



PATENTS ACT 1977

BETWEEN

Ingvest AB

Proprietor

Kingspan UK and STAM S.p.a.

Opponents

PROCEEDINGS

Application under section 74B for review of Opinion 13/20
in respect of EP(UK) 1877205

HEARING OFFICER

Phil Thorpe

DECISION

Introduction

1. In Opinion 13/20 (“the opinion”), issued 20 October 2020, the examiner was asked to consider whether a machine (“the contested machine”) would infringe EP 1877205 (“the patent”). It was the examiner’s opinion that it would not.
2. The proprietor of the patent (“the proprietor”) has requested a review of the opinion under section 74B of the Patents Act (the “Act”). The application for review was received within the three-month period from the date of issue of the opinion, with the application being accompanied by a statement setting out the proprietor’s grounds for review. Kingspan UK (“Kingspan”) and STAM S.p.a. (“STAM”) have each contested the application and filed counter statements on the 16 February 2021 and 20 February 2021, respectively.
3. All sides have agreed that I should decide the matter on the basis of their written submissions.

Grounds for review

4. The grounds for a review of an Opinion are set out in rule 98(5) of the Patents Rules 2007 which reads:

98(5). The application may be made on the following grounds only –

- (a) that the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent; or
- (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. The nature of a review under section 74B was considered by the Patents Court in DLP Limited¹ in which Kitchen J said (my emphasis):

“22. In the case of an appeal under rule 77K, the decision the subject of the appeal is itself a review of the opinion of the examiner. More specifically, it is a decision by the hearing officer as to whether or not the opinion of the examiner was wrong. I believe that a hearing officer, on review, and this court, on appeal, should be sensitive to the nature of this starting point. It was only an expression of an opinion, and one almost certainly reached on incomplete information. Upon considering any particular request, two different examiners may quite reasonably have different opinions. So also, there will may be opinions with which a hearing officer or a court would not agree but which cannot be characterised as wrong. Such opinions merely represent different views within a range within which reasonable people can differ. For these reasons 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. Likewise, on appeal, this court should only reverse a decision of a hearing officer if he failed to recognise such an error or wrong conclusion in the opinion and so declined to set it aside. Of course this court must give a reasoned decision in relation to the grounds of appeal but I think it is undesirable to go further. It is not the function of this court (nor is it that of the hearing officer) to express an opinion on the question the subject of the original request.”

6. Hence a review is not intended to be a second opinion on the matters presented in the opinion. Whether I necessarily agree or disagree with the examiner’s opinion is also not the matter at hand in this review. Furthermore, the matter is not whether any of the parties agrees or disagrees with the opinion. What matters is whether the examiner made an error of principle or reached a conclusion in their opinion which was clearly wrong.
7. The proprietor submits that the examiner has wrongly concluded that the contested machine did not fall within claim 1 of the patent. In particular, the examiner is said to have incorrectly interpreted a feature in claim 1.

The Patent

8. The patent relates to method of shaping profiles from a plane metal strip through the use of a production line. Such a production line is shown in figures 1 and 2 below and contains, among other features, two curving units 26, 27 for curving a profile formed from a strip of metal.

