



BL O/263/04

26 August 2004

PATENTS ACT 1977

BETWEEN

Cartonneries de Thulin S.A.

Applicant

and

(1) Wilson Gunn Gee

Opponents

(2) Hot Form Production S.N.C. di Adriano

Mariotto & C.

PROCEEDINGS

Application under section 27 of the Patents Act 1977
to amend European Patent (UK) number EP 0430956 B2

HEARING OFFICER

P Hayward

DECISION

Introduction

- 1 These proceedings have arisen because a request to amend a patent is being opposed by two other parties. The patent started its life as an application under the Patent Cooperation Treaty and was granted by the European Patent Office on 12 September 1992. The specification is in German. It was amended in the course of opposition proceedings and re-published with amended claims on 2 July 1997. Since then, the patent has been the subject of infringement and invalidity proceedings in the UK courts, in the course of which it was held by the Court of Appeal to be invalid because of added matter introduced in the opposition proceedings before the European Patent Office. This judgment has been reported in [2001] RPC 7.
- 2 The present amendment is intended to remove the added matter identified by the Court of Appeal. It is opposed on the grounds that it would add matter, contrary to section 76(3)(a) of the Act, and would extend the scope of protection, contrary to section 76(3)(b). It should be noted that the present opponents are not the same as the defendants in the original infringement action, who had given an undertaking in those proceedings not to oppose the amendment now being sought.

3 The matter came before me at a hearing on 1st April 2004. The patentee was represented by Henry Carr QC, instructed by Bird & Bird. The first opponent was represented by Thomas Hinchliffe, instructed directly by the first opponent which is, of course, a firm of patent and trade mark attorneys. The second opponent (“Hot Form”) did not appear but had made clear before the hearing that it still maintained its opposition to the amendment. The second opponent’s grounds for opposition are largely covered by the first opponent’s grounds, so I do not need to consider them separately.

The patent

4 The invention concerns a container (“cassette”) for storing two data discs of CD format. The cassette according to the invention has three parts which are hinged together: a “base part” with hinges on two opposite edges, a “cover part” hinged to one of those edges which, when closed, forms with the base part the shell of the cassette; and a “disc-receiving part” which is hinged to the other edge and is, when the cassette is fully folded shut, enclosed within the cover and base parts. The disc-receiving part is provided on each of its two faces with means for securely holding a CD. In its fully closed state the cassette resembles in shape and size a conventional single-CD cassette of the kind often known as a “jewel box”.

5 The only independent claim in the patent, claim 1, reads as follows:

A cassette (1) for storing circular information discs (29) and comprising a base part (2), a cover part (3) and a disc-holding part (4) in which

- the base part (2) is pivotable relative to the cover part (3) by means of a first hinge device (12,17) provided on a first edge (6) of the base part and the disc-holding part (4) is pivotally received by the base part,
- both sides of the disc-holding part (4) respectively have clamp holders (24-27) for a central hole of a circular information disc (29),

characterised in that

- the disc-holding part (4) is pivotally mounted on the base part (2) by means of a second hinge device (18,19) which is disposed on the edge (7) of the base part (2) opposite the first edge (6) comprising the first hinge device (12,17),
- the disc-holding part (4) is pivotable by means of the second hinge device (18,19) by a maximum pivoting angle of at least 80° to an end position in which the disc-holding part (4) comes to abut a pivoting-travel limiter provided in the region of the second hinge device (18,19) and in which **both sides of the disc-holding part (4) are freely accessible for removal of one of the two information discs (29) as desired.**

6 The passage in bold was not present in claim 1 of the patent as granted. It was added

in the course of the opposition proceedings. It is this addition which the Court of Appeal found to be added matter, and the patentee is now attempting to remedy that.

