

PATENTS ACT 1977

IN THE MATTER OF

an application under section 27

by Calix Technology Limited

to amend Patent Number EP(UK) 0,578,711 B

and an opposition thereto by Crown Cork and Seal Technologies Corporation

DECISION

Introduction

- 1 International patent application PCT/GB92/00623 was filed on 7 April 1992, claiming priority from two earlier United Kingdom applications dated 8 April 1991 and 27 March 1992. After it was published on 15 October 1992 as WO 92/17376 A, it entered the regional phase as a European Patent application before the European Patent Office (“the EPO”) and also entered the national phase in several countries, including the United States. The European Patent application designated a number of states including the United Kingdom and was granted with effect in the UK as European patent EP (UK) 0578711 B1 (“the EP patent”) on 25 June 1997.
- 2 On 18 March 1999 the proprietors, Calix Technology Limited (“Calix”), made an application to amend the EP patent under section 27(1) of the Patents Act 1977 (“the Act”). The statement of reasons accompanying the application states that the purpose of the amendments sought is “to more clearly distinguish the subject matter of the main claims from the disclosure in German patent application No 3538358” (which I shall call “the German specification”). Also filed with the statement of reasons was a copy of an opinion from David Young QC on the validity of the claims of the EP patent. Initial advertisement of the application to amend was made in the *Patents and Designs Journal* of 21 April 1999. After an exchange of correspondence between a Patent Office examiner and Calix, in which no agreement on the allowability of the requested amendments was reached, full advertisement of the amendment application appeared in the *Patents and Designs Journal* of 15 September 1999.
- 3 In the meantime, on 12 May 1999, notice of opposition under section 27(5) was given on behalf of Crown Cork and Seal Technologies Limited (“CCS”) by their patent agent, Mr R E Gadsen. The notice of opposition was treated as having been filed on the day that the amendments were advertised, that is 15 September 1999. In a letter of 25 August 1999 CCS confirmed that a letter dated 11 May which had accompanied their notice of opposition should stand as their statement of case. At that stage they stated that the second paragraph of that letter which commented on the form of the proposed amendments and the validity of the proposed amended claim could be disregarded, so that only those sections concerning exercise of the comptroller’s discretion were for consideration. A counterstatement was filed by Calix on 16 December 1999, and was accordingly restricted to issues relevant to the exercise of the comptroller’s discretion. A supplementary statement of case directed to the validity issue was filed by CCS on 24 August 2000. It was accompanied by a second opinion from David Young QC and prior art in the form of technical abstracts and patent specifications. A supplementary counterstatement was filed by Calix on 13 November 2000, directed to CCS’s statements

on validity.

- 4 After the filing of evidence, the matter came before me at a hearing at which Miss Jacqueline Reid, instructed by Beck Greener, appeared as Counsel for Calix. CCS did not appear and were not represented. A skeleton argument was provided by Miss Reid before the hearing.

Evidence

- 5 The evidence rounds did not follow entirely the usual course. In a letter of 17 January 2000, CCS said that they did not intend to file evidence in support of the opposition. The letter went on to call upon Calix, as part of their duty of full disclosure, to file evidence to substantiate their counterstatement in the form of a copy of an official action dated 19 June 1995, in which the US Patent and Trademark Office (“USPTO”) used the German specification to reject the claims of the US patent application (“the US application”) also proceeding out of International patent application PCT/GB92/00623 and hence corresponding to the EP patent. The Patent Office took the view that this US official action was relevant to the matter in hand and might be necessary to enable the comptroller to dispose fairly of the proceedings, and a letter to that effect was issued on 24 January 2000. The requested copy of the official action was filed on behalf of Calix on 24 February 2000.
- 6 Evidence on behalf of Calix was filed on 7 August 2000 in the form of a witness statement and exhibits from Mrs Jacqueline Needle, a partner in the patent agents firm of Beck Greener, which represents Calix; and a witness statement and exhibit from Matthew John Searle, shareholder in, and technical consultant to, Calix. He is also one of the inventors named in the EP patent. Further evidence, said to be in support of Calix’s position on obviousness, was filed on 6 April 2001 in the form of a second witness statement and exhibits from Mr Searle.
- 7 On 10 January 2001 a letter was filed from Mrs Ismay Hilary Ratliff, the patent agent then representing CCS, accompanied by several technical abstracts and extracts from the earlier evidence filed on behalf of Calix. This was regarded by the Patent Office as unsworn evidence and was refiled on 18 January 2001 as a witness statement from Mrs Ratliff with exhibits. A second witness statement from Mrs Ratliff was filed on 18 May 2001. However, it later became clear that Mrs Ratliff would not attend to allow herself to be cross-examined on her second witness statement, despite a request from Calix that she should make herself available. As a result CCS accepted that this second witness statement be struck out of the proceedings.

