



PATENTS ACT 1977

BETWEEN

B D & H Limited	Claimant
and	
Signwaves Limited	Defendant

PROCEEDINGS

Application under section 71 for a declaration as to non-infringement of patents GB2541956B and EP(UK) 3168826B1 and an application under section 72 for revocation of Patent EP(UK) 3168826B1

HEARING OFFICER Phil Thorpe

Mr. Michael Downing of Downing IP Limited, appeared for the claimant
Mr. Ian Bishop of IP21 Limited, appeared for the defendant
Hearing date: 18 January 2023

DECISION

Introduction

- 1 On 19th May 2022, B D & H Limited (“the claimant”) filed form 2/77 and a statement in which it sought a declaration under section 71(1) of the Patents Act 1977 (the Act) that its “Boost” sign does not infringe patents GB 2541956 B and EP (UK) 3168826 B1. The claimant also requested revocation under section 72(1) of EP (UK) 3168826 B1 on the grounds that it is not novel or inventive over the prior art, which includes the proprietor’s “Windmaster” sign. The proprietor of the patents (who is “the defendant” in this action) is Signwaves Limited.
- 2 In its statement, the claimant outlined correspondence between it and the defendant including a copy of a letter sent by the defendant on 28th January 2022 asserting infringement of both patents. This letter included photographs provided by the defendant in support of its claim of infringement. The claimant states that it has responded to this letter, explaining why the claims of neither patent are infringed. In particular, in a letter dated 10th March 2022 the claimant requested a written acknowledgement that the “Boost” sign does not infringe either patent. The claimant states that the defendant has not provided the requested written acknowledgement.
- 3 The defendant provided a counter statement on 9th August 2022 denying allegations of non-infringement and asserting infringement of EP 3168826 B1 by the claimant’s

sign. Whilst the defendant asserted a slightly different series of events with respect to the correspondence between the parties, the defendant did not contest the request for a declaration of non-infringement in respect of GB 2541956.

- 4 On 12th September 2022 the claimant filed evidence including a witness statement by Mr James Fox, a Director of B D & H Limited. The defendant did not provide any evidence in reply, but queried aspects of the witness statement. A second witness statement was provided by Mr Fox dated 12th December 2022.
- 5 The matter came before me on 18th January 2023. The claimant was represented by Mr. Michael Downing of Downing IP Limited. The defendant was represented by Mr. Ian Bishop of IP21 Limited. Both sides submitted skeleton arguments for which I am grateful.

Preliminary Matters

- 6 In its skeleton argument the defendant sought to introduce some new photographs into the proceedings. In turn the claimant also sought to admit into proceedings an actual example of their Boost sign. The admissibility of these was dealt with as a preliminary point at the hearing.

The sample of the sign

- 7 Mr Bishop was content that the example of the sign (the sample did not include the base component) could be admitted into the proceedings. This corresponded to the sign shown in the appendix of the original statement of case.

The New Photographs

- 8 The defendant was keen to introduce some additional photographs into the proceedings at the hearing. Mr Downing objected to their introduction noting that the skeleton argument and the hearing were far too late in the proceedings to be introducing new material which the claimant had not had time to consider. He also highlighted doubts about the provenance of some of photographs. Mr Bishop's response was that it was the defendant's understanding that these were photographs of the claimant's sign but that the defendant was keen to ask Mr Fox about the photographs.
- 9 The hearing is clearly not the place to be introducing this sort of new material to be put to witnesses. There was indeed a feel that this was more of a fishing expedition by Mr Bishop than a real attempt to deal with the matters that had been pleaded. I therefore refused to admit the new photographs which purported to show variations of the claimant's products except for one which was an enlarged version of the claimant's photograph 2.3 in annex 2 of its original statement of case.

The Witness

- 10 Mr James Fox is a Director of B D & H Limited, having started working for the company in June 1986 and appointed as director in December 1997. Since about 2003, Mr Fox has been dealing with technical issues arising within the business and considers that he has become very familiar with the construction of the company's signs – including the methods and materials used to do so.

- 11 In his witness statements Mr Fox discusses Correx (RTM) sheets, which are used by B D & H Limited for the display panels in their signs and are said to comprise a lightweight, rigid twin-walled polypropylene sheet with an internally fluted structure. He also discusses the alleged infringing Boost sign and the prior art Windmaster sign with reference to the claims of EP 3168826 B1.
- 12 At the hearing Mr Fox was cross-examined by Mr Bishop. Despite Mr Bishop's rather convoluted questioning, I found Mr Fox to be a reliable witness who answered the questions put to him openly and honestly.
- 13 Whilst I found Mr Fox's answers about the background to the Boost sign and its manufacture helpful, ultimately, I did not take too much from his statement or answers. This simply reflects the nature of the case which covers relatively simple technology and where the main issue in dispute is really one of construction of the patent which is a matter for me rather than any witnesses.

