

PATENTS ACT 1977

BETWEEN

Frank Cunningham Requester

and

Nokia Observer

PROCEEDINGS

Request under section 74B of the Patents Act 1977
for a Review of Opinion 11/06 issued on patent number GB 2400958 B

HEARING OFFICER Phil Thorpe

DECISION

Introduction

- 1 This is a review of Opinion 11/06 (“the Opinion”) issued 20 September 2006.
- 2 The Opinion was requested on 26 June 2006 by Mr Frank Cunningham asking whether his patent GB 2400958 B (“the patent”) was infringed by a product made by Nokia known as the Nokia PT-6 Remote Camera (“PT-6”). Nokia filed observations on the request which covered both infringement and validity, and in addition filed a separate request for an opinion on validity. Since the issues of infringement and validity would to a large extent hinge on the construction of the claims, the two opinion requests were consolidated into the one opinion. It is that opinion that is the subject of this review.
- 3 The examiner who issued the Opinion came to the following conclusions:
 - i) the Nokia PT-6 Remote Camera did not infringe any claim of the patent;

ii) Claims 1-5 of the patent were valid but claim 6 was invalid in the light of patent specification WO 03/075242 A1.

4 The prior art referred to by Nokia included patent application WO 03/075242 A1 (“WO’242”), extracts from a user guide for the PT-6, and public disclosures relating to Nokia’s PT-2 Remote Camera, a predecessor of the PT-6.

This Reference

5 On 19 October 2006, the Patent Office as it was then received an application for a review of the Opinion from Mr Cunningham. In this he asserts that claim 6 of the patent is valid and that the PT-6 infringes his claims. The application for a review was advertised by the Office on 22 November 2006. Nokia filed a counter-statement contesting the application on 20 December 2006. On 13 January 2007, Mr Cunningham requested a hearing on the matter.

6 On 19 January 2007 I held a case management conference with both parties with the purpose of establishing the date and venue for the hearing, and to deal with several preliminary issues. After some discussion it was agreed that the hearing would be in Manchester.

7 The hearing was subsequently held on 15 February 2007 at the Asylum and Immigration Centre in Manchester. Mr Cunningham represented himself and was assisted by Mr Ray Clarke, a marketing specialist. Nokia was represented by Ms Rachel Bunn of The Waterfront Partnership and Mr Richard Vary a representative of Nokia.

8 I should add that Mr Cunningham was given a further two weeks following the hearing in which to submit written observations strictly limited to the issue of costs. This he did.

The law

9 Mr Cunningham has requested this review of the Opinion under section 74B of The Patents Act 1977 as amended (“the Act”) and rule 77H of The Patents Rules 1995 as amended (“the Rules”). Rule 77H, governs the making of applications for reviews, and provides as follows:

(5) The application may be made on the following grounds only—

(a) that the Opinion wrongly concluded that the patent was invalid, or was invalid to a limited extent; or

(b) that, by reason of its interpretation of the specification of the patent, the Opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

10 Rule 77J of the Rules governs what action the Office may take at the end of the review procedure, and reads as follows:

(1) Upon the completion of the proceedings under rule 77I the comptroller shall either—

(a) set aside the Opinion in whole or in part; or

(b) decide that no reason has been shown for the Opinion to be set aside.

The scope of the review

11 The Act is quite specific about what aspect of an opinion can be subject to a review. As noted in previous reviews¹, it might be thought odd that provision is made for a review of an opinion at all. After all, opinions under the Act are not binding, and if a person wishes to have an issue resolved, it is usually possible to bring an action before the comptroller or the courts, or to undergo alternative dispute resolution. The rationale for providing reviews is that this option is not always available. This was explained in the consultation document that the Office issued prior to introduction of the opinions service². Paragraphs 33 and 34 of the consultation referred to reviews of opinions on infringement, and read as follows:

33. The patent holder may apply to have an adverse opinion on validity set aside, and this would include an opinion which suggested that the patent was only partially valid. It is important to provide this opportunity since – in the absence of a third party launching revocation proceedings or committing an allegedly infringing act– the patent holder may have no other way of tackling an adverse opinion on validity that he feels is wrong.

34. The patent holder may also apply to have an adverse opinion on infringement set aside, but only where the opinion has come to that adverse view as a result of (what the patent holder believes is) an erroneous construction of the patent specification. Generally speaking, if the opinion has concluded that no infringement is taking place and the patent holder disagrees, he may sue for infringement. This could include the circumstances where the patent holder disagrees with the way that the claims have been construed. But suing for infringement is not possible if the opinion was sought on a potential or hypothetical act, and in such circumstances it would be unfair to deny the patent holder a chance to overturn an infringement opinion based on a construction of the claims which is adverse to him. Thus it is proposed to allow a review of an infringement opinion where the sole issue at stake is the construction of the claims.

12 Although this only envisages reviews where the alleged infringing activity is potential or hypothetical, the wording of the rule admits real activities as well.

13 In this case Mr Cunningham has asked for a review in respect of both an adverse opinion on validity and an adverse opinion on infringement. Whilst the scope of the review in respect of validity is clear, that is not necessary the case for infringement despite the specific way in which the provision is drafted. I shall explain why.

14 Rule 77H (5)(2) requires me to decide whether the opinion wrongly concluded that a particular act did not constitute an infringement of the patent by reason of its interpretation of the specification of the patent. The starting point for my enquiry has to be whether the opinion correctly interpreted the specification. If it

¹ BL O/115/07, BL O/172/07, BL O/078/07, BLO/025/07, BL O/007/07

² Consultation Paper: The Patents Act 2004: Patent Office Opinions And Other Changes To The Patents Rules
<http://www.ipo.gov.uk/consult-patentopinions.pdf>

did then that must be the end of the matter as far as this part of the review is concerned. If the opinion, having properly interpreted the specification went on to wrongly conclude that there was no infringement because, for example, the examiner misunderstood the nature of the alleged infringing act or because he misapplied the law on infringement, then that is unfortunate but not something that can fall within the scope of any review.

