



BL O/109/04

20th April 2004

PATENTS ACT 1977

BETWEEN

Automotive Products UK Limited

Claimant

and

LuK Lamellen und Kupplungsbau Beteiligungs
KG

Defendant

PROCEEDINGS

Application for revocation of Patent No. GB2261923 under Section 72(1) and request to amend under Section 75; Request to amend under Section 27

HEARING OFFICER

G M Rogers

DECISION

- 1 The patent relates to friction clutches, and more particularly to such clutches incorporating wear adjustment devices, and the aim of the invention is to produce an arrangement where the wear adjustment device tends to maintain a substantially constant biasing force from the diaphragm spring.
- 2 The patentees LuK Lamellen und Kupplungsbau Beteiligungs KG (LuK) filed a request to amend their patent under Section 27 on 29 November 2000. Whilst this request was being processed in the Patent Office, an application for revocation was filed by Automotive Products UK Limited (AP) on 27 February 2001. Because the Section 27 action had already reached the stage where the proposed amendments had been advertised in the Patents and Designs Journal (PDJ), LuK opposed a proposal by the Office to stay the Section 27 action until the Section 72 action was resolved, but a stay was eventually put in place following a hearing on 31 May 2002.
- 3 On 5 July 2002 LuK filed a request for amendment of their patent under Section 75. This was opposed by AP and as a result LuK filed further amendments on 15 January 2003. These were advertised in the PDJ and, although AP initially gave notice of opposition to the amendments and sought an extension of time in which to file their grounds of opposition, no grounds were filed, and eventually in a letter dated 14 October 2003, AP indicated that they no longer wished to oppose the application to

amend. They also stated that they wished to withdraw their application for revocation. In a further letter dated 2 March 2004, AP confirmed that their withdrawal of the application for revocation was not conditional on the amendments being allowed under Section 75.

- 4 Thus the situation is now that the request to amend under Section 75 stands unopposed, and the revocation action is terminated. With regard to the request to amend I have to satisfy myself that the proposed amendments are allowable in the sense that they remove the defect they were intended to cure and do not add matter contrary to Section 76. In the case of the Section 72 action, I need to consider whether the withdrawal should be accepted or whether any further action needs to be taken in the public interest.
- 5 Although the amendments submitted on 5 July 2002 (the '02 amendments) were subsequently replaced by further amendments, it is convenient to consider those first, as the final amendments requested (the '03 amendments) can be seen as further amendments to those of 5 July 2002 and in fact incorporate most of the '02 amendments. The '02 amendments resulted in the statement of claim having 22 independent claims, namely, 1-3, 15-20, 23-25, 29-31, 34-40. In their opposition to these amendments, AP raised no objection to the amended claims 1, 3, 15, 17, 18, 20, 23, 25, 29, 31 and 34, since those claims were limited to arrangements in which the adjustment device includes an axially movable swivel bearing for the operating means, and, apart from claim 34, also includes a ring between the clutch housing and the diaphragm spring. I agree with this analysis, and whilst AP stated that their reason for not objecting to these claims was that they no longer had any commercial interest in them, I find that the amendments relating to those claims, which are the same in the '03 amendments, are allowable in that those claims are novel and involve an inventive step in relation to the prior art, and in particular JP3-134318, and GB2019957.
- 6 In their statement opposing the '02 amendments, AP objected to the proposed new independent claims 2, 16, 19, 24, 30 and 35-40. In their statement they allege that claims 2, 16, 19, 24, 30, 35, 38 and 40 lack novelty or an inventive step in the light of the disclosure in JP3-134318 and common general knowledge. They also allege that claim 40 lacks an inventive step in the light of JP3-53628 and common general knowledge. They allege that claims 36 and 39 are obvious in the light of the disclosure in GB2019957 and common general knowledge and that claims 37-39 lack clarity and contain added matter. Finally, they also objected to the amended dependent claims 4-14, 21, 22, 26-28, 32, 33, and 41-45.
- 7 In their '03 amendments, LuK have introduced two additional features into each of the independent claims 2, 16, 19, 24, 30 and 35, 38 and 40, namely that the adjustment means includes a ramp arrangement and that the adjustment inhibiting means includes a wear sensor. In claims 36 and 39, in which the adjustment means is in the form of a ring, they have added the feature that the adjustment inhibiting means includes a wear sensor, and in claim 37 they have added the feature that the adjustment means includes a ramp arrangement. As I have said, these proposed amendments stand unopposed. Therefore I have to satisfy myself that the amendments are allowable in that they do not add any new matter in contravention of Section 76, and that they cure any defect for which they were proposed.

