Intellectual Property Office

BL O/754/22

02 September 2022

PATENTS ACT 1977

APPLICANT	Bibado Ltd
ISSUE	Application under section 74B for review of Opinion 10/21 in respect of GB 2528484 B
HEARING OFFICER	Phil Thorpe

DECISION

Introduction

1 In Opinion 10/21 (“the opinion”), issued 18th October 2021, the examiner was asked to consider whether the claims of GB 2528484 B (“the patent”) were novel and inventive, in light of three patent documents. It was the examiner’s opinion that claims 1-3, 5 & 6 lacked novelty over one of these documents, WO 2013/004230 A1 (“the prior art”).

2 The proprietor of the patent, Bibado Ltd (“the proprietor”), has requested a review of the opinion under section 74B. The application for review was received within the three-month period from the date of issue of the opinion, with the application being accompanied by a statement setting out the proprietor’s grounds for review and requesting that a decision be made based on the papers on file. The application for a review has not been contested.

Grounds for review

3 The grounds for a review of an opinion are set out in rule 98(5) of the Patents Rules 2007 which reads:

98(5) The application may be made on the following grounds only –

a) that the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent; or

b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

4 The nature of a review under section 74B was considered by the Patents Court in DLP Limited[1] in which Kitchen J said (my emphasis):

> *22. In the case of an appeal under rule 77K, the decision the subject of the appeal is itself a review of the opinion of the examiner. More specifically, it is a decision by the hearing officer as to whether or not the opinion of the examiner was wrong. I believe that a hearing officer, on review, and this court, on appeal, should be sensitive to the nature of this starting point. It was only an expression of an opinion, and one almost certainly reached on incomplete information. Upon considering any particular request, two different examiners may quite reasonably have different opinions. So also, there well may be opinions with which a hearing officer or a court would not agree but which cannot be characterised as wrong. Such opinions merely represent different views within a range within which reasonable people can differ. For these reasons <u>I believe a hearing officer should only decide an opinion was wrong if the examiner has made an error of principle or reached a conclusion that is clearly wrong.</u> Likewise, on appeal, this court should only reverse a decision of a hearing officer if he failed to recognise such an error or wrong conclusion in the opinion and so declined to set it aside. Of course this court must give a reasoned decision in relation to the grounds of appeal but I think it is undesirable to go further. <u>It is not the function of this court (nor is it that of the hearing officer) to express an opinion on the question the subject of the original request.</u>*

5 Hence, a review is not intended to be a second opinion on the matters presented in the opinion. Whether I necessarily agree or disagree with the examiner's opinion is also not the matter at hand in this review. Furthermore, the matter is not whether any of the parties agrees or disagrees with the opinion. What matters is whether the examiner made an error of principle or reached a conclusion in their opinion which was clearly wrong.

6 The proprietor submits that the opinion wrongly concluded that the patent was invalid to a limited extent. In particular, it is submitted that the examiner has made an error in principle and/or reached a conclusion that is clearly wrong by incorrectly construing the claims and concluding that claims 1-3, 5 & 6 of the patent are not novel in light of the prior art.

The patent

7 As the opinion explains, the patent relates to a protective garment such as a bib or apron, especially for a child. Such bibs often protect the chest and occasionally the arms of the individual but do not prevent food from falling on and around the legs of the user and on the chair in which the individual may be sitting. With reference to the figures (reproduced below), the protective garment of the invention has a lower region 12 which is arranged to cover the legs of the wearer and can also cover a chair in which the wearer is sitting. The inside of the garment is provided with a gripping region 40 that helps to prevent the garment slipping and holds it in place, by allowing the garment to grip an item of furniture about which the garment is placed.

