**2005 PAPER P6**
**SAMPLE SCRIPT A**

*This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.*

**CONSTRUCTION.**

***Claim 1.***

Independent apparatus claim.

1.1 *"an accessory .... vehicles"*- clearly identifies field as relating to parts for use with vehicles, where the parts are replaceable.

1.2 *"for"* = suitable for

1.3 *"comprising"* = not limited to features of the claim.

1.4 *"tubular member"* - suggests a hollow cylindrical member, however tubular is not necessarily limited to member having a constant cross-section, so it encompasses conical-shaped members, ie. ones having an internal or external surface "or both) that tapers.

Description indicates that this term encompasses cross-sectional shapes that are not circular (lines 28-30) + where the diameter can change. Furthermore, in order to cover the embodiment shown in the figures it should be construed broad enough to cover members that are only partially hollow ie  .

This construction is also required to cover the term "cup" in dependant claim 2.

1.5 *"retaining means"* = any means which can retain a tyre valve cap. Wider than "storing" because the means is merely designed to hold the cap in place long enough for its removal, so the length of time for which it has to retain the cap is irrelevant.

1.6 *"retaining + storing"* = clear meaning of retaining valve cap from tyre valve + then storing it "ie holding it) when it is removed + tyre valve is being operated on.

1.7 *"tyre valve cap"* = conventional term taking normal meaning in the art.

1.8 *"opposite end"* = ambiguous because no indication of what an "end" is. Clearly it is an end opposite the "retaining means", however such an accessory can have multiple sides + ends. Figures show the accessory being elongate + therefore having two distinct ends, however it is possible that a rounded or cuboid accessory having multiple "ends" would function the same + should therefore be encompassed by the claim. Therefore construed merely as a means to facilate rotation which is remote from the retaining means.

*"opposite end"* also not restricted by whether an additional attachment to accessory or integrally formed

because no reason in description to limit it so.

Claim also indicates that the "opposite end" is of the tubular member rather than the accessory. Overall, however if the accessory "is" a tubular member, then it should cover both possibilities.

*"facilitate rotation"* = permits rotation of the tubular member + therefore the retaining means.

*"by reducing ... when removing the valve cap"* = clear from description, however reduction of torque not necessarily over whole of period of removal of valve cap ie may change from initial twist to unstick valve cap, to final twisting to remove cap from valve.

***Claim 2***

Dependant on claim 1.

2.1 *"cup"* = indicates a hollowed out cavity within the retaining means. Definition of cup generally requires it to be only partially hollow, ie. requires a base to retain contents, however as cap is retaining by means of frictional association with side walls of retaining means, then the retaining means comprising a "cup" would function equally well if it was hollow throughout. Therefore, on purposive construction, it should be interpreted broad enough to cover both possibilities.

2.2 "*internal taper"* = internal cross-section diminishes in diameter. Cross-section need not be uniform. Taper is generally directional: + figures suggest it tapers with the widest part being nearest the opening for the valve cap, however its conceivable that could work in opposite direction.

2.3 "*plurality"* = more than one.

2.4 "*spaced ridges"* = raised portions with gaps between them.

2.5 "*diverging outwardly"* = diverging in line with direction of taper + towards opening for valve cap.

2.6 *"respective end"* = not clear from claim, however construed to mean the open end of the retaining means which receives the valve cap, because this is the "outward" end from the figures.

2.7 "*gripping + retaining surface"* = clearly a surface that can grip the cap + retain/hold it in place for removal due to frictional association.

***Claim 3***

Dependant on claim 2 only.

3.1 The axis referred to, in order for the claim to make sense, = longitudinal axis.

Figures also clarify this.

Otherwise claim is clear from description for person skilled in the art.

***Claim 4.***

Dependant on claims 1 - 3.

4.1 "*opposite end"* is construed as in para 1.8 for it to have an antecedent.

4.2 *"of greater diameter"* ie. greater than retaining means end of accessory. As knurled surface is on "exterior" of this end, it would be sensible + reasonable for the diameter referred to be the external diameter.
4.3 *"knurled"* = formed with irregularities ie. not smooth.

4.4 *"to allow .... gripped + rotated"* = clear ie. to be gripped by user so they can rotate tool.

***Claim 5***

Dependant on claims 1 to 4.

5.1 = end opposite to retaining means (see para 1.8) should have a portion which diminishes in size enough to fit into tyre valve ie pointed end is required.

***Claim 6***

Dependant on claims 1-4 only.

6.1 opposite end to retaining means of claim 1 (para 1.8) is also suitable for performing same function as retaining means. Indicates accessory can be double ended (with two similar ends) instead of having one end for entering the tyre valve.

***Claim 7***

Dependant on claims 1 to 6 in so far as the kit claimed comprises a tool of claims 1 to 6.

7.1 *"vehicle .... kit"* = clearly a kit containing accessories for vehicles - field is same as claim 1.

7.2 *"conventional .... cap"* - ie. cap well known in art already or those not devised yet. Lines 64 - 66 provides examples of such caps.

7.3 *"accessory"* - according to previous claims.

7.4 *"specially adapted"* ie. retaining means is shaped to fit + cooperate with conventional or designer cap.

**Infringement**

- of GB patent by clients proposal

***Claim 1.***

Clients device is clearly an accessory for a vehicle. It is considered to comprise a "tubular member" because this was construed as indicating a hollow portion that is not necessarily hollow throughout (to cover cup) and the base portion 1b of the clients device is "generally cup shaped" (line 24) which falls within this construction.

The cup shaped base has a tapering internal diameter + external diameter however "tubular" was also construed in para. 1.8 as not being limited to having a constant cross-section. This feature of claim 1 is therefore in the clients proposed device.

This base portion (1b) is also formed with gripping ribs (1f) so it acts to retain the valve cap in position so that it can be removed. Even though not explicitly stated in the clients proposal, this retaining means can

also be used to retain the cap within our construction. Indeed the clients letter indicates that this is a problem with the prior art to be overcome with the device (lines 14-15).

The clients device also has an end remote from the retaining means "and therefore within our construction of "opposite end") which is formed with longitudinal serrations (1d). It is therefore adapted to facilitate rotation so falls within the scope of claim 1 as construed.

The clients device permits variable torque to be applied (greater or smaller). Further, the fact that the base portion is wider diameter than the valve cap will mean the less torque is "required" to rotate the tubular member at first compared to without the tool being used.

As the construction isn't limited to the initial twist or final rotations, the variable torque permitted is encompassed by the reduced torque required.

As all the features of claim 1 are covered in the clients proposed device, this device infringes claim 1.

***Claim 2.***

The base portion (1b) is cup shaped + so clearly falls within the scope of the "retaining means comprising a cup" as construed because our construction covered a partially hollowed out (as in clients device) or fully hollow retaining means.

The internal diameter of the base portion diminishes + therefore falls within our construction of "internal taper".

It also has a "plurality of spaced ridges" because it has more than one raised portions (gripping ribs 1f) that have gaps between them. These diverge outwardly (from fig 2) in the direction of the taper (+ therefor conform with our construction) and towards the open end of the retaining means which receives the cap. This is within our construction of "respective end" despite this term being unclear because it is construed as the open cap-receiving end.

