

PATENTS ACT 1977

IN THE MATTER OF an application under section 71(1) by Melkris Limited, trading as Brital Engineering Services, for a declaration of non-infringement of Patent No GB 2,257,100 in the name of Philip Denman

DECISION

Background

- 1 UK Patent GB 2257100 was granted to the defendant, Philip Denman, with effect from 18 January 1995 and remains in force to this day. It is concerned with a lockable device to prevent the unauthorised use of towing equipment. The preferred embodiment can be put together in two alternative configurations so it can be used to lock the towing hitch of a trailer both when the trailer is unattached to a towing vehicle and when it is attached.
- 2 On 21 February 2000, the claimant, Melkris Limited trading as Brital Engineering Services, filed an application for a declaration of non-infringement under section 71(1). The defendant has contested this, and it now falls to me to decide whether or not to make the declaration sought. First, however, there are a number of preliminary points I must deal with.
- 3 The parties have been represented in these proceedings by their respective patent agents - D W & S W Gee for the claimant and Eric Potter Clarkson for the defendant. The proceedings have been conducted throughout in what I can only describe as a highly confrontational way. There have been allegations, counter-allegations and denials, played out in lengthy correspondence (even the counterstatement was 36 pages long, and that is ignoring the annexes) with considerably more heat than light. The waters have also been muddied by attempts by the defendant to bring in a number of issues that are completely irrelevant to the question of whether I should grant a declaration of non-infringement, such as his willingness to grant a licence and demands to know when the claimant first started marketing the device in question.
- 4 On the plus side, though, the evidence has been kept very short, amounting on both sides to little more than half-page declarations formally putting in evidence a few documents going to some of the peripheral allegations. Moreover, and very commendably, both sides have agreed to dispense with an oral hearing and asked me to decide matters on the basis of their written submissions. However, the net result of all the exchanges that have taken place since the proceedings began is that I have five preliminary points to deal with before I can turn to the substantive issues. They are:
 - C Whether the application should be thrown out for failure to comply with section 71(1)(a).

- C Whether the application should be thrown out because of what is alleged to be deliberate concealment of the truth by the claimant.
- C Whether the acts in respect of which a declaration is sought have been adequately particularised.
- C Whether I should admit what are alleged to be additional grounds introduced at a late stage.
- C Whether certain documents should be kept off the public part of the file.

I will deal with these points in turn.

Compliance with section 71(1)(a)

5 Section 71(1) states:

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.

6 It is clear to me, in particular from the tenses employed in this section, that the events specified in subparagraphs (a) and (b) need to have occurred before a declaration can be made. However, the secondary legislation goes further. Rule 74 of the Patent Rules 1995 governs the procedure for applications under section 71, and rule 74(1) requires that:

“an application to the comptroller under section 71 . . . shall be accompanied by . . . a statement in duplicate, setting out fully the facts upon which the applicant relies as showing that subparagraphs (a) and (b) of section 71(1) have been complied with . . .”

On a strict interpretation of this rule, the events specified in subparagraphs (a) and (b) need to have occurred not merely before a declaration can be made but before an application is filed. This would be eminently sensible, because there would be no need for an application if the defendant were to provide the acknowledgement requested.

7 In the present case, the claimant's agents wrote to the defendant on Friday 18 February

2000, asking for an acknowledgement that the claimant's device did not infringe the patent in suit. They filed the present application for a declaration of non-infringement on Monday, 21 February, that is, the next working day. In the event, their letter did not even reach the defendant. They had addressed it not to the registered address for service but to the defendant's own address as listed in the Patent Register. However, the defendant had moved from that address, and in due course the letter was returned as not delivered. A copy of the letter was sent to the defendant's new address on 28 February 2000, and the defendant's agent replied in a letter of 31 March 2000 declining to give the requested acknowledgement.

