

21 December 2012

**PATENTS ACT 1977**

Mr Nicholas MacPhail

Proprietor

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PROCEEDINGS

Request under section 74B of the Patents Act 1977  
for a Review of Opinion 18/10 issued  
on patent number GB2266762

HEARING OFFICER

Phil Thorpe

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**Decision**

**Introduction**

- 1 This decision relates to a request for a review of opinion 18/10 (“the Opinion”) under section 74B of the Patents Act (the “Act”). The Opinion was requested by Mr Nicholas J J F MacPhail in relation to whether the supply of Xcel, Pandora and Everest Heat Bank thermal storage products and associated other products by Dedicated Pressure Systems Limited (DPS) infringes GB 2266762 (the Patent).
- 2 The Opinion, which was issued on 3 February 2011, concluded that there was no infringement of the patent.
- 3 The proprietor of the patent, Mr MacPhail, then requested a review of the Opinion under section 74B. The matter came before me at a telephone hearing on August 22<sup>nd</sup> 2012 involving the proprietor Mr MacPhail and his attorney Mr Beattie of Forresters.

## The Law

- 4 The law governing reviews of opinions is set out, so far as is relevant here, in section 74B and Rule 98 of the Patent Rules 2007. These read:

### Section 74B    Reviews of opinions under section 74A

(1) Rules may make provision for a review before the comptroller, on an application by the proprietor or an exclusive licensee of the patent in question, of an opinion under section 74A above.

(2) The rules may, in particular-

(a) prescribe the circumstances in which, and the period within which, an application may be made;

(b) provide that, in prescribed circumstances, proceedings for a review may not be brought or continued where other proceedings have been brought;

....

### Rule 98.

(1) The patent holder may, before the end of the period of three months beginning with the date on which the opinion is issued, apply to the comptroller for a review of the opinion.

(2) However, such proceedings for a review may not be brought (or if brought may not be continued) if the issue raised by the review has been decided in other relevant proceedings.

(3) The application must be made on Patents Form 2 and be accompanied by a copy and a statement in duplicate setting out the grounds on which the review is sought.

(4) The statement must contain particulars of any relevant proceedings of which the applicant is aware which may be relevant to the question whether the proceedings for a review may be brought or continued.

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

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

**(b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.** (Emphasis added)

- 5 It is important to note that the grounds on which an opinion on infringement can be reviewed are quite narrowly prescribed in Rule 98(5)(b). The reason for this is that in most circumstances where a party feels aggrieved by an opinion, there will be a clear route for addressing that grievance. For example a party who is deemed by an opinion to be infringing a patent can seek a declaration of non-infringement. Equally where an opinion has concluded that no infringement is taking place and the patent proprietor disagrees, he may sue for infringement. This could include the circumstances where the patent proprietor disagrees with the way that the claims have been construed. Equally however there may be circumstances where suing for infringement is not possible or not appropriate and in such circumstances it would be unfair to deny the patent proprietor a chance to

overturn an infringement opinion based on a construction of the claims which is adverse to him. Thus the rules allow a review of an infringement opinion but only if the opinion came to a wrong conclusion on infringement as a result of how it interpreted the specification of the patent in suit.

- 6 In addition it is also important to fully understand the nature of reviews under S74B. This was considered in the Patents Court in the case of *DLP*<sup>1</sup> where the judge, Kitchen J as he was then , noted:

“In the case of an appeal under rule 77K [now Rule 100], the decision the subject of the appeal is itself a review of the opinion of the examiner. More specifically, it is a decision by the Hearing Officer as to whether or not the opinion of the examiner was wrong. I believe that a Hearing Officer, on review, and this court, on appeal, should be sensitive to the nature of this starting point. It was only an expression of an opinion, and one almost certainly reached on incomplete information. Upon considering any particular request, two different examiners may quite reasonably have different opinions. So also, there well may be opinions with which a Hearing Officer or a court would not agree but which cannot be characterised as wrong. Such opinions merely represent different views within a range within which reasonable people can differ. For these reasons I believe a Hearing Officer should only decide an opinion was wrong if the examiner has made an error of principle or reached a conclusion that is clearly wrong. Likewise, on appeal, this court should only reverse a decision of a Hearing Officer if he failed to recognise such an error or wrong conclusion in the opinion and so declined to set it aside. It is not the function of this court (nor is it that of the Hearing Officer) to express an opinion on the question the subject of the original request.”

- 7 It follows that the remit of any review is quite narrow. It is not a rehearing that would necessarily allow for example for new evidence not available to the examiner to be considered. Rather it is simply a review of whether the original opinion reached a conclusion that is clearly wrong on the basis of the material available at the time.

- 8 Mr Beattie enquired as to the product of the review and in particular if the review found the opinion to be clearly wrong would it go on to analyse those parts of the claim not considered by the opinion and thus make a determination on infringement. I explained that the review would simply either set the opinion aside or decide it should not be set aside. It would not look at questions not considered by the original opinion.