- 7 An amendment identical to that now proposed had originally been sought under section 75 of the Act in the course of the earlier infringement and revocation proceedings, but following the closure of those proceedings, has now been requested under section 27. It involves the removal of the added matter and the insertion of new wording at the very end of the claim. This would result in the final section of claim 1 reading as follows (new wording in *italics*):

the disc-holding part (4) is pivotable by means of the second hinge device (18,19) by a maximum pivoting angle of at least 80E to an end position in which the disc-holding part (4) comes to abut a pivoting-travel limiter provided in the region of the second hinge device (18,19) and in which *the maximum pivoting angle between the disc receiving part (4) and the base part (2) is less than 280E.*

- 8 It goes without saying that it is essential from the patentee's point of view to navigate a course which successfully disposes of the issue of added matter while not re-introducing the objections which arose in the original opposition proceedings before the EPO. There is, however, a third obstacle they must avoid: they cannot extend the protection conferred by the patent as it stood following the opposition.

Initial handling of the present application to amend

- 9 Upon initial receipt, in accordance with normal Patent Office procedures, the matter was referred to an examiner for opinion, who reported that the amendment sought was unacceptable as it incorporated added matter. More specifically, the objection was that although the originally filed application did disclose values for the maximum angle through which the disc-holding part may pivot, there was no implicit or explicit disclosure of a maximum angle of 280E as such.
- 10 In response to this official action, the applicant referred to the judgments of the appeal judges on the earlier infringement and validity action in which Walker LJ had concluded that the angular limitation was in fact a *functional* limitation related to the need to prevent the disc receiving part from turning over to the extent that a disc carried thereon was in danger of being dislodged and falling out, and that this implied an angle in excess of 180E and probably in excess of 270E. The applicant also pointed out that Gibson LJ in his judgment had suggested that a limit to the pivoting angle of between 80E and "say, 280E" would be consistent with the teaching of the specification.
- 11 The examiner rejected this argument, partly on the grounds that the appeal judges had concluded that the reference to free accessibility was itself added matter. However, in accordance with normal practice, the examiner's objection was put on hold whilst the proposed amendment was advertised. This resulted in the lodging of the present oppositions, so the application is now proceeding as an *inter partes* action. As the opponents have picked up all the examiner's objections, I do not need to consider the examiner's view any further.

The law

- 12 The application to amend is made under section 27 of the Act, the relevant paragraphs of which read as follows:

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.

- 13 Section 27(1) makes amendment subject to the provisions of section 76. The relevant part is subsection (3), but I will quote part of subsection (1) as well because that is where the definition of the important expression “additional matter” is found:

(1) additional matter, that is, matter extending beyond that disclosed in the . . . application for the patent, as filed

(3) No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it -

(a) results in the specification disclosing additional matter, or

(b) extends the protection conferred by the patent.

- 14 Amendment under section 27 is a discretionary matter. The patentee must demonstrate that the application to amend was made in good faith, that the request for amendment is justified, and that there are no statutory grounds for refusal. In the present case where the request for amendment arises directly from earlier litigation, it is not in issue that the amendment is necessary and no question of lack of good faith has been raised. This leaves the question of allowability under the two limbs of section 76(3) as the key matter to be tried. The burden of proof to demonstrate allowability of the amendment is on the patentee.

- 15 So far as section 76(3)(a) is concerned, both sides accepted that the correct approach is the threefold one of Aldous J in *Bonzel v Intervention* [1991] RPC 553, namely

(1) to ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly, in the application;

(2) to do the same in respect of the patent as granted;

(3) to compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition. The comparison is strict in the sense that subject matter will be added unless such matter is clearly

and unambiguously disclosed in the application either explicitly or implicitly.

In the present case, of course, in step (2) “as granted” must be replaced by “as proposed to be amended”.