- 15 If however I find that the opinion wrongly interpreted the specification, then the question arises of do I need to go further and if so how far? The relevant rule could be construed as meaning that for me to set aside the opinion, or at least a part of it, I need to go on and decide whether as a result of that interpretation, the opinion “wrongly concluded” that an act did not constitute an infringement. It is not enough that the opinion wrongly interpreted the patent: what is required is that as a result of this, the opinion then wrongly concluded that an act did not constitute an infringement. If it did this then the opinion, or at least a part of it, should be set aside. An alternative approach which has recently been adopted³, where the interpretation of the claims was found to be wrong but the conclusion on non infringement was not, was to set aside that part of the opinion covering the wrong interpretation.
- 16 Here Mr Cunningham is arguing that the Opinion wrongly construed the specification and as a result wrongly concluded that Nokia’s PT-6 Remote Camera did not infringe his patent. Nokia however submit that the Opinion was correct in its construction of the claims, but even if it was not and the claims should have been construed as Mr Cunningham argues, then the claims would be invalid on the basis of the prior art available to the opinion examiner. Nokia therefore asks that if I find in favour of Mr Cunningham’s construction that I should go on to consider not only whether the PT-6 infringed the patent as so construed, but also consider whether the patent is valid with that construction. Obviously if I find the patent is not valid then there can be no infringement. To do what Nokia ask would in this case at least, extend the nature of the review quite considerably and would most probably require a further opportunity for the parties to make submissions. In the event for reasons that will become clear this was not something that I needed to do.
- 17 I should add that Mr Cunningham also strongly argued that the Opinion erred in its consideration of Nokia’s claim that even if it was found that the PT-6 fell within the scope of the patent, it would have a defence against infringement under section 64 of the Act. This section reads:

Where a patent is granted for an invention, a person who in the United Kingdom before the priority date of the invention -(a) does in good faith an act which would constitute an infringement of the patent if it were in force, or(b) makes in good faith effective and serious preparations to do such an act, has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent; but this right does not extend to granting a licence to another person to do the act.

- 18 Mr Cunningham submits that comments in the Opinion on section 64 “*attempt to redraw the legal boundaries for everyone in the UK with what is regarded as permissible adjustments [under section 64]*”. He goes on to say that “*This grave*

³ BL O/115/07

error must be corrected by the Patent Office as there would be enormous repercussions for Patent Law” further noting that if the Opinion was accepted it would “set a bad precedent” which “would appear to be officially sanctioned by the Patent Office if people view this opinion on the internet”.

- 19 Nokia submit that this is not an aspect of the Opinion that can be reviewed. I agree for the reasons that I have already set out in paragraph 14. I would however make two points. Firstly, on the question of section 64 the Opinion examiner found that there was insufficient information for him to conclude that Nokia have a justifiable defence to infringement under section 64. Hence section 64 had no bearing on his conclusion of non infringement. Secondly, it is important to note that section 74A(4) clearly provides that opinions are not binding for any purpose; they do not create any form of binding precedent. In addition if the whole or a part of the Opinion remains in place after this review, its status will be unaffected and that it will continue to be non-binding for any purpose.
- 20 Having considered what the scope of the review should be, I turn now to the detail beginning with the patent itself.

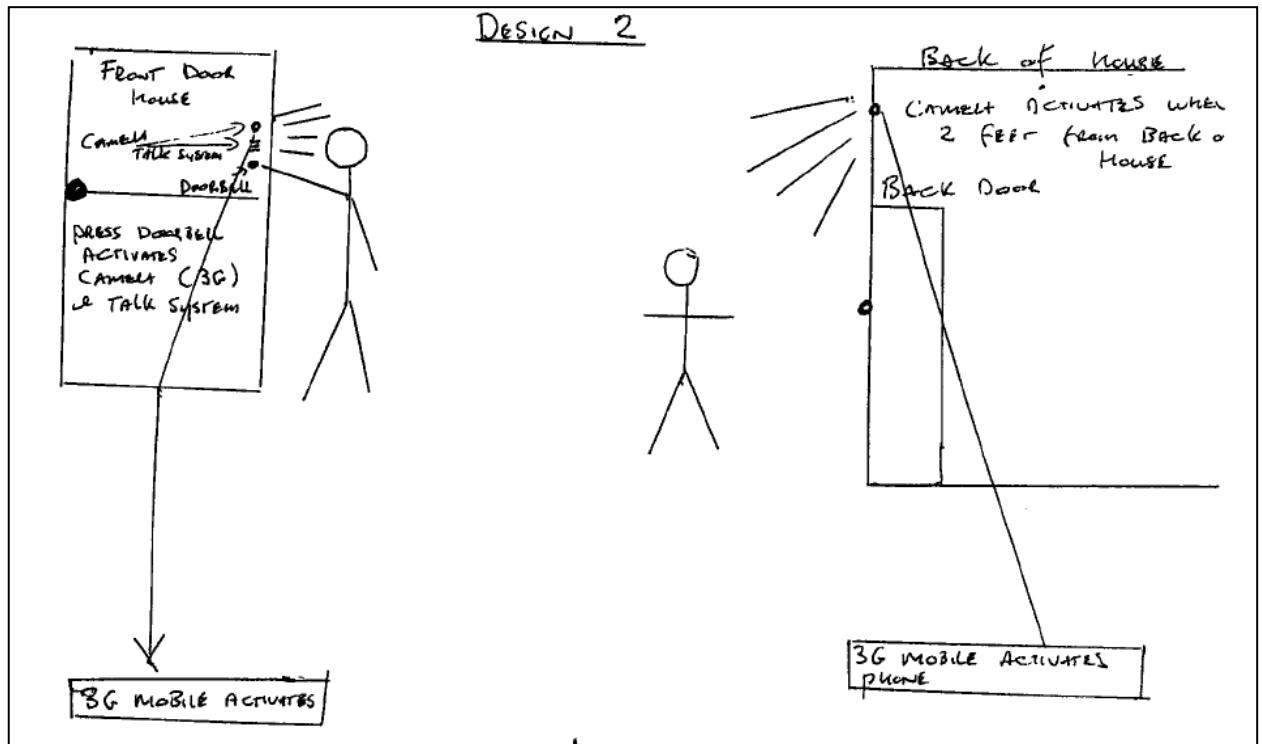
The Patent

- 21 The patent relates to a security system suitable for a house, business or car. The system comprises at least one camera linked to a mobile phone. In use, the camera(s) sends a picture to the mobile phone when activated by a passive infrared (PIR) motion detector or a doorbell. This alerts a user of the phone to the presence of someone at the property or car, and may also allow the phone user to talk to the person who has activated the camera(s).
- 22 The patent application was filed on 23 April 2003 with no claim to priority. The patent was granted on 7 December 2005. It appears that Mr Cunningham drafted the application and prosecuted it to grant without the assistance of a patent attorney. I will discuss whether this has any implications shortly. The application sets out the invention in a single page of description and in two figures which are reproduced here:

“Description

- 1) *A device consisting of a small camera linked to a mobile, built into a back or front door of a house etc.*
- 2) *A type of 3G doorbell / alarm system / security system*
- 3) *It can also be activated if someone comes within feet of your house / business / car. (PIR) or by doorbell itself*
- 4) *A person rings your doorbell. This activates a camera & 3G mobile system which alerts your 3G phone. You can then talk to a person at your front door when you are at work.*
- 5) *You are effectively in when out at all times contactable even by people who do not know your number (mobile).*
- 6) *The security implications are that you give the impression to a potential intruder that someone is at home*
- 5) *Built in camera & mobile (to talk to person)*
- 6) *At work you are notified of person at your door & act accordingly back of house camera alerts your mobile 3G of person close to house / security*
- 7) *It acts as both security device & accessible device to persons wishing to be contacted at all times*

