

OPINION UNDER SECTION 74A

Patent	GB2557957
Proprietor(s)	Integral Memory Plc
Exclusive Licensee	
Requester	Maucher Jenkins
Observer(s)	Handsome I.P.
Date Opinion issued	13 January 2025

The request

1. The comptroller has been requested to issue an opinion as to whether a product '*Integral LED Evofire IP65 Fire Rated Downlight SKU ILDFR70D001*', manufactured and offered for sale by Integral Memory Plc falls within the scope of UK Patent GB2557957 held by Integral Memory Plc. They argue that this request is in line with Rule 93(6)(a) despite their admission that a patent proprietor's product cannot infringe the proprietor's patent.
2. The request notes that the product is marked with the text 'Patent GB2557957' but considers that the product does not fall within the scope of that patent and thus misrepresents the product with regard to Section 110 of the Patents Act 1977. The request argues that this is a matter of public interest. Samples of this product were provided.
3. The request also refers to Rule 93(6)(d) which I understand is regarding amendments made to claim 1 adding matter and thus causing the patent to be invalid.

Observations

4. The observer argues that the request is not matter relevant to Rule 93(6)(a) and thus I should refuse to provide an opinion. They further state that the request should be refused under Rule 94(1)(a). They also refer to Rule 93(6)(d) again arguing that an opinion should not be provided on that basis that the issue of added matter has already be considered by the Office during pre-grant examination.
5. Observations in reply were also received.

Matters to be considered by this Opinion

6. Section 74A of the Patents Act provides for the procedure where the Comptroller can issue, on request, non-binding opinions. Section 74A(1) of the Patents Act 1977 states:

74A.-(1) The proprietor of a patent or any other person may request the comptroller to issue an opinion on a prescribed matter in relation to the patent.

(2) Subsection (1) above applies even if the patent has expired or has been surrendered.

(3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so—

(a) in such circumstances as may be prescribed, or

(b) if for any reason he considers it inappropriate in all the circumstances to do so.

And the relevant Patent Rule is the following:

93(6) The prescribed matters for the purposes of section 74A(1) are as follows—

(a) whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;

(b) whether, or to what extent, an invention for which the patent has been granted is not a patentable invention;

(c) whether the specification of the patent discloses the invention clearly enough and completely enough for it to be performed by a person skilled in the art;

(d) whether the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed or, if the patent was granted on a new application, in the earlier application as filed;

(e) whether the protection conferred by the patent has been extended by an amendment which should not have been allowed;

(f) whether a supplementary protection certificate is invalid under Article 15 of the Medicinal Products Regulation; and

(g) whether a supplementary protection certificate is invalid under Article 15 of the Plant Protection Products Regulation.

7. Section 74A(3) of the Patents Act 1977 then states:

The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so –

(a) in such circumstances as may be prescribed, or

(b) if for any reason he considers it inappropriate in all the circumstances to do so.

8. The list in Rule 93(6) is exhaustive and provides me with no power for issuing an opinion on the basis that it 'is a matter of public interest' as the request argues.
9. The request states that the issue they wish to resolve is whether the Product should or should not be marked as patented noting Section 110 of the Patents Act that

deals with 'Unauthorised claim of patent rights'. It can be seen that section 110 is not listed in rule 93(6) and I conclude that such a question is not matter for which an opinion can be sought.

10. The request argues that I should consider their request as a kind of infringement question and thus it should be allowed given rule 93(6)(a). They frame the request as a question of whether the product 'falls within the scope of' the patent or not. In the observations in reply the requestor further argues:

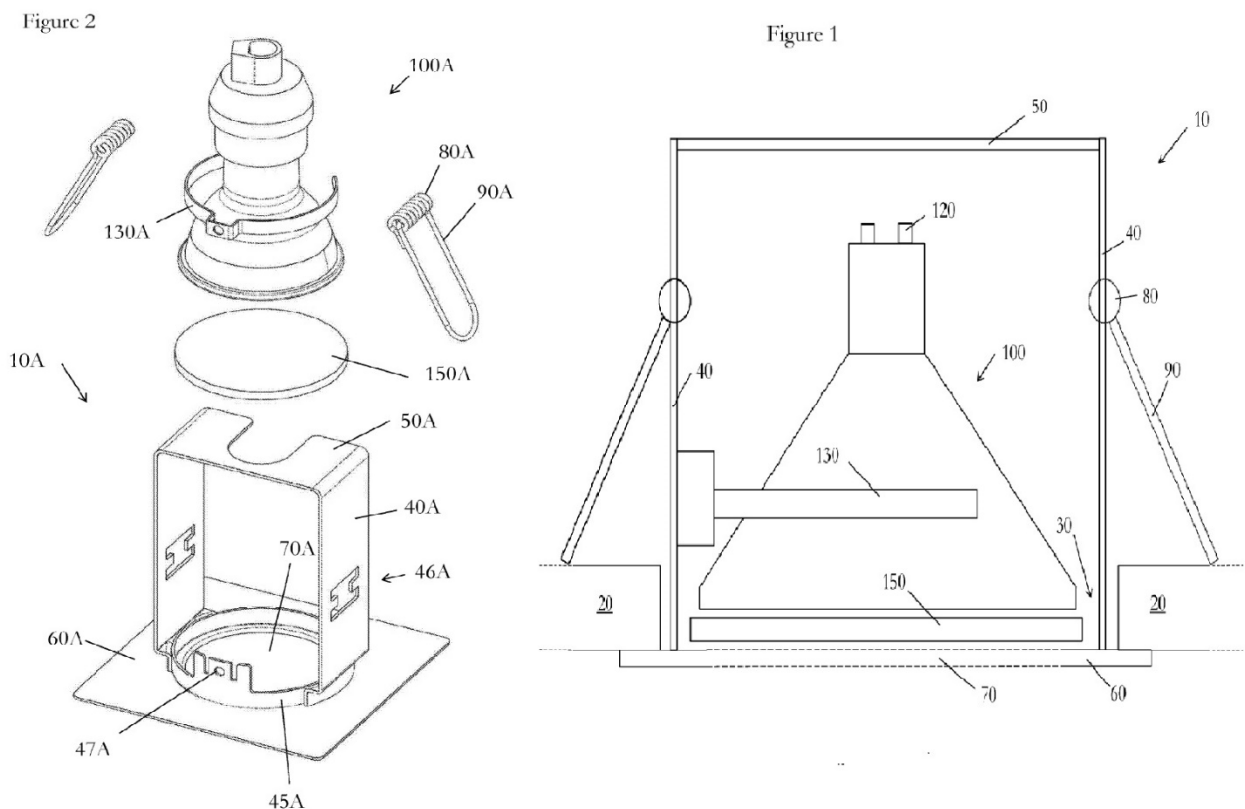
It is clear from here that the opinion service is provided to deal with broad questions of infringement, i.e., whether a product or a proposed product falls within the scope of a patent, rather than excluding a situation where, for narrow legal reasons, a particular sample of a product cannot be said to infringe.

11. The observations note that the phrase 'falls within the scope of' is not used in Rule 93(6), rather the specific word 'infringement' is used. They also note that the request does not describe any infringing act.
12. I agree with the observations. The main part of the request regarding rule 93(6)(a) does not make the case for any relevant infringing act and thus I do not think there is a sufficient argument regarding infringement for me to form an opinion. I will not give my opinion on this matter.
13. The request also refers to Rule 93(6)(d) which deals with added matter. The relevant argument seems to be contained in subsection 8 of the request where issues of claim construction are also discussed. Whilst the argument presented is a little sparse, it is clear the requestor considers the phrase 'sealing member material' adds matter in amended claim 1 and thus caused the patent to be invalid.
14. The observer argues that an opinion should not be provided in relation to added matter on that basis that the issue has already be considered by the Office during pre-grant examination. During pre-grant processing, a patent examiner will check that all amendments do not add matter, however that fact is not necessarily a reason to bar this request for the following reasons. Firstly, I note that pre-grant examination is not considered to be 'relevant proceedings' under Rule 92 and thus does not fall within the ambit of Rule 94(1)(b). Secondly, as Section 3.4 of the opinions manual¹ notes, a request repeating specific arguments raised by the examiner would normally be refused under Section 74A(3)(b). However, inspecting the pre-grant application dossier, I can see that the examiner raised no added matter objections at any time during prosecution. Thus I consider that the added matter allegation is effectively presenting a new argument.
15. I will therefore give my opinion on the specific alleged added matter in claim 1.
16. As there seems to be a reasonable question regarding the validity of claim 1, I do not think the request is 'frivolous or vexatious', by virtue of rule 94(1)(a).

¹ <https://www.gov.uk/government/publications/opinions-manual/opinions-manual>

The Patent

17. The Patent is for a light fitting that can be recessed into a ceiling space with a number of variations described. One example is shown below with the figure 1 showing a cross-section of the fitting of figure 2 when installed through a ceiling cut-out. All of the embodiments provide for a flange 60 to cover the cutout perimeter and for a window 150 to cover the rest of the cutout, with the lamp element carried behind this. This particular embodiment uses a biasing spring assembly 80,90 that acts to clamp the ceiling skin 20 between the spring ends and the upper face of the flange. The flange and window act together to provide a fire-resistant seal from the space below to mitigate spread of fire into the ceiling void due to the cutout.



