

OPINION UNDER SECTION 74A

Patent	EP(UK) 0801532
Proprietor(s)	Mr Jeremy David Lenighan
Exclusive Licensee	
Requester	Mr Martin Hyden, on 19 February 2008
Observer(s)	
Date Opinion issued	16 May 2008

The Request

1. The Comptroller has been requested to issue an opinion as to whether European Patent numbered EP 0801532 ('the patent') in the name of Jeremy David Lenighan is invalid, particularly in relation to patents US 3783456, GB 2264233, US 3896508, US 4891850, US 5231707 and EP 0204321.
2. The patent has been the subject of two previous opinions (02/05 and 27/06) requested by the patentee, but these were both primarily concerned with the question of whether the patent was infringed as well as being concerned with validity.

Observations

3. Observations were filed by Messrs Bailey Walsh & Co.

Observations in Reply

4. Observations in reply were filed by the requester.

The Patent

5. The patent was filed on 10th April 1997 being derived from a Patent Cooperation Treaty application PCT/GB/02717 which in turn claimed priority from GB patent application GB 9423451.5 filed on 21st November 1994. The patent is in force and was so at the time of the request.

6. The patent relates to a bath and shower screen assembly wherein the shower screen can be swung between an in use position 28B in which the screen engages an internal step on the bath to prevent water from spilling over the side of the bath and a stowed position 28A in which it is clear of the side of the bath. The screen can comprise a single panel or two or more panels hinged together, as shown below.

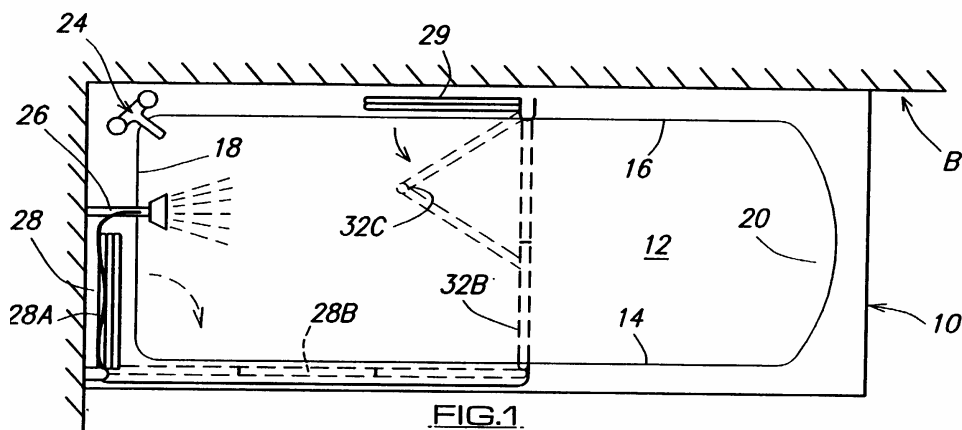


Figure 1 of the patent

7. There are six claims, claims 2 to 6 being appendant to claim 1 which reads as follows:-

“A bath and shower screen assembly wherein the shower screen 28 comprises a single front panel or two or more front panels hinged together, and wherein the shower screen 28 is pivotally mounted relative to the bath 10, so that the screen can be swung from an in use position in which it is over the front side 22 of the bath 10 but is prevented from being swung outwards over said front side 22, and prevents water from a shower from spilling over said front side 22 of the bath 10, and a stowed position in which the screen is clear of said front side 22, and wherein the front side of the bath 10, at least in the location of the bottom of the screen 28 when it is in the in use position, is internally stepped and defines a shoulder 36, characterised in that the shoulder is engaged by the bottom edge of the screen 28 in the in use position, so as to hold the screen 22 in said in use position.”

Should the Opinion be issued at all?

8. Before I can fully consider the requester's arguments in relation to the prior art, I must consider whether that prior art is admissible as regards whether it has previously been considered in proceedings. The law in this respect is as follows:-

Section 74A, subsection (3) of the Patents Act states that "The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so –

in such circumstances as prescribed.."

And in giving the "circumstances as prescribed" rule 94(1) states:-

"94.—(1) The comptroller shall not issue an opinion if—

- (a) the request appears to him to be frivolous or vexatious; or
- (b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.

