

PATENTS ACT 1977

BETWEEN

Winther, Browne and Company Limited

Claimant

And

Valor Limited

Defendant

PROCEEDINGS

Application for revocation under section 72 of the Patents Act 1977 of
patent number GB 2402468

HEARING OFFICER

J Elbro

Hearing date: 16 November 2011

DECISION**Introduction**

- 1 Patent Number GB 2402468 (“the patent”) was granted to Valor limited (“the defendants”) on 7 June 2006. It relates to a heating appliance that can operate even when exhaust gases cannot escape from the normal flue.
- 2 Prior to the launch of the present proceedings the patent was the subject of an Opinion request by Winther Browne (the “claimants”) under Section 74A of the Patents Act 1977 (“the Act”) as to whether the patent as granted was novel. The Opinion (15/08) was issued on 11 September 2008, finding the patent not novel. The defendants subsequently sought a Review of that Opinion under Section 74B, which was duly issued as BL O/179/09 on 26 June 2009.
- 3 The claimants launched proceedings seeking revocation of the patent on 25 September 2009 under Section 72 of the Act. The defendants filed a counterstatement on 8 December 2009. This contested the construction of claim 1 that the claimants’ argument was based on, but also included a conditional amendment to claim 1 should the claimants’ construction be upheld. In response to this, the claimants submitted a supplemental statement of claim on 18 January 2010, to which the defendants responded in turn with a revised counterstatement, on 15 February 2010.

- 4 I issued a Written Preliminary Evaluation on the case on 1 June 2010 in the hope of making further prosecution of the case as smooth as possible. The defendants lodged a further revised counterstatement on 24 September 2010.
- 5 The case then proceeded through the evidence rounds. As a result of the claimants filing an expert witness statement from a Mr Kevin Williams, the claimants sought to refine their statement of claim through a further supplemental statement on 10 August 2010, while the defendants objected to the form of Mr Williams' evidence. I dealt with both these matters at a Case Management Conference (CMC) on 10 September 2010, as a result of which I admitted the supplemental statement of claim, and the claimants filed a revised form of Mr Williams' evidence (of which, more below).
- 6 The substantive matter finally came before me at a hearing on 16 November 2011 where the claimants were represented by Dr Michael Spencer of the Patent Attorneys Bromhead Johnson and the defendants were represented by Mr Nicholas Manley of the Patent Attorneys W.P Thompson & Co.

The patent

- 7 The patent concerns a heating appliance such as a domestic gas fire where the heat source is located within a housing and a flue is provided to allow exhaust gases to be conducted away eg through a chimney. It is possible for such fires to be "open" fronted in which case combustion air can enter the appliance from the front without the need for any additional inlets. However open fronted appliances are required to be used with a hearth which adds significantly to the space taken up by the appliance. One solution that allows the hearth to be dispensed with is for the appliance to be fitted with a transparent barrier at the front such that the fire can still be seen but is less hazardous. When such a barrier is present an air inlet must be provided to allow combustion air to reach the heat source.
- 8 The patent seeks to solve a problem that might occur in an appliance fitted with such a barrier when the exhaust flue gets blocked or there is a down draught. In such a situation the patent says the combustion products cannot be exhausted from the appliance resulting in incomplete combustion and the build up of harmful combustion products that might escape into the room. The invention of the patent solves this problem by providing a gap between the barrier and the housing through which combustion air and exhaust gases can flow.
- 9 Claim 1 as granted reads as follows:

A heating apparatus comprising

a housing,

a combustive radiant heat source located within the housing,

a primary venting means for exhausting combustion products out of the housing and

a barrier formed from transparent material as hereinbefore described located in front of the heat source,

wherein the barrier is spaced from the housing, thereby defining a gap between the barrier and the housing to allow a gaseous flow to the heat source and to provide a secondary means of exhausting combustion products from the heat source out of the housing in the event that exhausting via the primary venting means is hindered or prevented.

