



BL O/238/04

10 August 2004

PATENTS ACT 1977

BETWEEN

Baxi Heating Limited

Claimant
(Opponent)

and

Robinson Willey Limited

Defendant
(Applicant/
proprietor)

PROCEEDINGS

Opposition to an application under section 27
to amend patent number GB 2305499 B

HEARING OFFICER

S N Dennehey

DECISION

Introduction

- 1 Patent Number GB 2305499 B (“the patent”) entitled “gas burner safety device” was granted on 10 February 1999 to Robinson Willey Limited (“the proprietor”) following an application filed under the Patents Act 1977 (“the Act”) on 2 April 1996. On 23 September 1999, through its patent agents, Potts, Kerr & Co, the proprietor filed a request under section 27 to amend the specification of the patent, referring to three items of prior art. Following preliminary consideration by the Patent Office, the amendments were advertised in the *Patents and Designs Journal* of 22 August 2001.
- 2 On 19 October 2001, notice of opposition to the application to amend was given under section 27(5) by Baxi Heating Limited (“the opponent”) through its patent agents, Franks & Co. In due course, statements of case were filed, albeit that a decision on the papers of 30 May 2002 was needed to resolve a preliminary issue. Following the usual evidence rounds, a substantive hearing was appointed. At that hearing, Mr Richard Davis appeared as Counsel for the opponent, and submitted a skeleton argument shortly beforehand. The proprietor chose not to appear or be represented, but instead relied on written submissions by its patent agents, in particular a series of letters filed immediately before the hearing. I should accordingly make clear that I have been careful to take into appropriate account the papers on file, so as to ensure fair treatment of both parties.

The patent

- 3 The patent relates to a gas burner safety device, and in particular to a gas burner incorporating means responsive to oxygen depletion. As explained in the patent specification as granted, it is important from a safety point of view to ensure that a gas fire or other gas appliance does not continue to burn when the level of oxygen in a room falls below a safe level. An oxygen-depletion sensing (ODS) pilot jet is acknowledged as known in which a pilot flame becomes unstable if the oxygen level falls below the required level, so that it ceases to act on a thermocouple, with the result that the gas supply to the main burner is shut off. While such ODS pilot jets are important safety devices, the provision of a pilot jet with ODS device and separate gas supply pipe and valve adds to the cost of any gas appliance fitted with them.
- 4 It is then said to be an object of the invention to provide a burner for a gas appliance which is responsive to oxygen depletion and/or increase in other gases in the ambient atmosphere. Following a number of statements of invention, the patent specification says that the burner according to the invention incorporates at least one oxygen-depletion-sensing flame port such that the need for a separate ODS pilot light jet with its separate gas supply pipe and control tap is obviated.
- 5 The patent specification as granted contains 18 claims which read:
 - “1. A burner unit for a gas appliance which burner has a plurality of ports and includes as a part thereof and not as a separate pilot flame device, additional means provided so as to produce a flame which is more responsive by lift-off effect to oxygen depletion in the ambient atmosphere and/or more responsive by lift-off effect to increase in carbon dioxide and carbon monoxide and/or nitrous oxide in the ambient atmosphere than the flames produced by the remaining plurality of ports.
 2. A gas burner for a gas appliance
which burner has a plurality of ports and is so designed to duct a gas/air mixture to at least one of its flame ports such that the flame provided by said at least one of its flame ports is more responsive by lift-off effect than the flames provided by the remaining of the plurality of ports to undesirable oxygen depletion in the surrounding air in a manner that can be detected by a thermocouple or other sensor and/or is more responsive by lift-off effect to build-up of undesired gases comprising carbon dioxide and carbon monoxide and/or nitrous oxide in a manner that can be detected by a thermocouple or other sensor, AND/OR
which burner has a plurality of ports and has at least one flame port so designed such that, the flame provided by said at least one flame port is more responsive by lift-off effect than the flames provided by the remaining of the plurality of ports to undesirable oxygen depletion in the surrounding air in a manner that can be detected by a thermocouple or other sensor and/or is more responsive by lift-off effect to build-up of undesired gases comprising carbon dioxide and carbon monoxide and/or nitrous oxide in a manner that can be detected by a thermocouple or other sensor.

3. A burner as claimed in claim 2, in which the at least one flame port is provided with additionally one or more adjacently located flame-influencing bodies, such that the flame produced by the port is responsive to said undesirable oxygen depletion or build up of said undesired gases in said manner that can be detected by said thermocouple or other sensor.

4. A burner as claimed in any of claims 1 to 3, in which the additional means which provides a flame responsive to oxygen depletion, or the at least one oxygen-depletion-sensing flame port. is provided to achieve the required responsive effect with consideration of one or more of the following features:-

- (a) the location of the port in a less or greater pressurised region of the burner;
- (b) the control of aeration;
- (c) the size, location, number or depth of the port or ports;
- (d) injector size;
- (e) the provision of other flame-influencing (flame retention) bodies (e.g. thermocouple and/or electron spark-ignition device and/or the other probes or bodies) having influence on flame stability;
- (f) the consideration of nature of the air and/or gas supply ducts.

5. A burner as claimed in any of claims 2 to 4, in which said at least one flame port of the burner is a purpose-designed nozzle inserted into the burner or flame strip of the burner or located somewhat remotely from the normal/standard burner flame ports.

6. A burner as claimed in claim 5, in which said nozzle is located at the end of the burner or in an extended portion of the burner.

7. A burner as claimed in claim 5 or 6, in which such purpose-designed nozzle has its own independent airflow/vent to ensure only room air is being sampled.

8. A gas appliance whenever incorporating a gas burner as defined in one or more of claims 1 to 7 and without an oxygen depletion sensing pilot light jet separate from the burner.

9. A gas appliance as claimed in claim 8, including a thermocouple controlling the main gas valve supplying gas to the burner and located to be in the flame issuing from said at least one port and such that when the level of oxygen drops below an acceptable level, the flame produced by the burner and said port will cease to act on the thermocouple.

10. A gas appliance as claimed in any of claims 1 to 9, in which an electric spark ignition electrode and device is provided for ignition purposes with the electrode providing sparks directly onto the burner to ignite gas from the ports of the burner.

11. A gas appliance as claimed in claim 10, in which the electrode operates to ignite the said at least one port without the provision of a separate pilot flame device.

12. A gas appliance incorporating a burner as claimed in claim 1, wherein the burner is a unit and includes an ODS nozzle.

