

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

- 5 Watermist submit that the examiner misdirected himself with regard to interpretation of the claims, that he failed to adequately consider the position of indirect infringement under section 60(2) and that he failed to realise the relevance of the evidence in deciding the question of whether the products infringe the patent. By doing so, they say that the examiner arrived at the wrong conclusion on whether Products 1 and 2 infringe the patent. These are considered to be relevant grounds for review.

Review

- 6 The nature of a review under section 74B was considered by the Patents Court in *DLP Limited*¹, in which Kitchen J said:

“22.....I believe a Hearing Officer should only decide an opinion was wrong if the examiner has made an error of principle or reached a conclusion that is clearly wrong.”

- 7 In the Opinion the examiner explains that the first step in deciding if there is any infringement is to consider whether the two products fall within the scope of the claims of the patent. He then sets out the correct principles for interpreting the scope of the claims, namely a purposive construction of the claims and their interpretation in the light of the description and the drawings. He does this by directing himself to the guidance in *Kirin-Amgen*² and the Protocol to Article 69 of the EPC. In assessing the scope of the main claim, claim 1, he says that he has no issue with the construction of the claim apart from what is meant by “a cabinet” and “a hinged lid”. He then proceeds to construe the meaning of these terms by considering what the skilled person in the art would have understood them to mean in light of the description and drawings. Watermist argue that the examiner misconstrued these terms and therefore came to an incorrect conclusion on infringement. They also argue that the examiner incorrectly interpreted the scope of the omnibus claim, claim 10, and again came to an incorrect conclusion on infringement. I shall deal with these arguments in detail below. Claims 1 and 10 of the Patent read as follows:

1. Fire fighting unit comprising a hose reel, a pump for generating a pressurised water supply to the hose, a power unit to drive a pump, and an operator-controlled water releasing and water cut-off mechanism in the water-issuing nozzle region of the hose allowing an operator, in use, to hold and direct the water emerging from the nozzle region; characterised by the features, firstly, that the hose reel, the pump, and the power unit are all housed within a cabinet; secondly, that the cabinet is so constructed that the operator must first open it before he can unreel the hose and operate the unit; thirdly, that the nozzle when operated delivers the water at a pressure which is reduced relative to the pressure at which the pump supplies water to the nozzle via the hose; fourthly, that the water emerges from the nozzle in the form of a generally conical wide-area fine mist or fog of water droplets; fifthly, that the cabinet is a cabinet incorporating an openable and closable hinged lid

¹ DLP Limited [2007] EWHC 2669

² Kirin-Amgen and others v Hoechst Marion Rossel Limited and others [2005] RPC 9

which forms an openable and closable door to the cabinet; sixthly that the hose reel is mounted inside the cabinet; and finally, that as the hose is unreeled, the hose reel does not detach from the apparatus in use.

10. A fire-fighting unit substantially as described herein with reference to and as illustrated in the accompanying text and drawings.