The Patent - EP 3168826 B1

- 14 The patent relates to a self-standing sign 12 which has a sign stand 11 and a removable display panel 10. The sign stand 11 has a base 17 with a flat upper surface and a support member 14. The removable display panel 10 has a perimeter region 13 and a pocket 15, whereby in use, the support member 14 can be inserted into the pocket 15 with the perimeter region 13 resting against the flat upper surface of the base of sign stand 11. Figures 1A-C show front views of the sign and are reproduced below:

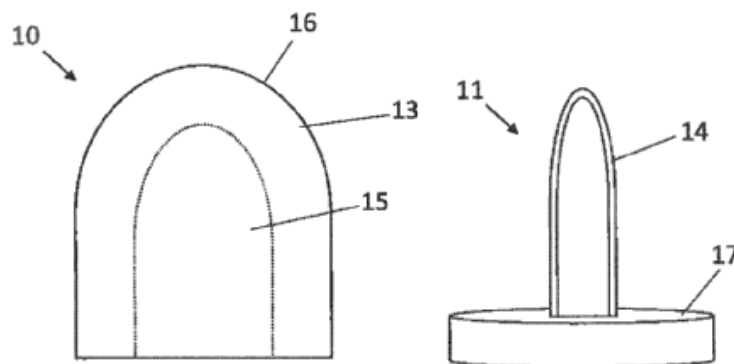


Figure 1A

Figure 1B

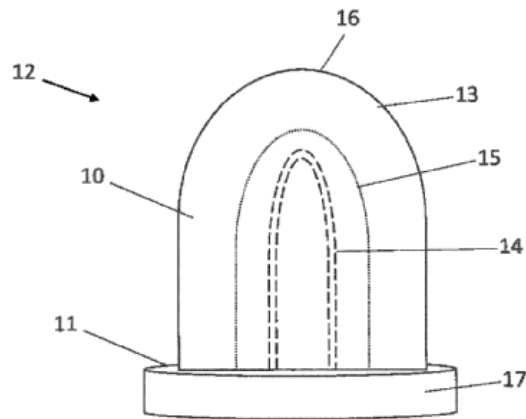
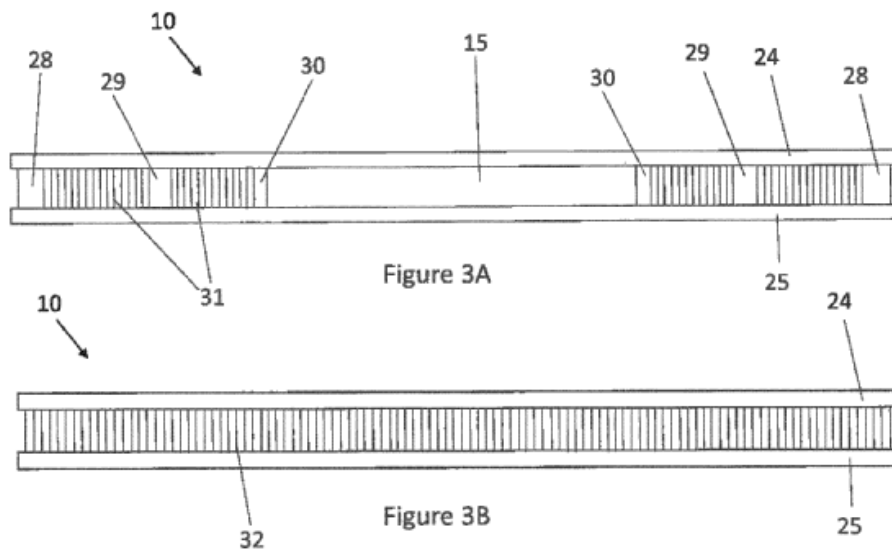


Figure 1C

- 15 Furthermore, the display panel 10 comprises sheets 24,25 which are bound to one another and have links 31,32 which are located between the pocket 15 and the outer edge 16 of the perimeter region 13. This enables the display panel to be sufficiently rigid so that the shape of the outer edge 16 is retained when the display panel 10 is positioned upright with the extending support member 14 in the pocket 15. Figures 3A and B respectively show a view from underneath and to the side of the display panel:



- 16 Claim 1 of the patent is the only independent claim, and reads as follows:

1. A self-standing sign (12) comprising a sign stand (11) and a removable display panel (10); wherein the sign stand (11) comprises a base (17) and a support member (14) extending from said base; said base (17) having a flat upper surface; and wherein the display panel (10) comprises a perimeter region (13) which surrounds at least in part a pocket (15) into which, in use, at least a portion of said upwardly extending support member (14) may be inserted; said perimeter region (13) having an outer edge (16); characterised in that said display panel (10) comprises two or more sheets (24,25) which are bound to one another and incorporating links (31,32) therebetween which are perpendicular to the plane of the sheets (24,25) and which are located between the pocket (15) and the outer edge (16) of the perimeter region (13); whereby said perimeter region (13) is sufficiently rigid so that the shape of the outer edge (16) of the perimeter region (13) is substantially retained when the display panel (10) extends upwardly and

said upwardly extending support member (14) is placed at least in part in said pocket (15); said rigid perimeter (13) extending to said flat surface; whereby said rigid perimeter region (13) rests against said flat upper surface.

Claim construction

- 17 Before I can consider the infringement and validity of the patent, I must first construe the claims. This means interpreting the claims in the light of the description and drawings as instructed by section 125(1) of the Patents Act. In doing so I must interpret the claims in context through the eyes of the person skilled in the art. Ultimately the question is what the person skilled in the art would have understood the patentee to be using the language of the claims to mean. This approach has been confirmed in the decisions of the High Court in *Mylan v Yeda*¹ and the Court of Appeal in *Actavis v ICOS*². Section 125(1) reads as follows:

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.

- 18 Neither the claimant nor the defendant has explicitly defined the skilled person. It is reasonable to conclude that the person skilled in the art is a designer and/or manufacturer of self-standing signs.