Preliminary Point

- 8 As a preliminary point at the hearing, I put to Miss Reid that in approaching consideration of the issues I needed to take into account all of the submissions and arguments that the other side had put forward in the course of the correspondence. In response, Miss Reid pointed out that I had the statement of case and evidence from the other side, and went on to say that it would not be usual to take into account the whole ream of discussions between the parties in correspondence. The other side had not chosen to put in any formal argument or any formal submissions. Miss Reid went on to say that the purpose of

skeleton arguments is so that the arguments of the other side are known in advance.

- 9 I pointed out that it is not always the case in Patent Office proceedings that we have skeleton arguments. I also noted that the other side had elected not to be present, which carries certain disadvantages. However, I suggested that I could not simply ignore arguments that they had previously put in. Miss Reid's view was that I should if my not doing so caused prejudice to her client. She went on to argue that the whole purpose of these proceedings is to deal with the issues between the parties. If the issues are not in the statements of case and not supported by the evidence, then they are not issues that the other side wanted to raise in the case. In her view it would be contrary to natural justice for me to take into account things which are outside of the ambit of the case that is put before me.
- 10 I entirely accept Miss Reid's last point. I agree with her that I should not trawl through the correspondence looking for fresh points which go beyond the grounds set out in the statements of case. However, I can see no reason why, in considering the issues before me as defined in those statements of case, I should not take account of *arguments* offered in correspondence in respect of those issues which fall within the statements filed on behalf of CCS. In coming to this view, I do not believe that Calix should be caught unawares by any of the arguments submitted by CCS in correspondence, since all the correspondence has been copied to them, nor therefore that they should suffer any prejudice as a result. Moreover, it would I think be unfair to CCS if I were to ignore arguments, in relation to the pleaded grounds, which they had put forward in correspondence.

The EP Patent

- 11 The EP patent relates to a container for beer and other beverages and to a method of dispensing beer and other beverages using the container. The purpose of the invention is to overcome the problems of serving a large number of people with beverages where the beverage has to be dispensed from a container such as a can or bottle into a plastics drinking vessel for consumption. The container of the invention is essentially in the form of a open mouthed vessel closed by a lid such that on removal of the lid the beverage can be drunk from the vessel.
- 12 The unamended specification contains 11 claims. Independent claim 1 defines the construction of the container, and reads:

“1. A container for beer and other beverages, comprising a body member (120) having an opening (122) at one end thereof, and a removable end closure member (126) closing said opening, wherein said body member (120) is made of plastics material and is sufficiently strong to contain a beer or other carbonated beverage, and said body member is shaped and configured to define a drinking vessel and said opening defines an unrestricted mouth opening of the drinking vessel, and wherein said end closure member (126) is completely removable to thereby reveal said unrestricted mouth opening (122), characterised in that said end closure member is a lid (126) having an internal screw thread, and an external screw thread (124) is formed on said body member (120) proximate said opening for engagement with the internal screw thread of said lid, and in that said external screw thread (124) extends around said body member (120) spaced from the opening (122) thereof to

thereby define a plain mouth opening.”

- 13 Claims 2 to 10 are dependent on claim 1 and are concerned with details of the material from which the container is made. Claim 3 is in particular relevant in these proceedings, and reads:

“3. A container as claimed in Claim 1 or Claim 2, wherein said body member (120) is fabricated from at least two plastics materials, the first plastics material being able to impart structural rigidity and the ability to withstand pressure to the body member, and the second plastics material being arranged to provide a barrier to the passage of gas.”

- 14 Claim 11 is concerned with a method of dispensing beer and other beverages using the claimed container, and reads:

“11. A method of dispensing beer and other beverages comprising the steps of packaging the beverage to be dispensed in a container as claimed in any of the preceding claims with the end closure member closing the container, and subsequently removing and discarding said end closure member to provide a drinking vessel containing said beverage ready for consumption.”

The proposed amendments

- 15 The requested amendments are not extensive, and in essence involve the incorporation of the matter of claim 3 into claim 1. Corresponding amendment to the statement of invention on page 2 is also requested, as is deletion of the passage bridging columns 1 and 2 on page 2 which corresponds to the matter of original claim 3. Consequential renumbering, and amendment of the appendancies, of the remaining claims is also requested.

- 16 Claim 1 as proposed to be amended reads:

“1. A container for beer and other beverages, comprising a body member (120) having an opening (122) at one end thereof, and a removable end closure member (126) closing said opening, wherein said body member (120) is made of plastics material and is sufficiently strong to contain a beer or other carbonated beverage, and said body member is shaped and configured to define a drinking vessel and said opening defines an unrestricted mouth opening of the drinking vessel, and wherein said end closure member (126) is completely removable to thereby reveal said unrestricted mouth opening (122), wherein said end closure member is a lid (126) having an internal screw thread, and an external screw thread (124) is formed on said body member (120) proximate said opening for engagement with the internal screw thread of said lid, and in that said external screw thread (124) extends around said body member (120) spaced from the opening (122) thereof to thereby define a plain mouth opening, and wherein said body member (120) is fabricated from at least two plastics materials, the first plastics material being able to impart structural rigidity and the ability to withstand pressure to the body member, and the second plastics material being arranged to provide a barrier to the passage of gas.”