13. A gas appliance as claimed in claim 12, in which the ODS nozzle is an ODS pilot light.

14. A main burner for a gas appliance as claimed in any of claims 1 to 7, in which said burner has a plurality of normal/standard burner flame ports and said additional means of claim 1 or said designed duct and/or at least one of its flame ports or at least one flame port of claim 2, is consequently such as to provide a flame which is more responsive to oxygen depletion than the flames provided by said normal/standard burner flame ports.

15. A gas appliance as claimed in any of claims 8 to 13 which appliance does not have a separate oxygen depletion sensing pilot light jet separate from the burner, and in which said burner has a plurality of normal/standard burner flame ports and said additional means of claim 1 or said designed duct and/or at least one of its flame ports or at least one flame port of claim 2, is consequently such as to provide a flame which is more responsive to oxygen depletion than the flames provided by said normal/standard burner flame ports.

16. A main burner as claimed in claim 14, or a gas appliance as claimed in claim 15, in which the main burner is a unit.

17. A gas burner for a gas appliance wherein the burner has a plurality of flame ports and at least one of said flame ports is adapted or especially provided such as to produce a flame which is more sensitive by lift-off effect to oxygen depletion than the flames produced by the remaining ports.

18. A gas appliance including a burner and having means sensitive by lift-off effect to oxygen depletion in the ambient atmosphere other than an oxygen-depletion-sensing pilot light jet separate from the burner, said burner having a plurality of flame ports and including as said sensitive means at least one flame port which is adapted or especially provided such as to produce an oxygen-depletion-sensitive flame which is more sensitive to unacceptable oxygen depletion than the flames produced by the remaining flame ports and in a manner that can be detected by a thermocouple or other sensor.”

The proposed amendments

6 The original request for amendment was, in accordance with standard procedure, considered first by an examiner within the Patent Office. The amendments which resulted from that procedure in effect propose to limit the patent scope down from gas appliances to gas fire appliances and add references to flame-influencing bodies to the independent claims. Various appendancies are adjusted, and corresponding amendments are offered to the description.

7 In a letter dated 7 June 2001, the proprietor asked for a new claim 17 to be added. This was duly taken into the request.

- 8 Those claims which stand substantially changed after the proposed amendments are as follows (additions being shown in bold, deletions in strike-out):

Claim 1

“A burner unit for a gas **fire** appliance which burner has a plurality of ports and includes as a part thereof and not as a separate pilot flame device, additional means provided so as to produce a flame which is more responsive by lift-off effect to oxygen depletion in the ambient atmosphere and/or more responsive by lift-off effect to increase in carbon dioxide and carbon monoxide and/or nitrous oxide in the ambient atmosphere than the flames produced by the remaining plurality of ports, **and in which the additional means which provides a flame responsive to oxygen depletion is provided to achieve the required responsive effect also comprises other flame-influencing (flame retention) bodies having influence on flame stability and/or the consideration of nature of the air and/or gas supply ducts.**”

Claim 2

“A gas burner for a gas **fire** appliance

which burner has a plurality of ports and is so designed to duct a gas/air mixture to at least one of its flame ports such that the flame provided by said at least one of its flame ports is more responsive by lift-off effect than the flames provided by the remaining of the plurality of ports to undesirable oxygen depletion in the surrounding air in a manner that can be detected by a thermocouple or other sensor and/or is more responsive by lift-off effect to build-up of undesired gases comprising carbon dioxide and carbon monoxide and/or nitrous oxide in a manner that can be detected by a thermocouple or other sensor, AND/OR

which burner has a plurality of ports and has at least one flame port so designed such that, the flame provided by said at least one flame port is more responsive by lift-off effect than the flames provided by the remaining of the plurality of ports to undesirable oxygen depletion in the surrounding air in a manner that can be detected by a thermocouple or other sensor and/or is more responsive by lift-off effect to build-up of undesired gases comprising carbon dioxide and carbon monoxide and/or nitrous oxide in a manner that can be detected by a thermocouple or other sensor, **AND in which the at least one flame port is provided with additionally one or more adjacently located flame-influencing bodies, such that the flame produced by the port is responsive to said undesirable oxygen depletion or build up of said undesired gases in said manner that can be detected by said thermocouple or other sensor.**”

Claim ~~17~~ 15

“A gas burner for a gas **fire** appliance wherein the burner has a plurality of flame ports and at least one of said flame ports is adapted or especially provided such as to produce a flame which is more sensitive by lift-off effect to oxygen depletion than the flames produced by the remaining ports, **and in which the at least one flame port is provided with additionally one or more adjacently located flame-influencing bodies, such that the flame produced by the port is responsive to**

said undesirable oxygen depletion or build up of said undesired gases in said manner that can be detected by said thermocouple or other sensor.”

Claim 16

“A gas **fire** appliance including a burner and having means sensitive by lift-off effect to oxygen depletion in the ambient atmosphere other than an oxygen-depletion-sensing pilot light jet separate from the burner, said burner having a plurality of flame ports and including as said sensitive means at least one flame port which is adapted or especially provided such as to produce an oxygen-depletion-sensitive flame which is more sensitive to unacceptable oxygen depletion than the flames produced by the remaining flame ports and in a manner that can be detected by a thermocouple or other sensor, **and in which the at least one flame port is provided with additionally one or more adjacently located flame-influencing bodies, such that the flame produced by the port is responsive to said undesirable oxygen depletion or build up of said undesired gases in said manner that can be detected by said thermocouple or other sensor .”**

Claim 17

“A burner unit for a gas fire appliance or a gas burner for a gas fire appliance or a gas fire appliance incorporating a burner unit or gas burner as claimed in at least claims 1, 2 or 6, in which in addition to the presence of a thermocouple, the flame-influencing (flame retention) bodies comprise an electron spark-ignition device and/or other probes or bodies.”

The law

9 The application to amend and the opposition to it are made under section 27 of the Act, the relevant subsections of which are:

“(1) Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.

...

(5) A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.”

Evidence

10 Evidence filed on behalf of the proprietor comprises three witness statements by Michael Daniels, who has been employed as Development Manager by the proprietor. Mr Daniels has been involved in the development of gas appliances for approximately 40 years. Evidence filed on behalf of the opponent comprises a witness statement by Michael

Langton, who has been employed by the opponent as Senior Development Engineer. Mr Langton has been involved in the development of gas appliances for approximately 35 years.