- 19 A number of features of claim 1 have been identified by the claimant and defendant that require construing, in particular:

“The display panel (10) comprises a perimeter region (13) which surrounds at least in part a pocket (15) into which, in use, at least a portion of said upwardly extending support member (14) may be inserted”

“said display panel (10) comprises two or more sheets (24,25) which are bound to one another and incorporating links (31,32) therebetween which are perpendicular to the plane of the sheets (24,25) and which are located between the pocket (15) and the outer edge (16) of the perimeter region (13)”

“said rigid perimeter (13) extending to said flat surface; whereby said rigid perimeter region (13) rests against said flat upper surface”

- 20 Firstly, I shall consider the term “pocket”. Mr Fox has suggested in his first witness statement that a pocket “brings to (my) mind a space that is wider than it is thick, to accommodate a flat item such as a sword or the arched support 14 shown in figure 1B of the patent”.

- 21 The defendant has asserted that the claimant has artificially truncated “a perimeter region (13) which surrounds at least in part a pocket (15)” of claim 1 without considering the subsequent features of “...into which, in use, at least a portion of said upwardly extending support member (14) may be inserted”. The defendant states that separating the means from its function is not helpful in the process of

¹ *Generics UK Ltd (t/a Mylan) v Yeda Research and Dev. Co. Ltd & Anor* [2017] EWHC 2629 (Pat)

² *Actavis Group & Ors v ICOS Corp & Eli Lilly & Co.* [2017] EWCA Civ 1671

interpretation. Furthermore, the defendant considers the interpretation of a “pocket” in the witness statement to assign a “very obscure and narrow meaning of the term pocket with no reference to the description”.

22 The defendant notes paragraphs 7 and 44 of the description which read:

“[0007]The pocket of the display panel, allows the display panel to form a sheath or sleeve so that different display panels can be interchangeably placed on a single sign stand such that only one sign stand need be owned for the interchangeable use of multiple display panels and display panels can be easily updated or replaced.”

“[0044] Figure 6 shows a further embodiment where the display panel 10 is a star-shaped panel which may also cooperate with a support member 14 which is of a similar shape to the support member 14 shown in Figures 1 and 2. The support member 14 may be partially or entirely sheathed by the pocket 15 of the display panel 10.”

23 The defendant therefore argues that this feature of claim 1 relates to a pocket or any appropriate receiving cavity to accept the support member into it. At the hearing Mr Bishop added to this by saying “...a pocket suitable in receiving at least a portion of the upwardly extending support member, it could be just a cavity, it could be anything, just dictated by that support member”.

24 At the hearing Mr Downing felt that the only reliable interpretation with regard a “pocket”, was the pocket 15 shown in figure 3A. He also stated the claim 1 was clearly not characterised by “means plus function language” and it should be interpreted as a named feature – a pocket – plus an ability that a named feature must have.

25 In my opinion the person skilled in the art would interpret the term “pocket” in this instance to be a sheath, sleeve or the like with an opening which can receive the upwardly extending support member. This is clear from paragraphs 7 and 44 of the description. Whilst figures 1 and 3 show a pocket with a particular shape, the person skilled in the art would understand that this is an example only – rather than a providing a limitation for the shape of the pocket.

26 With regard to the “perimeter region (13) which surrounds at least in part” the pocket, the defendant argues that the perimeter region is a region between an outer edge of the display panel and the support member and is also defined by its position with respect to the upper surface of the support member base and its requirement for rigidity by virtue of the (two or more) sheets. In essence Mr Bishop argues that there is nothing about the perimeter region other than it is a perimeter region – i.e. however you defined the perimeter it could effectively have the same characteristics as the rest of the sign (e.g. a sign made of uniform material). With regard to the perimeter region “surrounding at least in part the pocket”, the defendant states that the claim does not exclude the possibility that the pocket or sheath could be formed between the links of the display panel – with figure 3A said to envision this.

27 The claimant has argued that the existence of a perimeter region surrounding a pocket requires that there are two identifiable regions within the sign. At the hearing Mr Downing discussed that the definition of the perimeter region is a somewhat artificial construct and arbitrary. He argued that it is a “region” – so it has to be an

area of the sign. Furthermore, an edge of the sign is not a “region” of the sign. In particular, as defined subsequently in the claim, the perimeter region has an outer edge.

- 28 Mr Fox provided a discussion of a perimeter region in his statement. However, this definition of a perimeter region was solely in relation to the “Boost” sign, rather than considering how the terminology in claim 1 of the patent should be interpreted in light of the description and figures. I would note that in Mr Fox’s first statement, at paragraph 16, he appeared to agree that the perimeter region is a region between an outer edge of the display panel and the support member.
- 29 Throughout the specification there is nothing to indicate that the perimeter region could form part of a pocket – as the figures, claims and description clearly define the perimeter region and pocket as separate. Furthermore, I note that the description only refers in broad terms, as per claim 1, to “a perimeter region which surrounds, at least in part, a pocket” and looking at the description and figures as a whole I do not see how they place a specific requirement on where or by how much the pocket would have to be surrounded by the perimeter region. Therefore, the person skilled in the art would construe “a perimeter region (13) which surrounds at least in part a pocket (15)” as any region (subject to the other requirements of the claim) distinct from a pocket, between an outer edge of the display panel and the support member, which partially or entirely surrounds the pocket.
- 30 I would add that the main purpose of the perimeter region is to provide the rigidity to retain the unsupported outer edge of the sign when it is supported by the support member. I am also satisfied that it is within the scope of the claim for the material of the display panel to be uniform provided as noted in paragraph 24:

“[0024] The display panel 10 is formed of a material which is sufficiently rigid so that the shape of a perimeter region 13 of the display panel 10 is substantially retained when the sign 12 is assembled, without the need for additional supporting members and without the need for the sign stand 11 to extend to the perimeter region 13 inside the display panel 10. This configuration enables the display panel 11 to be of an elaborate shape which protrudes from the sign stand 11 without collapsing in use.”

