

## Spare set of claims

## Claims

1. An item of outerwear, <sup>1.1</sup> the item of outerwear having a body portion for <sup>1.2</sup> covering at least a major portion of a user's upper torso and means to <sup>1.3</sup> releasably secure the item of outerwear to the users torso, <sup>1.4</sup> the item of outerwear having a lowermost edge which is configured to terminate over <sup>1.5</sup> the user's legs, <sup>1.6</sup> secured to the lowermost edge is an upturned portion for capturing fluids running down the body portion, <sup>1.6</sup> the upturned portion having one or more drain apertures located at or towards the rear of the body portion to allow captured fluids to be expelled from the upturned portion.
2. An item of outwear according to Claim 1, <sup>2.1</sup> wherein a drain conduit is secured <sup>2.2</sup> to the drain aperture.
3. An item of outerwear according to Claim 1 or 2, <sup>3.1</sup> wherein the upturned <sup>3.2</sup> portion is deployable from a first condition in which the upturned portion is not able to capture fluids to a second condition where it is able to capture fluids running down the body portion.
4. An item of outerwear according to Claim 3, <sup>4.1</sup> wherein in the first condition the <sup>4.2</sup> upturned portion is not secured to the lowermost edge.
5. An item of outerwear according to Claim 4, <sup>5.1</sup> wherein the upturned portion, <sup>5.2</sup> in the second condition is secured to the lowermost edge by a discontinuous fixing device.
6. An item of outerwear according to any preceding Claim, <sup>6.1</sup> wherein the item of <sup>6.2</sup> outerwear is a jacket or coat.

Construction

Purposive:

Claim 1

1.1 Independent claim → device type, sets the scene.

“item of outerwear” must be broader than jacket and coat → since cl.6 limits to these options

p6, L.12-16 → items must be weatherproof ie. showerproof or waterproof.  
Purpose is to ensure wearer remains dry

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p6, L.45 can be worn over other clothes.

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1.2 “for” = suitable for

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“body portion – worn on user’s body “at least a major portion of a user’s upper torso”

→ p6 L.21-25 indicates even when open, item protects back and most of chest

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Purpose → to protect user from rain falling in all directions p6, L.21-25 so item must at least cover back. Maybe a coat

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1.2 (cont) note that user’s upper torso is separate from item!

Upper torso includes substantially back and chest

BUT since item eg. coat can be unzipped – leaves chest exposed (p6, L.21-25).

So in use, can cover chest and back

1.3 item of outerwear includes means!

“means” is broad → just functionally defined

“releasably” = not permanently connected, can be connected and disconnected without damage

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p7, L.15 → facilitates securing & removal eg. may include but not limited to a zip p6, L.23 such as a zipper 6 in Fig.1

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so means construed as allowing item to be securable & removable around user’s body.

1.4 “configured to” means only limited to do so in use ie when worn by user

Lowermost edge – may include hem 7 refers to bottom edge of item not including upturned portion which connects to upturned portion. but not limited to such.

From figures 1 & 2 of B → “terminate over user’s legs” implies not too far. Can be anywhere from hip down so that torso covered in use ie. when item is secured to user.

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1.5 upturned portion is secured to lowermost edge

Note is claim 4 incompatible? → claims the opposite of not being secured.

In view of p6, L.34-37 “secured” means permanently secured? Whereas cl. 4 is a different embodiment → releasably so must cover both!

So “secured” means secured/fixed releasably/unreleasably

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1.5 (cont) Purpose of securing is to allow for stowing when not in use p7, L.31-32 of upturned portion

“upturned portion” eg. may be gutter8 in Figs.

“upturned” refers to stowed position as eg. shown in Figs so is only upturned when in use p7, L. 31-32 to function as gutter

“for capturing fluids running down body portion”

→ acts as gutter in use

So, construe as lowermost edge attached to upturned portion which can capture water in use dripping down body portion

Purpose is to protect legs/trousers from rain in use p6, L. 12-16, p7, L.23 by providing a gutter function

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1.6 “one or more” includes one or a plurality

“drain apertures” may include but not limited to drainage aperture 9 in Figs.