- 11 As I understand it, both witnesses were put forward as expert witnesses. On the basis of their extensive experience in the development of gas appliances, I am content to accept that both are experts in the field of the patent. However, in many respects their evidence conflicts. That conflict is not something which I can resolve in circumstances where there has been no testing of the witnesses under cross-examination, and there is no corroboration of their opinions. Neither can it be said that one is more independent than the other. In this position, I shall draw what assistance I can from the expert evidence, while recognising there will be limits to how much that assistance can be.

What are the substantive issues to be considered and decided?

- 12 Form 11/77 refers to an attached letter for the reasons for the amendment request. That letter begins with an introductory paragraph, followed by the two paragraphs which I now quote:

“We advise that our request for amendment arises out of additional prior art being made available for the first time by the solicitors of Aeromatic Limited who are gas burner manufacturers and to whom the existence of the above patent has been drawn to their attention.

The prior art comprises Japanese Utility Model 6-22750 and we enclose a copy thereof and translation for the assistance of the Office and also copies of Japanese Specifications 61254486 (Publication 62098119A) and 61-111502 (Publication 62-268916) - copies enclosed herewith with translation.”

- 13 The next paragraph speaks about certain aspects of the amendment without explicitly giving a reason for them. The next paragraph is similar, but does say in relation to another aspect of the amendment (my emphasis added in italics):

“...This requested restrictive amendment is made *to distinguish the nature of the burner from the unit and appliance in which it is used from that of Japanese Utility Model 622750* which it is believed ...”

- 14 The implication of the letter is fairly clear it seems to me: the amendments are proposed in response to the proprietor becoming aware of the three Japanese documents. However, the letter does not explicitly say that the amendments are intended to cure a defect of lack of novelty or of inventive step, for example, although the reference to “distinguishing” might be thought to lead in that direction.

- 15 This might seem a trivial matter, but it assumes a much greater significance in the context of the submissions made by the proprietor in letters before the hearing. In its letter of 17 January 2003, the proprietor makes a number of assertions in this regard which I might summarise as follows:

C section 74(2) prevents validity being put in issue in proceedings under section 27

- C the Rules do not provide that the reasons for seeking an amendment should be given
- C on occasion, validity has been put in issue in section 27 proceedings via an indirect route on the basis that the requested amendments do not cure the defect which the proprietor had indicated as the reason for the amendment. The opponent has not argued this prior to the hearing, such grounds should not be admitted now, and they are not appropriate here anyway
- C to provide novelty and to strengthen the claims of a patent against an attack on the grounds of obviousness are valid reasons for requesting amendment
- C the effect of *Donaldson's Patent* [1986] RPC 1 is that objections of obviousness are to be excluded from consideration in opposition proceedings under section 27
- C the effect of *Smith Kline & French's (Bavin's) Patent* [1988] RPC 224 and *Minister of Agriculture's Patent* [1990] RPC 61 is that new grounds of invalidity and new documents, that is beyond the three cited by the proprietor, should not be considered
- C this exclusion of other documents extends to witness statements or other evidence
- C "In our letter of 17 September 1999, we simply stated the amendments were because of additional prior art being made available after grant and listed **only three** Japanese patent specifications. Also [in that letter] we also only indicated a specific amendment was to "distinguish" over JP 6-22750. "Distinguish" we submit may be from the point of view of novelty or inventive step and this interpretation is supported by case law."
- C the requested amendments strengthen the claims over the prior art against any attack on the grounds of obviousness, which is a (further) reason why objections as to validity on the ground of lack of novelty should not be entertained here
- C "...the amendments sought **distinguish** the claimed invention from the prior art ie strengthen against an obviousness attack. We submit that the claims as granted (and, of course, as proposed to be amended) are novel and inventive over the prior art. Further, reference is again made to *Donaldson's Patent* (1986 RPC 1) wherein it was held objections of obviousness, as distinct from covetousness (denied here), should not be considered in Section 27 amendment proceedings."
- 16 A number of these assertions were repeated by the proprietor in another letter a few days later.
- 17 The opponent's position in this respect by the time of the hearing can be more briefly stated by reference to the first two paragraphs of Mr Davis's skeleton argument, which read:
- "1. There is really only a single point for the Comptroller to decide in this matter: do the proposed amendments cure the defect?"

2. It is permissible for the tribunal to consider the validity of the newly filed claims over JP 6-22750 U, JP62-98119 & JP 62-268916 (“the JP prior art”) since it is the “defect” of invalidity in relation to these documents which has caused P’s application to amend (see *Smith Kline & French’s Patent*). If the amendments do not cause the Patent to become any more valid, then the correct course of action is to refuse the amendments.”

- 18 In fact, the opponent’s position up until the filing of that skeleton argument was not as narrow by any means. The statements of case had, in addition to the grounds covered by the first two paragraphs of Mr Davis’s skeleton, included grounds of opposition based on allegations of bad faith and covetousness, and had tried to bring in a large number of prior art documents in addition to the three identified by the proprietor. At the start of the hearing, I specifically asked Mr Davis to confirm that the proprietor was not pursuing those other grounds, and he did. I have no need to consider them further.
- 19 Even with that narrowing of the scope of the opposition, that still leaves questions around what issues I can and should consider and decide in these section 27 proceedings. There seems no dispute between the parties that the focus is on the three Japanese documents cited by the proprietor; the question is to what end. The implication of the proprietor’s assertions seems to be that these proceedings should in some way take account of those documents without considering issues of novelty or inventive step, and that this position is supported by precedent. I do not believe that is either tenable or correct, and shall explain why.
- 20 It seems to me the right place to start is that identified by Mr Davis: do the proposed amendments cure the defect? It is well established in case law under section 27, for example from *Smith Kline & French’s (Bavin’s) Patent* [1988] RPC 224 which the proprietor itself cited, that, to be allowable, proposed amendments must meet the defect they seek to cure, and may be refused in the exercise of the comptroller’s discretion if they do not.
- 21 What then is the defect the proprietor in the present case is seeking to cure? The proprietor has, it seems to me, been rather coy in this respect, and seems to be arguing that the opponent cannot oppose on grounds relating to validity because that has not been explicitly cited by the proprietor as the defect being addressed. This cannot I think be sustainable. If it were, opposition could simply be frustrated by applications to amend which listed prior art documents but said no more about them.
- 22 The proprietor’s somewhat oblique presentation of its reasons for amending can perhaps be understood better in the light of its assertion that the Rules do not provide that reasons for amending should be given. That may be so, but it is settled law that the effect of the word “may” in section 27(1) is that the allowance of amendments under section 27 is a matter for the discretion of the comptroller, and that favourable exercise of that discretion will be dependent on the proprietor making a full disclosure of all material matters. The reasons for making the application to amend are clearly a material matter.
- 23 Looking then at and behind the proprietor’s words, the purpose behind the present application to amend seems to me to be to distinguish the claims of the patent more clearly over the three Japanese documents cited by the proprietor in the amendment

application. As I have already noted, the language used by the proprietor points clearly in this direction, albeit that it does so neither clearly nor consistently.