8) Device could be called a 3G doorbell & would be called by this name



23 There are six claims in the granted specification which read as follows:

1. A security system comprising a camera/cameras built into or above the door of a house or other property, the camera/cameras being linked (wireless/mains) and capable of sending picture information to a mobile phone and being activated both by a person pressing a doorbell and a PIR detector
2. A security system as claimed in claim 1 above which the mobile phone can be a 3G mobile phone
3. A security system as claimed in either claims 1 or 2 in which the camera can also be linked (wireless/mains) to a mobile phone that can use PIR or other motion detector that can be set to activate within various parameters even inches
4. A security system as in claims 1 to 3 in which cameras can be provided at both front and back doors of a house or set above the doors and or within the grounds of a property
5. A security system as in any one of claims 1 to 3 where the system can be first set to be activated by a front doorbell or PIR detection or both
6. A security system for a vehicle comprising a PIR detector and cameras, the cameras being activated by the PIR when a person is very close to the outside of the vehicle either to disable the power supply or vandalise and being capable of sending picture information to a mobile telephone.

Scope of Protection

24 At the heart of this dispute, as with many other patent disputes, is the question of the scope of protection provided by the patent. Much of the argument in both the written and oral submissions went to this issue. It is I believe necessary given the nature of Mr Cunningham's arguments to discuss firstly the broad principles regarding determining the extent of protection before looking in detail at the actual patent.

25 I start with section 14 which sets out the requirement of every application for a patent. Section 14(2)(b) provides that every application shall contain-

a specification containing a description of the invention, a claim or claims and any drawing referred to in the description or any claim.

26 Section 14(5) goes on to say:

The claim or claims shall-

(a) define the matter for which the applicant seeks protection

(b) be clear and concise

(c) be supported by the description

....

27 Therefore when drafting a patent application it is important to focus on the claims since it is the claims that define the scope of protection. A skilful drafter of a patent application will typically seek to obtain the maximum scope of protection for the invention being disclosed. This he would do by initially drafting broad claims. The patent examiner, as part of the examination process, may object that the claims are anticipated by prior art or that they do not meet other requirements for example those set out in subsections 5(b) and (c) of section 14 referred to above. The applicant, or usually his attorney, will then redraft the claims often limiting their scope and this process will continue until the examiner is satisfied that the specification including the claims meets all the requirements. At that point a patent will be granted. It is I believe important to stress that the examiner is not concerned with the question of whether the claims could have been drafted more broadly as that is a matter for the applicant alone.

28 So it is clear that the claims define the invention for which protection is sought. But how do you decide what the claims mean? This is where claim construction comes in. The leading authority on this is the House of Lords decision in *Kirin-Amgen*⁴ which both sides relied on.

29 In this case, Lord Hoffman sets out in great detail how the way claims are interpreted has developed over the years in the UK and elsewhere. He identifies the relevant legal provisions that are relevant today and it is, I think useful for me

⁴ *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] R.P.C. 9

to repeat them here. The most important is section 125(1), which specifies that

For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

- 30 It is important to note that this section again brings out the importance of the claims. This section gives effect to Article 69(1) of the European Patent Convention (“EPC”) which reads:

The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

- 31 The extent to which the drawings and description should be used to interpret the claims was further clarified in the “Protocol on the Interpretation of Article 69” which reads:

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

- 32 The Protocol is given effect in the UK by section 125(3) which in turn reads:

The Protocol on the Interpretation of Article 69 of the European Patent Convention (which Article contains a provision corresponding to subsection (1) above) shall, as for the time being in force, apply for the purposes of subsection (1) above as it applies for the purposes of that Article”.

- 33 So what does all this mean? The judgment in *Kirin-Amgen* builds upon the ‘purposive approach’ to claim construction first introduced in *Catnic*⁵, where Lord Diplock stated

“A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge”.

- 34 In *Kirin-Amgen*, Lord Hoffmann held that purposive construction does not mean that one was extending or going “*beyond the claims to what, on the basis of the specification as a whole, it appears the patentee has contemplated*”. Rather he noted that “*the language chosen was usually of critical importance, with the*

⁵ *Catnic Components Ltd and another v Hill and Smith Ltd* [1982] RPC 183

specification being a unilateral document in the words of the patentee's own choosing, usually chosen on skilled advice".

- 35 Thus Lord Hoffman summarized that when applying a "purposive construction", the question is always **what the person skilled in the art would have understood the patentee to be using the language of the claim to mean.**
- 36 In this case however, as Mr Cunningham notes, the wording of the specification was not chosen on skilled advice and I mean that as no disrespect to Mr Cunningham. Rather what I mean is that a patent attorney who is skilled in drafting patent applications was not employed. I should stress that it is not necessary to employ such an attorney when applying for a patent and that a significant number of applications are filed without the use of such an attorney. The Office does nevertheless advise unrepresented applicants to seek advice from a patent attorney. There are a number of reasons however why attorneys are not used; cost being among these, and Mr Cunningham has alluded in his submissions to some of the reasons behind his decision.
- 37 Hence the patent is based on Mr Cunningham's own initial efforts augmented by exchanges between the examiner and Mr Cunningham during the examination of the patent. But does the fact that the patent was drafted without such skilled advice have any bearing on my decision here? The specification as a whole is clearly not as extensive as it might have been. Nor are the claims as clear. However that does not alter the approach that I must take when interpreting the claims although it does perhaps make that task more difficult. The correct approach is as already mentioned a purposive approach where I need to decide what the person skilled in the art would have understood the patentee to be using the language of the claim to mean. That is what I shall now do.

Arguments and submissions on construction

- 38 I shall begin by outlining Nokia's submission since they concur with the approach and conclusions of the Opinion examiner. Nokia submit that the examiner correctly construed the claims and that there is no infringement of the patent by the PT-6 since the PT-6 is not capable of being activated by a doorbell. Further, they submit that the examiner correctly concluded that claim 6 was invalid in the light of WO'242.
- 39 Nokia also argue that Mr Cunningham is seeking a construction of the claims that goes beyond that which *Kirin-Amgen*, section 125(1) of the Act, and the Protocol to Article 69 would allow.
- 40 Nokia submit that if a broad construction is adopted, as apparently favoured by Mr Cunningham, I should reassess the claims against the previously submitted prior art to determine whether the claims are valid.
- 41 I turn now to the submissions presented by Mr Cunningham. At the hearing Mr Cunningham brought together the various arguments presented in his observations accompanying the application for review, as well as those raised in his skeleton argument submitted 6 February 2007 and other correspondence

received prior to the hearing. Mr Cunningham presented his arguments with passion and conviction.

