

PATENTS ACT 1977

IN THE MATTER OF an application
under section 72 by Camfil AB
for the revocation of Patent No GB2329854
in the name of Interfilta (UK) Ltd

FINAL DECISION

Background

- 1 On 3 July 2000 Camfil AB applied for revocation of Patent No GB2329854 in the name of Interfilta (UK) Limited. In a decision dated 7 October 2002 [*BL O/391/02*] I held that claim 1 of the patent was not novel and that claim 2 lacked an inventive step. I further found that claim 3 was not novel when appendant to claim 1 and lacked an inventive step when appendant to claim 2. There were no other claims, but since I could not rule out the possibility that there might be some additional feature in the description which could provide support for a valid claim, I gave the patentees an opportunity to submit amendments within eight weeks. They filed proposed amended claims 1 and 2 on 2 December 2002. Camfil objected to them on a number of grounds, and Interfilta then replied disputing all their objections. Both sides then agreed that I should decide whether to allow these amendments on the basis of their written submissions, and that is what I shall now do.
- 2 The principles that I must take into account in considering these amendments are well known and not disputed by the parties, so I do not need to recite either the relevant parts of the statute or the case law in full. It is sufficient to say that the amendments must result in valid claims (so they must overcome the finding of invalidity against the original claims), must not add matter that extends beyond that disclosed in the original patent application, and must not extend the protection conferred by the patent. Further, even if the amendments are otherwise satisfactory, I have the discretion to decline to allow them if the conduct of the patentee has been reprehensible. Case law requires this conduct to be assessed against a fairly high standard.

The amendments requested

- 3 As granted, claim 1 reads:

“A gas filter element comprising a plurality of generally parallel partitions defining generally parallel pockets, each having an upstream open inlet end and a downstream closed end and having opposite walls formed of synthetic fibrous material, in which the parallel partitions extend from the upstream inlet end to the downstream closed end to form pockets and each partition has marginal portions which lie generally parallel to and are ultrasonically welded to the respective walls, whereby in use the air filter exhibits a low pressure drop and a high degree of dust efficiency and dust holding capacity.”

- 4 Proposed claim 1 reads as follows, the alterations (other than purely grammatical ones) being identified by italics:

“An *air* filter element comprising *a header frame and a filter pocket* comprising a plurality of generally parallel partitions defining generally parallel pocket portions, each having an upstream open inlet end and a downstream closed end and opposite walls formed of synthetic fibrous material, and in which the parallel partitions extend from the upstream inlet end to the downstream closed end to form the pocket portions, each partition having marginal portions which lie generally parallel to and are ultrasonically welded to the respective walls, *a short length portion of one edge of each partition adjacent the inlet end not being joined to the inner surface of an adjacent wall whereby to permit flexure of the front end of the pocket so that it may be mounted in the header frame*, whereby in use *the flow of air through the pocket is aerodynamically streamlined or laminar* and the air filter exhibits a low pressure drop and a high degree of dust efficiency and dust holding capacity *in the filtration of dust particles which range from about 0.3 to about 30 microns in size.*”

- 5 These changes add four features to the original claim:

- (a) a header frame is now required;
- (b) a short portion of each partition must not be joined to the adjacent wall (this was the feature of claim 2 as granted);
- (c) the flow of air through the pockets must be aerodynamically streamlined or laminar;
- (d) the filter must exhibit efficient filtration of dust particles in the range of approximately 0.3 to 30 microns.

The changes also alter the introduction of the claim from “gas” filter to “air” filter. The original claim, it will be noted, started off talking about a gas filter but then went on to talk about an air filter, whereas the proposed claim is more consistent in talking about air filters throughout.

- 6 The patentees also propose to retain what had previously been appendant claim 3, now renumbered as claim 2 with appropriate grammatical changes to its introduction. They do not propose to have any other claims.

- 7 I must now consider whether to allow these amendments, taking account of the arguments advanced by each side. There are a number of different aspects to consider.

Discretion

- 8 As I have said, the power to allow amendments is discretionary. Camfil argue that I

should decline to exercise my discretion in the patentees' favour for a number of reasons. In particular, they protest that (a) the patentees have not given full reasons as to why the amendments should be allowed, eg by explaining how the amendments would render the claims valid, (b) the patentees should have realised the original claims were bad much sooner and offered amendments earlier in the proceedings, and (c) the amendments should be refused in the public interest. Initially they also said that the change in the claim category - ie from "gas filter element" to "air filter" - would disadvantage Camfil (though they failed to say how) and would necessitate re-opening the revocation proceedings with further evidence rounds and another hearing. In a later letter, though, they stepped back from this position and said that if I were minded to allow the amendments they would not pursue revocation on the basis of the amended claims.