¹ DLP Limited [2007] EWHC 2669

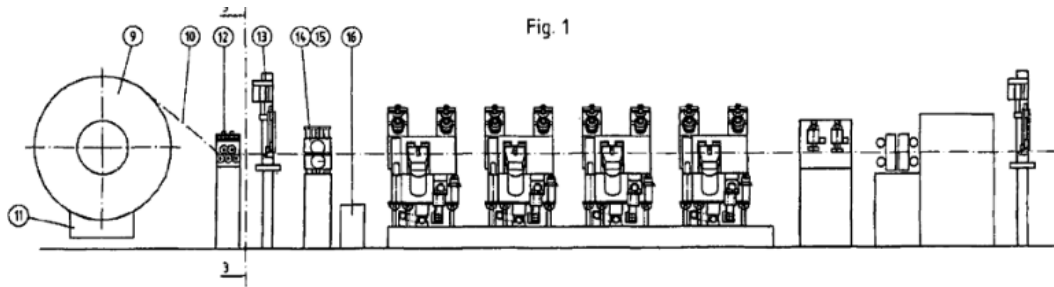


Fig. 1

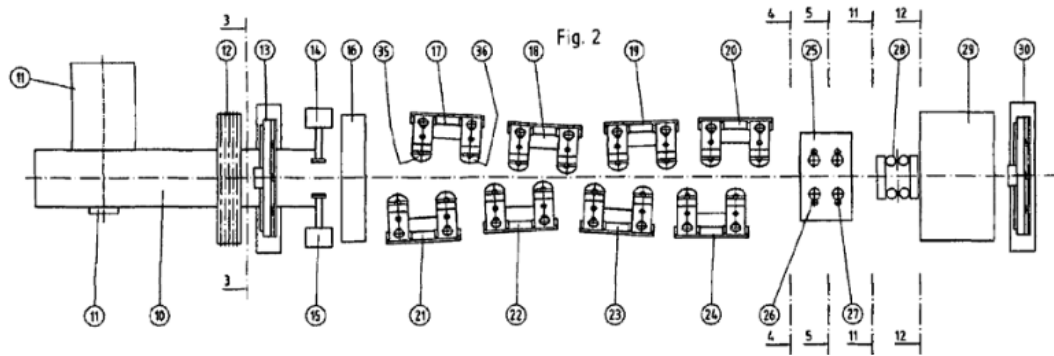


Fig. 2

9. A cross section of one profile that might be formed by such a production line is shown in figure 6.

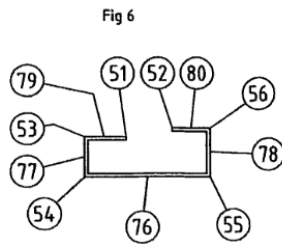


Fig 6

10. The curving units 26,27 are shown in more detail in figures 4 and 5. In particular, they show roller pairs 82,84;83,85 which act on the sides of the formed profile (shown in red in figure 5).

Fig 4

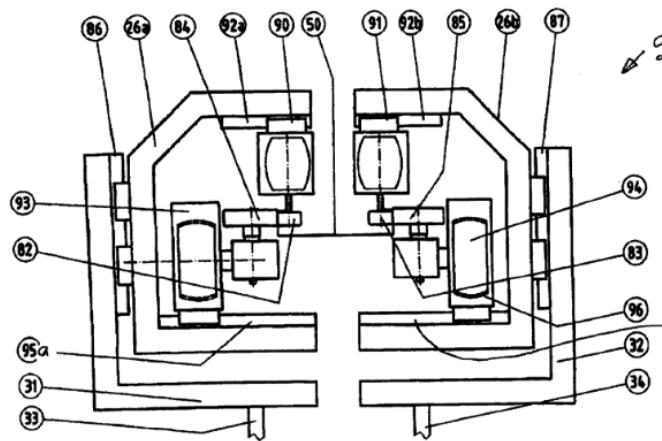
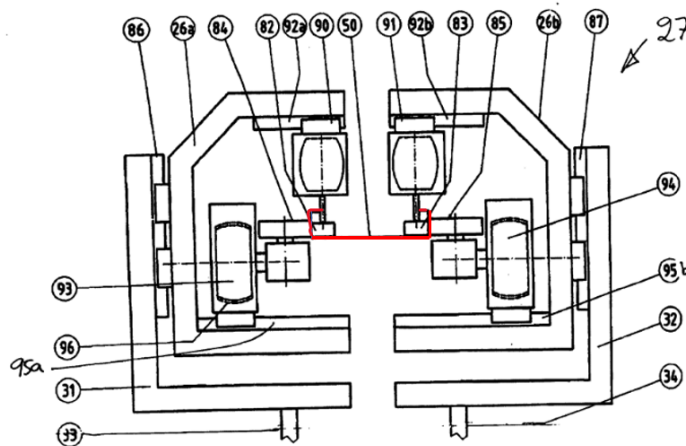


Fig 5



EP 1 877 2015 B1

11. Whilst the patent contains both method and apparatus claims, only the method claim was subject to consideration in the opinion. Claim 1 reads:

1. A method for forming from a plane strip of metal (50) and for either curving or twisting, or both, a profile (50) with a cross-section that varies along its length, wherein

sides (77, 78) are folded up on the metal strip in a number of roll-forming units (17, 18; 21, 22) that can be displaced sideways and rotated independently of each other,

characterised in

that the sides (77, 78) of the profile formed are rolled in roller pairs (82, 84; 83, 85) to become thinner at one of their edges such that the profile is curved or twisted,