- 17 At the hearing Miss Reid described the amended claim as being a concatenated claim which is effectively deleting claim 1 as it stood and concatenating it with claim 3. She called the proposed amendment as being “simply a deletion amendment rather than a recast amendment”. However, it seemed to me that these are not amendments only by way of deletion. I therefore raised this point with Miss Reid, noting that the main thrust of the amendment is to add claim 3 into claim 1, and drawing her attention to the comments of Pumfrey J. in *Instance & anr v CCL Label Inc* [2002] FSR 27 on forms of amendment, in which he draws a distinction between validating amendment and amendment by deletion. In her skeleton argument, Miss Reid refers me to an earlier case, *C Van der Lely NV v Bamfords Limited* [1964] RPC 54, on the same point. Miss Reid explained that, in her interpretation, in the present application to amend, claim 1 was being deleted and replaced by claim 3, the words “as claimed in claim 1” in claim 3 being replaced by claim 1. I have some difficulty with this interpretation of the authorities. They are saying, it seems to me, that deleting invalid claims is “amendment by deletion”, even if minor tidying up of wording to make sense in English is also necessary as a consequence. Validating amendment is taking an invalid claim and, not deleting it, but changing its wording or content so as to confer validity. It seems to me the present proposal lies in this latter category.
- 18 Having said that, while the categorisation of the proposal to amend either as validating or as by deletion can in some cases be highly significant for its allowability, in the present case, for reasons I shall come to, I do not believe it makes any difference.

Background to the request for amendment

- 19 The statement of reasons which accompanied the request explains that the attorneys acting for Calix first became aware of the existence of the German specification when collating prior art for submission in an Information Disclosure Statement in support of the US application. That Information Disclosure Statement was filed on 16 March 1995. Shortly afterwards, in June, the USPTO examiner issued the official action I have already referred to, objecting to the then claims of the US application as being obvious in view of the disclosure in the German specification when combined with other art. To facilitate the US response, a partial translation of the German specification was made. Prosecution of the US application ceased in January 1996 because the applicants ran out of funds.
- 20 The statement of reasons goes on to state that in prosecuting the application for the EP patent, Mrs Needle, as Calix’s patent attorney, had always proceeded on the basis that the main claim of the application filed in the EPO was clearly distinguished from all the prior art of record, including the German specification. That main claim became claim 1 of the granted EP patent.
- 21 It was some time later, on 21 January 1999, and during the course of negotiating a licence agreement, that the potential licensees CCS provided Calix with the first opinion from David Young QC. His opinion was that claim 1 of the EP patent was invalid in view of the German specification. Calix immediately sought advice and were advised by their own Leading Counsel on 17 March 1999 that it was likely that claim 1 as it stood was invalid. Calix immediately requested amendment of the EP patent, indeed on the very next day.

The opposition

- 22 Taken together, CCS's statements of case in effect present two grounds for their opposing the amendment request: (i) that the comptroller should not exercise her discretion to allow the request because Calix had acted in bad faith and had delayed unduly in seeking the amendment; (ii) that the proposed amendments would not in any case cure the defect of invalidity. I shall consider first the matter of discretion.

Discretion - The Law

- 23 The relevant parts of section 27 of the Act read as follows (my emphasis added):

“27.-(1) Subject to the following provisions of this section and to section 76 below, the comptroller *may*, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.

....

(5) A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.”

- 24 It has long been accepted that the effect of the word “may” in subsection (1) is that the allowance of amendments under section 27 is a matter for the discretion of the comptroller. It is also established in case law that the conduct of the proprietor is a factor to be taken into account in deciding whether to exercise that discretion.

- 25 At the hearing Miss Reid took me to the judgment in the *Instance* case, which is especially relevant to these proceedings. She referred me in particular to paragraphs 36 to 38, where Pumfrey J refers to the principles upon which the discretion to permit or refuse amendment should be exercised. Picking up Pumfrey J's words shortly after the beginning of paragraph 36, he says:

“36. ... In *SKF*, Aldous J set out a number of principles upon which the discretion to permit or refuse amendment should be exercised, which have been approved subsequently by the Court of Appeal:

- (a) the onus to establish that amendment should be allowed was upon the patentee who was required to make full disclosure of all relevant matters.
- (b) amendment would be allowed provided the amendments were permitted under the Act and no circumstances arose which would lead the court to refuse the amendment.
- (c) It was in the public interest that amendment be sought promptly. If delay in such application had arisen the patentee had to show reasonable grounds for his delay if leave to amend were to be given.
- (d) a patentee who sought to obtain an unfair advantage from a patent which he

knew or should have known required amendment, would not be allowed to amend. (e) in such applications, the court was concerned with the conduct of the patentee and not with the merit of the invention.