- 9 These protests by Camfil seem to me to have no substance and to be little more than a deplorable attempt to harass the patentee. On (a), amendments offered following a finding of invalidity are manifestly an attempt to overcome that finding - the patentees hardly need to be required to spell this out. If Camfil are of the view that these amendments do not overcome the validity, then the onus is on them to say why rather than just protesting rather vaguely that they might necessitate further proceedings. On (b), Camfil appear to be saying that the losing party in a dispute should be expected to realise they are going to lose before judgment has been given. That argument is valid only where a case is so hopeless that striking out or summary judgment would have been appropriate. The fact that Camfil sought neither in the present case knocks the bottom out of that argument. Finally, on (c), Camfil have not made the slightest attempt to suggest how the public interest might be harmed, so I can attach no weight to this argument.
- 10 The patentees argue that these amendments are being offered in response to the finding of invalidity, that it was quite proper for them to await that finding before offering the amendments and that their conduct has not therefore been such as to provide a basis for refusing to exercise my discretion in their favour. I agree.

Added matter; extending scope of protection

- 11 Camfil argue that the amendment to claim 1 impermissibly adds matter because the assembly now claimed, including the header frame and a filter pocket, was not unambiguously disclosed or claimed in the patent as granted. They also say there is insufficient disclosure in the specification to support what is now claimed.
- 12 I have to say these arguments are rather muddled. There is no legal requirement that the amended claims must have been claimed in the patent as granted, the test for added matter requires comparison with the original patent application, not with the patent as granted, and lack of support is an issue that is quite separate from added matter. Be that as it may, the patentees argue that the amended claims do not add matter and do have support, and I agree. There is clear disclosure on pages 2 and 4 of the description as filed that the filter element or filter pocket was to be mounted in a header frame. True, the header frame was not specifically described, but the evidence offered previously in these proceedings showed that the header frame is a perfectly

conventional component in such filtering systems, so there was no need to describe it. On the same basis, I cannot see that the amended claim 1 lacks support in the description.

- 13 Camfil also argue that the scope of protection has been extended, though they fail to explain how. The patentees deny this, pointing out that the original claim 1 has been narrowed by the addition of a number of extra features. I agree with the patentees. I cannot see any respect in which the scope of protection has been extended. In particular, including the header frame is not extending the protection, but rather, limiting the protection to the filter pocket when mounted in a header frame.

Novelty and inventive step

- 14 I now turn to the question of whether the amended claim 1 overcomes the finding that the original claims lacked novelty and inventive step. I can deal with novelty very quickly. The amended claim incorporates the feature of claim 2 as granted and in my previous decision I had found this claim to be novel. It follows that the amended claim must also be novel. However, in that decision I found that claim 2 as granted was obvious. Therefore, in order to establish the inventiveness of the amended claim 1, I need to consider whether the features added to the original claim 2, i.e. features (a), (c) and (d) listed above, result in a claim that has the requisite inventive step.
- 15 As I have already said, feature (a) is wholly conventional - filter pockets are designed to be mounted into header frames. In respect of feature (c) the patentees submit that, prior to the invention, filter pockets used span-wise stitching which created turbulent air flow due to the incident air flow hitting the span-wise stitches. In respect of (d) the patentees have stated that, in prior known stitched pockets, dust particles in the size range of 0.3 to 0.5 microns pass through the gaps between stitches and needle holes in stitched bags. They argue that these features give the claim an inventive step.
- 16 The arguments in respect of (c) and (d) might be persuasive if the patentees had to establish inventiveness over prior stitched filter bags. However these arguments overlook the fact that, as I found in my previous decision, the state of the art in question includes welded filter bags. The evidence of one of the patentee's own witnesses, Mr Holt, under cross examination supports the patentees' submission that features (c) and (d) result from the use of welded rather than stitched bags. Consequently the features that have been added to a claim which I have already found to be non-inventive are either wholly conventional or a direct result of using welded filter bags as already proposed in the prior art. Accordingly the addition of these features has not, in my judgment, imparted any inventive step to the claim.
- 17 I should add that if (c) and (d) are not a direct result of using welded bags, that means the patentees' bags must have some additional constructional feature, over and above just being welded, that results in (c) and (d) being achieved. There is, however, no description of any such constructional feature in the specification, so if this were the case, the patent as proposed to be amended would be bad for failure to disclose the invention clearly and completely enough for it to be performed by a person skilled in the art.

- 18 I will now turn to the proposed claim 2. This claim adds to the amended claim 1 the additional feature of original claim 3. However it was conceded at the substantive hearing that the latter added nothing inventive to claim 1 as granted, and I am satisfied that it adds nothing inventive to the proposed amended claim 1 either.

Conclusions

- 19 I have found that the amendments offered do not cure the invalidity of the claims as granted because the amended claims both lack inventive step. Accordingly I refuse to allow the amendments. Having already found that the patent as granted is invalid, I now order that it be revoked.
- 20 For the sake of completeness, I should say that normally amendments would be advertised. As I have refused to allow them, there is no point in doing so.

Costs

- 21 Neither party has so far asked for costs in respect of the request for amendment. Whilst the patentee has lost the application to amend, I have to say that Camfil's contribution to the issue has been of no help to me at all. I am therefore minded to make no order as to costs. However, if either side wishes to seek costs, they should come back to me within 28 days.

Appeal

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

Dated this 20th day of August 2003

P HAYWARD

Divisional Director, acting for the Comptroller

THE PATENT OFFICE