

15 March 2010

PATENTS ACT 1977

BETWEEN

Nationwide Filter Company

Proprietor

and

Berni Hambleton

Opponent

PROCEEDINGS

Request under section 74B of the Patents Act 1977
for a Review of Opinion 28/08 issued
on patent number GB 2411367

HEARING OFFICER

J Elbro

DECISION

- 1 This is a review of Opinion 28/08 (“the opinion”) issued on 3 March 2009 in respect of patent number GB 2411367 (“the patent”) in the name of Nationwide Filter Company (“Nationwide”). The patent, which was granted on 4 June 2008, was filed on 17 February 2004 with no claim to priority.
- 2 Nationwide filed a request for review of the opinion on 3 June 2009, together with a statement of grounds. Ms Hambleton filed a counterstatement on 23 July 2009 in opposition. I issued a preliminary written evaluation on 18 August 2009, following which both parties were given the opportunity to submit evidence. Only Nationwide filed evidence (which I refer to below). Both parties indicated they were content with a decision on the papers without a hearing, after an opportunity to make further submissions.

The Patent

- 3 As noted in the opinion, the granted patent is concerned with a method of forming a filter unit of the type comprising a filter element located in a peripheral encasement frame with a seal between the periphery of the filter element and the

frame. One specific embodiment is described and illustrated, showing a filter element 10 with marginal regions 11a, 12a on the front and rear faces 11, 12 of the element, a mould 14 defining a mould cavity 15 and having tapering projections which bite into the marginal regions of the filter element, the mould cavity 15 to be filled with a liquid curable resin system 16, which is then to be converted to a solid and the mould subsequently removed to produce a filter unit:

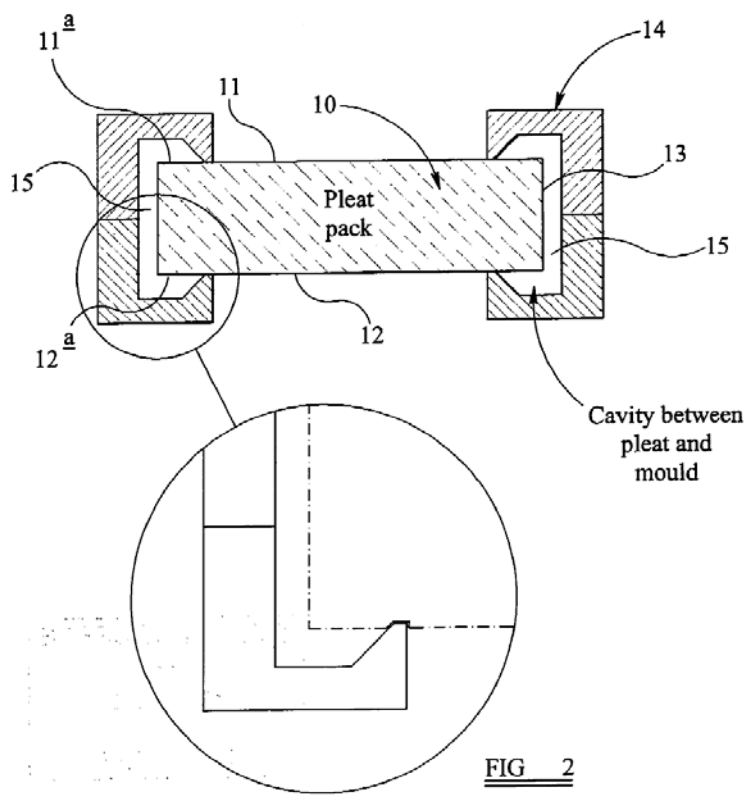


FIG 2

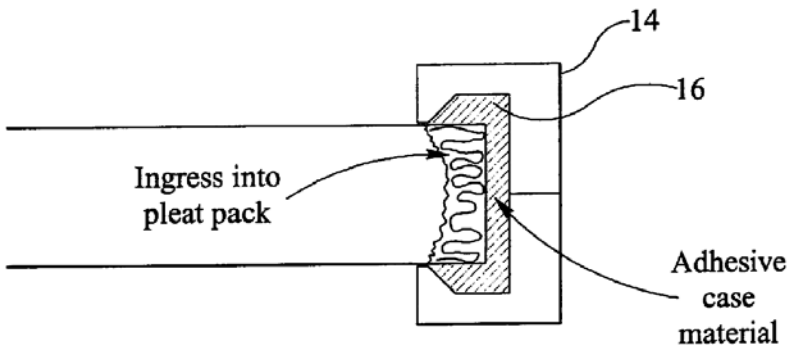


FIG 3

4 The granted claims include a single independent claim, claim 1, and a number of dependent claims. Claims 1 and 2 are relevant to this review and read as follows:

1. A method of forming a filter unit comprised of a filter element and an encircling

peripheral encasement frame to which the filter element is sealed comprising the steps of:

- (i) providing a filter element having front and rear faces and a bounding peripheral edge,*
- (ii) locating around the peripheral edge of the element a mould unit which seals against peripheral regions of the front and rear faces and which together with the peripheral edge and marginal regions of the of the front and rear faces of the filter element defines a mould cavity, said mould unit having tapering projections which bite into said peripheral regions of the of the front and rear faces so as to cause a slight depression therein,*
- (iii) filling the mould cavity with a liquid curable resin system,*
- (iv) effecting conversion of the liquid to a solid, and*
- (v) removing the mould thereby producing the filter element.*

2. *A method as claimed in any one of claims 1 wherein the filter element is pleated.*

5 Nationwide have also filed a request for amendment of the patent, which is ongoing. The opinion, and hence this review, relate to the unamended form of the patent.

The Law

6 So far as matters here the relevant parts of the Patents Rules 2007 covering reviews of opinions are:

Rule 98 - Review of opinion

(1) The patent holder may, before the end of the period of three months beginning with the date on which the opinion is issued, apply to the comptroller for a review of the opinion.

....

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

- (a) that the opinion wrongly concluded that the patent was invalid, or was invalid to a limited extent; or
- (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.

Rule 100 Outcome of review

(1) Upon the completion of the proceedings under rule 99 the comptroller shall either—

- (a) set aside the opinion in whole or in part; or
- (b) decide that no reason has been shown for the opinion to be set aside.

(2) A decision under paragraph (1)(a) or (b) shall not estop any party to proceedings from raising any issue regarding the validity or the infringement of the patent.

(3) No appeal under section 97 shall lie from a decision to set aside the opinion under paragraph (1)(a), except where the appeal relates to a part of the opinion that is not set aside.

7 The nature of a review of an opinion was considered in *DLP Limited* [2007] EWHC 2669 (“DLP”). In paragraph 22 of the judgment, Kitchen J stated:-

..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 well 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 is 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.

- 8 Hence in accordance with DLP a review is neither a rehearing nor is intended to provide a second opinion. Rather its purpose is to review whether the opinion was wrong because the examiner has made an error of principle or reached a conclusion that is clearly wrong.

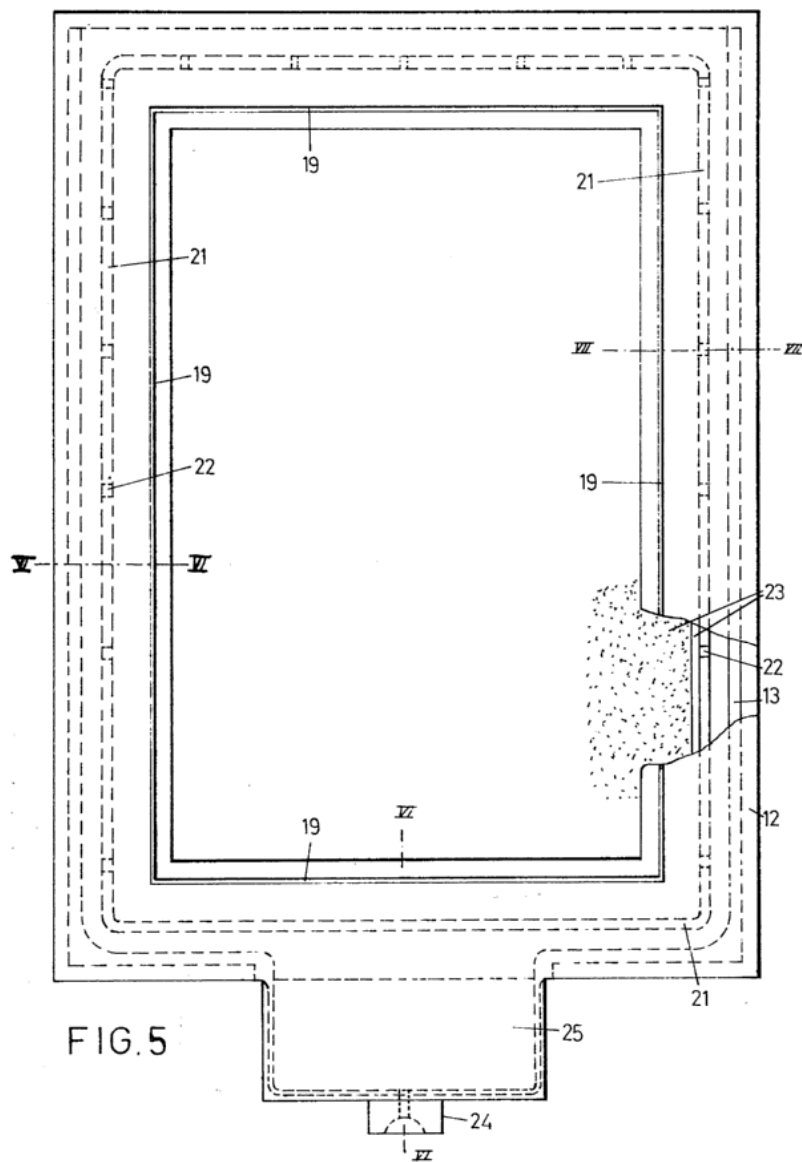
The Opinion and the request for review.