42 On construction, Mr Cunningham's argues that "*the examiner although mentioning the purposive approach to construction has in effect used the old method and the old English rules*" when construing the claims of the patent. He submits that the examiner was wrong to state that claim 1 requires all of the cameras to have as he puts it "*the doorbell feature*", i.e. to be activated by a doorbell. He argues that the examiner's construction ignores claim 3 which refers to a camera "*having PIR or motion detection*".

43 With regard to the placement of the camera(s) in claim 1, Mr Cunningham argues that the examiner did not look at the claim through the eyes of a skilled person and was therefore wrong to conclude that the locations specified in the claims were essential. Furthermore, Mr Cunningham submits that the examiner was wrong to construe the cameras in claim 4 as being additional cameras to those in claim 1.

44 Mr Cunningham would clearly like a different interpretation of claim 1 to be taken and in the observations accompanying the application for the review offers one possible construction:

A security system comprising a camera above the door of a house and activated by PIR and capable of sending picture information to a mobile phone.

45 Although Mr Cunningham has not provided me with any other alternative wording of claim 1, I believe, based upon the arguments presented, that one other possible interpretation he favours would be along the lines of:

A security system comprising cameras built into or above the doors of a house or other property, the cameras being powered (battery/mains) and capable of sending picture information to a mobile phone, with at least one camera being activated by a person pressing a doorbell and at least one camera by a PIR detector.

46 Turning to the examiner's construction of claim 6, Mr Cunningham argues that despite the examiners statement to the contrary, the drawings and description would enable claim 6 to be construed as defining a security system for a vehicle which may comprise just a single camera.

47 At the hearing Mr Cunningham referred to his previous experiences as a car mechanic, and explained that underneath a car there are many obstacles, such as catalytic converter boxes, exhaust boxes and all sorts of other elements which could obscure a single camera. According to Mr Cunningham, it is because of these obstacles that claim 6 specifically refers to "cameras". However, referring me to The Protocol on the Interpretation of Article 69 of the EPC, and Lord Hoffman's comments in *Kirin-Amgen*, Mr Cunningham argues that with ambiguity in the claim, the skilled person, taking into account claim 1, the description and the drawings, would conclude that claim 6 could be construed as covering a

single camera system. Taking into account the arguments presented I believe Mr Cunningham would like Claim 6 to read:

A security system for a vehicle comprising a PIR detector and one or more cameras activated by the PIR detector detecting a person close to the outside of the vehicle, the one or more cameras being capable of sending a picture to a mobile phone.

48 To further support this interpretation of claim 6, Mr Cunningham has refers me to Lord Hoffman's comments regarding particular terms and phrases in claims for which there is no accepted definition. According to Mr Cunningham, his claim is defining something new for which there is no accepted definition.

49 Mr Cunningham also argues that the examiner misapplied the teachings in two further cases: *Telsonic's Patent*⁶ and *Rosedale Associated Manufacturers Ltd v Carlton Tyre Saving Co Ltd*⁷. Mr Cunningham appears to be using these references to demonstrate that when purposively construing the claims, the test is to consider what a "person skilled in the art" would have understood the patentee to be using the language of the claim to mean rather than looking at the claims from the view of the "general public". I cannot however find anything in the Opinion that would lead me to conclude that the examiner has not applied the correct test in this respect. Indeed the reference by the examiner to *Telsonic* was by way of rebutting an attempt by Nokia to rely on the pre-grant file to support its interpretation of the claims. I believe that I need say no more about these two cases.

Interpretation – the Opinion

50 So did the Opinion misinterpret the claims?

51 Before I can reach a decision on that, I think it necessary for me to put the claims into context so that I can place myself in the position of a skilled person and attempt to understand what the patentee meant the language of the claims to mean. This understanding will then allow me to decide whether the examiner's interpretation is correct or not.

52 Turning to the description, I am presented with eight short statements instead of the detailed description that one might expect in an application for a patent. From the description I find that the application relates to a "device" which might be referred to as a "3G doorbell", an alarm system or a security system. As set out in the description, the device comprises a camera (singular) that is linked to a mobile phone and which can be used to protect your house, business or car. The camera is apparently capable of being activated by a PIR detector or a doorbell and upon activation links up with the mobile phone to allow the phone user to talk to the person who has activated the camera. The sixth statement of the description reads:

⁶ *Telsonic's Patent* [2004] RPC 38

⁷ *Rosedale Associated Manufacturers Ltd v Carlton Tyre Saving Co Ltd* [1960] RPC 59

“At work you are notified of person at your door & act accordingly back of house camera alerts your mobile 3G of person close to house / security”.

- 53 From this statement I understand that a second camera may be used in addition to a camera mounted at the front of a property. This second camera would be located at the rear of a property.
- 54 Turning to the figures, I find that one drawing shows a camera for use with the front door of a property. The drawing is annotated to inform the reader that the camera is activated by a doorbell. I understand this drawing to illustrate the single camera system described in statements 1 to 5. In the second drawing, I find a camera mounted over a back door with an annotation informing the reader that the camera is activated when a person comes within 2 feet of the house. It is not clear from the drawing how the camera is activated but given that the camera is located above the door and that no doorbell is illustrated, I believe that activation would be by a PIR detector. It is unclear whether the drawings are intended to show a single camera system or a two camera system but with reference to statement 6 of the description, I understand the second drawing is illustrating the second camera of a two camera system.
- 55 I turn now to paragraphs 17 to 20 of the Opinion in which the examiner explains how he arrived at the interpretation given to claim 1.
- 56 The examiner begins by considering the passage *“activated both by a person pressing a doorbell and a PIR detector”*, then moves on to consider the passage *“camera/cameras built into or above the door”*, and finally the passage *“the cameras being linked (wireless/mains)”*.
- 57 The passage *“activated both by a person pressing a doorbell and a PIR detector”*, was construed by the examiner to mean that a ‘something’ has the capability to be activated by both a signal from a doorbell and from a PIR detector although not necessarily by both means at the same time. He also concluded that actually having a PIR detector and doorbell present is not necessarily part of the claimed invention.
- 58 The examiner finds no reason to depart from a normal understanding of the words *“built into or above the door of a property”*. In particular he was not persuaded by Mr Cunningham’s argument that this was merely an option or suggestion. The phrase *“the camera/cameras being linked (wireless/mains)”* is interpreted by the examiner to mean that if there is more than one camera, they are linked in any material way. If there is only one camera then the phrase in his opinion imposes no limitation.
- 59 The examiner goes on to conclude that, on a proper construction, Claim 1 requires a security system comprising at least one camera built into or above a door of a property, capable of being activated by a PIR detector and capable of being activated by a doorbell to send a picture to a mobile phone, but not necessarily having a PIR detector and doorbell as part of the invention.

