

2006 Paper E – Commentary

Issue 1: Does the “Bat Frame” product infringe Patent A1/2?

25 marks

The conclusion was that claims 1, 4, 5 and 7 to 10 were infringed; claims 2, 3, 6, 10 and 11 were not.

The main points looked for in construing the Bat Frame were that the thigh rest was mounted on the same two radially extending arms as the knee support; and therefore both rests had a common pivot axis. Claim 1 of A2 needed to be construed to cover both the case where the first and second supports had separate pivot axes, and the case where the two supports had a common pivot axis.

The word “link” needed to be construed to include more than one component. The link in the Bat Frame has two arms extending radially outwardly from the common pivot axis as well as the “U” shaped part that is attached near either end to the distal ends of the arms.

Claims 2, 3 and 6 were not infringed because each claim had the limitation that the first and second supports needed to have separate pivot axes.

The presence of the limitations of the other dependent claims should have been fairly evident.

The omnibus claim 11 was too narrow to be infringed because of the common pivot axis.

The word “aligned” as used in claim 8 should have been construed to mean that a plane lying on the contact surface of the first support is substantially parallel to (or aligned with) the pivot axis of the first support.

Issue 2: Does the Home Gym product infringe Patent A1/2?

25 marks

The conclusion was that claims 1 to 5 and 7 to 10 were infringed; claims 6 and 11 were not.

The fine point of construction here was whether the mounting of body support member 7 on U-shaped member 8 (so that pad 7 rotates about an axis parallel to but displaced from the plane of pad 7) fits within the wording “... said frame pivotally mounting a first support ...” in claim 1. A purposive construction shows that it does.

The pivotal mounting of U-shaped member 12 is at single pair of points (lower reference # 11, 11 in Fig 1) that cannot be adjusted. So claim 6 is not infringed.

The limitations of each of the other dependent claims are readily apparent in the Home Gym product.

The omnibus claim 11 was also too narrow to catch the Home Gym product.

Copyright:

Some candidates did discuss the possibility that one or other product might infringe copyright in works owned by YSL. Marks were awarded if a candidate did recognise that there was not sufficient objective similarity between either competing product and the drawings of A2 for any such action to be contemplated. Marks were not lost if copyright was not considered.

Issue 3: Are there any grounds for attacking the validity of patent A1/2? 40 Marks

Prior use/fair basis in provisional:

The Bat Frame brochure asserts the product has been on sale since December 1995. That date is between the filing date of A1 (the provisional specification) and the filing date of A2 (the complete specification). Thus, if any claim that is infringed by the Bat Frame is not fairly based on matter disclosed in the provisional specification, it will be invalid because of the prior use by the Bat Frame.

Claim 1 has been construed to include first and second supports with separate pivot axes and with common pivot axes. A1, at lines 13 to 16 on page 2, and at lines 1 to 4 on page 3 refer to a body rest and a leg rest that are pivotal about separate axes. In the passage on page 2 the pivot axis of the leg rest is said to be below that of the body rest. In the passage on page 3 the leg rest pivot axis is said to be both below and to one side of the pivot axis of the body rest.

A1 does not expressly refer to an embodiment where the leg and body rests have a common pivot axis. But at lines 17 and 18 on page 2 it is stated that the leg and body rests can pivot independently to achieve a variety of configurations. This may imply a common pivot axis, but it is doubtful that it would pass the *Mond Nickel* test that the provisional must not be silent on the point.

Therefore, there is a good chance that claim 1 is invalid because of the prior use of the Bat Frame before the date of filing of the complete specification A2.

Anticipation by reference B

This reference discloses a body platform 58 that is mounted on a pair of arms 52 so that it is pivotal with respect to frame 10. An ankle support 90 is mounted on a frame member 70,76 on which platform 58 is mounted. As a consequence of this B teaches a first support 58 that is pivotally mounted on frame 10 adjacent its top, and a second support 90 that is pivotal with respect to frame 10 via a link 70,76. What B does not teach is that the higher position of the second support is to one

side of the second support. In figure 2 the position shown in ghost has the second support directly above the first support. While there are intermediate positions where the second support may be to one side of the second while still above it, alternatives do not satisfy the *General Tire* test for anticipation.

