



20 February 2009

**PATENTS ACT 1977**

BETWEEN

MeadWestvaco Corp

Claimant

and

Montreuil Offset

Defendant

---

PROCEEDINGS

Application under section 72 of the Patents Act 1977 for  
revocation of patent No GB2429969 B

HEARING OFFICER

A C Howard

---

**DECISION**

**Introduction**

1. This decision relates to an application under s.72(1)(a) of the Patents Act 1977 (hereafter “the Act”) by MeadWestvaco Corp (hereafter “MWV”) for revocation of UK patent no. GB2429969 B entitled “Packaging for digital obliquely stored discs” (hereafter “the patent”) in the name of Montreuil Offset (hereafter “Montreuil”).

**Background to the proceedings**

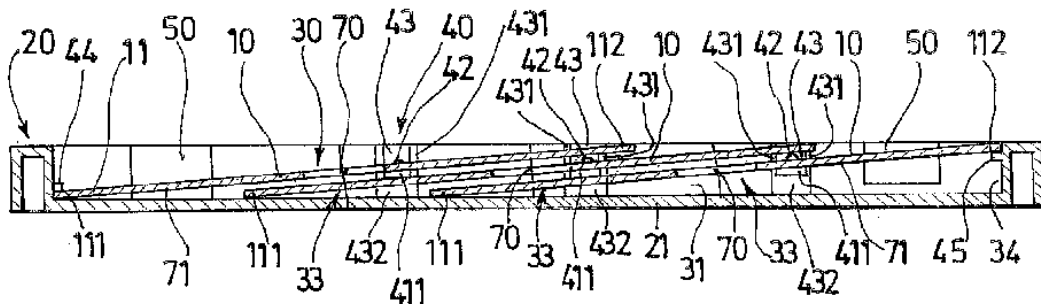
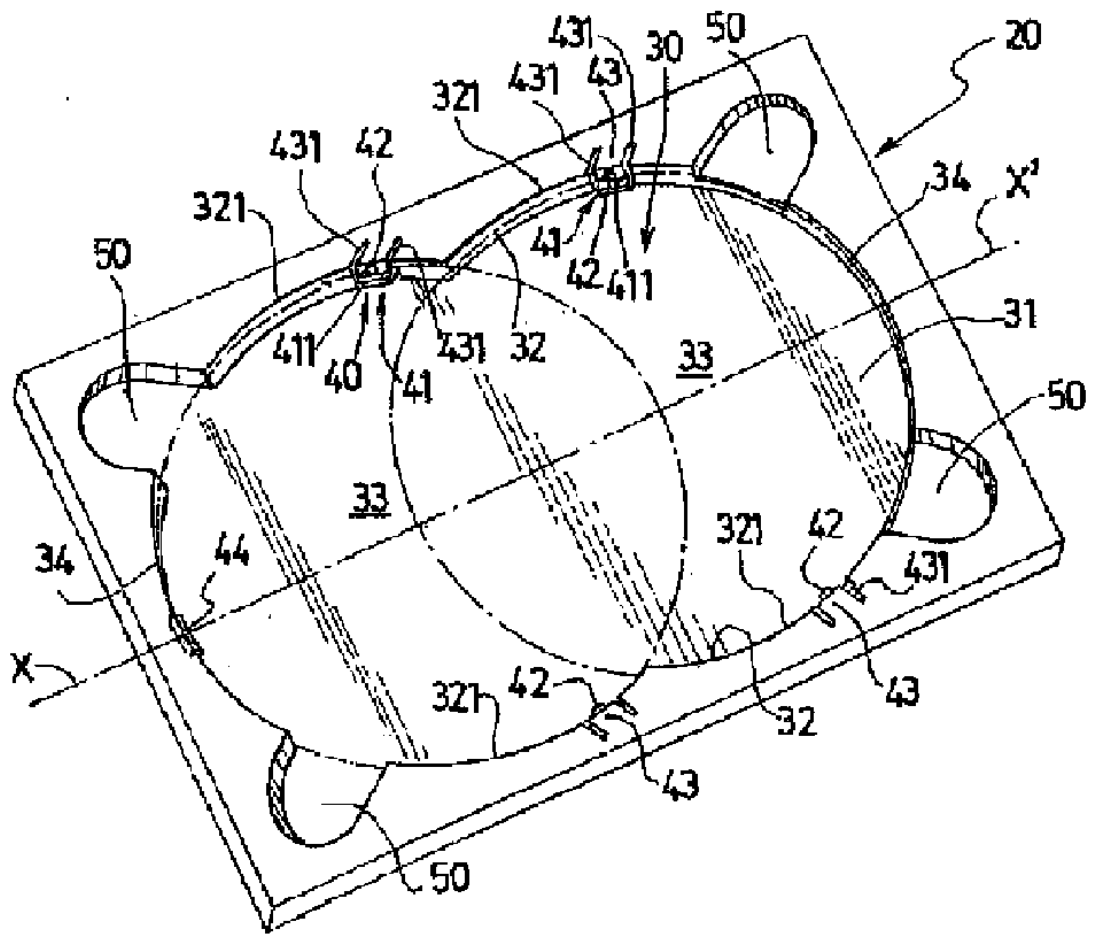
2. The application for revocation was received on 19 December 2007, which was also the date of grant of the Patent. MWV alleged that the patent was invalid for want of novelty and inventive step, and also raised grounds of added matter and insufficiency.
3. Montreuil filed its counter-statement on 19 March 2008. This was accompanied by a set of amended claims which sought to address the issues of added matter and insufficiency. The amendments offered are shown in the annex to this decision, with deletions shown in strikeout and additional text shown in bold. It was subsequently clarified in an email dated 14 April 2008 that this was a firm offer to amend the patent under Section 75 and was not conditional upon an

adverse finding on the unamended specification.

4. The proposed amendments were advertised for opposition on 25 June 2008 with no response being received.
5. An amended statement was filed by MWV which maintained that the patent as notionally amended was invalid for want of novelty and/or inventive step. The other grounds for revocation were maintained at that point but were withdrawn prior to the hearing.
6. I am content that the issues of added matter and insufficiency have been disposed of satisfactorily, and this decision is accordingly concerned only with the questions of novelty and inventive step, assuming that the amendments proposed under s. 75 have been incorporated.
7. Written evidence takes the form of statements by expert witnesses on behalf of both parties. In addition, the parties were able to compile a statement of agreed and disputed matters arising from the expert evidence which I have found helpful.
8. The matter came before me at a hearing on 8 December 2008, at which MWV were represented by Mr Hugo Cuddigan, instructed by Fry Heath & Spence LLP, and Montreuil were represented by Mr Michael Hicks, instructed by Urquhart-Dykes & Lord LLP.

