



BL O/172/07

19th June 2007

PATENTS ACT 1977

APPLICANT Mr Seymour Cemoun Daniels
 Mrs Ellie Victoria Daniels

ISSUE Review of Opinion 06/06 - whether
 patent number GB2377152 is infringed

HEARING OFFICER P Marchant

DECISION

1 This is a review of an opinion (“the Opinion”) under sections 74A and 74B of the Patents Act. The Opinion was requested by Mr and Mrs Daniels concerning an alleged infringement of patent number GB2377152, of which they are the inventors and patentees. The Opinion issued on 6 July 2006. The examiner’s view was that the allegation of infringement was not made out.

2 Mr and Mrs Daniels have requested a review of the Opinion under section 74B. Rule 77H(5)(b), made under section 74B, governs the making of applications for reviews in relation to opinions on infringement, and provides as follows:

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

(a)

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

3 Mr and Mrs Daniels’ application for a review accordingly says that the Opinion was in error in its interpretation of the specification and because of that, it wrongly concluded that the alleged infringing act did not constitute an infringement. Mr and Mrs Daniels provided a Statement in support of the request for a review, dated 3 October 2006 and further submissions by letter on 16 May 2007.

4 No observations were received in relation either to the Opinion or to the review.

The Effect of the Review

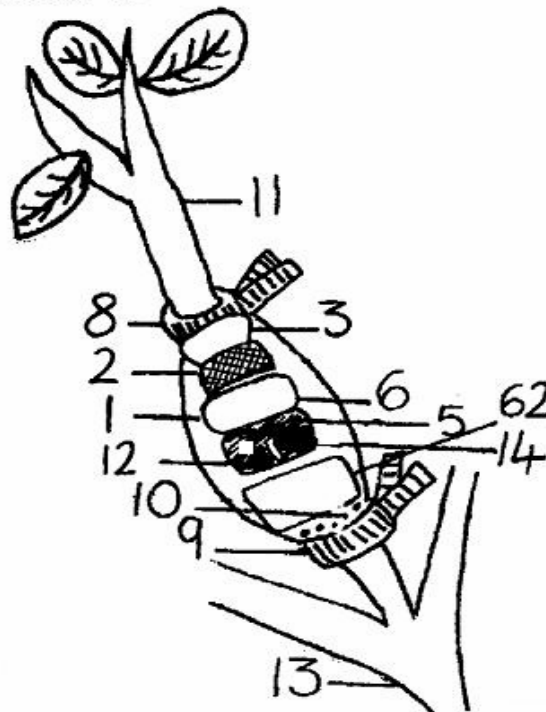
5 I considered the purpose and effect of reviews of opinions in a previous decision¹ and I note from that consideration firstly that the grounds on which the present review has been requested fall within the scope of rule 77H(5)(b). I note secondly, that opinions are not binding for any purpose, and if the whole or a part of the Opinion remains in place after this review, its status will be unaffected and it will continue to be non-binding for any purpose.

The Patent

6 The Opinion sets out the nature of the invention in its paragraph 3, which reads as follows:

“3. The patent relates to an air layering device which is used to initiate root growth on the stem of a plant before a cutting is taken. The following drawing is typical of the fifteen figures provided with the specification:

FIGURE 1.



1. Review of Opinion 04/06 BL O/025/07 18th January 2007

The device of the invention is a container 1 which, in use, is sealed to a stem of a plant at the top 8 and bottom 9 of the container and is provided with a hole 2 with cover 3 through which rooting materials (soil, compost, water etc) may be added; further holes 10 for drainage; a viewing window 5 with cover 6 to observe root growth 12 without damaging that growth; and an attached solar panel 62 with heating element. All of the described drawings have all of these features provided on the container which may take a number of forms including one in which it is formed in two parts.”

7 I consider this to be a fair outline of the disclosure of the patent. The Opinion goes on in paragraphs 4 to 6 to set out what is claimed, as follows:

“4. There are eight claims of which claims 1 and 8 are the only independent claims. The requesters, Mr. and Mrs. Daniels, argue that the patent is infringed which I take to mean that they believe that one or more of the claims are infringed.

5. Claim 1 reads:

An invention to take cuttings from plants comprising a container which is attached to the area of the twig/stem/branch of the plant to be used as a cutting, a hole near the top of the container, for the soil/compost/water/rooting liquid/equivalent rooting material, which has a cover, a viewing window in the container that has a cover, a seal at the top and bottom of the container to ensure a snug fit to the twig/stem/branch of the plant, holes in the bottom of the container for drainage, and an attached solar panel with a heating element with an on and off setting.

6. Claim 8 reads:

An invention to take cuttings from plants as described herein with reference to Figures 1-15 of the accompanying drawings.”

8 I shall also set out claim 6 since I refer to it below:

6. A container according to claims 1 to 4 in which the solar panel is a removable attachment.

Interpretation of the claims

9 The Opinion then sets out, in paragraph 10, the examiner’s approach to interpreting the claims. It is as well for me to discuss this aspect in detail since the Requesters’ view of infringement, as revealed in their Statement and further submissions, does not seem to involve a clear link between what is claimed and what infringes.