The clients device is provided with four equally spaced gripping ribs (1f) which grip onto the valve cap (lines 30-33), which clearly provides a gripping + retaining surface within our construction because they grip + retain the valve cap for removal.

As all features of claim 2 are present, claim 2 is infringed.

***Claim 3.***

The internal surface of the retaining means "cup-shaped portion 1a) is inclined at about $10^{o}$ to the axis shown in fig 1, which is the longitudinal axis + therefore within our construction so claim 3 is infringed.

***Claim 4.***

Isn't infringed because the opposite end to the retaining means (1a) doesn't have a greater external diameter than the retaining means. Therefore all the features of claim 4 aren't present = no infringement.

***Claim 5.***

The opposite end of the device to the retaining means is adapted to be inserted into a valve of the tyre + falls within our construction because it forms a pointed end (1k) (fig 1) (lines 45-46).

Claim 5 = infringed in so far as it is dependant on claims 1 to 3 only.

***Claim 6***

The opposite end forms a point (1k) + therefore isn't suitable also for acting as a retaining means for retaining + storing a valve cap, therefore claim 6 is <u>not</u> infringed.

***Claim 7***

Is infringed because the client proposes a kit of vehicle accessories that comprises either conventional valve caps or specially designed valve caps (lines 48-51). It also comprises the accessory of claims 1 to 3 + claim 5, the accessory being specially adapted to cooperate with the valve caps within our construction because the retaining means is shaped to fit + cooperate with them.

Claim 7 = infringed in so far as the accessory is the accessory of claims 1-3 + 5.

**Validity.**

Relevant prior art =

Pliers cited in Doc. D aren't relevant because not comprising a tubular member

***Claim 1.***

Isn't anticipated by the bottle cap remover (Doc C) because this isn't suitable for use with vehicles. In this respect car valves, even the valves of larger vehicles such as lorries, are significantly smaller in size than the bottle tops + the internal dimensions of the bottle cap remover would be far too large to engage a valve cap for its removal.

It also doesn't have an "opposite end" within our construction, ie one remote from the retaining means.

As all the features of claim 1 aren't disclosed, it isn't anticipated by Doc C.

It is however anticipated by Doc D because this is an accessory suitable for use with vehicles that discloses a tubular member within our construction because the body of the tool in D is hollow throughout, which is one of the interpretations within the scope of our construction. Also, the internal diameter changes at certain portions because its conical + is constant in other portions, all of which fall within our construction because the tubular member can have differing cross-section.

The front part (3) also has teeth (6) + therefore serves as a retaining means because it retains the valve cap in place for removal + also possible storage (even though this isn't explicitly disclosed).

The opposite end, ie. that which is remote from the retaining means is suitable for facilitating rotation because even though its smooth it is larger in diameter than a valve cap so can be more easily gripped, thus reducing the torque required for removal of the valve cap.

All features disclosed = anticipated by Doc. D.

Claims 2 - 7 are novel over Doc C by virtue of their dependance on claim 1.

***Over Doc. D.***

Claim 2 is also anticipated because all claim features are disclosed ie. "cup" was construed to cover a portion that was hollow throughout, so the front part (3) is covered. It also has a conical interior surface so tapers (line 56) + has teeth (6) with spaces in between which falls within our construction of "spaced ridges".

Claim 3 is novel because the tapered angle in Doc. D is 1-5$^{o}$ (line 53), not 10-20$^{o}$.

Claim 4 is novel because the exterior of the "opposite end" (ie that remote from the retaining means), has a smooth surface so is not formed with irregularities + is therefore not "knurled" within our construction.

Claim 5 is novel over Doc. D because the end remote from the retaining means is not adapted to be inserted into a valve.

Claim 6 is novel over Doc. D because even though the "opposite end" is suitable for storing a valve cap it isn't suitable for retaining one.

(Para 8.)

Claim 7 isn't anticipated because Doc. D doesn't disclose a kit, however if the accessory in Doc. D was sold with conventional valves (or otherwise) then claim 7 would be infringed by that retailer in so far as it is dependant on claims 1 + 2. Also a person using the tool in Doc. D may also be considered to infringe, and therefore a person selling just the tool could be considered a contributory infringer because they are providing means for putting an essential part of the invention into effect, especially if the provided instructions for use with conventional valves, + a box, for example, to keep them in. As the tests for infringement + novelty are essentially the same, the client may therefore have a squeeze argument in view of Doc. D if action was taken against them for alleged infringement of claim 7.

**Inventive Step**

***Claim 1*** wouldn't be obvious over the disclosure in Doc. D alone because it is in a different technical field, ie. bottle openers, however it does disclose a tubular member having a retaining means suitable for retaining + storing .... something (ie. bottle top). The other end is used to grip + twist the device so arguably all the other features of claim 1 are present, therefore claim 1 is arguable lacking inventive step over Doc. C. if it was combined with Doc. D because this may provide the motivation for a person skilled in the art to reduce the size of Doc D so its suitable for use with a vehicle valve cap.

However, I don't consider that Doc. C by itself renders claim 1 obvious, or that a person skilled in the art (ie in the field of vehicle accessories) would combine the teaching of D with C because they're in different technical fields + one document does not reference or teach towards the other so there would be no cause for combining them.

In the event that a court considers otherwise however, a combination of Docs C + D would be considered to render claim 1 obvious.

***Claim 2 ....***

includes the additional features of a "cup" shaped retaining means having an internal taper with spaced ridges. Cup was construed as including a completely hollow portion, therefore the bottle opener of Doc. C incorporates all the features of claim 2, only that its not suitable for use with a vehicle. For the reasons in the preceding paragraph therefore it would be considered obvious over a combination of C + D if they were combined, however I don't consider that they would be because the technical fields are so divergent,

+ in this case Doc. C itself would not render claim 2 obvious because no motivation is provided to rescale it + use it in the vehicle industry.

**Claim 3** is not obvious for the same reasons as claim 2, however if the documents were combined, then it would be obvious because $14^{o}$ in Doc. falls within $10\text{-}20^{o}$. Claim 3 isn't obvious over Doc. D alone either because $1\text{-}5^{o}$ is substantially different to $10\text{-}20^{o}$ + nothing in Doc D is provided to motivate a person skilled in the art to increase the angle of taper. Therefore even though they could, its unlikely they would change it.

***Claim 4*** = obvious over D because the only difference is that the outer surface is smooth + I consider it obvious to a person skilled in the art to make it rough or "knurled" in order to increase grip.

***Claims 5 + 6.***

= neither additional features

= obvious because too far removed from patent + no motivation to change prior art.

$\therefore$ = inventive.

***Claim 7*** = obvious because all features are disclosed by Doc. D in use other than that its sold as a kit, so selling device of Doc. D with valves would be obvious to do + also obvious to try.

Advice to Client:-

Summary of infringement by the cap removal device:-

**Summary.**

Claim 1 is infringed, and is anticipated by Doc D but not Doc C. It involves an inventive step over Doc. C, Doc. D + a combination of them because I don't consider they'd be combined, however in the event that a court would consider to combine them, then claim 1 would be rendered obvious.