- 8 The defendant argues that this was not complying with the requirements of section 71 and the rules. Although it could be said that the claimant had applied in writing before the application under section 71 was filed, albeit addressing the letter to the defendant's former address, it cannot reasonably be said that the defendant had refused or failed to give the requested acknowledgement in advance of the filing because he did not have the opportunity to do so. Indeed the defendant did not receive the letter in advance of the application being filed, but even if he had, he would have had insufficient time to respond.
- 9 I have considerable sympathy with the defendant on this point and deplore the way the claimant handled this. The claimant has provided some explanations as to why it was having to work to such a tight timetable, such as the fact that it had only just filed a patent application for its own device, but I do not find these explanations convincing. The fact is the claimant was tooled up and ready to offer its device for sale, and as the defendant has pointed out, one cannot reach that position overnight. Thus the timing of when it filed its patent application and when it sought an acknowledgement of non-infringement was very much in its own hands. Indeed, as the claimant has tacitly acknowledged in correspondence, the truth is it saw this as a race to the courts. It wanted to get its application under section 71 in before the defendant had any time to react by launching an infringement action. This approach is completely at odds with one of the key elements of the reform of civil justice initiated by the Woolf report and introduced, so far as the courts are concerned, by the Civil Procedure Rules 1998, under which parties are expected to try and settle their disputes first before resorting to litigation.
- 10 There is, however, another consideration. In *MMD Design & Consultancy Ltd's Patent* [1989] RPC 131 the hearing officer expressed the pragmatic view that dismissal of an application under section 71 because the claimant did not make available all the relevant documents to the defendant in advance of filing the application would mostly likely merely lead to the filing of another application. He therefore declined to dismiss the application. In the present case the situation is worse in that the defendant did not even learn of the claimant's case before the application was filed, but nevertheless throwing the application out now may simply lead to a fresh one being filed. How, then, should one balance the objectives of the reform of civil justice - which the comptroller has publically espoused in *Tribunal Practice Notice 1/2000*, [2000] RPC 587 - with the likely practical consequence of throwing a case out?
- 11 The defendant argues that the reform objectives should take priority and that *MMD* should no longer be regarded as good law. In my view, as a general principle that must

be right, though subject of course to the particular circumstances of the case. That means that if a similar situation were to arise in future, the comptroller may be much more inclined not to follow the *MMD* line but instead to throw the case out with an appropriate award of costs, even though that might simply result in a further application being filed a little later.

- 12 However, I consider that throwing the present case out at this stage would be neither a sensible course to adopt nor a fair one to the claimant. It would not be sensible because of the advanced stage that the proceedings have now reached. If I were to dismiss the application now, it would merely cause both parties further delay and expense to no good purpose. It would not be fair on the claimant because I am aware that, on the basis of *MMD*, the current edition of the *CIPA Guide to the Patents Act* encourages patent agents to believe that it is perfectly acceptable to defer seeking an acknowledgement until the section 71 proceedings are launched. Moreover, at an early stage in the present proceedings the Office suggested in a letter that the pragmatic *MMD* approach seemed appropriate. Of course, I have to think about fairness to the defendant too, and he has argued that he has been disadvantaged in a number of ways by the launching of the section 71 proceedings with no attempt to seek an acknowledgement first. However, I find his arguments wholly unconvincing, given that he has made no bones about the fact that he would never have given the acknowledgement anyway. For example, the fact that the defendant has lost sales has got nothing to do with the timing of the section 71 action - it is simply a consequence of competition from the claimant's product. Similarly, the submission that he lost the opportunity to negotiate a royalty bearing settlement is rubbish, as the claimant was not likely to agree a royalty on a product which it believed did not infringe.
- 13 Thus whilst I may well take a different line in future cases, I have decided not to throw out the present case for failure to comply with section 71(1)(a). I will, however, reflect the behaviour of the claimant in launching this action without giving the defendant a proper opportunity to make an acknowledgement when I come to costs.

Alleged concealment of the truth

- 14 I will now turn to the second preliminary matter. On 28 February 2000 the claimant sent to the defendant a letter which included the words "my client.....intends to make, dispose of, offer to dispose of, and use...". It is common ground that the claimant had by then already offered his product for sale, at the National Boat, Caravan and Leisure Show 2000 which began on 19 February 2001. The defendant sees the wording of the letter as an attempt to conceal from him the fact that some of the acts in question had already occurred, and he asks me to dismiss the application because of this. Having considered the submissions from both parties on this point, I am not prepared to do so. In my view this is making a mountain out of a molehill. The letter of 28 February 2000 was merely a redated version of a letter dated 18 February 2000 which was sent to an address from which the defendant had moved. The use of the word "intends" may well have been wholly correct on 18 February 2000, when the original version of the letter was first written, and insofar as it was arguably incorrect on 28 February, that arose solely from what was at worst an understandable error in not revising the original version of the letter to reflect its redating. I certainly do not believe that there was a

deliberate attempt at concealment, and the defendant's failure to notify the Patent Office of his new address was also a contributory factor. Apart from that, I also think it is very questionable whether there is anything wrong with the 28 February letter at all in the context of an application for a declaration of non-infringement. In his submissions the defendant kept looking at the proceedings as though they were an infringement action, and I suspect that may explain why he raised this point. However, this is not an infringement action, and the date on which the claimant first put its product on the market is therefore of no consequence. All in all, I am not prepared to dismiss the application on this ground either.

