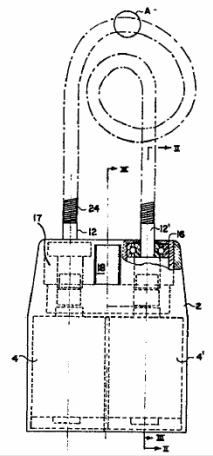
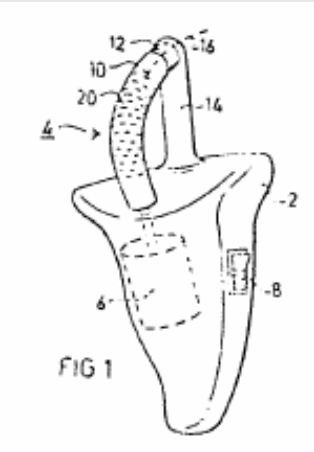
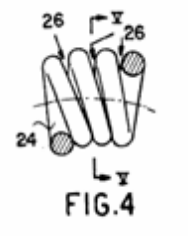
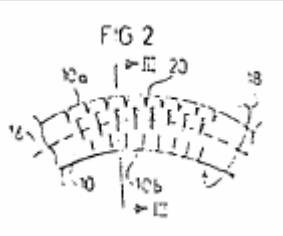
Court of Appeal, London, 12 August 1988, Improver v Remington

EP101656 *v* *EP0290119*









PATENT LAW

The question whether a patent infringement is given is one of purposive and realistic construction through the eyes and with the learning of a person skilled in the art, rather than with a verbal analysis of a lawyer.

The "purposive construction" approach established in the Catnic case is the same approach followed by the Protocol on the Interpretation of Art. 69 EPC.

Questions

If the issue was whether a feature embodied in an alleged infringement which fell outside the primary, literal or a contextual meaning of a descriptive word or phrase in the claim ("a variant") was nevertheless within its language as properly interpreted, the court should ask itself the following three questions:

(1) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no-

(2) Would this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art. If no, the variant is outside the claim. If yes-

(3) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention. If yes, the variant is outside the claim.

On the other hand, a negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a figurative meaning (the figure being a form of synecdoche or metonymy) denoting a class of things which included the variant and the literal meaning, the latter being perhaps the most perfect, best-known or striking example of the class.

Source: [1990] FSR 181; **21 IIC 561 (1990)**

Court of Appeal, 12 August 1988
(Hoffmann)
Decision of the Court of Appeal
August 12, 1988
–
Improver Corp. v. Remington Consumer Products Ltd
[…]
The patent sets out in the opening words in column 1 that: "*The present invention relates to an electrically powered depilatory device, useful for cosmetic applications*". In column 1, line 53, giving a summary of the invention, it says:
"The present invention seeks to provide to the market-place an electrically driven mechanical depilatory appliance which provides efficient hair removal by a device, whose size, complexity, cost and convenience compare favorably with an electric razor."
It is not suggested that that is precise enough to define the scope of the invention. The patent then goes on to set out a succession of embodiments of the invention. I do not propose to read any of them at the moment. After these various alternative embodiments it is said in column 6 at line 53:
It will be evident to those skilled in the art that the invention is not limited to the details of the foregoing illustrative embodiments, and that the present invention may be embodied in other specific forms without departing from the essential attributes thereof, and it is therefore desired that the present embodiments be considered in all respects as illustrative and not restrictive, reference being made to the appended claims. rather than to the foregoing description, and all variations which come within the meaning and range of equivalency of the claims are therefore intended to be embraced therein.
There follow twenty claims, but only the first need be considered because all the others are dependent upon the first. That reads as follows:
1. An electrically powered depilatory device comprising:
a hand held portable housing; motor means [...] disposed in said housing; and a helical spring [...] comprising a plurality of adjacent windings arranged to be driven by said motor means in rotational sliding motion relative to skin bearing hair to be removed, said helical spring including an arcuate hair engaging portion arranged to define a convex side whereat the windings are spread apart, and a concave side

corresponding thereto whereat the windings are pressed together, the rotational motion of the helical spring producing continuous motion of the windings from a spread apart orientation at the convex side to a pressed together orientation at the concave side and for engagement and plucking of hair from the skin of the helical spring producing continuous motion of the windings from a spread apart orientation at the convex side to a pressed together orientation at the concave side and for engagement and plucking of hair from the skin of the subject, whereby the surface velocities of the windings relative to the skin greatly exceeds the surface velocity of the housing relative thereto.