- 31 I will consider next the requirement that “said display panel (10) comprises two or more sheets (24,25) which are bound to one another and incorporating links (31,32) therebetween which are perpendicular to the plane of the sheets (24,25)”. The claimant argues that figure 3A of the patent clearly illustrates two separate sheets (24,25), each of which has an evident thickness. The claimant also notes figures 4A and B and paragraph 37 of the patent which states that

“[0037] .. each of the sheets 24,25 is comprised of a number of layers 26, 27 of bonded material. In a preferred embodiment, the bonding between the layers 26, 27 comprises a number of columns or corrugations of plastics material. The embodiment of Figure 4 shows two layers 26, 27 which are bound by a plurality of columns of plastics material which extend between the layers 26, 27 at an angle which is perpendicular to the plane of the layers 26, 27.”

- 32 Figure 4A (see below) shows a laminated honeycomb sheet as an example of respective sheets 24,25.

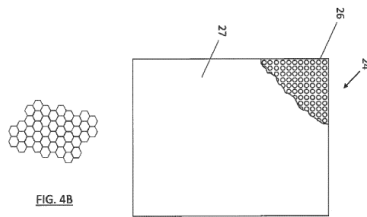


FIG. 4A

33 The claimant adds that this clarifies figure 3A, which therefore shows two multilayer sheets bonded to one another in the perimeter region – and not a single laminated sheet with flutes between the layers (i.e. a Correx sheet). Mr Downing noted that there is nothing in the patent to make it clear that figures 3 and 4 are different embodiments. Mr Downing also argued that the panel shown in figure 3 cannot be extruded due to its non-uniform nature, and that the honeycomb panels cannot be extruded.

34 The defendant argues that figure 3A shows an embodiment where the display panel is formed by two external layers and internal links. They also highlight paragraph 36 which reads:

“[0036] In a preferred embodiment, the display panel 10 is formed of extruded/fluted or laminated plastics material such as polypropylene. An extruded or fluted configuration provides improved uni-directional strength bias to the display panel 10. A laminated configuration provides improved omni-directional strength.”

35 Whilst figure 4 and paragraph 37 do discuss that each panel is multilayer, and figure 3 shows a perimeter region and pocket with a particular shape (which may be problematic to extrude) – I do not agree that the patent is limited to such an arrangement. In particular, paragraphs 10 and 36 refer to *the panel* (not just a sheet) being formed of extruded/fluted or laminated material. Thus, the person skilled in the art would construe the sheets “being bound to one another” such that it could encompass extruded, fluted or laminated material, as well as multilayer sheets bound to one another.

36 With regard to the “rigid perimeter (13) extending to said flat surface; whereby said rigid perimeter region (13) rests against said flat upper surface”, it is clear – e.g. from the figures and paragraph 42 – that this would be construed by the person skilled in the art as the rigid perimeter region resting directly on the flat upper surface of the base. Paragraph 42 reads:

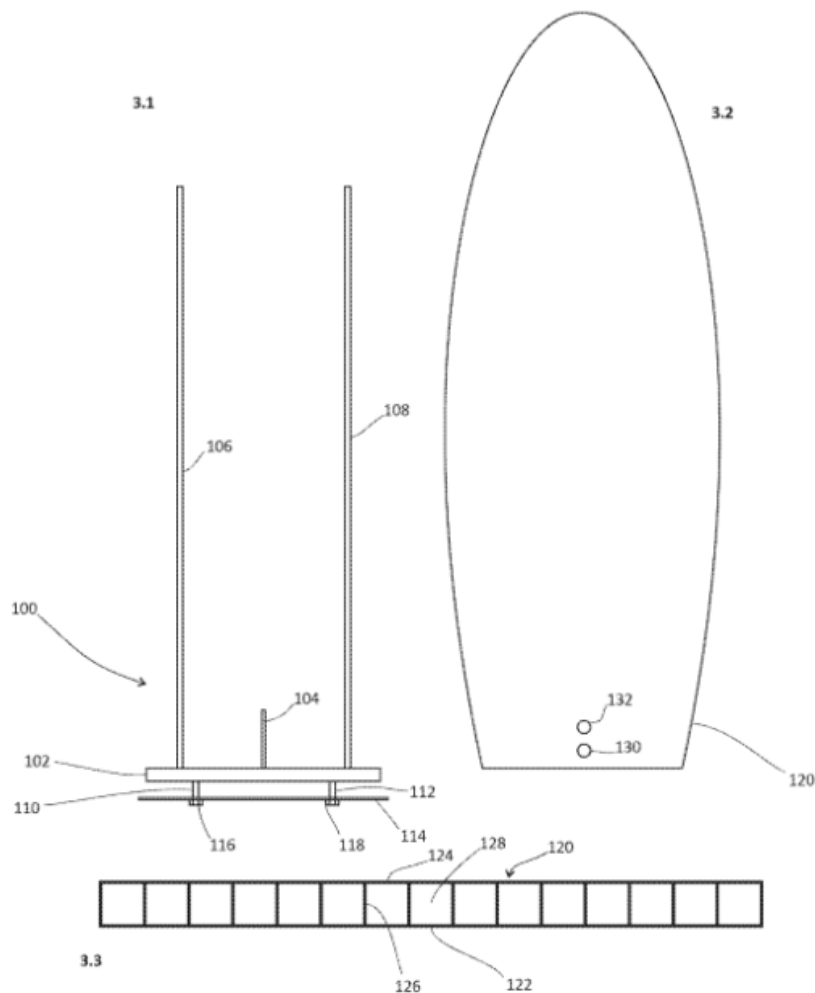
“[0042] In a further preferred embodiment, the base 17 of the sign stand 11 comprises a flat upper surface 16 so that a bottom edge 18 of the display panel 10 can more stably rest on the base 17.”

