



PATENTS ACT 1977

BETWEEN

Valor Limited

Proprietor

and

Winther Browne & Company Limited

Opponent

PROCEEDINGS

Request under section 74B of the Patents Act 1977
for a Review of Opinion 15/08 issued
on patent number GB2402468

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 Winther, Browne & Company Limited (herein “Winther Browne”), in relation to the validity of Patent Number GB2402468 in the name of Valor Limited. The Opinion, number 15/08, issued on 11 September 2008. The examiner’s view was that claim 1 of the patent lacked novelty in the light of the cited prior art. The examiner found that the case against the subsidiary claims, 2 to 17, had not been sufficiently made out by the applicant for him to undertake a full consideration of their validity, but he expressed the prima facie view that claims 2 to 6, 11, 12 and 16 seemed to lack novelty.
- 2 Valor Limited (herein “Valor”) have requested a review of the Opinion under section 74B. Rule 98(5)(a) governs applications for reviews and provides as follows in relation to Opinions on validity:

(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)

- 3 Valor's statement of grounds, dated 10 December 2008, accordingly says that the Opinion wrongly concluded that claim 1 at least, lacks novelty. Winther Browne filed a counter-statement on 29 January 2009, and the matter came before me at a hearing on 8 May 2009 at which Valor were represented by Mr Nicholas Manley of WP Thompson & Co. and Winther Browne were represented by Dr Michael Spencer of Bromhead Johnson.

The purpose and effect of the Review

- 4 The conduct of reviews of Opinions was considered in *DLP Limited* [2007] EWCH 2669 (Pat). Kitchen J confirmed that the hearing officer's role in conducting a review was to consider whether the examiner's opinion was one that could reasonably have been reached in the circumstances. Rule 100 provides that on completion of the review, the comptroller shall either set aside the opinion in whole or in part, or decide that no reason has been shown to set it aside. In *DLP*, Kitchen J further concluded that an opinion should be set aside only if the examiner has made an error of principle or has reached a conclusion that is clearly wrong.
- 5 In putting the outcome of this review into effect, Section 74A(4) provides that Opinions are not binding for any purpose. I observe that 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 patent relates to a gas or other fuel fire with a live flame having a window in front of the combustion region. The invention consists in the window being spaced from the body of the fire to allow air for combustion to flow in, and to allow a secondary route out for exhaust gases in addition to that provided by the main flue.
- 7 Claim 1, which is the only independent claim, reads:

1. 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 herein before 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 out of the housing in the event that exhausting via the primary venting means is hindered or prevented.

The Issues

- 8 The invention arises from the recognition that open fires allow air to flow directly into the combustion region and are able to continue operating effectively if the flue gets blocked. Because the fire is not enclosed, air will continue flowing to the flame and exhaust gases can flow out into the room. (It is accepted that this is not ideal!) However open fires need to be separated from people and furnishings and so require some protective structure around them, which takes up space. Fires with windows covering the combustion region have the necessary protection and thereby avoid the space problem, but are vulnerable to poor combustion if the flue is blocked or there is a downdraught. The invention consequently has a window over the combustion zone to provide protection, but one that is spaced from the front of the fire or has gaps in it, so that it can allow air in and exhaust out in a similar way to an open fire.
- 9 The prior art documents cited in the request for the Opinion also relate to fires having windows with air gaps. In each of the two cases which the examiner found to anticipate, the gap takes the form of a slot along the top of the window which admits secondary air for combustion.
- 10 The examiner construed claim 1 to include within the scope of the invention arrangements which, when the flue is blocked, exclusively allow exhaust gas to flow outward, as well as ones in which the inward flow of air and the outward flow of exhaust occur simultaneously.
- 11 In considering the prior art, he found that in the two examples mentioned, the gap provided would admit air in normal use and would conduct exhaust gases out when the flue was blocked. He consequently found that these two prior examples fell within the scope of the claim as he had construed it and therefore anticipated it.

Interpretation of the claims

- 12 A main consideration in reviewing the Opinion is consequently the construction to be placed on claim 1. Mr Manley argued that the examiner had erred in taking the view of construction that I have just described. In his view, the specification would be understood by the skilled reader to teach and claim that the gap according to the invention must inevitably involve air flowing in at the same time as the exhaust flows out. I shall refer to this as “two-way flow”.
- 13 Mr Manley quoted a number of precedent cases to support the point that the claims must be read in the light of the description. Lord Hoffmann considered the question of claim construction exhaustively in *Kirin-Amgen Inc v Hoechst Marion Roussel Limited* [2004] UKHL 46. This authority consequently supersedes earlier discussions. He said in paragraph 34:

“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."

It is clear from this that the patentee is taken to have chosen the wording of its claims intentionally and for a particular reason. An unsophisticated characterisation might be that while the teaching of the specification would be expected to influence how the particular features mentioned in a claim are to be understood, it would not be expected to result in the notional introduction of new features that the patentee could have spelt out in terms had it chosen to do so.