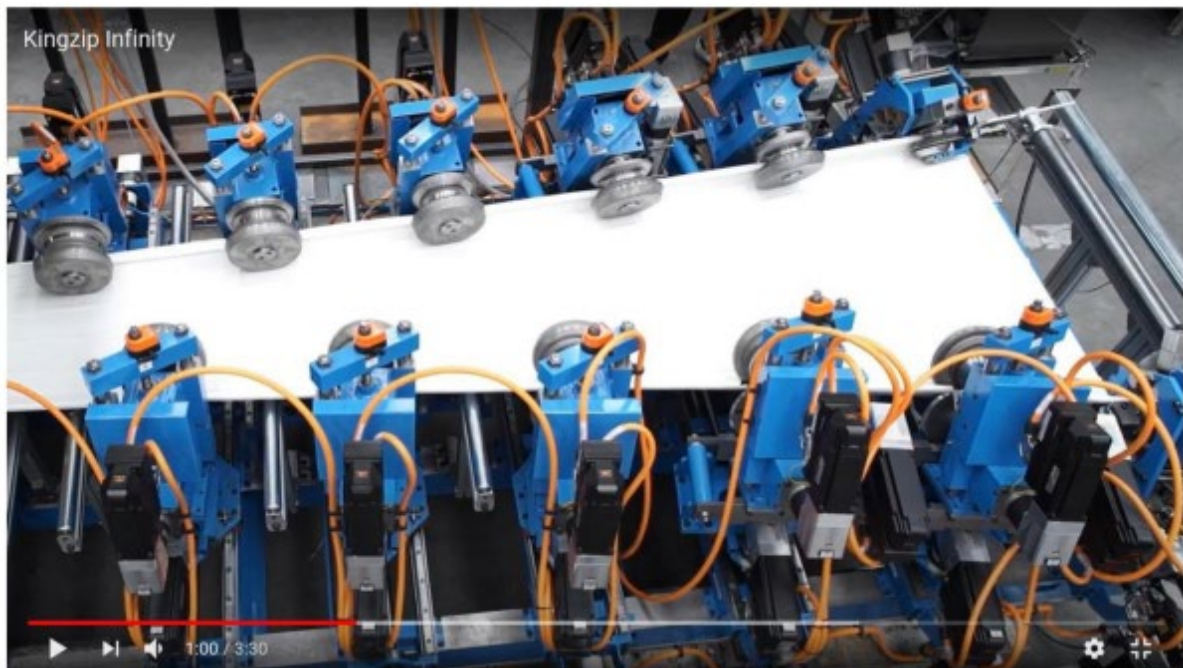
that the roller pairs (82, 84; 83, 85) are supported by supports (31, 32) that can be rotated in order to allow rotation of the roller pairs such that a line (II)

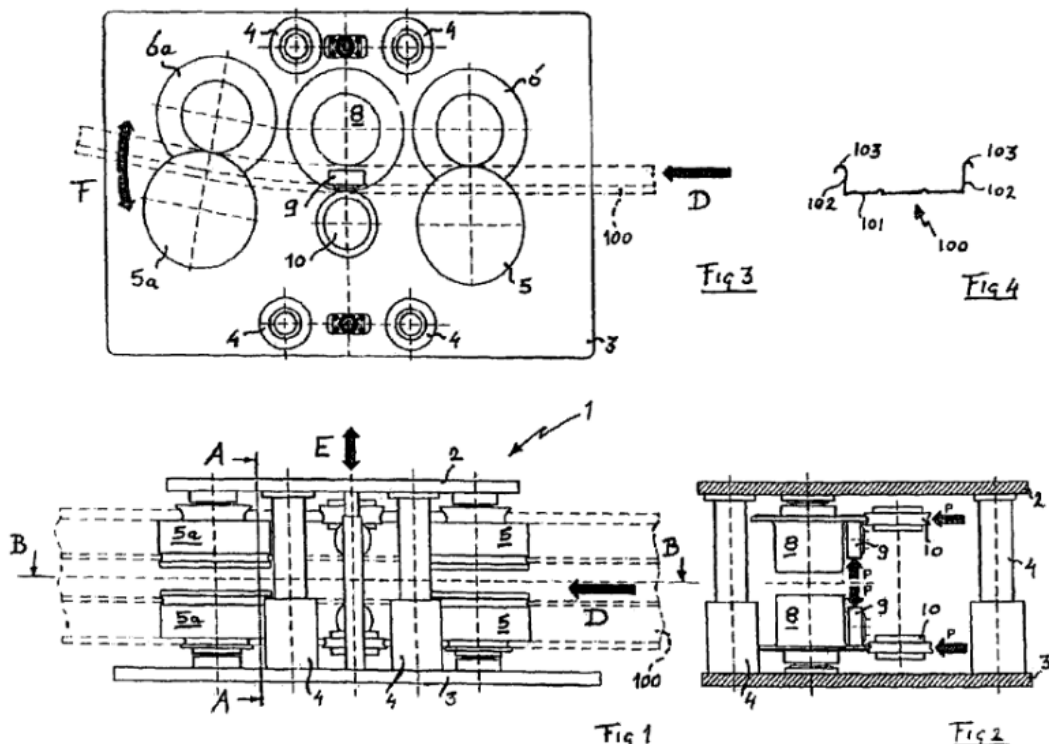
between the axes of the rollers in a roller pair can be held always perpendicular to the side that is being rolled, and

