

PATENTS ACT 1977

IN THE MATTER OF an application under section 72 by Rock Shing Industrial Limited for the revocation of EP(UK) Patent No 0063362 in the name of Braun AG

DECISION

The application for revocation was made on 12 March 1992 on the grounds that the invention is not a patentable invention and that the protection conferred by the patent has been extended by an amendment which should not have been allowed. With regard to the first ground, three considerations were put forward in the statement filed with the application, that is the novelty, inventive step and the clarity and conciseness of all of the claims. With regard to the second ground, it was alleged that an amendment made on 16 February 1987 under Section 117 of the Patents Act 1977 extended the scope of claim 1 and was thus unallowable. It was also alleged that there has been undue delay in applying to amend the patent and that the patentees have shown bad faith in that they have instituted infringement proceedings in Hong Kong in respect of a patent which is clearly invalid. The relief sought by the applicants for revocation is the complete or partial revocation of the patent, the latter being in respect of claims 1, 4-7 and 12-16, and costs.

Evidence on behalf of the applicants is given by Dr J A Shillinglaw, a specialist consultant in thermal problems and applications. Evidence on behalf of the patentees is given by Professor J H Whitelaw, professor of Conductive Heat Transfer at the Mechanical Engineering Department of Imperial College of Science, Technology and Medicine and by Dr W U Hagele, a director of Braun AG in charge of the production and process development of hair care, oral care and kitchen machines. Further evidence in the form of a copy of the application which resulted in the patent in suit and a translation into English of parts of that application was filed on 5 July 1994.

The patent in suit concerns a hairdryer having a flat iron attached to it by way of a releasable connecting device. In a first embodiment, hot air from the hairdryer nozzle is directed onto the central area of a flat topped ironing plate and then flows outwardly over the marginal surface of the plate, thereby heating it to facilitate ironing. In a second embodiment, a second plate is located above the ironing plate and the outwardly moving air is constricted to flow between the plates thereby improving the heating of the ironing plate. The central area of the ironing plate may contain holes and the connecting device may include elements enabling the iron to be stood on edge. A spray may be incorporated and a stepping switch and regulating wheel may be provided to enable fine control of the heating of the ironing plate to be achieved.

The English language version of claim 1 of the patent as granted on 27 March 1985 was as follows:

"1. Electric flat iron with a hairdryer forming the handle, top and the heating device for a flat iron, a heat-absorbing, heat-conducting plate being arranged via a connecting device in front of the hot air nozzle of the hairdryer, characterised in that the plate (2,2a) has a flat top surface (7), and projects with a marginal area over which flows the hot air leaving the impact area of the hot air flow over the latter and consequently over the contour (18,18a) of the hot air nozzle (4,4a)."

but this claim was corrected under the application under Section 117 and now reads:

"1. Electric flat iron with a hairdryer forming the handle, top and the heating device for the flat iron, a heat-absorbing, heat-conducting plate being arranged via a connecting device in front of the hot air nozzle of the hairdryer, characterised in that the plate (2,2a) has a flat top surface (7), and a marginal area which projects beyond the impact area of the hot air flow and consequently beyond the contour (18,18a) of the hot air nozzle (4,4a), over which marginal area flows the hot air leaving the impact area."

The applicants' case with regard to the first ground of objection is based upon Japanese patent JP 52-159781 (published 3 December 1977 and hereafter JP 781) and Japanese patent JP 56-30804 (published 25 March 1981 and hereafter JP 804). JP 781 discloses a hair dryer to the nozzle of which an ironing plate can be removably attached. The ironing plate is connected to a socket by support legs and, in operation, the end of the nozzle of the drier is inserted into the socket so that the plate is located spaced from the nozzle. Hot air leaving the nozzle plays upon the plate to heat it in order to facilitate ironing and the leading and trailing edges of the plate are slightly upturned. According to the specification, the temperature of the ironing plate can be regulated by the amount of hot air and by adjustment of the length of the support legs. JP 804 shows an iron cum dryer comprising a dryer having a nozzle and an apertured ironing plate, which is wider than the mouth of the nozzle, mounted to the nozzle by a cylindrical body slidable within the nozzle. When the device is used as a dryer, the cylindrical body is biased outwardly by a spring so that the plate is spaced from the end of the nozzle. When it is used as an iron the cylindrical body is pressed inwardly against the resistance of the spring until the plate contacts the end of the nozzle. In this position apertures in the cylindrical body and nozzle align to allow the escape of hot air and thus prevent overheating of the nozzle.