Are the acts adequately particularised?

- 15 It is established law that in an application for a declaration of non infringement the applicant must supply adequately-detailed particulars of the acts in respect of which the declaration is sought - see, for example, *Mallory Metallurgical Products Ltd v Black Sivalls & Bryson Inc* [1977] RPC 321. The defendant considers that the claimant did not do so in the present case, and in particular details of the operation and use of its device were not explained.
- 16 I agree with the defendant. The claimant's statement simply includes photographs of the device with no explanation of what is depicted, how it is used and how the two parts are locked together. Since the claims (which I will come to shortly) include details of how the device is fitted to a towing hitch when in use and require a lock, the omission of this information is unsatisfactory. However, it is also perfectly clear to me from their submissions that the defendant, who is obviously a specialist in this field, has never at any stage had the slightest difficulty in understanding how the claimant's device works, so his protests about the adequacy of the statement in this respect ring very hollow indeed. Moreover, any doubts about how the device is used would have been dispelled by the second paragraph of the letter of 28 February 2000 seeking an acknowledgement that the device did not infringe, which explains what the openings are for and that the device is lockable. Thus the only person who has been disadvantaged by the inadequacy of the statement is me, as a non-specialist in the field of locks for towing hitches, and even I have not had much trouble working out what is going on.
- 17 Accordingly, I am not going to delay these proceedings yet further whilst I give the claimant an opportunity to amend its statement. Instead, I am going to treat the statement as though it also included the substance of the second paragraph of the 28 February letter. This, in my view, provides sufficient additional clarification for present purposes.

Admission of additional grounds

- 18 On 12 February 2001, nearly a year after his statement, the claimant filed further arguments in support of his case in the form of comments on the defendant's counterstatement. The defendant has urged me to deem them inadmissible because, in

his view, they constitute new grounds of argument. I have carefully considered these comments and have decided that, with one exception, they should be admitted. They go to matters pleaded in the claimant's original statement because they are concerned with the interpretation of the main claim of the patent and are responding to arguments submitted by the defendant. They are the sort of submissions that could quite properly have been made at an oral hearing had there been one, and making them earlier was therefore helping to focus on the issues in dispute.

- 19 The one exception are the arguments in paragraphs 20 to 22 of the 12 February document relating to a specific prior art document that was cited during the prosecution of the patent application. It is a moot point whether these arguments are, as the defendant interprets them, challenging the validity of the patent or whether they are an attempt to bring in the American doctrine of "prosecution history estoppel". Either way, however, I am not prepared to admit them. If the defendant's interpretation is right, this is a completely new ground which was not pleaded in the original statement (and which, I observe, has not really been adequately argued even now). There is, admittedly, a vague reference in the original statement to the claim being "prejudiced by the prior art" if the claim is construed in a certain way, but no specific prior art was identified, let alone any indication of why that prior art prejudiced the claim. If the alternative interpretation is right, the arguments are irrelevant since "prosecution history estoppel" has never been an accepted element in claim interpretation in UK jurisprudence. The view has always been that a third party should be able to determine the scope of the monopoly from the patent specification as granted, without having to dig through the prosecution file in case some event during prosecution can be taken to impose a different interpretation on the claims.
- 20 In short, with the exception of paragraphs 20 to 22 I am prepared to admit the arguments in the 12 February document.