- 16 However, Mr Carr and Mr Hinchliffe put different glosses on this, and Mr Carr in particular referred me to a number of other cases. I will summarise the key points from those cases very briefly. *Southco v Dzus Fasteners Ltd* [1990] RPC 587 establishes that an amendment which has the effect of disclosing a new inventive concept is adding matter, but merely claiming the same invention in a different way is not. In *Assidoman Multipack Ltd v Meade Corporation* [1995] RPC 321 importing a feature from the description into a claim to limit its scope was held not to be adding matter. In *Millikin Denmark AS v Walkoff Mats Ltd and another* [1996] FSR 292 Jacob J (as he then was) warned against allegations of added matter which sought “to construct differences of real substance from mere changes in language or emphasis”. In *Spring Form Inc and another v Playhut Inc* Laddie J rejected an argument that changes in the scope of a claim necessarily added matter. Finally, in *Advanced Semiconductor G1/93* [OJ 1994 541], the Enlarged Board of Appeal of the European Patent Office said that adding an undisclosed feature which limited the scope of protection and which made no technical contribution to the subject matter of the claimed invention should not be considered as added matter as it did not give an unwarranted advantage to the patentee nor adversely affect the interests of third parties.
- 17 The conclusion Mr Carr drew from all these cases is that the correct approach is to understand the invention, or technical contribution, which the application as filed purports to be making, and then decide whether the effect of the proposed amendment is to disclose a different invention, one that was not described either explicitly or implicitly in the application. Mr Hinchliffe said this was wrong. In his view the reference to “relevant to the invention” in the third *Bonzel* test was simply to permit amendments such as acknowledgments of the prior art, something the European Patent Office permits. The “invention” for the purposes of this test is not some general “inventive concept” but what is in the claims, as stated in section 125 of the Act.
- 18 In my view, if one looks at this case law more carefully, neither of these can be regarded as an appropriate generalised statement of the principles that should be applied, and indeed, what really emerges is the importance of looking at the facts of each case. Take *Southco*, for example. It does not support Mr Hinchliffe’s position because it is clear from this case that the third *Bonzel* test permits much more than merely adding a prior art acknowledgement. Equally, it does not support Mr Carr’s position because Aldous J (as he then was) at first instance was not simply identifying some general “technical contribution” but looking in detail at what was claimed and how the amendments in question affected the teaching of the specification in the eyes of the skilled reader. Moreover, whilst the question of whether what was being claimed amounted to a different invention may have been the key issue in that case, the judge does not seem to have regarded this as the only question that might need to be considered, because on page 616 he says:

“There is no definition in the Act of what is meant by the word “matter” and I believe that this word is wide enough to cover both structural features of the

mechanism and inventive concepts.”

This implies that disclosing new structural features can add matter even if the inventive concept remained unchanged, and that must be right. To take the *Southco* invention as an example, the judge held that broadening the word “handle” in the claim to “rotatable actuating means” was not adding matter because the invention remained the same, but I cannot believe he would have been prepared to allow an amendment that added descriptions and drawings of specific alternatives to the handle that had been described, even though the invention in a broad sense would still remain the same.

- 19 This seems fully consistent with *Assidoman*, *Millikin* and *Spring Form*. In *Millikin*, for example, Jacob J said of one amendment that “the skilled man is it told no more about the invention”, and that is not the same as the test Mr Carr wants me to apply. Indeed, the *Millikin* approach tallies very closely with the EPO’s Guidelines for examination, to which Mr Hinchliffe referred me. These state that an amendment should be regarded as adding matter if:

“the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art.”

- 20 I have more difficulty with the approach apparently being advocated in *Advanced Semiconductor* of considering whether the patentee gets an “unwarranted advantage” because this seems to be introducing some sort of public interest test. It may well be that in practice the end result will be much the same, but this decision is not binding on me and I feel it would be wrong for me to prefer this approach over *Bonzel*.

- 21 In summary, in my view the *Bonzel* tests do not lead to the positions taken by either Mr Carr or Mr Hinchliffe. They do not necessarily debar the omission of features from a claim or the addition of features that were not expressly stated previously, but neither do they permit all changes that leave the broad inventive concept undisturbed. It will depend on the specific facts of the case, viewing the changes through the eyes of the skilled addressee.

- 22 Of course section 76(3)(b) is also in issue, but neither side referred me to any case law on this.

Evidence

- 23 The only evidence filed has been by the patentee. This takes the form of an “expert report and statement” of Hermann Grobecker. Mr Grobecker is an engineer in the design department of a German firm “UML”, and his job is the design of CD and DVD packaging. The evidence is unchallenged.