- 8 The examiner concludes at paragraph 24 of the Opinion that there is nothing in the description or drawings to suggest that a meaning other than that which would normally be attached to the term “cabinet” was intended. More specifically he says that he believes the term would be taken to encompass a box or case-like structure for enclosing components of the fire fighting unit. In paragraphs 22 and 23 he explains that claim 1 requires that “the hose reel, the pump and the power unit are all housed within a cabinet”, that “the cabinet is so constructed that the operator must first open it before he can unroll the hose and operate the unit” and “the cabinet is a cabinet incorporating an openable and closable hinged lid which forms an openable and closable door to the cabinet”. He says that a first requirement of the claim is that all the components are housed in a single cabinet – he says that this suggestion is reinforced by references throughout the claim to “the cabinet”.
- 9 Watermist argue that there is no foundation whatsoever for this conclusion. They say that the word “single” does not appear anywhere in the claims and suggest that as long as the hose reel, pump and power unit are housed within a cabinet, then an embodiment in which the hose reel, pump and nozzle are housed in their own separate cabinets would fulfil the clear requirement of claim 1. They also argue that the word “cabinet” could also cover a room or a recess – the etymology, they say, is from the French cabin-ette, meaning a closed space. In overlooking this alternative, they say that the examiner has artificially restricted the meaning of term without justification.
- 10 Protec argue that the claim specifically calls for all three claimed items to be housed in a cabinet. They say that the use of the seemingly superfluous word “all” merely reinforces the point that all three claimed integers must be housed in the same cabinet. I agree. In my view, the examiner has correctly construed the term “cabinet” in the light of what a person skilled in the art would have understood it to mean in light of the description and drawings.
- 11 As far as the term “a hinged lid” is concerned, the examiner relies on the further guidance in *Halliburton*³ which says that where a claim permits alternative interpretations, “it is possible to be left with no alternative but to take the most straightforward”. He notes at paragraph 28 of the Opinion that the term “hinged” is not defined in the specification and that no detail is given of the particular hinging mechanism. He says that in the absence of any alternative meaning in the specification, a skilled person would clearly understand the meaning of “hinged” as being the conventional understanding of the word, namely that the term requires some sort of pivoting action.
- 12 Watermist argue that the examiner erred in his assessment of what is meant by the term “hinged”. They say that he was wrong to say that all hinges include a pivot action in their operation and refer to certain types of hinges, namely sliding hinges, swinging hinges and displaced pivot hinges which swing between an open and

³ *Halliburton v Smith* [2006] RPC 2

closed position but do not move about a single pivot axis. Protec counter by saying that a hinge is perhaps one of the simplest mechanisms imaginable, and there is no definition of the term in the specification presumably because it is such a well understood term that there was felt to be no need to provide any such definition. They say that all hinges require a pivot, but the axis about which the pivot occurs does not have to be static, for example the displaced pivot hinge used in most double glazed windows. I agree. It is clear to me that the examiner has correctly construed the term “hinged lid” from the point of view of what a person skilled in the art would have understood it to mean in light of the description and drawings, i.e. a lid which pivots around an axis on the cabinet and forms an openable and closable door to the cabinet.

- 13 Having construed the scope of the main claim, the examiner then addresses the question of direct infringement and concludes that since Product 1 does not have a cabinet enclosure and Product 2 does not have a single enclosure and a hinged lid, the two products do not infringe claim 1 of the patent. Watermist say that having misconstrued the terms “cabinet” and “hinged lid” then it was inevitable that the examiner reached the wrong conclusion on direct infringement. I have already found that the examiner was correct to construe claim 1 in the way that he did, and I also agree with his conclusion that Products 1 and 2 do not fall within the scope of claim 1: the fire fighting units of Products 1 and 2 are not enclosed in a single cabinet and the sliding drawer assembly which encloses the hose reel in Product 2 is not a hinged lid.
- 14 The suggestion is made by Protec that the construction of the terms “a cabinet” and “a hinged lid” by Watermist amounts to an attempt at linguistic gymnastics in order to make Products 1 and 2 fall within the scope of the claims. I tend to agree, and I shall return to this when dealing with costs.
- 15 As far as the omnibus claim, claim 10, is concerned, the examiner construed this in the light of guidance at paragraph 14.124 and 14.125 of the Manual of Patent Practice and decided to give the claim a narrow construction limited to the embodiment shown in the drawings. Watermist suggest that this approach was incorrect and that he should have construed the scope of the claim as wide as the statement of invention. I disagree. In any case, even if Watermist are correct on this point, this would not help since the statement of invention is, to all intents and purposes, identical to claim 1, which I have already considered above.
- 16 Turning next to Watermist’s argument that the examiner failed to adequately consider the position of indirect infringement under section 60(2). The examiner deals with indirect infringement at paragraphs 43 to 53 of the Opinion and sets out the requirements which have to be met, namely that what is being supplied has to be means relating to an essential element for putting the invention into effect and that the party supplying the essential means knows (or it would be obvious to a reasonable person) that those means are suitable for putting and are intended to put the invention into effect. These requirements are not disputed by Watermist.
- 17 In relation to the supply of Product 1, the examiner considers two different scenarios for indirect infringement, the first in which the requestor supplies the product to the MoJ and the second in which the product is supplied to other customers. For the supply of Product 1 to the MoJ, the examiner decides that a letter from the MoJ to the supplier, confirming that they have no intention of placing Product 1 in a cabinet

and undertaking not to do so in the future, is sufficient to demonstrate that the requestor knows that the invention will not be put into effect. As far as the supply of Product 1 to other customers is concerned, the examiner concludes that there is insufficient evidence before him to say whether the supplier or a reasonable person might know of the intended use of the product.