### **The Patent**

9. The Patent was applied for on 17 June 2005, claiming a priority date of 17 June 2004. It describes and claims packaging in which two or more digital discs (typically CDs or DVDs) may be stored in overlapping relationship. The packaging comprises a rigid rectangular platform (20) having edges (32, 34) and a bottom (31) which may be hollow. Means are provided for holding the disks in respective oblique planes so that they overlap, in a spaced-apart arrangement. Each disk is removably held by retaining means, provided at the edges, which may (as in claim 1) comprise flexible tabs and rest-on protruding parts (40) or (as in claim 15) retaining means for removably holding each disk at two places on its periphery, whilst each disk also bears against the bottom (31). The platform may be part of a pack comprising a cover.
10. Selected drawings provided in the Patent specification are represented below.



Cross-section of version for holding 3 digital disks

11. The two independent claims (claims 1 and claim 15) are set out below, as notionally amended under Section 75:

1. Rigid platform (20), of rectangular general shape, comprising means (40) for retaining a plurality of digital discs (10) in respective storage positions, characterized in that it has a face in which a housing (30) for receiving the discs (10) is provided, delimited by a real or hollowed bottom (31), having edges (32, 34), and in that said retention means (40) are designed so as to

*removably keep each disc in respective planes oblique relative to the bottom (31) in a partially spaced manner and partially overlapping, and comprise a flexible holding tab (41) provided on a said edge, designed to hold each said disc in an oblique position, and comprising a protruding part (411) extending towards the inside of the housing (30), the size of which is chosen so that the peripheral edge (11) of the disc (10) rests on said protruding part.*

15. *Rigid platform (20), of rectangular general shape, comprising means (40) for retaining a plurality of digital discs (10) in respective storage positions, characterized in that it has a face in which a housing (30) for receiving the discs (10) is provided, delimited by a real or hollowed bottom (31), having edges (32, 34), and in that said retention means (40) are designed so as to removably keep each disc in respective planes oblique relative to the bottom (31) in a partially spaced manner and partially overlapping, said disc bearing, on the one hand, against said means at at least two points on its peripheral edge that are spaced apart, and, on the other hand against the bottom (31) of said housing.*

### **The matters at issue**

12. MWV say that at least claims 1 and 15 of the patent are not new or lack an inventive step by virtue of the disclosures of the following documents:

WO 03/058627 A1 (referred to hereafter as '627)

WO 02/067262 A1 (referred to hereafter as '262)

13. In addition, the following documents have been referred to as representative of the common general knowledge and/or in support of the allegation of lack of inventive step:

US 4676372

US 5713462

US 1303299

US 4815600

US 5333741

US 5570781

US 5791468

US 5676246

EP 1189233 A1

14. All the above documents were published earlier than the priority date of the patent.

## The law

15. The Comptroller's powers to revoke a patent on the application of another person are set out in section 72(1) of the Act, the relevant provisions of which read as follows:

### **Power to revoke patents on application**

72.-(1) Subject to the following provisions of this Act, the court or the comptroller may by order revoke a patent for an invention on the application of any person (including the proprietor of the patent) on (but only on) any of the following grounds, that is to say –

- (a) the invention is not a patentable invention;
- (b) ...

16. Also relevant is section 1(1) which defines the requirements for a patentable invention. It reads:

### **Patentable Inventions**

1.-(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say –

- (a) the invention is new;
- (b) it involves an inventive step;
- (c) ...

and references in this Act to a patentable invention shall be construed accordingly.

17. Sections 2 and 3 define what is meant above by “new” and “inventive step” respectively:

2.-(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say -

- (a) that matter was contained in the application for that other patent both as filed and as published; and
  - (b) the priority date of that matter is earlier than that of the invention.
- (4) ...

3. An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

18. The claims of a patent have to be interpreted in the light of Section 125

subsections (1) and (3) of the Act, which read as follows:

125.-(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

125.-(3) The Protocol on the Interpretation of Article 69 of the European Patent Convention (which Article contains a provision corresponding to subsection (1) above) shall, as for the time being in force, apply for the purposes of subsection (1) above as it applies for the purposes of that Article.

19. The Protocol on the Interpretation of Article 69 of the European Patent Convention reads as follows:

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

### **The expert witnesses and their evidence**

20. Both parties have made use of expert evidence in support of their respective cases. As set out more fully below, this evidence is directed to the interpretation of the teaching of a single section of one of the cited documents. Neither of the experts, in their written statements, attempted to address the issue of the common general knowledge, although some useful material in this respect came out under cross-examination.

21. It is well-established that the role of expert evidence in cases such as this is not to construe documents as such (this being for the hearing officer), but it can assist in interpreting the teaching of documents through the eyes of the person skilled in the art, for example in understanding the meaning of specialized or technical terms.

22. MWV's expert was Mr Sams. He runs a designs consultancy and describes himself as having experience since 1962 in providing design and development services in relation to a wide range of plastics-based products including medical devices and technical packaging. Under cross-examination he accepted that he has no special background however in the design of cases for CDs or DVDs, or of the market for such items.

23. Mr Sams's written evidence comprises two statements directed at the interpretation of a key passage of the '627 document. Exhibited to his first

statement is a drawing that he prepared on the basis of his understanding of the disclosure of '627. MWV rely on this to support their contention that the patent lacks novelty and/or inventive step having regard to this document.

24. Montreuil's expert was Mr Vincent. He has been employed in a number of companies in which capacity he has participated closely in the design and construction of packaging for digital discs, although he has not had direct responsibility for such activities since 2003. Mr Vincent's first language is French, and although, to use his own words, he can read and write English "reasonably well", he had been provided with a French translation of the '627 document to aid the preparation of his statement, which itself was drafted in French and translated into English. During cross-examination he was aided by an interpreter but was also able to understand and respond to certain of the questions in English.

25. Mr Vincent's statement is also directed principally at the interpreting the disclosure of '627. It focuses on the same passage as that addressed in the evidence of Mr Sams and incorporates a critique of Mr Sams's understanding of what this passage means.

26. At my request, the expert witnesses prepared a joint statement of matters on which they could not agree, which confirmed that the crux of the matter is the interpretation of the passage at lines 13-18 of page 18 of '627. To quote:

"Bernard Sams has read the patent specification and found the passage sufficiently intelligible for him to prepare a drawing of the apparatus he understands this to disclose. Didier Vincent has read this passage in combination with the rest of the description and does not find it sufficiently intelligible for him to describe the apparatus it purportedly discloses."

27. I found Mr Sams to be clearly knowledgeable in matters relating to the design of plastics articles. He responded openly and honestly to the questions put to him, for example readily accepting where the limits of his experience lay. I therefore have no reason to doubt his sincerity. However, under cross-examination, it became apparent that in preparing his written evidence he had misunderstood an important aspect of what is described in '627, and to my mind this undermines the credibility of his evidence.