- 9 The opinion found that claims 1 and 5 lacked novelty, and claims 1 to 5 lacked an inventive step, over a prior patent document, FR2140536, cited in the opinion request.
- 10 In its request for review, Nationwide challenges the finding of lack of inventive step of claim 2 (and therefore of claims dependent on it) only. It claims two errors in the examiner's assessment:
- FR2140536 is not the closest prior art and therefore the wrong starting point for an obviousness objection.
 - The examiner was wrong about the obviousness of substituting a pleated filter for the one used in FR2140536.
- 11 Nationwide therefore asks for the part of the opinion finding invalidity of claim 2 and dependent claims to be set aside.
- 12 Nationwide originally also submitted that the whole opinion should be set aside on the grounds that the opinion should not have been issued at all because the prior art documents considered in the opinion had been sufficiently considered prior to grant. However, Nationwide indicated in a letter of 29 September 2009 that they were not pursuing this point and I will say no more about it.
- 13 I should note in addition that in her counterstatement, Ms Hambleton attempted to reopen the question of inventiveness of claim 2 over another prior patent document, US 6045600, which the opinion had found the patent inventive over. As I indicated in my preliminary evaluation, it is apparent from the Rules quoted above that it is not open to me to find that the patent is invalid in light of US 6045600. The opinion examiner found differently, and that aspect of his opinion is not reviewable under rule 98(5). I will therefore say no more on this point

either.

The Prior Art Documents

- 14 French patent document FR2140536 was published on 19 January 1973, well before the earliest date of the patent. The opinion examiner's description of the disclosure of this document was not challenged, and I repeat it here.
- 15 The document shows a filter device and a method for making that device by moulding a reinforcing edge made up of strips or bands 5 around a filter element 1. The moulding involves placing the element 1 between mould halves 12 and 13, defining a mould cavity 23 which is then filled with a liquid curable material such as an expanding elastomer, the material is then allowed to harden and form a reinforced edge and the filter unit is removed from the mould. The mould halves also include strip blades 19 which penetrate the filter element to a certain depth once the mould halves are closed.



