

14 September 2012

PATENTS ACT 1977

BETWEEN

Leif Levon	Proprietor
and	
Orrefors Kosta Boda AB and Mr Goran Warff	Opponents

PROCEEDINGS

Request under section 74B of the Patents Act 1977
for a Review of Opinion 14/11 issued
on patent number EP2068179

HEARING OFFICER Peter Slater

DECISION

Introduction

- 1 This decision relates to a request for a review of opinion 14/11 (“the Opinion”) under section 74B of the Patents Act (the “Act”). The Opinion was requested by Mr Leif Levon in relation to whether his patent, EP(UK) 2068179 B1 (“the Patent”) was being infringed by Orrefors Kosta Boda AB and Mr Goran Warff. The Opinion, which was issued on 14 September 2011, concluded that there was no infringement of the patent.
- 2 The proprietor of the patent, Mr Leif Levon, requested a review of the Opinion under section 74B of the Act on 7 December 2011. Orrefors Kosta Boda AB and Mr Goran Warff filed a counter statement contesting the application on 17 January 2012. The defendants declined to be heard, and were content for a decision to be made on the basis of the papers currently on file. However, Mr Levon requested a hearing which took place by teleconference on 16 May 2012.

The Law

- 3 The law governing reviews of opinions is set out, so far as is relevant here, in section 74B and Rule 98 of the Patent Rules 2007. These read:

Section 74B Reviews of opinions under section 74A

(1) Rules may make provision for a review before the comptroller, on an application by the proprietor or an exclusive licensee of the patent in question, of an opinion under section 74A above.

(2) The rules may, in particular-

(a) prescribe the circumstances in which, and the period within which, an application may be made;

(b) provide that, in prescribed circumstances, proceedings for a review may not be brought or continued where other proceedings have been brought;

....

Rule 98.

(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.

(2) However, such proceedings for a review may not be brought (or if brought may not be continued) if the issue raised by the review has been decided in other relevant proceedings.

(3) The application must be made on Patents Form 2 and be accompanied by a copy and a statement in duplicate setting out the grounds on which the review is sought.

(4) The statement must contain particulars of any relevant proceedings of which the applicant is aware which may be relevant to the question whether the proceedings for a review may be brought or continued.

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

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

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

(Emphasis added)

- 4 It is important to note that the grounds on which an opinion on infringement can be reviewed are quite narrowly prescribed in Rule 98(5)(b). The reason for this is that in

most circumstances where a party feels aggrieved by an opinion, there will be a clear route for addressing that grievance. For example a party who is deemed by an opinion to be infringing a patent can seek a declaration of non-infringement. Equally where an opinion has concluded that no infringement is taking place and the patent proprietor disagrees, he may sue for infringement. This could include the circumstances where the patent proprietor disagrees with the way that the claims have been construed. But suing for infringement is not possible if the opinion was sought on a potential or hypothetical act, and in such circumstances it would be unfair to deny the patent proprietor a chance to overturn an infringement opinion based on a construction of the claims which is adverse to him. Thus the rules allow a review of an infringement opinion but only if the opinion came to a wrong conclusion on infringement as a result of how it interpreted the specification of the patent in suit.

- 5 It is also I believe worthwhile for me to briefly say something here about the nature of reviews under S74B. This was considered in the Patents Court in the case of DLP where the judge, Kitchen J, noted:

“In the case of an appeal under rule 77K [now Rule 100], 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 was wrong if the examiner has made an error of principle or reached a conclusion that is clearly wrong. Likewise, on appeal, this court should only reverse a decision of a Hearing Officer if he failed to recognise such an error or wrong conclusion in the opinion and so declined to set it aside. It is not the function of this court (nor is it that of the Hearing Officer) to express an opinion on the question the subject of the original request.”

- 6 It follows that the remit of any review is quite narrow. It is not a rehearing that would necessarily allow for example for new evidence not available to the examiner to be considered. Rather it is simply a review of whether the original opinion reached a conclusion that is clearly wrong on the basis of the material available at the time.