that the roller pairs (82, 84; 83, 85) and the sideways displacement and the angular motion of the roll-forming units (17, 18; 21, 22) are controlled by the same computer program such that the roller pairs (82, 84; 83, 85) follow the sides (77, 78) and a line (II) between the axes of the rollers in one roller pair is held always perpendicular to the side being rolled.

The contested machine

12. Screenshots from two videos and also the disclosure of a Patent document, EP 1272292, have been said to show a machine for curving profiles formed from a strip of metal. In particular, EP 1272292 includes pressure rollers 8, 9 & 10 acting on the profile. One of the screenshots, and figures 1-4 of EP 1272292 are shown below.





Argument and analysis

13. In opinion 13/20 the examiner considered two points with regard to the construction of claim 1. In particular, he considered the following feature (“the feature”) of claim 1:

“the sides (77,78) of the profile formed are rolled in roller pairs (82, 84; 83, 85) to become thinner at one of their edges such that the profile is curved or twisted”
14. At paragraph 18 of the opinion the examiner interpreted this feature by stating “it seems clear to me that thinning of the sides at one of their edges is the cause and the effect is that the profile is curved or twisted. Both the claim itself and the description lead me to this view”. He then specifically refers to figures 4 & 5 and paragraphs 19-23 of the patent to indicate his reasons for this interpretation.
15. The proprietor has submitted that the examiner has interpreted this feature incorrectly in two ways. Firstly, the proprietor has submitted that the examiner has taken this feature to mean that the thinning of the edges is the direct cause of the curving/twisting of the profile. This is said to be incorrect – as the claim does not require the relationship between the thinning and the curving/twisting to be directly causal – rather the claim merely requires that the thinning must be of the type associated with a curving or twisting of the profile.
16. Secondly, the proprietor has submitted that the examiner has interpreted this feature of the claim to require that the roller pairs be arranged to roll only the edge to be thinned. They submit that it would be apparent to the person skilled in the art, having read the patent, that the roller pairs need not be arranged precisely as shown in figures 4 & 5. Additionally, the proprietor submits that the person skilled in the art would appreciate that figures 4 & 5 illustrate “only the bare minimum requirements of the invention”, and that there is no reason why other areas of a side, in addition to

the edges which are to be thinned, could not be rolled by the roller pairs. Therefore, the invention could include obvious modifications in which the roller pairs are arranged to roll the whole of the sides of the profile – such that they are oblique to the side, or with equal pressure (this might be less affective but still capable of curving/twisting a profile).