Although objection on the first ground, according to the statement, is raised against all claims, the case is argued only in respect of claims 1, 4-7 and 12-16.

After the completion of the usual rounds of evidence, the matter came before me at a hearing on 11 and 12 July 1994 at which Mr R Prentice of R. R. Prentice & Co appeared on behalf of the patentees and Miss A. Findlay of Lloyd Wise, Tregear & Co appeared on behalf of the applicants for revocation.

At the outset, Miss Findlay stated that it was the intention of the applicants not to pursue the matter of amendment. This was acceptable to Mr Prentice except for the question of costs, to which I shall return later. Consequently, I need not deal further with this matter except perhaps to say that an application under Section 117 is one for "correction" and not "amendment" and is thus not subject to the restrictions of Section 76(3)(b), upon which

section the applicants' arguments were based. Thus, in my opinion, the second ground for revocation could not, in any event, have been sustained.

There was considerable debate at the Hearing on the construction to be put upon Claim 1 of the patent in suit and I must deal with this matter before going on to consider whether or not the claim is novel and involves an inventive step. The language of the patent in suit before the European Patent Office was German and thus the body of the patent reads in German. There are three sets of claims, one in German, one in French and one in English, the last two being translations of the German version. It is with the English translation of the claims that I am concerned and in particular with the corrected version of claim 1 which I have already recited.

On 23 December 1992, the applicants filed a translation (the Meek translation) of the German claims as published by the European Patent Office. The reason for filing this translation was explained to me at the hearing by Miss Findlay as being an attempt to show that there is an ambiguity in claim 1 as to whether the air flow goes over both the nozzle contour and the marginal area of the plate or just the latter. She submitted that the claim could be read either way. To my mind, this version equates to the original version of claim 1 rather than to the corrected version of claim 1 published with the patent in suit. I agree, however, that both the Meek version and the original version of the patent in suit are somewhat obscurely, if slightly differently, worded. However, this defect has been remedied in the corrected version and it is to this version that I now turn my attention, but before doing so I would add that a translation (the Penfold translation) of claim 1 of the application upon which the patent in suit is founded was filed by the applicants on 4 July 1994; this was explained by Miss Findlay as showing what the patentees first thought they had invented as against what they ended up with in view of the cited prior art, but I do not see that this aids me greatly in construing the corrected version of claim 1.

In the statement, the applicants for revocation have helpfully split the corrected version of claim 1 into three separate elements as follows:

- a. electric flat iron with hairdryer forming the handle, top and the heating device for the flat iron;
- b. a heat-absorbing, heat-conducting plate being arranged via a connecting device in front of the hot air nozzle of the hairdryer;
- c. the plate having a flat top surface, and a marginal area which projects beyond the impact area of the hot air flow and consequently beyond the contour of the hot air nozzle, over which marginal area flows the hot air leaving the impact area.

I agree with their analysis but would go one step further and split the last element into two to give:

- c. the plate having a flat top surface and a marginal area which projects beyond the impact area of the hot air flow and consequently beyond the contour of the hot air nozzle;
- d. the arrangement being such that the hot air leaving the nozzle and hitting the impact area then flows outwardly over the marginal area.

It is against these four elements, then, that I will consider the arguments in respect of claim 1 put forward by the two sides.

On behalf of the patentees Mr Prentice put it to me that the term "flat" as used in element c. must be construed as meaning free from ribs, bent-up edge portions or other elevations of this type and he derived support for this argument from the decision of the European Patent Office in respect of European Patent No 0063362, which is the European equivalent of the patent in suit. The decision is shown in exhibit WUH1 in these proceedings and the English translation of the decision forms exhibit WUH2. I note that, in exhibit WUH2, the top surface of the ironing plate is referred to as being "plane" rather than "flat". However, in view of the definition of the word "plane" in the Shorter Oxford English Dictionary,

which definition includes the word "flat", I am prepared to accept that the two words are interchangeable.