The status of the Opinion and the Review

- 10 I will first deal with a preliminary matter regarding how I should treat the Opinion and Review previously issued by the Office on the patent. The status of these were something of an issue between the parties. In his submissions Dr Spencer seemed to suggest that some weight should be given to the views expressed by the examiner in the Opinion. For his part Mr Manley sought to have all mention of the Opinion and subsequent Review removed from the present proceedings, reflecting a consistent argument from the defendants throughout.
- 11 Sections 74A and B are the provisions of the Act that deal with Opinions and their review respectively. Section 74A(4) reads
 - (4) An opinion under this section shall not be binding for any purposes.
- 12 That seems to me as clear and unequivocal statement of the status of an Opinion as one can get. What is more, there is nothing in the provisions relating to the Review that change the status of an Opinion. Even if upheld on Review (as was the case with this patent) the Opinion is not binding for any purposes.
- 13 Dr Spencer argued that as the Opinions were statutory based, they must have a purpose and therefore should at least bear weight. Mr Manley countered that section 72 revocation proceedings were likewise statutory and entirely separate.
- 14 It seems to me that the Opinions are a statutory service provided by the Office under particular restrictions – without, for example, oral evidence or cross-examination available in proceedings such as the present ones. They provide a valuable expert opinion based on the evidence available, but no more than that. That an examiner has found one thing based on the evidence before him does not read across to what I should find based on the different evidence before me.
- 15 Having said that however I consider that Mr Manley's earlier submissions that all references to the Opinion and Review should be struck out went too far. He did not pursue that argument at the hearing but I would say that it seems entirely reasonable to me that a party might make submissions to the effect that "the patent as granted is invalid for the reasons given in the Opinion". I fail to see how that is suggesting that the Opinion is in any way binding.
- 16 For the avoidance of any doubt I find that I am not in any way bound or influenced by the Opinion or the Review and have reached my decision in this dispute on the basis of all the evidence presented to me, with the onus being on the claimants to make the case for revocation.

The Expert Witness

- 17 Before turning to the substance of the issues raised, I will make some observations on the evidence in the case.
- 18 The claimants put forward Mr Kevin Williams as an expert witness. Mr Williams is a Director of an organisation called Hurtwood Limited which he explained was a consultancy firm offering advice to organisations on the efficient heating of their premises. He is a qualified engineer with some 16 years' experience in the heating industry. Under cross examination it emerged that he had an excellent practical understanding of the principles of combustion (even if his theoretical knowledge was less good) but that his real specialism was in large scale heating installations rather than the domestic appliances with which the invention is concerned. The extent to which this was an issue is somewhat doubtful, however, as the science involved in this case was not greatly theoretical or specialised.
- 19 Worryingly, though, while I do not question Mr Williams' honesty, under cross examination it emerged that his status as an independent witness was somewhat questionable. Whilst he had no specific link with the claimants, after considerable probing by Mr Manley, Mr Williams revealed that he was familiar with Dr Spencer and Bromhead Johnson as they had acted for him in some patent matters. I am surprised that this was not made clear in Mr Williams' witness statement (either as filed or as amended) or with less questioning from Mr Manley, particularly since the form of his witness statement – and in particular making clear Mr Williams' instructions and relationship to the parties – had been a significant issue at the CMC.
- 20 However, in the event, as will be apparent from the later parts of my decision, it does not appear that any crucial point turns on the credibility of Mr Williams' evidence.

Other evidence

- 21 The only other evidence filed related to some test results carried out by Mr Peter Gilmour, one of the defendants' Senior Development Engineers, on a heating appliance said to be according to the invention and thus protected by the patent. That evidence was uncontested and demonstrated gaseous flows at various locations near the gap between the barrier and housing of the appliance in normal and blocked flue modes of operation.

The Main Issues

- 22 The interpretation to be given to claim 1 is at the heart of this dispute. The defendants' case is basically that claim 1 requires the flow of combustion air in and exhaust gases out via the gap to be simultaneous when the normal exhaust route is not available. They argue that simultaneous flow is novel and inventive over the prior art and thus that claim 1 as granted is novel and inventive, and the patent valid. The amendment offered is conditional upon me finding that the claim as granted is not limited to simultaneous flow in and out, and would explicitly impose that limitation.
- 23 The claimants' case is basically that claim 1 as granted is not limited to simultaneous inward and outward flow and thus is not novel over the prior art. They consider the

proposed amendment should not be permitted as it adds matter, the claim as proposed to be amended is still not novel and inventive, is unclear and the invention is not capable of industrial application.

- 24 I will consider first the validity of the patent as granted, and then that of the patent as proposed to be amended.