- 18 Watermist argue that the examiner was wrong to say that the MoJ's stated non-intention to place Product 1 in a cabinet dismisses indirect infringement. They say that it is the supplier, or the reasonable person, who "must have or obviously imply their knowledge, not the customer". What I understand Watermist to be saying here is that the terms set out in the MoJ's letter are irrelevant in considering what the supplier knew of the intended use of the product. In addition, it was only through the rounds of observations leading up to the Opinion that the MoJ's written undertaking was made, and so before receiving this letter the requestor could not rely on a disclaimer to dismiss an indirect infringement.
- 19 The question of indirect infringement was considered by the Court of Appeal in *Grimme v Scott*⁴, in which Jacob LJ sets out the following criteria for interpreting the requirements of section 60(2) for knowledge and intention:

"In short, the knowledge and intention requirements of ... section 60(2) are satisfied if, at the time of supply or offer of supply, the supplier knows, or it is obvious in the circumstances, that ultimate users will intend to put the invention into effect. That is to be proved on the usual standard of balance of probabilities. It is not enough merely that the means are suitable for putting the intention into effect (for that is a separate requirement), but it is likely to be the case where the supplier proposes or recommends or even indicates the possibility of such use in his promotional material."

- 20 Indirect infringement may still have taken place even without the supplier suggesting the possibility of an infringing use, as was the case in *KCI Licensing Inc & Ors v Smith & Nephew Plc & Ors*⁵. In the present case, I do not think that there is sufficient information available to give a general opinion on what the supplier knew or did not know (or reasonably should have known) of the intended use of either of the two products, and this is acknowledged by the examiner at paragraphs 48 and 53 of the Opinion. The examiner then addresses two particular circumstances in which further information is available. In respect of Product 1, the examiner considers that he is able to give an opinion on indirect infringement to the extent that the MoJ letter demonstrates that the supplier knew that the user had no intention of putting the invention into effect. In respect of Product 2, the examiner considers that the photograph of the product at HM Prison Reading, which is not placed in a cabinet having a hinged lid, is sufficient to demonstrate that the user was not putting the invention into effect. In these circumstances, it seems to me that what the examiner is saying is that since the invention is clearly not being put into effect then there can be no direct or indirect infringement. I think that it was entirely reasonable for the examiner to draw this conclusion and to give the very limited opinion on indirect infringement that he did. The examiner has not, as Watermist suggest, offered a general opinion on indirect infringement because, as he quite clearly states, the information was not available to him to do so.

⁴ *Grimme v Scott* [2010] EWCA Civ 1110

⁵ *KCI Licensing Inc & Ors v Smith & Nephew Plc & Ors* [2010] EWCA Civ 1260

Conclusion

- 21 I conclude that the examiner in his opinion did not make an error in principle or reach a conclusion that is clearly wrong. I therefore make no order to set the opinion aside.

Costs

- 22 Both sides have asked for an award of costs in their favour. Given the nature of the review and the fact that both sides agreed for it to be made on the basis of the papers, I would not normally consider it necessary to make an award of costs to the winning party. However, as I have alluded to above, the nature of the arguments on claim construction made by Watermist have placed an unnecessary burden on Protec and I think it is right that I compensate them to some extent for this effort.
- 23 In the circumstances, I order Watermist Limited to pay Protec Fire Detection Limited the sum of £600 as a contribution to their costs.

Appeal

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

H Jones

Deputy Director acting for the Comptroller