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[1] *DLP Limited* [2007] EWHC 2669

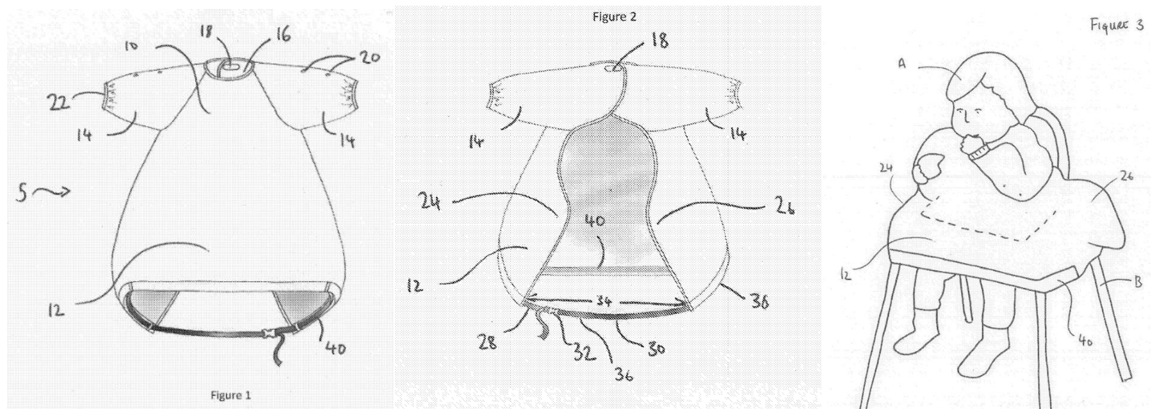


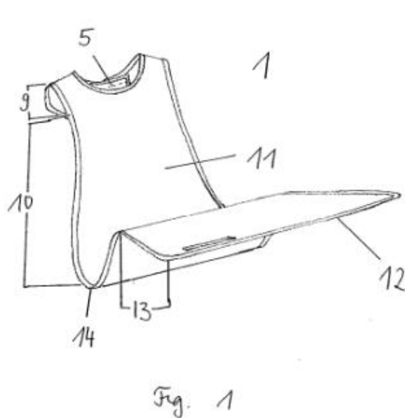
Figure 1 Figure 2 Figure 3

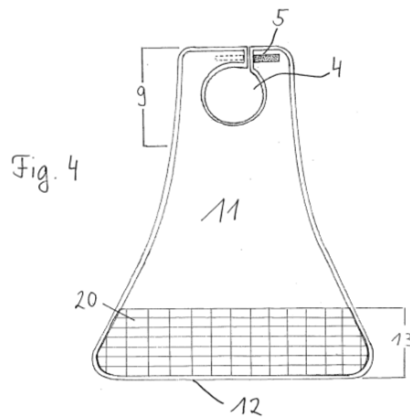
8 Claim 1 of the patent reads:

1. *A protective garment to be worn by a wearer, the garment having a lower edge, wherein the lower edge is provided with a gripping region, the gripping region comprising a strip of thermoplastic elastomer, silicone, rubber or acrylic tape arranged to provide a frictional engagement between the garment and a chair or other item of furniture used by the wearer.*

The prior art

9 The prior art concerns a child's bib. As set out in the opinion, the description regarding Fig.1 explains that the bib "is composed of a collar section 9 that can be placed around the child's neck and of a protective section 10 that extends as a surface 11 as far as the end border 12 of the bib 1". In connection with Fig. 4, "A friction-increasing means 20 extends on the underside of the protective section 10 from the end border 12 over only part of the surface 11". In this embodiment, "the friction-increasing means 20 are limited to the edge strip 13 along the end border 12, with which the bib rests on the table". Further, "this edge strip 13 is approximately as wide as the diameter of a conventional plate, or somewhat larger. During use, therefore, the plate rests on the edge strip 13 and applies weight to the latter". The prior art explains that the friction-increasing means ensures that the section of the bib extending toward the end border remains on the table or tray surface and does not slip away.