A preferred embodiment of the invention is said to be one in which the helical spring arcuate hair engaging portion "*extends along an arc subtending more than 90 degrees and preferably more than 180 degrees, whereby the surface velocities of windings of the helical spring simultaneously include components extending in mutually perpendicular directions, for significantly enhanced hair removal efficiency*."

The looped configuration to which this description refers can be seen in Figures 1 and 2 of the patent drawings, Its advantages are further explained as follows:

The looped Spring configuration of the present invention is a particular feature thereof in that there are simultaneously present at all times windings of the helical spring whose component of velocity relative to the hair extends in mutually perpendicular directions. The apparatus thus is operative to remove hair oriented in various directions without requiring movement of the housing against the skin in all of these directions.

The description ends, however, with the following general statement, which I shall later refer to as the "equivalents clause":

It will be evident to those skilled in the art that the invention is not limited to the details of the foregoing illustrative embodiments, and that the present invention may be embodied in other specific forms without departing from the essential attributes thereof. and it is therefore desired that the present embodiments be considered in all respects as illustrative and not restrictive, reference being made to the appended claims, rather than to the foregoing description, and all variations which come within the meaning and range of equivalency of the claims are therefore intended to be embraced therein [...].

Infringement:

The question of infringement turns upon a short but undoubtedly difficult point of construction, namely whether the rubber rod in the defendant's invention is a "helical spring" as that expression is used in the claims of the patent in suit [...]. The proper approach to the interpretation of English patents registered under the Patents Act 1949 was explained by **Lord Diplock in Catnic Components Ltd. v. Hill & Smith Ltd.** 1) The language should be given a "purposive" and not necessarily a literal construction.

If the issue was whether a feature embodied in an alleged infringement which fell outside the primary, literal or a contextual meaning of a descriptive word or phrase in the claim ("a variant") was nevertheless within its language as properly interpreted, the court should ask itself the following three questions:

(1) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no-

(2) Would this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art. If no, the variant is outside the claim. If yes-

(3) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention. If yes, the variant is outside the claim.

On the other hand, a negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a figurative meaning (the figure being a form of synecdoche or metonymy) denoting a class of things which included the variant and the literal meaning, the latter being perhaps the most perfect, best-known or striking example of the class.

Thus in **Catnic** itself the claim of a patent for a lintel of box construction required that the upper plate be supported upon the lower plate by two rigid supports, one in front and the other "extending vertically" from the one plate to the other at the rear. The defendant's lintel had a rear support which was inclined 6° or 8° from the vertical. The House of Lords decided that this variation had no material effect upon the load-bearing capacity of the lintel or the way it worked and that this would have been obvious to the skilled builder at the date of publication of the patent. It also decided that the skilled reader would not have understood from the language of the claim that the patentee was insisting upon precisely 9t)° as an essential requirement of his invention. The conclusion was that "extending vertically" meant "extending within the range of angles which give substantially the maximum load-bearing capacity and of which 90° is the perfect example."