Claim 2 is infringed, and anticipated by Doc. D. It also involves an inventive step as per claim 1.

Claim 3 is infringed, but is novel over Doc. C or Doc. D, and isn't obvious over C or D in isolation or combination.

Claim 4 is not infringed, and is novel over Doc. C or Doc. D, but is obvious over Doc. D.

Claim 5 is infringed only in so far as it is dependant on claims 1 to 3. It is novel over Doc C + Doc. D. It is inventive over prior art.

Claim 6 is not infringed, and is novel over Doc. C + Doc. D. Inventive over prior art.

***Infringement by clients kit:-***

Claim 7 is infringed in so far as the accessory used is that of claims 1 to 3 and 5. It isn't anticipated, however a squeeze argument may exist as discussed in para. 8 if the patentee tried to take action against them for infringement of claim 7. Claim 7 is anyhow obvious over Doc. D.

The clients valve cap itself won't infringe the claims because no claim is directed to a cap itself, the tool generally being intended for use with conventional caps.

However supply of the caps with the cap remover would be contributory infringement of claim 7, however as mentioned, a squeeze defence may exist in view of Doc. D if the court were to decide claim 7 was inventive over D + therefore valid.

In summary, claim 3 is arguably infringed + valid, however it is possible for inventive step to be argued otherwise + the claim to be considered valid, however always better to err on the side of caution.

Claim 5 also = infringed + partially valid.

In view of the only partial validity of the patent, Motorbit, could introduce the features of claim 3 into claim 1, ie the angle of the taper which would render claim 1 valid + infringed, strengthening their position.

If they're aware of Doc. D they will likely apply for post-grant amendment before commencing any infringement proceedings because only get limited damages for partially valid patent.

Also post-grant amendment is discretionary so if they've known about D + delayed, then Comptroller may not grant discretion to amend.

May be advisable to approach Motorbit + advise them of invalidity of their patent + use this as potential bargaining tool to negotiate a licence on reasonable terms. Want to try + avoid litigation because very expensive.

Possibility of designing around infringement, maybe changing angle of taper to outside Motorbits range? This should be serious consideration because not only would you infringe as person manufacturing, or authorising manufacture, the manufacturers you've approached would also infringe (would you be liable for this) as would retailers + end users. However end users would likely have private non-commercial use defence.

Motorbit could get injunction to stop you manufacturing, however unlikely because patent only partially valid. if they took you to court

**Advice to client:-**

Small client - not much money.

Relief for unjustified threats?

Potential infringers:- client
manufacturers (client liable?)
shops
users.

Two possible infringements - cap removal device
cap itself
kit of the two

Amendment - introducing taper angle $10\text{-}20^0$ wld overcome prior art + later inf't.

| *1 → Indep* | **Inf't** | **Bottle** | **Patent** |
|---|---|---|---|
| an accessory | ✓ | ✓ | ✓ |
| suitable for vehicles | ✓ | x consider awkwardness of valve quite large in diameter compared to tyre valve | ✓ 5-6 |
| "comprising" a tubular member – suggests hollow but not thro'cut 35 – 36 of pat. not nec circular + of uniform cross section | ? base portion cup shaped | | ✓ body 42 |
| having at one end retaining means valve<br>*wider than storing* | ✓ valve extractor client letter (14-15)<br>also retained for removal | x | ✓ 33-35 front part 3 w teeth 6 (54) retains |
| suitable for removal | ✓ | x | ✓ |
| and storing | ✓ not explicit but yes | x | not explicit but in practice yes |
| a tyre valve cap | ✓ | x | |
| and the opp. end<br>*can be integral or otherwise*<br><br>*of what – hub member or whole accessory?* | | | |
| Being adapted to facilitate rotation | ✓ ie can be rotated as long as remote from end where valve inserted | | ? smooth ? but wider in diameter, so ✓ |
| Rotation end opp to retaining Means of the tubular member | ✓ | does reduce amt of torque but act opp retaining means ✓ | |
| by reducing amt of torque required to rotate the tub. Member <u>when removing the Valve cap</u><br>*But not nec initial force* | ✓ variable force<br>= Infd | x<br>= not antic So dep cl's Can't be Antic. | not explicit but because larger = ✓<br>= antic. |

***2 → cl. 1***

| | | | |
|---|---|---|---|
| wherein the retaining means comprises a cup ?<br>*not hollow thru'out but no reason why shd be restricted wd function as well if hollow* | ✓ 1a 1,24 | ✓ | ? ✓ hollow thru'out apart from removable cap |
| with an internal taper provided<br>*diminishes, directional – functional - drawings* | ✓ 33-34 | ✓ | ✓ 51 |
| with a plurality of ridges<br>*covers teeth* | ✓ | ✓ | ✓53-55<br>34-35 longit. = ridge |
| diverging outwardly | ✓ in line with taper | ✓ | ✓ |
| towards the respective end<br>*? desc 46-47* | ✓ | | ✓ |
| of the member | ✓ | | ✓ |
| and providing a gripping and | ✓ 31-34 intl. | ✓ | ✓ |
| retaining surf. | ✓ | | ✓ |
| | = infd. | = but dep on cl.1 so<br>= no antic. | = antic. |

***3 → cl. 2 only***

| | | | |
|---|---|---|---|
| in which the internal taper forms an angle of from $10^{o}$ to $20^{o}$ w the axis of the tub. member | ✓ 33-34 | $14^{o}$ = ✓ | x 53 $1\text{-}5^{o}$ |
| | = infrd. | = no antic.<br>= dep. | = no antic. |

***4 → cl's. 1-3***

| | | | |
|---|---|---|---|
| wherein the opp end<br>*ie to retaining means antecedent*<br>of the tub. member is of greater diameter | x diminishes to point 45-46 | knurled surf. but no opp end to retaining end | ✓ |
| and is provided on the exterior thereof | ✓ | | |
| with a knurled surf. *(uniform)* | ✓ 1d 25-27 | | x smooth |

| | | | | |
|---|---|---|---|---|
| to allow the tub. member to be gripped and rotated | ✓ | | | |
| | = not infrd. | | = no antic. | = no antic |
| ***5 →cl's 1- 4*** in which the opp. end is adapted to be inserted into the valve of the tyre ... | ✓ | | x | x |
| | = inf'd when dep on 1 - 3 | | = no antic. | = no antic. |
| ***6 →cl's 1 - 4 only*** opp. end is prov'd w, retaining means suitable for for [removing] + storing a tyre valve cap. | x | | x | x |
| | = not inf'd | | = no antic. | = antic when dep on cl's 1 + 2 |
| ***7*** | | | | |
| a vehicle accessory kit | ✓ | | x | x |
| comprising a conventional or designer valve cap | ✓ | | x | ✓? |
| and an accessory as per cls 1 - 6 | ✓ | x | | ✓ cl's 1 + 2 |
| wherein the accessory is spec. adapted | ✓ | x | | ✓ |
| to cooperate w, the valve cap | ✓ | | x | ✓ |
| | = inf'd in so far as dep. on cl's 1-3 + 5 | | = no antic'n | but not kit so no antic'n ===== |

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**2005 PAPER P6**
**SAMPLE SCRIPT B**

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**Interpretation of Claims in GB 2000000B**

***Claim 1***

*"Accessory for vehicles"* - Normally "for" is interpreted as "suitable for". Thus this claim would be directed to an accessory suitable for vehicles. There is not much limitation in the term "accessory", however. The first line of the patent states that the invention relates to vehicle accessories, and claim 1 goes on to define the accesory as comprising "means suitable for removing and storing a tyre valve cap". It is clear that the scope of the term is limited to accessories - things used in conjunction with or peripheral to vehicles. It is a device.