- 24 This then begs the question of what “distinguish” means. The proprietor has asserted that the effect of *Donaldson’s Patent* [1986] RPC 1 is that objections of obviousness are to be excluded from consideration in opposition proceedings under section 27. In that case, which I note was decided under the Patents Act 1949, the opponent was seeking to mount an obviousness attack on the unamended and amended claims on the basis of prior art cited in the proceedings by the proprietor and by the examiner in the pre-grant proceedings. The key point, it seems to me, to be derived from *Donaldson*, and from *Great Lakes Carbon Corporation’s Patent* [1971] RPC 117 to which it refers, is that amendment proceedings should not permit an opponent to bring in objections relating to validity which are not related to the ground on which the amendment is being sought. Where the amendment application is launched by the proprietor in connection with, or to distinguish more clearly from, items of prior art he has identified, I believe that in exercising the comptroller’s discretion as to whether to allow those amendments, I should consider whether they do distinguish for novelty and inventive step. After all, the defect in the patent would remain if the amended claims were clearly not novel or were obvious in the light of the proprietor’s cited prior art. I think this conclusion fits the comment in the proprietor’s submissions about what “distinguish” means too.
- 25 At this point I should perhaps make clear that I do not accept Mr Davis’s submission that “if the amendments do not cause the Patent to become any more valid, then the correct course of action is to refuse the amendments.” Usually an application to amend prompted by prior art will be to cure some invalidity revealed by that art (even though proprietors may sometimes be reluctant to admit that in such clear terms). However, I see no reason why, within reasonable limits where new art may cast a shadow of doubt over a patent’s validity, a proprietor should not offer an amendment which while on a strict reading may not be absolutely necessary to confer validity, nonetheless serves to put validity on a clearer basis. If I need further support for this view, I would draw it from the fact that it must be in the public interest for patent monopolies to be clearly drawn, and such amendments would serve that interest by reducing the scope for argument or uncertainty about their validity.
- 26 The proprietor’s other argument in respect of entertaining validity questions is that section 74(2) prevents validity being put in issue in proceedings under section 27. I accept this in as much as section 27 is not mentioned in section 74(1) as being a provision under which validity may be put in issue. I do not, however, take this to mean that questions of validity cannot be considered when the comptroller is deciding whether or not to exercise discretion to allow a proposed amendment. Indeed, it is my view, on the basis of the case law, that the comptroller should do so when the defect being addressed arises from prior art. What I take the effect of the interaction between sections 27 and 74 to be is that proceedings under section 27 may not be allowed to develop into a roving enquiry into validity of the granted patent, nor may a finding of invalidity expressly flow from proceedings under section 27.
- 27 The final assertion made by the proprietor in this connection is that the effect of *Smith Kline & French’s (Bavin’s) Patent* [1988] RPC 224 and *Minister of Agriculture’s Patent* [1990] RPC 61 is that new documents, that is in this case beyond the three cited by the

proprietor, should not be considered. As the opponent is no longer attempting to rely on prior art other than that cited by the proprietor, I do not need to consider this point, except that the proprietor has asserted that this exclusion of other documents extends to witness statements or other evidence. It seems to me that this point is a fair one insofar as, but no further, that such evidence might be a way of introducing into the proceedings prior art beyond that brought in by the proprietor. Thus, I should make clear that I shall not be looking to the witness statements for evidence of the state of the art or what was the common general knowledge. However, I do think it is reasonable in the general case of section 27 proceedings for evidence to be admitted to assist the comptroller in other ways, for example as to the meaning of technical terms if it is expert evidence, or in establishing when certain events occurred if it is evidence of fact. In the present case, such questions of fact are not in issue, and the evidence is primarily of an expert nature. I shall therefore make use of it as an assistance in my task of construing the patent and the prior art as through the eyes of the notional skilled man.

- 28 In summary then, I see the proper task before me as being to consider whether the proposed amendments distinguish the patent claims more clearly over the three Japanese documents cited by the proprietor, and in the light of my conclusions to decide whether the comptroller's discretion should be exercised to allow the proposed amendments.

The relevant prior art: three Japanese documents

- 29 As I have established, in deciding the allowability of the proposed amendments, I need to consider them in the light of the prior art put forward by the proprietor in making the amendment request. This art comprises three Japanese documents. The proprietor has submitted that being Japanese documents they would not normally be considered by experts in the UK or Europe. However, as Mr Davis submitted, this is not the law. The Act places no geographical limitation on the field of prior art and I believe I should infer no hindrance to or hesitation by the skilled man in looking at the three patent documents based solely on their country of origin. The proprietor also sought to take a point over the verification and filing of the translations of the three Japanese documents, but I see no merit in it. With the benefit of hindsight, it seems to me there was some procedural confusion over the filing of verified translations. However, they were filed, and I am satisfied that they form a sound basis on which to work. With that, it is convenient briefly to review each of the three documents in turn.

- 30 Japanese Utility Model 6-22750 ("750") discloses a burner having a series of burner ports (4). At one burner port section, an oblique-angled notch creates an offset (h) which makes part of a flame (a) expand outwards to produce an oxygen depletion detection flame (b). The temperature detection tip (3) of a temperature detection sensor (2) (thermocouple) is inserted into the flame (b) and serves to close a gas safety valve if the flames are extinguished. The oxygen depletion flame (b) is projected into secondary air (c) which flows up the side of the burner. When the oxygen depletion flame (b) is burning normally combustion is enhanced by the secondary air flow (c). However, if combustion is incomplete because of oxygen depletion, the effect of the secondary air flow is to make the flame (b) lift earlier. A little before incomplete combustion occurs due to oxygen depletion, the secondary air flow (c), which contains a low level of oxygen, speeds up the lifting of the oxygen depletion detection flame (b) because the combustion speed falls (and flame (a) also lifts and forms the shape (a')). Then the temperature detection tip (3)

which is inserted in flame (b) ceases being heated and its temperature drops rapidly. 750 does not explicitly say in what applications or appliances the burner is intended for use. To that extent, I believe it is reasonable to infer that the burner is intended for general use. I do note that 750 does specifically refer to prior art problems associated with “gas water boilers etc”, but it is not clear to me that this implies a limitation on the burner it discloses. By comparison with the prior art, the device is said to be simple in structure and simple and cheaper to manufacture.