“Located at or toward rear” → just limited to not being at front in use ie. could be at rear or sides of body portion when worn by user

“captured fluids” – fluids collected from upturned portion

Purpose is to expel fluids in use ie. function as a drain for gutter.

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Also p6, L. 26-29 → together upturned portion functioning as gutter and apertures functioning as drain provide liquid flow path since allow water to flow in known direction. Providing at rear means doesn't interfere with working practices → consistent with if at "sides" since only interferes if draining water at front ie. by feet.

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Claim 2

2.1 Includes all features of claim 1

2.2 "drain conduit" – such as hose but not limited to this p6, L. 31-32 eg. down pipe p7, L.16-19.

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Purpose is to further direct water away from wearer

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So drain conduit functions as further liquid flow path for draining collected fluid away from aperture

"secured" – p7, L.18 indicates push fit mechanism to drain aperture

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→ implies releasably secured but not limited to such

So construe as secured to aperture for providing further drainage away from user.

Note "the drain aperture" – no antecedent basis but clearly refers to at least one of the one or more drain apertures.

Claim 3

3.1 Includes all features of claims 1 OR all features of claims 1 and 2

3.2 "deployable" just means upturned portion can move from 1st condition to 2nd condition but must still be secured in both conditions!

"1st condition" functionally claimed → unable to capture fluids.

→ corresponds to it being "downturned" when not in use for guttering.

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"2nd condition" functionally claimed → functioning as gutter portion to capture fluids.

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Claim 4

4.1 Includes all features of claim 3 so → all features of claims 1, 2 and 3 OR claims 1 and 3

4.2 Incompatible with claim 1?

Appears intention was to cover eg. hem gutter portion when unfolded But  
very unclear OR Fig. 3 embodiment which is incompatible with claim 1.

→ possibly an edge of upturned portion eg hem embodiment not secured  
to lowermost edge?

4.2 (cont)

upturned portion must be releasably secured to be compatible with  
claim 1

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ie. must be releasably securable.

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Issues with sufficiency? because

In 1st condition – does not capture fluids as in cl. 3.

→ so isn't achieving purpose of invention in 1st condition?

→ construe as when upturned portion separate from garment in use. ie.  
unattached to garment.

Claim 5

5.1 Includes all features of claim 4 ie. claims 1, 2, 3 and 4 OR claims 1, 2 and 4

5.2 second condition → upturned portion functioning as gutter to capture  
fluids ie. in use

“discontinuous fixing device” DFD appears to include but not limited to  
buttons

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→ though not described with embodiment of foldable hem so added  
matter?

Not enabling.

only in relation to separate gutter of Fig 3

→ construe as something which intermittently connects to item lowermost  
edge

Claim 6

6.1 Includes features of

- claim 1 or
- cl. 1 and 2 or
- cl. 1, 2 and 3 or
- cl. 1, 2, 3 and 4 or
- cl. 1, 3, or
- cl. 1, 3 and 4 or
- cl. 1, 2, 3, 4, 5 or
- cl. 1, 3, 4 and 5

6.2 Jacket or coat – not an apron

Purpose – can be worn over day clothes so as to provide protection p6,  
L. 45 – 46

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**MARKS AWARDED 11.5**

Infringement

Falls in scope?

Who? Acts? Exemptions?

Client's DrainGate (DG)

→ abandoned project so no current MUDOIK acts → so no infringement.

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→ began serious and effective preparations to work DrainGate by approaching TVBS in good faith before (Apr 2015) the effective date of B (1 July 2016)? BUT by abandoning project this preparations were not continuous therefore cannot rely on work of DG as prior user right defence.

Client's GutterGate (GG):

Client acts in respect of GG

→ developed after (Aug 2018) effective date of B (1 July 2016) so no prior user defence.

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→ acts include:

- Manufacture so making S60(1) act
- secure orders to supplier & fire services

– Advertising & selling since May 2019 → disposing & offering to dispose S60(1) acts.

– also any use, keeping (storing) (and if importing?) are S60(1) acts.

