



**PATENTS ACT 1977**

BETWEEN

SRJ Limited and SRJ Technologies Group PLC  
(formerly SRJ Technologies Limited)

Claimant

and

Per-Christian Irgens

Defendant

PROCEEDINGS

Application under section 72 for the revocation of patent GB2468976B

HEARING OFFICER

Mr Phil Thorpe

Mr Matthew Kime, instructed by Hutchinson IP, appeared for the claimant  
Mr Thomas St Quintin, instructed by Ward Hadaway LLP, appeared for the defendant

Hearing date: 15 December 2021

**DECISION**

**Introduction**

- 1 Patent number GB2468976B (*“the patent”*) was filed on 26<sup>th</sup> March 2010 and granted to Per-Christian Irgens (*“the defendant”*) on 29<sup>th</sup> June 2011. The patent claims priority from Norwegian patent application NO 20091269 which has a filing date of 29<sup>th</sup> March 2009.
- 2 In February 2021, SRJ Limited and SRJ Technologies Group PLC (formerly SRJ Technologies Limited) (*“the claimant”*) made an application to the comptroller under sections 72(1)(a) and (d) of the Patents Act 1977 (*“the Act”*) for revocation of the patent on the grounds that the invention claimed is neither novel nor does it involve an inventive step over the prior art, that it is insufficient and that the matter disclosed in the specification of the patent extends beyond that disclosed in the application as filed.
- 3 On 20<sup>th</sup> April 2021 the defendant filed a counterstatement to which the claimant responded with a reply to the counterstatement on 11<sup>th</sup> August 2021. The normal evidence rounds followed with both sides putting forward expert evidence.

- 4 The matter came before me on 15<sup>th</sup> December 2021. The claimant was represented by Mr Matthew Kime of Ingenuity IP Chambers who was instructed by Hutchinson IP. The defendant was represented by Mr Thomas St Quintin of Hogarth Chambers who was instructed by Ward Hadaway LLP.

### **The law**

- 5 The comptroller's powers to revoke a patent on the application of another person are set out in section 72(1) of the Act, the relevant part of which read as follows:

72.-(1) Subject to the following provisions of the Act, the court or the comptroller may by order revoke a patent for an invention on the application of any person ... on (but only on) any of the following grounds, that is to say –

(a) the invention is not a patentable invention;

(b) ...

(c) the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art;

(d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed...

- 6 An invention is patentable if it meets the conditions set out in section 1(1) of the Act, namely that the invention is new, it involves an inventive step, it is capable of industrial application and is not excluded.

- 7 Sections 2 and 3 of the Act define what is meant by “new” and “inventive step” respectively. Section 2 states that an invention shall be taken to be new if it does not form part of the state of the art and goes on to define the state of the art as comprising anything made available to the public before the priority date of the invention. Section 3 states that an invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art.

### **The expert witnesses**

#### Mr Lumley

- 8 The claimant put forward Mr Peter Lumley as an expert witness. Mr Lumley is a specialist in mechanical design and engineering in process equipment and pressure vessels. He is a degree qualified, apprentice trained, Chartered Engineer who is the Managing Director of Manderstam International Group. He has 42 years of experience of the design, fabrication, commissioning, maintenance and operation of a wide range of process equipment in the process industry, which incorporates pressure vessels and piping. Mr Lumley has significant experience as an expert witness in 75 cases in the UK High Court and the International Court of Arbitration and has given oral evidence 29 times though this was his first-time giving evidence in a patent case. Mr Lumley had the advantage of seeing Dr Brown's report and was also instructed through a series of questions he was asked to answer. Mr St Quintin suggested that this may have influenced his evidence however I do not believe it did to any material effect.

9 I found Mr Lumley to be a helpful witness who understood that his role was to assist the tribunal. I did not sense that Mr St Quintin, who cross examined Mr Lumley, to have any real issues with his performance as an expert witness other than as mentioned above.

#### Dr Brown

- 10 The defendant put forward Dr Warren Brown as an expert witness. Dr Brown has over 25 years' experience in mechanical engineering in the design, analysis, construction, commissioning and daily maintenance of both upstream and downstream oil and gas facilities. He also researched the effects of thermal transients on (pressure vessel and piping) bolted joints for his Ph.D.
- 11 Dr Brown was cross examined by Mr Kime. Mr Kime was keen to bring to my attention that Dr Brown had not been provided with full details of the pleaded case prior to compiling his report. Indeed, as admitted by Mr St Quintin, he had not been shown the response to the counterstatement filed by the claimant. It also transpired that he had not been provided with the certified translation of the prior art patent document but rather an alternative uncertified translation. This according to Mr Kime might have prevented Dr Brown from assisting the tribunal as much as he could have done. In fairness to Mr Kime, he did not ask for the evidence of Dr Brown to be struck-out, but he did suggest that the hearing be adjourned to allow Dr Brown to consider the entirety of the pleaded case. I was not prepared to do that noting that Mr Kime would have the opportunity to challenge any aspect of Dr Brown's evidence during cross-examination and that he could further address me in light of that as to the weight that I should give to his evidence. I would however note that it was disappointing that those instructing Dr Brown had not provided him with all the relevant documents.
- 12 Fortunately, by the time of his cross-examination, Dr Brown had had sight of the certified translation and also the response to the counterstatement. He noted that he did not think that he had misunderstood anything based on having a different translation of the prior art. Having carefully considered the full extent of his evidence including his oral testimony and recognising the straightforward components of the device and the short description in the prior art patent, I am satisfied that the lack of the authentic translation has not impacted on the contents of his evidence.
- 13 In his expert report Dr Brown had sought to explain how the invention in the patent differed from the prior art. Despite sustained and sometimes combative questioning from Mr Kime, Dr Brown maintained his position on these differences. Overall, I found Dr Brown to be a credible expert witness who did seek to assist the tribunal
- 14 Ultimately, apart from some useful background on hot-bolting and some insights into what was the common general knowledge of the skilled person, I did not take too much from either expert witness. That is not a reflection on them as witnesses – both sought to assist the tribunal. Rather it reflects the nature of the case which covers relatively simple technology and where the main issue in dispute is really one of construction of the patent which is a matter for me rather than expert witnesses.

#### **The granted patent**

- 15 The patent relates to a flange clamp which can be used to enable bolts in an existing bolted flange coupling to be removed or replaced without releasing the pressure in the bolted flange coupling. This is often referred to as hot-bolting particularly where the bolts are replaced in a piping system that is still pressurised. The patent has two figures, reproduced below.

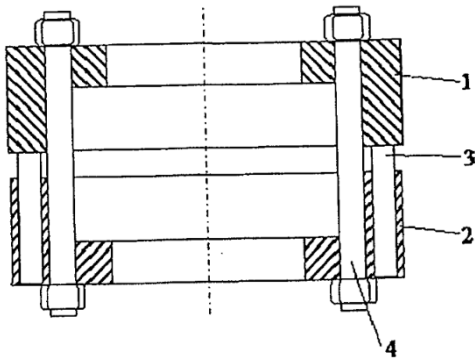


Fig. 1

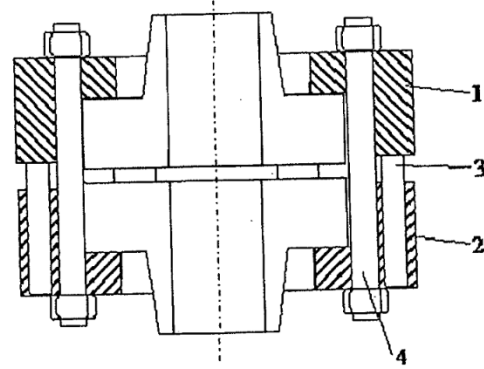


Fig. 2

- 16 The flange clamp of the invention comprises opposite clamp parts 1, 2 and a preloading part 4 arranged to preload the opposite clamp parts towards each other. The flange clamp can be preloaded to a higher force level than the existing force level of the flange coupling on which it is to be used and contraholders 3 in the flange clamp are arranged to work as a back stop to absorb the preload and prevent it from being transferred to the existing flange connection and prevent the gasket (not shown) from being over compressed.
- 17 In a hot-bolting operation, the dynamical flange clamp (or flange clamp segments) is first fitted around the bolted flange coupling. The clamp bolts 4 are then tightened until the clamp parts have full contact with the flanges. Then the contraholders 3 are adjusted to achieve contact with the clamp half 1. With the use of the socket screws as contraholders, this adjustment is achieved by tightening each individual socket screw. The clamp bolts 4 can then be preloaded to a higher force level than the existing force level of the flange coupling bolts. The flange coupling bolts can then be changed and the new coupling bolts can be preloaded to the required level. Finally, the dynamical flange clamp can be removed.
- 18 The patent has 7 claims in total with two independent claims, apparatus claim 1 and method claim 6. The claims read as follows:

1. A flange clamp comprising opposite clamp parts (1 and 2) and a preloading part (4) arranged to preload the opposite clamp parts towards each other, the clamp comprising contraholders (3) arranged to work as a back stop to absorb the preload.
2. A flange clamp as claimed in claim 1, wherein the contraholders (3) are adjustable.
3. A flange clamp as claimed in claim 1 or 2, wherein the clamps (1 and 2) are provided as whole rings.
4. A flange clamp as claimed in claim 1 or 2, wherein the clamps (1 and 2) are split into segments.

5. Use of a flange clamp as claimed in any preceding claim in a hot bolting operation.
6. A method of clamping comprising: applying a clamp, the clamp comprising opposite clamp parts, a preloading part and contraholders; and preloading the clamp parts towards each other, wherein the contraholders work as a back stop to absorb the preload.
7. A flange clamp, substantially as hereinbefore described with reference to the drawings.

## Claim construction

- 19 Before I can consider the validity of the patent, I must first construe the claims. This means interpreting the claims in the light of the description and drawings as instructed by section 125(1) of the Patents Act. In doing so I must interpret the claims in context through the eyes of the person skilled in the art. Ultimately the question is what the person skilled in the art would have understood the patentee to be using the language of the claims to mean. This approach has been confirmed in the decisions of the High Court in *Mylan v Yeda*<sup>1</sup> and the Court of Appeal in *Actavis v ICOS*<sup>2</sup>. Section 125(1) reads as follows:

For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

### *The skilled person*

- 20 The claimant identifies the person skilled in the art as “an offshore oil and gas engineer, a pipe fitter or someone who is familiar with flanged pipe couplings”. I agree that the knowledge of the person skilled in the art is not limited to hot-bolting. The defendant contends that the skilled person is “a person engaged in oil and gas pipeline design or the design of systems for the maintenance of such pipelines”. These suggestions for the skilled person are not that far apart. I will take the person skilled in the art therefore to be an offshore oil and gas engineer, a pipe fitter or someone engaged in oil and gas pipeline design or maintenance who is familiar with known flange couplings and bolted flange couplings.

### *The common general knowledge*

- 21 Each side put forward numerous documents to exemplify what would have been common general knowledge (CGK) to the skilled person at the time of the invention. These include two patent documents US6869081 B1 and JP4157413 B2, standards and draft standards documents from the American Society of Mechanical Engineers (ASME), a trade brochure from Patriot International<sup>3</sup>, a safety publication from the Engineering Equipment and Materials User Association (EEMUA) on the removal and replacement of flanged joint bolting on live piping and equipment, a Flange

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<sup>1</sup> *Generics UK Ltd (t/a Mylan) v Yeda Research and Dev. Co. Ltd & Anor* [2017] EWHC 2629 (Pat)

<sup>2</sup> *Actavis Group & Ors v ICOS Corp & Eli Lilly & Co.* [2017] EWCA Civ 1671

<sup>3</sup> [www.patriot-int.com](http://www.patriot-int.com)

Bolting Standard document from a company called Woodside and a Grayloc Connectors trade brochure<sup>4</sup>.

22 In *Raychem Corp's Patents*<sup>5</sup> Laddie J explained common general knowledge as follows:

“The common general knowledge is the technical background of the notional man in the art against which the prior art must be considered. This is not limited to material he has memorized and has at the front of his mind. It includes all that material in the field he is working in which he knows exists, which he would refer to as a matter of course if he cannot remember it and which he understands is generally regarded as sufficiently reliable to use as a foundation for further work or to help understand the pleaded prior art. This does not mean that everything on the shelf which is capable of being referred to without difficulty is common general knowledge nor does it mean that every word in a common text book is either. In the case of standard textbooks, it is likely that all or most of the main text will be common general knowledge. In many cases common general knowledge will include or be reflected in readily available trade literature which a man in the art would be expected to have at his elbow and regard as basic reliable information.”

23 A set of industry standards may be considered to be part of the common general knowledge, even if they are of such length and complexity that no skilled worker could possibly be expected to know even a fraction of the information contained therein, providing the skilled person would know where to find the information relevant to the task in hand (from *Nokia v Ipcor*<sup>6</sup>).

24 Sachs LJ. in *General Tire & Rubber Co v Firestone Tyre & Rubber Co Ltd*<sup>7</sup> sets out the relationship of patent specifications to the common general knowledge, stating “it is clear that individual patent specifications and their contents do not normally form part of the relevant common general knowledge”.

25 To be considered to be CGK, all documents need to have been published and readily available at the time of the invention, which has a priority date of 29<sup>th</sup> September 2009. The publication dates of some submissions are not clear and also the arguments in relation to each proposed CGK document have not been fully set out in the submissions or in the skeleton arguments. I will nevertheless seek to draw some conclusions on the various submissions focusing on what was known about hot-bolting.

#### *Hot-bolting at the priority date of the patent*

26 The expert evidence of Dr Brown included a reference to Article 3.11 of ASME PCC-2-2008, which was published on April 7<sup>th</sup> 2009<sup>8</sup> (before the priority date of the patent). Article 3.11 defines “hot-bolting” as “the sequential removal and replacement of bolts on flanged joints while under reduced operating pressure. It is carried out one bolt at a time in predetermined cross pattern sequence”. Section 3.4 of this article states that “hot-bolting may be performed only when the operating pressure is equal to or less than 50% of the maximum pressure allowed”. In the execution of the

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<sup>4</sup> [www.grayloc.com](http://www.grayloc.com)

<sup>5</sup> *Raychem Corp's Patents* [1998] RPC 31

<sup>6</sup> *Nokia v Ipcor* [2010] EWHC 3482

<sup>7</sup> *General Tire & Rubber Co v Firestone Tyre & Rubber Co Ltd* [1972] RPC 457

<sup>8</sup> [Repair of Pressure Equipment and Piping ASME PCC-2-2008 | XIOMARA BELLO - Academia.edu](http://www.xiomara-bello.com/Repair-of-Pressure-Equipment-and-Piping-ASME-PCC-2-2008)

hot-bolting process there is no mention of clamping the bolted joint (section 4.2 of the article).

- 27 Additionally, Dr Brown referred to an information sheet produced by EEMUA, an organisation that helps to improve the safety, environmental and operating performance of industrial facilities. The EEMUA information sheet is entitled “Guidance Procedure for the Removal and Replacement of Flanged Joint Bolting on Live Piping and Equipment” and was published in September 2005. This corroborates that the hot-bolting process at that time did not involve the routine use of clamps. Section 2 of the EEMUA sheet states “the technique involves the sequential removal and replacement of flange bolts on piping and equipment while in operation... is carried out one bolt at a time in a predetermined pattern. The technique may be carried out at normal operating pressure although it is preferable to reduce the pressure to the minimum practical level”. Throughout this information sheet there is no mention of clamping the existing bolted flange joint.
- 28 Dr Brown did however note that in 2009 the use of clamps in hot-bolting was known in the industry but it was not widespread. In the Woodside Flange Bolting Standard, which was made available on the internet in January 2009 and filed with Dr Brown’s report, section 5 is entitled “Procedure for Hot-bolting” and states that “it is therefore allowable to hot bolt flanges with 4 securing fasteners only with the installation of two external clamps”. The table below is taken from page 13 of the same document and shows that the installation of clamps for hot-bolting procedures is recommended in certain circumstances when there are four securing fasteners.