- 8 AP objected that the passage in claim 37 which states that “the adjustment device ensures an at least approximately uniform course of disengagement of the clutch” represented added matter which was not in the specification as filed. However, this passage does not form part of the proposed amendments but was in the corresponding claim as granted, so this is not relevant to the proposed amendments under Section 75. I will return to this issue when I consider the withdrawn application for revocation.
- 9 I am satisfied therefore that all the amendments proposed do not involve any added matter. I have already said that I am satisfied that amended independent claims 1, 3, 15, 17, 18, 20, 23, 25, 29, 31 and 34 are distinguished from the prior art identified. I am also satisfied that independent claims 2, 16, 19, 24, 30 and 35-40 as amended in the ‘03 amendments are also distinguished from the prior art. I therefore find that the amendments submitted on 15 January 2003 are allowable.
- 10 In considering the issue of revocation under Section 72 from a public interest point of view, I will thus do so with regard to the patent as amended under Section 75. I have already determined that as amended, the claims are distinguished from the cited prior art. The only other issues are whether the specification discloses the invention clearly and completely enough as required by Section 72(1)(c) and whether the specification discloses matter which extends beyond that disclosed in the application for the patent as filed as required by Section 72(1)(d).
- 11 I am satisfied that the specification as amended does not contravene Sections 72(1)(c) or (d). I have mentioned above that AP raised objection to the amendments to claims 37-39 on the grounds that they lacked clarity and contained added matter, so I will consider these points specifically. AP suggest that the reference in claims 37-39 to “the clutch pedal being adapted to be operated in the manner of an accelerator pedal” is unclear in that “in the manner of an accelerator pedal” is not understood. One of the features of the invention is that the clutch requires much lower forces to disengage it so much lower effort needs to be applied to the pedal. LuK explain that in their counterstatement that the force required is more akin to that required to depress an accelerator pedal. The latter is usually depressed by pivoting the foot around the heel, whereas conventional clutch pedals are frequently operated by movement of the whole foot. I accept this explanation and am satisfied that a skilled person would reach the same conclusion. Thus I find that the specification is not lacking in clarity in this regard.
- 12 AP suggest that the passage “an at least approximately uniform course of disengagement of the clutch” in claims 37-39 adds matter in that there is no corresponding disclosure in the application as filed. Whilst I can find no corresponding explicit reference in the application as filed, I am satisfied that there are implicit references which provide a sufficient basis for the passage. For example, on page 27 at lines 32-35 there are references to a “constant release point” and on page 30 at lines 25-30 there is reference to “after the adjustment process the disengagement force path again corresponds to the line 49 in Figure 10”.
- 13 I find therefore that there is no need for any action in the public interest, so the withdrawal of the application for revocation is accepted. All that remains is for the

proposed amendments filed on 15 January 2003 to be implemented. They have already been advertised in the Patents and Designs Journal, and apart from the opposition from AP, now withdrawn, no other opposition has been raised. I therefore direct that the file be forwarded to the appropriate section of the Office for the amendments to be effected as soon as the period for appeal has expired, or as soon as any appeal has been finally disposed of.

- 14 I am aware that following the preliminary hearing on 31 May 2002, the hearing officer stayed the Section 27 action that was extant at that time and extended the opposition period to the end of the appeal period following a decision on the Section 72 action. At the time he speculated that his ruling would be academic as he was confident that the Section 27 action would be swept up by the Section 72 proceedings. That has proved to be the case, but for completeness I confirm that the opposition period for the Section 27 amendments will expire as soon as the period for appeal of this decision has expired, or as soon as any appeal thereon has been finally disposed of. I make no further order with regard to the Section 27 proceedings as they have been overtaken by the Section 72 action and more particularly the latest Section 75 amendments.
- 15 Both parties have agreed to bear their own costs in these matters, therefore I make no order for costs.

Appeal

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

Dated this 20th day of April 2004

G M ROGERS

Deputy Director acting for the Comptroller