Confidentiality of certain documents

- 21 I must now deal with the final preliminary point. On 29 November 2000 the defendant sent to the Office two letters dated 31 March and 19 April 2000 respectively which are marked "without prejudice". He did so to refute what he saw as an allegation by the claimant that he had made no attempt to settle the dispute out of court after the application for a declaration of non infringement had been filed. I pause to observe that whilst "without prejudice" communications are normally inadmissible as evidence, they can be admissible in order to establish that such communications took place. Seven weeks later, on 16 January 2001, the claimant asked for these letters to be excluded from the public part of the file. It did not refer to any legal basis for this request, but I shall construe it as a request for directions under rule 94(1) of the Patents Rules 1995. The defendant resists the request.
- 22 Rule 94(1) reads:

"A person filing at, or sending to, the Patent Office, a document other than a Patents Form, or any party to any proceedings to which the document relates, may, within fourteen days of the filing or sending of the document, request the

comptroller (giving reasons for the request) to direct that the document or any part of it specified by him be treated as confidential, and the comptroller may, at his discretion, so direct; and whilst the request is being considered by the comptroller, that document or part thereof . . . shall not be open to public inspection.”

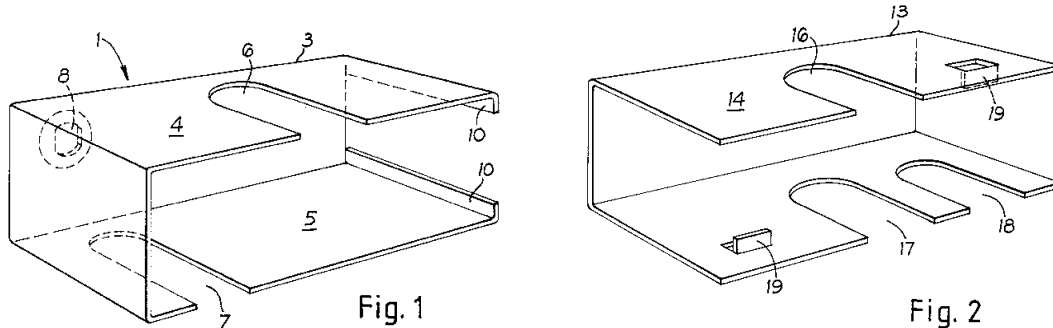
This rule is complemented by rule 93(4)(a), which provides that no document shall be open to public inspection until 14 days after it has been filed.

- 23 The defendant argues that the request was out of time, and points out that by the time it was made the documents had already been open to inspection for five weeks. I also observe that the claimant did not give any reasons for its request. On their own, I do not regard these points as inevitably fatal to the request - time limits can be extended, and the claimant will doubtless argue that the reason for the request is implicit from the “without prejudice” markings on the two letters - but there are other factors. Having looked at these letters, I think it is doubtful whether they really fall in the class of privileged correspondence, notwithstanding their markings, since they do not seem to me to be part of a genuine attempt to settle the dispute. Indeed, they contain nothing that has not already been mentioned elsewhere on the file. Moreover, the fact that the author of these letters has no objection to their being public carries some weight.
- 24 At the end of the day, these letters are at best of marginal significance to the present proceedings. However, I am mindful of the general rule that documents on the Office’s patent files should be open to public inspection unless there is a good reason for not doing so. Having weighed up all the factors, I decline to make a direction under rule 94(1). Accordingly, I order that these documents now be returned to the public part of the file.

The patent

- 25 Having dealt with these preliminary issues, I can now turn to the substantive issue of whether the acts in question constitute an infringement of the defendant’s patent. I will start by looking at the patent.
- 26 As I said at the outset, patent number GB2257100 relates to a security device for preventing the unauthorised use of towing equipment. The device is intended to be attached to a trailer hitch, e.g. of a caravan, and optionally also to a towing bar of a vehicle, so that the trailer cannot be attached to a vehicle or, if it is already attached, cannot be detached from it. The device incorporates a lock so that it can only be removed by an authorised person.
- 27 The preferred embodiment is best illustrated in figures 1, 2 and 5. Figures 1 and 2 show the two main parts of the device, and figure 5 shows them locked together on to a trailer hitch whose handle is shown at 52. The device comprises first and second parts in the form of complementary outer and inner bodies 3 and 13 respectively. The inner body 13 may be slidingly received within the outer body 3. The outer body is said to be “constructed as a hollow rectangular box having a minor end face and an adjacent major side face removed”. The inner body is said to be “constructed as rectangular

hollow box having both minor end faces and a connecting major side face removed". The outer body has two recesses 6,7 on opposed faces 4,5, and the inner body has three recesses 16,17,18, two in one face 14 and one in the opposite face 15. The positions of the recesses are illustrated in the accompanying drawings.