28. As regards Mr Vincent, I am satisfied that he is familiar with the art concerned and is qualified to testify as to the common general knowledge at the relevant time.

### **Discussion and analysis**

29. Helpfully, the parties were able to agree on a set of elements which can be characterised as the essential features of the claims. These are as follows and I am happy to proceed on the basis of this analysis (integers common to both independent claims being referred to by the same numbers):

#### Integers common to claims 1 and 15

1. Rigid platform of a rectangular general shape, comprising means for

retaining a plurality of discs in respective storage positions  
characterised in that it has

2. a face in which a housing for receiving the discs is provided,
  - a. delimited by a real or hollowed bottom
  - b. having edges
3. and in that said retention means
  - a. are designed so as to removably keep each disc in respective planes oblique relative to the bottom
  - b. in a partially spaced manner and partially overlapping,

Integers of claim 1 only

4. and comprise a flexible holding tab
  - a. provided on a said edge
  - b. designed to hold each said disc in an oblique position
  - c. and comprising
    - i. a protruding part extending towards the inside of the housing
    - ii. the size of which is chosen so that the peripheral edge of the disc rests on said protruding part.

Integers of Claim 15 only

5. said disc bearing, on the one hand against said means at at least two points on its peripheral edge that are spaced apart;
6. and, on the other hand against the bottom of said housing.

**Preliminary matter**

30. Mr Cuddigan put it to me that Mr Hicks had gone beyond Montreuil's counterstatement by adducing arguments in his skeleton to the effect that integers 2, 3(a), 4(c)(ii), and 6 are not disclosed by '627. Mr Cuddigan submitted that this amounted to a late amendment to the counterstatement and should not be allowed. He did nevertheless submit arguments as to why he believed these elements were disclosed.
31. Rule 82 of the Patents Rules 2007 gives me wide powers over the management of proceedings, subject to the overriding objective in Rule 74 to deal with cases justly. This is defined as including, so far as is practicable—
  - (a) ensuring that the parties are on an equal footing;



- (b) saving expense;
- (c) dealing with the case in ways which are proportionate—
  - (i) to the amount of money involved,
  - (ii) to the importance of the case,
  - (iii) to the complexity of the issues, and
  - (iv) to the financial position of each party;
- (d) ensuring that it is dealt with expeditiously and fairly; and
- (e) allotting to it an appropriate share of the resources available to the comptroller, while taking into account the need to allot resources to other cases.

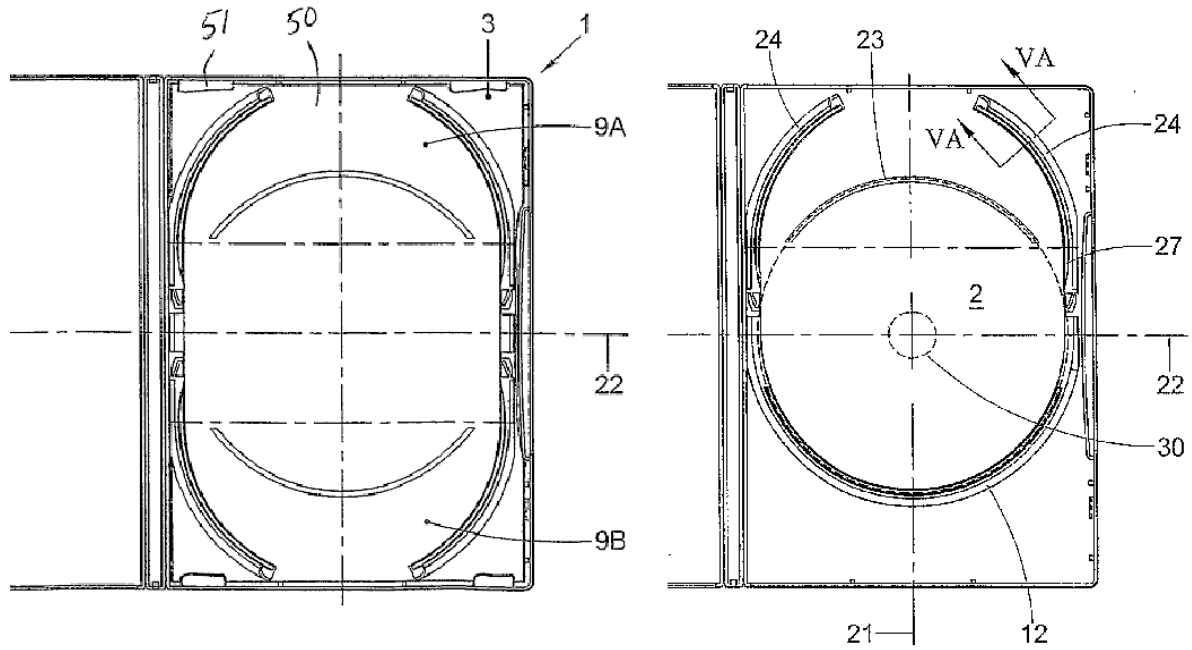
32. It is indeed true that in respect of '627, Montreuil's counterstatement (at paragraph 4.3) focuses on the retention means (integer 3) and does not mention other features. However it is stated clearly that paragraph 4.3 of MWV's statement (which is the paragraph in which the lack of novelty over '627 is alleged) is not admitted, and I take this to mean that none of the contents of this paragraph are admitted. Moreover MWV's statement itself does not set out in any detail how it is considered that the above-mentioned integers are disclosed in '627. It is only at the point of Mr Cuddigan's own skeleton that such a level of detail is reached
33. In the light of the above, I consider it wholly reasonable that Montreuil should be permitted to respond with their counter-arguments. I am satisfied that this has not resulted in either party being placed on an unequal footing.

### **Novelty**

34. Mr Hicks referred me to the well-known passage in *General Tire* [1972] RPC 457 at page 486, where it is stated that to anticipate a patentee's claim a prior publication must contain "clear and unmistakable directions to do what the patentee claims to have been invented ... The prior inventor must be shown to have clearly planted his flag at the precise destination before the patentee." To this I would add that it is necessary to put a purposive construction on the claims, interpret them in the light of the description and drawings as instructed by section 125(1) the Act, and take account of the Protocol to Article 69 of the European Patent Convention. The correct approach is to determine what a person skilled in the art would have understood the patentee to have used the language of the claim to mean.
35. As already remarked, MWV rely on two documents, although one much more heavily than the other.
36. I shall consider first '627. This discloses a "device and method for packaging platelike information carriers". Selected drawings are represented below. Some embodiments (eg fig 5) involve storage of a single disc which requires an

information carrier 2 to be laid on lay-in shoulders 24 and then slid into a lock position (as shown in fig 5) where it abuts a stop shoulder (12) and is held in place by resilient fingers and guide elements.