Argument and analysis

10 The proprietor does not dispute the examiner’s statement on the correct approach to claim construction nor their identification of the skilled person. I agree that there is no error here. In paragraphs 19-20 of the opinion, the examiner sets out that the claims are to be interpreted in the light of the description and drawings, notes section 125(1), highlights the precedent case law, and reaches a reasonable definition of the skilled person (which I note is not contested).

11 The proprietor submits that the approach to claim construction has not been correctly applied by the examiner, which constitutes an error in principle. Firstly, it is argued that the garments described in the prior art and the patent are “clearly different” and that the skilled person “would interpret the claim in such a way, if it was reasonable in the circumstances to do so, that would cover the specific embodiment described in the patent, but would not cover inventions which are clearly different, such as that in [the prior art]”. Further, the proprietor submits that the examiner has failed to interpret key features which are pertinent to the assessment of novelty, in particular a full construction of the term “lower edge” and of what is meant by “providing a lower edge with a gripping region comprising a strip”.

12 On this first point that the patent and the prior art are clearly different, I cannot identify any specific criticism of the examiner’s opinion that is being raised here. It is perhaps a general point aimed at drawing attention to perceived differences between the garments to set the scene for the detailed criticisms which follow. Nevertheless, it should be pointed out that the claims of the patent should not be construed with the express aim of excluding a specific prior art document from being within their scope. They should be construed with reference to the specification and any drawings, as noted above, and a view can then be taken as to the relevance of specific prior art to the issue at hand (in this case novelty). This is the approach followed by the examiner, who construes the claims in isolation of the specific prior art at paragraphs 19-28 of the opinion.

13 On the second point that certain key features have been misconstrued, the relevant passages of the examiner’s opinion are paragraphs 21-28.

Paragraphs 24 & 25 are particularly pertinent to the construction of the lower edge, its relationship with the gripping region, and the further limitation that the gripping region comprises a strip. They read as follows:

24. Regarding the ‘lower edge’, on page 2 lines 7-8 of the Patent we are told, ‘The gripping region is preferably found at or near a lower edge of the lower region’. On page 2 lines 18-20, ‘the gripping region may comprise a strip of thermoplastic elastomer or silicone tape that extends along part or all of the lower edge of the garment’. From page 5, paragraph 1 of the Patent: ‘Near to the lower edge, 38, of the lower region, 12, the garment is provided with a gripping region, 40’. There seems to be some confusion from the Patent as to whether the ‘lower edge’ refers to the ultimate edge of the garment or a region at this extreme edge. I think the skilled person would understand the lower edge in claim 1 to have the latter interpretation. This construction is supported by Fig.1 where there is seen to be a small gap between the gripping region 40 and the extreme edge of the garment. Be-baby have allowed for this gap by construing the lower edge to be a region ‘at or near’ the most distal edge. I think this is unnecessary and the lower edge is simply a region of the garment at the distal boundary of the garment. Regarding ‘the lower edge is provided with a gripping region’, the skilled person would understand this to mean that at least part of the garment that is the lower edge (as defined previously) includes a gripping region. In other words another part of the lower edge (e.g. a small gap at the ultimate boundary) may not be provided with a gripping region.

25. In claim 1 the gripping region comprises a ‘strip’. On page 2 lines 18-20 of the Patent we are told, ‘In a particular embodiment the gripping region may comprise a strip of thermoplastic elastomer or silicone tape that extends along part or all of the lower edge of the garment’. Further on page 5 lines 2-5: ‘the gripping region is made up of a strip of sticky or gripping material that helps to prevent the garment slipping and holds it in place’. This arrangement is illustrated in the Figures of the Patent where in the single embodiment the gripping region 40 is seen to extend as an elongate, continuous, piece along the garment. The skilled person would understand a strip to mean a long, narrow piece of material. The skilled person would further understand that the strip comprises a continuous, uninterrupted length of material as no other type of strip is described. The skilled person would also conclude that the ‘strip’ is a particular feature, distinct from the rest of the garment. It is not clear in claim 1 whether the strip may be of acrylic tape or whether ‘acrylic tape’ is a separate option. However, I do not think this is important as ‘tape’ will be construed in a similar way to ‘strip’.