- 28 In use, the inner body 13 can be engaged with the outer body 3 with the recesses 6 and 17 in register. In this configuration, the device can secure a hitch which is not attached to a tow bar. The hitch is confined between the inner and outer bodies with the hitch handle 50 protruding through the recesses 6,17 as seen in figure 5, and the inner and outer bodies are locked. Once locked, the hitch socket 54 is inaccessible to an unauthorised party. In a second configuration, the device can be used secure a hitch to an associated towing bar. In this case, the inner body 13 can be engaged with the outer

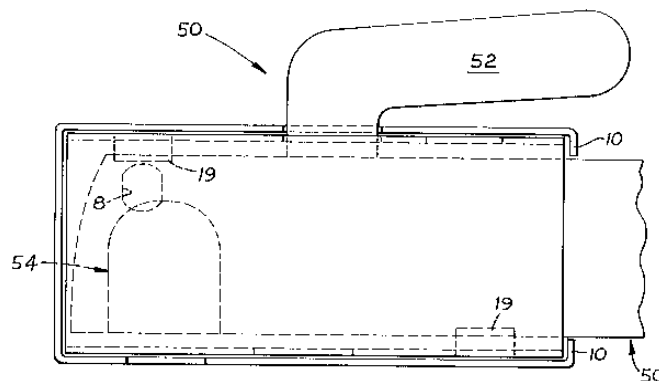


Fig. 5

body 3 with the recesses 6 and 16 in register. In this configuration, the recesses 7 and 18 are also in register and form an aperture through which the neck between the towing bar and towing ball passes.

- 29 In both configurations, the inner and outer bodies can be locked together by the use of a mechanism (not shown) which is received in an aperture 8 in the outer body and which has a locking member engageable with one of two flanges 19 of the inner body.

- 30 Claim 1 of the granted patent reads:-

“A device for preventing the unauthorised use of towing equipment, the device comprising:

a first locking box including a first side; a second side spaced from the first side; a further side connecting the first and second sides; and a first recess opening at an edge of the first side remote from the further side, the first locking box being adapted to receive a first item of towing equipment between the first and second sides such that a member thereof passes through the first recess;

a second locking box co-operable with the first locking box to close off the first recess and thereby form a first aperture, and also to confine the item of towing equipment with the first locking box; and

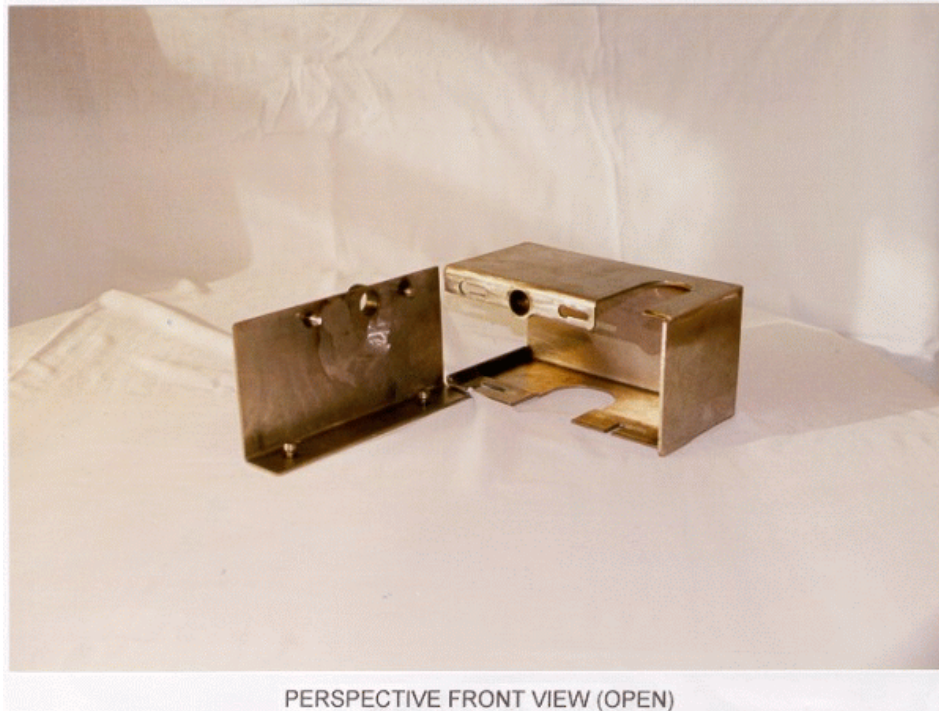
a locking means operable to lock the first and second locking boxes together thereby to lockingly confine the first item of towing equipment within the first locking box.”