*"tubular member"* - Tube normally means a hollow cylinder (whether circular cylindrical or otherwise). In this instance the accessory only comprises the tubular member, so need not be entirely hollow, nevertheless a portion of the accessory must have a substantially cylindrical element that has a cavity or bore to qualify as tubular.

It is not clear to me whether the cavity in Fig 1 & 2 extends through the entirety of the accessory. It is sufficient, I construe, for the cavity to end at the taper, i.e. a blind hole, for the portion 1 to be a tubular member.

*"retaining means"* - This means is situated at one end of the tubular member. In the description, lines 48-50, the retaining means is described as splines or ridges. I see no reason to limit to such.

Retaining means is further qualified in the claim however to be one suitable for removing and storing a tyre valve cap.

Thus, retaining means is any retaining means that further provides the function of removing a tyre valve cap and storing (by retaining) the cap.

*"opposite end being adapted to facilitate rotation of the tubular member"* - Opposite end is defined in relation to the end with the retaining means.

Adapted to facilitate rotation could mean to increase applied torque and provide leverage for tight caps (reducing torque applied by user). Alternatively it could be to increase gearing and more speedily remove loose caps.

Facilitate rotation is further qualified in the claim, however, as "by reducing the amount of torque required". Thus I construe this as meaning the end of the tubular member away from the retaining means is adapted by any suitable means (eg handle, wheel, larger diameter) that will reduce torque applied by the user.

***Claim 2***

Dependent on claim 1 - therefore has all of the features of claim 1.

*"cup with an internal taper"*- The tubular member of claim 1 could be a cup (blind hole) and it is such in claim 2. The cup is further defined as having an internal taper, which would be useless unless the widest part of the taper extended to the outside world. Essentially a tapered hole.

*"spaced ridges diverging outwardly"*- This clarifies that the taper has its widest point opening outwards.

The ridges must run along the axis of the taper, circumferential ridges are not covered. There is no upper limit on the number of ridges ... just more than one.

*"gripping and retaining surface"*- This is the inside of the taper and is the function of the ridges.

***Claim 3***

Dependent only from claim 2 so has all features of claims 1 and 2.

*"$10^o$ to $20^o$"*- This defines the angle of the taper.

Neither claim nor description qualify $10^o$ to $20^o$ - for instance by using "substantially" or "about" line 55 of description states that this is the best range.

Thus I think the range is limited to $10^o$ - $20^o$ with common-sense coverage of $9.5^o$ - $20.5^o$ but not extending to beyond that. I do not think that stating the best range is $10^o$ - $20^o$ allows you to cover $8^o$

***Claim 4***

Dependent on Cl 1, 2, and 3. note claim dependency of cl 2.

*"Greater diameter"*- Greater diameter than what? It is not clear whether this means the opposite end is greater ie of greater diameter than the first end or of greater diameter than the cap.

The description states (line 28-30) that the tubular member is preferably circular cross-section but its diameter may vary.

In the specific embodment (line 45) the tubular member is cylindrical, so construing greater diameter to mean greater than its other end excludes the specific embodiment (may be whats intended).

There is nothing to suggest it means greater than the cap, however, and I construe it as meaning the tubular member has a greater diameter at its opposite end.

***Claim 5***

Dependent from cl 1-4

*"adapted to be inserted into the valve"*- Opposite end must have a portion thin enough to do this.

Adapted means it can be an extension, thus not mutually exclusive with cl 4 where the opposite is of "greater diameter".

***Cl 6***

Dependent on cl 1-4. Note not on cl 5

This claim defines the situation in which the retaining means is mirrored to a certain degree at both ends. When dependent on cl 4 one end must have a greater diameter than the other.

***Claim 7***

Independent claim to a kit

*"conventional valve cap"* - This is a cap that is not specifically designed to engage with the accessory.

*"designer valve cap"* - one specifically designed to engage with the accessory "as defined"

Thus can only be an accessory as defined in the device claims .... thus there is a dependency.

*"accessory specifically adapted"* - De facto situation for a designer cap, but qualifies situation for conventional caps.

I don't think it adds much as the device wouldn't work if it could not co-operate with the cap.

**Infringement**

Your valve cap is an accessory according to claim 1.

I believe that your cup shaped portion is a tubular member according to my construction of claim 1 ..... It is substantially cylindrical and has a bore.

You don't explicitly state that the valve cap is retained, but your letter highlights the problem of valve caps being lost and the description indicates that there is a tight grip. I think that your "cup shaped base portion" is a retaining means suitable for both removing (its primary function) and storing (inherent) a tyre valve cap.

"One end" as in claim 1 will be the end that fits over the cap.

The other end must, in order for this claim to be infringed, be adapted to facilitate rotation by reducing the applied torque.

It could be argued that the other end of your device does the opposite, and therefore doesn't infringe.

However, the rear end of the cup base portion is the opposite end of the tubular member according to my construction and this portion does have a greater diameter specifically to reduce the torque applied by the user.

***Thus on my construction your device will infringe claim 1.***

***Claim 2***

Your retaining means does comprise a cup with a taper. Your equally spaced ribs (1f on drawing Fig 2) are the spaced ridges of claim 2.

These ribs are explicitly described as "gripping ribs" on line 31 of your proposal. Thus the inside of your cup does indeed provide a gripping and retaining surface according to my construction.

***Claim 2 is infringed***

***Claim 3***

In that your taper is $10^{o}$ it infringes the range stated in claim 3. For reasons given in my construction I do not believe it would infringe if it were $9^{o}$.

***Claim 3 is infringed.***

***Claim 4***

The cup shaped base portion tapers with its widest end at the opening and a narrower end at its rear. This narrower end is the "opposite end" according to my construction and interpretation. Claim 4, requires the opposite end to be greater diameter and I construed this as a greater diameter than the first end.

***Thus your device does not infringe claim 4.***

***Claim 5***

The long axial stem in your device attaches to the "opposite end" of the cup shaped base portion. Thus I believe that the opposite end is adapted within my construction of the claim to be inserted into a valve.

***Your device will infringe claim 5 so far as it is dependent on claims 1 to 3 but not 4.***

***Claim 6***

***Your device does not have 2 retaining means and therefore will not infringe claim 6.***

***Claim 7***

This claim requires a valve cap and an accesory.

I have construed valve cap to mean any valve cap - ie both prior art and specially designed. The accessory will always be adapted to co-operate with the valve cap.

Thus you will infringe if you sell a kit containing your valve cap and your device as the device infringes claims 1-3 and 5 as far as it depends on 1-3.