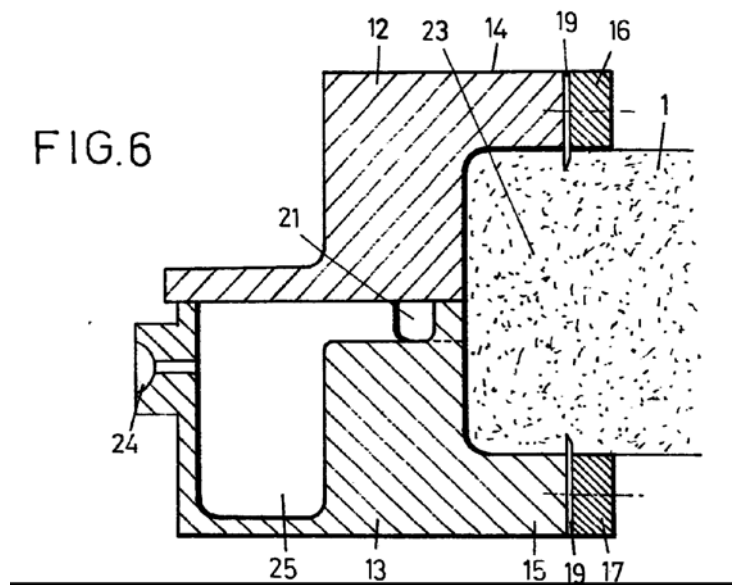


FIG. 7

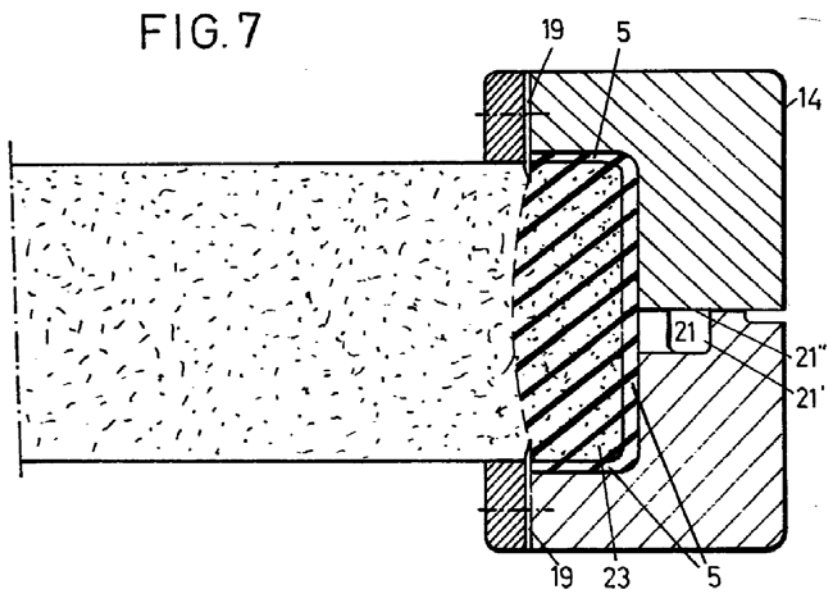
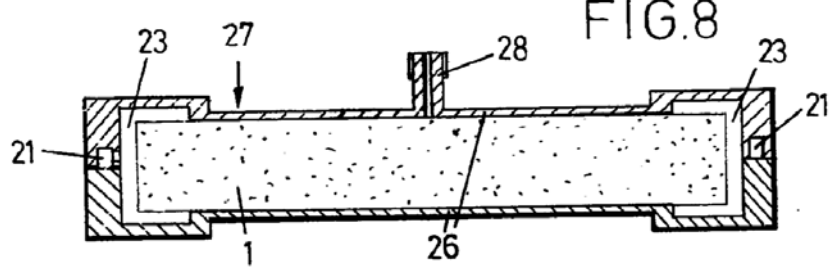


FIG. 8



16 As mentioned above, also considered in the opinion is patent document US6045600, which discloses a filter including a pleated accordion fold pack.

Closest Prior Art

17 Nationwide argues that the approach to inventive step in the opinion should have been on the basis of the closest prior art, and not any one of a plurality of

possible prior art documents. They argue that US 6045600, which specifically relates to pleated filter units, was the closest prior art and so once the examiner had determined (as he did) that the invention was not obvious in light of that document there was no need to consider any other.

- 18 Nationwide criticise in particular as lacking justification the examiner's statement in paragraph 25 of the opinion that "I do not agree that any prior art document selected as the matter cited could be described as correct or incorrect in the context of the *Windsurfing/Pozzoli* test."
- 19 This argument appears to have nothing to it. It appears to put the cart before the horse by attempting to define what is the closest prior art without reference to which provides the stronger obviousness argument. By definition, if a patent is inventive over document A but not over document B, then document B is closer prior art. This is, I think, what the examiner is getting at in his comment in paragraph 25 of the opinion.
- 20 Therefore, if the examiner is correct that the patent is invalid in view of FR2140536 (but not other documents), FR 2140536 is the closest prior art. As such, Nationwide's argument here adds nothing to its argument on obviousness considered below.