- 31 Japanese Specification 62-98119 (“119”) concerns a safety device in a burner installed inside a room, and relates to a combustion safety device in a burner such as an open heater installed inside a room, or a small instantaneous water boiler. A translator’s note suggests that in context the expression “open heater” probably means open in the sense that the flames can be seen, but it could also mean free-standing. Either way, the burner appears to be suitable for use in a range of gas appliances. The burner (6) has two groups (a) and (b) of burner ports (10). The burner ports of group (a) are shorter than those of group (b) so that the volume of gas per unit of surface area is greater at ports (a) than at ports (b). A shield (13) with an aperture (13a) makes one group of burner ports independent of the other. A thermocouple (9) is located with its sensor in the space between the aperture and the (a) group of burner ports. If the oxygen level in the room falls, abnormal combustion occurs at the (a) burner ports, whereupon its flames lengthen and eventually flames occur at the aperture (13a). When this happens, the thermocouple sensor ceases to be in contact with the flames, is cooled, and triggers shutting off of the gas supply. By comparison with prior devices, this device does not need a separate burner for detecting oxygen depletion, and is therefore a simpler structure.
- 32 Japanese Specification 62-268916 (“916”) relates to a combustion device which burns combustion air and fuel gas at a specified air-fuel ratio and is mainly concerned with instantaneous gas water boilers for household or business use. The burner (3) includes a combustion plate (31); an ignition device comprising a sparker (33); a safety device (7) which comprises a thermocouple (34) for detecting abnormal combustion; a thermocouple (35) for detecting the combustion temperature thus detecting the oxygen level within the flames (air-fuel ratio); and a combustion control device (9) comprising a solenoid valve. The sparker (33) and thermocouple (34) are fitted in an area where there is a lower excess air factor, and therefore where abnormal combustion caused by oxygen deficiency, eg because the level of oxygen in the room drops, occurs more rapidly and is immediately detected by thermocouple (34).

The skilled man

- 33 It is important that questions of construction, novelty and obviousness are approached through the eyes of the relevant skilled man. Mr Davis’s submission was that in this case the relevant skilled man would be a gas appliance engineer such as the proprietor’s witness. He added the observation that there seems to be no technical or commercial demarcation in this industry. The proprietor does not deal explicitly with this point, but I do not read its submissions as leading in a different direction. I am content to accept that as a fair description of the notional skilled man here.

Novelty

34 Mr Davis's submission was that all four of the independent claims as proposed to be amended boil down to three integers. While I accept that is largely right as a general proposition, there are small differences between the claims which it seems to me mean that the clearest way of approaching this matter is to consider each of the independent claims in turn, albeit that this may be a trifle long-winded.

Amended claim 1

35 The key elements of claim 1 as proposed to be amended are in my view:

- (i) a burner unit for a gas fire appliance
- (ii) a plurality of ports
- (iii) additional means to produce a flame more responsive by lift-off to oxygen depletion (or build-up of undesired gases) than the flames of the remaining ports *[sic]*
- (iv) the additional means (also) comprises other flame-influencing bodies

36 It is necessary and important for me at this point to consider several questions of construction of this claim. In doing so, I might comment that this claim and the others are not as clear as they might be, and Mr Davis made some points on that at the hearing. However, I believe that with appropriate effort and in a positive frame of mind, it is possible to construe them and for that reason I have not dwelt on the opportunities for picking holes in them.

Gas fire appliance

37 The first question is what limitation the reference to a *gas fire* appliance places on the claim. It is well established in case law that this "for" should be interpreted as meaning that the burner should be "suitable for" use in a gas fire appliance. Thus, I believe that disclosure of a burner which was suitable for use in a gas fire appliance would not be unallowable as an anticipation solely on the ground that it was not explicitly said to be for this use.

38 With the disclosure of the three Japanese documents in mind, this leads on to the question whether a burner of unspecified application, or one specified as being for a boiler, would have been considered by the notional skilled man as being suitable for use in a gas fire appliance. What does the expert evidence tell me? Mr Daniels, put forward by the proprietor, variously says in his first witness statement (my emphasis added in italics):

"... I confirm that burners designed for water heaters *tend* to be very highly aerated ... it appears that most of the burners shown in the Japanese patents are burners typical of water heaters or central heating boilers and that it is known that the higher the primary aeration, the hotter and more stable the flame."

"...a heat exchanger [in a water heater] is normally a hollow structure and has open areas ... If these open areas become blocked, the combustion of the flame is immediately affected. Therefore a very highly aerated flame is needed in water heaters to prevent the build-up of soot which would tend to block the heat exchanger ..."

“I also confirm that with a gas fire one does not employ maximum aeration of the burner because of the noise such creates. A water heater *may* be in a kitchen where noise *may* be acceptable. A gas fire is *normally* in a living room and users will not accept such noise. The burners of gas fire appliances therefore *normally* have smaller ports and the flame is *normally* stable and not prone to lift-off the burner ...

39 In effect Mr Daniels is implying that water heater burners would not be suitable for use in a gas fire appliance. However, he does not explicitly say so, and the generalising words he uses call into question the extent to which a burner suitable for use in a water heater or boiler would not also be suitable for use in a gas fire appliance.

40 Mr Langton’s evidence, put forward by the opponent, is rather different. In his witness statement, he variously says:

“I confirm the use of a burner unit having ... was employed ... within gas appliances generally including gas fires and water heaters specifically. As such, I confirm the apparatus and method used to detect incomplete combustion and to prevent premature shutdowns is the same in both such appliances. Whilst the flames generated in water heaters may be generally be [*sic*] higher aerated than those in gas fires, additional means are still required ...”

“... it is apparent to me that the patentees are attempting to establish distinctions between the operational characteristics of gas fire appliances and water heater appliances, their distinctions centring around aeration and flame stability. ... In short, the stability of a burner flame is dependent upon the operational settings of the burner unit specific to that appliance.”

“The operation of both gas fires and water heaters is a trade off between maximum aeration and noise. ... Such is common to both gas fire and water heater appliances which use and are usable with identical components differing only in an aeration setting, both operating between identical constraints of noise reduction and combustion efficiency.”

“... I confirm that soot deposition ... is as much of a concern within gas fire appliances as with water heater appliances ... - again, the technology is interchangeable between both fire and water heater applications.”

