Intellectual Property Office

For Creativity and Innovation

BL O/232/07

15th August 2007

PATENTS ACT 1977

APPLICANT Roger Colston Downs

ISSUE Request under section 74A for a second opinion as to whether patent number GB 2295741 is infringed

HEARING OFFICER R J Walker

DECISION

Introduction

1 Mr. Roger Colston Downs is the proprietor of patent number GB 2295741 (“the patent”) which relates to a topography processor system. On 3 May 2007 he requested a second opinion under section 74A of the Patents Act 1977 as to whether the patent is infringed by the London Congestion Charging Scheme (“LCCS”) end to end enforcement process. The Office gave this request the reference number 10/07.

2 The Office wrote to Mr. Downs on 18 May 2007 with a preliminary view that the request should be refused because it merely covers issues which were sufficiently considered in an earlier opinion (04/06) and in a review of that opinion (BL O/025/07).

3 The earlier opinion, which was also requested by Mr. Downs, considered whether Capita’s implementation and operation of the LCCS end to end enforcement process infringed the patent. In these earlier proceedings Mr. Downs filed material to support his view that the patent was infringed. Capita filed observations contesting this view and in turn Mr. Downs responded to Capita’s observations. Ultimately the opinion concluded that the LCCS system does not infringe the patent. Dissatisfied with this conclusion Mr. Downs requested a review of the opinion. The hearing officer, who conducted the review, decided on 18 January 2007 that the opinion correctly interpreted the specification of the patent. As a result he made no order to set the opinion aside. Mr. Downs did not appeal this decision (BL O/025/07) although the opportunity was open to him.

4 Returning to the present request, Mr. Downs did not accept the Office’s

preliminary view that it should be refused and he asked to be heard. Therefore, the matter came before me at a hearing on 12 July 2007. Mr. Downs appeared in person and I was assisted by a patent examiner, Mrs. Villis. In preparation for the hearing Mr. Downs provided a skeleton argument and a speaking note for which I am grateful

The Law

5 It is helpful to set out the relevant law as it relates to opinions, not only as it relates to the comptroller's jurisdiction to refuse to issue an opinion but also more generally. Section 74A states:

> ***"74A Opinions as to validity or infringement***
>
> *(1) The proprietor of a patent or any other person may request the comptroller to issue an opinion –*
>
> *(a) as to whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;*
>
> *(b) as to whether, or to what extent, the invention in question is not patentable because the condition in section 1(1)(a) or (b) above is not satisfied.*
>
> *(2) Subsection (1) above applies even if the patent has expired or has been surrendered.*
>
> *(3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so –*
>
> *(a) in such circumstances as may be prescribed, or*
>
> *(b) if for any reason he considers it inappropriate in all the circumstances to do so.*
>
> *(4) An opinion under this section shall not be binding for any purposes.*
>
> *(5) An opinion under this section shall be prepared by an examiner.*
>
> *(6) In relation to a decision of the comptroller whether to issue an opinion under this section –*
>
> *(a) for the purposes of section 101 below, only the person making the request under subsection (1) above shall be regarded as a party to a proceeding before the comptroller; and*
>
> *(b) no appeal shall lie at the instance of any other person.*

6 Section 74B relates to reviews of opinions and I should quote this provision here since it is also relevant to what I must decide:

"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;

(c) make provision under which, in prescribed circumstances, proceedings on a review are to be treated for prescribed purposes as if they were proceedings under section 61(1)(c) or (e), 71(1) or 72(1)(a) above;

(d) provide for there to be a right of appeal against a decision made on a review only in prescribed cases."

7 Rule 77A of the Patents Rules 1995 deals with the interpretation of the rules relating to opinions. This rule states among other things that:

> "*"proceedings" means proceedings (whether pending or concluded) before the comptroller, the court or the European Patent Office."*

8 Rule 77B (Request for an opinion under section 74A) and rule 77C (Entry in the register) do not concern me and so there is nothing to be gained by setting them out here.