***Infringement - valve cap.***

There is no claim to a valve cap as such and thus your proposed valve cap would not directly infringe.

However, the cap would be an essential element of the kit of claim 7 to the extent that it is sold in infringing kits, or knowingly to people who sell infringing kits.

**<u>Validity</u> - Novelty**

I do not think that the bottle cap remover (doc C) anticipates the GB patent. The document does have a publication date earlier than the filing date but it clearly relates to bottles.

I have construed claim 1 as being directed towards an accessory for a vehicle and it has a requirment that a tyre valve cap is removed.

This is not disclosed in Doc C and it does not anticipate cl 1.
All other claims are dependent on cl 1 therefore all are novel over doc C.

**Validity - Novelty over doc D**

Doc D is a withdrawn EP application.

It was published prior to the filing date of the GB patent and is therefore full prior art.

***Claim 1***

Doc D explicitly discloses a tool for opening and closing valve caps. Thus it is an accessory for vehicles according to my construction of claim 1.

The tool functions by gripping a cap in the same way as the GB patent.

There is no explicit disclosure of retension, however one of the identified problems is that the user can get his hands dirty. Furthermore the valve cap is described as being gripped securely (line 28) Thus doc D discloses a retaining means as in claim 1.

The tool has a rear end of larger diameter than the front end. This feature reduces the torque require.

Thus Doc D discloses all features of claim 1.

***Claim 1 lacks novelty***

**INVALIDITY**

***Claim 2***

The front end of Doc C comprises a cup with internal taper and has ridges (teeth) which provide a gripping and retaining surface.

***claim 2 lacks novelty.***

***Claim 3***

Doc D does not disclose an internal taper of $10^{o}$ to $20^{o}$

Claim 3 is ***novel***

***Claim 4***

The opposite end clearly has greater diameter but does not disclose knurling

***Claim 4 is novel***

Doc D does not disclose an opposite end adapted to engage with a valve.

$\therefore$ ***Claim 5 is novel***

$\therefore$ ***Claim 6 is novel***

***Claim 7.***

Doc D does not disclose a kit comprising the tool and a valve cap ...

$\therefore$ ***Claim 7 is novel***

**Validity - Inventive Step.**

If I am wrong that Document D discloses a tool with a retaining means - Claim 1 will be novel. I state this doubt as it may be arguable that the suggestion that the tool grips the cap securely may not be sufficient to anticipate the retaining means of claim 1.

If this is the case I believe that the retaining feature is clearly obvious given doc D. The teeth in doc D form an interference fit on the cap in the same way as the ridges of the GB patent. If retention of the cap by the tool is not disclosed it certainly is obvious. Cl 2 - If claim 1 obvious over doc D then cl 2 adds nothing more and will be obvious.

Claim 3 is the first clearly novel claim.

The invention of claim 3 is a device (accesory) for removing and retaining valve caps using an interference fit caused by ridges inside a tapered cavity where the tapering is between $10^o$ - $20^o$.

Common knowledge of the skilled person would include knowledge of the dimensions of valve caps.

Doc D discloses all of the elements of claim 3 except the angle of taper.

The angle of taper in doc D is far lower ($5^o$) than in claim 3, possibly due to being designed for recessed valve caps.

The GB patent states that the optimum angle has been determined to be between $10^o$ and $20^o$.

It could be argued that this realisation is patentable and that reading doc D you would be surprised that such a great taper angle achieved better results.

It may be that known valve caps at the time of filing tapered at between $10^o$ and $20^o$ and thus the claim is obvious, but I don't have that information

If Doc C were to be combined with Doc D, the angle of $14^o$ is disclosed.

I do not think it is permissible to combine docs D & C however as the motor vehicel accessory manufacturer would not be concerned with bottle top openers. I think they are too far removed and are not to be considered.

***Thus I find claim 3 is inventive***.

A kit comprising a device according to claim 3 is going to be novel, but not inventive as far as it relates to conventional caps. It would seem an easy step to take to sell the 2 together.

I think that the kit is likely to be inventive when combined with the designer caps within my construction.

***Claims 5 & 6 is also likely to be inventive and claim 7 inventive accordingly***

The term greater diameter of claim 4 does not appear to have basis in the description

Check file to see if it was always present or added subject matter.

**Note to client**

My summary is that claims 3 and 4 are valid and infringed and that claim 7 would be infringed by a kit containing an accessory according to claims 3 or 4 and a designer cap.

Your designer caps would be an indirect infringement if sold in the kit

The GB patent will expire at the latest 20 years from filing, ie by 10 Nov 2007. Thus there is only 1 year left. Then you will be free to use. You cannot infring the EP of Doc D as it is not in force.

You infringe claims 3 and 4 if dependent from claims 1 or 2.

Possibly ask for a licence.

We think that claims 1 and 2 are invalid and we could threaten to apply for revocation They may have current licenses and wish to take the easy way out.

You personally will not infringe as you wish to licence and not make or sell etc ...

Your licences are potential infringers however and, there is a possibility that you could be found to be a joint tortfeaser.

Motorbit can sue and apply to amend during proceeding to a valid claim ie claim 3 or 5.

They could apply to amend prior to initiating proceedings. Discretion is required but usually given unless they were trying it on.

It appears that Motorbit have made a unjustified threat. You don't make or import and therefore they should not have threatened proceedings. It doest seem as if there is a product yet so their possible defence of finding infringement will fail - I don't think it a defence if they find you a joint tortfeaser. The threats are actionable by you and you could potentially claim damages (slight) and an injunction against further threats.

Suggest you use this point to get them to the table and obtain a licence for your potential manufacturers, on sensible terms, to allow them to make and sell.

Otherwise ... wait for a year and licence.

Consider a patent to your tool directed to the holes to aid manufacture ... better licensing position for you. If these holes have a technical function and are novel they should be patentable. Ease of manufacture could be the key to this idea and getting money from it.

* * * * * * * * * *

**2005 PAPER P6**
**SAMPLE SCRIPT C**

*This script has been supplied by the JEB as an example of an answer which achieved a pass in the relevant paper. It is not to be taken as a "model answer", nor is there any indication of the mark awarded to the answer. The script is a transcript of the handwritten answer provided by the candidate, with no alterations, other than in the formatting, such as the emboldening of headings and italicism of case references, to improve readability.*

**CONSTRUCTION**

***Claim 1.***

*1.1 "An accessory for vehicles"*

accessory = device pg 7, line 6
invention relates ..... particularly to a device.

for vehicle =
must have some use relating
to the vehicle, not just
something that can be
carried in one

for = suitable for

vehicle = common meaning = something
with wheels that can be driven on a
road/on land.
ie something that can be used with a vehicle.

*1.2 "comprising a tubular member
having at one end retaining
means suitable for removing
and storing a tyre valve cap"*

comprising = including or consisting

tubular member - nothing to suggest non-common meaning; ie substantially cylindrical and hollow. Because the example has a tapered internal wall 4, I think tubular has to be construed broadly to encompass any tapering on outer or inner surfaces.

removing = such to
remove/release the valve cap
from the valve - not
necessarily to remove to
a long distance as long as
it's taken off the valve
a little tiny distance.
no need for narrow construction here.