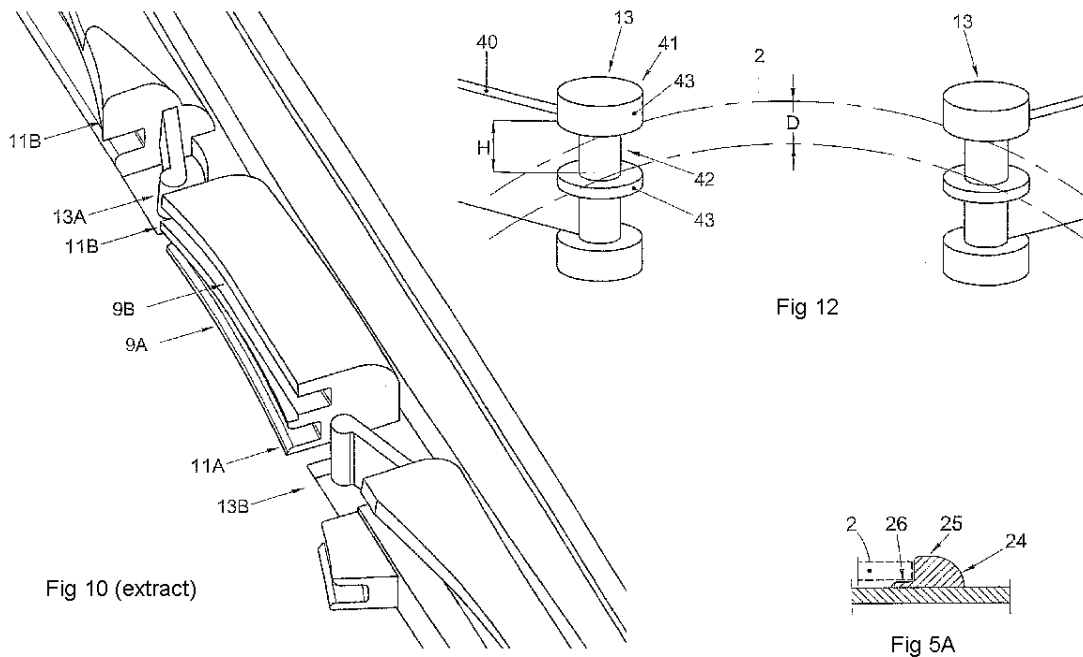
37. At least one embodiment (figs 10, 12, 15) provides storage for two information carriers. As shown most clearly in fig 15, these are slid into position from opposite directions.



'627 Fig 15 (extract)

'627 Fig 5 (extract)

38. When the disks have been slid into position, the disks are stored one above the other and are held in position by resilient elements and guides (fig 10) or by resilient elements having locking edges see (item 43 fig 12). Typically, a disk is slid into position along guides. The lower disk may be slid into its storage position through lower guide grooves. Parts of lower and upper guide grooves are shown at the top left and bottom right parts of '627 fig 10 below.
39. Fig 5A (below) shows a cross-section of a lay-in shoulder for use when a disk is placed onto the platform prior to being slid into in its stored position (as in Fig 5 above).
40. Fig 10 (below) also shows that resilient elements (13A, 13B) have a longitudinally extending portion which is typically angled towards the storage position. Due to the angle, such resilient elements have to be "pushed aside" until a disk has passed them, when removing a disk. The angle would appear to contribute to the storage position locking a disk in place.



41. It is not in dispute that '627 discloses the first (pre-characterising) part of each of claims 1 and 15. It is also not disputed that '627 discloses retention means for holding discs one above the other. Montreuil do however contend that there is no disclosure of

- a platform having a face in which a housing for receiving the discs is provided delimited by a real or hollowed bottom and having edges (integer 2);
- retention means which keep each disc in oblique planes (integer 3(a));
- flexible tabs which hold each disc in an oblique position (integer 4(b))
- the disc resting on a protruding part (integer 4(c)(ii))
- discs which bear against the bottom of the housing (integer 6)

42. I shall therefore proceed to look at each of these integers in turn.

*a platform having a face in which a housing for receiving the discs is provided...*

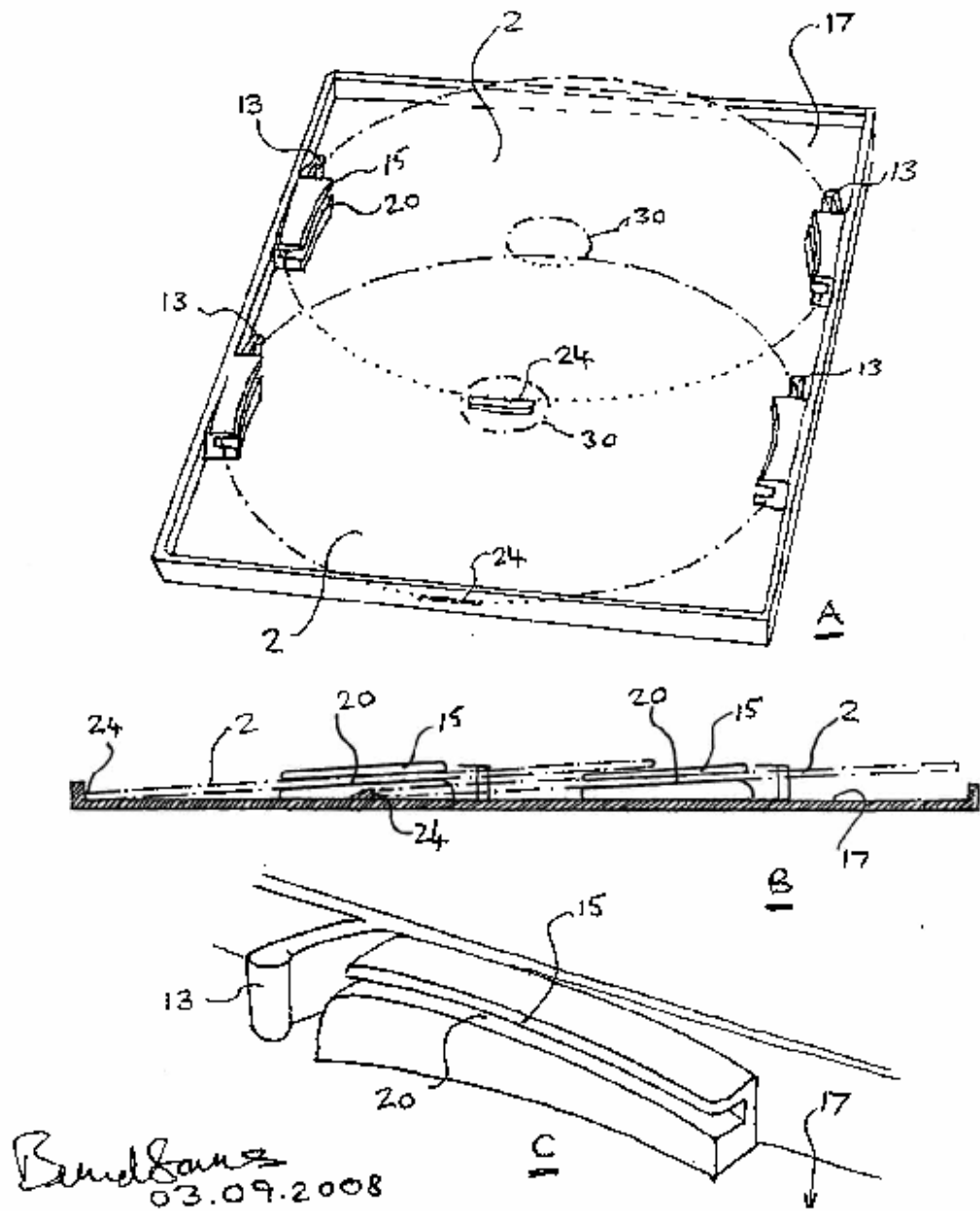
43. Mr Cuddigan submitted that the "platform having a face" is comprised by the component labelled with reference 17 in Figure 1 of '627 and the "housing" is made up of the rails, guides and stop shoulder. Mr Hicks argued that what we have is a flat surface with "various things sticking up which either guide or hold [the disc]" and this does not constitute a housing. Applying a purposive approach, I interpret "platform having a face in which a housing for receiving the discs is provided" as meaning a generally flat component having a structure in which discs can be received, and the references to a "bottom" and "edges" as requiring respectively the existence of an element approximately parallel to the disc in its