### **Analysis of the arguments**

- 9 The issue before me is whether the examiner has, by reason of how he has interpreted the specification of the patent wrongly concluded that the Xcel Heat Bank does not fall within the scope of the claims.

- 10 Claim 1 is the only independent claim. It reads:

*A system for providing mains pressure domestic hot water, the system comprising: a boiler having a casing and being arranged to heat the water present in a thermal store, the thermal store being in the form of a receptacle for water which comprises either the water jacket of the boiler or a vessel separate from the water jacket of the boiler, the receptacle being within the*

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<sup>1</sup> [2007] EWHC 2669 (Pat)

*casing of the boiler; a thermal store low temperature thermostat which, when actuated by a reduction in thermal store temperature, transfers the output of the boiler to the thermal store; a heat exchanger for heating mains pressure domestic hot water, the heat exchanger being a unit which is separate from the thermal store; flow sensor means to sense a flow of mains pressure water through the heat exchanger; a pump connected to pump water so that the water flows through the thermal store and through the heat exchanger; control means responsive to a flow of water sensed by the flow sensor to control the pump; the arrangement being such that heat energy is drawn from the thermal store and is transferred to the mains pressure water in the heat exchanger whenever there is a flow of mains pressure water through the heat exchanger.*

11 The proprietor argues that the examiner has erred in construing the above claim as being directed to a boiler with a water jacket and has also misunderstood what the phrase “water jacket” means in this context.

12 On the first point I can be brief. The claim clearly states that:

*“the thermal store being in the form of a receptacle for water which comprises either the water jacket of the boiler or a vessel separate from the water jacket of the boiler”*

13 Hence in light of this I can see nothing clearly wrong with the statement of the examiner in paragraph 16 of his opinion that the author of the patent did have a certain type of boiler in mind ie one with a water jacket.

14 I turn now to how the examiner has construed the phrase “water jacket of the boiler”.

15 It is noted that in its initial request, the proprietor did not put forward any arguments on the construction of this particular phrase. At the hearing Mr Beattie explained that this was because it was not thought to be an issue. It was perhaps unfortunate that the alleged infringer did not file any observations as it might have been that the issue of the meaning of this phrase might have been raised. This would have allowed the proprietor to respond in its observations in reply.

16 In the event the opinion examiner had little by way of argument before him to help on this point. His analysis of the meaning of this phrase is set out essentially in paragraphs 20-25 of the opinion. In these paragraphs the examiner considers whether an arrangement of the alleged infringing article which comprises a water filled tank having an electric immersion element as the sole heat source falls within the scope of the claim. The examiner notes:

20. Moving on to the first of the two options, the Requester when comparing the claims with the installation instructions states that:

*“As can be seen from page 5 of the installation instructions, the Xcel Heat Bank can be **optionally supplied with 3kW, 6kW or 9kW electric elements, with up to three elements in total**” ( My bold). “It is therefore made clear that as an alternative to being heated by water from a separate boiler, the water in the thermal store may be directly heated by electric elements” and that “in these embodiments the “boiler” as required by claim 1 comprises the thermal store itself”.*

21. Indeed, the second paragraph of the installation instructions says “The Xcel may be

*used with gas, oil or biomass boilers, wood burners, solar panels, heat pumps, electric heating elements, or central boiler systems.*" which rather suggests to me that the Xcel heat store is intended, in at least some incarnations, to comprise an electrically heated source of water i.e. an electrical boiler.

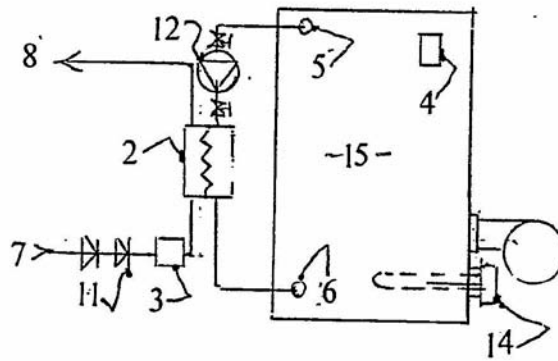
22. So, I can agree with the requester that the Xcel thermal store is, at least in some configurations, a boiler in its own right but I do not consider this boiler to be a water jacketed boiler as required by claim 1.

23. Although not put explicitly, the Requester in pointing out Figure 2 of the Patent and the associated part of the description on page 5 (penultimate and last paragraphs) i.e. that "*Figure 2 illustrates a modified embodiment of the invention in which the thermal store comprises the water jacket of the boiler*", "*The water jacket is provided with an immersion heater*" and "*The immersion heater provides a standby or stand alone heat source*" seems to be drawing a parallel between the Xcel and Figure 2 arrangements and suggesting that a vessel provided with an immersion heater comprises the "water jacket" of the boiler.