The patent

- 7 The patent in suit relates to a display lamp device for illuminating decorative ornaments. It was granted on 1 June 2011, and has an earliest priority date of 6 December 2007. The granted specification contains a single independent claim which reads as follows:

1. A display device providing internal illumination of decorative objects, comprising; an aperture for receiving light rays from a light source, a light guide system tapering from said light source toward a distal aperture, serving as a limited display area for said object, wherein reflective surface walls direct and concentrate collimated, divergent and convergent light rays in order to illuminate said decorative object.

Arguments and analysis

- 8 Mr Levon's request of 7 December 2012 sets out the grounds on which he is requesting a review. In particular, he argues that the examiner was wrong to suggest that the opening passage of claim 1 should be interpreted to mean that the display lamp device and decorative objects are necessarily separate items. In support of his arguments, he refers to paragraph [0010] of the specification which states that "the device can be tailor made to fit a particular ornament" suggesting that the lamp and the decorative object may be separate items or part of a whole apparatus as emphasised by Figure 8 which illustrates the use of the display device to illuminate a head structure which appears to be integral with the device.
- 9 The defendants in their submissions agree with the examiners construction and consider the opinion to be valid.

The opinion

- 10 In his opinion, the examiner set out the background and then directed himself as to the law. He addressed the issue of claim construction and correctly identified the decision of the House of Lords in *Kirin-Amgen*¹ as the leading authority in this jurisdiction on the question of interpretation. With the principles explained in that case in mind, he turned to consider what the patentee meant by the words:

"A display device providing internal illumination of decorative objects"

- 11 His conclusions are set out in paragraph 18 of the opinion as follows:

"18. Claim 1 opens with "A display device providing internal illumination of decorative objects". I believe that the person skilled in the art would understand that to mean "A display lamp device providing internal illumination of decorative objects" once having read the entire patent, especially the other claims, and inspected its drawings. I also believe that this opening passage would be taken to mean that the lamp and the decorative objects are separate items"

- 12 The examiner then turned to consider whether the patent was infringed by the defendant's "Baskerville lamp". However, having construed the claim in the way that he did, he came to the conclusion that because the "decorative object", in this case the foot portion of the lamp was attached to the lamp, and not a separate item, the lamp did not fall within the scope of claim 1 and therefore there was no infringement.
- 13 Again, his conclusion as set out in paragraphs 34 and 35 of the opinion as follows:

"34. I have no doubt that the coloured glass foot portion of the stem of the Baskerville lamp can be taken as a decorative object, but it is a decorative object that is permanently attached to the rest of the lamp. In that sense it does not satisfy the opening passage of claim 1 as I have construed it; in the Baskerville lamp the decorative object is not separate from the lamp.

35. In my view the Baskerville lamp does not include all the features required by claim 1 of the patent."

¹ Kirin-Amgen Inc v Hoechst Marion Roussel [2005] RPC 9

- 14 The question is, was the examiner correct to interpret claim 1 as he did? Is it necessary for the display lamp and the decorative object to be separate items? I do not think so. Whilst there are embodiments where the lamp and the decorative object are clearly separate, for example, those shown in figures 1 to 3 of the specification where the display device comprises a two-part prism, in which the lower part houses the light source and the upper part forms the decorative object to be illuminated, this is not the case in all of the embodiments disclosed. In particular, the embodiment shown in figure 8 of the specification, referred to by Mr Levon in his submissions, is a good example. Figure 8 illustrates an embodiment in the form of a figurine, in which the body of the figurine appears to incorporate the lamp, and provides the collimation necessary to illuminate the decorative object, in this case the head of the figurine which as one might expect appear to be integral with the body. There are also a number of other embodiments illustrated where the lamp and decorative object appear to be integral with one another. If the claim is to cover all of these embodiments, I do not think is correct for the examiner to have concluded that the opening passage of claim 1 should be read as meaning that the lamp and decorative object are necessarily separate items. I therefore have no choice other than to set the opinion aside.

Conclusion

- 15 This application for a review of opinion 14/11 is successful, and the opinion is hereby set aside.

Appeal

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

P R SLATER

Deputy Director acting for the Comptroller