- 60 I shall discuss whether each camera must have the ‘capability’ of being activated by either the doorbell or PIR detector shortly but before I do so I shall first consider the location of the “camera/cameras” and what is meant by “linked (wireless/mains)”. Claim 1 says that the camera/cameras are “*built into or above the door of a house or other property*” [emphasis added] which clearly implies just a single door. I think however, that a skilled person, having considered the drawings and description would deem the word “door” to also means “doors” as the application clearly contemplates a system for the front and back of a property, and there is no suggestion that two cameras are to be mounted within or above a single door. Mr Cunningham argues that dependent claim 4 in referring to cameras mounted within the “*grounds of a property*” supports a much broader interpretation of claim 1. I do not believe that this argument is well founded. Indeed in the absence in the description, or indeed anywhere else, of any support for such an interpretation, any ambiguity arising from claim 4 would be resolved by treating the claim as merely adding flesh to the bones of claim 1. In other words it would be construed as adding to claim 1 as properly construed rather than as an invitation to construe claim 1 in a way that has no proper basis in the application.
- 61 Claim 1 clearly contemplates a system comprising a single camera or more than one camera. Claim 1 goes on to specify that “*the camera/cameras being linked (wireless/mains) and capable of sending picture information to a mobile phone*”. The opinion examiner only looked at the words “*linked (wireless/mains)*” within this passage and concluded that this means that if there is more than one camera, then the cameras are linked in *any* material way. I can see the logic in this interpretation but must also consider the alternatives offered by Mr Cunningham.
- 62 Mr Cunningham asserts that it was quite clear that in this part of the claim he was attempting to say that the, or each, camera is powered either by battery means (wireless) or via cable means (mains). The whole of this argument seems to rely on the word “mains” and that this would lead a skilled person to the conclusion that the passage is referring to power supply. I am not persuaded by this argument and, having carefully examined the specification, noting especially the use of the word “linked” in the description and also the absence of any reference to “(wireless/mains)” in the application as filed, I find myself coming to an interpretation that differs slightly from that reached by the examiner. I am of the Opinion that the linkage that is being referred to in the description is that between the camera/cameras and what is described as a “mobile” or “3G mobile system” which is part of the system and which is capable of sending picture information to a mobile phone. I believe that this interpretation has sufficient support in the description to enable me to use it to resolve the ambiguity that clearly exists in the granted claims. I should stress that this interpretation would cover a system where the “camera” and “mobile” or “3G mobile system” were part of the same device for example a mobile 3G phone with camera. In the event, I do not think that anything turns on this particular feature of the claim.
- 63 I return now to the activation of the camera(s) of the system. The examiner was of the opinion that the system comprises at least one camera, wherein the at least one camera must be capable of being activated by either a PIR detector or

doorbell. This does not mean that the camera, in use, is connected to both a PIR detector and a doorbell, but it must have the 'capability' of being activated by both. The construction given in paragraph 20 is also open to alternative interpretations since it is unclear whether it is the 'system' or the 'camera' that must be capable of being activated in the specified manner, however, having regard to the comments made in paragraph 17, I am satisfied that it is the activation of the camera that is being referred to.

64 In my opinion, this interpretation of "*the camera/cameras... being activated both by a person pressing a doorbell and a PIR detector*" would sit comfortably with a claim to just a single camera system. This would allow the single camera to be sited at the front of a property and linked to a doorbell, or alternatively sited at the rear of the property and linked to a PIR detector.

65 In relation to a claim to a system having more than one camera I can also see benefits in having a single design of camera that can be placed in various locations and connected to the most appropriate source of activation; which might be the doorbell at the front of the house or a PIR detector at the back. Whilst it is of course possible to envisage a system similar to that set out but having different designs of camera for the various locations each being activated only by one source, the simple fact is that such a system is neither clearly disclosed nor more importantly claimed. I must therefore take the claim at face value and conclude that the examiner's interpretation in this respect is correct.

66 Thus, I believe claim 1 should be interpreted slightly differently to how it was in the Opinion so as to read:

A security system comprising one or more cameras built into or above the door(s) of a property, each camera in the system being capable of being activated by a PIR detector and also by a doorbell, the camera/cameras being linked to a device that, upon the camera/cameras being activated, is capable of sending picture information to another phone.

67 I turn now to claim 6. The first thing that strikes me is that in claim 1, Mr Cunningham specifically refers to "*camera/cameras*" and thus clearly contemplates a system having just one camera or a system with more than one camera. He had the opportunity use exactly the same wording in claim 6 but chose to restrict the claim to a system with "*cameras*". The second thing that strikes me is that with one exception the claim makes linguistic and technical sense, and, significantly, there are two separate references to "*cameras*". The only part of the claim that is in any way ambiguous in terms of how it might impact on the scope of the claim, is the part that seems to be referring to the intent of the person who is very close to the outside of the vehicle. Mr Cunningham's argument that this part of the claim did not impose any restriction on the claim was accepted by the Opinion examiner. I believe that was correct and I too accept that this part imposes no limitation on the scope of the claim.

68 I can find no further ambiguity in this claim and I find its meaning no different when I look at the supporting description and drawings, which I might add, are noticeably silent on this aspect of the invention. I accept Mr Cunningham's

argument that claim 6 is attempting to define something new, namely a security system for a vehicle, but the components within the system and the words used to define those components are quite conventional. Therefore, whilst Lord Hofmann's comments regarding references to things for which there are no known definitions, offer me assistance, I do not find that they lead me to an alternative interpretation of claim 6. It is clear to me that a skilled person who has read the single page description and noted the security system illustrated in the figures, would ultimately take the words of claim 6 at face value, with no alternative meanings being applied. In conclusion, I believe that the examiner correctly construed claim 6.

- 69 The remaining claims, claims 2-5, are specified as being dependent on claim 1. By virtue of their dependency these claims are taken to build upon the invention set out in claim 1 rather than taking away or replacing features of claim 1. In other words these dependent claims add to the system set out in claim 1. I will need to consider these only if I find claim 1 to be infringed.
- 70 Having properly construed the independent claims I need now to go on and review the Opinion's finding in respect of the validity of claim 6 and the non-infringement of the claims. I will start with the issue of validity.