On page 3 of the EPO decision there is a discussion of the mode of operation of the device according to the invention and it is concluded that the hot air issuing from the dryer nozzle and impinging upon the surface of the ironing plate flows away substantially in all directions, acting, as this occurs, in the sense of smoothing the article being ironed in the vicinity of the ironing plate. It was considered that such a mode of operation is only possible if the top surface of the ironing plate is planar "that is free from ribs, bent-up edge portions or other elevations of this type".

In Miss Findlay's submission this interpretation cannot be relied upon in these proceedings since it was not based upon a consideration of the two Japanese patents which have been cited in these proceedings, namely JP 781 and JP 804, but was based solely upon a consideration of Japanese Patent 54-040218 (hereafter JP 218) which disclosed an ironing attachment for a hair dryer in which a frame including an ironing plate is slid over the end of the dryer, the plate having upwardly directed fins in the region opposite the nozzle of the dryer and in which the attachment works in an entirely different way.

For the patentees, Mr Prentice contended that a consideration of the decision showed that the question of the nature of the surface of the ironing plate was taken in the context of whether or not the subject matter of the patent had been extended beyond the context of the application as already filed. He concluded that the view that the surface was free of ribs, bent-up edges or the like was reached in isolation from the consideration of any of the Japanese patents and that it was clear that Japanese patent JP 218 was considered only in relation to inventive step after the nature of the surface had been determined. He went on to say that since the construction of claim 1 had already been interpreted by the European Patent Office, it would not be right for a national patent office to adopt a different view.

I am inclined to agree with Mr Prentice on this point in that, in the European decision, the interpretation of the term "flat" does precede the consideration of inventive step in relation to JP 218. While I recognise the point made by Miss Findlay that it might be disingenuous

to say that the EPO examiner would not have had the Japanese patent in mind at all, I believe that the conclusion reached by the European Patent Office was based essentially upon the way in which the device operates. I do not, however, accept Mr Prentice's view that it would not be right for a national patent office to adopt a different interpretation since the evidence and the arguments before it might be different. First and foremost I believe that I must reach my conclusion on the meaning of the term "flat" on the basis of the arguments and evidence before me in these proceedings but, having said that, the decision of the EPO must be persuasive and I should not depart from it without good reason having regard to the provisions of Section 130(7) and the importance which the courts in this country have attached to this section on a number of occasions.

Both Mr Prentice and Miss Findlay submitted that I must look at the body of the specification for guidance in interpreting the claims of the patent in suit, Miss Findlay stressing that a "purposive" interpretation should be made, and both argued at length on the extent of the role that expert witnesses can or cannot play in the interpretation or construction of claims.

With regard to the latter, Mr Prentice drew my attention to attempts by Dr Shillinglaw in both his first and second affidavits to interpret the meaning of the term flat and he contended this is impermissible; only the court or comptroller can do this. I note at this juncture that Dr Hagele in paragraph 6 of his declaration also offers his interpretation of the word. Mr Prentice drew support for his case from the decision in *Glaverbel v British Coal* [1993] RPC 92 at page 94 where Mummery J states that "The opinion of expert witnesses on the construction of the specification (or of any other document) will not be admitted by the court" which is a reiteration of the position voiced by Tomlin LJ in *British Celanese Ltd v Courtaulds Ltd* [1935] RPC 171 at 196. Mr Prentice's conclusion was that while Dr Shillinglaw is quite entitled to give his opinion as to whether he considers the invention obvious or not, he is not entitled to construe the scope of a claim.

For her part Miss Findlay took me to the decision in *Improver Corp v Remington Consumer Products* [1989] RPC at page 77/78. There it is set out that a purposive construction must be through the eyes and with the learning of a man skilled in the art and that a claim must be read through the eyes of a notional addressee. In her submission, therefore, I can and

should listen to the skilled man when construing a claim and the evidence of the skilled man is helpful to the court in determining how a claim should be construed. She fully accepted that, at the end of the day, it is the court's job to construe the claim but she rejected the proposition that the skilled man's evidence is not of assistance in undertaking that task.