9 However, rule 77D (Refusal or withdrawal of request) is relevant:

"77D.-(1) The comptroller shall not issue an opinion if –

(a) *the request appears to him to be frivolous or vexatious; or*

(b) *the question upon which the opinion is sought appears to him to have been sufficiently considered in any proceedings.*

(2) *The comptroller shall not issue an opinion if the requester gives him notice in writing that the request is withdrawn.*

(3) If the comptroller intends at any time –

(a) to refuse the request because the condition in paragraph (1)(a) or (b) is satisfied; or

(b) *to refuse the request because, in accordance with section 74A(3)(b), he considers it inappropriate in all the circumstances*

to issue an opinion,

he shall notify the requester accordingly.

In the present case the Office's preliminary view was based on rule 77D(1)(b).

10 Rule 77E (Notification and advertisement of request)) is not relevant here.

11 The rules continue by making provision for the submission of observations and observations in reply in relation to a request for an opinion. Some of these provisions are relevant to the matter I must decide and so I set them out here:

> "*77F.-(1) If the request has not been refused or withdrawn, any person may, before the end of the relevant period, file observations on any issue raised by the request.*
>
> *(2) ……… .*
>
> *(3) ………. .*
>
> *(4) A person to whom observations are sent under paragraph (3) may, not later than two weeks after the end of the relevant period, file observations confined strictly to matters in reply.*
>
> *(5) ……… .*
>
> *(6) ……..... .*
>
> (7) *………. .*"

12 I see no need to quote rule 77G (Issue of the opinion).

13 Rule 77H sets out the procedure for launching a review, including the need for a statement setting out fully the grounds on which the review is sought. In particular, rule 77H(5) prescribes circumstances in which an application for a review may be made:

> *"77H.(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) ………………….*
>
> *(3) The application shall be made on Patents Form 2/77, and shall be accompanied by a copy and a statement in duplicate setting out fully the grounds on which the review is sought.*
>
> *(4) …………………………………..*
>
> *(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."

14 Rule 77I deals with the further procedure on review and apart from noting that this rule provides an opportunity for any person to file a counter-statement contesting the application for a review, I do not need to refer to the provisions of this rule here. Rule 77J deals with the outcome of the review and gives the comptroller the power to set aside the opinion in whole or in part, or to decide that no reason has been shown for the opinion to be set aside. Finally, rule 77K provides that no appeal shall lie from a decision to set aside an opinion under rule 77J except where the appeal relates to a part of the opinion that is not set aside.

The request for a second opinion

Introduction

15 Mr. Downs' request for a second opinion is accompanied by a paper (RCDOP2.020507) ("the '507 paper") in which he sets out his view of the issues that should be addressed. The introductory part of this paper sets the scene:

"1.1 Given the consultation paper's preclusion of new issues being considered in the opinion or review process, beyond those submitted in the original request for an opinion 27/03/06, this request for an opinion builds on the original request, reciting information submitted to and arising from that process, together with new information contained in the subsequent request for a review 21/09/06 and decision 18/01/07.

1.2 In representing the paper 'Analysis of opinion 04/06 dated 23/06/06 re GB2295741B' associated with the request for a review, but now in the context of this request for a second opinion, this paper directs attention to a consideration of the new issues contained in that paper beyond those contained in the original request, together with further issues arising out of the decision 18/01/07.

1.3.1 Not withstanding the constraints imposed on the hearing officer during the review process, the decision 18/01/07 being the most recent document, is first considered, since it consolidates the view set out by the opinion, and presents in the new light of this request, an opportunity to comment from this new perspective, on issues contained within it.

1.3.2 Since the decision is somewhat broader in its consideration of issues raised by the opinion, it presents a framework within which discussion of the principle issues is possible, both in respect of the decision in its own right, but also the decision in the context of necessarily unconsidered submissions.