17. Kingspan have stated in their counterstatement that the interpretation of the feature of claim 1 is correct, and the examiner has not made an error in principle or reached a conclusion that is clearly wrong. Kingspan considers the examiner to have taken into account “the full claim language” and “consideration of the whole teaching of the claim”. The examiner has therefore not arrived at an artificial construction of the meaning of the claim. Kingspan does not believe the examiner has construed that the roller pairs roll only the edge to be thinned – and have expressed doubt as to the part of the opinion the request is referring. Kingspan also notes that any thinning in the contested machine is a consequence of curving – rather than a curving as a consequence of thinning.
18. In their counterstatement, STAM believe that the Examiner gave a clear and correct interpretation of the patent. STAM considers the proprietors interpretation to be outside the teaching that the patent provides. In particular they refer to paragraphs 20-25 of the description which is said to provide that the thinning concerns only a band of the profile side. STAM also considers that the patent teaches to obtain the curvature/twisting of the profile only by playing on the reduction of the original thickness of a band on each side of the profile.
19. From the proprietor’s request it does not appear that they believe that the examiner made an error in principle, and I consider that the examiner has directed himself correctly with regard to the appropriate law on claim construction and infringement. The issue is whether the examiner reached a conclusion that is clearly wrong.
20. The question I must answer is not whether I disagree with the examiner’s construction of claim 1 but whether the examiner’s construction was wrong. In my view there is nothing in what the proprietor says that shows that the examiner’s construction was clearly wrong. Paragraphs 19-23 and figures 4 & 5 of the patent are consistent with his stated interpretation of claim 1. In particular, paragraph 19 states that the “counter rollers can be adjusted such that they make contact with the upper part of the side of the profile” (this position is shown in figure 4) with paragraph 21 going on to state that “the profile will be curved downwards when the rollers are pressed with a large force and with some obliqueness against the vertical sides or walls of the profile in order gradually to thin the vertical sides upwards”. Figure 5 shows the rollers 84,85 in a different/lower position with paragraph 22 stating that “the rollers 84,85 are arranged to roll the vertical sides of the profile gradually thinner against the central flange of the profile 50, such that the profile curves upwards”. Whilst the proprietor has offered a different interpretation of the claim – they have not provided any particular insight into the description and figures of the patent to indicate that the examiner was clearly wrong in interpreting the claims as he did.
21. Having considered the examiner’s construction of claim 1, there remains the question of whether the application of his interpretation of the claims to assess infringement led to an opinion that was clearly wrong. In his discussion of the contested machine, at paragraph 32 of the opinion, the examiner comments that:

“I note that the arrangement shown in figures 4 and 5 of the patent has rollers 82,83 that exert pressure only on a part of each side of the profile, thereby directly thinning only those parts and hence I am told curving or twisting the profile. Whereas the contested machine, at least insofar as it is illustrated in figures 2 and 3 of patent EP1272292, seems to exert pressure over substantially the whole of each side of the profile”

22. He goes on to state at paragraph 40 of the opinion, when considering the issue of infringement:

“I have concluded above that the rollers in the contested machine as illustrated by rollers 9 in figure 2 of patent EP1272292 exert pressure over substantially the whole of each side of the profile. Hence it is not the case that the sides of the profile formed are rolled in roller pairs to become thinner at one of their edges such that the profile is curved or twisted.”

23. The proprietor considers that the examiner, in his application of his interpretation of claim 1 to the question of infringement, has made clear that it is a requirement that the thinning must be the sole cause of the curving/twisting of the profile. The proprietor also submits that when coming to apply his interpretation of claim 1 (see paragraph 18 above) to the matter of infringement, the examiner deviated from his stated interpretation of the claim by reading an additional feature requiring the side be rolled only at the edge to be thinned.
24. I would note that the examiner has not stated in his opinion that thinning of the profile must be the *sole cause* of the curving/twisting of the profile for there to be infringement. Rather he concluded, based on the information available to him, that the sides of the profile formed using the contested machine are not rolled to become thinner at one of their edges such that the profile is curved or twisted, because the rollers of EP1272292 exert pressure over substantially the whole of each side of the profile. This is consistent with his cause and effect interpretation in paragraph 18 of the description.
25. In paragraph 32 of the opinion I do not think the examiner was imposing or reading an additional feature into claim 1. Rather he was *demonstrating* that roller pairs rolling only on a part of each side of the profile is a cause of thinning of the sides at one of their edges with the effect that the profile is curved or twisted. Thus, his discussion of the patent in paragraph 32 is consistent with his interpretation of claim 1 in paragraph 18.
26. Thus, I do not believe that the examiner has deviated from his construction of the claim, nor added a feature to the claim, such that he has clearly reached a wrong conclusion with regards to infringement of the contested machine.

Conclusion

27. I conclude that the examiner 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

28. None of the parties has requested costs and therefore I make no order in that respect. I would in any event note that it is Office practice to not award costs in respect of reviews of Opinions given the low-cost nature of the Opinion service and the fact that Reviews, as in this case, can usually be decided on the basis of the papers.

Appeal

29. Any appeal must be lodged within 28 days after the date of this decision.

PHIL THORPE

Deputy Director acting for the Comptroller