



**PATENTS ACT 1977**

BETWEEN

Interiors Manufacturing Limited

Proprietor

and

Lizzanno Partitions (UK) Limited

Opponents

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PROCEEDINGS

Request under section 74B of the Patents Act 1977  
for a Review of Opinion 07/12 issued  
on patent number GB2432617 B

HEARING OFFICER

Peter Slater

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**DECISION**

**Introduction**

- 1 This decision relates to a request for a review of opinion 07/12 (“the Opinion”) under section 74B of the Patents Act (the “Act”). The Opinion was requested by M&S Solicitors Limited, as to whether claims 1 and 12 of GB2432617 B (“the Patent”), would be infringed by an apparatus as described and illustrated in the request (“the Proposal”). The Opinion, which was issued on 14 May 2012, concluded that there was no infringement of the patent.
- 2 The proprietors of the patent, Interiors Manufacturing Limited, requested a review of the Opinion under section 74B of the Act on 14 August 2012. The request itself was incomplete in that it did not include a copy of Patents Form 2 which was subsequently filed on 15 August 2012 outside of the normal three month period allowed for filing such a request. The proprietor therefore requested a discretionary extension in respect of the aforementioned deadline on the grounds that there had been an error in their Records Department where the relevant date had been incorrectly recorded. The hearing officer acceded to their request and granted an extension sufficient for the review to proceed.
- 3 Filemot Technology Law Ltd filed a counter statement on behalf of Lizzanno Partitions (UK) Limited on 14 December 2012 contesting the application and requesting the Comptroller give summary judgment on the grounds that the

proprietor had no real prospect of success, and that the opinion should not be set aside.

- 4 Since the review was requested on 14 August 2012, there have been two judgments handed down by the Patents County Court dealing with the subject and scope of omnibus claims. *Environmental Recycling Technologies Plc v Upcycle Holdings Ltd* [2013] EWPC 4 and *Lizzanno Partitions (UK) Limited v Interiors Manufacturing Limited* [2013] EWPC 12. The latter being particularly relevant to this case as it relates to the same patent and discusses an identical form of omnibus claim. I therefore gave both parties an opportunity to file any additional submissions they might have regarding the relevance of these judgments to this review. I also indicated to both parties in a letter dated 30 September 2013, that I did not think a summary judgment was appropriate on this occasion and that subject to any further submissions they might have, I would issue a reasoned decision in full.
- 5 Additional submissions were filed by Filemot Technology Law Ltd on 28 October 2013. I received nothing further from Interiors Manufacturing Limited. Both parties agreed to have the matter decided on the basis of the papers.

### **The Law**

- 6 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)

- 7 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.
- 8 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:

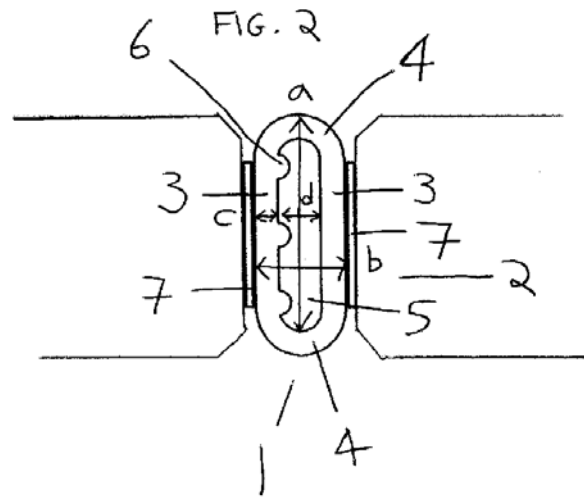
“In the case of an appeal under rule 77K [now Rule 100], the decision the subject of the appeal is itself a review of the opinion of the examiner. More specifically, it is a decision by the Hearing Officer as to whether or not the opinion of the examiner was wrong. I believe that a Hearing Officer, on 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.”

- 9 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**

- 10 The patent entitled “A gasket” was filed on 22 November 2005 in the name of Komfort Office Environments plc. It was granted on 16 June 2010. The current proprietors are Interiors Manufacturing Limited.
- 11 The invention relates to a gasket for providing a seal between two or more glass sheets forming a partition or wall. The gasket itself is made of a hollow tube of non

rigid material. The cross-section of the tube when it is not in use has a particular shape. One aspect of that shape is that the tube has substantially planar longer sides and curved shorter sides. The invention as illustrated in Figure 2 is shown by way of example below:



- 12 As is described at page 4 of the patent, the hollow tube 2 has a width (a) greater than its breadth (b). The hollow tube has two longer sides 3 and two shorter sides 4. Three axially extending ribs 6 are positioned on the interior of the hollow tube 2 on one of the longer sides 3 of the hollow tube 2.