1.4 The claims are next considered in the context of the UK file history. This file is relevant, not only because of the primary issues currently being addressed, namely the relevance of range decompression to the invention,

and the further wider understanding of systems relevant to the invention, in other words the scope of the phrase topography processor system, but also because of the relevance of the issues raised at the time the application was made.

1.5.1 The paper then continues by considering in conjunction with, and offering direction to previous information, addresses the further principle argument in respect of the examiner's extension of the observer's argument in respect of determining the relative position of an object in a scene, as differentiating the LCCS end to end enforcement process from the specification.

1.5.2 There are a number of secondary issues raised in the course of the opinion 04/06, for which direction is also offered in respect of subsequently submitted information."

The '507 paper continues by commenting in some depth on the patent, the earlier opinion and the review of that opinion, in particular on how the patent was construed and on how the LCCS was viewed.

The patent, the opinion and the review

16 The '507 paper questions the basis for the characterisation of the invention of the patent in both the opinion and the review. In particular, it states that not only is it unclear what problem, purpose or premise is contained within the patent specification that supports the hearing officer's statement in his review decision concerning the nature of the invention but also the nature of the invention, as set out in the opinion and review, runs contrary to the patent when properly construed. It also makes the point that whilst *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9 was cited as an authority on construction, the issues it raises were not heeded. Furthermore, the '507 paper identifies matters which the hearing officer allegedly did not understand or on which he was allegedly mistaken. It also states that the opinion and the review took a too narrow view of the LCCS end to end enforcement process.

17 In the '507 paper Mr. Downs states that the review of the opinion was constrained in that it could only consider if the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent by reason of the interpretation of the specification of the patent. The '507 paper also relies on a consultation document, which was issued to seek views on the introduction of the opinions service, and in particular it refers to a statement in that document about precluding the introduction, or at least consideration, of new issues beyond those raised in an original request for an opinion. The '507 paper goes on to allege that despite these constraints the opinion erroneously extended an argument submitted by the observer and so introduced a new issue.

18 The '507 paper also looks at the interpretation of the patent by reference to its UK file history and takes the view that the file history corroborates Mr. Downs' construction of the patent. Furthermore, it deals briefly with a number of secondary issues, including a question of sufficiency, which was touched on in the earlier opinion

Conclusions

19 The conclusions set out in section 5 of the '507 paper provide a helpful summary of the issues and I quote them below. By way of clarification I should explain that the reference to "D" is a reference to the request for a review, filed on 21/9/06.

> *"**5.1** D section 6 summarizes the issues in that paper and are again directed towards the attention of the examiner, they remain valid but in the light of the further disclosure, contained in the decision require some amplification.*
>
> ***5.2*** *It is clear that the principle issue on which this case now turns, is that of a purposive construction of the patent / claims.*
>
> ***5.3*** *The opinion and decision demonstrate inconsistency in construction both in respect of the examination instigated rationalization of the original WIPO claim, and also in respect of the clear rationale of Lord Hoffmann's considered discourse of how a purposive construction should be made.*
>
> ***5.4*** *There is little point in citing a precedence in patent claim construction, if the issues detailed in that precedence are not heeded.*
>
> ***5.5*** *It is insufficient to justify a construction of patent / claim based on a premise identified through literalism, this is contrary to the teaching of Lord Hoffmann, and contrary to the precedence of construction apparently agreed and requested by both the examiner and observer."*

Mr. Downs' arguments

Three points of contention

20 At the hearing Mr. Downs identified three points of contention with the Office's preliminary view as presented in the letter of 18 May 2007. The first was that the request for the second opinion should be refused because it merely covers issues which had been sufficiently considered in the previous opinion and review. The second concerned the possibility Mr. Downs had had to appeal the review decision and the third related to the opportunity still available to Mr. Downs to bring an action for infringement.

The issues have not been sufficiently considered

21 Mr. Downs did not accept that the issues raised by his request for a second opinion had already been sufficiently considered. In his view the earlier opinion raised a number of new issues for which the opinion process offered no further iteration to redress. He explained that various issues, such as purposive construction of the patent, were not contentious originally and had only become so with the delivery of the earlier opinion. This being the case, Mr. Downs believed that such issues could only be addressed through a request for a further opinion.