- 31 Of the remaining claims, claims 2-4 are dependant on claim 1 and include all its features, and claim 5 is an omnibus claim. I can confine myself to claim 1 for the moment.

The claimant's device

- 32 The device in respect of which the claimant seeks a declaration of non-infringement was illustrated in a set of photographs attached to the statement, one of which is reproduced below. In the claimant's letter of 28 February 2000 to which I have already referred, it says that the device is to prevent the unauthorised use of an item of towing equipment, and when closed and locked includes two openings which can accommodate a part of the hitch handle and a part of the towing ball, respectively. The letter also says the device operates in a similar fashion to the device illustrated in the patent. The claimant stated that he “intends to make, dispose of, offer to dispose of and use in the U.K.” the photographed device.
- 33 It will be noted from the photograph that the claimant's device consists of two parts. The one on the right has two slots, one of which receives the hitch handle and the other of which - if the trailer is actually hitched to a vehicle - receives the neck between the towing bar and the towing ball. It is therefore very similar to the body 3 of the preferred embodiment in the patent specification. The one on the left, however, is essentially just an L-shaped member. Although not very clear in the photograph as reproduced here, it has mushroom-headed projections which engage in slots in the right hand part. Clearly when the two parts are engaged and locked together (by means unspecified), the towing hitch and - if the trailer is attached to a vehicle - the tow ball will both be securely contained within the device, just as they are in the patented device.

Does the claimant's device infringe?



- 34 This question really boils down to one key issue: do the two parts of the claimant's device constitute "boxes" within the meaning of claim 1? That depends on the interpretation of the claim. I do not think there is any real dispute that the claimant's device includes all the other features of claim 1, so I do not need to spend time going through the claim identifying each of the other claimed features in the claimant's device.
- 35 The claimant argues that, in the case of the outer body and the inner body, the description of the patent specification uses the word "box" in a manner consistent with an understanding of a "box" as a six-sided container. For example, the description states that "the outer body 3 is constructed as a hollow rectangular box having a minor end face and an adjacent major face removed". Also, "the inner body 13 is also constructed as a rectangular hollow box having both minor end faces and a connecting major side face removed". It then appears to argue that in claim 1, "box" should be construed in the same way as in the description, i.e. as a six-sided container, and that on that basis, its device includes neither a first box nor a second box.
- 36 I do not agree with this argument so far as the first box is concerned. The photographs of the perspective views of the claimant's device in the open state show a four-sided box which is very much the same in construction as the outer body 3 illustrated in figure 1 of the patent in suit. Using the description and drawings to interpret claim 1, in accordance with section 125, it follows that "first locking box" in claim 1 must be construed as embracing a four sided box (or, if you prefer, a six-sided box with two sides missing) since this is what is actually described and illustrated. It necessarily follows that the claimant's device also has a "first locking box". In relation to the "second locking box" of claim 1, however, the second part of the claimant's device has

only a single side and a small flange. On the claimant's interpretation of the word "box" as a six-sided container - albeit allowing for the fact that some sides may be missing - this member clearly does not constitute a box. There is just no reasonable way of stretching this definition of a box to include merely two sheets of material joined orthogonally together at a common edge. Such an artifact is, in my opinion, not a container at all. Rather, it seems to be equatable more to the lid of the four-sided box. Accordingly, using the claimant's definition of "box", I do not agree that the claimant's device infringes the defendant's patent.

37 The defendant prefers an alternative definition of "box" taken from The Concise Oxford Dictionary. That definition is "a protective casing for a piece of mechanism" and is the tenth of fourteen different meanings of the word "box" when used as a noun. I have to say I am very sceptical about the value of dictionaries in helping to construe everyday words in a patent specification, but I will go along with the defendant's definition for the moment. On that basis, there is no doubt in my mind that both the outer body 3 of the defendant's patent and the right hand part of the claimant's device constitutes a protective casing for the towing hitch, and I note that the claimant has not disputed this point. On this dictionary definition, therefore, they are both "boxes". By the same token, the inner body 13 of the patent specification is also a "box". However, by no reasonable stretch of the imagination can it be said that the left hand part of the claimant's device is a "protective casing" for the towing hitch. The claimant's device consists essentially of one box or casing and another member which, as I have said, acts akin to the lid of the box or casing. In this respect, I note that the defendant has tried to extend his dictionary definition of a box to a housing or shield (my emphasis) for mechanical parts. The extension of the meaning of the word "box" to a shield is, I believe, unjustified. Accordingly I find that, using the defendant's definition of "box", there is no infringement by the claimant's device.