- 24 Mr Grobecker’s evidence is very brief. He sets out his instructions as follows, the comments in italics being mine:

“I refer to third paragraph of page 2 of Exhibit “HG-2” [*the English translation of the original PCT application*], which corresponds to the paragraph beginning at line 21 of page 5 of Exhibit “HG-1” [*the PCT application in German, though the reference to page 5 is clearly an error - he means page 3*]. Bird and Bird have asked me to explain what a person skilled in the design of CD boxes during the late 1980s would understand to be the likely cause of damage that a circular information disc (CD) would face if the disc-receiving part were to turn over completely in the absence of a pivoting-travel limiter.”

25 To understand these instructions, it will be helpful if I quote the relevant passage:

“It has also been found advantageous, for reliable use of the storage cassette, to provide a means for limiting the angle through which the disc-storing part pivots outwards since this reliably prevents the disc-receiving part turning over completely, resulting in damage to the circular information disc. But even a storage case that does not have such a pivoting-travel limiter, generally signifies a reliable saving of space in terms of the aim of this invention.”

I should perhaps add that the disc-storing and disc-receiving parts are one and the same - the different terminology is just a quirk of translation.

26 Mr Grobecker’s short conclusion is as follows:

“It is my view that the skilled person would recognise that in the absence of a pivoting-travel limiter of some kind, a disc-receiving part would have the potential to turn through an angle of almost 360E. . . . It follows that the CD fitted to the upper surface of the disc-receiving part when in the 0E position is in danger of having its edge closest to the disc-receiving part’s hinge pinched against the underside of the base part. If the edge of that CD were to be pinched against the underside of the base part in this way, there is the risk that the CD would be flicked off the spindle that would otherwise clamp the CD to the disc-receiving part.”

27 He adds that the skilled person would not feel limited to applying the ideas disclosed to designs that were based on CD boxes existing before the patent application was filed or published. That additional comment is significant, because one does not need to be a skilled engineer to appreciate that if the pivoting travel limiter were removed from the only embodiment described, the disc-receiving part would still only be able to rotate to about 210E before it fouled the end of the base part. To get rotation to anything approaching 360E one would need a quite different hinge arrangement.

Added matter

28 I must now turn to the question of whether the proposed amendment would add matter. Although both Mr Carr and Mr Hinchliffe relied on the *Bonzel* approach, Mr Carr did not take me through the steps systematically, and whilst Mr Hinchliffe did, many of his submissions were not framed specifically in terms of those steps. However, I don’t feel that mattered because there was no real dispute that in everything hinged on step 1

- ascertaining what was disclosed in the application as filed. Accordingly, I do not propose to work systematically through these steps in my decision, not because I am ignoring *Bonzel* but simply because the outcome speaks for itself once step 1 has been dealt with.

29 It is common ground that an upper limit of 280E for the pivotal range of movement of the disc-holding part is not *explicitly* disclosed in the application as filed. The key question to be determined is whether this limit is *implicitly* disclosed.

30 Mr Carr argued it was. His line of reasoning was as follows.

C The application as filed (in the passage I have just quoted - the “page 2 passage”) states that the purpose of the pivoting-travel limiter is to prevent the disc-receiving part from turning over completely, resulting in damage to the disc.

C The expression “turn over completely” means to turn through an angle as far as it is possible to travel in the absence of a pivoting-travel limiter, which means almost 360E.

C If a disc-receiving part in a cassette box similar to that of the invention were to be allowed to turn over completely, a disc carried thereon would ultimately come into contact with the base part. This would cause the edge of the disc to be pinched and possibly cause the disc to be flicked off, with concomitant risk of damage.

C The angular displacement of the disc-holding part at which the risk of pinching and flicking off becomes significant is “a little beyond 270E”, or “about 280E”.

C Therefore the *explicit* disclosure that the purpose of the pivoting-travel limiter is to prevent the disc-receiving part from turning over completely, resulting in damage to the disc, incorporates an *implicit* disclosure that the maximum possible angular position of the pivoting-travel limiter is 280E.