In the end, therefore, the question is always whether the alleged infringement is covered by the language of the claim. This, I think, is what Lord Diplock meant in Catnic when he said that there was no dichotomy between "textual infringement" and infringement of the "pith and marrow" of the patent and why I respectfully think that Fox LJ put the question with great precision in Anchor Building Products Ltd. v. Redland Roof Tiles Ltd. 2) when he said the question was whether the absence of a feature mentioned in the claim was "an immaterial variant which a person skilled in the trade would have regarded as being within the ambit of the language" (My emphasis). It is worth noticing that Lord Diplock's first two questions, although they cannot sensibly be answered without reference to the patent, do not primarily involve questions of construction. Whether the variant would make a material difference to the way the invention worked and whether this would have been obvious to the skilled reader are

questions of fact. The answers are used to provide the factual background against which the specification must be construed. It is the third question which raises the question of construction and Lord Diplock's formulation makes it clear that ou this question the answers to the first two questions are not conclusive. Even a purposive construction of the language of the patent may lead to the conclusion that although the variant made no material difference and this would have been obvious at the time, the patentee for some reason was confining his claim to the primary meaning and excluding the variant. If this were not the case, there would be no point in asking the third question at all.

Catnic was a decision on the Patent Act 1949, Section 125 of the Patent Act 1977, which is declared by section 130 (7) to be framed to have as nearly as practicable the same effect as Article 69 of the European Patent Convention, says that the invention shall be taken to be that specified in a claim, as interpreted by the description and drawings. Section 125 (3) applies to English patents the Protocol on the Interpretation of Article 69 which, if I may paraphrase, says that the Article 69 and section 125 (l) mean what they say: the scope of the invention must be found in the language of the claims. Extrinsic material such as the description can be used to interpret those claims but cannot provide independent support for a cause of action which the language of the claim, literally or figuratively construed, simply cannot bear. On the other hand, the claims should not be interpreted literally but in a way which "combines a fair protection for the patentee with a reasonable degree of certainty for third parties." Dillon LJ said in his judgment at the interlocutory injunction stage of this action that Lord Diplock's speech in Catnic indicated the same approach to construction as that laid down by the Protocol. This view has been adopted by the Court of Appeal in Anchor Building Products and at least two unreported cases at first instance. 3) I regard it as binding upon me. I must therefore ask Lord Diplock's three questions to ascertain whether "helical spring" should be interpreted to mean a class of bendy, slitty rods of which a close-coiled helical spring in its primary sense is a striking and elegant example but which includes the defendant's rubber rod.

(1) Does the variant have a material effect on the way the invention works?

The answer to this question depends upon the level of generality at which one describes the way the invention works. At one extreme, if one says that the invention works by gripping and pulling hair, there is obviously no difference. The same would be true of a pair of tweezers. At the other extreme, if one says that it works by gripping hairs between metal windings of circular cross-section wound in a continuous spiral around a hollow core, there obviously is a difference [...].

[…]

It seems to me that the right approach is to describe the working of the invention at the level of generality with which it is described in the claim of the patent. As I have said, the expert for the defendants agreed that there was no difference between the descriptions in the defendant's patent and the patent in suit of the way the inventions worked. The differences lay entirely in the descriptions of the hardware. In my judgment, at the appropriate level of description, the rubber rod works in the same way as the helical spring and the differences I have mentioned, so far as they exist, are not material.

(2) Would it have been obvious to a man skilled in the art that the variant would work in the same way?

[…]

In my view the question supposes that the skilled man is told of both the invention and the variant and asked whether the variant would obviously work in the same way [...].

[...]

The experts called by the plaintiff agreed that it would have been obvious to the skilled man that the attributes which enabled the helical spring to function in the way described in the specification were that it was capable of rotating, capable of transmitting torque along its length to resist the forces involved in plucking hairs, bendy (to form an arc) and slitty (to entrap hairs by the opening and closing effect of rotation) [...]. On this evidence the second question must in my judgment be answered yes [...].

(3) Would the skilled reader nevertheless have understood that the patentee intended to confine his claim to the primary meaning of a helical spring?

This brings one to the question of construction.

[...]

[...]