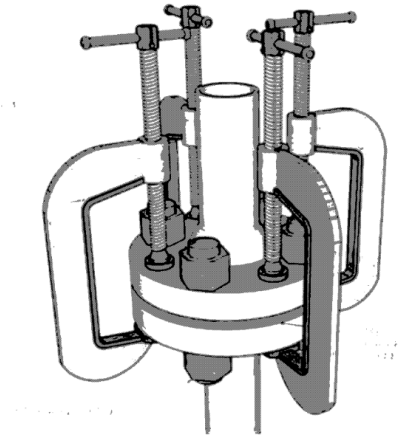
A table summarising the hot bolting procedure is given below.

**Summary of Hot Bolting Procedure to Replace Corroded Bolts**

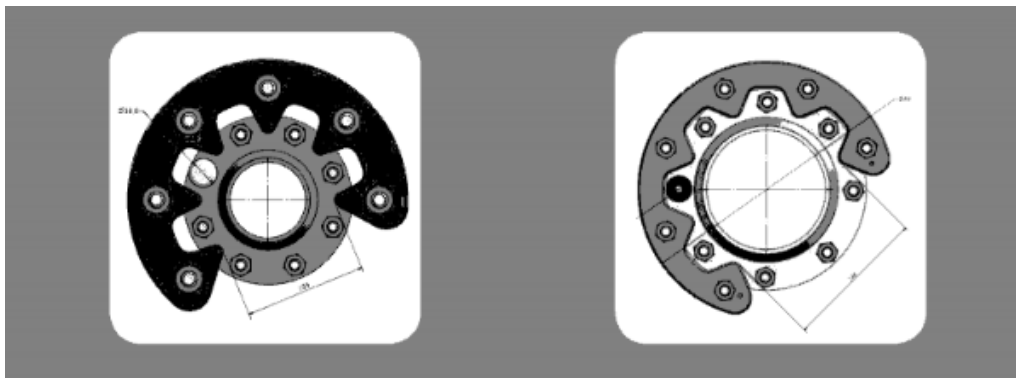
Class	4 securing fasteners	8 or more securing fasteners
150	Yes (with clamps installed)	Yes
300	Yes (with clamps installed)	Yes
600	No	Yes (limit pressure to 8 MPa)
900	No	Yes (limit pressure to 12 MPa)
1500	No	No
2500	No	No

- 29 Mr St Quintin highlighted the proximity of the publication of this document to the priority date of the patent. He also referenced some fairly standard copyright restrictions on the use of the guidelines in the document itself. The thrust of his argument was that this document was unlikely to have been part of the common general knowledge. Mr Lumley’s response was that this document was available on the internet and that they were also earlier versions of this document. He also noted that Woodside is the principal oil and gas company in Australia.
- 30 I note also that Dr Brown recognised that the EEMUA documents were only available to members of that organisation though in his opinion they were still part of the CGK.

- 31 In its counterstatement the defendant did recognise that at the priority date of the invention an accepted approach to hot-bolting was to use C-clamps to force the mating flanges together prior to bolt loosening and removal and the defendant provided an illustration of this (reproduced below)



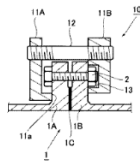
- 32 The defendant argues that it was not appreciated by the skilled addressee at the priority date that an increase in stress or compression of the gasket from the C-clamps was a problem that would benefit from a solution. Therefore, there was nothing to cause the skilled addressee, without the hindsight knowledge of the patent, to seek to apply any tool other than C-Clamps in a hot-bolting operation.
- 33 The claimant response was that C- Clamps were not the only clamps suggested for hot-bolting. It refers to Patriot International (and other manufacturers) clamps that it argues were being used for hot-bolting at the time of the invention. The Patriot International clamps as set out in the submitted brochure are shown below. The date for the publication of the brochure is however not clear and has not been provided.



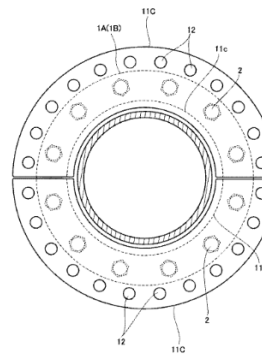
- 34 To further illustrate that clamps other than C-clamps were being used, the claimant also refers to JP4157413B2 and has helpfully provided a machine translation. JP4157413B2 was published on 1<sup>st</sup> October 2008 and as shown below discloses a device clamp which clamps over an existing bolted flange joint to reinforce it.



【図3】



【図4】



- 35 Mr St Quintin noted that there is simply no evidence that either the use of the Patriot clamps or the clamp disclosed in JP4157413B2 were part of the common general knowledge. I agree. However, on balance I am satisfied that the possible use of clamps in hot-bolting, even if as Dr Brown argues it was not widespread, would nevertheless still be part of the skilled person's CGK at the priority date of the application.

#### *Construction of the claims*

#### *The meaning of "flange clamp"*

- 36 The meaning of the term "flange clamp" was the subject of much discussion at the hearing. Claims 1-4 and 7 are all directed to "A flange clamp" with claim 5 being directed to the "Use of a flange clamp". Claim 6 in contrast does not refer to a flange clamp but is rather directed simply to a method of applying "a clamp". Further the description is titled "Hot Bolting Clamp" and starts by noting that the invention "relates to a dynamical flange clamp useful for strengthening flange couplings or taking over the bolt forces in loaded flange couplings. In particular the invention is useful for bolt changes in a Hot-bolting operation."
- 37 Mr St Quintin argues that the terms "flange clamp", "dynamical flange clamp" and just "clamp" as used in the patent all mean the same thing. It is a clamp that can be applied to an existing bolted flange coupling to allow replacement of the bolts in a hot-bolting operation. This construction Mr St Quintin argues was supported by Dr Brown who notes that the skilled person, because of their CGK, would recognise the terms "clamp" and "flange clamp" as being devices that are added to already bolted couplings. Mr St Quintin goes on to argue that consideration of what is a clamp in the context of the patent, and of each of the claims, as a whole, must take account of the teaching that the clamp disclosed in the patent has "contraholders" that "absorb the preload". This it is argued cannot be fulfilled if the device is used for the initial seating of a gasket, and for the gasket to be compressed.
- 38 Mr Kime rightly notes that the term "flange clamp" is not specifically defined in the patent. The patent uses the related term "dynamical flange clamp" stating "by the use of dynamical flange clamp according to the invention, the gasket stress is kept virtually constant during the transfer of forces between the flange coupling bolts and the flange clamp. This is done without any further adjustment to the dynamical flange clamp" (page 1 lines 22-25). He notes that none of the claims specified "a dynamical flange clamp", but instead each claimed a broader "flange clamp". The claimant also

argued that “flange” must be given its usual and ordinary meaning which they defined as “a projecting rim”.

