidence, that the skilled person would think it refers to the embossing having a surface.

93. The additional requirement that the surface extends from an interior side to an exterior side is Mr Ward contends equally unclear. One interpretation is that the material of the glove does extend from the exterior surface to the interior surface. However, this does not define what the interior surface looks like. Considering the latter part of the claim and indeed the specification as a whole, would he suggest lead the skilled person to conclude that the embossing on the exterior surface is to provide better grip whereas the purpose of the inner surface is by contrast to provide tactile sensitivity. The skilled person would recognise that that function is best achieved with a smooth surface.

Conclusion on novelty over Thai

94. I am more persuaded by the arguments of Mr Ward that there are indeed significant differences between the invention in claim 14 and the disclosure in Thai. From a proper reading of the whole document, there is no clear disclosure of a fishscale pattern in Thai nor is there a clear disclosure that the reverse of said pattern is present on the inside surface of the glove for contact with a wearer's hand. The statement relied on by the claimant simply does not provide this. Consequently, Thai does not anticipate claim 14. Given the narrow scope of claim 13, it also does not anticipate that claim.

Obviousness over Thai

95. Allied's arguments that the invention is obvious over Thai were premised essentially on the only difference between the disclosure in Thai and claim 14 being the shape of the textured pattern. In the event I have concluded that Thai does not teach providing a textured finish on both the inside and outside of the glove. Given that finding, and also given that Allied is essentially making the same arguments on Thai as they did on Hull II, then the obviousness objection based on Thai is at best no stronger than that discussed above in respect of Hull II. Indeed, given the additional difference of the shape of the textured pattern it is considered weaker.

96. Hence, I do not believe I need to say anything further on obviousness other than my observations in respect of Hull II apply equally to Thai and that I do not consider that claim 14 is obvious over Thai.

The other pleaded arguments

97. As noted, Mr Hicks sensibly focused the hearing on essentially Hull II, Thai and added matter. He accepted that if he failed on those arguments then he would fail also in respect of the other grounds advanced in the original pleading. It is therefore not necessary for me to address those other arguments here.

Conclusion and findings

98. I am satisfied that to the extent properly pleaded, GB2521248B does not disclose matter beyond that disclosed in the application for the patent, as filed. I refused to consider an alternative attack on added matter brought by Allied in the days immediately prior to the hearing. This was not pleaded and was introduced too late for Covco to be able to properly respond.

99. I find the invention claimed in claim 14 to be novel and to involve an inventive step over US 7356852 B2 (Thai) and US 8286264 B2 (Hull II). I also find that claim 13, which is a narrow omnibus claim, is also novel and inventive. Claims 15-47 are all dependent on at least claim 14 and hence they are also considered to be valid.

Costs

100. Covco have been successful in defending their patent and are therefore entitled to a cost award in its favour. It is long established practice that in proceedings before the comptroller only a contribution towards the successful party's costs should normally be awarded and that the amount should be guided by the comptroller's published scale¹⁰ unless the circumstances warrant departing from the published scale. My preliminary view is that such a departure is not justified here. I recognise that the way that the claimant pleaded its case, and then sought to run arguments different to how it was pleaded was not ideal though this harmed it more than it put the other side to unnecessary expense. I therefore make a preliminary award in favour of Covco to the sum of £2500 made up of the following elements:

£300 - Preparing a statement and considering the other side's statement

£600 - Preparing evidence and considering and commenting on the other side's evidence

£1600 - Preparing for and attending a hearing

¹⁰ [Published Scale of Costs](#)

101. I will however allow both sides a period of 4 weeks from the date of this decision to make any submissions they wish to make on the matter of costs. In the absence of any submissions then Allied should pay Covco the sum of £2500 no later than 5th May 2023.

Appeal

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

Phil Thorpe
Deputy Director acting for the Comptroller