38 So far I have been looking at the literal interpretations of claim 1 offered by the two sides. However, the "second locking box" of the claim is defined in the claim to a large extent by function. Firstly it needs to close off the recess of the first box, and secondly it needs to confine the item of towing equipment in the first box. When functional requirements like these are present, it is particularly important to construe the claim purposively, following the guidelines in *Improver Corp. v Remington Consumer Products Ltd.* [1990] FSR 181. *Improver* says that the following questions should be answered:

(1) does the applicant's variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no:

(2) would this 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. And 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.

39 Taking question (1) first, as noted earlier, the second member of the applicant's device

does indeed perform the two functions required of the "second locking box" in the claim - the applicant has not disputed this. The main difference between the second locking box of the defendant's invention, as specifically embodied in his description, and the second member of claimant's device is that the three-sided locking box is replaced by what is at best a two-sided member (or, as the claimant puts it, a member having "only a single side and a small flange"). Question (1) thus amounts to whether or not this difference has a material effect on the working of the invention.

40 The defendant argues that the provision of mushroom heads on the second part of the claimant's device which cooperate with shaped slots on the first part have the same function as the side walls of the defendant's second locking box, i.e. to accurately locate the components relative to each other so that they can be locked together. The defendant also states that the movement of the mushroom heads in the slots serves the function of guiding the two components during assembly. He also argues that a secondary function of the mushroom heads is to prevent temporary separation of the two components, asserting that this function is performed by flanges 19 on the second locking box of his invention. I have to say I find that there is no suggestion in the patent that the flanges 19 provide a separation prevention function: from the description at the top of page 8 of the patent, it is clear that the flanges are part of the locking means of the device and are accurately described as "locking flanges". For his part, the claimant has said that the primary function of the mushroom heads is to prevent the attempted forced separation of the components when assembled and locked.

41 While I accept that there is a guiding and locating function involved in both the claimant's device and the defendant's invention, I do not accept that the different ways in which these functions are performed are not material to the working of the invention. I am reinforced in this view by the defendant's own submissions. First, in his counterstatement he says that "the function of the forwardly protruding walls 14, 15 of the second box 13 is to assist in the co-operation of the second locking box with the first locking box". Secondly, in paragraph 16 of a letter dated 26 March 2001 he says:

"It is important to remember that in use the Device of the patent and (we assume) the Applicant's device are deployed at low level (typically only a short distance above the ground), in an awkward location and such that some parts of the Device are obscured. It is therefore helpful that the first and second locking boxes are capable of being readily guided together by "feel"."

Whilst he was making these comments to support an argument that the "second locking box" did not have the same function as the first box and therefore should not be construed in the same way, they highlight the fact that the way the two components are put together is an important feature, and in my view the way the two parts of the claimant's device are put together is quite different from the way the two parts of the claimed device are put together. Moreover, the function of the mushroom heads in preventing temporary separation of the components is not to be found in the defendant's invention. Considering the description of his invention in his patent, his use of a U-shaped second locking box is also concerned with allowing the parts to be put together in two different ways so that the device can be used with the trailer both hitched and unhitched, though I accept this feature does not appear in claim 1. Thus there are

material differences in the working of the claimant's device when compared with that of the defendant. The answer to question (1) is therefore Yes.