The purpose and scope of a review based on the consultation document

22 Before I turn to the new issues identified by Mr. Downs, I should set out his submissions on why he believes the opinions process offered no further iteration to address them. Mr. Downs explained at the hearing that whilst a range of issues were addressed in his request for a review, it only later became clear to him that the consultation document, referred to above, requires new issues to be addressed by a request for a further opinion. He pointed out that the consultation document was specific about what aspects of an opinion can be subject to a review and he referred me to paragraph 34 of the document. I should add that the hearing officer quotes this paragraph in his review decision and this has encouraged Mr. Downs to rely on the consultation document to determine what is and what is not legitimate in the opinions process. Mr. Downs seemed to accept at the hearing that the consultation document was not legally binding but even so on his reading of paragraph 34 he suggested that a review involves consideration of whether the examiner justified his conclusion in respect of his premise, not necessarily whether the premise was correct.

23 On the specific question of the allowability of new issues, Mr. Downs referred me to paragraphs 22 and 23 of the consultation document and what they have to say about submitting observations. Mr. Downs only referred to a couple of sentences in these paragraphs but I will quote them in full with Mr. Downs' emphasis so that the context is clear:

"***Submitting observations (rule 78F)***

22. Anyone will be able to submit written observations for four weeks after the advertisement appears. This will include parties who have been notified directly, so the Office will ensure that they are notified on or before the date that the advertisement appears, and are informed of the deadline. ***The written observations will have to be confined to the issues raised in the request and are required in duplicate. Thus observations filed at this stage will not be allowed to broaden the scope of the opinion by raising unrelated new issues. If an opinion on such issues is required then we would expect a further, separate request for an opinion to be made.*** *It may be that the observations reveal that the request should be refused, in which case the procedure described in paragraph 17 will follow.*

23. *The observations will be sent to the requester, who will be given four weeks to respond.* ***The response must strictly be in reply to issues raised in the observations, so again if new issues are raised, a further opinion would need to be requested.*** *Where the patent proprietor or exclusive licensee made the request, he will (like any other requester) see all the observations and be able to make observations in reply. However, where he is not the requester, he will in any case be sent a copy of all the observations filed – but will not be given the chance to make observations in reply unless the comptroller thinks it is particularly appropriate*."

From this Mr. Downs concluded that the consultation document precludes

consideration of new issues during the course of an opinion, and that a review of an opinion can only consider issues which formed part of the opinion process. Thus, he took as excluded from the review of his earlier opinion issues discussed in all but section 1 (Introduction) of a paper “Analysis of opinion 04/06 dated 23/06/06 re GB2295741 B” (“the review paper”), which he submitted with his request for a review of that opinion.

24 He found support for his view that new issues in fact had been excluded in paragraph 25 of the hearing officer’s review decision (again Mr. Downs’ emphasis):

> “25 The second part of point three is concerned with the issue whether the LCCS performs topographical calculations in the sense required by the present claims. The inquiry in this review is to assess whether ‘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’. **Consequently, it is only if I find that there is an error in the interpretation of the specification within the Opinion that I need go on to consider whether as a result of that error the infringement assessment was flawed.** That being the case I will not pursue this question unless it becomes necessary.”

25 Mr. Downs also relies on a concluding statement made by the hearing officer (once more with Mr. Downs’ emphasis):

> “27 **I have considered Mr. Downs’ representations as to the interpretation of the specification but have not been persuaded by them**. I have considered whether there are any other grounds not identified by Mr. Downs but relevant to the interpretation of the specification and to the allegation of infringement, in respect of which the Opinion may have been in error. **If there had been any, I would have considered them too but I can find none, the only issue of relevance being the one Mr. Downs has identified.**”

He saw a connection between this statement and paragraph 19 of the review decision where he assumes, I think, the hearing officer is referring solely to section 1 (Introduction) of the review paper and so has excluded from consideration the rest of the paper, which according to Mr. Downs contains the new issues. He also reads the reference to the “one” issue as a reference to the interpretation of the specification “within” the opinion and as reinforcing his view that in order to progress the issues, the request for a review should have been presented as a request for a new opinion.