31 This line of reasoning depends critically on two key interpretations of the application as filed. First that to “turn over completely” does indeed mean to turn through almost 360E, and secondly, that the potential damage to the disc which might result from the disc-receiving part “turning over completely” does mean damage caused by the disc being pinched and flicked off. If both these interpretations are correct, there is then the question of whether the point at which the disc faces a significant risk of being flicked off is indeed 280E.

32 I will first consider the interpretation of “turn over completely”. For his interpretation, Mr Carr relied on the evidence of his expert witness, Mr Grobecker, and on the judgment of the Court of Appeal in the earlier litigation. The evidence, as Mr Carr rightly reminded me, is unchallenged, but it is important to look carefully at what it says, and as Mr Hinchliffe pointed out, Mr Grobecker was not expressly asked to say what the expression “turn over completely” would have meant to the skilled reader of the original patent application. However, Mr Grobecker does say that the skilled reader would have recognised that, in the absence of a pivoting-travel limiter, the disc-

receiving part would have the potential to turn through an angle of almost 360E and I am satisfied that this comment makes no sense unless Mr Grobecker was construing “turn over completely” as rotation to nearly 360E. Accordingly I agree that Mr Grobecker’s evidence supports Mr Carr’s contention.

33 As for the earlier litigation, the expression “turn over completely” had indeed been subject to considerable scrutiny. The judge at first instance had construed it to mean rotation through 180E, but the Court of Appeal had, Mr Carr argued, rejected this interpretation, finding that it meant to turn through almost 360E. This, said Mr Carr, was binding on me. Mr Hinchliffe disagreed, saying that the Court of Appeal had made no binding construction of this expression because the reasoning given in the respective judgments was based on consideration of whether a numerical maximum of less than 180E must be read into claim 1 of the patent as granted, and their lordships’ conclusions on this matter were based at least in part on considerations of free accessibility to both sides of the disc-holding part.

34 I am inclined to agree that, on a strict reading of the judgments, Mr Hinchliffe is right. It is true that Peter Gibson LJ said:

“Although the judge thought the natural meaning of “turning over completely” meant turning through 180E rather than 360E, I have to say that I am not persuaded that this is so”.

However, Robert Walker L J (with whom Brooke L J agreed) made no finding on the meaning of the expression. When Robert Walker L J referred to angles greater than 180E, it was in the context of interpreting the requirement for free accessibility, and that requirement, as Mr Hinchliffe rightly says, was not in the application as filed. Further, their lordships were never asked to construe the application as filed, save in respect of the added matter point. Nevertheless, whilst they may not have made a finding that, in the strict sense, is binding on me, I do not consider that the interpretation of “turning over completely” is affected by the added matter, and I do not feel Robert Walker L J could have arrived at the conclusion he did unless he accepted that this expression envisaged turning through something approaching 360E. Thus I take the view that the Court of Appeal judgment supports the conclusion I have reached on the basis of Mr Grobecker’s evidence, viz that “turn over completely” does indeed imply turning by almost 360E.

35 That takes me to the question of whether the potential damage to the disc envisaged in the original specification was damage caused by the disc being pinched against a part of the cassette and flicked off. Again there nothing about this explicitly in the original specification. As Hot Form put it in its statement of case:

“ . . . there is no hint in the Application that striking the underside of the base part is in any way an issue, or constitutes a relevant cause for the disc falling out. That this is not the implicit reason for the disc falling out can clearly be derived from the much smaller maximum angles proposed as being preferred.”

36 The patentee accepts there is no explicit disclosure of the disc getting pinched but says this is implicit, so I need to look more carefully at what the specification says. The

page 2 passage quoted above is not as clear as it might be because it fails to identify the potential cause of damage. There are, however, other references to potential damage in the paragraphs immediately before and immediately after the paragraph containing this passage. The previous paragraph explains that with a prior cassette design which was opened with a combination of pivoting and sliding movements, there was a risk of a jerk that could cause the disc to fall out and become scratched or otherwise damaged. The subsequent paragraph explains that the risk of falling out is considerably reduced by the hinge arrangement of the present invention - presumably because the simpler, smoother movement reduced the risk of a jerk - and then goes on to say that the protection against falling is "further improved by limiting the angle of opening". On their plain reading, these passages do not seem to be suggesting that the disc is in danger of getting pinched against a part of the cassette. Rather, as Mr Hinchliffe argued, they seem to suggest that the risk is simply that the disc will fall off the holder.