Validity of claim 6

- 71 The Opinion found that claim 6 was anticipated by WO'242. Again I must stress that as this is a review of the Opinion I need only consider whether this particular claim was anticipated by this document. It is not necessary for me consider in respect of validity the other disclosures considered by the Opinion examiner, for example those relating to the PT2 or PT6 systems. There was some discussion at the hearing as to whether WO'242 was describing the PT-6, the PT-2 or something else. That is not however relevant. What matters is whether WO'242 on its own anticipates claim 6. I should add also that I do not need to consider at this stage the validity of the other claims as none of these were found to be invalid.
- 72 Mr Cunningham puts forward a number of reasons why he believes the examiner was wrong to find claim 6 anticipated by this document and I will consider each in turn. The first is that WO'242 is not citable under section 2(3) of the Act because:
- (i) the matter contained WO'242 as filed was not the same as published and therefore one of the requirements of section 2(3) has not been met;
 - (ii) WO'242 fails to provide an enabling disclosure.
- 73 To support his argument that the content of WO'242 as filed was not the same as published, Mr Cunningham points to the different wording found in an equivalent US patent application and differences between WO'242 and the features of the PT-6 and the PT-6's predecessor, the PT-2 (both of which are allegedly embodied in the patent application). At the hearing Mr Cunningham also questioned how closely WO'242 resembled its priority document.

74 All of these arguments are however based on a misunderstanding of this part of section 2(3). Although I sought to explain this at the hearing, I believe it is necessary for me to discuss this section in a little more detail.

75 In very basic terms, section 2 deals with novelty with section 2(1) stating that an invention shall be taken to be new if it does not form part of the state of the art. Section 2(2) and (3) then go on to discuss what comprises the state of the art with section 2(2) applying to all citable matter, including patent specifications (granted or not) made publicly available **before** the date of filing of a given patent application. Material in the section 2(2) filed can be used to demonstrate that an invention lacks novelty and/or an inventive step.

76 Section 2(3), which is of interest here, reads as follows:

The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say –

(a) that matter was contained in the application for that other patent both as filed and as published; and

(b) the priority date of that matter is earlier than that of the invention.

77 The reference to “application for a patent or a patent” covers the following⁸:

(a) UK applications made under the Patents Act 1977 and which have been published under section 16;

(b) UK patent specifications published under the 1949 Patents Act;

(c) applications for European patents (UK) which have been published by the European Patent Office under article 93 EPC (see also (e) below);

(d) international applications for patents (UK) which have been published by WIPO under article 21 of the PCT and which have entered the national phase (that is, the national fee (if any) has been paid and, if the application is in a foreign language, an English translation has been filed at the Office);

(e) international applications for European patents (UK) which have been published by WIPO under article 21 of the PCT and which have entered the regional phase (that is, the national fee has been paid and, if the application is in a language other than English, German or French, a translation into one of those languages has been filed at the European Patent Office).

78 The reference to an “application for a patent” in this section makes it clear that to be citable under section 2(3) it is not necessary that a patent has been granted, merely that an application for the patent has been published.

79 So for the purposes of s2(3)(a) what is important is not any differences between related applications but any differences between the patent application that is being considered as prior art, when it was filed and when the same document

⁸ See Section 2.30 of the Manual of Patent Practice at <http://www.ipo.gov.uk/practice-sec-002.pdf>

was published. As I pointed out to Mr Cunningham at the hearing, patent applications are typically published “as filed”. This means the document that is published is identical to the document as filed by the applicant. The only exception to this is that the published document may also include later filed amended claims alongside the originally filed claims. In the case of international applications such as WO’242, the content of the application is governed by Rule 48 of the Regulations under the Patent Cooperation Treaty (PCT). Rule 48(2)(f) in particular states:

“If the claims have been amended under Article 19, the publication of the international application shall contain the full text of the claims both as filed and as amended.”

- 80 Thus, under the PCT, the only changes to a PCT application that will be published are amendments to the claims; even then the original claims will still form part of the published specification.
- 81 The fact that the US patent application that is equivalent to WO’242 has claims of a different format or a different description is irrelevant to section 2(3)(a). Also irrelevant is the Finish priority document. This is because the filing date of WO’242 is before the filing date of Mr Cunningham’s patent hence it is not necessary to rely on the priority date for WO’242 to be citable under section 2(3).
- 82 For section 2(3)(a) to apply it is necessary for Mr Cunningham to show that the matter contained in the originally filed application for WO’242, which according to the front page⁹ was filed in English, is different to that in WO’242 as published. I do not believe that Mr Cunningham has shown that it is and therefore I must conclude that the examiner was right to consider the document as a potential citation under section 2(3).
- 83 I turn now to the next strand of Mr Cunningham’s arguments in relation to this document; namely that it does not provide an enabling disclosure. It is well established and accepted by both sides that the novelty of a claim can only be challenged if the anticipating material, whether it be a patent specification or something else, provides an enabling disclosure. Mr Cunningham argues that WO’242 fails to provide the necessary enabling disclosure and thus cannot be used to attack the novelty of claim 6.
- 84 The issue of anticipation was considered recently by the House of Lords in *SmithKline Beecham Plc’s (Paratoxetine Methanesulfonate) Patent*¹⁰. A copy of this case was made available to Mr Cunningham by Nokia immediately before the hearing. Mr Cunningham has queried whether the lateness of this constitutes acceptable behaviour. I will return to that later when I discuss the issue of costs. In the event it quickly became clear at the hearing that there was common ground on the need for an enabling disclosure hence it was not necessary to refer in detail to this case. Whilst both sides were content to accept that an enabling disclosure is required, there was less agreement as to what the expression

⁹ See under heading “(25) Filing Language” on front page of WO 03/075242 A1 available at <http://v3.espacenet.com/origdoc?DB=EPODOC&IDX=WO03075242&F=0&QPN=WO03075242>

¹⁰ *SmithKline Beecham Plc’s (Paratoxetine Methanesulfonate) Patent* [2006] RPC 10

“enabling disclosure” meant. Mr Cunningham in particular seemed to have misunderstood the requirement and although I again sought to explain it to him at the hearing I think for completeness, and hopefully to remove any lingering misunderstandings he may still have, I will briefly explain it again here.

- 85 Put simply, and considering for example a patent specification, a disclosure is enabling if it is sufficient to enable a skilled person to perform the invention set out in that specification. The difference between disclosure and enablement is more apparent in high technology inventions in for example the field of pharmaceuticals (as in the case referred to above). In the case of low-tech inventions, the simple disclosure of the invention in the patent is often enough to enable the skilled person to perform it. I should stress that in considering the question of enablement, it is the invention in the prior art that needs to be enabled by the disclosure in that prior art and not the invention in the patent against which the prior art may be cited.
- 86 In the case of WO’242, I have read the whole specification carefully and am satisfied that the disclosure in that application would enable a skilled person to perform the invention set out in that application. WO’242 does provide an enabling disclosure.
- 87 I need now to consider whether the Opinion was correct in finding that WO’242 discloses the invention set out in claim 6. For WO’242 to do this it must disclose subject matter which, if performed, would necessarily result in infringement of that claim. In his written submissions and at the hearing Mr Cunningham repeatedly referred to the need for the prior art to “plant a flag”. As acknowledged by Mr Cunningham this expression emanates from the decision by the Court of Appeal in *General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited*¹¹ where Sachs LJ stated:

"If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated. The prior inventor, however, and the patentee may have approached the same device from different starting points and may for this reason, or it may be for other reasons, have so described their devices that it cannot be immediately discerned from a reading of the language which they have respectively used that they have discovered in truth the same device; but if carrying out the directions contained in the prior inventor's publication will inevitably result in something being made or done which, if the patentee's patent were valid, would constitute an infringement of the patentee's claim, this circumstance demonstrates that the patentee's claim has in fact been anticipated"....