The Patent as granted

Construction of the Claim

- 25 It is well established that the approach that I must adopt in construing the claim is as set out by Lord Hoffman in his judgment in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd [2005] RPC 9*. At paragraph 34 he said:

“The question is always what the person skilled in the art would have understood the patentee to be using the language of the claims to mean. And for this purpose, the language he has chosen is usually of critical importance. The conventions of word meaning and syntax enable us to express our meaning with great accuracy and subtlety and the skilled man will ordinarily assume that the patentee has chosen his language accordingly. As a number of judges have pointed out, the specification is a unilateral document in words of the patentee’s own choosing. Furthermore, the words will usually have been chosen upon skilled advice. The specification is not a document *inter rusticos* for which broad allowances must be made.”

- 26 As indicated above, the key question in this dispute is whether claim 1 as granted requires the gap to simultaneously provide flow of combustion air to the fire and exhaust gases from it when exhaust via the normal flue is not possible (the “abnormal” mode of operation). The claimants say it is not so limited; the defendants that it is. Neither side put forward detailed forensic arguments in favour of their interpretation; indeed, each appeared to consider their interpretation to be manifestly correct. Mr Manley made particular pains to emphasize the correct construction was a matter for myself alone.
- 27 It appears to be common to both parties’ interpretation that in the “abnormal” mode of operation the exhaust gases are vented through the gap. The difference between them is whether the claim requires combustion air to enter “simultaneously”. (The claimants took a point on the meaning of simultaneously that I discuss below in the context of the proffered amendment, but in view of my conclusions here that does not matter for construing the original claim).
- 28 It is immediately apparent from the wording of the claim that the requirement that inward and outward flow must be simultaneous is not explicit in the claim. The defendants’ interpretation of the claim therefore relies upon that limitation being implicit from the teaching of the specification. The question to be answered it seems to me is whether the skilled man would understand the description to teach that in the abnormal mode of operation, air for combustion necessarily enters via the gap.
- 29 It is clear that air for combustion can enter through the gap in at least some circumstances. For example the second complete paragraph on page 5 of the patent, when describing the abnormal mode, states:

“In the event of a blocked exhaust flue or in the case of a downdraught down the flue, it is not possible for the combustion products to exit via the flue in the normal manner. However, in such circumstances, the provision of the gap 42 between the glass sheet 36 and the front wall of the heater allows combustion products to escape into the room where the heater is located. Although this is obviously not ideal, it does allow combustion to continue relatively unhindered (particularly since entry of fresh air via the gap 42 results in more efficient combustion) and prevents the formation of dangerous levels of harmful products (eg carbon monoxide) which can result from incomplete combustion.”

- 30 However, it is far from apparent that this necessarily occurs in the claimed invention. As can be seen from the passage above, the specification makes it clear that the abnormal mode can be caused by a downdraught whereby air entering via the flue prevents exhaust gases escaping via that flue. There is no evidence before me as to how air flows in or out of the gap in this situation (the tests conducted by the defendant I refer to elsewhere were limited to the situation where the flue was blocked). However it seems to me that a significant downdraught will provide ample air for combustion and force the exhaust gases to escape via the gap, without necessarily allowing air to enter via the gap. Certainly, I believe that the skilled man would not understand the description to teach that combustion air necessarily enters via the gap.
- 31 Furthermore, one of the prior art arrangements described in the patent is a gas fire where the opening is covered by a barrier having no gap. Such an arrangement requires a specific inlet to allow combustion air to enter. The present invention modifies the prior art fire by introducing a gap, but no mention is made of this meaning the additional inlet is not needed. This reinforces my view that the skilled man would not understand the patentee to be insisting that air for combustion must be able to enter through the gap.
- 32 Hence I find that the skilled man would not consider the invention to require simultaneous flow of combustion air in and exhaust gas out in the abnormal mode of operation and thus that on a proper construction, the claim is not limited to the “simultaneous” situation.

Novelty

- 33 I have found above that, as the claimants contended, claim 1 as granted is not limited to arrangements where the gap provides simultaneous flow of combustion air in and exhaust gases out of the appliance. The claimants argue that when given that interpretation, claim 1 as granted is not novel in light of the disclosures in FR2617270 ('270) & FR2653534 ('534). (At the hearing they did not pursue an attack based on a further document, US5421321 which had been raised at earlier stages).
- 34 At the hearing, Mr Manley, for the defendants, argued that even under this interpretation (which the defendants disputed as I note above), claim 1 was novel (and inventive). This point had not been clearly raised by the defendants at any previous stage in the proceedings, and indeed was not present in Mr Manley's skeleton argument, but Dr Spencer did not object to it being raised (though he obviously disputed its merit).