retained position and parts adjacent to the periphery of the disc. On this interpretation, the rail, guides, and stop shoulder of Figure 1 disclose this feature.

*retention means which keep each disc in oblique planes*

44. This is one of the critical features of the claim in relation to the cited art. Its meaning is I believe quite clear, but for the avoidance of any doubt I confirm that I construe it as requiring that the retention means must maintain the discs when in their position of storage in respective planes which are at an oblique angle to the plane of the platform and approximately parallel to each other.
45. In the submission of Mr Hicks, none of the embodiments discloses discs stored at an oblique angle. On the other hand, Mr Cuddigan bases his view on the passage at page 18 lines 13-18 where it is stated that

“The guide elements can be designed such that the slide-in direction to some extent includes an angle with the closing face 17 of the respective cover part, such that information carriers, while inclined relative to the cover part, can be slid into the lock position. In such an embodiment, for instance, on one cover part, two information carriers can be slid one under the other, to some extent overlapping like roof tiles.”
46. The quoted passage is an example of the sort of generalising statement frequently found in patent specifications which discusses possible modifications and alternative arrangements which would still be considered to fall within the scope of the invention. As such it has to be understood in the context of those embodiments which are described.
47. Crucial to MWV’s case is the evidence of Mr Sams, who testified that he was able to interpret this part of the description as meaning that discs could be slid into position from the same side of the case and held at an oblique angle in overlapping manner. An important question to answer is thus whether the sketch he provided is a representation of what is described at page 18 lines 13-18 of ‘627.
48. Mr Sams’s sketches (reproduced below) do bear some similarity with the embodiment illustrated in Figure 11 of ‘627 but the retention means differ, reflecting the fact that in the latter, the discs are slid in from opposite sides of the case and brought to rest overlying one another. In this interpretation the retention means would be comprised by means 15 and 20 in Mr Sams’s sketch, which relate in turn to the guide means 11A and 11B and the receiving means 9A, 9B shown in Figure 10 of ‘627.



49. It became apparent under cross-examination that Mr Sams had at the time of preparing his sketch made an error in his interpretation of '627 in that he had not appreciated that the discs of one of the preferred embodiments were slid into position and stored co-axially one above the other. Instead he had been under the impression that at least one went in slanted, and the discs came to rest in a

partially overlapping relationship. The exchange went as follows:

MR HICKS - Did you read this part of the specification?

MR SAMS - I read it. It did not seem to pertain to the area I was concentrating on page 18.

MR HICKS - You say it did not seem to pertain to it?

MR SAMS - No, I saw various elements. When I read page 18, which was the one I was specifically aiming at, it said it will be clear that the invention is not limited to the exemplary embodiments. Many variations are therefore possible. So I took the elements and built up from the description with 5.

MR HICKS - When you came up with your drawing, you had not therefore paid particular attention to this part of the specification?

MR SAMS - I looked at that part of the specification, I could see the various elements and built it up into what I believe is the true embodiment that is suggested on page 18.

MR HICKS - I am not sure I fully understand you. You are saying, when you came to understand the bit on page 18 when it was referring to two discs, you did bear in mind this part of the patent specification?

MR SAMS - I looked at it, but I did not pay too much attention because I felt page 18 dealt with it and there was overlapping.

MR HICKS - I see. You looked at it, but you did not pay too much attention to it?

MR SAMS - No.

MR HICKS - Would you just then have a look at figure 11 and see if you agree with me.

MR SAMS - Obviously, the one nearest to you is the last one to go on. This one goes in slanted and this one goes in and slides off just from looking at it.

MR HICKS - Just looking at it now?

MR SAMS - Yes, because this one is raised up closer to you and it slides on after the other one.

MR HICKS - What is your understanding of figure 11 at least as it is now, and I will take you back to it? How were the discs stored when they came to their resting part in figure 11? Do you think they are stored concentrically one on top of another like that or do you think they are stored partially overlapping?

MR SAMS - Partially overlapping.

MR HICKS - So that the edge of one is above the hole of another?

MR SAMS - Yes.

MR HICKS - It was that understanding of the way figure 11 works that helped

you understand the passage on page 18?

MR SAMS - No, I did not use that in the description I made. As far as I believe, page 18 is telling me from the embodiments, the way the two parts are held, the way they come to a stop, the way it is supported on its edge and the way the whole aspect expands to remove it. That is what I drew. It is straightforward. It is what I understood from the patent.

MR HICKS - What I am trying to understand is whether, in coming to that conclusion, you paid attention to the passage at the bottom of page 12, on page 13 and at the top of page 14 or not?

MR SAMS - As I read through it, I got a clear indication of what was happening with the discs. They were not bent at all. They were held between parallel surfaces and were slid in. The discs were then trapped in the centre by two resilient tabs. That is what I understood from all of that.

MR HICKS - They came to a rest in figure 11 partially overlapping with the periphery of one disc over the whole of the other and vice versa?

MR SAMS - That is what I understood when I first read it, yes.