26 Mr. Downs further argued that references in paragraphs 21, 22 and 24 of the review decision to submissions in the review paper but going beyond section 1 of that paper, indicate that new issues, raised by the opinion and addressed in the request for a review, were neither permitted for consideration nor indeed considered. He presumed that if they had been considered the hearing officer would have challenged the opinion examiner’s premise on construction and that he would not have made a comment said by Mr. Downs to be in direct contradiction to an assertion made in the review paper.

Construction

27 I can now turn to the new issues identified by Mr. Downs and the first of these relates to how the patent was construed. Mr. Downs referred me to section 3 the review paper. In short this paper argues that the opinion examiner did not approach the construction of the patent correctly and as a result he came to the wrong conclusion.

Characterisation of a topography processor system

28 Mr. Downs went on to identify as a further new issue what the opinion examiner had concluded from his characterisation of a topography processor system and how as a consequence the LCCS was differentiated from the invention of the patent. He commented that the opinion examiner's conclusion that a topography processor is solely concerned with determining the relative position of an object in a scene and that this was not an attribute of the LCCS, were not issues raised during the progress of the earlier opinion. Mr. Downs again referred to the review paper, in particular to section 4 of this paper which deals with issues related to the topography processor system.

Purpose of invention

29 Mr. Downs then touched on a further new issue which in his view arose from the opinion. This issue concerned what he saw as a misunderstanding on the part of the opinion examiner of the purpose of the invention. Once again he referred me to the review paper, particularly section 2, for the detail.

Capita's actions

30 At the hearing Mr. Downs referred me to a letter, dated 6 November 2006, in which Capita indicate that they have nothing further to add to the observations they made in respect of the request for the earlier opinion. The letter also states (Mr. Downs' emphasis):

> "**Capita's view is that, irrespective of whether there has or has not been any misunderstanding by the examiner in relation to the specification, there is nothing in the Application for a Review of the Opinion submitted by Mr Colston Downs dated 21st September 2006 which makes any material change to the previously identified issues**.
>
> Capita strongly believes that neither its activities nor those of the London Congestion Charging Scheme infringe patent number GB2295741 granted to Mr. Roger Colston Downs."

Mr. Downs surmised that on one interpretation this amounted to recognition that the issues raised by himself and Capita during the course of the opinion were not reflected by the opinion, rather the opinion posed a puzzle at the edge of the claim and has little to do with resolving the issues. He went on to suggest that Capita make it clear in their letter that they believe the issues are of no consequence to them, even though in his view the opinion examiner did not take account of their principle argument that the LCCS is an image processing system

and instead extended their argument.

31 In their observations on Mr. Downs' request for the earlier opinion Capita referred to the file history of a US application corresponding to the patent, At the hearing Mr. Downs suggested that it was not unreasonable to assume that Capita also accessed the UK patent file and would have been aware of the rationale behind the changes to the patent specification and claims before grant.

Sufficiency

32 Mr. Downs then turned to the question of sufficiency of the patent since this had been mentioned in both the opinion and the review decision. His point here was quite simple and it was that this was a new issue and therefore the opinion and review should not have addressed it. In his view the correct course would have been for him to request an opinion on this matter if he wanted it.

New issues raised by the review decision

33 Mr. Downs continued by referring me to his speaking note which identifies a number of new issues raised by the review decision and going beyond those raised by the opinion. Mr. Downs contended that by expanding the discussion of the specification as it was presented in the opinion, the hearing officer introduced statements fundamental to his decision which are incorrect or unclear.

UK file

34 Mr. Downs drew my attention to a further issue he believed to be relevant to his request for a second opinion. This concerned the UK file history which he submits corroborates his construction of the patent.