Anticipation by reference C

The apparatus described in this reference has a chest support cushion 42 and a platform 56 that act in use to support the chest, pelvis and thigh of a user. The combination of 42 and 56 are pivotal about axis 72 with respect to frame 10. Foot rests 34 and 'T' member 50 support the feet and calves of a user. Both 34 and 50 are linked through multiple linking components to the same pivoting axis 72 as 42 and 56. Thus reference B teaches a frame pivotally mounting a first support (42, 56) and a second support (34, 50) pivotally mounted via a link to the frame. Figure 4 shows the apparatus at the start position, Figure 5 shows the apparatus when operating, and Figure 6 shows the apparatus when the user is shifting their centre of gravity to return the apparatus to the start position. The difference here from claim 1 is that most of the second support equivalent (34, 50) is still below most of the first support equivalent (42, 56) when the apparatus is tilted to its operative position shown in Figure 5. Therefore the clear and unmistakable directions required by the *General Tire* test are not present and there is no anticipation.

Anticipation by reference D

In this reference neither horizontal body supporting member 19 nor cross piece 24 is pivotal with respect to frame 11,12 and 13. Thus there is no anticipation.

Obviousness

The difference between the inventive concept of claim 1 and reference B is that the pivoting of the second support in B is to a position above the first support. The issue is whether it would be obvious to limit that pivot to a point to one side but still above the first support. Reference C teaches pivoting so that the second support is to one side of the first support, but not clearly above it. There is not much evidence from either the discussion of the prior art in A1 or A2 that assists in determining if this would be obvious to a person skilled in the art.

The inverse analysis applies to the difference between the inventive concept of claim 1 and reference C. The second support in C pivots to one side but not clearly above the first support. There is little to assist in determining if this difference would be obvious to the person skilled in the art either.

The inventive concept of claim 2 is the combination of claim 1 with the limitation that the pivot axes of the first and second supports are spaced from one another. This limitation is not taught in any of the prior art, and, in the absence of any

other evidence that it would have been known to a person skilled in the art, claim 2 and claims dependent on claim 2 are not obvious.

Inutility

Claim 1 does not require the pivoting axes of either support to be horizontal. However, it is difficult to see how a user could successfully invert themselves if the axes had a vertical orientation. They would slide down the support. Claim 1 would be vulnerable on this ground.

Other Grounds

While it might be possible to assert minor quibbles about sufficiency and fair basis for the claims in the complete specification there are no other grounds of invalidity that are likely to succeed.

Issue 4: What can be done to improve the position of the client?

10 marks

The analysis has shown that claim 1 is likely to be invalid because of prior use of the Bat Frame. If this proves to be the case then the vendors of the Bat Frame product have a “*Gillette*” defence. If claim 1 covers a combination where the first and second supports have a common pivot axis it is invalid; if it is limited to a combination where the first and second supports have different pivot axes then the Bat Frame does not infringe.

If the Client amends patent A2 by combining claim 1 with claim 2 they are more likely to succeed in successfully prosecuting Home Gym for infringement. At the same time they would be precluding any chance of a successful action against the Bat Frame product.

Combining claims 1 and 2 would be a disclaimer narrowing the scope of the patent and would not be precluded by section 40(1). The sooner the amendment is made the better. Amendments after acceptance are discretionary. If a patentee delays making an amendment after becoming aware of the need to do so, the decision in *PDL v Jackson* means a court could refuse to allow the amendment. The amendment here, however, is not because claim 1 is potentially invalid in the light of prior art cited some years ago against the corresponding US patent; it is because the possible prior use by the Bat Frame alerted the client to the need to restrict claim 1 to the scope of claim 2. The client needs to be asked when they first became aware of the Bat Frame to see if they should have made the amendment earlier.

Combining claim 2 with claim 1 would also overcome the inutility problem by not specifying the pivot axes are horizontal.

The client also should be advised that because both the Bat Frame and Home Gym products have been on sale for a number of years, it is unlikely that they could succeed in obtaining an interim injunction.