- 39 Mr St Quintin argued that the construction of the term flange clamp he was advocating added technical limitations to the claim. These relate he argued to certain relative dimensions of the flange clamp to the bolted flanged coupling to which it is to be applied. The difficulty however for Mr Quintin is that the patentee has chosen to claim the flange clamp in isolation and not in combination with the bolted flange coupling to which it is applied. The patentee could easily have done that by directing the claim specifically to the combination or to the flange clamp when used with a bolted flange coupling and then set out explicitly any dimensional or functional limitations between the two, but they have chosen not to do so.
- 40 Further the description of the patent does not go into any detail on the relative sizes of the various clamp components especially in relation to the size of the flange coupling to which it is to be applied. The description does not clearly disclose how access to the flange coupling bolts is achieved. Indeed, the coupling bolts are not shown in either of the figures in the patent. It is also evident that the design of the clamp, especially when the clamps 1 and 2 are formed as whole rings, will be specific to the general arrangement of the bolted flange coupling in particular to the pitch of the bolts. So, a clamp that might work with a bolted flange coupling where the pitch of the bolts is 300mm would not necessarily be suitable for a similar bolted flange coupling but with the bolts pitched at 600mm. The clamp will also need sufficient space between the outside of the bolts and the edge of the coupled flange in order for the clamp parts to properly engage.
- 41 This dependency of the flange clamp on the flanged coupling makes it difficult to properly construe the claim as currently worded. For the purpose of this decision, I will construe the term “flange clamp” as not having any particular dimensional limitations relative to the flange coupling other than that it is suitable for use in replacing or strengthening the bolts in that flange coupling. I would add that the patent clearly relates to a clamp that should be suitable for use in a hot-bolting operation. This would suggest that the clamp will have certain requirements in terms of strength ie it would need to be able to withstand preloading forces comparable to the forces in the bolted clamp to which it is applied. Neither side has suggested that the prior art clamp would not meet these requirements and hence I need say no more.

*The meaning of “preloading part” and “conraholders”*

- 42 Whilst there was some discussion of the terms “preloading part” and “conraholders” during the hearing, I did not detect any real difference between the parties.
- 43 The preloading part is identified in the patent description as the bolt 4, the tightening of which provides a force which urges the two clamp halves 1 and 2 together. The conraholder is the adjustable screw threaded shaft 3 which acts as a backstop to prevent the further motion of the clamp halves towards one another. This prevents the over compression of a gasket which may be present either between two flanged rings on pipe endings or between two flanged rings on pipe endings within an already present bolted pipe connection.

### *The scope of claim 5*

- 44 Mr St Quintin described claim 5 as perhaps the more commercially interesting application of the clamp namely the specific use of the clamp for hot-bolting. There was some difference between Mr Quintin and Mr Kime on the scope of this claim. Mr Quintin described the claim as a process claim and hence even if claims 1-4 were anticipated or obvious, the idea of using an established product to do something that no one previously thought of is adding something to the existing stock of knowledge and therefore is or is certainly capable of being inventive. He refers to various authorities as discussed in paragraph 2.23 of the CIPA Guide.
- 45 Mr Kime noted that it is trite law to state that the mere use of a known product (other than certain medicines) in a specific application cannot confer novelty or inventive step on an otherwise invalid patent claim. He went on to say that there are no "second non-medical use" provisions in the Act corresponding to Section 4A. Claim 5 claims nothing more than a use for a known product, so that use cannot render new or non-obvious the product itself or the claimed use.
- 46 Mr Kime is indeed correct to say that there are no "second non-medical use" provisions in the Act. The reason for that is because the provisions in Section 4A allowing the patenting of substances or compositions for methods of first and second uses are clearly tied to the medical methods that are specifically excluded in that section. There is no comparable exclusion for non-medical methods of using an invention hence there is no need for explicit provision allowing first and second non-medical uses.
- 47 Both Mr Kime and Mr St Quintin have referred me to numerous authorities on this point. Mr Kime notes that in T215/84 it was held that
- "...The discovery that the known equipment may be used in a new manner cannot render the entity itself novel..."
- 48 This is he argues consistent with *Inhale Therapeutics v Quadrant*<sup>9</sup> where Laddie J. notes:
- "Just as it is no defence to infringement for the infringer to say that he did not know that he had the features of the claim in his product, so it is no answer to an allegation of anticipation that no one would have realised that the article or process described in or obtained from the prior art had the features of the claim."
- 49 He goes on to refer to T523/89 where the board of appeal referenced the EPO's Guidelines for examination<sup>10</sup> noting that:
- "...The question of anticipation of a claim to an article for a particular use is dealt with in the Guidelines C-III, 4.8 and C-IV, 7.6 from which it is clear that, with the exception of medical uses of known substances, the indication of intended use is only to be seen as limiting to the extent that the article has to be suitable for this use. In other words, the disclosure of an equivalent article without an indication of the particular use claimed but which is nevertheless suitable therefor will destroy the novelty of a claim to the article for that particular use. The present Board sees no reason to disagree with this general principle of interpretation as

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<sup>9</sup> *Inhale Therapeutics v Quadrant* [2002] RPC 21

<sup>10</sup> [EPO Guidelines for examination](#)

stated in the Guidelines, which to its best knowledge has not been put into contention in any previous cases before the Boards of Appeal...”

50 Both of the EPO decisions referred to above relate to claims of the form “Apparatus for a particular purpose” and are thus of limited use in considering the proper scope of a claim directed to the use of a product.

51 Of more relevance is the Enlarged Board of Appeal’s decision in G 2/88 where they were specifically considering whether a claim for the use of a compound for a particular non-medical purpose was novel under Art. 54 EPC. This was with regard to a prior publication which disclosed the use of that compound for a different non-medical purpose, so that the only novel feature in these cases was that the previously disclosed use of the substance, although specifically stated to be for another purpose, would inherently comprise the use as claimed in the new application. The enlarged board was *inter alia* asked to answer the following question:

“(iii) Is a claim to the use of a compound for a particular non-medical purpose novel for the purpose of Article 54 EPC, having regard to a prior publication which discloses the use of that compound for a different non-medical purpose, so that the only novel feature in the claim is the purpose for which the compound is used?”

52 The Enlarged Board cited T 231/85, a case concerning an application for use as a fungicide of a compound already disclosed in the prior art as a growth regulator. The use according to the claimed invention and the use disclosed in the prior art were both carried out in the same way (ie the means of realisation was the same, namely the spraying of useful plants). The board had nevertheless concluded that the claimed invention was novel because the technical teaching in the application differed from that in the citation, and that, even if means of realisation was the same, the use was not yet known. It went on to note that “the fact that a substance is known does not preclude the novelty of a previously unknown use of this substance even if the new use does not require any other technical implementation than an already known use of the same substance.”

53 In this instance the use of claim 5 does require a technical implementation namely its use in a hot-bolting procedure. Hence a claim directed to “A clamp for hot-bolting” is different in scope to a claim directed to “The use of a clamp in hot-bolting” with the former covering clamps that are suitable for hot-bolting whilst the latter covers the actual use of the clamp in hot-bolting. The jurisprudence of the EPO is reflected in the Manual of Patent Practice (MoPP) in sections 2.16 and 2.17 which note that:

“Similarly a claim such as “the use of substance X as an insecticide” is regarded as equivalent to a “process” claim of the form “a process of killing insects using substance X” and is not interpreted as directed to the substance X recognisable (eg by further additives) as intended for use of an insecticide.

A claim to the use of X for the purpose of Y may be regarded as novel provided that the method of use is new. Parker J. stated in *Flour Oxidizing Co Ltd v Carr and Co Ltd*,<sup>11</sup> that “when the question is solely a question of prior publication, it is not, in my opinion, enough to prove that an apparatus described in an earlier specification could have been used to produce

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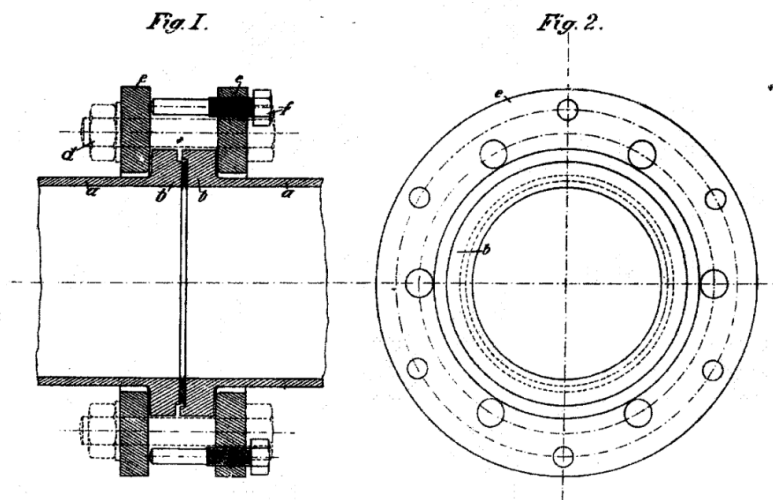
<sup>11</sup> *Flour Oxidizing Co Ltd v Carr and Co Ltd*, 1908 25 RPC 428

this or that result. It must also be shown that the specification contains clear and unmistakable directions so to use it”.