- 14 The starting point in determining the proper construction must be what the claim actually says. Claim 1 does not specify that the gap must be such as to allow air to flow in at the same time as exhaust gas flows out. On the face of its wording it quite evidently allows arrangements in which the inward airflow is interrupted by abnormal operation and in which exhaust flows exclusively outward for the duration of the abnormal running.
- 15 Mr Manley evidently accepted that the claim does not explicitly include the two-way feature, but he maintained that it must be read in accordance with the teaching of the description which he says must inevitably be understood to do so. Mr Manley in running this argument has to demonstrate firstly that the description would be understood by the skilled person to require (rather than just envisage) two-way flow, and furthermore that the claim should be construed to import such a limitation from the description into its scope.
- 16 He argues, in paragraphs 3 to 10 of Valor's statement, that the specification consistently describes two-way flow. He points to a number of passages that support this. It seems, once it is pointed out in the way Mr Manley has done, that the present embodiments are configured to operate with two-way flow. But a fair amount of inference is needed to reach that appreciation. In addition it is not entirely clear that the description is intended to cover the operation even of these embodiments in every eventuality. For example in the event of a severe downdraught one might expect even an arrangement intended to operate with two-way flow to change to an entirely outward flowing gas stream. The requirement for a two-way flow feature is not set out explicitly anywhere in the description and there seems to be nothing in the disclosure to insist that this must be the way in which the invention operates in all its possible configurations. It seems too great a step from the indication that this is probably the way that the embodiments are intended to operate, to conclude that the invention must inevitably involve two-way flow.
- 17 Mr Manley argues in support of his proposition that the skilled person would understand that the gap must allow two-way flow, because if it did not, the fire would be prevented from operating because of the lack of combustion air. The

examiner's view was that there is nothing to preclude fires according to the invention having a separate air intake in addition to the gap. Mr Manley says that this is possible, but irrelevant. I consider that it is relevant because it is something that would be in the mind of the skilled person. I imagine the skilled person would envisage configurations both with and without separate air inlets. They might well form the view that a fire without a separate inlet would probably involve two-way flow, but I think they would also envisage configurations with a separate air inlet in which two-way flow was not a requirement.

- 18 The statement of grounds also refers to the reference in the specification to the setting of the width of the gap to a certain value so that "the amount of air flowing to the combustion chamber can be regulated to a level which produces efficient combustion of the gas." The argument is that this would suggest to the skilled person that the gap is intended to supply air for combustion even if the exhaust is blocked and that no further air supply is required or desirable. I think this would be taken by the skilled person to refer primarily to the operation of the system in normal running rather than when the flue is blocked. It is a general statement about the configuration that would or could be made whatever arrangements were provided for feeding air to the fire and removing exhaust. I do not see that it implies anything about the requirement or otherwise for the gap to operate with two-way flow.
- 19 Paragraphs 11 to 16 of the statement of grounds argue that the invention is stated to alleviate the problems both of open fires and of fires with enclosing windows, and that the skilled reader would take from that that it must involve two-way flow in the event of blockage in order to provide the benefit of an open fire. In my experience the substance of inventions as described in specifications is not so closely based on the problems of the acknowledged prior arrangements that it is possible to infer features of the invention precisely from their perceived deficiencies. I do not think the skilled reader would take this consideration to preclude the possibility of other configurations falling within the claims.
- 20 I accept that the description points towards two-way flow, but I don't think the skilled person would conclude that that is the only possible mode of operation. I expect the skilled reader would also consider other configurations to fall within the scope of the invention, for example ones with a separate air supply and without limitation to two-way flow and ones with other modes of operation in transient conditions. I find that the description does not inevitably require the invention to involve two-way flow in the event of blockage or downdraught. It therefore seems to me that Mr Manley has not succeeded in demonstrating that the invention would be understood by the skilled person to require two-way flow.
- 21 If two-way flow is not an inevitable feature of the invention as described in the specification then it cannot be imported as an implied limitation into claim 1. I repeat my observation furthermore that it does not say anywhere in terms in the specification or the claims that the system involves what I have referred to as two-way flow. If the patentee had chosen to, it could have used wording to specify such operation in the claim, and indeed in the description but it has not done so. As a result of these considerations I do not see that it is possible to deviate from the natural meaning of the words of the claim. I consequently find that the examiner's construction of the claim was a reasonable and proper result.

The prior art

- 22 I have found that the examiner's construction of the claim is a reasonable one. I agree with his view that the invention according to the claim must include arrangements in which the gap may operate exclusively to conduct exhaust gas out of the combustion region when there is a blockage, as well as arrangements in which there is two-way flow.
- 23 As I mentioned above, the prior art specifications FR 2617270 and FR2653534 in each case involve fires with enclosing windows in which a gap is provided at the top of the window. The purpose of the gap is to allow in secondary air to assist with complete combustion. Mr Manley remarked at the hearing that there was no disclosure or suggestion that such an arrangement would allow exhaust gases to exit in the event of a blockage. At times argued that such exhaust flow would not occur though he did in fact accept this would be the case when I questioned him about it. I think that the skilled person would infer that an outward flow of exhaust gas would be the inevitable result in the event of a blockage or downdraught. Just as with the arrangements of the present invention, if there is a gap between the window and the enclosure, and over-pressure arises because of a blockage or downdraught I think it is inescapable that exhaust gas would flow out in the prior art configurations just as it is said to do in the present invention.
- 24 Other than that particular point, I did not understand Mr Manley to argue that if the examiner's view of construction was found to be correct, that the examiner nevertheless erred in making the finding that he did as to anticipation. That being the case, and having reviewed the discussion of the prior art in the Opinion and Mr Manley's arguments on it, I do not need to rehearse the issues point by point, but can simply declare that I find nothing exceptionable in the examiner's discussion of the prior art and I find his conclusion on lack of novelty to be one that can reasonably have been reached on the law and facts of this case.

Conclusion

- 25 The purpose of this review has been to assess whether, to quote from Rule 98(5)(a); "the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent". I am satisfied that the Opinion was correct in its assessment of the patent in suit as having been anticipated by the prior art, and in particular that claim 1 was correctly construed. I accordingly make no order to set the Opinion aside.

Costs

- 26 Winther Browne have successfully defended the action and I order that Valor Limited pay Winther Browne & Company Limited £2000 as a contribution towards their costs.

Appeal

- 27 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