- 35 Looking at the documents relied on in turn: '270 discloses a wood or ligneous fuel burning appliance comprising a closed fireplace having a glazed door and an inlet for primary and/or secondary combustion air towards its top. A variety of embodiments are disclosed including one where there is a single route for air to enter the appliance and another where there are two for allowing primary and secondary combustion air to enter. In this context primary combustion air refers to air used to burn off the fixed carbon from the fuel and secondary combustion air refers to air used to burn the released carbon. Thus "secondary" is used in a different context to "secondary" as used in granted claim 1 which relates to the route for exhaust gases in the "abnormal" operating mode.
- 36 '534 concerns an adaptation to the glass door of an existing heating appliance whereby a gap is left at the top of the door to allow air to enter the appliance, that air acting as a source of combustion air to prevent premature blackening of the glass by soot from the fire.
- 37 In assessing their relevance, the first point I note is that whilst the embodiments described in the present patent (and indeed all the discussion at the hearing) focus on gas appliances, the claim contains no such limitation and thus also covers heating appliances using other fuels. Thus the relevance of the citations is not affected by their not disclosing gas fuelled appliances.
- 38 It is clear that both these documents disclose appliances having the features specified in the pre-characterising portion of claim 1. Furthermore, they provide a gap which allows combustion air to enter the appliance. The difference between the parties is whether they disclose "a secondary means of exhausting combustion products from the heat source out of the housing in the event that exhausting via the primary venting means is hindered or prevented."
- 39 Neither document makes any mention of operation when exhaust via the normal flue is inhibited or indeed of the passage of exhaust gases from the fire via any route other than the normal flue. The claimants' case is that that does not matter because in the event of its flue being blocked the exhaust fumes would necessarily escape via the gap provided in the arrangement disclosed in either one of the prior art documents.
- 40 In support of this attack they sought to rely on Lord Hoffman's judgment in *Synthon BV v Smithkline Beecham Plc*¹ where he said:

"Although it is sometimes said that there are two forms of anticipatory disclosure: a disclosure of the patented invention itself and a disclosure which, if performed would necessarily infringe the patented invention they are both aspects of a single principle, namely that anticipation requires prior disclosure of subject-matter which, when performed, must necessarily infringe the patented invention."

In the claimants' view, both French documents disclose subject matter which in the event of a problem with the regular flue, would necessarily infringe the patent and thus anticipate the patented invention.

¹*Synthon BV v Smithkline Beecham Plc* [2005] UKHL 59

- 41 The defendants, on the other hand, contended that there is no evidence to support the view that the gap in either of these documents provides for the exhaust of combustion products in the event of a blocked flue. In addition to there being no specific disclosure of this mode of operation in the prior art being relied upon, Mr Manley argued that the skilled man would not need to consider exhaustion in this mode and would have no motivation for sizing the gap so as to make it suitable for exhaustion if the flue became blocked.
- 42 In my view the defendants' arguments somewhat miss the point. It seems to me that the motivation of the skilled person to consider exhaustion in this mode and thus the appropriate dimensions of the gap to allow it to act as a secondary exhaust is irrelevant to this particular question. The issue here is whether the gaps provided in the prior art arrangements for the supply of combustion air would necessarily act as an exhaust in the abnormal mode. In my view they would. I accept that neither document mentions or even hints at the possibility of the gap providing an exhaust role. However, in the event that the normal flue becomes blocked or a downdraught occurs, the exhaust gases would be forced out of any available gap either by a build up of pressure or by the downdraught. Thus in the event of a blocked flue or downdraught my view is that exhaust gases would escape via the gaps in the prior art arrangements. In my view the test for anticipation outlined in *Synthon* is met and claim 1 as granted is anticipated by FR2617270 and FR2653534.
- 43 The claimants also argued that claim 1 as granted was invalid on the basis of a lack of novelty through "the skilled person's common knowledge" and "prior use". In support of this Dr Spencer highlighted that claim 1 covers an embodiment in which the barrier is formed from a number of strips of glass with gaps between them. Drawing upon Mr Williams' witness statement, Dr Spencer argued that this embodiment was functionally equivalent to the sorts of gas fire that were common place before the priority date of the invention whereby the opening was covered by a metal grill or piece of glass.
- 44 I note that this argument appeared very late in the proceedings and consequently the arguments are not very well developed. Furthermore there is very little in the way of evidence to support the attack and as I have already said, I do not feel able to place great reliance on Mr Williams' evidence. As I have already found claim 1 to lack novelty on the basis of specific pieces of prior art, I do not consider it necessary to dwell on this particular attack.
- 45 Finally, Dr Spencer argued that should I find against him on novelty, any difference would still lack an inventive step. Mr Manley objected strongly that this allegation was raised too late. However, having found claim 1 to lack novelty, I consider these arguments moot.
- 46 It is also not necessary for me to decide whether the dependent claims are novel and inventive since, as noted above, the defendants have filed a request to be allowed to make an amendment to claim 1 in the event that I find it invalid. I therefore turn to this amendment.