- 37 In support of this interpretation, Mr Hinchliffe relied on findings made in the earlier litigation about the poor design of the central tenons used for retaining discs in place and suggested that this would at the time in question have been understood as the principal cause of discs falling off. The evidence that gave rise to those findings is not before me in the present litigation, but Robert Walker L J says in his judgment that:

"There was ample evidence before the judge that some tenons were badly designed and others became less effective through wear and tear. Where a disc-holder carried a CD on each side, rotation of the disc-holder through 90° made each freely accessible, and continued rotation carried an ever-increasing risk (through the operation of both static and dynamic forces) of the CD being dislodged prematurely and suffering damage."

I also note that Peter Gibson L J alludes to the same point in his judgment, referring to the fact that the greater the angle of opening, the greater the risk of falling "if the tenon fails to perform its function".

- 38 Although Mr Carr had been very keen for me to rely on the Court of Appeal's findings in respect of the meaning of "turn over completely", he was rather less enthusiastic about my relying on their finding (or, strictly, the finding of the court below) that at the relevant time, disc retaining tenons were not wholly reliable. Instead, he urged me to rely on the evidence of Mr Grobecker, who of course said that a skilled person would recognise the likely cause of damage was that the disc would get pinched and flicked off. (I should say that Mr Carr also argued that the judicial statements quoted in the preceding paragraph were not findings of fact but merely recording submissions made by counsel in that case, but that is not the way I read them.)
- 39 Mr Carr did not suggest it was improper for me to take notice of the judicial statements on the reliability of the tenons that were made in the previous litigation, but I need to consider whether I should nevertheless prefer Mr Grobecker's unchallenged evidence. Having looked at that evidence more closely, I find it rather less convincing than it appears at first sight. Whilst Mr Grobecker had read the whole patent specification, he was only asked to say what the skilled person would understand to be the likely damage in the page 2 passage I have quoted above. That he was only looking at the

paragraph containing this passage is perfectly clear from paragraph 12 of his evidence, which commences “I should add that in reading the specified paragraph, the skilled person . . .”. However, construing passages in a patent specification in isolation is always dangerous - they have to be read in the context of the whole document. Mr Grobecker should have been asked to look at all the passages in the specification that refer to damage and then say what sort of damage the skilled person would understand to be envisaged. Had he been asked to do this, I am not confident he would have come to the same answer, because his explanation does not sit very well with the other references to damage being caused by the disc falling out. In particular, the passage saying that the novel hinge arrangement of the invention reduces the risk of falling out makes no sense if the cause of falling out that the author had in mind was pinching of the disc against the base.

40 In short, although Mr Grobecker’s evidence is unchallenged, the question he was asked to address was too narrow. Accordingly, I do not feel obliged to accept it as an authoritative statement of what the skilled person, reading the whole specification, would have understood to be the potential cause of damage. On the contrary, I prefer the finding made in the previous litigation, because that sits much more comfortably with all the references in the specification to damage and falling out.

41 This conclusion is in itself sufficient to break Mr Carr’s chain of logic, but for completeness I will nevertheless go on to look at whether there is any basis in the original specification for the figure of 280E. The figure does not appear anywhere in the original specification, and Mr Hinchliffe suggested that it has, to use his words, been “plucked out of the air”. Nor is 280E mentioned in the evidence, and in fact the earliest document in any of the papers before me where it appears is in the judgment of Peter Gibson LJ at paragraph 67, where he says that:

“ . . . it is hard to see why both sides of the disc-holding part are not fully accessible between a minimum pivoting angle of 80E and a maximum pivoting angle of, say, 280E (though the pivoting-travel limiter may not permit so great an angle)” .