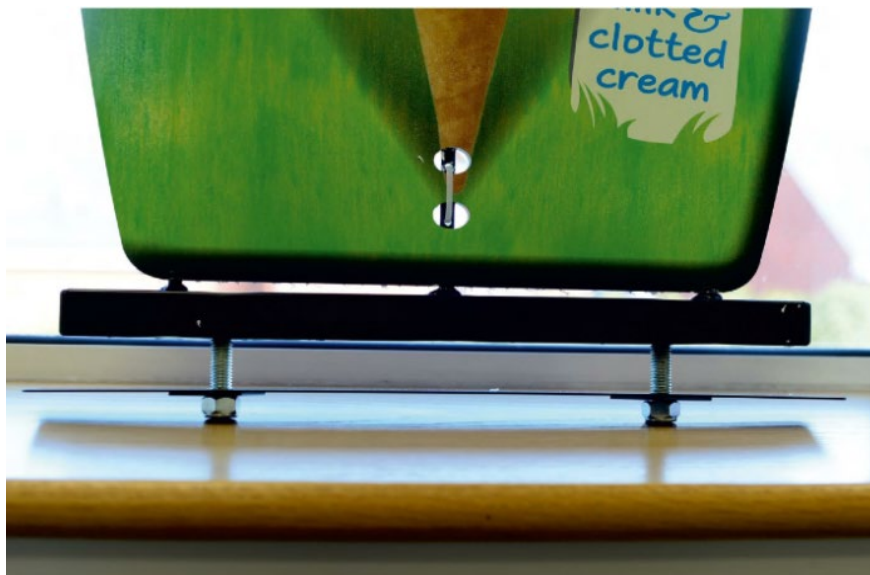
The Boost Sign

37 The claimant has provided a number of pictures of the boost sign, some of which were originally provided by the defendant during correspondence, along with figures representing the Boost sign that contain numbered line drawings. As noted, an

example of an actual Boost sign corresponding to the sign shown in the coloured photographs below was also provided at the hearing. With reference to the figures, the sign consists of a base 100 which comprises a square-section bar 102 with three upwardly extending spikes welded to it – the central spike 104 is relatively short compared to the outer spikes 106,108. As can be seen in the photographs, there is a weld or beading where the rods meet the base. In use, the base is often secured to a free-standing plastics moulded unit which can be water filled to provide stability.

38 The panel 120 comprises a “Correx” board cut to a required shape. Correx has a fluted structure comprising a front face 122 and a rear face 124 linked by internal flutes 126. To fit the panel to the base, the spikes are inserted into appropriate apertures 128. The panel 120 has a pair of holes 130,132 to expose sections of the central spike 104 to allow a cable tie to be passed through holes provided in the central spike 104 to fix the panel on the base and prevent removal. The claimant’s figures and a number of the photographs of the Boost sign are reproduced below.





- 39 At the hearing Mr Fox outlined his understanding of the available sizes of flutes in the Correx sheet and how the panel/board was made. Mr Fox commented that a panel with a flute of 10mm was the only available board to fit on a base with a support member, or spike, of 8mm and that the panel's manufacture involves cutting the Correx sheet and printing onto this sheet. Mr Fox confirmed that Boost signs only utilise welding on the top of the base to connect to the spike – in particular for strength and budget purposes.

The Law

- 40 Declarations of non-infringement are governed by section 71 of the Act. Insofar as relevant to this decision, section 71 states: -

Declaration or declarator as to non- infringement

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 the person has applied in writing to the proprietor for a written acknowledgement 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 such acknowledgment.

- 41 The claimant has provided, with its statement, copies of written correspondence between the claimant and the defendant that effectively demonstrate that the proprietor has refused to provide a written acknowledgement of non-infringement with respect to EP 3168826. I am therefore satisfied that the comptroller has the necessary power under section 71 to make such a declaration.
- 42 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 read 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) ...

- 43 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.
- 44 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.

Does the Boost sign infringe EP 3168826 B1?

- 45 The law on the scope of a patent claim in relation to infringement is as stated by the Supreme Court in *Actavis UK Ltd v Eli Lilly & Co*³ and the Court of Appeal in

³ *Actavis UK Ltd v Eli Lilly & Co* [2017] UKSC 48; [2017] RPC 2

*Icescape Limited v Ice-World International BV*⁴. Lord Kitchin summarised the position at paragraph 66 of the *Icescape* judgment:

“66. The whole approach to interpretation and scope of protection therefore involves the following steps, considered through the eyes of the notional addressee:

i) Does the variant infringe any of the claims as a matter of normal interpretation?

ii) If not, does the variant nevertheless infringe because it varies from the invention in a way or ways which is or are immaterial? This is to be determined by asking these three questions:

a) Notwithstanding that it is not within the literal (that is to say, I interpolate, normal) meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e. the inventive concept revealed by the patent?

b) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?

c) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?”