The proposed amendment

- 47 The proposal is to amend claim 1 so that the characterising part of the claim reads:

“wherein the barrier is spaced from the housing, thereby defining a gap between the barrier and the housing which allows a gaseous flow to the heat source and simultaneously provides a secondary means of exhausting combustion products from the heat source out of the housing in the event that exhausting via the primary venting means is hindered or prevented.”

- 48 The effect of this would be to explicitly limit claim 1 to an arrangement whereby the gap provides simultaneous two way flow during the “abnormal” mode of operation.
- 49 The claimants opposed that amendment on a number of grounds: added matter, lack of novelty/inventive step, and lack of industrial application. They have though acknowledged that following the decision in *Zipher Ltd vs Markem Systems Ltd*² what they consider to be the unreasonable delay in proposing the amendment by the defendants is not a reason for refusing it. The proprietor’s conduct as regards amendment could however have a bearing on costs which I will return to later.

Added matter

- 50 The first ground upon which the claimants opposed the proposed amendment to claim 1 was added matter. They argued that the specification as filed made no mention of the inward and outward flow through the gap being simultaneous and that the amendment is an attempt to introduce a feature into the specification that was not originally envisaged by the applicant. In support of that argument Dr Spencer impressed upon me that it is settled law that a patent application is a document drawn up unilaterally by the applicant/patentee which can include or exclude any feature desired at that time. That is clearly reflective of Lord Hoffman’s comments on claim construction from *Kirin-Amgen* that I refer to above. Dr Spencer put it to me that if the applicants envisaged the arrangement as providing simultaneous inward and outward flow, surely they would have used that wording somewhere in the specification. He said that since there was no such mention of simultaneous two-way flow in the specification as granted, introducing it now would be contrary to Section 76(3)(a). He also pointed to the proposed amendments also seeking to amend the statement of invention to have the same wording of claim 1 as further evidence that the description does not provide support for the inclusion of the “simultaneous” feature in claim 1.
- 51 Whilst the word “simultaneous” clearly does not appear in the description I do not consider the proposed amendment would result in the disclosure of additional matter contrary to Section 76(3)(a). As I have outlined when construing the original claim 1 above, whilst I do not consider claim 1 as granted to be limited to the gap providing simultaneous two way flow, such an arrangement is clearly envisaged in the specification – and indeed highlighted in the section I quote above –and its inclusion as an additional limitation to the claim does not add matter.
- 52 That the proposal also includes a corresponding amendment to the description is in my view merely reflective of the common practice of making the statement of invention (also commonly known as the consistory clause) consistent with the independent claims.

² *Zipher Ltd v Markem Systems Ltd & Anr* [2008] EWHC 1379 (Pat)

Clarity

- 53 The claimants have also questioned what “simultaneous” means in this context. Indeed Dr Spencer sought to suggest it could be given two interpretations and thus was unclear. On the one hand, he suggested that it could mean that during abnormal operation, the gap provides simultaneous two way flow at any particular point. Alternatively he suggested it could be interpreted as the gap as a whole providing simultaneous two way flow in that mode such that at any given point, flow is only in one direction. For example cool combustion air enters at the bottom with hot exhaust gas exiting at the top because of convection.
- 54 I consider that the skilled person would understand “simultaneous” to be being used in an entirely temporal sense and would not consider it to impose any spatial limitation on the flow. Thus I consider the claim as proposed to be amended is clear in this respect – during abnormal operation the gap must provide inward and outward flow at the same time.