“... both burners operate in exactly the same way, using shared technology ...”

“Whilst ... the patentees attempt to distinguish water heaters from gas fires with regard to burner technology, ultimately, any such differences should only be considered as slight variations in operating conditions using identical burner technology.”

41 Thus, Mr Langton is in effect saying that water heater burners would be suitable for use in a gas fire appliance.

42 The evidence of the two experts is therefore directly conflicting on this point. The conflict is not something which I can resolve in favour of one or the other absent cross-

examination or corroboration. In this position, I believe what I must do is read the pieces of prior art and the patent in their own terms as best I can as though through the eyes of the skilled man.

Lift-off

43 I need also to consider carefully what is meant by the expressions “lift-off” or “lifting-off”. Their construction is key to understanding the scope of the claims, and hence the questions of novelty and inventive step of those claims as compared with the Japanese prior art. Although neither expression appears in the original late-filed claims, they do appear throughout the application as filed. Looking at those occurrences in more detail, page 1 at line 22 of the published application refers to the prior art ODS pilot and says:

“... the flame becomes unstable and the flame acting on the thermocouple ceases to act on such, possibly as a result of “lifting off”, with the result that ...”

44 At the end of page 2, the specification speaks of providing other flame-influencing bodies and says:

“...the possible provision of other flame-influencing (flame retention) bodies ... although this may not necessarily be essential but the proximity of such to the flame in question have been found to have influence on flame stability and lift-off etc.”

45 There is a simple use of the expression “lift-off” at line 10 of page 3, followed later in the same page by this description:

“... Thus since a burner may incorporate within its design an area ... such that in a reduced oxygen atmosphere, the flame will lift-off the burner.”

46 Finally, the sentence bridging pages 3 and 4 of the application reads:

“... The thermocouple will be located to be in the flame issuing from said at least one port but when the level of oxygen drops below an acceptable level the flame produced by the burner and said port will cease to act on the thermocouple (likely as the result of “lifting-off”).”

47 I turn now to what the two expert witnesses say on this point. Michael Daniels, the proprietor’s witness, refers in his first and second witness statements to lift-off but does not explain precisely what he means. In his third witness statement he says:

“Examples of the effect on the characteristics of the flame include: that the flame may “lift-off” the port and cause the sensor to cool; the cone of the flame may “elongate” such that the sensor lies in the cool area of the inner cone (such as typically occurs in highly-aerated water heater burners); or the flame may become “soft” and be capable of being deflected away from the sensor by air currents. Many of the prior art documents relied upon by the Opponents and referred to by Mr Langton rely on characteristics other than “lift-off” to effect cooling of the sensor.”

48 Michael Langton, put forward by the opponent, in paragraph 2 of his witness statement differentiates two occurrences of lift-off in these terms:

“... The first of these phenomena is the lift-off effect of flames observed during “normal” operation and resulting from an oxygen depleted environment (a vitiated atmosphere), and the second is premature lift-off which occurs following an initial start up or ignition of the gas appliance.”

49 In paragraph 9 he states that “... too high an aeration will result in the flame lifting-off the burner resulting in the appliance shutting down.”

50 However, nowhere does Mr Langton define what lift-off is. Mr Davis’s submission at the hearing was that lift-off was flame instability of the type where the ignited part of the flame detaches itself from the burner and rides up.

51 I am not sure how much the expert evidence helps me in terms of defining what “lift-off” as used in the patent means. Mr Daniels comes the closest, insofar as he appears to differentiate “lift-off” from “elongation” and from a “soft” flame. On this basis, it seems to me that the natural meaning of the term in the patent is the one which the skilled man would take. That is to say, the plain language of the references to lift-off or lifting-off in the application as originally filed would suggest to him a phenomenon whereby the flame (by which I mean the zone where the gas is actually burning, but including the inner non-burning cone) lifts above the burner so that there is a gap between the base of the flame and the burner or port from which the gas is issuing.

52 I think this construction is in line not only with Mr Davis’s submission but also with the proprietor’s submission at pages 2 and 3 of its letter of 17 January 2003. At page 5 of that letter, the proprietor goes on to differentiate this “true lift-off” from other effects whereby a flame might be lifted off or away from a thermocouple. Such lifting of a flame off or away from a thermocouple, it is submitted, might occur through flame-softening or deflection by side draughts, and is different from true lift-off of the base of a flame from the port of the burner. Mr Davis argued that this more detailed explanation of “lift-off” was not supported in the application for the patent as filed. I do not agree, and am prepared to regard “lift-off” in the sense used in the patent as a different effect from flame elongation or softening. That said, I do not exclude the possibility that those other conditions, of flame elongation or softening, may not be accompanied by “lift-off” in the sense I have construed it.

Can the flame-influencing body be a thermocouple?

53 I need also to consider whether the flame-influencing body of (iv) can be a thermocouple. Mr Davis’s submission was that it can be and is. He referred me to page 2 of the application as published and to claim 4 of the granted patent in support. The proprietor disagrees, and points out that the relevant text is deleted by the proposed amendments. The opponent responds that patent construction requires a reading of the patent document itself, without an exhaustive study of pre and post grant amendment behaviour. I believe this latter view is right. The expression “other flame influencing body”, whether or not qualified by the words “flame retention” in parentheses, on a fair reading in the context

of claim 1 does not exclude a thermocouple placed in a position where it influences the flame. Claim 17 as proposed to be amended seems also to fit with this interpretation.

54 With these points of construction in mind, I turn now to consider the novelty of claim 1 as proposed to be amended in the light of the three Japanese specifications in turn, bearing in mind also the brief summaries of their disclosures I have given earlier in this decision.

55 Taking first 750, it seems to me that there is disclosed a burner having a series or plurality of ports. The burner is not said to be limited to a particular use, and I believe the skilled man would not read it as excluding or being unsuitable for use in gas fire appliances. For reasons I have already explained, I do not accept the proprietor's view that this burner would not be suitable for use in a gas fire appliance, and I would say that it is. It seems to me that additional means is provided in the form of a notched port which produces a flame (b). In saying this, I note the proprietor's submission to the contrary, but can see no reason why the notched port cannot be read as being the additional means in the terms of claim 1. In this respect, I accept Mr Davis's submission that "additional" as used in the claim introduces only a very slight limitation. The flame (b) is clearly said, in conditions of oxygen depletion, to lift earlier due to the effect of secondary air flow. Thus, it is more responsive to lifting than the main flame (a). The proprietor makes a point that the flame (a) also lifts, and that is correct. However, it does not negate the fact that the flame (b) lifts earlier and hence is more responsive. The next question is whether this lifting, of which 750 speaks, is the same as the "lift-off" specified in the claim. I have read the specification of 750 in translation very carefully and as a whole, and I have concluded on the balance of probabilities that it is the same form of lift-off. Finally, I see in 750 one additional flame influencing body in the form of a thermocouple situated in that flame (b). However, amended claim 1 clearly speaks of "bodies" in the plural. I think Mr Davis was arguing that the secondary air flow also counted as an additional integer, but I would not read it as meeting the terms of the claim. To the extent that 750 lacks a second flame influencing body, I do not regard amended claim 1 as lacking novelty in the light of 750.