50. Under further cross-examination, Mr Sams accepted that the component in his drawing which he described as a “stop” (reference 24) corresponds to a component described as the “lay-in shoulder” in ‘627 which serves a quite different function, and that he had made this mistake because he had read the arrangement illustrated in ‘627 “the wrong way round”.
51. Despite being pressed by Mr Hicks, Mr Sams denied his mistaken understanding had influenced his interpretation of the passage on page 18. He also denied ever having seen a CD case resembling the invention of Montreuil’s patent, despite being shown a physical example by Mr Hicks in an attempt to jog his memory.
52. Nevertheless, it is clear to me, and this was confirmed by Mr Sams under cross-examination, that in formulating his drawing, it had been necessary to address a technical hurdle in devising a means to hold both discs in the required position.
53. For this reason, while I am prepared to accept that Mr Sams had indeed prepared his sketch on the basis of the description at page 18 lines 13-18 of ‘627, I believe that what he came up with added to the disclosure. While the passage in question undoubtedly mentions that discs can be slid into position “while inclined relative to the cover part”, so that they overlap “like roof tiles”, how this will work in practice is not set out in any meaningful way, and in my opinion there is no disclosure of retention means which keep each disc in oblique planes. The authors of ‘627 have accordingly not “planted their flag” at this spot.

*flexible tabs which hold each disc in an oblique position*

54. It was not suggested to me that the word “tab” has any special meaning in this context. The Shorter Oxford Dictionary defines “tab” as “a short broad strap, flat loop or the like, attached by one end to an object, or forming a projecting part by which a thing can be taken hold of, hung up, fastened or pulled”. This has the clear sense of an element which is generally flattened in shape and is attached at

one end to something. Taking account of the function of the tab in the patent, and conscious of the fact that the patent draughtsman appears to have chosen this rather specific word with some care, I construe the expression "flexible tab" to cover any resilient component of this general shape which, by virtue of its flexibility, would serve to engage a disc and secure it in position against movement in normal use.

55. '627 discloses flexible means (for example the components labelled 13A in Figure 10), which Mr Cuddigan invited me to interpret as "tabs", and I accept that they are tab-like within the meaning of the way I have construed this term. However all they do is bear against the disc edge and play no part in maintaining the orientation of the disc.
56. In a different embodiment, the elements labelled 13 in Figure 12 include grooves which engage the edge of the disc rather than simply bearing against it, but these grooves are not themselves "tabs" and there is no suggestion that it is the function of these elements to hold the discs in an oblique position, or in any other particular orientation.
57. For the above reasons I do not believe that this integer is present in '627.

Integer relevant to claim 1 only

*the disc resting on a protruding part*

58. Mr Cuddigan suggested to me that the resilient element 13 of '627 is also a "protruding part" on which a disc rests and therefore meets this integer. There is no doubt that this component does "protrude" into the space occupied by the disc, so the key issue here is what is meant by to "rest on". This expression can often be understood in the sense of something lying on a surface, as for example in the phrase "the book rests on the table". However, in the CD case of the invention, an important function of the protruding part is to co-operate with other elements of the retention means to hold the disc in place. This leads me conclude that "resting on" should in this context be construed as "resting in contact with" and accordingly to inclines me to accept Mr Cuddigan's interpretation that this integer is disclosed by element 13 of '627.

Integer relevant to claim 15 only

*discs which bear against the bottom of the housing*

59. Mr Cuddigan referred me to the components which are described as "stop shoulders" in '627. These are present in all the illustrated embodiments, for example as shown by reference numeral 12 in Figure 1. At lines 16-18 of page 4, the following is stated:

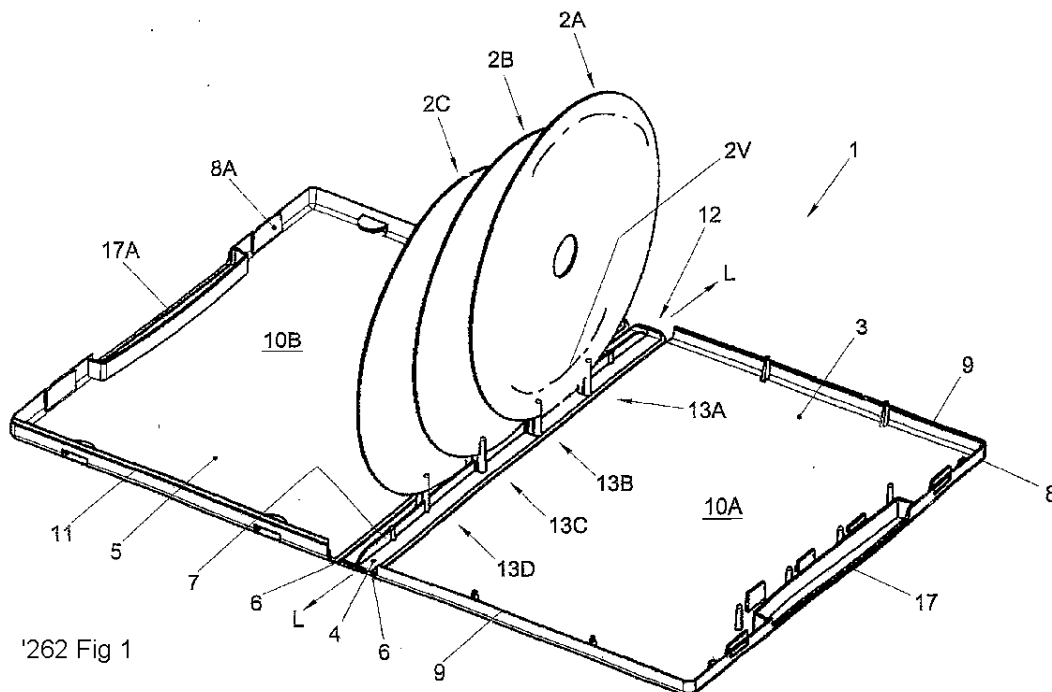
"Preferably, in the lock position mentioned, the information carrier has its outer surfaces held in a spaced relation from the cover parts, thereby preventing damages still better."

60. Mr Cuddigan's submission is essentially that because it is only in a preferred embodiment that the disc is held spaced apart from the cover (by for example the



lip of shoulder 12 in Figure 1), there is implicit disclosure of an arrangement wherein the disc is in contact with the cover (the “housing” in the terminology of the patent).

61. Mr Hicks, on the other hand, pointed out to me that none of the embodiments illustrated in '627 shows a disc bearing against the bottom of the housing. In his words, “In each and every case, the disc either rests on something like 12 in figure 1 or, as in figure 11, it ends in a circle.”
62. I have sympathy with this point of view. While the word “preferably” at line 16 of page 4 does admit of other possibilities, there is no clear suggestion of how in practice one of these possible alternatives might result in a configuration which would anticipate integer 6. The flag has not been planted at this point.
63. I accordingly conclude that claims 1 and 15 of the patent are novel having regard to '627.
64. I shall turn now to consideration of '262. Figure 1 of this document is shown below. It illustrates a CD case comprising three parts hinged together in a manner resembling the cover of a book. Disks are held by rod shaped projections (13A-13D) at the hinge (or spine) of the case. When the disk case is closed, parts of the disks generally diametrically opposite to the projections may be in contact with ridges extending from a face or edge of a cover portion of the disk case. The disks are stored so that they are spaced and overlap each other and so that they lie at an oblique angle to the cover part (3) when the disk case is closed.