- 42 Since the answer to question (1) is Yes, I need not consider questions (2) and (3). However, in case I should later be found to be wrong on question (1), I have to say I consider the answer to the third *Improver* question would have been Yes anyway. The description in the defendant's patent of the components being "constructed as a hollow rectangular box having a minor end face and an adjacent major side face removed" and "constructed as a rectangular hollow box having both minor end faces and a connecting major side face removed" encourages a skilled reader to adopt a somewhat narrower interpretation of the word "box" than that for which the defendant has argued. This is reinforced by the fact that the claim does not shrink from using the general term "member" in relation to part of the towing equipment but deliberately chooses to use the more specific word "box" for the two main parts of the device. Thus I consider that, even if a reader skilled in the art had understood that strict compliance with the primary meaning of the term "box" was not an essential requirement of the claim, he would not have been led to the very wide construction put upon the term by the defendant.
- 43 There is one other point I must mention. Claim 1 requires a "locking means". There was a small debate in the correspondence about whether the position on infringement was different if the claimant sold his device without the lock fitted. In the end I don't think the claimant was suggesting it would be, and in my view that must be right. All that really matters for the claim is that the device is lockable, and the claimant's device is.
- 44 I have therefore concluded that the claimant's device, whether provided with or without a lock, does not infringe claim 1 of the defendant's patent. I have not so far considered claims 2-5, and the defendant was given leave to defer making submissions on these claims until the position on claim 1 had been resolved. However, in view of my finding on claim 1 I do not think there can be any argument about the position on claims 2 to 5, and there is therefore no point in my giving the defendant an opportunity to make submissions. Since claims 2-4 are appendant to claim 1 and fall wholly within its scope, there can be no infringement of these claims if claim 1 is not infringed. Claim 5, being an omnibus claim limited to a device constructed, arranged and adapted to operate substantially as described in the defendant's patent with reference to the drawings, likewise cannot be infringed.

Conclusion

- 45 I therefore allow the request by the claimant for a declaration of non-infringement of patent number GB2257100B in the name of the defendant. I declare that the manufacture, sale, offer for sale and use of a device as represented in photographs accompanying the claimant's statement, for use as described in the second paragraph of the letter dated 28 February 2000 sent by the claimant's agents to the defendant, does not constitute an infringement of patent number GB2257100B.

Costs

- 46 The claimant has won and is therefore in principle entitled to a contribution towards its costs on the comptroller's usual scale. As these proceedings were launched before 22 May 2000 it is the "old" scale, reproduced in Annex B at [2000] RPC 603, that applies. However, there are other factors to take into account. I have deplored the fact that the claimant launched these proceedings without giving the defendant a proper opportunity to give an acknowledgement that its device did not infringe, and the defendant is entitled to the costs he incurred in having to deal with this point. I also found against the claimant, or at least had to be critical of the way it had behaved, on some of the other preliminary points too, and again the defendant is entitled to some costs in this respect.
- 47 In this connection, the defendant has drawn my attention to the comments of Mr Justice Neuberger in *Liverpool City Council v Rosemary Chavasse Ltd and Another* [CH 1999 No 02528] in relation to the Civil Procedure Rules:-
- "It seems to me that when considering these sort of arguments the court should, particularly at this stage of the application of the new regime and the new rules on costs, grasp the opportunity of making it clear to litigants in general, as well as to the parties in the proceedings, that the provisions of the Civil Procedure Rules with regard to attitudes which have to be adopted and steps which have to be taken mean what they say. They are there to be observed and if they are not observed then the court will not be slow to visit the person who fails to observe them with appropriate sanctions."
- 48 The facts of that case are by no means on all fours with those of the present proceedings, and of course the costs regime in proceedings before the comptroller is rather different from that in the courts. Nevertheless I agree that Mr Justice Neuberger's comments do support the view that parties who do not conduct their cases in a reasonable way should have that fact reflected in costs.
- 49 The blame, though, is by no means all on one side. I have found against the defendant on some of the preliminary points, and he has been responsible for a lot of unnecessary work through raising and pursuing matters which have little or no direct bearing on the substantive issue to be decided. At times I have found it extraordinarily difficult to distill the essential substantive issues from the irrelevant and often caustic points scored. I have also taken account of the fact that, despite encouragement from me, negotiations to settle this matter out of court have been characterised by intransigence and have never got beyond first base.
- 50 Bearing in mind that there has been negligible evidence and no oral hearing, even if everything had run smoothly any costs award on the scale would have been fairly low. Taking account of all the factors I have mentioned above, I have decided that in the circumstances each side should bear its own costs.

Appeal

- 51 As this decision is not on a matter of procedure, any appeal should be lodged within six weeks.

Dated this 20th day of August 2001

P HAYWARD

Divisional Director, acting for the comptroller

THE PATENT OFFICE