Secondary issues

35 The last of Mr. Downs' submissions to me on new issues concerned issues which he referred to generally as secondary issues and which were previously addressed in section 4 of the review paper.

Fairness

36 All in all Mr. Downs urged me to allow his request for a second opinion because the considerable number of issues, which he believes remain unresolved, warrants it in the interest of justice.

The reason for not appealing the review

37 At the hearing Mr. Downs addressed me on the point made in the Office's letter that he could have appealed the review if he disagreed with it. He explained that he chose not to appeal because he thought that it offered too little scope to raise new issues outside the course of the opinions process.

The option of litigation

38 Mr. Downs accepted that he could bring court proceedings against Capita for the alleged infringement of the patent but he felt that this undermined the declared aim in the consultation document of providing a process which provided swift and affordable dispute resolution. In his view a new opinion based on his request for a second opinion would facilitate the resolution of his dispute with Capita.

Assessment of Mr. Downs' submissions

39 As the person requesting an opinion, Mr. Downs is entitled by virtue of section 74A(6) to be heard on whether his request 10/07 should be refused.

The matter to be decided

40 In my view the earlier opinion and the review of that opinion were proceedings before the comptroller. Thus, in accordance with rule 77A and rule 77D(1)(b) the matter I must decide is whether the question upon which Mr. Downs is now seeking a second opinion appears to me to have been sufficiently considered in connection with the earlier opinion and its review. I am able to narrow this down further since Mr. Downs accepted at the hearing that the question posed by his request for a second opinion is the same as that posed in his request for the earlier opinion. Thus, all that I need to decide is whether it was sufficiently considered during the earlier proceedings. I should make clear here, as I did at the hearing, that it is not for me to consider in this decision the rights or wrongs of the conclusions reached in the earlier opinion and in the decision reviewing that opinion.

The consultation document

41 In his request for a second opinion Mr. Downs refers to and relies on various statements made in the consultation document issued by the Office with a view to obtaining views on proposed amendments to the Patents Rules 1995, including the rules for implementing section 13 of the Patents Act 2004, which allowed the Office to issue opinions in relation to patent validity and infringement. Mr. Downs also referred to this consultation document at the hearing. I note that Mr. Downs felt justified in referring to the content of the consultation document because the hearing officer did so in his review decision. However, as I explained to Mr. Downs at the hearing, this consultation document is not legally binding on me and the law I must apply is that contained in the Patents Act 1977 (as amended by the Patents Act 2004) and in the Patents Rules 1995 (as amended by the Patents (Amendment) Rules 2005). I have already set out those provisions of the 1977 Act and 1995 Rules relevant to this decision.

42 Whilst I have referred above to passages taken from the consultation document, I have done so merely to reflect Mr. Downs' submissions to me. I do not propose to consider them further in this decision.

The hearing officer was constrained in what he could consider

43 Mr. Downs is of the opinion that there were legal constraints on the hearing

officer which precluded his consideration of new issues going beyond those contained in the original request for the earlier opinion. I fear that Mr. Downs has misunderstood the consultation document. It is clear to me from rule 77F(1) that an observer is permitted to file observations on any issue raised by a request for an opinion. Thus, if the request seeks an opinion on whether a patent is infringed by a particular thing or process, observations on the scope of the patent and the alleged infringement would be allowable. However, unless the request also sought an opinion on the validity of the patent, any observations on validity would not be allowed. Equally, the requester is permitted by virtue of rule 77F(4) to file observations confined strictly to matters in reply. As for the review process, rule 77H(3) requires a statement setting out fully the grounds on which a review is sought and it seems implicit to me that this statement should identify the matters in dispute and the patent holder's arguments in relation to these disputed matters. In my view there can be no question of requiring a request for a further opinion in order to deal with arguments against an opinion under review and addressing the same basic facts. This must be the case even if the arguments had not been presented in the original request for an opinion or prior to the issue of the opinion. It seems to me to be entirely legitimate for such arguments to be considered as part of the review.