14 Therefore, the examiner has considered the phrase “the lower edge is provided with a gripping region” by giving due consideration to the relevant passages of the description, and with reference to the drawings, to arrive at a conclusion as to how the skilled person would construe this phrase. Further, the examiner goes on to consider how the skilled person would construe the requirement for the gripping region to comprise a strip, again with reference to relevant parts of the description and drawings. I cannot identify any error of principle in the examiner’s approach to claim construction.

15 The proprietor further submits that the examiner’s incorrect construction led them to make a conclusion on the novelty of claim 1 in view of the prior art that is clearly wrong. They set out a number of detailed arguments in support of this, which build on the points considered above.

16 The proprietor broadly agrees with the examiner's definition of the lower edge in paragraph 24 of the opinion as being a region at the ultimate edge of the garment (furthest from the neck) rather than being confined to the edge itself. However, they argue that further construction of the "lower edge" is necessary, particularly in relation to the nature and extent of the "region". They submit that the patent defines a "lower region" and a "lower edge", these being distinct features that cannot be distinguished from each other without further construing the "lower edge". They suggest that an appropriate construction as to the limit of the "lower edge" is that it is "an outside boundary, portion or border, such as that formed by a seam" where border and seam are said to be features that "would be recognised as relevant by a person skilled in the art to the provision of a garment such as a bib and in view of the specific embodiment".

17 The proprietor also argues that the examiner's construction of the phrase "the lower edge is provided with a gripping region" does not provide any interpretation of how the extent of the gripping region might correlate with the lower edge. They make the following argument:

It seems somewhat ignored, or allowed to be implicitly understood, in the Examiner's approach, that the extent of the lower edge is defined by the extent of the gripping region. However, that is not what the claim states. It states that the 'lower edge is provided with a gripping region'. That requires that the lower edge is definable in itself and not solely in relation to the extent of the gripping region, but this has not been addressed by the Examiner.

18 By way of reminder, the relevant wording of claim 1 reads: "the garment having a lower edge, wherein the lower edge is provided with a gripping region". The description of the patent is rather opaque as to what exactly is meant by the "lower edge". It is only described in terms of its relationship with other elements of the garment, namely the lower region and the gripping region. Page 2 lines 7-8 state that "The gripping region is preferably found at or near a lower edge of the lower region" and page 5 lines 1-2 state "Near to the lower edge, 38, of the lower region, 12, the garment is provided with a gripping region, 40". The numeral 38, denoting the lower edge, can be seen at the bottom right of figure 2. The line accompanying the numeral and identifying the relevant part of the garment does not appear to extend beyond the ultimate edge of the garment, but I note that only so much can be gained from analysis of a hand-drawn line on a figure. The gripping region is indicated by numeral 40 in figures 1 & 2, where it is seen to take the form of a strip extending around the inner periphery of the garment. There is a clear gap visible between the gripping region and the ultimate edge of the garment.

19 The examiner's analysis in paragraph 24 of the opinion results in a broad definition of the lower edge as being a region at the ultimate edge of the garment (the phrase "ultimate edge" is used synonymously with "extreme edge" and "distal boundary" in paragraph 24). This is somewhat open-ended in that no explicit upper limit has been placed on the extent of the region that defines the lower edge. However, I do not consider that the examiner has made any clear error by defining it in this way. It was a reasonable way to

construe the lower edge that was open to the examiner in the absence of a clear and precise definition provided by the specification. Alternative ways of construing the lower edge may also have been reasonable, such as to limit the lower edge to being the ultimate edge or to being a region extending only as far as the seam, but that does not make the examiner's construction clearly wrong under the circumstances.