However, the figure is clearly being quoted in the context of discussion about the disc being “fully accessible” at the maximum angle, and since the court found this to be added matter it does not help me in deciding whether there is any implicit disclosure of 280E in the specification as filed.

42 In the only embodiment described in the original specification, the disc-receiving part will hit the stop at little more than 90E. This is reflected in original subordinate claim 3, which says that the maximum angle is “120E, preferably about 80E to 100E”. Hot Form argue that the teaching of the whole specification points strongly towards a maximum angle well short of 280E. Given my conclusion that there is no implicit disclosure of “pinching and flicking” as being a risk, I agree. Thus the proposed amendment adds matter. This finding, I must stress, is not in my view in any way consistent with the Court of Appeal’s judgment, because what they were construing is a specification that taught “full accessibility” at the end point. There is nothing in their judgments to suggest they would have come to the same conclusion if the specification had not included this teaching, and of course the original specification does not.

- 43 Although that disposes of the added matter point, I feel it might be helpful if I briefly considered what conclusion I would reach if I were found on appeal to be wrong on the damage point. In other words, if the skilled reader of the original specification would indeed have recognised that the damage would arise from the disc being flicked off as it contacted the base, would there then be an implicit disclosure of 280E?
- 44 The difficulty the reader of the original specification faces is that, with the construction and hinge arrangement described, one cannot ever get to the position where the disc is in danger of being pinched, even if the travel limiter is removed. The reader is therefore forced to imagine some completely different construction and hinge arrangement which allows this degree of rotation. I do not purport to be an expert in hinges, but I have little doubt that there are numerous possible options. For there to be an implicit disclosure of 280E, the point at which pinching would occur would have to be roughly at this angle for all, or least most, of these options. That seems unlikely, but if true, the onus of showing it is true rests with the patentee, and they have not discharged that onus. In particular, the evidence of the patentee's own expert, Mr Grobecker, makes no reference whatsoever to this angle or anything like it. Thus even if I am wrong on the damage point, I would still conclude that the proposed amendment adds matter.

Extending the scope of protection

- 45 I now turn to the argument from Wilson Gunn Gee that the proposed amendment would extend the protection of the patent, contrary to s. 76(3)(b). The patentee accepts that if the proposed claim includes anything in its scope that is not covered by the current claim 1, then the amendment cannot be allowed. The "current claim" 1 for these purposes is claim 1 of the patent as it stood following the opposition proceedings.
- 46 The arguments advanced in this respect by Wilson Gunn Gee in its original statement were not pursued at the hearing, and instead Mr Hinchliffe put forward two different arguments. The first was to the effect that the Court of Appeal had not established that the upper limit for "freely accessible" was at least 280E. The basis of this argument was that Robert Walker L J (with whom Brooke L J agreed) said it meant "in excess of 180E (and probably in excess of 270E)" but did not say whether the latter meant, say, 275E or something higher. Peter Gibson LJ had mentioned "say 280E" as a possible limit, but his was a minority judgment. Given that the onus was on the patentee to demonstrate clearly that the amendment did not extend the scope of protection, relying on these indefinite statements from the Court of Appeal judges was not, Mr Hinchliffe submitted, sufficient. If the upper limit on a proper construction of the expression "freely accessible" was, in fact, less than 280E, eg 275E, the scope of protection was being extended to the extent that the claim now embraced a range (275E to 280E) that it did not embrace before.
- 47 In my view this argument is splitting hairs and has no merit. It presupposes that the skilled reader could have translated the requirements of the claim as granted into a precise upper figure, but claims are not always amenable to such precise interpretation. It is quite clear that the Court of Appeal judges felt the upper limit for free accessibility

was just a bit over 270E. That inevitably involves a little fuzziness, but that is nothing unusual in a claim. Fuzziness can always be resolved, if considering whether something infringes, by purposive construction. The patentee has translated “just a bit over 270E” into a figure, namely 280E. That translation is, in my view, a reasonable and acceptable one that - if one accepts the judges’ comments - makes no material difference to the scope of the claim when construed purposively. I therefore reject Mr Hinchliffe’s first argument.

