



PATENTS ACT 1977

PROPRIETOR	Francis O'Hare
OPPONENTS	Deo Beauty Products Ltd Australian Bodycare UK Ltd
ISSUE	Application under section 74B for review of Opinion 3/12 in respect of GB2435687B
HEARING OFFICER	H Jones

DECISION

Introduction

- 1 Opinion 3/12 is concerned with the question of whether the supply or sale of the Hywax Tube Heater DBP by Australian Bodycare International and the Deo Tube Wax Heater by Deo Beauty Products constitute an infringement of patent GB2435687B. The opinion was requested by the patentee and proprietor, Mr Francis O'Hare, and observations were received from Australian Bodycare UK Ltd and Deo Beauty Products Ltd. The Opinion was issued on 21 June 2012, in which the examiner concluded that the sale or supply of the heaters would not constitute an infringement.
- 2 The patentee has exercised his right to apply for a review of the opinion. The application for review was received within the three month period from the date of issue of the opinion. The application was accompanied by a statement setting out the patentee's grounds for review.
- 3 Deo Beauty Products Ltd and Australian Bodycare UK Ltd contest the application. Their grounds for opposition are set out in separate counterstatements dated 29 October 2012 and 31 October 2012 respectively.
- 4 I issued a preliminary evaluation on the issue on 23 September 2013 and invited parties to consider the need for an oral hearing or to have the review conducted on the basis of the papers. In the event that parties wished to have the review conducted on the basis of the papers, I said that I would allow a period of four weeks to submit observations with respect to my evaluation which I would take into account in my final decision. All parties agreed that the review should be conducted on the basis of the papers, and observations on the preliminary evaluation were submitted by Rosemary Eve of Brookes Batchellor LLP on behalf of Australian Bodycare UK Ltd.

Grounds for review

- 5 The grounds for a review of an Opinion are set out in rule 98(5) of the Patents Rules 2007:

*98(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.*

- 6 Mr O'Hare submits that the examiner made an error in construing the claims in light of the description and that, as a consequence, wrongly concluded that there was no infringement. This is an allowable ground for review.

Review

- 7 The nature of a review under section 74B was considered by the Patents Court in *DLP Limited*¹, in which Kitchen J said:

"22.....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."

- 8 In Opinion 3/12, the examiner sets out the correct principles for interpreting the specification, namely a purposive construction of the claims and their interpretation in the light of the description and the drawings. He explains, again correctly, that he must decide what a person skilled in the art would have understood the patentee to be using the language of the claim to mean.
- 9 In assessing the scope of the main claim, claim 1, the examiner says that at first sight it is fairly easy to understand: the only part that requires any further consideration is the part which reads "an adaptor removably mountable to the body and comprising a plate with substantial oval apertures". I note that the wording of the claim actually refers to an adaptor being removably "mounted" to the body, not "mountable", but nothing rests on this difference. In my view, the examiner was right to pay particular attention to the meaning of this part of the claim.
- 10 He then proceeds to construe the meaning of the phrase "comprising a plate", and decides to construe the word "plate" quite broadly such that it encompasses not only the flat planar surface labelled 24 in figures 3A and 3B, but also the planar surface labelled 41 in figures 9A to 9E. I note that the description refers to parts 24 and 41 both as plates, and in my view the examiner was correct to construe the word "plate" as broadly as he did.
- 11 The examiner did not find it necessary to consider what the skilled reader would understand the patentee to mean by the word "adaptor". However, having construed the word "plate" to mean a planar surface, he concludes that the skilled person would understand that the patent was using the phrase "comprising a plate" to cover, as he

¹ DLP Limited [2007] EWHC 2669

says, “not only the sort of adaptors shown in figure 3 but also the phrase [in] a broader sense to cover the adaptors shown in figure 9”.