20 The examiner goes on to construe the phrase "the lower edge is provided with a gripping region":

…the skilled person would understand this to mean that at least part of the garment that is the lower edge (as defined previously) includes a gripping region. In other words another part of the lower edge (e.g. a small gap at the ultimate boundary) may not be provided with a gripping region.

21 Again, I cannot detect any clear error in how this phrase has been construed. The proprietor's argument that the examiner has allowed it to be implicitly understood that the extent of the lower edge is defined by the extent of the gripping region is, in my view, reading too much into the words of the examiner. It appears that the examiner is doing no more than making the point that the gripping region does not need to cover the entirety of the region that is the lower edge. This follows from the examiner's earlier analysis of the description and drawings, particularly the gap shown between the gripping region and the ultimate edge of the garment in figure 1.

22 The proprietor makes a final point on incomplete claim construction regarding the term "strip". They broadly agree with the examiner on the general meaning of the word but nevertheless consider that the phrase "lower edge is provided with a gripping region comprising a strip" has not been appropriately construed. It is argued that the construction of "strip" has been carried out independently of "gripping region" despite their nested relationship. In my view, although the examiner makes some broad initial observations about the gripping region in isolation in paragraph 22, they qualify this by noting that claim 1 specifies "what form it takes" amongst other things. In paragraph 25, the gripping region taking the form of a strip is then considered explicitly. I cannot identify any clear error here.

23 Finally, the proprietor makes several submissions on the examiner's assessment of novelty. Again, these build on the previous arguments, which I will refer back to as necessary. Firstly, they argue the following (where D1 refers to the prior art):

In applying the construction of the claims to the assessment of novelty and the reading of D1, the Examiner appears to apply a circular, self-defining argument. In D1, according to the Examiner, the lower edge it would seem is that part of the garment having a gripping region, rather than the gripping region being provided to the lower edge. The Examiner also opts to find that the end border of D1 does not need to have a gripping region comprising a strip provided to it because not all of the lower edge needs to have a gripping region according to the construction. There is a somewhat incongruous interpretation of lower edge provided with a gripping region

which does not require a significant end border to have a gripping region, but has little other limitation in its meaning. The Examiner does not address any reason or need to limit the extent of the lower edge up the length of the bib toward the collar. Thereby, it would seem that in applying the construction in this way, any amount of gripping region provided to the bib, provided that it is longer than it is narrow, would appear to meet the Examiner's application of the construction of claim 1 of the patent when applied to D1. There is no requirement for the whole of the 'lower edge' to be provided with gripping region meaning that an end border of D1 can be free of gripping region and still fall within the definition, while the extent of the gripping region according to the Examiner's application defines the extent of the border edge. This cannot be correct.

24 The examiner's assessment of novelty in view of the prior art can be found in paragraphs 47-59 of the opinion. In paragraph 48, the examiner states that the garment of the prior art has a lower edge without identifying it precisely. In paragraph 49, the examiner considers that the gripping region in its broadest interpretation is provided by the friction-increasing means 20. (I understand the qualifier of "in its broadest interpretation" to be a reference to paragraph 22 of the opinion where the examiner firstly considers the gripping region in isolation, as discussed above). The examiner then considers the feature "the lower edge of the garment is provided with a gripping region" and forms the opinion that it is anticipated by the prior art. They reach this opinion by considering that the gap between the ultimate edge of the garment and the friction-increasing means 20 (as shown in Fig. 4 of the prior art) is consistent with their construction of claim 1 that the gripping region need not occupy the whole of the lower edge region, i.e. that a gap is permitted.