"If, on the other hand, the prior publication contains a direction which is capable of being carried out in a manner which would infringe the patentee's claim, but would be at least as likely to be carried out in a way which would not do so, the patentee's claim will not have been anticipated, although it may fail on the ground of obviousness. To anticipate the patentee's claim the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented ... A signpost, however clear, upon the

¹¹ *General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited*¹¹, [1972] RPC 457

road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee".

88 So does WO'242 plant a flag on the invention as defined by claim 6? This claim as properly construed requires the following:

A security system for a vehicle comprising a PIR detector and cameras, the cameras being activated by the PIR when a person is very close to the outside of the vehicle and being capable of sending picture information to a mobile telephone

89 Mr Cunningham argues that WO'242 does not disclose certain aspects of the system claimed in this claim. In particular it gives no indication that any aspect of the system is wireless nor is the invention in WO'242 suitable for use outdoors. He bases this last assertion on the presence in WO'242 of what he refers to as a "temperature backup" and the absence of any form of outside weather shield. I would add that Mr Cunningham is using the term "wireless" I believe to mean that the device is not mains powered but rather battery powered.

90 I am not persuaded by any of these arguments for the simple reason that none of the features that Mr Cunningham argues is lacking in WO'242, is an essential feature of the invention set out in claim 6. Again Mr Cunningham has misunderstood that it is the invention as actually set out in claim 6 that is being considered. Claim 6 is entirely silent on how the system is powered – it is not therefore necessary for anticipation to show a particular mode of powering the system such as by battery. Equally the claim does not explicitly require the system to be waterproof. Whilst Mr Cunningham might only have had in mind a waterproof system; that is not what he has claimed. The wording of the claim, as recognized by the examiner, extends to cover systems that may or may not be waterproof. And for the purpose of anticipation it is necessary only that the prior art plants it flag somewhere within the scope of the claim. It is not necessary for the prior art to disclose everything falling within the claim.

91 I am therefore not persuaded by Mr Cunningham's arguments. I still need however to ensure that WO'242 does actually disclose something falling within the scope of claim 6.

92 WO'242 clearly discloses, in for example, paragraphs [0047] to [0050] a surveillance system that comprises one or more cameras that can be activated by an infra red detector and which according to the description can be located to monitor, for example, a pleasure boat, a car or a garage. Upon activation, picture information is sent from the camera(s) to a portable videophone (multimedia phone). I am therefore satisfied that this document discloses all the features of claim 6 and consequently if put into practice would infringe claim 6. Consequently the disclosure is an anticipating disclosure that destroys the novelty of claim 6 - it does plant a flag on the invention set out in claim 6.

93 I am therefore satisfied that the Opinion was correct to find claim 6 invalid.

Infringement

- 94 I turn now to the question of infringement. As I discussed in the section entitled “Scope of review”, if I find that the Opinion’s interpretation of the claims was correct then I do not need to say anything further on infringement. That is the case with claim 6. However in my consideration of the interpretation of the claims I found that the examiner has misinterpreted an aspect of claim 1 – the meaning of the word “linked”. As such I need now to go on and consider whether this resulted in the Opinion wrongly concluding that there was no infringement of the patent by the PT6 system. That consideration can however be very brief. This is because the Opinion examiner did not consider the word “linked” as limiting the scope of the claim in any material way. Hence he favoured a slightly broader interpretation of claim 1 (although in practice there is probably very little between his interpretation and mine). However even with this broader interpretation he did not find the PT 6 to be infringing essentially because he found that the PT6 is not capable of being activated by a doorbell - this being something on which the parties agreed then and still agree now. Since I have also construed the system of claim 1 as requiring the capability of being activated by both PIR and a doorbell, it follows that the claim as interpreted by me is not infringed. It follows also that claims 2-5, all of which are dependant on claim 1, are not infringed.
- 95 I am therefore satisfied that the Opinion correctly found none of the claims to be infringed.

Costs

- 96 Having dealt with the substantive issues and found in favour of Nokia, I now go on to the issue of costs. Both sides have provided me with submissions – Nokia at the hearing and Mr Cunningham shortly afterwards.
- 97 Rule 77H refers to a review as “proceedings” and in that context proceedings are defined as proceedings before the comptroller. Accordingly it is appropriate that I should follow the standard procedure adopted in such proceedings when considering the issue of costs.
- 98 It is long-established practice for costs awarded in proceedings before the comptroller to be guided by a standard published scale¹². The scale costs are not intended to compensate parties for the expense to which they may have been put but merely represent a contribution to that expense. This policy reflects the fact that the comptroller ought to be a low cost tribunal for litigants, and builds in a degree of predictability as to how much proceedings before the comptroller, if conscientiously handled by the party, may cost them.
- 99 However as is made clear in the Patents Hearing Manual the scale is not mandatory. I have the power to award costs off the scale where the circumstances warrant it. In extreme cases, costs may even be increased to the extent of approaching full compensation, or be reduced to zero. This flexibility is to enable me to deal proportionately with, for example:

¹² See Chapter 5 of the Patent Hearings manual at <http://www.ipo.gov.uk/hearings-chapter05.pdf>

- i. delaying tactics, failure without good cause to meet a deadline, or other unreasonable behaviour, particularly where the other side is put to disproportionate expense;
- ii. a claim launched without a genuine belief that there is an issue to be tried;
- iii. costs associated with evidence filed in respect of grounds which are not pursued at the substantive hearing (though a party should not be deterred from dropping an issue which, in the light of the evidence filed by the other side, it now realises it cannot win);
- iv. unreasonable rejection by the party that eventually loses of efforts to settle the dispute before the proceedings were launched or a hearing held;
- v. unreasonable refusal by that party to attempt alternative dispute resolution;

and the increase or reduction should be commensurate with the extra expenditure incurred by the other side as the result of such behaviour. It should however be emphasised that merely because a party has lost does not of itself mean that their behaviour in fighting the case was unreasonable: it only becomes unreasonable if it was fought in a way that incurred unnecessary costs.