The dictum in *Glaverbel* is still the law and I must follow it. Consequently, I shall treat Dr Shillinglaw and Dr Hagele's attempts at construction of the term "flat" merely as background opinion. With this in mind, I now turn my attention to the body of the specification in order to reach, with the aid of the evidence filed, a purposive construction of the term "flat", bearing in mind, as I do so, the deliberations of the European Patent Office.

At the hearing Miss Findlay directed me to the purpose of the invention which she took to be the better heating of the ironing plate. A reference to page 2 of the translation of the patent in suit shows this to be correct since the second paragraph of that page reads "The purpose of the invention is to provide a flat iron of the aforementioned type which permits rapid heating of the plate to a high ironing temperature without any risk of a heat build-up in the hairdryer". Miss Findlay went on to say that the two important features for solving this problem are the flat top surface and the marginal area which, together, produce the following four effects:

1. Laminar flow which is said to give rapid and effective heat exchange (there is some debate about this which I shall come to later).
2. Reduced flow resistance which reduces heat build-up.
3. A suction effect which has a cooling effect on the hair dryer.
4. A larger plate area which increases the area usable for ironing and available for heat absorption.

This is supported on page 3 of the translation of the patent in suit. Miss Findlay concluded that, in a purposive construction, "flat" must mean "sufficiently flat that the air flowing from the nozzle will not be constrained or significantly impeded". She adds that claim 1 further requires the air to flow from the impact area over the marginal area.

In his first declaration, Dr Shillinglaw sets out his interpretation of the term "flat". He comments that claim 6 of the patent refers to a rough and/or matt surface and thus the term "flat" cannot mean "completely flat". Both Professor Whitelaw and Dr Hagele state that, in their views, a rough surface can still be "flat" since, although rough to the touch, it will look flat unless viewed with a microscope.

There was considerable debate as to the nature of the flow of air across the ironing plate, that is to say whether or not it is laminar or turbulent, and what effect the roughness of the plate would have. Although the patent on page 2 of the translation suggests that the air flow is laminar, it is Dr Shillinglaw's opinion that the flow would be turbulent as a result of the turbulent airflow from the nozzle hitting the ironing plate and changing direction. Professor Whitelaw states that he has conducted experiments which also strongly suggest that the flow from the nozzle is turbulent and that the flow over the plate is turbulent, although only some of the findings are summarised in his evidence. In paragraph 8 of his declaration, Dr Hagele confirms the turbulent nature of the flow over the ironing plate surface even though he envisages that the initial flow through the nozzle could, with appropriate nozzle design, be laminar. It is agreed between the experts that the effect of the roughness of the plate surface can be expected to be small.

Taking into account these differing views, I am of the opinion that the term "flat" must be construed as including a rough surface but limited to a surface which is free of any projections which would deflect the stream of hot air moving outwardly over the ironing plate and away from the article being ironed. Furthermore, in the absence of clear evidence to the contrary, I am not convinced that the nature of the air flow over the ironing plate, that is whether the flow is laminar or turbulent, is critical in the context of the way in which the invention works, nor do I believe that the question of whether the upper surface of the ironing plate is rough or smooth should influence me unduly. I have therefore come to the

same conclusion as the EPO that the term "flat" should be given its normal technical meaning.

The applicants' attack on claim 1 is based upon Japanese patent JP 781. Dr Shillinglaw maintains that the device of the Japanese patent shows all the features of claim 1 of the patent in suit even though the ironing plate does not have a completely "flat" surface since the leading and trailing-edges are slightly turned up. He states in his second affidavit that, on an estimate based upon the overall size of a travel iron and the relative size of the constituent parts, the height of the turn ups is 1-2mm above the surface of the plate and that the turn ups extend for less than 15% of the perimeter of the plate. Thus, he argues, the restriction to the airflow is minimal and the terms of claim 1 of the patent in suit are met.