37. Underlying the principles affecting the exercise of this discretion is a desire to ensure that patentees do not obtain an advantage which is unfair from their failure to amend, and perhaps, in some cases at least, to punish patentees for the unreasonableness of their conduct even when no advantage has in fact been gained. Aldous J was careful to distinguish two kinds of delay. Relying on the judgment of Graham J in *Matbro Ltd v Michigan (Great Britain) Ltd* [1973] RPC 823, he observed that culpable delay (in which the patentee was aware of the need to amend but failed to do so) was different in significance from a patentee who knows of an objection but ‘never thought or should have thought that amendment was the right course’. He says that in both cases failure to amend earlier is contrary to the public interest, but in the second category the patentee may be excused as he has acted reasonably.

38. In making decisions as to need to amend on the basis of advice received from a competent patent agent, a patentee cannot normally, in my judgment, be criticised. In this case, the advice was given by a competent professional adviser and received and considered by an individual who was not conversant with the details of law relating to anticipation and who entrusted his professional advisers to provide the basis for decisions. I should be loath in such circumstances to consider that the patentee had been guilty of culpable delay, the more so since the point upon which the need to amend turns is not free from difficulty.”

26 Miss Reid also quoted from *Kimberly-Clark Worldwide Inc v Procter and Gamble Ltd No 2* [2001] FSR 22, on the question of covetous claiming. At paragraph 58 Pumfrey J says:

“58. In my judgment, a claim of covetousness cannot begin to be made out unless it is established that the draftsman of the specification sought to obtain a claim of a breadth which was unjustified on the material available to him. That material will include the description of the invention, and such information as he has concerned the prior art. I would however caution against an approach which substitutes for a draftsman’s bona fide assessment of the breadth of protection which he can obtain in the light of the prior art which has been located by him or on his behalf an assessment made *ex post facto* in the knowledge of material of which the draftsman was unaware or the significance of which he failed, in good faith, to appreciate. I do not believe that it is a correct exercise of this discretion to refuse amendment in the absence of conduct which can fairly be described as blameworthy.”

27 From these authorities, it is clear I must look not only at the promptness with which amendment was sought once the defect had been noticed, but also the respective roles and contributions of the proprietors and their professional advisers in the process.

Discretion - the facts

28 In their statements CCS contend that Calix were aware as early as March 1995 of the

German specification, and that the relevance of the German specification was fully appreciated in September 1995. In support of this view CCS point out that a translation of the German specification was requested on 31 August 1995 and received by Calix by 8 September 1995. CCS draw attention to three particular passages in letters, exhibited to Mrs Needle's witness statement, which were exchanged immediately after Mrs Needle had sight of the translation. The first is in a letter from Mrs Needle to the US Attorney dated 8 September 1995 referring to prior art, including the German specification, which the USPTO examiner had used as a basis to reject claims of the US application. It reads:

“Unfortunately, though, each specification whilst maintaining, as does the industry, that such containers should be of glass, throws in a reference to the use of other materials and gives plastics material as a specific example.”

29 I note though that immediately following in that letter, but not quoted by CCS, it says:

“However, neither specification contains a specific and unequivocal disclosure of a plastics material container, shaped as a beer glass, having an inwardly curved base, made of plastics material, and with a screw threaded closure. It is this combination of elements, most of which are known in themselves, which is unique.”

30 This further passage seems to me to suggest Mrs Needle was not persuaded as to the ultimate relevance of the German specification (and another).

31 CCS's second quotation comes from a letter from Mrs Needle to Matthew Searle dated 8 September 1995. Enclosing a copy of a translation of the German specification, she comments on its relevance in the prosecution of the US application in the following terms:

“Unfortunately, the German reference has shown that the prior art is very much closer than I had originally thought. Thus, the German reference has a drinking vessel with screw thread and although it makes clear that the vessel is preferably of glass there is a reference to plastics material.”

32 The third CCS quotation comes from a letter from Matthew Searle to Mrs Needle dated 9 September 1995 in which he writes:

“I have read through the German patent and agree that it seems very close.”

33 CCS assert in their statements of case that the existence of the German specification was not mentioned during the protracted commercial negotiations between CCS and Calix on a potential licence under the EP patent between December 1997 and November 1998. No mention had been made that the claims of the EP patent may have been too broad. In this respect, Calix had not demonstrated good faith in their dealings with CCS. On the question of undue delay, Calix had not sought amendment of the EP patent application during its prosecution in 1995 and 1996 but had delayed seeking amendment until 1999, despite having appreciated the relevance of the German specification.