## Novelty

### The prior art

- 54 The pleaded case relies on one piece of prior art: an Austrian patent AT12838. The Austrian patent is in German and a certified translation was filed. The text of the description referred to in this decision is taken from the certified translation.
- 55 I would note that the claimant in its response to the counterstatement referred to a further prior patent document, JP 4157413B2, to inter-alia counter an argument by the defendant in its counterstatement that “C-Clamps” were the de-facto choice when using clamps in hot-bolting applications. As the date of the hearing approached, correspondence from the claimant appeared to suggest that this Japanese document was also to form a stand-alone novelty citation against the claimed invention. I asked Mr Kime whether this was something that had been clearly pleaded or if any request had been made to amend the pleadings in this respect. He confirmed that no such request had been made nor had it been pleaded that JP 4157413B2 formed the basis of a stand-alone challenge against the claimed invention. Unsurprisingly I informed Mr Kime that the hearing would be restricted to the case that had been pleaded.
- 56 The Austrian patent was published in 1908 and relates to forming a leak tight closure of the joint between two wrought iron pipes, without experiencing the problems of the prior art, namely overly stressing or deforming the flanges or bending the stud bolts (the fixing bolts). There are two figures reproduced below.

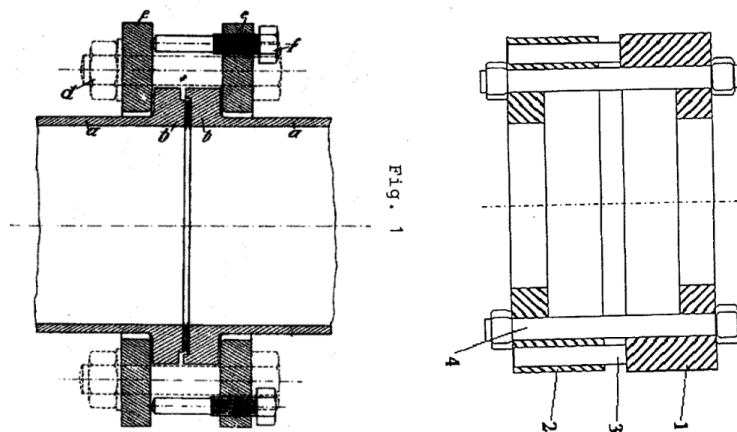


- 57 The sealing material/gasket is not labelled, but is the dark area between the collars *b*. The description of the invention is short and so has been reproduced below in its entirety:

“The pipes *a a* comprise the collars *b b* against which the flanges *e* lie, said flanges being connected to each other by bolts *d*. Appropriate sealing material is laid between the collars *b b*. Thrust bolts *f*, the bolt circle of which lies outside the bolt circle of the

fixing bolts, are disposed in one of the two flanges. These thrust bolts *f* are preadjusted to correspond approximately to the flexibility of the seal between the collars *b* and the bolts *d* are then tightened until the thrust bolts *f* touch the other flange. Should leaks subsequently occur, requiring further tightening of the bolts *d* and compressing the seal, the thrust bolts *f* can be readjusted according to the tightness.”

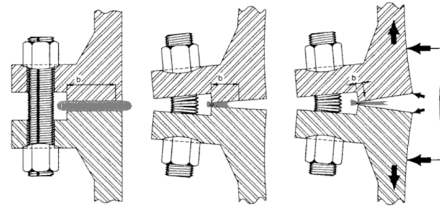
- 58 Structurally, the device of AT12838 is very similar to that of the claimed invention as can be seen if the prior art figure is put alongside the figure from the patent.



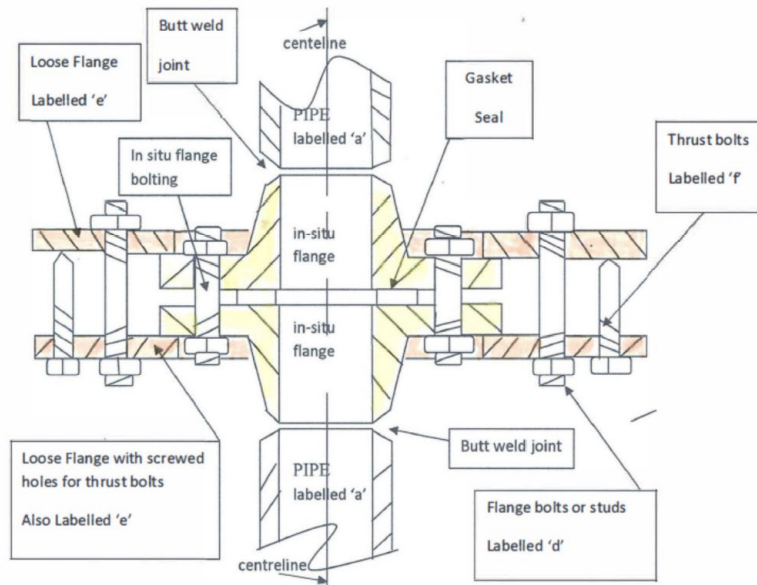
- 59 Both have two opposing clamp parts (flanges *e* and *e* and clamp parts 1 and 2). Both have bolts and nuts (*d* and 4) to draw the two clamp parts together and bolts (*f* and 3) to limit the distance between the clamp parts when drawn together. Mr Lumley accepted this however Dr Brown thought such a comparison was too simplistic. This was picked up by Mr St Quintin.
- 60 Mr St Quintin contends that there are significant differences between the two such that AT12838 cannot be considered to anticipate claim 1. I will start however with a difference that is not in my opinion significant. That is that AT12838 relates to flanged connections for wrought iron pipes which Mr St Quintin put to Mr Lumley is a material that is no longer used in this sort of industry. Notwithstanding that the patent in issue including the claims makes no mention of the material of the pipes that the flange clamp is to be applied to, Mr Lumley went on to note that whilst wrought iron was not a common material in use in oil and gas pipelines, it was still a useful material which was corrosion and acid resistant. Hence, I see nothing of significance in the material of the pipes.
- 61 More significantly Mr St Quintin notes that the function of the device in AT12838 is completely different to that of the flange clamp in the patent. The device in AT12838 is to secure the two pipes together in a way that does not over-compress the gasket or cause flange rotation. As Dr Brown helpfully illustrated in one of the attachments to his evidence, undesirable flange rotation can occur with excessive tightening of the securing bolts (see figure below) which can cause the opposing surfaces of the flange parts to open up affecting the quality of the seal. The thrust bolts *f* in AT12838

are intended to prevent both over-compression of the gasket as well as flange rotation.