44 When Mr. Downs requested the earlier opinion he provided a statement setting out the question to be considered and the facts to be taken into account. The question was whether the patent is infringed by the LCCS end to end enforcement process. The facts included information about the LCCS. In response Capita filed observations, denying that the LCCS infringes the patent and giving their view on how the patent should be construed and on how what is claimed is distinguished from the LCCS. As noted above Mr. Downs then filed observations in reply.

45 The opinion examiner acknowledges both sets of observations in the earlier opinion. There is no suggestion whatsoever in this opinion that the observations went beyond issues raised by the request or were not confined strictly to matters in reply. Indeed it is clear from the earlier opinion that the opinion examiner took account of not only the information supplied with the request but also the observations when forming his opinion. I am therefore prepared to accept that the opinion examiner sufficiently considered the matters raised by way of observations. As for Mr. Downs contention that the opinion examiner erroneously extended an argument submitted by Capita and so introduced a new issue, I do not see how this shows that the examiner failed to consider sufficiently the question upon which the earlier opinion was sought. In my view it merely indicates that Mr. Downs does not agree with the examiner's analysis of Capita's observations.

46 The hearing officer refers in his decision to the submissions made by Mr. Downs for the purpose of the review and he addresses in turn the four principle areas of alleged misunderstanding by the opinion examiner. I have read this decision and in my view it contains clear indications that the hearing officer took account of the points raised by Mr. Downs in so far as they were relevant to how the patent should be construed. Thus, I do not agree with Mr. Downs that the decision indicates that the hearing officer considered only section 1 (Introduction) of the

review paper. The hearing officer did not consider whether the LCCS performs topographical calculations in the sense required by the patent's claims, as he interpreted them, but he explained why this was unnecessary in view of rule 77H(5)(b) and his finding on construction. I accept this and it does not change my view that the hearing officer sufficiently considered the matter before him.

The nature of Mr. Downs' request for a second opinion.

47 From the introduction of the '507 paper it is clear to me that Mr. Downs believes that the earlier opinion and the review decision raise a number of new issues. I have carefully considered these issues which are identified and discussed in some detail in the '507 paper. It seems to me that they arise from an analysis by Mr. Downs of the earlier opinion and the review decision and that they address matters which he considers are wrong, inconsistent, misunderstood, overlooked or unclear in these earlier proceedings. Thus, in essence it appears to me that Mr. Downs is trying to put the record straight, as he sees it, by addressing these issues in his request for a second opinion.

Construction of the patent

48 Taking a broad view, in the conclusion to the '507 paper Mr. Downs identifies the principle issue as the way the patent and its claims should be construed.

49 I find it difficult to accept that identifying issues where the opinion examiner and the hearing officer might have got it wrong (and I am not offering any comment on this) indicates that they did not sufficiently consider how the patent should be construed. They both had the patent to read and I have no reason to believe that they did not sufficiently consider it. Indeed, there are indications in the earlier opinion and the review decision that the patent was comprehensively considered by both the opinion examiner and the hearing officer. The earlier opinion refers to the patent and sets out the nature of the invention as the examiner saw it and the hearing officer deals with the construction of the patent in even greater detail in his review decision. Moreover, acknowledging the principles of claim construction, set out in *Kirin-Amgen*, the opinion examiner states in the earlier opinion that he turned to the specification of the patent to construe the claims.

The view taken of the LCCS end to end enforcement process

50 Mr. Downs' issue with the opinion examiner's view of a topography processor system's functionality and how this differentiates the invention from the LCCS end to end enforcement process is again in my view a criticism of the conclusions reached by the examiner. I do not see anything here to suggest that the documents relating to the LCCS end to end enforcement process had not been sufficiently considered in the light of the construction placed on the patent. On the contrary it appears to me that these documents were sufficiently considered in view of a statement made by the opinion examiner in paragraph 17 of the earlier opinion that:

> "*I have considered carefully all of the documents submitted by the requester but can find no suggestion that the LCCS system performs topographic calculations based on the relative positions of the colour and the black and*

white cameras and the image data provided by the cameras."