Novelty

- 55 The claimants further contended that the proposed amendment should not be allowed because the claim as amended would not be novel or inventive. As regards novelty, they pursued the same two pronged attack as they mounted against the claim as granted ie based on specific prior art documents (ie FR2617270 and FR2653534) and on common general knowledge and prior use.
- 56 Looking at the specific prior art attack first, the claimants argue that any gap that is big enough will permit a free flow of air into and out of the combustion chamber and that consequently the gap in either French patent will anticipate this feature. They say it does not matter that the size of the gap is not specified in these documents since it is equally not mentioned in the claim as currently proposed.
- 57 As neither document envisages the gap providing an outlet for the exhaust gases, it is of course inevitable that the prior art documents do not disclose the gap providing simultaneous two-way flow. Thus the only way that the prior art documents can be said to anticipate the proposed claim is if, following *Synthon*, they disclose subject matter that would necessarily infringe the patent. For that to be the case the arrangements of the prior art documents would necessarily need to provide simultaneous two-way flow in the abnormal mode.
- 58 Whilst in my consideration of the claim as granted I found it to be inevitable that exhaust gases would escape via the gaps in the prior art documents, I do not consider it inevitable that combustion air will flow in through them at the same time. Dr Spencer’s argument was that “any gap that is big enough” will provide the two-way flow. However, the gaps in the prior art documents are sized to provide inward flow of combustion air but not necessarily two way flow – in other words they are *not* necessarily big enough to provide the two way flow. Thus the claimants have not demonstrated that the prior art documents anticipate proposed claim 1.
- 59 In their remaining novelty attack the claimants argued that the invention of proposed claim 1 is functionally equivalent to a fire with a gap at each of the top and bottom of the front of the combustion chamber and that Mr Williams’ evidence was that fires

with such features were commonplace at the priority date of the invention. Alternatively, the claimants argued that if proposed claim 1 encompasses the embodiment of claims 9 and 10, then it would be anticipated by the commonplace domestic fires fitted with wire meshes across the opening as stated in Mr Williams' witness statement. Although Mr Manley dismissed this as lacking "a transparent barrier", Mr Williams' evidence did also refer to transparent strips in place of a wire mesh.

- 60 However, I do not believe Mr Williams' evidence went as far as Dr Spencer wished it to go. Mr Williams' evidence did not explicitly address the question of whether, if the flue was blocked, air would simultaneously be able to enter through those gaps at the same time as combustion products were being vented. I do not consider the claimants to have presented sufficient evidence for this strand of their case to succeed.

Inventive Step

- 61 The claimants have also argued that the proposed amendment of claim 1 should not be allowed because it is not inventive. They suggest that even if the claim is novel over the prior art documents relied on (by virtue of the gap not being suitably sized to allow simultaneous two-way flow) it is not inventive over them since it would be obvious to the skilled man to vary the size of the gap until it was suitable. For their part the defendants argue that this is a bold assertion which is not backed up by any evidence and that the claimants have failed to make their case sufficiently to succeed on this ground.
- 62 The test to be followed in determining whether an invention involves an inventive step is of course that set out by the Court of Appeal in *Windsurfing*³ as modified in *Pozzoli*⁴. This was referred to by Dr Spencer when outlining his case at the hearing, although not explicitly applied in his specific challenges on inventive step.
- 63 The *Pozzoli* test comprises the following steps:
- 1 (a) Identify the notional "person skilled in the art"
(b) Identify the relevant common general knowledge of that person;
 - 2 Identify the inventive concept of the claim in question or if that cannot readily be done, construe it
 - 3 Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
 - 4 Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention.
- 64 Nothing appears to turn on the identity of the skilled person or common general knowledge. The inventive concept of the claim as amended appears to be

³ *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59

⁴ *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588 [2007] All ER (D) 275 (JUN)

recognising that the gap between the barrier and the housing can act simultaneously as both inlet and exhaust in the abnormal mode. The difference between the prior art French documents and the invention is that the gap is specifically sized to allow this.

65 The claimants argued that it would be obvious for the skilled man to adjust the gap in either of the French prior art documents so that they are suitable to provide simultaneous two way flow. However the gaps in those documents are provided with the sole intention of acting as inlets. Moreover the documents are not remotely concerned with the passage of exhaust gases or emergency operating conditions. I can see no reason whatsoever why the skilled man would have any motivation to make the adjustments necessary to what is disclosed in those documents to allow two way flow without prior knowledge of the present invention – and assuming that prior knowledge is precisely what step 4 forbids.