#### Flange Rotation

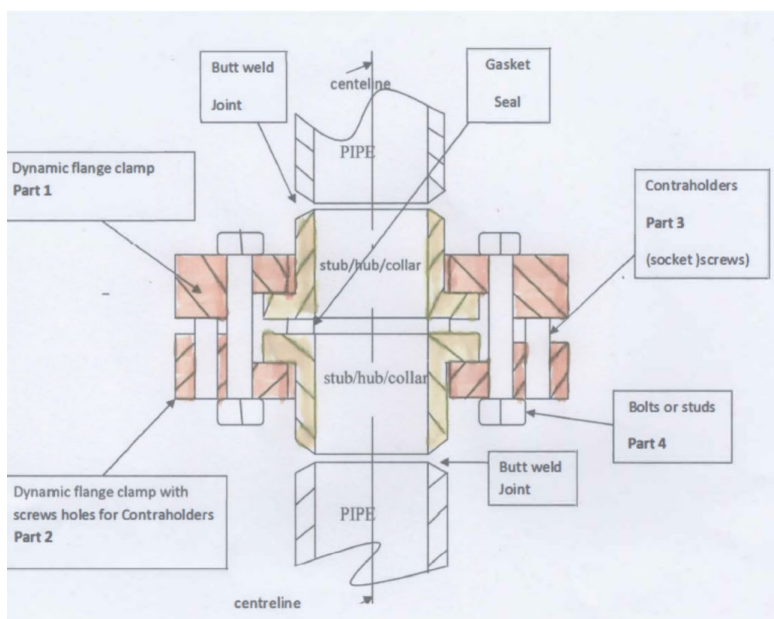


- 62 Dr Brown noted that the problem of flange rotation was something that would have been part of the Skilled Person's CGK at the priority date together with other common methods of solving that problem. He refers to the possible use of wedges between the external gaps of the flange as well as dual railed gaskets, which consist of a concentric gasket and metal ring. The (outer) metal ring has a thickness that enables proper compression of the (inner) gasket but prevents flange rotation. An example of such a gasket is shown in US6869081.
- 63 Mr Lumley agreed that the device of AT12838 worked by compressing the two collars welded onto pipes towards each other, to squeeze and compress the sealing material or gasket that is between the two collars and thereby form a leak tight closure. He agreed that overtightening the connecting bolts could lead to flange rotation and that this effect can also cause the fixing bolts to be bent out of shape. Mr Lumley also agreed that if flange rotation and/or bent fixing bolts occur then an absolute sealing of the pipe joint is no longer achieved.
- 64 Mr Lumley went on to agree that there was an instruction to adjust the thrust bolts (f) before any tightening of the bolts (d) and then the bolts (d) are tightened until the thrust bolts (f) touch the other flange. Mr Lumley also agreed that should leaks subsequently occur, the thrust bolts (f) would be slacked off and then the bolts (d) are tightened until the flange touches the thrust bolts in their new position, and then the person tightening the bolts would stop. Mr Lumley agreed that AT12838 did not specifically disclose loading the thrust bolts with any force once they touch the flange (i.e. no specified preload) and instead they are used as a backstop to the tightening.
- 65 Mr Lumley agreed that there is no disclosure of applying the device of AT12838 to an existing bolted flange connection with a compressed gasket. Mr Lumley however prepared the following technical drawing (referred to as figure A4-1) to illustrate how the device in AT12838 could be used with a bolted flange coupling to enable hot-bolting.



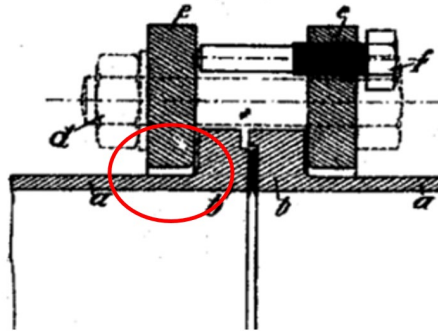
66 Mr Lumley notes with reference to the above drawing that if the device of AT12838 is assembled on a bolted flange, then the additional bolts (labelled “f”) can be adjusted to limit the movement of the rings (loose flanges e) in the same way as bolts 3 are used to prevent movement towards each other of the clamp parts (1 and 2) in the patent. Therefore, the adjustment and movement of the rings in relation to each other will be such that the clamp under preload will be mechanically prevented from increasing the load on the flange coupling.

67 Mr Lumley also produced the following diagram (referred to as figure A4-2) to indicate that the flange clamp of the patent could equally be used in the same way as the device in AT12838 is used ie. to secure together two pipes with collars without excessively deforming the gasket thus further demonstrating the inter-changeability of the two devices.

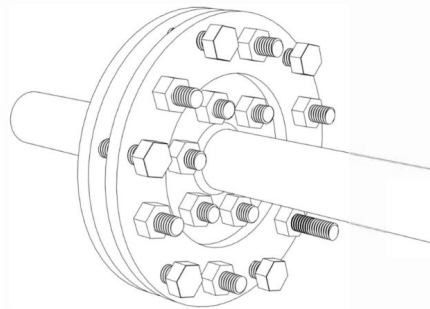




68 Mr St Quintin response to figure A4-1, which was supported by Dr Brown, was firstly that it would be impossible to use the AT device in a hot-bolting operation as if the device was installed around a bolted flange, it would not be possible to remove and replace any of the bolts in that bolted flange. This is because all the bolts would be obscured by the AT12838 device. Both drew this conclusion from figure 1 of AT12838 which shows (with my added emphasis below) the inner diameter of flanges e close to the external diameter of pipes a. In other words, if the collars b were secured together with through bolts, then the flanges would overly those bolts if fitted afterwards thus preventing their replacement.



69 Mr Lumley has avoided this problem in his depiction in figure A4-1 by apparently having the inner diameter of the flanges e outside of the bolts holding the collars b together. I say apparently because it is not totally clear from the figure. Mr Lumley was however shown the following diagram produced by the claimant's representative and he confirmed that it did depict the AT12838 device applied to a pre-bolted flange joint as envisaged in his figures A4-1.



70 Dr Brown also took issue with the functionality of the arrangement shown in figure A4-1 noting that the relative disposition of the flange and thrust bolts to the pipe flanges was likely to induce the sort of flange rotation discussed above. Indeed, Dr Brown made the same observations in respect of AT12838 highlighting the passage in the description stating that *“Thrust bolts f, the bolt circle of which lies outside the bolt circle of the fixing bolts d, are disposed in one of the two flanges.”*

71 Mr Kime's response to this was to note that the thrust bolt equivalents in the drawings of the patent also appear to lie outside the circle of the main bolts. However, Dr Brown maintained his position that there is a subtle difference relying on the text of the patent more than the drawings. His argument is that the conholders in the patent function act as a stop, in other words as noted in the

patent they “limit movement of clamps parts 1 and 2 towards each other”. In contrast the function of the thrust bolts in AT12838 is to prevent flange rotation as discussed above.

72 Whilst recognising Dr Brown’s expertise in this field, I am not persuaded by his argument that the thrust bolts in AT12838 are not arranged so as to be capable of working also as a backstop to absorb a preload as required by the claim. The skilled person would I believe fully recognise that the thrust bolts could perform that function in the same way that the contraholders could prevent flange rotation if used in the manner of the clamp in AT12838.

73 Dr Brown also sought to distinguish AT12838 from the patent by arguing that the clamp in AT12838 and the arrangement depicted in A4-1 could not be used in a hot-bolting operation because they each show clamps consisting of two complete rings which could not be fitted in place around an operational (already assembled) bolted joint.

74 Mr Lumley agreed that the device as depicted in AT12838 could not be fitted to an existing pipe connection as it is a solid ring; the ring would need to be segmented or split in some way in order to apply it to already connected pipes and there is no teaching towards using the AT12838 device in this way. In his expert report, Mr Lumley stated that the dynamic flange clamps of the patent would however also need to be hinged or split into segments to slip over a pre-bolted flange joint.

75 The patent in suit does not describe how such a split could be formed, the considerations of where to split the rings or how split clamps could be used and claims a flange clamp split into segments in claim 4.