25 I do not read the examiner as having equated the lower edge with the gripping region in the prior art. It is clear from the examiner's reasoning on the presence of a gap that they considered the lower edge and the gripping region to be separate features. Plainly, the garment must have a lower edge. The examiner's lack of an explicit identification of the upper limit of the lower edge in the prior art follows from their open-ended construction of the term in the patent as being a region at the ultimate edge. I have already found above that this way of construing the lower edge was not in error. The fact that the examiner has not explicitly set out what they consider to be the upper limit of the lower edge in the prior art does not mean that they have equated its upper limit with the upper limit of the friction-increasing means 20. Further, it is my view that there is no clear error or inconsistency in finding that the prior art discloses that the lower edge is provided with a gripping region even though the end border 12, i.e. "the gap", is free of the friction-increasing means 20.

26 Secondly, the proprietor submits that the examiner does not address the difference between the "lower region" and the "lower edge". They suggest that the skilled person could take the view that the prior art discloses a *lower region* provided with a gripping region comprising a strip but not a *lower edge* provided with a gripping region comprising a strip. It appears to me that this argument is linked to the previous argument that the upper limit of the lower edge has not been defined and that a failure to do so makes it

indistinguishable from the lower region. As above, I find that the examiner was not clearly wrong to reach an open-ended definition of the lower edge. Having reviewed the examiner's reasoning, I am satisfied that they have not erred by failing to explicitly address the difference between the lower edge and the lower region. There is nothing in the opinion that leads me to conclude that the examiner has confused the lower edge with the lower region.

27 The proprietor makes a related argument that the examiner has not considered the extent of the gripping region in the prior art, which the proprietor states "extends a good one-third of the extent of the bib". The proprietor then submits that "In no reasonable interpretation could a full third of the extent of the bib of [the prior art] be construed as 'the lower edge' while at the same time somehow distinguishing from 'the lower region'". The examiner considered whether "the gripping region comprising a strip" was disclosed by the prior art in paragraph 50 of the opinion. The following passage is relevant:

50. … We are told in [the prior art] that: 'It is not essential that the entire protective section of the bib is provided with friction-increasing means; preferably, the friction-increasing means extend on an edge strip along the end border.' We are told further that this edge strip is 'no more than one-third of the surface of the protective section'….

28 Thus, the proprietor's premise that the gripping region of the prior art (i.e. the friction-increasing means) extends one-third of the extent of the bib is incorrect. The prior art clearly teaches that the friction-increasing means extends on an edge strip that is no more than one-third of the surface of the protective section. In other words, it could well be less than one-third as appears to be illustrated by Fig. 4 where the friction-increasing means 20 is confined to edge strip 13 along end border 12. The examiner took account of this in their analysis and reached a reasonable conclusion that the prior art discloses the requisite strip. Further, in my view, there is nothing to support the argument that the examiner has construed a full third of the bib to be the lower edge.

29 Finally, the proprietor again highlights the differing purposes of the garment of the patent and the garment of the prior art. In particular, that the garment of the patent has a lower region for covering a chair and a narrow strip of gripping region provided to its lower edge to retain it against the chair, whereas the garment of the prior art has an extended area of gripping material to act as a non-slip place mat. As before, I cannot identify what, if any, specific criticism of the examiner's opinion is being made and I refer to my comments in paragraph 12 of this decision. I acknowledge that the garments may have different purposes but that does not preclude the prior art from anticipating the claim as construed through the eyes of the skilled person.

30 The proprietor's attacks on the examiner's construction of the invention and their application of that construction to the assessment of novelty are not persuasive. Therefore, I do not believe that the examiner has reached a conclusion with respect to the novelty of claim 1 that is clearly wrong.

31 The proprietor has not made any specific arguments in relation to dependent claims 2, 3, 5 & 6. Therefore, I understand their argument that the opinion should be set aside as regards the conclusion of lack of novelty of these claims is based solely on their dependence on claim 1.

Conclusion

32 I find that the examiner did not make an error of principle or reach a conclusion that is clearly wrong in concluding that claims 1-3, 5 & 6 lack novelty. I therefore make no order to set the opinion aside.

Costs

33 Since the application for review has not been contested, I make no order in respect of costs.

Appeal

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

Phil Thorpe

Deputy Director, acting for the Comptroller