9. This is clearly intended to avoid opinions which repetitiously challenge or check the proceedings in previous patent applications or in previous litigation relating to the patent on the same grounds as those used previously. To my mind the "relevant proceedings" would clearly also encompass earlier opinions in relation to the patent.
10. The observer therefore thinks that the comptroller should decline to give an opinion at all, saying that all of the documents cited by the requester have been considered before either in the International Preliminary Examination Report ('IPER') or in the previous opinions. He also thinks that the request is frivolous because the requester has had already had the opportunity to comment on validity in the previous opinions.
11. In particular, the observer says that the new document cited by the requester and on which a major part of their arguments rely, US 3783456, is not really new at all as it was cited against US 3896508 (amongst others) and therefore that the EPO would have found this document in their role as International Search Authority (ISA) when conducting the prior art search in relation to the patent. The observer also says that the ISA would have dismissed US 3783456 as irrelevant as it is a more remote piece of prior art, relating to sliding rather than pivotable shower doors.
12. I note that US 3783456 does not appear in the list of references cited on the front page of the published specification of US 3896508, but it may have indeed been cited subsequently by the US examiner. Although the requester has not apparently given me evidence to this effect, his

assertion that US 3783456 was cited in proceedings relating to US 3896508 in this respect is not directly challenged by the requester, so I take it to be so.

13. Does this mean however that the ISA examiner must have looked at US 3783456 when carrying out the prior art search in relation to the application for the patent as contended by the observer? I can see that it is certainly possible, but I certainly cannot be sure, that the ISA examiner would have considered US 3783456. On the balance of probabilities I therefore think that US 3783456 must be considered a new citation and I do not think I can therefore decline to give an opinion on the assumption that US 3783456 has been considered in earlier proceedings.
14. As regards whether the request is frivolous, it is indeed unfortunate that the requester did not include US 3783456 when considering the earlier requests for an opinion on the validity of this patent. Although the proprietor has requested that this request be refused in this respect, having considered the matter carefully it has been decided on balance to allow this request.
15. As regards the other documents relied on by the requester, however, namely GB 2264233, US 3896508, US 4891850, US 5231707 and EP 0204321. These have all clearly been a part of earlier proceedings, either with regard to the IPER or with regard to the earlier opinions. In particular, I note that the requester's case as regards inventive step relies on GB 2264233 as the closest prior art, putting that forward as evidence of the state of the art. This document was considered in depth in opinion 27/06 as the best evidence of the state of the art. In as far as any inventive step can be considered in relation to US 3783456, however, I think that it is a new question in terms of rule 94(1)(b), and therefore that I can give an opinion in this respect. As regards the documents previously considered in the search and examination procedure and in the earlier opinions, however, i.e. US 3896508, US 4891850, US 5231707 and EP 0204321, I decline to give an opinion as they have been amply considered already in relation to both novelty and inventive step.
16. I therefore conclude that it is appropriate for me to give an opinion as regards the validity of the patent, but only in respect of novelty and obviousness as regards US 3783456 in relation to GB 2264233 as representing the state of the art.

Claim Construction

17. Before I can determine whether or not the patent is valid, the scope of the claims must be determined as to whether the product falls within that scope and whether the claims are novel and inventive. In accordance with

section 125(1), the protection of the claims is determined as that specified in a claim as interpreted by the description and any drawings.

18. The standard principles of claim construction were set out by Lord Hoffmann in *Kirin-Amgen and others v Hoechst Marion Roussel Limited and others* [2005] RPC 9 (see paragraphs 32-52). You must put a purposive construction on claim 1, interpret it in the light of the description and drawings as instructed by section 125(1) and take account of the Protocol to Article 69 of the EPC. In summary then, you must decide what a person skilled in the art would have understood the patentee to have used the language of the claim to mean.
19. I take the person skilled in the art in this respect primarily to be a designer of bath and shower assemblies, although I could equally take them to be a designer just of shower screens as they would anyway have to have intimate knowledge of bath design and construction, given the use to which such screens are put.
20. The claim states that the screen is pivotally mounted “so that the screen (28) can be swung from an in use position in which it is over the front side of the bath”. Thus far I think the skilled man would think it clear that the screen is positioned above at least a part of the front side of the bath. The claim then goes on however “..but is prevented from being swung outwards over said front side”. Somewhat unfortunately perhaps, the word “over” is here used in a different sense, but I think it would be clear to the skilled person, guided by the patent specification, that these words qualify the swinging of the screen over and beyond the front side of the bath.