However, in his first affidavit, in connection with claim 12, Dr Shillinglaw bases a measurement of the distance between the nozzle and the ironing plate surface of the Japanese patent upon the width of the four fingers, shown in figure 3, that is to say 6 cms. If this measurement were to be used as a basis for estimating the turn-up of the front and rear edges of the plate which, as measured in the drawing, are ½mm and 1mm respectively, then the front turn up would be 3mm and the rear turn up would be 6mm rather than the 1-2mm quoted by him. This apparent discrepancy was noted by Mr Prentice at the hearing who, on his own calculations, came to a turn up closer to 7mm than the 1-2mm quoted by Dr Shillinglaw. He added that such a turn up would have an appreciable effect on air flow and he also contended that the circumferential extent of the turn up is irrelevant.

Miss Findlay took up the question of the height of the turn up, basing her estimates upon measurements taken from the second figure in the Japanese patent. Her conclusion was that the turn ups are about 2mm high, a height which may impede the flow somewhat, but which would not significantly impede it. She also refuted the idea put forward by Mr Prentice that the circumferential extent of the turn up was irrelevant. She maintained that a 15% turn up gives 85% of unimpeded air flow. Finally, I note that the thickness of the plate as depicted in Figure 2 is approximately twice the thickness of the flute as depicted in Figure 3 and that this would give a turn up height of about 3mm in Figure 2.

The estimates for the turn up heights of the edges of the ironing plate of the Japanese patent thus vary between about 1mm and 7mm, these estimates being based upon the figures shown in that patent, which both parties have accepted as being somewhat diagrammatic. However, for want of any better way of determining the dimensions in the Japanese patent, I propose to accept these estimates as being the upper and lower limits with the reality probably being somewhere in between. On the basis that the rear straight edge of the ironing plate of the Japanese document is about 15% of its perimeter, I am also prepared to accept Miss Findlay's figures of 15% impeded air and 85% unimpeded air. These dimensions and proportions, however, are disclosed in relation to the device of the Japanese patent and it seems to me that, if I am to disregard the height and the extent of the upturned edges and construe the ironing plate of the Japanese patent as being flat as invited by Miss Findlay, it would be necessary for the applicants for revocation to persuade me that, if the upturned edges were to be incorporated into the invention of the patent in suit, they would have no material effect upon the way in which it functions.

With regard to the mode of operation of the device of the Japanese patent, there is no clear indication in that patent of how the device functions, at least in terms of air flow. In the English translation of the patent in suit, the distance between the nozzle and the ironing plate is discussed at page 8. It is stated that the distance is approximately 4 to 6mm with approximately 5mm being preferable. It also talks about the plate not being too hot in the case of a minimum spacing of 5mm and, later on, it refers to an optimum spacing of approximately 5mm. There is also reference to the distance optionally being somewhat larger. In his first affidavit, in connection with a discussion of claim 12 which is directed to the distance between the nozzle and the plate, Dr Shillinglaw states that from a comparison of the distance with the width of the four fingers shown in Figure 3, the distance in the Japanese patent is about 6cms. With reference to the relevant passages in the patent in suit, however, Mr Prentice argued that "somewhat larger" does not mean something like 10 times the maximum distance quoted. The greater the separation between the nozzle and the plate, the greater would be the heat loss from the flow of air and 5mm is about the optimum distance without overheating resulting. Mr Prentice took the point one step further in saying that the greater distance between the nozzle and the plate of the device of the Japanese patent would almost certainly mean that the effect of the air flow from the nozzle impinging on the

plate would be greatly reduced since, because of the turbulence, a great deal of air would escape and not impinge on the plate at all. In the absence of any guidance in the Japanese patent and taking into account the arguments put to me by both sides, I have come to the conclusion that the applicants have failed to demonstrate that the Japanese patent would or could exhibit the air flow required by the patent in suit, that is to say impact in a central area followed by flow outwardly over the marginal area. Indeed I am drawn to the view that, in the device of the Japanese patent, the airflow from the nozzle may well diverge to such a degree that it impinges upon a wide area of the ironing plate.

Thus, on the question of novelty alone, the purpose of the invention of the patent in suit is to provide a flat iron which permits rapid heating of the plate to a high ironing temperature without any risk of a heat build-up in the hairdryer. This is achieved by locating the nozzle of the drier within a few millimetres of the ironing plate so that the hot air which emanates from the nozzle strikes the flat top surface of the ironing plate and flows away laterally over the marginal area. The effect of this lateral flow of air over the marginal area as I understand it, whether it is laminar or turbulent, is to retain hot air in close proximity to the plate for a longer period than might otherwise be the case so that a hotter and larger usable ironing surface is obtained. It is also stated in the patent that the lateral flow of hot air across the plate produces a suction effect around the casing of the hairdryer enabling cold air to flow continuously from above for cooling the hairdryer and, whilst there was little discussion of this effect at the hearing, it was not disputed.