"at one end" also needs to be construed broadly not to be limited to precisely the end-most thing is the retaining means, because the cap in the example may be received in the base of the bore 6 if it is a small cap.

retaining means. Retain = to grip and hold - pg 8, lines 48 to 49 - the cap is gripped in the splines 5 and held there to retain it in the splines when the tubular member is removed from the tyre valve.

Retain = to keep.

Dust cap is retained in the splines until operation on tyre is performed - pg 8, lines

52-53.

Retaining means = something able to grip + keep a tyre valve cap until needed again.

Suitable for = able to.

tubular member: preferably but not necessarily of circular cross-section and may have varying diameter - see pg 7 lines 28-30.

storing = holding within the retaining means - pg 8, lines 52-53

*1.3 "and the opposite end being adapted to facilitate rotation of the tubular member by reducing the amount of torque required to rotate the tubular member when removing the valve cap."*

"opposite" = reference to the end of the accessory that is not the end that has the retaining means - because of earlier reference to one and having retaining means in 1.2

Facilitate = to make easier = common meaning

torque = turning force = common meaning.

"the" valve cap - no antecedent basis. This implies accessory must be capable of moving a valve cap of the vehicle in question.

opposite end has some means that enables easier rotation of the tubular member because the turning force required to rotate the tubular member when engaged with a valve cap is reduced.

"opposite end" can mean any part of the accessory closer to the very opposite end point to the retaining means than the retaining means itself.

***Claim 2***

*2.1 "An accessory for vehicles According to claim 1"*

accessory (see 1.1) having all features of claim 1.

*2.2" wherein the retaining means comprises a cup with an internal taper"*

retaining means (see 1.2)

comprises = consists of or includes

cup implies roughly shape of cup - ie must have surrounding wall and a base.
must be construed to cover the LH end of the tubular member 1 shown in Fig 4, which has surrounding

taper is not specified which direction it should go, so could cover either inwardly or outward tapers.

tapered wall 4 and base 6.

cup must have an internal taper - ie cup wall must be tapered
must cover the tapered wall 4 in its scope
see also pg 8, lines 44-47.

*2.3 "provided with a plurality of spaced ridges diverging outwardly towards the respective end of the member and providing a gripping and retaining surface."*

plurality = more than 1.

"ridges" must include the example:
splines or ridges 5
- see pg 8, line 48 and Fig 2.

ridge = something that projects from a surface

diverge = move away from each other, which implies that the taper (of 2.2) must be going outwards in the direction of the end of the member having the retaining means.

ridges must provide gripping and locating surface for cap - pg 8, lines 48-49.

*3.1 "An accessory for vehicles according to claim 2"*

accessory having all features of claim 2.

*3.2" in which the internal taper forms an angle of from $10^o$ to $20^o$ with the axis of the tubular member."*

internal taper - see 2.2

from $10^o$ to $20^o$ = angle is approximately $10^o$ to $20^o$, so there is nothing to indicate only exact values of the ends of the range are meant, so say approx from $9^o$ to $21^o$. Seems reasonable error - be larger.

could even

The angle is measured relative to the longitudinal axis of the tubular member - See Fig 1 which clearly has a longitudinal axis and the tapered portion 4 does seem around 10-$20^o$ inclined to it.

*4.1" An accessory for vehicles according to any of claims 1 to 3"*

accessory having all features of claim 1 or claim 2 or claim 3

*4.2 "wherein the opposite end of the tubular member is of <u>greater</u> diameter"*

opposite end - see 1.3

greater should be greater than ....?
as Fig 1 shows that the opposite end (the RH end) is of equal diameter to the end with the retaining means(the LH end), I can only assume this opposite end has a greater diameter than portion (ie any other portion) of the tubular

means the another member.

| | |
|---|---|
| | in this example, it's got a greater outer diameter than the portion 9. See pg 8, lines 59 to 60 + Fig 1, 9. |
| *4.3 "and is provided on the exterior therof with a knurled surface to allow the tubular member to be gripped and rotated".* | the opposite end is provided with a knurled exterior surface<br>- pg 8, lines 57-58. |
| | knurled = surface is shaped to allow device to be gripped firmly - pg 8 lines 57-58 |
| *5.1 "An accessory for vehicles according to any of claims 1 to 4"* | accessory having all features of claim 1 or claim 2 or claim 3 or claim 4. |
| *5.2 "in which the opposite end is adapted to be inserted into the valve of the tyre to depress the pin of the valve + thereby release air from the tyre."* | Opposite end - see 1.3<br>end must be shaped/dimensioned to be inserted into the tyre valve to release air therefrom<br>.<br>Shape is preferably, but not necessarily a tapered pointed end - pg 7, lines 34-36 |
| *6.1 "Accessory for vehicles according to any of claims 1 to 4"* | accessory having all features of claim 1 or claim 2 or claim 3 or claim 4 |
| *6.2" wherein the opposite end is also provided with retaining means suitable for removing and storing a tyre valve cap."* | opposite end - see 1.3<br>both ends of tubular member provided with a means suitable for removing and storing tyre valve cap<br>- see 1.2 construction<br>and pg 7, line 36 to pg 8, line 39. |
| *7.1 "A vehicle accessory kit"* | = kit of two or more items |
| *7.2 "comprising a conventional or designer valve cap"* | comprising = including or consisting of<br>conventional valve cap = push on or screw threaded dust cap. See pg 7, lines 8-9<br>designer cap = a cap for which an accessory has been specifically designed to co-operate with - pg 8, lines 62-64.<br>so the kit could include either a conventional valve cap OR a designer cap. |
| *7.3 "and an accessory as defined in any of claims 1 to 6"* | accessory for vehicles having all features of claim 1, or 2 or 3 or 4 or 5 or 6 |
| *7.4 "wherein the accessory is specifically adapted to co-operate with the valve cap.* | co-operate = grip and retain - pg 8, lines 48-52.<br>the accessory must have some means to grip and retain the valve cap of 7.2 and must be specifically formed so that it does that. |

| | |
|---|---|
| | eg the tapered wall 4 which could engage valves of may different diameters. |

**INFRINGEMENT**

| | |
|---|---|
| 1.1 present | tyre cap removing device is a device to be used with a vehicle<br>- pg 5, line 48 + Figs 1 + 2 |
| 1.2 present | device 1 = tubular member, as defined in construction 1.2<br><br>device 1 has retaining means in form of four gripping ribs 1f which grip a valve cap C. - pg 4, lines 31-32<br><br>ribs 1f remove and store tyre valve cap within these ribs because cap is released from valve - pg 5, line 42<br><br>cap obviously remains stored in the gripping ribs 1f - see Fig 2. |
| 1.3 present | the device has portion of larger external diameter than the cap and so a greater turning force can be applied by gripping this portion - this must be portion 1a.<br>see Fig 2 and pg 4, lines 10 to 13.<br><br>the device may be gripped just next to the apertures 1i, which is a point closer to the opposite end tip 1k, than where the gripping ribs 1f are.<br><br>any point on 1a may be gripped, including just next to the apertures, and the torque varies depending on this - see pg 4, lines 13-14. |