Normal Interpretation

46 The claimant has argued that none of the following features of claim 1 are present in the applicant’s Boost sign:

“The display panel (10) comprises a perimeter region (13) which surrounds at least in part a pocket (15)”

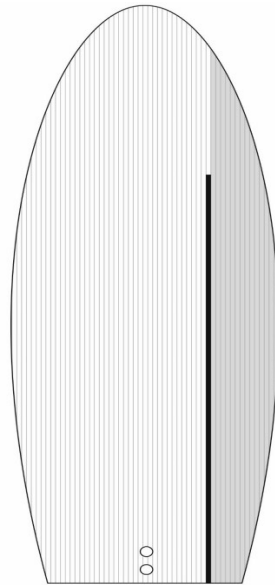
“said display panel (10) comprises two or more sheets (24,25) which are bound to one another”

“said rigid perimeter (13) extending to said flat surface; whereby said rigid perimeter region (13) rests against said flat upper surface”

47 The claimant has argued that the existence of a perimeter region surrounding a pocket requires that there are two identifiable regions within the sign, and that the display panel has neither a definable pocket nor a definable perimeter region. In his witness statement, Mr Fox identified the perimeter region as the area shaded in grey, shown in the diagram below. This diagram also shows the internal flutes and a spike/support member. He felt this accorded with the defendant’s statement that the perimeter region is “a region between an outer edge of the display panel and the support member”. He also noted that if an internal flute of a sheet of Correx™ used in the Boost sign was identified as the “pocket” (I note that Mr Downing did not accept that a flute was a pocket), then the pocket must extend along the entire height of the sign and thus there was no way for the perimeter region to then surround this pocket/flute in any meaningful way. In particular, this “perimeter region”

⁴ *Icescape Limited v Ice-World International BV* [2018] EWCA Civ 2219; [2019] FSR 5

does not “surround at least in part a pocket”, since it lies entirely to one side of the flute/pocket. At the hearing Mr Downing added that however the perimeter region is arbitrarily identified it does not surround at least in part anything that can be identified as a pocket.



- 48 The claimant also argues that the Boost panel is not two sheets bound to one another, as it is a single fluted sheet extruded as one. Furthermore, the claimant notes that, as shown in the photographs of the Boost sign, there is a clear spacing between the bottom edge of the sign panel and the top of the base. They add that the display panel is prevented from reaching the flat upper surface of the base due to weld beads connecting the spikes to the base, which are wider than the internal flutes of the Correx. Nor does the claimant accept that the panel will “sag over time” (e.g. due to damage, “bowing” or “flaring” of the panel) such that the panel would rest against the upper surface of the base and, nevertheless, the item sold by the applicant and for which a declaration of non-infringement is sought does not have the sign panel in contact with the base.
- 49 The defendant has argued that the Boost sign has a pocket in the form of a flute and also a perimeter region possessing a fluted structure for rigidity. At the hearing Mr Bishop considered the Boost panel to have a perimeter region – i.e. the notional perimeter which surrounds at least in part the flute/pocket – and this region must have the perpendicular links of the Correx board. The defendant has asserted that the relative sizes of the flutes and the spikes would ensure that the perimeter region rests on the upper flat surface of the base. Mr Bishop also asserted that there would be “immediate bowing” of the Boost panel such that the panel would “snuggly rest” on the surface of the base. This he says this is demonstrated by pictures of a similar “Walls” sign which were first provided in their letter dated 28th January 2022 (reproduced below). I have highlighted the alleged bowing below..
- 50 Mr Fox confirmed that B D & H Limited did not produce/print these “Walls” signs.



- 51 At the hearing Mr Downing argued that these pictures were clearly each showing the same “Walls” sign (with an unknown Correx board), and notwithstanding they were not produced by the claimant, they in fact still show the board being clear of the base.
- 52 It is clear to me that the panel of the Boost sign has a pocket as I have construed the term – as the flute provides a close-fitting sheath or covering – and this pocket receives the spike of the base. I am also satisfied that the Boost sign has a perimeter region as I have construed that term. The “perimeter region” can, for example, be taken to be a region on either side of a flute receiving a spike, which extends between the flute and the outer edges of the panel (as proposed by Mr Fox). Covering one side of the flute *partially* surrounds the flute such that it is a perimeter region that “surrounds at least in part a pocket”. Furthermore, this perimeter region is formed of Correx material which is rigid and is comprised of two sheets which are “bound to one another and incorporating links therebetween which are perpendicular to the plane of the sheets” (as correctly construed).
- 53 From the photographs of the Boost sign, as well as the exhibit, it is readily apparent that the rigid perimeter of the panel does not “extend to said flat surface; whereby said rigid perimeter region (13) rests against said flat upper surface” as there is a clear gap between the panel and the upper surface of the base, which is provided (at least) by the welding beads. The relative sizes of the flutes and spikes of the Boost sign are not such that the panel will rest of the flat surface of the base. Furthermore, I do not accept that the panel of the Boost sign would bow/flare so as to rest on the

flat surface – at the very least because the defendant has provided no evidence of this.