76 So where does this leave me? I would note firstly that the description in AT12838 is an enabling disclosure. AT12838 is also in the same field as the patent, that is the technical field of pipe connections. But does AT12838 disclose a clamp used to replace existing bolts in a bolted flanged coupling? The answer to that is clearly no. But as discussed above claim 1 is not limited to a clamp when used in such an application. Rather the claim is directed to a clamp that would be suitable for that purpose. And despite the observations of Dr Brown and the arguments of Mr St Quintin, I believe that the clamp in AT12838 would be suitable for hot-bolting a suitably sized bolted flanged coupling. I should perhaps clarify that in referring to a suitably sized bolted flange coupling I am referring to a coupling that will allow the clamp to engage with coupling to allow the flanges of the coupling to be engaged by the clamp whilst also allowing access to the bolts of the coupling.

77 Hence AT12838 discloses each feature of claim 1 as detailed below:

A flange clamp comprising opposite clamp parts (*flanges e e*) and a preloading part (*bolt d*), able to preload the opposite clamp parts towards each other, the clamp comprising contraholders (thrust bolts *f*) that can work as a back stop to absorb the preload.

78 Therefore, I find that claim 1 lacks novelty with respect to AT12838.

- 79 AT12838 clearly discloses adjustable conholders (the thrust bolts *f* are adjustable) and so I find that claim 2 also lacks novelty. AT12838 further discloses flange clamps (*e*) which are provided as whole rings (as depicted in figure 2) and so I find that claim 3 also lacks novelty.
- 80 Claim 6 of the patent is to a method of clamping comprising applying a clamp, the clamp comprising opposite clamp parts (flanges *e* of the Austrian patent), a preloading part (bolt *d* of the Austrian patent) and conholders (thrust bolts *f* of the Austrian patent); and preloading the clamp parts towards each other, wherein the conholders work as a backstop to absorb the preload. In the Austrian patent, the device in use has the thrust bolts *f* contact the flanges and act as a backstop when the bolts *d* are tightened, and so the method of use is identical noting that the claim is not directed clearly to clamping an existing bolted flange coupling. I find that Claim 6 lacks novelty.
- 81 The Austrian patent does not explicitly or implicitly disclose a flange clamp where the clamps are split into segments so claim 4 is novel. Further given the construction of claim 5 set out above, there is no clear and unmistakable direction in AT12838 of using of the clamp disclosed in that document in a hot-bolting operation. Indeed, the function of the clamp is completely different namely, to provide the main means of securing the two flanged pipes together. Hence claim 5 is novel.

### **Inventive step**

- 82 In assessing whether or not an invention would have been obvious it is easy to be misled by hindsight. Therefore, it has become the practice to approach the question in a step-by-step way, as first laid down in the *Windsurfing* case<sup>12</sup>. More recently it has been restated by the Court of Appeal in *Pozzoli*<sup>13</sup> where Jacob LJ noted: -

*I would restate the Windsurfing questions thus:*

*(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?*

- 83 I have considered the Skilled Person and their Common General Knowledge above.
- 84 Claim 4 claims the flange clamp of claim 1 or 2, where the clamps are split into segments; this segmentation is the inventive concept of claim 4.
- 85 The description notes in respect of this feature that:

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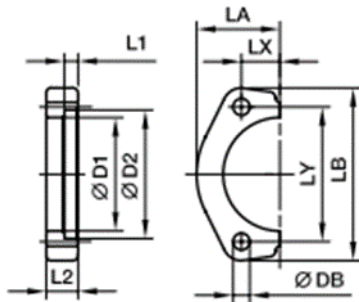
<sup>12</sup> *Windsurfing* case [1985] FSR 59

<sup>13</sup> *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

*“The dynamical flange clamp may be formed as a full ring, or the clamp can be split into two or more segments in order to accommodate installation on pipeline flange couplings. Each segment will then contain bolts 4 and contraholders 3. Further, in some embodiments a full flange clamp circle may be provided, but in other embodiments a full flange clamp circle is not necessary, for example if only a limited number of bolts are to be changed on a flange connection. In such cases, one or more clamp segments may be placed accordingly to these bolts.”*

- 86 The claimant’s attack on claim 4 is that it would have been obvious for the person skilled in the art to consider splitting the clamp of AT12838 into segments so that the clamp could be retrofitted to an existing pipe connection. The claimant argues that splitting clamps into segments was well known and it would have been obvious to try. It refers to excerpts from a Parker Catalogue with a purported date of December 2005 to demonstrate that split rings were known at the filing date. The catalogue shows a range of split clamps as depicted below whilst noting that:

*“The split clamps make it easy to assemble the connection in close quarters. They also make removal of the flange head component, such as a hose assembly, easy by loosening all four bolts and removing one clamp half.”*



- 87 This publication date of the catalogue has not been challenged by the patentee though it does not accept that this catalogue forms part of the common general knowledge. The patentee does however accept that the skilled addressee would have known of the types of segmented devices for use in hydraulic applications that it illustrates.
- 88 The patentee argues that there are many technical considerations required to split the clamp as the forces and materials must be balanced carefully for it to work effectively. They also argue that it would not have been an obvious modification to apply to the device of AT12838. The skilled addressee would not without hindsight knowledge of the invention of the patent or without invention have had any motivation to create a segmented version of the device disclosed in AT12838.
- 89 The patentee’s arguments are to some extent undermined by the cursory way this aspect of the clamp is described in the patent. Notably the patent does not describe in any detail how the clamp is split other than it can be split into two or more segments, nor does it highlight any technical considerations necessary to implement such a split clamp. On balance therefore I do not believe that the provision of a split ring is something that would involve an inventive step. Indeed, the skilled person considering the challenges of applying the clamp in AT12838 as a simple clamp to in-situ flanged pipes or where access to the pipes is limited would readily consider splitting the clamp. Hence claim 4 is considered obvious.

- 90 Mr St Quintin highlights the lack of any real detail in the claimant's attack against claim 5 on inventive step. I find some force in this. Despite having numerous opportunities to do so, the claimant has not fully set out why it considers it would be obvious to use the clamp of claim 1 in a hot-bolting application. Its argument, which was reflected also in the evidence of Mr Lumley, appeared to be that there is no reason why it couldn't be used for hot-bolting but as indicated by Parker J. above that is simply not enough.
- 91 Mr St Quintin did address me at some length on the question of the obviousness of claim 5 using the structured approach set out in *Pozzoli*. He identified the inventive concept as the use of the clamp of claims 1-4 for a hot-bolting operation. He then provided a number of observations as to why such use was not obvious in light of the disclosure in AT12838. He stressed the need to avoid hindsight and ex post facto reasoning, which he suggested had influenced Mr Lumley's submission. He went on to note that it is well established that the skilled person is deemed to read a document and be interested in it when he reads it but that does not mean that once he has read it, he believes it is interesting for any problem he is trying to solve. He refers in support to the comments of Birss J. in the *Vernacare v Environmental Pulp Products*<sup>14</sup> and Laddie J. (as they both were then) in *Inhale v Quadrant*<sup>15</sup>.
- 92 In *Vernacare* Birss J. noted that:
- "As a matter of principle, the skilled person reads any given piece of prior art with interest. However, as a matter of principle again, once they have done so, there is nothing to say as a matter of law that the skilled person is not entitled to say having read it with interest, "I have read it with interest, but I am not interested." The context is vital."
- 93 In *Inhale v Quadrant* Laddie J. indicated that not only does the skilled person come to each piece of prior art without any preconceptions but the more distant a prior art document is from the field of technology covered by the patent the greater the chance that an intelligent but uninventive person skilled in the art would fail to make the jump to the solution found by the patentee. Mr St Quintin recognised that AT12838 and the patent in suit both in general relate to piping, but that AT12838 does not relate to hot-bolting at all. He suggests that the skilled addressee reading AT12838 without the patent in mind would have had no hint that it was something that they could and should use in a hot-bolting operation.
- 94 Mr St Quintin also highlighted the importance of motive referring to *Actavis v ICOS*<sup>16</sup> where Lord Hodge indicated that in the absence of motive to take an inventive step, the argument for obviousness becomes more difficult. Mr St Quintin goes on to suggest that the common general knowledge does not include knowledge that it is a benefit in a hot-bolting operation to avoid compression of a gasket. That is not something that the skilled person would have had any motive to avoid or would have had in their mind at all when reading AT12838. Further, there is no suggestion there is any motivation to improve known hot-bolting techniques, so it is not suggested that there was a problem that the skilled person was grappling with to seek to try to come up with new solutions to hot-bolting.