24. This is not the common meaning of what a water jacket is which must surely be (given the term "jacket" i.e. a vessel or chamber that surrounds another component) distinct from a simple "tank". I do not think that the skilled person would conclude that the author of the Patent had in mind a tank, especially given the context of that last paragraph of page 5 i.e. "*the boiler may be a steel jacketed oil fired boiler having burners... The immersion heater provides a standby or stand alone heat source.*"

25. Given, therefore, that there is no water jacket of the boiler in the Xcel heat store within the meaning of the term used in claim 1 there can be no infringement of claim 1 by any of the acts in S. 60.

- 17 On review the proprietor argues that this is too restrictive an interpretation. Rather it argues that the skilled person would ascribe to the claim a broader meaning that would extend to cover a vessel that contains water that is heated by whichever heating means is provided. This includes a tank or a cylinder with an electric heating element with the outer sheath of the heating element forming effectively part of the jacket. Indeed it goes further to suggest that any type of boiler must have a water jacket because the water heated in the boiler must be contained by some vessel and that vessel is a water jacket.
- 18 The proprietor also believes that the examiner has misunderstood the distinction between a boiler and a tank. It argues that the person ordinary skilled in the art would understand a boiler to be the vessel for heating water primarily for circulating through radiators or which produces indirectly hot water to be dispensed through household taps. In contrast a "tank" would be viewed as a container (or cylinder) for storing domestic hot water.
- 19 I am not sure that this is really an issue here. Rather the question is whether a cylinder or tank with an immersion heater is or is not a boiler with a water jacket within the context of how that phrase is used in the patent.
- 20 In respect of that context the proprietor refers me to figure 2 of the patent (shown below). It argues that this shows a water jacket of the boiler which has an immersion heater (14) as its only heat source (in some embodiments). It argues that as claim 1 would be taken to encompass all the described embodiments that this supports a wider interpretation of the claim.



- 21 From the passages of the opinion reproduced above it is clear to me that the examiner has taken account of the description, including the entirety of the description relating to figure 2. He has drawn the conclusion that the figure and description do not support a construction of claim 1 that would cover a tank or a cylinder with an immersion heater as the sole source of heating.
- 22 Having carefully read the description I am not convinced that the examiner was clearly wrong to reach this conclusion. The initial patent application was I believe produced by Mr McPhail without professional assistance. The lack of detail and the impreciseness of some of the drafting reflect this to some extent. This should not be taken as criticism of Mr MacPhail. Drafting a good patent specification can be difficult exercise. However it is clear that there is for example no unambiguous disclosure of a boiler with a water jacket that comprises just a water container and an immersion heater. Such an embodiment might possibly be inferred essentially from the use of the term “stand alone” in relation to the immersion heater. The description does not however clearly explain what “stand alone” means in this context. There is nothing to clearly say that the immersion heater completely replaces the boiler referred to in that part of the description and that the claims are intended to cover such an embodiment.
- 23 The opinion examiner has in the passages referred to above reached a conclusion that the claims when read in light of the description do not extend this far. This is his interpretation. The proprietor has put forward another. It is not for me here to choose one interpretation over the other. Rather I am required to decide whether the examiner’s interpretation is clearly wrong. On the basis of the patent as a whole I do not believe it is.
- 24 The proprietor has also provided me with a number of documents to show how the term water jacket is commonly used in the technical field. Mr McPhail at the hearing also expanded on the interchangeability of the terms “water jacket” and “heat exchanger”. It is clear that there is indeed some overlap in terminology. I would however note firstly that none of this material was before the examiner who did the opinion and secondly some of the documents at least post date the patent.
- 25 The examiner in his opinion has however given his view on what was the common usage, or more precisely what was not the common usage, of the term water jacket. To the extent that these documents show that the examiner’s understanding of the meaning of this term at the time the patent was drafted was

clearly wrong then they would be relevant to this review. I have however studied these documents carefully and, even if I accept that those that are undated were indicative of the situation when the patent was drafted, then I would still not be persuaded that the examiner was clearly wrong. Rather what they demonstrate to me and this was to a degree borne out by Mr McPhail at the hearing, is that there was then, and probably is still now, no common terminology – rather terms were and are used interchangeably. There is nothing to clearly show for example that the phrase “water jacket of a boiler” would at the time the patent was granted necessarily be taken to always include a water cylinder fitted solely with an immersion heater.

## **Conclusion**

- 26 This is I believe the sort of case that Kitchen J. had in mind when he set out the nature of reviews of opinions. The opinion here was based on limited information and argument. It was also based on a patent specification that was at least when it was originally filed was written without professional representation. The examiner has expressed his opinion based on his interpretation of the patent specification. Others may come to a different opinion however for me to set aside the opinion I need to be satisfied that the opinion reached by the examiner was clearly wrong. I do not believe it is. I therefore refuse to set aside the opinion.

## **Appeal**

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

**P THORPE**

Divisional Director acting for the Comptroller