- 54 Therefore, the claimant’s Boost sign does not fall within the scope of claim 1 of the EP 3168826 B1, on a normal interpretation of the claim.

Immaterial Variation

- 55 The second issue to be addressed is asking whether the variant provided by the Boost sign varies in a way(s) which is immaterial? The court in *Actavis* provided a reformulation of the three questions in *Improver*⁵ to provide guidelines or helpful assistance in connection with this second issue. These reformulated questions are:

(i) Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e. the inventive concept revealed by the patent?

(ii) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?

(iii) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

- 56 To establish infringement in a case where there is no literal infringement, a patentee would have to establish that the answer to the first two questions was “yes” and that the answer to the third question was “no”.

- 57 Whilst the claimant has argued that this is an issue that would normally have to be answered by evidence⁶, I consider that this point can be readily answered by considering whether the Boost sign achieves substantially the same result in substantially the same way as the invention. At the hearing Mr Bishop discussed that the patent aims to provide a sign with greater stability through the “interaction” of the rigid perimeter and the flat upper surface. By resting a rigid perimeter region on the flat upper surface of the base, the sign of claim 1 of the patent is said to contribute enhanced stability and structural strength to permit much larger sign construction without drawbacks such as excessive swinging. This inventive concept is not achieved by the Boost sign due to the gap between the panel and the base. Therefore, the Boost sign does not vary in a way that is immaterial.

Validity

The prior art - “Windmaster”

- 58 The claimant has provided an extract from the defendant’s 2008 brochure, depicting its “Windmaster” sign. The defendant has not disputed the publication date of this brochure. Pictures from this brochure are reproduced below.

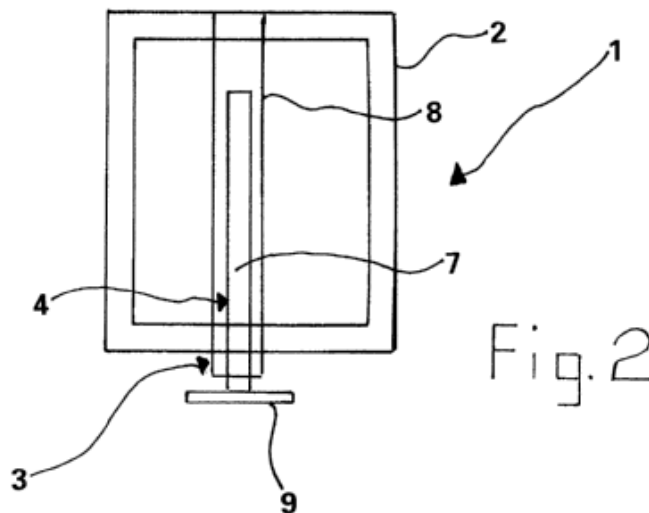
⁵ *Improver Corp v Remington Consumer Products Ltd* [1990] FSR 181

⁶ See paragraph 54 of *Actavis UK Ltd v Eli Lilly & Co* [2017] UKSC 48; [2017] RPC 2



The prior art -DE 20202774 U1

59 DE 20202774 was published on the 7th August 2003 and relates to a display case 1, with a housing 2 and flat anchor plate 9. The display case can be pulled out or extended using sections 7 and 8. Figure 2 shows the display case in its storage or un-extended position and is reproduced below.



Novelty

60 In order to anticipate claim 1 of the patent, the prior art must have all of the integers of the claim. The claimant has argued that claim 1 of the patent is not valid as it is anticipated by either the defendant's "Windmaster" sign or document DE 20202774 – although this is largely based on me construing the claims so as to be infringed by

the Boost sign. In other words, this is a squeeze argument – if the claims are interpreted such that the Boost sign infringes then the claims would be invalid – if however, the claims are construed such that the Boost sign does not infringe then the claims would be valid.

- 61 It is clear from the figures/pictures that neither of DE 20202774 or the Windmaster disclose a rigid perimeter *extending to a flat surface of a base*, where the rigid perimeter *rests against said flat upper surface*. In particular, in the Windmaster brochure there is a gap between the panel and the base showing the support members therebetween, and if the panel were to rest on anything, it would rest on springs rather than the surface of the base itself. There is also no disclosure of the use of a rigid panel with two or more sheets and perpendicular links in DE 20202774. Therefore, claim 1 is not anticipated by the Windmaster sign or DE 20202774.

Inventive step

- 62 In assessing whether or not an invention would have been obvious it is easy to be misled by hindsight. Therefore, it has become the practice to approach the question in a step-by-step way, as first laid down in the Windsurfing⁷ case. More recently it has been restated by the Court of Appeal in *Pozzoli*⁸ where Jacob LJ noted:

“I would restate the Windsurfing questions thus:

(1) (a) Identify the notional “person skilled in the art”

(b) Identify the relevant common general knowledge of that person;

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention.”

- 63 The skilled person is a designer and/or manufacturer of self-standing signs. Their common general knowledge was not referred to explicitly by either party during prosecution. It is fair to assume that the person skilled in the art would be aware of various panel materials, such as Correx, and be aware of various base designs, such as solid or water filled bases and/or the use of springs.
- 64 As discussed above, the inventive concept resides in providing a sign with greater stability though the interaction of a rigid perimeter of a panel and the flat upper surface of a base. By resting a rigid perimeter region on the flat upper surface, the sign of claim 1 provides enhanced stability and structural strength to permit much larger sign construction without drawbacks such as excessive swinging.