***claim 1 is infringed by the tyre valve cap removal device***

| | |
|---|---|
| 2.1 present | accessory having all features of claim 1 |
| 2.2 present | cap is provided by annular wall 1e of portion 1a, which is tapered - see Fig 2, and pg 4, lines 33 to 34<br><br>and base of cup is provided by smaller cup-like portion 1b giving wall extensions and a base. The apertures li are just for ease of manufacture and do not detract from the general cup shape. |
| 2.3 present | plurality = 4<br>gripping ribs 1f = ridges<br><br>four equally-spaced tapered gripping ribs<br>- see pg 4, lines 30 to 31 |

the taper is outwards towards the open end of the retaining means (LH end in Fig 2)

***Claim 2 is infringed by the tyre valve cap removal device.***

| | |
|---|---|
| 3.1 present | all features of claim 2 present |
| 3.2 present | internal surface of cup-shaped portion 1a is inclined at about $10^o$ to the axis of Fig 1<br>- pg 4, lines 33 to 34<br><br>the shown axis is the longitudinal axis - see Fig 1.<br><br>about $10^o$ falls in the range $9^o$ - $21^o$ which I construed in construction 3.2. |

***Claim 3 is infringed by the tyre valve cap removal device.***

| | |
|---|---|
| 4.1 present | accessory having all features of claim 1 present<br>accessory having all features of claim 2 present<br>accessory having all features of claim 3 present |
| 4.2 present | opposite end can include the part of the cap portion 1a where the apertures 1i are included<br>(see construction 1.3 - broad defn. of opposite end).<br><br>the cup portion 1a at that point is of greater diameter than the smaller cup portion 1b hence the "opposite end" has a greater diameter than another portion of the tubular member<br><br>cup portion 1b forms an extension of the cup portion 1a - see pg 4, lines 24-25.<br>so "the tubular member" can mean both 1a and 1b. |
| 4.3 present | cup portion 1a has external serrations 1g - these will allow easier gripping + rotation.<br>- see pg 4, lines 34-35. |

***Claim 4 is infringed by the tyre valve cap removal device.***

| | |
|---|---|
| 5.1 present | accessory having all features of claim 1 present<br>accessory having all features of claim 2 present<br>accessory having all features of claim 3 present<br>accessory having all features of claim 4 present |
| 5.2 present | see defn. of opposite end in 1.3 construction. |

the end 1k can be inserted into a valve to release air from the tyre - pg 5, lines 45-46.

***Claim 5 is infringed by the tyre valve cap removal device.***

| | |
|---|---|
| 6.1 present | accessory for vehicles having all features of claim 1<br>accessory for vehicles having all features of claim 2<br>accessory for vehicles having all features of claim 3<br>accessory for vehicles having all features of claim 4 |
| 6.2 not present | no disclosure that the space within the smaller cup portion 1b could be used to hold a valve cap and in any case, <u>there is no means to remove a tyre valve cap provided in the smaller cup portion.</u><br>I know that valve caps can be of differing sizes, so it's possible a very small cap could be stored there. |

***Claim 6 is not infringed by the tyre valve cap removal device.***

| | |
|---|---|
| 7.1 present | client intends to provide a kit of at least 2 items - pg 5, lines 51 to 54 |
| 7.2 present | designer valve cap will be included in the kit<br><br>co-operating valve caps are ones designed to co-operate with the tyre valve cap removal device - hence are "designer valve caps" - see pg 5, lines 51 to 54 |
| 7.3 present | the device is present in the kit - pg 5, lines 51 to 54<br>the device means the device 1 which has all features of claim 1 (also has all features of claim 2, 3, 4, 5)<br>⇨ present when dep on any of claims 1-5. |
| 7.4 present<br><br>of | <u>co-operating valve caps</u><br>- must mean to co-operate with the device<br>- pg 5, lines 51 to 54.<br><br>the accessory and valve caps are both supplied with kit, hence both are formed to co-operate with each other.<br><br>Hence accessory is adapted to co-operate with caps kits. |

***Claim 7 is infringed by the proposed kit.***

***Claim 7 is infringed by the client's co-operating valve cap if the cap is specifically designed to fit with the tyre valve cap removal device.***

See letter.

**NOVELTY**

***C***

| | |
|---|---|
| 1.1 not disclosed | bottle top remover - not for vehicles - see pg 11, line 3. |

***Claim 1 is novel over C.***

| | |
|---|---|
| 2.1 not disclosed | not accessory for vehicles |

***Claim 2 is novel over C.***

| | |
|---|---|
| 3.1 not disclosed | not accessory for vehicles |

***Claim 3 is novel over C***

| | |
|---|---|
| 4.1 not disclosed | |

***Claim 4 is novel over C.***

| | |
|---|---|
| 5.1 not disclosed | not accessory for vehicles |

***Claim 5 is novel over C.***

| | |
|---|---|
| 6.1 not disclosed | not accessory for vehicles |

***Claim 6 is novel over C.***

| | |
|---|---|
| 7.1 not disclosed | not vehicle accessory kit |

***Claim 7 is novel over C.***

**Novelty**
***Document D***

| | |
|---|---|
| 1.1 disclosed | tool for opening and closing the cap of a valve of an air fitted tyre of a car, tractor or other vehicle - pg 14, lines 5 to 9. |
| 1.2 disclosed | tubular member = body 1 of tool - tubular shape as defined in construction 1.2, see Figs 1-3.<br><br>retaining means = gripper 3 having teeth 6 provided at one end.<br><br>- teeth grip the valve cap securely - see pg 14 - lines 27-29<br>- gripper is pressed onto the valve cap to open + close valve - pg 14 - lines 31-33.<br>open valve falls in my definition of removing the valve cap - see construction.<br>valve cap obviously retained in teeth until screwed back on again. |
| 1.3 disclosed | opposite end clearly includes rear portion 5. |

| | |
|---|---|
| | Rear portion 5 reduces torque because that is the portion that is gripped and because it has a larger diameter than the gripper 3. |

***Claim 1 lacks novelty over D.***

***<u>Claim 2</u>***

| | |
|---|---|
| 2.1 disclosed | all features of claim 1 are disclosed in D. |
| 2.2 not disclosed | because there is no <u>base</u> to the tapered front portion 3.<br><br>internal taper present - see Fig 3, front portion 3. |
| 2.3 disclosed | teeth 6 are plurality of spaced ridges - project inwards - see x-section of Fig 3, teeth 6<br><br>taper + teeth 6 diverge outwards towards the open RH end - see Fig 3.<br>- teeth provide gripping surface - pg 14, line 28 + lines 31 to 33.<br>teeth retain valve cap until it's closed again - pg 14, lines 31-32. |

***Claim 2 is novel over D.***

| | |
|---|---|
| 3.1 not disclosed | not all features of claim 2 disclosed. |
| 3.2 not disclosed | coning angle of first part = 1-5$^{o}$. This is not within 9$^{o}$-21$^{o}$ → not close enough to 10 to fall in this range. |