- 12 I think it would have helped at this point of the Opinion to have explained in a bit more detail what the examiner took the word “adaptor” to mean, or, more importantly, what he thought the skilled person would take it to mean. As the examiner rightly acknowledges, this word is important in understanding whether there is infringement or not. The specification refers to the “adaptor” as being a means to convert an open chamber wax heater into a wax tube heater by way of a removable insert which acts to “mutually isolate, but cooperatively support” multiple tubes of wax. The removable insert, or adaptor, can be inserted into the hollow body of the heater as in figure 9 or positioned on the lip of the hollow body as in figures 2 and 3. It would have helped as well to explain the particular significance that the word “comprising” has in terms of patent claim construction: as is explained at paragraph 14.113.1 of the Manual of Patent Practice, the word is generally interpreted to mean “including”, i.e. other integers or features may be present, as opposed to the words “consisting of”, which is generally interpreted to mean “consisting exclusively of”. There is nothing in the specification to suggest that the word “comprising” should be interpreted in any other way than that set out in the Manual.
- 13 In my preliminary evaluation I said that the examiner had made an error of principle in construing the meaning of the phrase “comprising a plate” and that this had led to a conclusion on infringement which I considered to be clearly wrong. In his assessment of whether the two-part construction of metal cup and removable rubber disc of the Hywax tube heater falls within the meaning of an adaptor “removably mounted to the body and comprising a plate with substantially oval apertures”, the examiner says that “if the claim did not refer to the adaptor as “comprising a plate” then I would have no hesitation in saying this two piece construction has all the features of the adaptor of claim 1.” He goes on to say that “I do not believe overall that the two-part construction of the Hywax adaptor could reasonably be considered to be “comprising a plate”. It is clear from this that the examiner has construed the meaning of “comprising a plate” as consisting exclusively of a plate, and not, as he ought to have done, as including a plate. Although he does not say so explicitly, the fact that he has previously construed the word “plate” very broadly to encompass a planar surface such as the removable rubber disc of the Hywax tube heater, the only reason I can see for dismissing the two-part Hywax adaptor as comprising a plate must have been because the adaptor has both a plate and a metal cup. There is no question in my mind that the Hywax and Deo tube heaters have an adaptor which comprises a plate.
- 14 In observations submitted in response to my preliminary evaluation, Ms Eve argues that the Hywax product does not infringe the patent, not, as in the original Opinion, because the adaptor can only consist of a plate, but because the adaptor cannot comprise the pot which is present in the Hywax product. The pot in this instance is the metal cup referred to by the examiner. She says that the adaptor of the Hywax product is mounted upon the pot and not the body of the heading device as required by claim 1 of the patent. She acknowledges that the examiner did not construe the meaning of the word “adaptor” in the Opinion and says that it was of “critical importance” that he did so. She then sets out the way in which the word “adaptor” should be construed and argues that had the examiner construed the word in this way then he would still have arrived at the same conclusion with regard to infringement.

- 15 As this is a review of an Opinion and not a separate finding on the issue, I do not think it is necessary for me to decide whether the Hywax and Deo products do or do not infringe upon the patent. Ms Eve may well be right in saying that the claim should be construed in the way she sets out and that the examiner was correct to say that the products do not infringe, but the point is that the examiner failed to construe an important aspect of the claim and misconstrued another key part. It is quite possible that the examiner has arrived at the correct conclusion on infringement, but the basis upon which he did so was, in my view, so clearly flawed that it casts doubt on his conclusion. Moreover, had he construed the phrase “comprising a plate” in the way I consider he ought to have done, he says in the Opinion that he would have had no hesitation in saying that the Hywax product has all the features of claim 1, i.e. he would have come to a different conclusion on infringement. For this reason I consider that the finding on infringement is wrong.

Conclusion

- 16 Having found that the examiner made an error in construing the phrase “comprising a plate” and failed to construe an important word (“adaptor”) in claim 1 of the patent, I consider that the examiner’s finding on infringement is wrong and that the Opinion should be set aside.

Costs

- 17 Neither side has asked for costs, so I do not propose to make any award.

Appeal

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

H Jones

Deputy Director acting for the Comptroller