34 It is not in dispute that Calix knew about the German specification in 1995, and recognised it was very close to their claimed invention. However, in the light of the judgment in

Instance, I believe that what I need to consider carefully is whether, on the one hand, Calix had been advised by their professional advisers that amendment was necessary, but had chosen not to go along that route, or whether, on the other hand, Calix had not sought amendment because they had not been advised to do by advisers whom they relied on.

35 In his first witness statement Mr Searle states that he had always been Calix's main point of contact with their patent attorney, Mrs Needle. He does not recall how he first became aware of the German specification, but he does recall a meeting involving Mrs Needle and others on 6 March 1995 at which he became aware of an abstract of the German specification that referred to a glass container. Because of that, he took the view that German specification was not relevant and received no advice to contradict that. He goes on to explain the circumstances under which he became aware that the German specification might be more than just one of a large number of patent specifications made available from various sources. In particular, it was on 21 January 1999 that CCS gave Calix the (first) opinion of David Young QC. On Mrs Needle's advice Calix sought an opinion on their own behalf from Michael Silverleaf QC. Mr Searle's first witness statement concludes:

“The advice given by Leading Counsel, Mr Michael Silverleaf QC, on 17th March 1999 was the first time that I had been advised that the German specification contained all of the elements of Claim 1 of our Patent.”

36 I have noted already that Calix argue that in prosecuting the application for the EP Patent at the EPO, Mrs Needle had always proceeded on the basis that the main claim of the application was clearly distinguished from all the prior art on record, including the German specification. Mrs Needle's witness statement includes several passages which make this point. In particular in paragraph 27 she states that she was still of that view even after seeing the (first) opinion from David Young QC and reviewing the German specification and the law on anticipation. She nevertheless at that point advised her clients to seek an opinion on validity and to be prepared to seek amendment of the EP patent if they were advised that the patent was invalid. They followed her advice.

37 CCS have not challenged either Mr Searle's or Mrs Needle's evidence or sought the opportunity to cross-examine either of them. On the basis of this unchallenged evidence, and having in mind Miss Reid's submissions, it appears to me that a fairly clear picture emerges of Calix relying entirely on their professional advisers as regards what to do about their patent affairs. They were in 1995 given and accepted professional advice from a highly reputable source that the German specification was relevant, but were not at that time advised that any further action was needed. When advised to seek Counsel's opinion on the matter in early 1999, they did so without delay. When that opinion suggested invalidity of the EP patent, they immediately applied to amend it. It seems clear to me that the substantial delay between their becoming aware of the German specification in 1995 and action being taken about it in 1999 can be attributed to their reliance on the professional opinion of their patent attorneys.

38 I am not persuaded that, on the balance of probabilities, a case has been made that Calix themselves acted in bad faith by maintaining a claim which they knew to be invalid, given the advice they received and acted on from their professional advisers. Applying the wisdom of the *Instance* judgment, I do not believe that there has been culpable delay on

the part of Calix, nor therefore that the application by Calix to amend the EP patent should be refused as a matter of discretion.

Does the amendment cure the defect?

- 39 It is of course not sufficient for an applicant for amendment to demonstrate that the circumstances and its behaviour are such that the comptroller should favourably exercise her discretion. To be allowable, the proposed amendments must also be such as will meet the defect which they seek to cure. In these proceedings, Calix state in their statement of reasons that the proposed amendment is intended “to more clearly distinguish the subject matter of the main claims” from the disclosure in the German specification. I take the word “distinguish”, in the context of the 1977 Act, as embracing both potential novelty and obviousness objections. In deciding whether the proposed amendments will cure the defect of invalidity of claim 1, I shall therefore need to consider both the novelty and the inventive step of the proposed amended claim.
- 40 The case put by CCS appears to be that the amended claim would not be valid and that therefore the requested amendment would fail to cure the defect of not distinguishing over the German specification. In their supplementary statement they contend that the addition of the subject matter of claim 3 into claim 1 would add nothing novel or inventive to claim 1, because the subject matter of claim 3 was well known to those skilled in the field of plastics containers.

Novelty

- 41 I turn first to novelty. The relevant section of the Act is section 2, which reads:
- “2.-(1) An invention shall be taken to be new if it does not form part of the state of the art.
- (2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.”
- 42 The German specification is concerned with a sealable drinking vessel for still and carbonated drinks. There are a number of different embodiments in which a vessel provided with a sealable closure is disclosed, including in figures 8,9, and 20 screw threaded caps which engage an external screw thread on the vessel. Although the main thrust of the German specification is that it provides a glass vessel, it nevertheless includes clear statements that the vessel may be made from plastics, both in the description (bottom of column 8) and in claims 48 and 49. The German specification also explicitly refers to use of the vessel for still or carbonated drinks, and the last paragraph of the description suggests that selection of a suitable closure for the vessel will be a factor for different drinks. In my view the disclosure of the German specification anticipates the unamended claim 1 of the EP patent, and Miss Reid admits as much in her skeleton argument.
- 43 In considering the claim as amended, Miss Reid argued that the restriction imparted by the incorporation of claim 3 was not disclosed in the German specification. I agree with her

submission. I can find no suggestion that the vessel may be made from “at least two plastics materials, the first plastics material being able to impart structural rigidity and the ability to withstand pressure to the body member, and the second plastics material being arranged to provide a barrier to the passage of gas”, as is required by amended claim 1 of the EP patent. I therefore conclude that amended claim 1 is novel over the disclosure of the German specification.