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<sup>14</sup> *Vernacare v Environmental Pulp Products* [2012] EWPC 41

<sup>15</sup> *Inhale v Quadrant* [2002] RPC 21

<sup>16</sup> *Actavis v ICOS* [2019] UKSC 15 [2019] RPC 9

- 95 He goes on to note that even if as I have found, the common general knowledge did even include knowledge of use of clamps for hot-bolting then the sort of C-clamps shown in the Woodside document or something similar would reinforce the indication that the skilled addressee did not appreciate that avoiding compression was important and also would not have indicated that a solution was required.
- 96 Mr St Quintin also contests that the skilled person reading AT12838 would not read it and think that it had any application in the use of hot-bolting. It is a permanent installation providing a solution to flange rotation that the skilled addressee knew had since been well solved and would have found that uninteresting. He also highlights that neither Mr. Lumley nor Mr Kime could provide any reason why the skilled person would wish to use the Austrian disclosure for hot-bolting. The only reason he suggests that you would get anywhere close to such a suggestion is by hindsight reasoning. Mr Quintin also noted that Dr Brown did not consider that the device of the Austrian patent would have given the skilled addressee any reason to deploy it for hot-bolting.
- 97 All the factors presented by Mr Quintin provide in my view a compelling case. There is simply no clear reason why the skilled person would have considered using the device for hot-bolting. Hence, I find that claim 5 is not obvious in light of AT12838.

### **Added Matter and Sufficiency**

- 98 The claimant claims that Claim 1 of the application was amended during the examination of the application in a manner that resulted in the application disclosing matter extending beyond that disclosed in the application as filed contrary to section 75(2).
- 99 Claim 1 as originally filed including the following (with added emphasis):
- “...where opposite clamps (1 and 2) are preloaded towards each other, characterized by contraholders (3) which are fitted on clamp (2) and works as a back stop to absorb the preload...”.
- while claim 1 of the patent as granted states:
- “...the clamp comprising contraholders (3) arranged to work as a back stop to absorb the preload...”.
- 100 The claimant contests that the removal of the phrase “which are fitted on the clamp (2)” has added subject matter that was not clearly and unambiguously derivable from the content of the application as filed. The defendant suggests that the amended wording covers for example the use of stand-alone shims or spacers as contraholders.
- 101 The defendant contends however that there is no material difference between “contraholders which are fitted on the clamp” and “clamp comprising contraholders”.
- 102 When considering in *Bonzel*<sup>17</sup> whether an amendment to the description had the result that a patent as granted disclosed matter which extended beyond that disclosed in the application, Aldous J. described his task as:

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<sup>17</sup> *Bonzel and Schneider (Europe) AG v Intervention Ltd* [1991] RPC 553

(1) to ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly in the application;

(2) to do the same in respect of the patent as granted;

(3) to compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition. The comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly.

- 103 As summarised by Jacob J. in *Richardson-Vicks Inc.'s Patent*<sup>18</sup>, “the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification.”
- 104 Dr Brown in his evidence expressed the opinion that the skilled person would not see any difference in function between the alternative wording, stating that “‘fitted on the clamp’ may either mean the contraholders are specifically shaped to engage the clamp or it may simply mean that the contraholders are attached to the clamp by some means. This has the same meaning to the skilled person as the term “comprise contraholders” since in both cases the requirement is that the contraholders are present as an integral part of the clamp arrangement.”
- 105 Mr Lumley did not give an opinion on this issue.
- 106 Applying the approach set out in *AC Edwards v Acme Signs and Displays*<sup>19</sup> I would observe that there is no indication in the application as filed that it may be possible for the contraholders not to be “fitted on the clamp”: it is repeatedly stated either that the contraholders are fitted on the clamp or that the clamp comprises contraholders. I would add that there was no material alteration in the specification between the filing and the grant other than in respect of claim 1 and the corresponding consistory clause. There was no explicit disclosure in the application, as filed, of the matter now alleged to be added ie. that the contraholders are not mounted on the clamp and could for example be stand-alone shims. It follows that any added matter must be in claim 1 as granted. Claim 1 does not claim that the contraholders are not mounted on the clamp and could for example be stand-alone shims. It is possible that claim 1 covers those matters, though Dr Brown appears to question that, but even if it did then that is not a disclosure of them. The result, in my view, is that the claimant’s contention on added matter fails.
- 107 The claimant also argues that the application provides no explanation as to how the invention may work if the contraholders are not fitted to, or form part of, the clamp, and so it follows that the claim is not supported across its entire scope/breadth, and therefore the granted patent is insufficient due to excessive claim breadth.
- 108 The House of Lords in *Biogen Inc v Medeva plc*<sup>20</sup> held that the disclosure must be sufficient to enable the whole width of the claimed invention to be performed, and the disclosure of a single embodiment will not always satisfy the requirement regardless of the width of the claim. The granted patent claims “a flange clamp...comprising

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<sup>18</sup> *Richardson-Vicks Inc.'s Patent* [1995] RPC 568

<sup>19</sup> *AC Edwards v Acme Signs and Displays*, 1992 WL 893945 (1991)

<sup>20</sup> *Biogen Inc v Medeva plc* [1997] RPC 1

contraholders arranged to work as a back stop to absorb the preload". The clamp of the invention comprises contraholders, which form a part of the clamp, as do the clamps described in the application as filed. I find that there is no unsupported subject matter in the granted claim and that the claims are fully supported by the description as filed.

### **Conclusion and findings**

- 109 I find that Claims 1-3 and 6 are invalid in that they lack novelty in the light of the prior art.
- 110 I find also that claim 4 is invalid as it lacks an inventive step in light of the prior art.
- 111 I dismiss the attack against claim 5 and the attacks based on added matter and sufficiency.
- 112 Accordingly, and in accordance with section 72(4) of the Act, I order that patent GB2468976 be revoked unless it is amended under section 75 to the satisfaction of the comptroller. I allow the defendant 8 weeks from the date of this decision to submit proposals for amendments, though this period should be treated as stayed should an appeal against the present decision be lodged. In considering any amendments, the defendant should be mindful of the guidance provided by Henry Carr QC, sitting as a Deputy Judge in *Monkey Tower Ltd v Ability International Ltd*<sup>21</sup> as to the nature of the type of amendments that would justify the exercise of discretion under section 75. The defendant should send a copy of any amendments to the claimant who will then have 4 weeks to submit comments thereon to the comptroller should they so wish, sending a copy of any comments to the defendant. I will then decide how the case is to proceed. If no amendments are filed, I will revoke the patent.

### **Costs**

- 113 It is long established practice that in proceedings before the comptroller only a contribution towards the successful party's costs should normally be awarded and that the amount should be guided by the comptroller's published scale unless the circumstances warrant departing from the published scale. My preliminary view is that there is no case here to depart from the scale. Hence, I am minded to award the claimant the sum of £2600 as a contribution to its costs. This is made up of the following:
- £400 for preparing a statement and considering the other side's statement
- £1000 for preparing evidence and considering and commenting on the other side's evidence:
- £1200 for preparing for and attending the hearing.
- 114 I will however allow both sides to make submissions on the matter of costs within 8 weeks of the date of this decision if they so wish. If no submissions are made within

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<sup>21</sup> *Monkey Tower Ltd v Ability International Ltd* [2013] EWHC 18 (Pat)



that period, then the sum of £2600 should be paid by the defendant to the claimant within 12 weeks of this decision.

### **Appeal**

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

**PHIL THORPE**

Deputy Director acting for the Comptroller