65. Montreuil argue that '262 does not disclose any “platform” having “a face in which a housing for receiving the discs is provided” as well as several other of the required integers. In the submission of Mr Cuddigan, the platform feature is met by what he describes as the “base” of the package (reference 3 in Figure 1), and

the requirement for a housing is satisfied, for example, by the means shown in Figure 3 by which the discs are supported on the opposite sides to the projections.

66. In my view, '262 clearly discloses means for retaining a plurality of discs in respective storage positions, these means being provided on the storage case which is rectangular. Integer 1 is therefore met. However on the basis of my construction as set out above, I do not accept that any part of the case could realistically be regarded as having a "face in which a housing for receiving the discs is provided, delimited by a real or hollowed bottom". The "housing" in '262, to the extent that it could be regarded as present at all, is formed by the co-operation of the two opposed parts of the cover as they are folded shut, and does not exist as part of a face on a platform.
67. I accordingly conclude that integer 2 is not present in '262. Other aspects of claims 1 and 15 that depend on or refer back to this integer are necessarily not present either, and in consequence claims 1 and 15 are novel having regard to '262.
68. Having found that claims 1 and 15 are both novel, it follows that claims dependent upon these claims are also novel.

#### **Inventive step.**

69. I shall follow the test for inventive step as set out in *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588, the restated version of the well-known Windsurfing approach. In particular, I have to:
- (1)(a) Identify the notional "person skilled in the art";
  - (1)(b) Identify the relevant common general knowledge of that person;
  - (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
  - (3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
  - (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art, or do they require any degree of invention?
70. Mr Hicks in his skeleton argument referred me to several authorities including *Panduit Corp v Band-IT* [2003] FSR 8, *Technograph Printed Circuits v Mills & Rockley (Electronics) Ltd* [1972] RPC 346 and *Monlycke A.B. v Proctor & Gamble Ltd* [1994] RPC 49, to emphasise the importance of expert evidence in making a determination of inventive step.
71. I shall now apply this approach to the main claims of the patent, having regard to the two principal documents which have been cited.

The person skilled in the art

72. I take the person skilled in the art here to be a person familiar with the design and manufacture of CD and DVD cases. Mr Cuddigan identified Mr Vincent as being “a representative skilled person for the purposes of this patent” and I have no reason to disagree.

The common general knowledge

73. I mention above a number of prior art documents which were referred to by MWV, but I have heard no submissions on their relevance. I have nevertheless reviewed them and conclude that they demonstrate that, in general terms, the storage of planar articles such as optical discs in an oblique, overlapping manner is well known. One document (EP 1189233) describes a case for a single disc in which the disc is held in place by resilient means gripping the edge which bear some resemblance to the flexible tab of the patent in suit, but I have heard no submissions on the point and I have no reason to believe that the teaching of this single document represents common general knowledge.
74. The written statement of neither expert witness refers explicitly to common general knowledge, although in cross-examination Mr Vincent did refer to conventional CD and DVD storage cases in which the discs are held in place by a central boss or “rosette”. I am therefore content to take this as representing the common general knowledge at the relevant time as regards the manner of securing discs in their packaging. Both Mr Hicks and Mr Cuddigan agreed that the relevant common general knowledge did not extend to holding a disc by the edge.

The inventive concept

75. Mr Hicks suggested to me that the correct approach would be simply to construe the claims.
76. Mr Cuddigan on the other hand urged me to consider the inventive concept of claim 1 as comprising “the oblique overlapping feature and the flexible tab at the edge of the disk”. In support of this contention he referred me to following exchange during the cross-examination of Mr Vincent:

MR CUDDIGAN - Can we have a look at the patent claims. This is the list of integers that is behind Mr. Hick's skeleton, so, again, we are still working from the same document. Are you familiar with that claim, M. Vincent?

MR VINCENT - It is the claim of the patent in suit, yes.

MR CUDDIGAN - Would you agree with me that the oblique overlapped feature is the most important feature of that claim?

MR VINCENT - Yes.

MR CUDDIGAN - Yes, you would. That is found at integer number 3 on the paper there. I want you to ignore that feature. Pretend 3 is not there. Do you

think there is anything in what is left that strikes you as surprising or inventive?

MR VINCENT - Yes, the flexible holding tab is a very important point because it is the difference between the rosette that is used and this invention. So most important are the tab and the holding position.

MR CUDDIGAN - Is this right, it is the fact that you are holding the disc by the outside and not from the centre?

MR VINCENT - Yes.

MR CUDDIGAN - You are saying that is important?

MR VINCENT - Yes.

MR CUDDIGAN - I understand. Apart from that, we have the oblique stacking and we have holding the disc from the outside not the middle. I suggest that the rest of this claim is just a standard description of a CD or DVD box. You would agree?

MR VINCENT - Yes.

77. I do not believe that this approach of identifying the “most important” feature of the claim, then ignoring that and trying to identify anything which remains and is “surprising or unusual” is the correct way to identify the inventive concept. It is necessary rather to look at the claim as a whole in a purposive way and determine its essence, disregarding elements which, although they may be limiting, do not matter.
78. Here, a key point is the provision in a disc package of the type comprising a platform and housing of means which retain a plurality of discs at an oblique angle by engaging their edges. This enables them to be removably positioned and retained in an oblique overlapping relationship. In claim 1 the means are the flexible tabs and protruding parts, while in claim 15 they are the feature of bearing at at least three points including the bottom of the housing. These, then, are what I consider to be (to borrow the words of Jacob LJ at paragraph 49 of *Pozzoli*) the skilled man’s “take home messages” from claims 1 and 15.

#### The differences between the inventive concept and the prior art

79. A critical distinction the patent makes over the common general knowledge is the replacement of the “rosette” as the means of holding the discs in position. ‘627 also makes this distinction, but I have found above that although it mentions that discs can be slid into position “while inclined relative to the cover part” so that they overlap “like roof tiles”, there is no disclosure of retaining means which keep each disc in an oblique position. A further difference with respect to claim 1 relates to the absence of a flexible tab as retaining means, and with respect to claim 15, to the absence of disclosure of discs bearing against the bottom of the housing.
80. As I have found above, the other cited document, ‘262 discloses a completely different configuration in which there is no platform or housing.