Inventive step

44 Section 3 of the Act reads:

“3. An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).”

45 At the hearing Miss Reid took me to *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 which sets out the approach to be taken in determining whether an invention involves an inventive step. The process set out by Oliver LJ at page 73 is as follows:

“There are, we think, four steps which require to be taken in answering the jury question. The first is to identify the inventive concept embodied in the patent in suit. Thereafter, the court has to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, as that date, common general knowledge in the art in question. The third step is to identify what, if any, differences exist between the matter cited and as being “known or used” and the alleged invention. Finally, the court has to ask itself whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to a skilled man or whether they require any degree of invention.”

46 Miss Reid then took me to several further relevant authorities. From *Technograph Printed Circuits Ltd v Mills and Rockley (Electronics) Limited* [1972] RPC 346 she quoted Lord Reid’s comments on page 355 on the ordinary skilled man:

“To whom must the invention be obvious? It is not disputed that the hypothetical addressee is a skilled technician who is well acquainted with workshop technique and who has carefully read the relevant literature. He is supposed to have an unlimited capacity to assimilate the contents of, it may be, scores of specifications but to be incapable of a scintilla of invention. When dealing with obviousness, unlike novelty, it is permissible to make a “mosaic” out of the relevant documents, but it must be a mosaic which can be put together by an unimaginative man with no inventive capacity.”

47 Then on page 356, having quoted a passage from *Sharp and Dohme Inc v Boots Pure Drug Co Ltd* (1928) RPC 45, Lord Reid says:

“In the passage which I have just cited there is the word “valuable”. So what he [the skilled man] must be supposed to have done is to try everything which would appear to him as giving any prospect of valuable results.”

48 Miss Reid drew from that the point that if the skilled man does not think that there are going to be any valuable results, he is not going to try a particular line. She also quoted Lord Diplock in the same case, including at page 362 his remarks that:

“Once an invention has been made it is generally possible to postulate a combination of steps by which the inventor might have arrived at the invention that he claims in his specification if he started from something that is already known. But it only because the invention has been made and has proved successful that it is possible to postulate from what starting point and by what particular combination of steps the inventor could have arrived at his invention.”

49 Turning to *Dyson Appliances Ltd v Hoover Ltd* [2002] RPC 22 at page 484, Miss Reid drew my attention to Aldous LJ’s remarks on common general knowledge:

“Common general knowledge has to be distinguished from what is known. To be common general knowledge the knowledge has to be that which is known by the ordinary addressee of the patent. In this case Hoover did not call, as a witness, anybody who had worked in their design department who could have helped the Court on what was generally known in the industry. The only evidence was that of the professors who were not, as the judge pointed out, in a position to know what was common general knowledge in the industry.”

50 At the hearing Miss Reid inferred from this that the court needs to be helped with the assessment of the common general knowledge because it cannot make any assumptions as to what is known. She referred me to several other passages, which I need not quote here, except that on page 486 where Aldous LJ says:

“The mantle of a skilled person is that of an actual skilled person. The purpose of assuming the mantle of a skilled person is to enable the decision as to what is obvious to be a decision based on actual facts. They include all the attitudes and perceptions of such a person.”

51 Miss Reid took this to support her contention that it is appropriate and necessary that I should take into account the mindset that Calix put forward as that which existed in the ordinary skilled man at the time.

52 Having found earlier that the unamended claim 1 lacks novelty, I do not need to consider whether it contains an inventive step. I turn immediately to the claim as it is proposed to be amended, which I have already found is novel. The alleged inventive concept of the amended claim 1 is the structural restriction imported into claim 1 by the incorporation of the features of previous claim 3, that is the restriction that “said body member (120) is fabricated from at least two plastics materials, the first plastics material being able to impart structural rigidity and the ability to withstand pressure to the body member, and the second plastics material being arranged to provide a barrier to the passage of gas”. In

determining whether that inventive concept would have been obvious to the skilled man I need to consider, among other things, what was the relevant common general knowledge at the priority date. The extent to which I can legitimately do so depends on the relevant evidence I have to help me. In these proceedings, Calix have submitted what they describe as expert evidence, and various prior art documents have been submitted by CCS.