In my judgment the difference between the experts depends upon how one construes the equivalents clause. The first part of the clause merely says that the description should not be used to restrict the meaning of the language used in the claims. That is not the question here. What matters is the final words: "and all variations which come within the meaning and range of equivalency of the claims are therefore intended to be embraced therein. " If this means: "whatever contrary impression the skilled man may be given by the language of the claims read in the context of the rest of the description, all references in the claims to hardware are deemed to include any other hardware which would in any circumstances function in the same way" then I think the expert for the plaintiffs must be right. In my judgment, however, the clause does not have so wide an effect. The words I have quoted say that the variation must still come within the meaning of the claims and the reference to "range of equivalency" means in my judgment no more than "don't forget that the claims must be interpreted in accordance with Catnic and the Protocol." Thus interpreted, I do not think that "helical spring" can reasonably be given a wide generic construction and I accept the expert for the defendant's reasons for thinking that a skilled man would not understand it in this sense. This is not a case like Catnic in which the angle of the support member

can be regarded as an approximation to the vertical. The rubber rod is not an approximation to a helical spring. It is a different thing which can in limited circumstances work in the same way. Nor can the spring be regarded as an "inessential" or the change from metal spring to rubber rod as a minor variant. In **Catnic Lord Diplock** asked rhetorically whether there was any reason why the patentee should wish to restrict his invention to a support angled at precisely 90°, thereby making avoidance easy. In this case I think that a similar question would receive a ready answer. It would be obvious that the rubber had problems of hysteresis which might be very difficult to overcome. The plaintiff's inventor had done no work on rubber rods. Certainly the rubber rod cannot be used in the loop configuration which is the plaintiff's preferred embodiment. On the other hand, drafting the claim in wide generic terms to cover alternatives like the rubber rod might be unacceptable to the patent office. I do not think that the hypothetical skilled man is also assumed to be skilled in patent law and he would in my judgment be entitled to think that patentee had good reasons for limiting himself, as he obviously appeared to have done, to a helical coil. To derive a different meaning solely from the equivalents clause would in my view be denying third parties that reasonable degree of certainty to which they are entitled under the Protocol.

The German Decisions

The patent in suit is being litigated in a number of countries but the only one in which the action has come to trial is in Germany, where the Landgericht (District Court) of Düsseldorf found in favour of the plaintiff. This naturally causes me concern because the Landgericht was interpreting the same patent according to the same Protocol and came to a different conclusion. It seems to me that the reason for the difference between me and my colleagues in Düsseldorf is that, having answered what I have labelled as Lord Diplock's first two questions in the same way as I have, they treated those answers as concluding the matter in favour of the plaintiff and did not find it necessary to ask the third question at all. The specification, they said, conveyed to the expert "the understanding that the configuration of the hair engaging portion as helical spring has to be understood functionally" and the expert to whom the patent was directed would have "no difficulties in perceiving and understanding this meaning of the teaching of the invention." This does seem to me with respect to be an interpretation closer to treating the language of the claims as a "guideline" than the median course required by the Protocol. I also detect some difference in approach between the Landgericht and the Oberlandesgericht (Court of Appeal) which had previously discharged an interlocutory injunction granted by the Landesgericht. The Court of Appeal placed much more emphasis upon the language of the specification [...]. The Court went on to say that the rubber rod undoubtedly worked in the same way as the helical spring (i.e. it answered Lord Diplock's first question in the same way as 1 have). Although it does not specifically say so, I think it may be assumed that it would have regarded this as equally obvious to anyone skilled in the art. But when dealing with the question of whether this would affect the question of construction. i. e. whether the skilled man would have regarded the rubber rod as included in the claims of the patent, the Court of Appeal expressed considerable doubt. He could have done so if he had analysed the function of the spring in the invention and then set about thinking of equivalents to perform the same function. But the Court doubted whether "the average person skilled in the art thinks in such a theoretical way. This applies particularly to the present case because there appeared to be no need for theorising in view of the fact that a normal helical spring was known as a perfectly suitable means for plucking." It may be said that the expert evidence before the Landgericht at the trial was different, but I doubt whether this could have been so. There was no real difference between the views of the experts on questions of engineering: the difference lay in the approach to construction, which is really a question of law.

Validity

[….]

[held to be valid]