Supplier of builder's equipment

→ orders from client → not exempt because of commercial customer

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→ acts include:

– sales and advertising (disposing & offering to dispose S60(1)) in UK

– keeping, using

Fire Services

→ orders from client → not exempt because not private

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→ acts include:

– keeping, using

GG – does it fall in scope of claims?

Claim 1

1.1 x a kit, no item of outerwear – but for use with coat p4, L. 5-6

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1.2 x same as 1.1 but is for use with a coat

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1.3 x same as 1.1 → BUT for use with coat

1.4 x same as 1.1

1.5 x no item of outerwear

BUT G' is a gutter p4, l.5 = upturned portion since provides W p4, l. 8-9 → clearly captures fluids when attached to coat

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1.6 x “integrated drainage pipe” DP clearly has aperture at top leading to DP, Fig 2.3

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“rear of the coat is best” = located at rear of coat p4, L. 18-21

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Also same purpose “to allow water retained in W to be expelled”

But G' is connected to inner surface of garment NOT lower edge of garment

Hence GG does not fall in scope of claim 1.

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BUT GG is a means essential to claim 1! Since it relates to heart of invention ie. guttering and drain function

So, once fitted to item of outerwear eg. a coat → meets requirements of features 1.1 – 1.4

BUT would still not fall within 1.6.

BUT is it immaterial variant?

Actavis:

- GG applied to coat has purpose of capturing water as described in client letter so achieves substantially same result in substantially same way as cl. 1.
- reading at priority date and knowing it achieves substantially same result, skilled person also understand it does so in substantially same way → obvious in view of water retention
- Although not covered by claims (see sufficiency & construction of cl. 4 and 5) clearly patentee disclosed attaching gutter not just to lower edge in view of Fig.3. Hence, skilled person would understand patentee didn't require strict compliance with upturned portion secured to lowermost edge.

Hence GG arguably an equivalent under Actavis for essential means

Claim 2

2.1 x see above – only as essential means

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2.2 ✓ DP = drain conduit since integral p4, L.18 so secured

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Hence GG is essential means for claim 2 under Actavis – see above.

Claim 3

3.1 x see above – only as essential means

3.2 ✓ E" allows for reasonable connection to hook and eye so

1st condition = when unattached

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2nd condition = when attached

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p4, L.14 – 16



Claim 4

- 4.1 x see above-only as essential means
- 4.2 ✓ E" can be hook and eye fastener so must be releasable  
→ 1st condition is when attached

Hence GG falls in scope of claim 4 as Actavis essential means.

Claim 5

- 5.1 – only as essential means
- 5.2 ✓ hook and eye fastener = DFD since only intermittently connects as seen from Fig 2.3 to coat in second condition → when attached.  
not lowermost edge but clearly equivalent (see claim 1 above)

Hence GG is equivalent within scope of claim 5.

Claim 6

- 6.1 – only as equivalent
- 6.2 x but use with coat

Hence, GG is not in scope of claim 6

So summary:

Client is supplying and offering to supply (sales and adverts) in UK GG which is essential means under Actavis of claims 1 – 5 and is known or obvious to put invention into effect in UK since advertised as guttering and draining effect p4, l. 18-19 for coats

No staple commercial product defence since only use is as this.

Also supply and offer to supply of GG is to unauthorised persons ie. without consent of B proprietor.

So Client is a contributory infringer! But not if supply and offer to supply is to clients outside UK in respect of EP(GB) though may infringe other EP rights → check!

In view of acts above by supplier and fire services

→ are direct infringers in respect of those acts if include coats as claimed.

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So client and supplier and fire services all at risk of infringement proceedings by B proprietor.

Remedies that B could seek include:

- declaration of validity of contested and infringement
- damages/account of profits
- injunction against further infringement
- delivery up/destruction
- costs/expenses based on financial standing of parties.

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MARKS AWARDED 12.5

Novelty

Doc C = full prior art because published before effective date of B claims under a 54(2) EPC

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D = a54 (2) EPC prior art because published before effective date of B.

Note DG of A is not prior art because there was no public disclosure before effective date of B → although client approached TVBS, this was in confidence.

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Are features of claims disclosed in prior art?