53 The “expert evidence” from Calix is in the form of a second witness statement from Mr Searle, in which he asserts that he is *now* an expert in the packaging of beer in plastics material containers. However, he admits that at the time that the invention was conceived, he “would not have claimed any special expertise in packaging or plastics material technology”. This gives me some difficulty in determining what weight I should attach to his evidence as an expert, as his expertise is based on hindsight. A further factor is that Mr Searle is one of the inventors named in the EP patent, and as Miss Reid admitted at the hearing can hardly therefore be described as an unimaginative addressee in the art. I have considerable reservations about the extent to which Mr Searle’s evidence can properly be regarded as indicative of what the notional skilled man thought or knew at the priority date. However, I think that I can attach some weight to the exhibits filed with his statement as being a pointer to the attitude in the beer packaging industry at the time that the invention was being developed. In particular, Mr Fussell’s view that there was only a 50:50 chance of success in a feasibility study taking forward the prototype of the invention is indicative. Even here though, the evidence is sketchy.

54 I will now turn to the documentary material submitted by CCS. At the hearing Miss Reid referred me to *Great Lakes Carbon Corporation’s Patent* [1971] RPC 117 and *Minister of Agriculture’s Patent* [1990] RPC 61. She argued that in the light of those authorities I should not consider the prior art documents that CCS had put in, and that I should confine myself to considering the prior art identified by Calix - the German specification. In other words, I should be looking at the question of whether claim 3 as was, now the amended claim 1, is obvious over the German specification alone. I fully accept that these authorities apply here and that I cannot allow these proceedings to develop into a roving enquiry into the validity of the EP patent. More than that, it is clear from the Hearing Officer’s decision in the *Minister of Agriculture* case, which was confirmed on appeal, at page 64 that “... the opponent should not be allowed to introduce further documents to bolster up an attack on validity and that the proper course if the opponent wishes to do this is to bring a revocation action.” It is clear I must consider the amended claim 1 in the light only of the German specification.

55 At the hearing Miss Reid argued that the German specification did not disclose the strength requirement of claim 1 of the EP patent, where it says “...and is sufficiently strong to contain a beer or other carbonated beverage...”. She argued that without this limitation, a vessel according to the German specification might leak in use. I have considered this submission, but I find myself unpersuaded. The limitation is cast in vague terms, and it is arguable how restrictive it is when interpreting the claim. Miss Reid also took me through the German specification, drawing me to several passages which emphasise the advantages of using glass as a material for drinking vessels. She argued that the German specification as a whole has as its aim to promote glass over plastic and paper cups and metal cans, and that it teaches away from plastic. I certainly take the point that the main thrust of the German specification is towards the use of glass, but nonetheless I cannot ignore that it includes the clear statement “In many cases e.g in aeroplanes, lightweight packaging is

desirable for drinks. The drinking vessel described in this application can therefore of course also be made of plastic or metal.”. Moreover, it contains claims 48 and 49 which refer to a drinking vessel made of plastic or metal. However, there is nothing in the German specification to suggest how such a plastic vessel would be put into effect in practice, in contrast the detail that is given for the construction of glass vessels. I am inclined to the view that the skilled man would not at the priority date have been tempted by the German specification to try to construct a vessel using a two layer plastics material that would be suitable for carbonated drinks. There is nothing in the evidence which points against this view, and such evidence as there is tends in the same direction.

56 In case I am wrong in my primary position that I should give no consideration, for obviousness purposes, to the prior art that has been filed by CCS, I shall briefly consider what effect it might have if considered.

57 At the hearing Miss Reid took me through the technical abstracts that had been filed by CCS. They are scattergun in coverage, spanning the years between 1976 and 1991. Many of them relate to conventional bottles or containers not intended for use with carbonated drinks. Of the many, only four (PIRA Abstracts Nos 03-89-01969 (Anon), 03-90-04062 (Bartlett), 03-91-00273 (van Damme), and 03-90-00018 (Anon) are concerned with containers that are said to be suitable for carbonated drinks or beer, and of those only the first two disclose multi-layer constructions. However, all of these disclosures are concerned with bottles, not wide mouth containers. Wide mouth plastics containers are referred to in 03-87-01623 (Goddard), and in 03-90-00018 (Anon), but not in the context of carbonated drinks or multi layer materials. Miss Reid’s skeleton argument drew attention to others (03-86-01902 (Stevens) and 03-90-04062 (Bartlett)) which tend to reinforce the difficulties and prejudice against such materials.

58 I have to say that even if they were open to my consideration the documents put in by CCS do not help me in forming an opinion on what was well known in the art at the priority date of the invention, in respect of two layer plastics materials used in the carbonated drinks packaging industry. Neither does any of them present an obvious mosaic with the German specification. In short, they would not persuade me that claim 1 in its amended form is obvious.

59 I ought also to mention the second opinion of David Young QC, lodged with CCS’s supplementary statement of case, regarding the validity of the amended claim 1. Miss Reid submitted at the hearing that I should pay no regard to it, the validity of the claim in these proceedings being a matter for the tribunal. I fully agree with that submission and can confirm that I have not taken any account of Mr Young’s opinion.