Whether the differences would have been obvious to a person skilled in the art

81. There is no dispute that the nearest and potentially most relevant prior art is '627. In this respect, the submissions of Mr Cuddigan and Mr Hicks were inevitably coloured by their positions on the question of novelty. In the words of Mr Cuddigan,

“This brings us finally to differences between the prior art and the claims and in the light of what I have just said, I submit that there are none whatsoever. Even if I am wrong about that and, for example, '627 did not disclose the oblique overlapping feature, you will remember again in cross examination that M. Vincent accepted that was a standard approach which the skilled addressee would consider.”

82. I have already concluded that storing objects such as discs in an oblique overlapping matter is common general knowledge. However, the problem faced by MWV is that in the only embodiments clearly described in '627 involving storage of two discs, they are inserted and slid into parallel coaxial storage positions from opposite directions. All the evidence I have seen and the submissions I have heard suggests that it is not feasible to arrive at an oblique overlapping arrangement in this way. Thus, in order to show that the patent is obvious from the starting point of '627, one would have to show that the skilled, but non-inventive, person would be able to take the passage at page 18 lines 3-26 of '627 and from that (1) appreciate that the discs must be inserted from the same direction (notwithstanding that the reader is directed otherwise by the described embodiments) and (2) devise means for retaining the discs in an oblique position.

83. I acknowledge that Mr Sams does appear to have come up with such an arrangement, but I do believe he could well have been influenced, albeit unconsciously, by his misreading of the description of '627. It is unlikely in my opinion that a person of ordinary skill in the art of disc packaging would have derived this “teaching” from '627, and such a person would not therefore have proceeded in the same way. On balance I prefer Mr Vincent’s evidence to the effect that he found the relevant passage of '627 impossible to interpret in a meaningful way. This points me to the conclusion that the patent is non-obvious over '627.

84. I have already commented that the difference is far greater in the case of '262 and I have been offered no serious argument that this forms a realistic starting point for any consideration of lack of inventive step.

85. For the above reasons I consider that both Claims 1 and 15 of the patent as notionally amended involve an inventive step over both cited documents. It follows that all the claims which are dependent upon these claims are also inventive.

**Conclusion and order**

86. I have concluded that the patent as proposed to be amended is both novel and involves an inventive step. I therefore

- allow Montreuil's application to amend the patent as indicated in the annex to this decision, and direct that the respective clean amended pages which have been supplied by Montreuil be incorporated in the specification; and
- refuse MWV's application for revocation.

### **Costs**

87. Both sides asked for their costs, although neither made detailed submissions on this point at the hearing. I therefore assume that both parties are content for me to settle the matter on the comptroller's scale. Montreuil have won overall and are therefore entitled to a contribution towards their costs, but they did amend their patent in response to some of the matters originally pleaded, and I have taken this into account in my assessment.
88. Accordingly, I order MWV to pay Montreuil the sum of £2,000 within 7 days of the expiry of the appeal period below. Payment will be suspended in the event of an appeal.

### **Appeal**

89. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

**A C HOWARD**

Divisional Director acting for the Comptroller

## ANNEX – annotated claims showing proposed amendments

-20-

### CLAIMS

1. Rigid platform (20), of rectangular general shape, comprising means (40) for retaining a plurality of digital discs (10) in respective storage positions, characterized in that it has a face in which a housing (30) for receiving the discs (10) is provided, **delimited by a real or hollowed bottom (31)**, having edges (32, 34), and in that said retention means (40) are designed so as to removably keep each disc in **an respective planes** oblique, **position relative to the bottom (31) in a partially spaced manner and partially overlapping**, and comprise a flexible holding tab (41) provided on a said edge, designed to hold each said disc in an oblique position, and comprising a protruding part (411) extending towards the inside of the housing (30), the size of which is chosen so that the peripheral edge (11) of the disc (10) rests on said protruding part.
2. Platform according to claim 1, characterized in that each holding tab (41) is arranged to snap in the peripheral edge of a disc (10).
3. Platform according to Claim 1, characterized in that the means (40) for retaining each disc exclude any complementary means using a central rosette.
4. Platform according to Claim 1, characterized in that the housing (30) is delimited by a flat bottom (31), extending to the same level in the entire said housing.
5. Platform according to Claim 4, characterized in that the protruding part (411) extends at a distance above the bottom (31) of the housing (30).
6. Platform according to Claim 1, characterized in that the retention means (40) comprise two holding tabs (41) placed on two opposite edges (32) of the housing (30) delimiting between them a zone (33) for receiving the disc in an oblique position.
7. Platform according to Claim 4, characterized in that the holding tab (41) of the retention means (40) comprises locking means (42) for releasably locking the disc (10) in an oblique storage position, in a perpendicular direction opposite to the bottom (31) of the housing (30).
8. Platform according to Claim 7, characterized in that the locking means (42) is arranged to releasably lock the disc (10) in an oblique position.
9. Platform according to Claim 1, characterized in that the holding tab (41) is arranged so that it can be flexed towards the outside of the housing (30), and the peripheral edge (11) of the disc (10) can be released from the locking means (42).

10. Platform according to Claims 4 and 9, characterized in that the retention means (40) comprise a tab or means (44) for locking a lower part (111) of the peripheral edge (11) of the disc (10) in a direction perpendicular to the bottom (31) of the housing (30).
11. Platform according to Claim 1, characterized in that the housing (30) is divided into a plurality of zones (33) for receiving a disc (10), each zone (33) being delimited at least by two circularly arcuate segments (321) of two longitudinal edges (32) placed opposite one another, and supporting the holding tabs (41) for holding the corresponding disc (10).
12. Platform according to Claim 11, characterized in that each said zone is designed in such a way that each disc (10) is prevented from moving in a longitudinal direction (XX') of the platform (20).
13. Platform according to claim 12, characterized in that each longitudinal edge (32) of the housing is divided into a succession of circularly arcuate segments (321), to form a pointed zone towards the inside of said housing.
14. Platform according to Claim 4, characterized in that the retention means (40) are designed in such a way that, beyond them, the peripheral edge 11 of the disc 10 is free, and suspended above the bottom (31) of the housing (30).
15. Rigid platform (20), of rectangular general shape, comprising means (40) for retaining a plurality of digital discs (10) in respective storage positions, characterized in that it has a face in which a housing (30) for receiving the discs (10) is provided, **delimited by a real or hollowed bottom, (31)**, having edges (32, 34), and in that said retention means (40) are designed so as to removably keep a each disc in **an-respective planes oblique position relative to the bottom (31) in a partially spaced manner and partially overlapping**, said disc bearing, on the one hand, against said means at at least two points on its peripheral edge that are spaced apart, and, on the other hand against the bottom (31) of said housing.
16. Pack for a plurality of digital discs (10), which comprises a platform (20) according to anyone of Claims 1 to 15.