The Law

18. Rule 93(6)(d) relates to Section 76 of the Patents Act that deals with 'Amendment of applications and patents not to include added matter' and the relevant section is:

76. (2) No amendment of an application for a patent shall be allowed under section 15A(6), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

19. The alleged added matter arises from amendments to the claims filed in response to examination reports under Section 18(3).
20. The test for added matter was described by Aldous J. in *Bonzel and Schneider*

(Europe) AG v Intervention Ltd² as

(1) to ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly in the application;
(2) to do the same in respect of the patent as granted;
(3) to compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition.
The comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly.

The test was summarised by Jacob J (as he then was) in *Richardson-Vicks Inc.'s Patent*³ as

'the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification.'

Added Matter – Section 76

21. The request focusses on the amendment to claim 1. The wording of the claim as initially filed was:

*1. A fire resistant recessable light unit of the type for installation into a ceiling void, the unit comprising a ventilated, lamp accommodation means and a sealing member, the sealing member comprising a planar flange extending radially outwardly from the lamp accommodation means, the unit further comprising a transparent window arranged between the flange and the lamp accommodation means, wherein **the flange comprises flange material and the window comprises window material, both flange and window materials having a melting point greater than a predetermined temperature**, and wherein the lamp accommodation means remains ventilated at temperatures in excess of the predetermined temperature.*

The amended wording forming the granted claim is:

*1. A fire resistant recessable light unit of the type for installation into a ceiling void, the unit comprising a ventilated lamp accommodation means without intumescent material and a sealing member, the sealing member comprising a planar flange extending radially outwardly from the lamp accommodation means and a hole for allowing light to pass through, the unit further comprising a unit retention means for retaining the flange immediately adjacent the ceiling, and a transparent window arranged to cover the hole in the sealing member, **wherein the sealing member comprises sealing member material and the window comprises window material, both sealing member and window materials having a melting point greater than a predetermined temperature**, and wherein the lamp accommodation means*

² Bonzel and Schneider (Europe) AG v Intervention Ltd [1991] RPC 553

³ Richardson-Vicks Inc.'s Patent [1995] RPC 568

is arranged to remain ventilated at temperatures in excess of the predetermined temperature, and wherein the predetermined temperature is 800°C.

22. The request suggests that the phrase '*sealing member material*' has no basis in the originally filed application, the original claim instead referring to '*the flange comprises flange material*'. I have highlighted the relevant parts of each claim above in bold. It can also be seen that both claims state '*the sealing member comprising a planar flange*'. The request also notes that the reference to '800°C' was in original filed claim 3.

23. The request, when arguing (at subsection 8) that there is doubt as to the meaning of "*sealing member material*", states the following in relation to the construction of the granted claim:"

Therefore, for the Patent to be valid pursuant to section 76 of the UK Patents Act 1977 feature (a) must be construed such that the "sealing member material" is the "flange material", and consequently feature (a) of claim 1 should be construed that the "flange material" has a melting point greater than 800C.

24. In the observations in reply, the requestor notes, among other things, that:

Claim 1 of the Patent defines "the sealing member comprising a planar flange". This implies that the sealing member may comprise something else other than the flange. For example, the sealing member may also comprise ... another part. There is no disclosure in the application as filed that (all of) the sealing member material has "a melting point greater than a predetermined temperature", therefore this feature of claim 1 extends the patent "beyond that disclosed in the application for the patent as filed".

25. The observations discuss reading claim in the light of the purpose of the invention and say:

One purpose of the invention is to prevent fire from spreading through a hole cut into a ceiling and in which the light unit has been installed, to prevent fire from reaching the floor above, for instance. ... the fire is prevented from spreading through the hole by ensuring that the relevant parts of the light unit do not melt below a predetermined temperature and thus fall away. The skilled person would therefore understand the invention to require that the hole is "sealed" by sealing means comprising materials having a melting point greater than a predetermined temperature. It is explained in the specification that is achieved by a sealing member, comprising the flange, and the glass. The flange has flange material having a melting point greater than a predetermined temperature. The glass also has a melting point greater than a predetermined temperature. The specification explains on page 2, lines 17-19 that "the flange, which either directly or indirectly retains the window in place, acts to hold the window in place and prevent it from falling out in the case of a fire."