60 For these reasons, I do not find that the proposed amended claim 1 is lacking in inventive step.

Clarity of scope of amended claim 1

61 I also need to ensure that the amendment, while overcoming objections of lack of novelty and inventive step, does not leave claim 1 manifestly invalid on some other count. In this respect, I should mention that in the course of her submissions on the disclosure of the

German specification, Miss Reid placed great emphasis on the question of containing and transporting carbonated beverages and the problems that gives rise to. However, there is an inconsistency in her clients' patent, the EP patent, between what the claim specifies and what the description says the invention is suitable for, notably at the top of column 5, where there is a reference to the use of the container for wine. Wine of course in many instances is not carbonated, and thus to my mind this reference to use for wine could be argued as being inconsistent with the reference in amended claim 1 to use for carbonated beverages. This inconsistency was present in the patent as granted, and whilst I accept that it is not the purpose of amendment proceedings to re-examine the granted patent, I am uneasy about this arguable inconsistency as it now assumes greater prominence as it affects claim 1, not just an appendant claim.

62 When I put this point to Miss Reid at the hearing, she replied that the claims were expressly related to a strength requirement of the container necessary for it to contain carbonated beverages successfully. We had a lengthy discussion about the construction of amended claim 1 of the EP patent, which I have to say did not entirely resolve my concerns. I thought then, as I do now, that it is right that the public should be quite clear as to the scope of the monopoly of the amended specification. Eventually I posed the point to Miss Reid by asking:

“If a competitor of your client were to manufacture a vessel of this sort, but it was sufficiently weak when you put a carbonated beverage in it that it could not contain it, but it could contain a still beverage, that would not be a problem?”

to which she replied:

“I do not think that would be covered by the express terms of the claim.”

63 In the light of Miss Reid's submissions, I am satisfied that there is not any ambiguity that I should consider further.

Summary

64 I have carefully considered all the evidence and argument before me, and concluded that the comptroller's discretion should be exercised to permit amendment, and that the proposed amendments are such as to cure the defect identified by Calix. I therefore allow the request to amend EP(UK) 0578711 in the manner sought.

Costs

65 In her skeleton argument Miss Reid asked that Calix be awarded costs, and at the hearing I asked her to address me on the issue. She pointed out that Calix had needed to deal with the material that had been put forward by CCS, even though they had not attended the hearing. Drawing her attention to paragraph 9.54 of *Terrell on the Law of Patents* (fifteenth edition), which deals with an analogous but admittedly slightly different situation, I put it to her that CCS were arguably acting in the public interest to ensure that the amendment proposal is suitable. Miss Reid's view was that they were “acting in their own interests...they seek to exploit this themselves and do not want to be inhibited by a patent that might prevent them.” Referring to the Civil Procedure Rules, Miss Reid noted that

in the general rule of the courts costs were dealt with on an issue base, so that if you have to deal with the issues raised by the opponent on which they fail, then you succeed on the costs of those.

- 66 I think it is important to remember that the comptroller proceeds on a different basis as to costs from the High Court; costs in proceedings before the comptroller are usually contributory and based on a published scale. I have considered Miss Reid's submissions carefully. Indeed Calix have been successful in their application to amend. More than that, CCS put in a lot of documents which Calix felt they needed to deal with, even though, as I have found, they had no place in amendment proceedings under section 27. I think it is fair to say that it is common in opposed amendment proceedings under section 27 that no award of costs would be made, or one would be made to the opponent. However, in this case I believe it is right that I should make an award to Calix for the reasons I have given. I therefore order CCS to pay Calix £400 as a contribution to their costs. This sum should be paid within seven days after the expiry of the period for appeal against this decision; if an appeal is lodged, payment is suspended pending the outcome of the appeal.

Appeal

- 67 As this decision does not relate to a matter of procedure, under the current Practice Direction 49E to Part 49 of the Civil Procedure Rules, any appeal must be lodged within six weeks from the date of this decision. That is a prescribed period which the comptroller does not have the power to alter. However, on 1 April 2003 a new Part 63 to the Civil Procedure Rules will come into force and the appeal period will in consequence reduce by default to the 14 days specified in Part 52 of the Civil Procedure Rules, specifically in rule 52.4. This will have the effect of curtailing the period for appealing against the present decision to less than the six weeks at which it currently nominally stands. **The period for appealing against the present decision will therefore effectively expire on 31 March 2003.**
- 68 Furthermore, under the new rules effective from 1 April 2003, the comptroller will no longer have any power to extend appeal periods. An application for extension will instead have to be made to the court. However, the Patents Court has made clear that, unless there are special circumstances, it will look sympathetically on any request to extend to its original length an appeal period which has been truncated by the coming into force of Part 63.

Dated this 3rd day of March 2003

S N Dennehey
Divisional Director, acting for the comptroller

THE PATENT OFFICE