*Arguments and analysis*

- 13 The proprietors argue that the examiner was wrong in his interpretation and construction of the omnibus claim 12 which they allege to be infringed. Claim 12 reads as follows:

*12. A glass partition or wall comprising two or more glass sheets and a gasket which provides a seal between the edge of one of the glass sheets and one or more of the other glass sheets substantially as described herein or as shown in the drawings.*

- 14 In his opinion, the examiner acknowledges that the wording of claim 12 differs somewhat from the usual type of omnibus claim, in that it includes the words “substantially as described herein or as shown in the drawings” (emphasis added) and appears to agree to some extent with the proprietors submissions regarding the construction of the claim. Indeed, he is content to proceed on basis that the claim should be construed in two parts as was suggested by the proprietors in their submissions as follows:

- i. A glass partition or wall substantially as described in the patent and having a scope as wide as the statement of invention; and
- ii. A glass partition or wall substantially as shown in the drawings

- 15 However, the examiner was keen to point out in paragraph 22 of the opinion, that “omnibus claims are of a narrow nature, and are intended to limit the invention to the

*particular embodiments contained within the specification.” He goes on to say that “while I agree with Fry that the description should be construed to be as wide as the statement of invention, I think that if the omnibus claim is also to be limited to “substantially” what is shown in the drawings of the patent (and without any reference to the description), then this part of claim 12 has to be construed very narrowly, with the proviso “substantially” including within its scope only very minor alterations of what is shown.”*

- 16 Having construed the claims, the examiner moves on to consider whether the proposal infringes claim 12 in paragraphs 27 to 31 of his opinion. Using the two-part construction referred to above as the basis for his determination. The examiner considers part i) of claim 12 first. In his opinion, this part of the claim “*should be construed as having a scope as wide as the statement of invention*” which in this case is equivalent to claim 1. The examiner deals with infringement of claim 1 in paragraphs 25 to 26 of his opinion where he concludes that whilst the gasket shown in figure 3 of the proposal comprises a hollow tube having a pair of longer sides and a pair of shorter sides, the shorter sides are not curved, as required by claim 1. Hence, since there is no infringement of claim 1, he concludes that this part of claim 12 would also not be infringed.
- 17 Regarding part ii) of claim 12, the examiner identifies a number of differences between the figures shown in the patent and those accompanying the proposal as follows:
- i) the gasket of the partition shown in each of the figures of the patent is unitary in construction, whereas that of the proposal has separate component parts, ie two longer side walls joined to two shorter end walls;
  - ii) the drawings in the patent show a gasket having three ribs projecting from an inside surface, a feature which is not readily apparent from the figures of the proposal; and
  - iii) the shorter sides of the hollow tube shown in the figures of the patent (which each show ‘in use’ arrangements) are curved whilst those of the proposal are best described as having a shallow V-shape.
- 18 These differences, the examiner considers to be significant and not what one might expect to be encompassed by the words “substantially” as shown in the drawings. On that basis, the examiner concludes that the proposal would not infringe claim 12 of the patent from a consideration of the drawings alone.
- 19 The proprietors argue that the examiner was incorrect to conclude that the shorter sides of the gasket shown in figure 1 of the proposal were V-shaped but are in fact curved. Whether the shorter sides of the gasket in the proposal are curved or V-shaped is difficult to determine given the quality of the drawings. However, I do not think the examiners conclusion in this respect is an unreasonable one.
- 20 They also argue that these differences are not significant when it comes to a consideration of the invention. Both gaskets are of a very similar shape, and will function in a similar way, having more give in one direction than in the other direction. The presence of the join and the absence of ribs in the proposal does not

alter that fact. The proposal is “substantially as shown in the drawings”, and so infringes claim 12 of the patent. I disagree, these features would all appear to have some effect on the flexibility of the gasket and cannot merely be ignored.

*Has the examiner got it wrong?*

- 21 Historically, omnibus claims have not been regarded as easy to interpret. Are they broad or narrow? Whilst I do not think I would have approached this in quite the same way as the examiner, in that I would not necessarily have split the claim into two parts, I think the examiner was right to have given the claim a narrow interpretation. In my opinion, to refer to what is described “herein” is to include the text which relates to what is shown in the drawings and hence it is difficult to consider the drawings independently of the description. In my view, despite the unusual use of the word “or” in claim 12, the claim must be talking about a glass partition or wall made using the gasket described in the description which includes the embodiment shown in the drawings. Amongst other things the gasket must therefore have a unitary construction, curved ends and three internal ribs as shown in the drawings for there to be any possibility of infringement. Given that this is not the case, I do not consider the proposal to infringe claim 12 of the patent, and find the examiner’s conclusion to be a reasonable one.
- 22 I also find the outcome of the examiner’s opinion to be consistent with that of the judgement in *Lizzanno Partitions (UK) Limited v Interiors Manufacturing Limited [2013] EWPC 12*. A similar case before the Patents County Court relating to the same patent in which the omnibus claim 12 was given a very narrow interpretation by the judge and found not to be infringed albeit by a slightly different arrangement of gasket.

### **Conclusion**

- 23 I conclude that the examiner in his opinion did not make an error in principle or reach a conclusion that is clearly wrong. I therefore make no order to set the opinion aside.

### **Appeal**

- 24 Any appeal must be lodged within 28 days

**P R SLATER**

Deputy Director acting for the Comptroller