51 As noted above I accept that in accordance with rule 77H(5)(b) the review decision stopped short of considering whether the LCCS is a topography processor system in the sense required by the claims of the patent and as construed by the opinion examiner and the hearing officer. However, in my view this does not detract from the opinion examiner's own consideration of the LCCS end to end enforcement process.

Sufficiency

52 Section 74A(1) sets out the things that the comptroller can issue an opinion on. Sufficiency is not one of them. Thus, even if Mr. Downs is right in arguing that sufficiency was a new issue and as such should not have been addressed in the earlier opinion and its review, I could not allow a request for a new opinion to consider the matter. The comptroller simply does not have the jurisdiction to give opinions on sufficiency.

New issues raised by the review decision

53 If as Mr. Downs contends a number of new issues, which went beyond those raised by the opinion, emerged from the hearing officer's review decision, I do not accept that this indicates that the question upon which the opinion was sought was not sufficiently considered. If anything, this would seem to indicate that the hearing officer had considered the question in greater detail than the opinion examiner had done.

UK file history

54 It appears to me that Mr. Downs seeks to rely on the file history to show that the opinion examiner and the hearing officer were wrong in the way they construed the patent. Once again, I do not believe that this shows that they did not sufficiently consider the question upon which the opinion was sought.

Capita's actions

55 I have considered the letter dated 6 November 2006 from Capita and I cannot draw from it the same inferences as Mr. Downs has done. Even if I could, I do not believe that this letter would help me with the matter I must decide. Similarly, I am not helped by Mr. Downs' speculation that Capita would have accessed the UK patent file and so would have been aware of the rationale for the pre-grant amendment of the patent.

Secondary issues

56 I have already rejected Mr. Downs' submissions that the hearing officer considered only section 1 (Introduction) of the review paper. It appears to me that the hearing officer would have considered this paper, including section 4 on secondary issues, in its entirety. Thus, I am not persuaded that the secondary issues, identified by Mr. Downs, provide grounds for allowing the request for a second opinion.

Fairness and Mr. Downs' decision not to appeal the review decision

57 I do not accept that the interests of justice are such that I must allow Mr. Downs' request for a second opinion. As noted above it seems to me that Mr. Downs has made this request so that he can put the record straight. However, he has already had this opportunity in that he requested and received a decision reviewing the earlier opinion and on top of that he could have appealed that decision. The sequence of opinion, review and appeal is designed just so a patent holder has an opportunity to redress any perceived injustice arising from an opinion or a review. It is not appropriate in my view to challenge an earlier opinion and/or review of that opinion by seeking a second opinion on the same question and based on the same facts.

58 I also believe that Mr. Downs was mistaken to think that an appeal would have offered too little scope to raise new issues outside the course of the opinions process. On appeal Mr. Downs could have challenged the hearing officer's decision and presented his arguments in support of his view, much in the way he has done in his request for a second opinion.

The option to start infringement proceedings

59 I note what Mr. Downs said about the idea of swift and affordable dispute resolution underlying the introduction the opinions process. Moreover, I have no way of knowing whether a new opinion, based on his present request, would facilitate the resolution of his dispute with Capita. However, such considerations do not assist me to decide whether the question, posed by the present request, has been sufficiently considered in any other proceedings.

Conclusion

60 I have carefully considered all of Mr. Downs' submissions to me in support of his view that his request for a second opinion should be allowed to proceed. However, it appears to me that earlier opinion and the review of that opinion have already sufficiently considered the question as to whether the patent is infringed by the LCCS end to end enforcement process. Therefore, in accordance with rule 77D(1)(b) I refuse the request for an opinion filed by Mr. Downs on 3 May 2007.

Appeal

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

R J WALKER
Divisional Director acting for the Comptroller