Feature C

1.1 ✓ apron made from water repellent material p12, L.15-19  
can be worn over clothes Fig. 1  
so apron = item of outerwear

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1.2 x apron doesn't cover back

1.3 ✓ Fig.1, ref 10C indicates securably & removably releasable means from wearer

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1.4 ✓ lower edge where apron meets reservoir extends to knees so lower than hip in use Fig.1

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1.5 ✓ gutters 11 = upturned portion since captures water RU p13, L. 1-5  
Prevents legs & shoes from being wet

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1.6 ✓ spouts 14 allow water to drain so = drain apertures

1.6 (cont) provided a spout 14 at rear in Fig.1 where ref "15" is

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Hence cl. 1 is novel over doc C.

Claim 2

2.1 x see above

2.2 ✓ “separately attached pieces” p13, l. 15 – 16 ie. secured!  
“projecting downwardly” p13, l.1

so must be a liquid flow path for further drainage.

Hence cl. 2 is novel over C by virtue of cl. 1

Claim 3

3.1 x see above

3.2 ✓ fasteners allow formation of gutters so can form 1st condition & 2nd  
condition p14, L.14, 11 – 13.

Hence, cl. 3 is novel over C by virtue of cl. 1

Claim 4

4.1 x see above

4.2 x gutters integrally formed with apron so not separate from apron

Hence claim 4 is novel over C

Claim 5

5.1 x see above

5.2 ✓ separable fasteners = DFD and provide gutters 11 (ie. upturned  
portion functioning as gutter) p14, l. 8 – 13.

Hence, claim 5 is novel over C by virtue of cl. 1 and claim 4.

Claim 6

6.1 x see above

6.2 x apron

Hence claim 6 is novel over C

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		Examiner's use only
<u>Feature</u>	<u>Doc D</u>	
1.1	✓ “cycling coat” p17, l. 8-9 = item	0.5
1.2	✓ Fig. 1 shows covering back and chest so has body portion	0.5
1.3	x “one piece garment” p17, l. 8-9	
1.4	✓ from fig, extends past hips	0.5
1.5	✓ “enclosed runway” collects raindrops p17, l. 28-30 so is upturned portion Fig. 1 shows connected to lowermost edge.	0.5
1.6	✓ “apertures 210” discharge water collected in rivulet 180 p17, l.35-40 so act as drain → drain apertures  Fig.1 located at <u>side</u>  Rivulet = enclosed runway.	0.5  0.5
Hence cl. 1 is novel over D		
<u>Claim 2</u>		
2.1	x see above	
2.2	x Drain ports 210’ shaped to provide further liquid flowpath but not secured to aperture	0.5
Hence cl. 2 is novel		
<u>Claim 3</u>		
3.1	x	
3.2	x Runway 110 p18, l.30 provided separately so when attached → 2nd condition and unattached → 1st condition <u>BUT</u> not releasably unattached so can’t go from 1st → 2nd condition	0.5
Hence claim 3 is novel.		

Claim 4

4.1 x

4.2 x same as cl.3

Hence, cl.4 is novel over D.

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Claim 5

5.1 x

5.2 x seam or glue – see figs p18, l.31 – 36

Hence cl.5 is novel

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Claim 6

6.1 x

6.2 ✓ coat

Hence claim 6 is novel over D

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**MARKS AWARDED 16.5**

Inventive Step

Applying Windsurfer / Pozzoli:

PSA

CGK

Inventive concept (I.C.) – purposive

Starting point

Differences

Obvious?

PSA includes designers and manufactures of protective garments to prevent dripping when splashed – particularly outdoor garments

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CGK:

→ doc C = many years ago says client letter

→ published in 1980

→ was patented → must have had commercial sense to exploit?

BUT not an outdoors garment as such → apron unlikely to be CGK

therefore C is prior art, not CGK

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→ outdoor weather garments – likely in view of PSA not being limited to a type of garment so would know of cycling coat p17, l. 8-9. Also builders coats from client letter like shown in Fig. 1 of A.

Examiner's  
use only

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### Claim 1

#### Inventive concept

To provide an outdoors protective garment having a guttering and draining function that does not interfere with practices of user p6, L. 26 – 29.