⁷ *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] FSR 59

⁸ *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

- 65 The Windmaster sign differs from the inventive concept in that there is a gap between the panel and the base, and if the panel were to rest on anything, it would rest on springs. DE 20202774 does not disclose a rigid panel with two or more sheets and perpendicular links, with this rigid panel resting on a flat base.
- 66 At the hearing Mr Downing emphasised, with respect to the Windmaster sign, if the only distinguishing feature was that the perimeter region contacts the base then this was not sufficient for an inventive step. I was not however presented with any evidence of that. The claimant also considers it obvious to provide a bottom stop for the sign in DE 20202774 to prevent the display board from slipping too far down. Furthermore, DE 20202774 is said to provide a display case that will that inevitably have a front and rear face and having perpendicular links (which are the shortest and simplest) is an obvious way of connecting these faces together.
- 67 The defendant argues that the combination of the reinforced perimeter region and the upper flat surface of the base onto which the reinforced perimeter rests is non-obvious. This configuration is said to depart completely from the Windmaster sign which accommodates swinging of the sign, through spring members and spacing between the base and the panel, in order to provide a large panel. Furthermore, DE 20202774 is said to be inferior to the Windmaster.
- 68 I consider that the person skilled in the art, when presented with the Windmaster sign, would not readily appreciate that the springs could be removed so as to accommodate a rigid (e.g. Correx) panel in a stable manner. This seems to me to indicate some inventive insight and would require significant adaption of the Windmaster sign. Furthermore, whilst the skilled person would be aware of Correx materials, I do not see how they would apply this to the sign housing of DE 20202774 and also have this rigid housing resting on the base without some inventive ingenuity or hindsight. Therefore claim 1 is not obvious in light of the Windmaster sign or DE 20202774.

Conclusion and Declaration

- 69 I conclude that EP 3168826 B1 is valid as it is novel and inventive over the prior art.
- 70 I conclude also that the Boost Sign identified in Annex 1 of the statement of grounds, which is manufactured and distributed by B D & H Limited, does not infringe EP 3168826 B1. The defendant accepted that the Boost sign would also not infringe GB2541956B.
- 71 I therefore declare, on the basis of the evidence and arguments before me, that the manufacture, disposal, offer to dispose, of the Boost Sign identified in Annex 1 of the statement of grounds, or the keeping of such signs whether for disposal or otherwise, in the United Kingdom, do not and would not constitute an infringement of the claims of either patent EP 3168826 B1 or GB2541956B.

Costs

- 72 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 scale unless the circumstances warrant departing from the published scale⁹.

- 73 Both sides were given the opportunity to address me on the issue of costs at the hearing. Mr Downing argued for an off-scale award in favour of the claimant. He highlighted firstly what he considered the intimidatory stark tone of the pre-action letters that his client had received contrasting those with the defendant's counterstatement which raised some doubt about the defendant's understanding of the alleged infringing signs. Mr Downing also noted that the defendant's claim that its sign was also infringing GB2541956B was evidently without any basis and that this has been borne out by the defendant failing to pursue that aspect of the case. Given the similarities between EP 3168826 B1 and GB2541956B I asked Mr Downing if the defendant's decision to not oppose the claimant's request for a declaration in respect of the GB patent in its counterstatement had resulted in the claimant incurring unnecessary costs. Mr Downing expressed some doubt about whether the defendant had been as clear as it could have been that it was not opposing the request in respect of GB2541956B. He also noted that there were significant differences between the two patents even if there was considerable overlap.
- 74 Mr Downing also sought to highlight deficiencies in the counterstatement though he accepted these had not been raised during the course of these proceedings. He also noted that it could have indicated prior to launch of these proceedings that the GB patent was no longer in issue. Summing up Mr Downing contended that the defendant had made assertions of infringement against the claimant that it has not properly researched, that it had maintained those assertions even when it was clear there was no infringement and that it has sought to maximise the claimant's costs despite its efforts to keep costs down.
- 75 Mr Bishop responded that once the nature of the alleged infringing sign had become clear that the defendant had focussed its arguments on EP 3168826 B1 and had accepted that GB2541956B was not infringed. He also highlighted the claimant's own evidence, in particular the line drawing of the Boost sign which cast doubt on its precise structure.
- 76 Having considered the matter carefully I am not persuaded that an award off-scale is justified. The defendant did concede on the question of the GB patent early in the proceedings before the comptroller and in a way that did not clearly lead to any unnecessary costs for the defendant noting that it was required to pursue the case in respect of the similar EP patent. I also believe that whilst the clarity of submissions from both sides could at times have been clearer, neither side deliberately sought to cause the other side unnecessary costs.
- 77 The claimant has been successful in its action for a declaration of non-infringement and is therefore entitled to an award in its favour. It failed in its action to revoke EP 3168826 B1 however the nature of the case against that patent was intrinsically tied to its case of non-infringement and therefore I will not make any offset against the claimant in that respect. I therefore award the claimant the sum of £2300 made up of the following elements:

⁹ [Tribunal Practice Notice \(TPN 2/2016\)](#)

Preparing a statement and considering the other side's statement - £400

Preparing evidence and considering and commenting on the other side's evidence - £500

Preparing for and attending a hearing - £1000

Official fees - £400

- 78 The sum of £2300 should be paid by Signwaves Limited to B D & H Limited as a contribution to its costs, this sum to be paid within seven days of the expiry of the appeal period below.

Appeal

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

PHIL THORPE

Deputy Director acting for the Comptroller