Therefore, amending flange material to sealing member material has no effect on the functioning of the invention. ... It is therefore submitted that the

skilled person would understand the invention in the same way, pre and post claim amendment. The skilled person has not learnt anything new by this amendment (Richardson-Vicks Patent [1995] RPC 568) and therefore it is submitted that no new subject matter has been added. Regardless, even if post-grant amendment was requested to revert to the original claim 1 wording, it is submitted that no unallowable broadening of the claim would occur such that the patent would remain valid.

26. To apply the *Bonzel* added matter test, I need to consider who the skilled reader is. I note that this has not been directly addressed by the requester, or observer. I consider that the skilled reader will be an electrician experienced in installation of light fittings and will also be aware of building regulations regarding electrical fittings in buildings and the related fire regulation aspects. They would be familiar, in general, with light fittings that are recessed by fitting into a ceiling cut-out such that the fitting extends though the ceiling to the void above.
27. Firstly, I agree with the requestor that, while the term '*sealing member*' is used throughout the application as filed, the specific phrase '*sealing member material*' is not found. This does not automatically mean there is added matter, rather the test needs to be applied. I note that '*sealing member*' is used in the original claims and throughout the original filed application. Further the material properties of the parts that comprise this sealing member are also described in the original filed application.
28. The original claim 1 states that the sealing member '*comprises a flange*' where as in the granted claim, it '*comprises a flange ... and a hole*'. The skilled reader is not told anything new by claim 1 explicitly stating there is a hole '*for allowing light to pass through*'.
29. The original claim said the sealing member comprised the flange and this was made of flange material. When reading granted claim 1 in the light of the granted patent specification, I think that the skilled reader is essentially told the same thing; The granted claim says the sealing member material is the material that forms the flange (and thus the material that defines the hole). The original and granted claims thus both tell the skilled reader that the material of the flange has a predetermined melting point.
30. The amended granted claim also now specifies the '*predetermined temperature*' as 800 degrees. This is clearly found in the original filing and was in the originally filed dependant claim 3. This is nothing new.
31. I disagree with the requestor who argues (in the observations in reply) that granted claim 1 now implies that the sealing member '*may be ... something else*' and that this may not have the required melting point. In both the original claims, and the amended granted claims, the skilled reader will understand that the sealing member '*comprises*' the flange and thus the sealing member may include other features. The skilled reader is not told about a new feature in granted claim 1.
32. I note that the dependant claims in both the original filing and the granted patent do go on to describe an additional (optional) feature of the sealing member: an '*upstanding portion*'. While the granted dependant claims make no explicit mention of any materials in relation to this portion, it is implied from claim 1 that this portion also

comprises 'sealing member material' with the same melting point properties as the material forming the flange.

33. Looking at the claims as originally filed, it is not implied from claim 1 that the portion comprises the same class of material as the flange. The originally filed claims set is silent regarding the melting point of the upstanding portion. In contrast, the granted claim set tells the skilled reader that the upstanding portion has a melting point greater than 800 degrees. I thus need to consider if this amounts to the skilled reader being told something new.
34. Reading the original specification, I note the portion between line 28 page 9 to line 4 page 10 which discusses the embodiment (of figure 3, 4) having this upstanding portion:

The window comprises material which has a greater melting point than the glass typically used in such downlighters. Furthermore, the flange 260A, upstanding portion 240A and collar 280A comprise material which has a greater melting point than the material typically used in such downlighters. In use, if a fire is present in the room beneath the ceiling which includes the unit 200A, because the window does not melt or break easily, due to the fire, the fire cannot penetrate into the ceiling void in which the unit 200A is situated. Furthermore, because the flange, upstanding portion and collar do not melt the window will not fall out, again, preventing the fire from penetrating into the ceiling void in which the unit 200A is situated.

This makes it clear that the upstanding portion is expected to have the same minimum melting point properties as the flange such that the light fitting assembly maintains its fire resistance. Thus I conclude that there is basis in the original filing for this upstanding portion to have a melting point greater than 800 degrees when the flange also has a melting point greater than 800 degrees.

35. I therefore conclude that granted claim 1 does not teach the skilled reader anything new in comparison to the original filed application. Also, the set of granted claims, taken as a whole, does not teach the skilled reader anything new.

Conclusion

36. It is my opinion that the Patent is valid. I do not find that there is matter disclosed in the specification of the patent which extends beyond that disclosed in the application for the patent as filed.
37. I decline to give my opinion on whether the product falls within the scope of the patent or not.

Gareth Lewis
Examiner

NOTE

This opinion is not based on the outcome of fully litigated proceedings. Rather, it is based on whatever material the persons requesting the opinion and filing observations have chosen to put before the Office.