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Doc D is best starting point because relates to outdoor protective garment (cycling coat) whereas C relates to apron (indoors).

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Differences over D and inventive concept ⇒ none → as shown in the novelty analysis the novelty is over D being a one piece garment but this is still item of outdoor clothing. Hence for this reason alone, claim 1 is obvious.

For argument's sake even if the inventive concept instead considered to be providing releasably secured outerwear to be removed and secured with ease by means such as zip, CGK includes outerwear like coat of Fig.1 of A. So providing means for releasably securing would be obvious to skilled person in view of known builder's jackets.

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Adding a zip or the like would not be undue burden on skilled person but would easily be able to modify cycling coat to incorporate buttons of Fig.1, A.

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Hence claim 1 is not inventive.

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### Claim 2

Inventive concept: provide a drain conduit to direct captured water away from wearer.

Differences:

Starting from D – drain ports ensure no dribble from coat onto users legs p13, l.44-45 Provides same technical effect as claim 2 so arguably drain conduit itself isn't inventive.

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Hence claim 2 is not inventive

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Claim 3

Inventive concept:

Providing claimed 1st and 2nd conditions for stowing gutter away when not in use p6 l. 34-38

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Differences:

Starting from D → teaches permanently securing by glue p18, l. 34-35 the runaway to garment. So teaches away from inventive step.

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Nothing in CGK to inventive concept.

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Would skilled person look to doc C? It does teach rearranging gutters as desired but not for stowing away.

Hence claim 3 appears inventive.

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Claims 4 and 5 inventive for same reasons.

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Claim 6

Inventive concept is to wear outerwear over dry clothes

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Skilled person knows of builders coats from CGK and cycling coat from D.

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Hence claim 6 is obvious and not inventive.

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**MARKS AWARDED 11.5**

Sufficiency

As above see construction section – claims 4 and 5 not enabling in view of limitations of “secured” in claim 1 to “not secured” in claim 4.

In fact, claims 4 and 5 appear to relate to separate embodiment of attachable gutter in Fig. 3 rather than integral gutter of Figs. 1 & 2.

Hence, claims 4 and 5 are not enabling → insufficient!

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**MARKS AWARDED 0**

## Amendment

Correct "the drain aperture" to "the one or more drain apertures" for antecedence purposes.

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Claim 3 appears novel and inventive and would be narrowing amendment therefore allowable as post grant amendment by amending claim 1 to include claim 3.

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MARKS AWARDED 0.5

Advice

Oppose?

Breach of confidence? Entitlement?

Prior user rights – no

New filing?

Rights

No granted rights yet so nothing immediately enforceable

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BUT B → to be granted 1 Dec 2019 so will be enforceable of then (ie. 1 Dec 2019) because of London Agreement for automatic validation in UK and 1st renewal not due until end July 2020.

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As an EP → will be in opposition period until 1 Aug 2020 → can centrally oppose till this date!

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Threats → non actionable because client is a manufacturer despite letter from TVBS making evident that B exists and indicating infringement proceedings and client aggrieved

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As discussed above, once granted → client is contributory infringer so risk of infringement proceedings. No prior user defence (see above)

Although we could oppose centrally at EPO once granted → B proprietor could amend to claim 3 to make valid and still enforce against client and client's commercial customers.

BUT client approached TVBS in confidence

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→ check, what was said? Did sign NDA with them?

→ appears likely to be in confidence so TVBS had air of confidence

→ by filing patent to invention TVBS have filed when not entitled!

Also publication of B was breach of confidence!



So, client can sue TVBS for breach of confidence

AND instigate entitlement proceedings

→ advisable since patentable subject matter and in time – up to 2y post grant  
(1 Dec 2021).

→ have to wait till after grant since in admin grant right now?

→ request EPO stay of proceeding

→ file S12 entitlement proceedings for ownership of invention of doc B

Gather together as much evidence as possible that B proprietor stole idea eg.  
NDAs signed, notes from meeting etc.

If successful, can seek for B to be transferred into client's name.

Any bits that B proprietor is entitled to however → can split patent.

Alternatively entitlement at UKIPO

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4.5

**MARKS AWARDED 4.5**