10 I will cite the relevant parts of the Patents Act that govern infringement in order to make this point abundantly clear. Section 60 says that a person infringes a patent if he does infringing acts in relation to “the invention”. Section 125 defines “the invention” by saying that it “shall be taken to be that specified in a claim of the specification”. The precise wording and the interpretation of the claims are therefore of crucial importance in determining whether an activity does or does not infringe.

11 It is indeed the whole purpose of the claims to define the scope of the monopoly to which the patentee is entitled and therefore, as an inevitable result, also the field within which third parties are not allowed to trespass without permission from the patentee. If it were possible for the patentee to say after a patent had been granted that certain features of the claims were not really essential, it would be impossible for anyone to assess the scope of the monopoly and there could be no certainty for third parties as to what they could and could not do in relation to a patent.

12 That is not the position. The patentee is bound to the wording of the claims, and there are principles of claim interpretation, based in the legislation and elaborated in a body of case law, which govern how the scope of a claim, and therefore the monopoly afforded by a patent, is to be assessed. The examiner has correctly set out the main principles in paragraph 10 of the Opinion. I would add one further principle, from the judgment of Hoffmann LJ in *Kirin Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, that the claim should be interpreted on the basis of “what a person skilled in the art would have thought the patentee was using the language of the claim to mean”.

Reviewing the Opinion

13 Based on those principles, the examiner has assessed the invention defined in claim 1 and concluded, correctly in my view, that the invention according to the claim (and therefore also any infringing article) must necessarily include all the following features:

- a. a container which can be sealed at the top and bottom to a twig, stem or branch, the container having;
- b. a hole near the top, for introducing materials, with cover;
- c. a viewing window and cover;
- d. holes at the bottom of the container for drainage; and
- e. an attached solar panel with heater and switch.

14 Turning to the Statement, the Requesters say in their ninth paragraph that the examiner was mistaken in interpreting the invention so as to include a solar panel as an essential feature. The same point is made in paragraph 4 of their further submissions. These paragraphs respectively read:

“Section 15 of the opinion is wrongly interpreted as the solar panel is a removable attachment. In the description it is clearly written that it “can”

be rather than that it “is” a permanent fixture as it is not a permanent fixture. Each diagram shows a solar panel to avoid infringement problems in the future. The solar panel is to be sold separately as it is for autumn/ winter use and the main growing times for plants are spring and summer.”

“The solar panel does not have to be present in “Cuttings Made Easy”. Claim 7 of Cuttings Made Easy states that it can be removed. It is not a permanent fixture. Cuttings Made Easy can be sold without a solar panel. P10 of the description clearly states that it “can be attached to the various containers/bag when needed”. The solar panel can be sold separately.”

15 In the second passage, I take “claim 7” actually to mean “claim 6”, which is where this feature is claimed. The proposition put forward by the Requesters is that although claim 1 recites “*and an attached solar panel with a heating element with an on and off setting*”, a solar panel is not an essential feature of the invention. This can not be the case. The claim requires “an attached solar panel” and following the principles of claim interpretation such a claim can be infringed only by an article which includes an attached solar panel.

16 To address the arguments made by the Requesters; I take the feature that the solar panel is a “removable attachment” as claimed in claim 6 to define an arrangement in which the solar panel with heating element etc is provided, as is required by claim 1, and in which, in addition, the solar panel can be removed. Claim 1 will only be infringed by arrangements which include a solar panel with a heater, along with all the other requirements of the claim. Claim 6 will only be infringed by articles which have all the features of claim 1 (including the solar panel) and which also have the feature that the solar panel is a removable attachment. It is not infringed by articles which have no solar panel at all.

17 The reference in the description to the solar panel optionally being a permanent fixture and which “can be attached to the various containers/bag when needed” is consistent with what is claimed and does not suggest claim 1 should be interpreted in any way other than that it requires a solar panel to be provided. The remainder of the description is also consistent with this interpretation, since each of the 15 embodiments shows and describes a solar panel. I do not consider that these arguments overturn the straightforward interpretation of claim 1, that it must include a solar panel.

18 The other arguments raised by the Requesters, in their Statement and further submissions, do not address the question whether the examiner’s interpretation of the specification of the patent was misdirected. They relate instead to whether the alleged infringing article does or does not include one or other of the features of the claim. The fourth and fifth paragraphs of the Statement and paragraphs 5 to 8 of the further submission say that the alleged infringing article does in fact have a viewing window with a cover, while the seventh paragraph of the Statement and paragraph 9 of the further submission say that it does involve holes at the bottom of the container for drainage. However, even if these arguments were entirely valid, as provided in rule

77H(5)(b) it is not the purpose of this review to revisit what was said in the Opinion on those points, only to assess whether the Opinion interpreted the specification correctly. Consequently they can have no effect on the outcome of this review, and I must decline to consider them.

Conclusion

19 The purpose of this review has been to assess whether, to quote from rule 77H (5)(b); “by reason of its interpretation of the specification of the patent, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.” I am satisfied that the Opinion has interpreted the specification correctly, and in particular claim 1 and claim 6, and as a result I make no order to set the Opinion aside.

Appeal

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

P Marchant

Deputy Director acting for the Comptroller