I have already indicated that I do not consider that the device shown in JP 781 discloses such a flow of air away from the area where the hot air from the nozzle impinges upon the ironing plate and would therefore not produce the beneficial effects of a higher ironing temperature and flow of cool air claimed for the iron of the patent. In my view the two irons are quite different and the difference is reflected in claim 1 of the patent in suit by the functional requirement that the hot air flows away over a marginal area after leaving the impact area on the plate. I think that Mr Prentice recognised that this functional requirement could, perhaps, have been worded more clearly but, on my reading of the specification, the meaning is quite clear. I have also concluded that the requirement in claim 1 that the top surface of the plate be flat is to be construed as meaning free from upturned portions which, prima

facie, is a further distinction from the disclosure of JP 781 and the applicants for revocation have not persuaded me that the upturned edges on the ironing plate of JP 781 would not have a material effect on the flow of air across the plate and away from the iron of the patent in suit so that I might, on a purposive construction, regard the plate shown in the Japanese patent as being flat. The applicants case is not helped by the diagrammatic nature of the drawing in the Japanese patent and the uncertainty as to the height of the upturned edges, but it seems to me that, if they are some 3mm in height (which is about one half of the preferred distance between the nozzle of the drier and the plate in the invention of the patent in suit), any effect which the upturned edges might have on the flow of air across the plate and in deflecting it upwardly cannot be wholly disregarded; as I have already said there was very little evidence on the point, but it seems to me that any upward deflection of the hot air might well be detrimental to the suction effect and to the flow of cooler air to the drier. The attack on the ground of novelty therefore fails.

Turning to the question of obviousness, I must consider the state of the art in 1981 at the date of the patent.

It was not in dispute that electric irons had been known for some time but, because of their size and weight, they were not regarded as being portable by travellers and the like. One solution to this problem which had been proposed was to modify a hair dryer and, according to Mr Prentice, there were at least four such travel irons known at the date of the patent, two of which are the subjects of JP 781 and JP 804 cited in these proceedings, and I think that it is clear from the evidence that irons of this type were not regarded as being as efficient as known electric irons because of their reduced weight and the reduced temperature to which the soleplate could be heated.

JP 781 does not refer to the problem of heating the soleplate of the iron to a satisfactory temperature although it does explain that the temperature can be regulated by varying the amount of hot air from the dryer or by adjusting the space between the mouth of the dryer and the plate. JP 804 discloses that, by shortening the pathway between the heater and the plate, the soleplate can be heated to a higher temperature and it makes provision to prevent the barrel of the dryer from becoming abnormally hot by providing side openings in the

barrel to facilitate the escape of hot air; I note that this document also discloses a soleplate which is larger than the mouth of the barrel of the drier.

JP 218 is not a document on which the applicants rely in these proceedings but it was relied upon in the opposition proceedings before the EPO to which I have referred earlier. I make no other reference to this document other than to note that it suggests, although not in precise terms, that pre-heating of the article to be ironed is desirable.

Although it was not summarised as such at the hearing, this is the background against which the patentees in these proceedings set out to make an improved portable iron and, in particular, to increasing the ironing temperature. Both JP 781 and JP 804 indicate that the temperature of the ironing plate can be increased by shortening the path between the plate and the nozzle outlet of the drier and JP 804 also recognises the need to prevent overheating of the drier which it achieves merely by allowing the hot air to escape. In my view, however, neither of these documents either alone or taken together point in the direction of the invention of the patent in suit in which the nozzle is placed in close proximity to the ironing plate, the air is forced to flow laterally over a wider marginal area of the ironing plate as a result of which a large area of the ironing plate is raised to a higher temperature and, at the same time, the hot air is not only removed from the immediate vicinity of the drier but creates a suction effect which helps to cool the drier; the additional benefit claimed is a measure of pre-heating the article to be ironed. It seems to me that if the prior art had pointed towards the solution adopted by the patentees as regards the flow of air, then the applicants for revocation may have been right in their claim that the removal of the upturned edges from the plate of JP 781 would have been obvious, but JP 781 does not consider this method of operation and in JP 804 the hot air only makes direct contact with the soleplate in an area corresponding to that of the outlet of the nozzle of the drier. While the invention in suit may not be a major technical breakthrough, I am satisfied that it represented an advance in the state of the art at the time and, in my judgement, the attack on the ground of a lack of inventive step also fails.