Obviousness

- 21 Nationwide does not contest the examiner's general approach, which was to apply the well-established *Windsurfing/Pozzoli*¹ test to determining obviousness in relation to FR 2140536. In particular, it does not challenge the examiner's construction of claim 2 or his finding that the difference between claim 2 and FR 2140536 is the requirement in claim 2 that the filter element be pleated.
- 22 What Nationwide challenges is the examiner's finding (paragraph 24 of the opinion) that "it would have required no inventive ingenuity to employ any one of a number of well known filter media types in the filter unit and so it would have been obvious for the skilled man to employ a pleated filter element in the method shown in FR2140536".
- 23 The finding of obviousness of claim 2 follows immediately from this finding. The question for me, bearing in mind the test set out in DLP as explained above, is therefore whether the examiner has made some error of principle in coming to this finding, or has reached a conclusion which is plainly wrong.
- 24 Nationwide argues that pleated filter media as in claim 2 of the patent are relatively delicate (e.g. paper) compared with that used in FR2140536, which comprises agglomerated particles. Examples given in FR2140536 include activated carbon, silica gel, natural or synthetic ion exchangers and molecular sieves, and lava, plastic, or metal particles. Reference is also made to filters from fibrous materials and expanded materials with open cells such as foam. Nationwide argues that the skilled person would have understood these to have

¹ set out in *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*, [1985] RPC 59A as restated and elaborated upon in *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

different properties from the more delicate pleated media of claim 2. Hence the skilled person would not consider adopting the moulding technique disclosed in FR 2140536 in relation to pleated media. Specifically, the blades which can be seen in fig. 7 (reproduced above) of FR 2140536 would not be appropriate for use in conjunction with a pleated media filter. This argument was made, albeit more compactly, in observations in response to the opinion request, and so was in essence considered by the opinions examiner.

- 25 Nationwide bolstered their argument by submitting as their sole piece of evidence papers from the file of the equivalent US application to the patent, US 10/597917. During the prosecution of that application through the USPTO, the examiner's attention was drawn to FR 2140536 and US 6045600, along with argument similar to that put forward in the previous paragraph. The examiner essentially adopted Nationwide's reasoning and allowed a claim similar to claim 2 in the patent.
- 26 Ms Hambleton supports the examiner's finding. She argues that substituting a pleated filter would have been a "mere workshop modification". In particular, she argues that the filter in FR 2140536 is itself described as a weak object which is easily damaged in handling, contrary to Nationwide's argument that a pleated filter would be more delicate. She also argues that claim 2 only requires the filter to include a pleated element rather than consisting exclusively of one.
- 27 Ms Hambleton further considers the US examiner's analysis to be incomplete. She considers him to have assumed the blades of FR 2140536 would inevitably cause significant damage to a pleated filter, whereas she considers the length of the blade and material of the filter can be varied to overcome such problems. She considers the disclosure of FR 2140536 of the possible use of fibrous materials to lend support to this.
- 28 Taking the point relating to the US document first, I do not see that the actions of the US examiner have any real bearing. The documents were not available to the opinions examiner so have no direct bearing on his decision. They could conceivably be used to argue that the opinions examiner was clearly wrong, but the fact that a different examiner came to a different conclusion falls a long way short of that. This is especially so as the US examiner was applying US law and the practice of the USPTO and so there is no clear read-across to whether the same arguments would apply under UK law.
- 29 More generally, it seems to me that no real error of principle by the examiner has been alleged – rather it is that he came to the wrong conclusion in believing use of a pleated filter in place of those disclosed would have been obvious. But I do not believe that I can find the examiner's conclusion to have been plainly wrong. It appears to be accepted that pleated filters were known in the art. In this context, although there may be some practical difficulties with using a pleated filter in the device of FR2140536 the examiner's opinion that using such a known filter in that device would have been an obvious variation seems to me to be not unreasonable.

Conclusion

- 30 I have found no error of principle in the examiner's analysis and have not found his conclusion regarding claim 2 to be clearly wrong. No argument was made about the other parts of the opinion, in particular Nationwide did not argue for independent validity of the claims dependent on claim 2. I therefore decline to set aside any part of the opinion.

Costs

- 31 Both parties have confirmed that they would expect an award on the Comptroller's usual scale to be awarded to the successful party. This was a decision on the papers and there was only a minimal amount of evidence. I therefore award Ms Hambleton the sum of £300 to be paid by Nationwide not later than 7 days after the expiry of the appeal period. If an appeal is lodged, payment will be suspended pending the outcome of the appeal.

Appeal

- 32 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