56 Looking next at 119, there is disclosed: a burner having a plurality of ports; additional means in the form of a sub-group of ports (a) which are shorter than the rest and whose flames are more sensitive to oxygen depletion; and other flame-influencing bodies in the form of a thermocouple and a shield. The proprietor submits that "true lift-off" is not exhibited in the operation of the burner of 119. However, it is clearly said in the specification of 119 that:

"... if the oxygen level in the room falls, abnormal combustion occurs at the "a" burner ports where the load is greater - first the flames lengthen, and eventually combustion flames occur at the aperture (13a). When this happens, the thermocouple sensor, the heat contact, not only ceases to be in contact with the flames, it is also cooled by the mixed gas supplied by the "a" burner ports group, and the electromotive force (output) from the thermocouple falls rapidly."

57 Mr Davis's view was that this passage from 119 is saying that the ignited part of the gas only occurs above the plate (13) and there is a non-ignited part between plate (13) and the burner port; that is, the flame has lifted off from burning immediately at the burner to a higher position.

58 I too understand this passage to be a description of an effect which meets the definition of lift-off which I elaborated earlier. Oxygen depletion causes the flames to occur at the aperture in the shield - in effect, to lift off. That flame elongation also takes place does not in my view mean that lift-off does not. Finally, the burner of 119 is said to be installed inside a room, such as in an open heater. This I believe meets the “gas fire appliance” requirement. Accordingly I regard amended claim 1 as lacking novelty in the light of 119.

59 Turning to 916, there is provided a combustion device burner of a different construction. The proprietor argues that it does not have a plurality of ports. Despite Mr Davis’s assertion of the presence of ports, I have some sympathy with the proprietor’s view. A gas/air mixture is fed via two routes, one of which involves a mixture with a smaller excess air factor going through a branch gas supply pipe (84). This latter mixture is said to be expelled through small holes on the periphery (36) of a combustion plate (31). However, I do not regard the apertured combustion plate as constituting a plurality of ports. I would regard there to be additional means in the form of the branch gas supply pipe(84) which produces a flame which has a smaller excess air factor, and hence is more susceptible to abnormal combustion; and additional flame-influencing bodies in the form of a thermocouple and a sparker. If there is a deficiency of oxygen, then “abnormal combustion” is said to take place, and the effect is registered by a thermocouple, but it is not clear to me what form the abnormal combustion takes. Mr Davis took me to Mr Langton’s evidence where he suggests abnormal combustion in 916 would be manifested by lifting-off. However, it is for the tribunal to construe the documents, of course taking account of expert evidence as to the meaning of technical terms. For my part, I am not persuaded there is a disclosure of “lift-off” in 916; it is silent on that point, and it is too much I think to infer lift-off from that. The burner is said to be mainly concerned for use in instantaneous gas water boilers, but as I have said I am not persuaded this makes it other than suitable for use in gas fire appliances. Nonetheless, for reasons related to the non-disclosure of a plurality of ports and of lift-off, I do not regard amended claim 1 as lacking novelty in the light of 916.

Amended claim 2

60 The key elements of claim 2 as proposed to be amended are in my view:

- (i) a burner for a gas fire appliance
- (ii) a plurality of ports
- (iii) at least one port which provides a flame more responsive by lift-off to oxygen depletion (or build-up of undesired gases) than the others
- (iv) the at least one port is provided with one or more adjacently located flame-influencing bodies

61 The claim also refers to the lift-off being “in a manner that can be detected by a thermocouple or other sensor”. The question which then arises is whether the thermocouple or other sensor is an essential part of the apparatus being claimed in claim 2, or whether that apparatus merely needs to be capable of working with a thermocouple. Claim 7 helps provide the answer. That claim provides an apparatus “including a thermocouple”. Since claim 7 is appendant to claim 2 (among others), the logical inference must be that the thermocouple is not an essential feature of claim 2.

62 On this construction, it seems to me that 119 anticipates amended claim 2 for the same reasons as it does claim 1. Moreover, 750 seems to me to anticipate amended claim 2, as this claim, unlike amended claim 1, requires the presence of only one flame-influencing body, which requirement is met by the thermocouple. As regards 916, it is not clear that at least one different port is provided, which accumulated with the differences already noted means that I do not believe it anticipates amended claim 2.

Amended claim 15

63 The key elements of amended claim 15 as proposed to be amended are in my view the same as those of amended claim 2. My conclusions in relation to that claim therefore apply to this one too.

Amended claim 16

64 The key elements of claim 16 as proposed to be amended are in my view:

- (i) a gas fire appliance
- (ii) a burner having means sensitive by lift-off to oxygen depletion other than a separate ODS pilot
- (iii) a plurality of ports
- (iv) the sensitive means comprising at least one port which provides a flame more responsive by lift-off to oxygen depletion than the others
- (iv) the at least one port is provided with one or more adjacently located flame-influencing bodies

65 The logic which applied to amended claims 2 and 15 also applies here, but with the important difference that the burner must be provided as part of a gas fire appliance, and not merely be suitable for use in one. On this basis, I believe the claim is anticipated by 119, which speaks of a burner installed in an open heater, but not by 750 or 916 whose applications are not specifically in gas fire appliances, and which do not therefore disclose them.

Inventive step

66 On one view, having made a finding that all four independent claims lack novelty over at least one of the three Japanese documents, I do not need to go on to consider obviousness. I shall, however, do so, in case my view on novelty is wrong.

67 As Mr Davis reminded me at the hearing, the well-established approach to obviousness is the stepwise one laid down in the case of *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59. The *Windsurfing* process is set out by Oliver LJ at page 73 as follows:

“There are, we think, four steps which require to be taken in answering the jury question. The first is to identify the inventive concept embodied in the patent in suit. Thereafter, the court has to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was,

as that date, common general knowledge in the art in question. The third step is to identify what, if any, differences exist between the matter cited as being “known or used” and the alleged invention. Finally, the court has to ask itself whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to a skilled man or whether they require any degree of invention.”