48 His second argument was that it was possible to envisage arrangements in which the maximum angle was between 80E and 280E and yet both sides of the disc holding part were not freely accessible at the end point. This could occur, it argued, if the base part was rather thicker than in a normal jewel case, because then the base would prevent the removal of one disc at angles near the upper limit of the range. In this case, the amended claim would be embracing something that was not embraced by the claim as granted.

49 Mr Carr submitted that I should not permit Mr Hinchliffe to put this new argument, pointing out that the patentee had had no time to consider its implications, or what the appropriate response might be. Further, to deal with the argument the patentee might want to obtain further expert evidence. In response Mr Hinchliffe reminded me that although these were proceedings between parties, there was also a public interest involved in the allowance or otherwise of amendments which have a bearing on the validity of a patent. He pointed out that the fundamental objection to the amendment (ie that it extended the scope of protection) had been properly pleaded, and urged me to consider whether it was realistic that the patentee might need to adduce further evidence.

50 Having taken fully into account all the points put to me, I ruled that it would not be right to permit this new argument to be put at the hearing without giving the patentee any opportunity to consider a response. The need to safeguard the public interest does not override the imperative to be fair to both parties, but nor does the latter permit me simply to ignore a matter which appears on its face to be relevant. I did however reject the argument that further evidence was likely to be required. The nature of the question raised made it unlikely that expert evidence would assist in its resolution.

51 The way forward I proposed, and which was accepted by both parties, was that I should proceed to allow Mr Hinchliffe to put his new argument, but that if, having heard both parties, I came to the conclusion that the outcome of the case would turn on this one point, I would allow the patentee a proper opportunity to reply and then rule on that as a preliminary matter before coming to my decision on the substantive question at issue. As it happens, I have found the proposed amendments unacceptable because they add matter, so I do not need to consider Mr Hinchliffe’s argument on extending the scope of protection. However, it might be helpful if I said that, *prima facie*, Mr Hinchliffe does seem to have real point here which, if it were the key issue, the patentee would have to address carefully.

Conclusion

52 I have made no ruling on whether the amendments would extend the scope of

protection, save to reject Mr Hinchliffe's first argument. However, I have found that the proposed amendment would result in the specification disclosing additional matter, contrary to section 76(3)(a), because there is no implicit teaching in the application as filed of a maximum angle of 280E. I have also found that this conclusion is not dependent on how the references in the specification to "damage" are construed. Accordingly I refuse to allow the amendments.

- 53 Sometimes when the comptroller refuses an amendment in section 27 proceedings he gives the patentee an opportunity to have another go with an alternative amendment. The patentee has not asked to be given another chance, and even if it had, I would not have been inclined to give one. This is partly because of the need for finality, bearing in mind that the patent has already been the subject of lengthy court proceedings, and partly because I am at a loss to see what amendment could be proposed that would overcome the problems the patentee faces.

Costs

- 54 The opponents have won and in principle are entitled to a contribution towards their costs. I was not addressed on the question of costs at the hearing, so strictly I cannot make an award until the parties have had a chance to make submissions, should they wish to do so. However, to save what will probably be unnecessary toing and froing, I am going to adopt a pragmatic approach. I can see no obvious reason for departing from the comptroller's usual scale in this case, so I am going to make an award based on that scale. The award will be provisional in that if any party feels it is unreasonable, they will be at liberty to make submissions to me within 28 days. If any submissions are received, the costs award will be stayed so that the other parties can respond to those submissions and I can then reach a more-considered decision on costs. However, if no submissions are received, the costs award will stand, with the costs to be paid within five weeks of today.
- 55 On that basis, and bearing in mind the small amount of evidence, the relatively-short hearing and Hot Form's more-limited involvement in these proceedings, I order Cartonneries de Thulin S.A. to pay Wilson Gunn Gee £1500 and to pay Hot Form Production S.N.C. £700.

Appeal

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

P HAYWARD

Divisional Director acting for the Comptroller