66 I therefore do not consider the amended claims obvious.

Lack of industrial applicability

67 The remaining ground on which the claimants opposed the proposed amendment to claim 1 is that the invention in that claim is not capable of industrial application. In support of that position the claimants drew upon Mr Williams' evidence which suggested that it was not possible for the same gap to be sized so as to provide the correct amount of air for efficient combustion in the normal (open flue) mode and safe two-way flow in the abnormal mode. In short Dr Spencer argued that a gap large enough to allow safe operation in abnormal mode would be too big to provide efficient combustion in normal mode. Dr Spencer highlighted that the specification is silent as to the dimensions of the gap that could do this and indeed that the arrangement in the proposed claim does not work in any meaningful technical way.

68 During the hearing there was extensive discussion around the purpose of the invention and in particular whether the primary motivation behind it was one of efficiency or of safety. Indeed much of the cross examination of Mr Williams focussed on this as much of the evidence was directed to whether the invention could operate efficiently. For his part Mr Manley argued that issues of efficiency were irrelevant since nowhere in the specification is it claimed that the invention has anything to do with improving efficiency. I agree with Mr Manley on that. In my view it is clear that the primary motivation underlying the invention is safety. In particular the motivation is how to provide safe operation in the abnormal mode albeit without overly compromising efficient operation in normal mode.

69 Ultimately I think this boils down to whether or not an appliance meeting the requirements of proposed claim 1 would work. To that end the defendants provided uncontested evidence from Mr Peter Gilmour, on the basis of experiments he conducted, that an appliance made according to the invention would work. Based on that evidence I conclude that the claimants have failed to show that the invention of proposed claim 1 is not capable of Industrial application. That the appliance might not be hugely efficient is of no bearing.

Conclusion

- 70 I have found that claim 1 as granted is not limited to simultaneous two-way flow under abnormal exhaust conditions. In light of that interpretation I have found that claim 1 as granted is not novel over the disclosures of FR2617270 & FR2653534 and the patent as granted is invalid.
- 71 The conditional amendment proposed by the defendants is governed by section 75 of the Act (having been proposed in the course of revocation proceedings before the Comptroller). I order that the proposed amendments should be formally requested within four weeks of the date of this decision and that they are then advertised in accordance with section 75(1). If the amendments are not formally requested within that period the patent will be revoked unless there is an appeal of this decision lodged within the time period for appeal.

Certificate of Contested Validity

- 72 At the hearing, the defendants requested that I issue a certificate of contested validity under Section 65 in the event that I found the patent to be valid. Section 65(1) provides that

If in any proceedings before the court or the comptroller the validity of a patent to any extent is contested and that patent is found by the court or the comptroller to be wholly or partially valid, the court or the comptroller may certify the finding and the fact that the validity of the patent was so contested.

- 73 In the present case the claimants have contested the validity of both the patent as granted and as proposed to be amended. I have found above that as granted the patent is invalid but that as proposed to be amended would be valid. It would therefore seem appropriate that the issuing of such a certificate should be considered if and when the proposed amendments are effected.

Costs

- 74 The claimants have succeeded in that I have found the patent in its original form (which the defendants sought to maintain) invalid. They have not however won on everything as I have allowed the defendants' proposed amendment and found the resulting patent valid, both of which the claimants contested. Furthermore Dr Spencer accepted at the CMC that a contribution to costs in light of the claimants' additional grounds for revocation of 10 August 2010 was appropriate.
- 75 Neither side argued for an award of costs departing from the usual Office scale. The hearing was a relatively short one lasting less than a day, and although it involved cross-examination of a witness, the evidence was not extensive. Dr Spencer argued that the defendants should have amended the patent earlier, and that although, post-*Zipher vs Markem*, late request was not grounds for refusing amendment, this should still be taken into account in costs. The defendants, on the other hand, maintained that they considered the amendment unnecessary, and had a right to defend the patent as granted.

- 76 As these proceedings were issued after 3 December 2007, it is the scale of costs in Tribunal Practice Notice 4/2007 which applies. Taking all the above considerations into account I award £2000 as a contribution to the claimants' costs, to be paid by the defendants within 7 days of the expiry of the period for appeal.

Appeal

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

J ELBRO

Divisional Director Acting for the Comptroller