68 The first step for me therefore is to identify the inventive concept embodied in the patent. For these purposes, it is clear that all four claims share the same inventive concept, which I would summarise as follows:

- (i) a burner for a gas fire appliance
- (ii) a plurality of ports
- (iii) means (eg at least one port) which is part of the burner and provides a flame more responsive by lift-off to oxygen depletion than the main flame
- (iv) one or more additional flame-influencing body.

69 The next step is to assume the mantle of the skilled but unimaginative addressee at the priority date, imputing to him the relevant common general knowledge. It is generally the case that expert evidence is helpful, if not absolutely essential, to negotiate this step with confidence. The expert evidence before me is, as I have commented, rather split. However, I have already said that I am prepared to regard the relevant skilled man as a gas appliance engineer, and I will impute specialist knowledge to him accordingly.

70 The next step is to identify what, if any, differences exist between the matter cited as being “known or used” and the alleged invention. In the present case, this means comparing the Japanese prior art with the inventive concept of the claims as proposed to be amended. And finally I must consider whether those differences would have been obvious to the notional skilled man.

71 Taking those last two steps together, my view is that while 916 provides feature (iii), though not as a different port, and also feature (iv), it does not have a plurality of ports, and in that sense it is a different sort of burner from the inventive concept of the patent. As I have already explained in relation to novelty, 750 and 119 each provides features (ii), (iii) and (iv). Also, to put it at its lowest, both disclose burners which are not unsuitable for use in gas fire appliances. As I have already explored in reference to the expert evidence, it seems to me that the technologies of burners for gas fires, room heaters and gas water boilers are very similar and would all be available to a skilled gas engineer, the notional skilled man in this case. Accordingly, I consider that it would be obvious to the skilled man to try using either of these two disclosed burners in a gas fire appliance. I conclude therefore that even if I am wrong on the question of novelty, the independent amended claims are all lacking in inventive step in the light of each of 750 and 119.

Added matter

72 Mr Davis tried at the hearing to take a number of added matter points. Correctly, he pointed out that the application as filed did not contain claims, and hence that the original disclosure was correspondingly narrow. For example, he tried to mount an attack on the expression “flame-influencing (flame retention) bodies” introduced into the proposed

amended claims. I have considered these points carefully, but am not persuaded they are made out. The original application, although short, contained a number of options for the burner integers which provide, I believe, support for the proposed amendments. In any event, this line is a secondary one to the other grounds which I have already found militate against allowing the amendments.

Request for further amendments

- 73 In a letter dated 17 January 2003 the proprietor made a late request to make further amendments beyond those originally requested under section 27. These would involve the insertion of “(flame retention)” before “bodies” in claims 1, 12, 14 and 16 as proposed to be amended for the purpose of consistency. The request was for the amendments to be entered immediately. That I have not included this further amendment in the form of claim I considered above is simply for clarity and convenience in this decision. The conclusion I have reached would be unaffected by this further amendment, since it is clear that the bodies disclosed in the Japanese documents as being flame-influencing would in practice equally be flame-retaining, in precisely the same way as they are in the proposed to be amended claims of the patent.
- 74 A request was also made in section 10 of the same letter for yet “further possible amendments conditional upon an adverse finding”. Essentially, that request was for “one or more of” five different lines of possible amendment. The proprietor also indicated that should the decision be unfavourable to it, it “would respectfully request other further opportunity to modify the requested amendments as might be possible to overcome any remaining objections”. A further conditional amendment request was contained in the proprietor’s letter of 23 January 2003.
- 75 At the hearing Mr Davis objected to these auxiliary amendment requests on the grounds that they were submitted too late and were unclear. I tend to agree. The possibilities for further amendment which the proprietor put forward are just that: possibilities. No clearly formulated wording is offered, just a vague menu of options. With respect to the request for a further opportunity to submit amendments conditional upon an unfavourable decision, I am not minded to allow it. The onus is upon the proprietor in section 27 proceedings to offer amendments which overcome the defect it identifies. In this case it has offered a set of amendments which has fallen short of doing that. In its letters, it has tried to keep the door open, but in a way that did not seem very focused. If it had wanted an opportunity to offer real alternative amendments it could have done so already. For these reasons, I refuse the proprietor an opportunity to submit modified amendments in these proceedings.

Should I make a finding on validity?

- 76 At the hearing the opponent indicated that it was keen to receive a finding on the issue of validity. As I have already indicated, I believe the law is clear on this point. Section 74(2) prevents validity as such from being put in issue in amendment proceedings under section 27. The purpose of these opposed section 27 proceedings is to decide whether proposed amendments should be allowed. Its purpose is not to decide on the validity of the patent. My decision must reflect that fact.

Conclusions

77 In summary, having considered all the evidence and argument before me, I am not persuaded that the proposed amendments would distinguish over the prior art brought forward by the proprietor as its reason to amend. Since the proposed amendments would not therefore cure the defect being addressed, I refuse to exercise the comptroller's discretion to allow the request to amend the patent.

Costs

78 Both parties have asked for an award of costs. Costs in proceedings before the comptroller are usually awarded to the successful party on a contributory basis derived from a published scale. I see no reason in the present case to depart from that standard practice.

79 In considering the costs award to make, I do not need to consider the costs associated with the preliminary decision as they were dealt with then. In awarding costs to the opponent as the successful party, I believe I should consider tempering them to take account of the fact that the opponent raised in its opposition a number of grounds which it dropped only just before the hearing. More than that, the opponent attempted to bring into consideration a significant number of additional prior art documents which again it dropped just before the hearing. There is no doubt in my mind that these actions will have raised the level of expense for both parties materially above the level at which they might have been. That is not to say that it was not welcome that the proprietor did narrow its case, as that saved costs at the hearing, and I would not want any costs award to deter such narrowing as this in the future. It is simply that further savings would have been possible had it done so earlier.

80 With these considerations in mind, I order the proprietor to pay to the opponent £1200 as a contribution towards its costs. This sum should be paid within seven days after the expiry of the period for appeal against this decision, except that if an appeal is lodged, payment is suspended pending the outcome of the appeal.

Appeal

81 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal against this decision must be filed within 28 days after the date of this decision.

S N DENNEHEY

Director, acting for the Comptroller