Since I have found claim 1 to be valid and all the substantive claims are appendant directly or indirectly to claim 1, it follows that these claims are also valid and I need not consider

the arguments and counter-arguments in respect of those claims put forward at the Hearing.

Earlier in this decision I referred to the third consideration under the first ground on which revocation is sought, that is the clarity and conciseness of all the claims. The clarity of claim 1 was brought into question by Miss Findlay with regard to the various translations filed as I have indicated earlier in this decision and I have already stated that I find the corrected version of the claim to be clear. If I understood her correctly, Miss Findlay argued against the clarity and conciseness of the claims on the basis that the invention is not a patentable invention, that is to say under Section 72(1)(a) as interpreted by Section 125. I note, in this connection that paragraph 5 of the statement also makes reference to the requirements of a claim in Section 14(5). This approach was accepted by Whitford J in the Patents Court in Genentech Inc's Patent (1987 RPC 553 at page 592) but his finding was overruled on appeal (1989 RPC 147 at page 236) where Dillon LJ in particular said:

"One of the other permissible grounds for revocation in section 72 is ground (c):-
"the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art." That clearly reflects section 14(3) of the 1977 Act, but there is nothing in section 72 to reflect section 14(5), and the fact that section 14(3) is deliberately picked up in section 72, while section 14(5) is not, makes it impossible to imply that failure to comply with section 14(5) in relation to the claims in a patent is to provide grounds for revocation under section 72. Ground (a) of the grounds for revocation in section 72 "that the invention is not a patentable invention" refers back to section 1, which defines what is a patentable invention, and to sections 2, 3, and 4 which explain that definition, but it does not, in my judgment, refer back to section 14(5).

If, therefore, there is a patentable invention and a patent is granted, that patent cannot be revoked - nor can its validity be disputed - on the grounds that the claims in the patent as granted do not comply with section 14(5)."

In the present case the applicants are seeking to rely upon the requirement of Section 14(5)(b), which is a requirement for the grant of a patent, as a ground for revocation

but the judgement of the Court of Appeal makes it clear that this is not an option which is available to them and I need consider the point no further.

I mentioned at the beginning of this decision that the applicants allege undue delay before amending and bad faith in starting infringement proceedings in Hong Kong. With regard to the former, the applicants contend that the Japanese patents cited in the proceedings were cited against a corresponding foreign patent at least as early as 1985 and thus there has been a clear delay in amending the patent in suit. The patentees do not deny that they have been aware of the Japanese patents, which were in fact cited against the corresponding US patent. They do deny, however, that claim 1 of the patent is invalid. Mr Prentice reiterated this at the hearing and pointed out that the invalidity or otherwise of claim 1 had not yet been decided. In the event, of course, I have decided that the claim is valid and the patentees views are vindicated and the question of undue delay does not therefore arise. With regard to the latter, the patentees do not deny that they have instigated infringement proceedings in Hong Kong but they do deny that the patent in suit is invalid. Once again, in the event, this has proved right and the patentees cannot be criticised for their actions.

Since I have found against the applicants on all of the grounds pleaded, the patentees are entitled to an award of costs. Taking account of the second ground of revocation which was not pursued at the Hearing but which the patentees had to consider, I award the patentees Braun AG the sum of £900 (nine hundred pounds) by way of contribution to their costs and I direct that this sum be paid by the applicants for revocation, Rock Shing Industrial Limited.

This being a substantive matter, the time within which an appeal may be lodged is 6 weeks from the date of this decision.

Dated this *29* day of *September* 1994

P J HERBERT
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