***Claim 3 is novel over D.***

| | |
|---|---|
| 4.1 disclosed | accessory has all features of claim 1. |
| 4.2 disclosed | opposite end can mean near portion 5 - see construction 4.2<br>which has a greater diameter than another part of the tubular member, for example, the conical part 4. |
| 4.3 not disclosed | no disclosure of anything except a smooth surface of the body 1 of the tool. |

***Claim 4 is novel over D.***

| | |
|---|---|
| 5.1 disclosed | accessory having all features of claim1 |
| 5.2 not disclosed | rear end portion 5 is much too big to be inserted into a tyre valve to release the air pressure and there is no disclosure of any modification that would enable this. |

***Claim 5 is novel over D.***

| | |
|---|---|
| 6.1 disclosed | accessory having all features of claim 1 disclosed |
| 6.2 not disclosed | the rear cover 2 allows a space within it where small objects can be kept inside, presumably between the end of the air pressure gauge and the rear cover 2 - see pg 15, lines 70 to 72.<br><br>This space is suitable for storing a tyre valve cap.<br><br>But there is no disclosure of means suitable for removing the tyre valve cap provided at the LH end (rear cover end) of the accessory in Fig 3. |

***Claim 6 is novel over D.***

| | |
|---|---|
| 7.1 disclosed | 2 or more items are disclosed - the tool and a valve cap |
| 7.2 disclosed | conventional valve caps are disclosed, even though specially designed ones are not |
| 7.3 disclosed | accessory as claimed in claim 1 disclosed. |
| 7.4 disclosed | adapted to co-operate = teeth 6 and gripper formed by front part of tool makes accessory specifically adapted to co-operate with a combined valve cap. |

***Claim 7 lacks novelty over D.***

**INVENTIVE STEP**

***Claim 1*** lacks novelty over D so also lacks an inventive step over D, as the skilled person would find all these features present in D.

***Claim 2***

Document D is considered the closest prior art because it also relates to an accessory for vehicles.

D discloses all features of claim 2 except that the retaining means is not strictly cup shaped because the front portion 3 does not have a base of the cup.

There is no particular necessity for the base 6 of the cup of B to exist, as depending on the size of the valve cap, it would be wedged at some point in the splines anyway.

If the skilled person looked at C, it might not occur to him to combine C and D because they are in different fields. He would see that C includes a cup with an internal taper and a base provided by the detachable lid 21.

However, he would not seek to combine this in the gripper front part 3 of document D, because it is essential there is no barrier between the front part 3 and the air pressure gauge, or the air pressure gauge could not work.

***Hence, claim 2 is inventive over document D, whether read alone or in combination with C.***

***Claim 3***

The closest prior art is again D, because it's in the same field.

I think claim 3 is inventive over D and a combination of C and D for the reasons given in respect of claim 2.

However, the additional feature of the angle of $10^o$ to $20^o$ is already known from C.

It's $14^o$ in C - see pg 11, line 25. This enables the device of C to be used with many different sizes of bottle cap.

Hence it is known that an angle of $14^o$ is useful and that it gives the same advantages of the tapered range of $10^o$-$20^o$ of B in that such a angle allows fitting to many different sizes of item.

***Hence, if I were wrong about claim 2, this further feature would not provide claim 3 with inventive step***

***Claim 4***

The modification is the knurled surface.

It is known from C to provide a knurled surface to facilitate gripping.

***Hence, claim 4 lacks inventive step***.

***Claim 5***
modification of adapting opposite end to be inserted into valve of tyre
not known from C or D

***hence, I believe it's inventive***

***Claim 6 is inventive*** because the opposite end having retaining means for both removing and storing is not disclosed in C or D.

**ADVICE**

Dear client

***Threats Action***

Motorbit has threatened you with taking action for infringement for your "activities". Motorbit will be aware that you are not a manufacturer or importer because you have visited them recently. Their threats to you are therefore actionable. You would have grounds to sue Motorbit for unjustified threats of patent infringement if you can prove the threats were made (eg provide the letter from themselves) and that you are aggrieved - suffering actual harm/financial damage. You would be entitled to relief, such as damages + injunction unless Motorbit can prove you were infringing, in which case you wouldn't get relief unless you can prove invalidity in a relevant respect + that Motorbit knew of the invalidity.

***Improve your position***

You should consider filing a patent application for your tyre valve cap and tyre valve cap removal device.

This gives you the option to negotiate with Motorbit and perhaps agree to cross-licence.

***Prior secret use***

You may be entitled to carry on with your proposal, despite motorbits patent, if you made serious and effective preparations to put your invention into effect in the UK before 10 November 1987.

You could authorise business partners to work the invention and you could work your invention without infringing. However, you would not be able to licence your invention, as you currently intend to do.

***Relevance of D***

D is prior art because it was published before the filing date of B (Motorbit's patent).

It does not affect D's status as prior art because D was later deemed withdrawn.

D being deemed withdrawn may indicate that there is other relevant prior art that maybe used against B.

We should consider doing a prior art search.

***Possible revocation of B***

***Your invention not looking like B***

Your invention/proposal would still infringe if you include all the features of B's claims.

***Infringement***

You are not intending making/importing/selling your valve cap removal device/valve cap/kit, so you would not be a direct infringer.

However, any car manufacturers you licence are potential infringers because they will make one or more of the above items/import/sell/market them.

You could be seen as a joint tortfeasor engaged in a common design with the car manufacturers to infringe the patent, because you are encouraging the car manufacturers to infringe the patent.

I believe that claims 1-5 would all be infringed by the tyre valve cap removal device (your device 1) and that the kit claim 7 would be infringed by your proposed kit (document A, pg 5, lines 51-54).

If the car manufacturers supply specially designed valve caps (such as valve cap C) to shops for use as part of a kit, according to claim 7, then this may be contributory infringement. This is because the specially designed caps are essential means to put the invention into effect of the kit claim 7.

If they supply just ordinary tyre valves, this may not be contributory infringement because these are staple commercial products, but it would still be an infringement if the ordinary tyre valves are supplied with the aim of inducing infringement, eg by encouraging shops to sell these with the rest of

the items in the kit.

Because your valve cap removal device and kit infringe claims 1-5 and 7 of B, then Motorbit could sue you for infringement.

They could sue you for damages, and they could try to obtain an injunction against you and any of your licensees at full trial. You could be sued as a joint tortfeasor engaged in a common design to infringe, together with any of your licensees.

Motorbit could also try to obtain an interim injunction against you, but these are difficult to obtain, and I see no reason why they could not be adequately compensated with damages, in the event they would win at full trial.

***Validity of B***

Claims 1 and 7 lack novelty over D.

Claim 2 is inventive
Claim 3 is inventive

Claim 4 is not inventive

Claim 5 is inventive

Hence, the proprietor of B could try to amend Claim 1 to include any of the features of claims 2, 3 or 5 to strengthen the validity of the patent. Must have acted in good faith to obtain discretion to amend.

You would then still infringe a valid patent.

Currently, you infringe currently valid claims 2, 3 and 5. which is a dangerous position. Hence, I suggest you seek a licence from B

You could apply for a declaration of non-infringement, but I don't think this would be granted because of likely infringement.

Proprietor's damages may be reduced if he sues you now, because patent only partially valid.

Pls call to discuss.

Yours sincerely,

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