- 100 I note also that the costs that I am considering here are the costs related to these proceedings, in other words the review of the Opinion. They do not cover the costs incurred by the parties leading up to the issuing of the Opinion. Hence the behaviour of the parties during that time is not relevant.
- 101 Nokia requests that I depart from the normal scale in view of what they see as unreasonable behaviour by Mr Cunningham. In particular they argue that he raised irrelevant grounds for review; he made untrue allegations of impropriety and that he brought these proceedings before the Office with no bona fide intention of allowing their outcome to resolve the dispute about whether Nokia infringes the Patent.
- 102 Nokia goes on to argue that I should award full costs and has provided me with a schedule detailing some £14,800 of costs although at the hearing they indicated that they were actually looking for an award in the region of 70% of that figure. This, in their view, reflects the normal court practice of never awarding 100% of claimed costs.
- 103 In addition to the figures mentioned above, Nokia also indicate that the additional costs incurred on their side as a result of Mr Cunningham's unreasonable behaviour was £1443. I should add that Nokia refer in support of their submission on costs to *Rizla Ltd's Application*.¹³
- 104 At the hearing Nokia also sought to submit two further documents to support their case on costs. These were two letters sent by Nokia to Mr Cunningham, both of which were marked "Without prejudice save as to costs". One of the letters was redacted to hide a certain passage. In seeking to submit these documents Nokia agreed to waive any privilege. After having had an opportunity at the hearing to

¹³ *Rizla Ltd's Application* [1993] RP 365.

read the letters, Mr Cunningham agreed that I could also read them. However in his written submission filed shortly after the hearing Mr Cunningham argues that these documents should not have been admitted into the proceedings. Mr Cunningham did however also make observations on the contents, recognising that by then the letters had already been admitted.

- 105 I have further considered these letters in the light of Mr Cunningham's observations and have concluded that they do not demonstrate any unreasonable behaviour on the part of Mr Cunningham. Rather what they show was a genuine effort by Nokia to avoid further litigation beyond this review which also not unreasonably was rejected by Mr Cunningham. I therefore attach no weight to these documents when considering the issue of costs.
- 106 Mr Cunningham in his written submission seeks to defend his own behaviour whilst also identifying a number of aspects of Nokia's behaviour that he considers unreasonable. I will deal first with Nokia's behaviour and as I noted above I am concerned only with their behaviour during these proceedings ie the review of the Opinion and not with anything that occurred during the Opinion process itself.
- 107 Looking through the particular examples provided by Mr Cunningham and excluding those relating to events prior to the launching of these proceedings, I am left with the following allegations of unreasonable behaviour: failure to provide sufficient information relating to the priority document of WO 03/075242 and the late introduction of the *SmithKline Beecham* House of Lords case.
- 108 I have considered Mr Cunningham's arguments in respect of these two issues but am not persuaded that Nokia's behaviour in respect of either of these was unreasonable. As I have discussed above the priority document relating to WO'242 was not relevant to the issues before me here. As I have also mentioned the late introduction of the House of Lords case did not give rise to any unnecessary delay or expense as there was no disagreement between the sides on the need for an enabling disclosure. Indeed no use was made of this authority during the hearing.
- 109 I return now to the behaviour of Mr Cunningham during these proceedings and whether this justifies an award off scale. Mr Cunningham is clearly someone who believed strongly in his case. He has also indicated on more than one occasion that he considers himself already to have been the subject of one miscarriage of justice. I am sure that that experience has had a significant bearing on the way that he has approached this case. He also sees himself very much in a David v Goliath battle. On top of all of this he also chose, probably out of necessity, to represent himself although he did have some help at the hearing at least although apparently not from someone familiar with patent law or litigation. Nevertheless he has represented himself with no little conviction and has clearly thrown himself into the legal aspects of the case. Unfortunately much of his argument was based on misunderstandings. In particular he based his arguments mainly on a false assumption that the scope of his patent extended well beyond the words that he had actually used in his claims, even when read in the light of the description and drawings, to cover aspects of his invention that he seems to have thought of yet not specified or else specified in a way that was clear only to

him. He has also seemingly at times forgotten that the burden of proof lies on him to demonstrate that the Opinion was wrong rather than on the other side to show that it was right. However none of this is particularly unusual in litigants in person and overall I do not believe that Mr Cunningham's behaviour, though at the times demanding on both Nokia and the

110 Office was so unreasonable as to justify an award off scale. I find some support for this in Nokia's own modest claim for unnecessary costs incurred as a result of what they believed was unreasonable behaviour on the part of Mr Cunningham.

111 I therefore intend making an award in accordance with the published scale which is set out in Tribunal Practice Notice 2/2000¹⁴ to which Mr Cunningham has referred me as well in the Patent Hearings Manual. Accordingly I award Nokia the sum of £1500 to be paid by Mr Cunningham. I would add that in making this award, which is likely to be significantly less than would be awarded in Court proceedings, I am not required to consider either the actual costs incurred by, or the respective financial positions of, the parties.

Appeal

112 Nokia has asked that I refuse leave to appeal. When pressed at the hearing as to the legal basis that would allow me to do this, they referred to Part 52 of the Civil Procedure Rules (CPR)¹⁵ and paragraph 52.3.4 of the White Book, which is the authoritative reference book relating to the CPR.

113 I have looked carefully through section 52 and the relevant part of the White Book but can find nothing to suggest that I have any discretion on the question of appeal. Appeals from reviews are clearly provided for under Rule 77K which reads:

Appeals against a decision on review

77K. No appeal under section 97 shall lie from a decision to set aside the Opinion under rule 77J(1)(a), except where the appeal relates to a part of the Opinion that is not set aside.

114 In this case my decision does not set aside the Opinion and is therefore subject to appeal.

Conclusion

115 I have found nothing to show that opinion 11/06 wrongly concluded that claim 6 of patent GB2400958 B was invalid. I have also found nothing to show that, by reason of its interpretation of the specification of the patent, the Opinion wrongly concluded that PT-6 does not infringe any claim of the patent. The Opinion therefore stands.

¹⁴ Tribunal Practice Notice (TPN 2/2000) Costs In Proceedings Before The Comptroller at <http://www.ipo.gov.uk/patent/p-decisionmaking/p-law/p-law-tpn/p-law-tpn-2000/p-law-tpn-2000-tpn22000.htm>

¹⁵ http://www.justice.gov.uk/civil/procrules_fin/contents/parts/part52.htm

- 116 I award Nokia the sum of £1500 to be paid by Mr Cunningham not later than 7 days after the expiry of the appeal period. If an appeal is lodged, payment will be suspended pending the outcome of the appeal.
- 117 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

PHIL THORPE

Deputy Director acting for the Comptroller