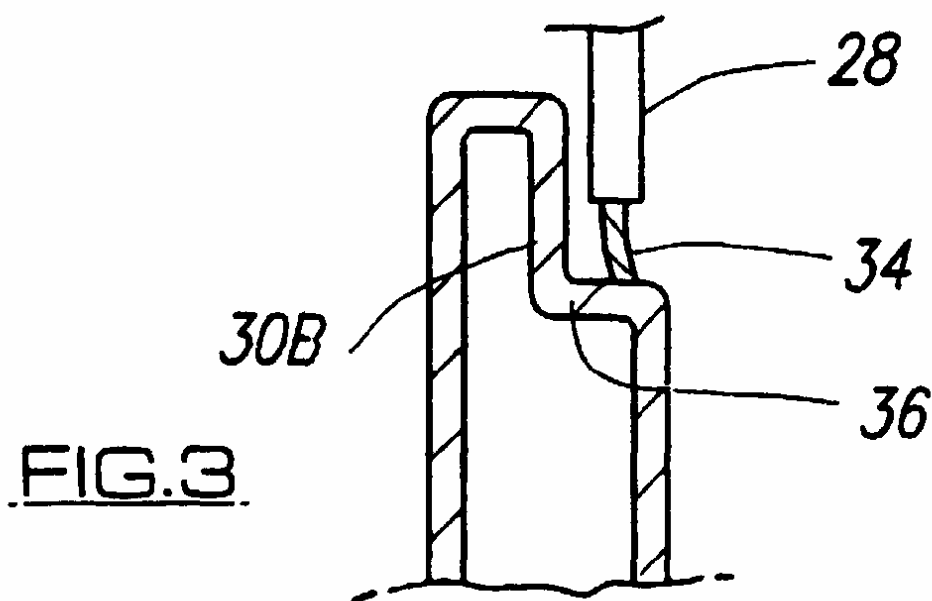


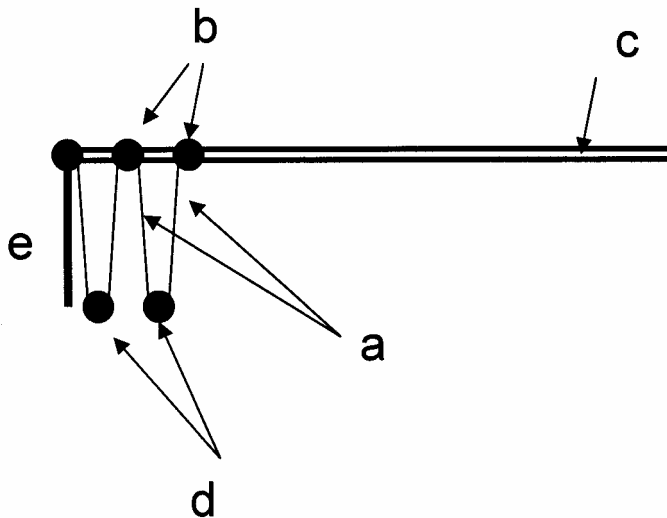
Figure 3 of the patent

21. The claim then goes on to say that the front side of the bath, at least in the location of the bottom of the screen when it is in use, "is internally stepped and defines a shoulder". At first sight interpretation of this is straightforward, but the description uses rather different language in referring to the bath having "rebates or recesses to accommodate the lower edges of the panels" and figure 3 in particular refers to "the shoulder 36 of the recess 30B". I think the skilled man would therefore conclude that the side of the bath is stepped and that the "shoulder" is simply an upward facing surface formed at a lower part of the step.
22. Furthermore the characterizing part of the claim states that the shoulder is engaged by the bottom edge of the screen in the in use position, "so as to hold the screen in said in use position". This is somewhat confusing as in the embodiment the screen is not apparently held against any inward motion away from the shoulder other than by the friction of the seal 34. I therefore conclude that the skilled person, using a purposive construction from the rest of the claim, would interpret this only in that the screen is held in the sense of being prevented from swinging out over the front side of the bath.
23. The requester emphasises the meaning of the word "prevented" in the phrase "so that the screen can be swung from an in use position in which it is over the front side 22 of the bath 10 but is *prevented* from being swung outwards over said front side 22" in claim 1. He says that the word "prevented" could potentially have two meanings, i.e. that the action could be absolutely stopped or could just be inhibited. The observer however argues that the specification clearly refers only to the former, more restricted interpretation that the swinging over and beyond the front side of the bath is absolutely prevented. I agree with the observer in this respect as I think that without any indication to the contrary the skilled person would only take the literal and more restricted meaning of the word "prevented", such that any swinging over and beyond the front side of the bath is absolutely prevented.

Novelty

24. The request includes copies of the various patents referred to as relevant prior art, i.e. US 3783456, GB 2264233, US 3896508, US 4891850, US 5231707 and EP 0204321. As I have declined to give an opinion as regards these previously considered documents, I will only refer to the case for novelty and obviousness set out by the requester in relation to US 3783456, except in as far as the requester's case necessarily also involves GB 2264233 as the closest prior art.

25. Firstly, as the requester points out, US 3783456 was published on 8 January 1974, well before the priority date of the patent, so it certainly forms part of the state of the art for the patent.
26. US 3783456 is primarily concerned in its embodiment with a pair of sliding doors for a shower or tub, tub being the well-known American term for what we would call a bath. Its single independent claim refers to “a pair of overlapping doors”, but, as the requester points out, US 3783456 contains a passage (column 1, lines 39 to 45) that says “my invention can have application to other closures besides sliding doors, such as accordion doors or shower curtains, and the above observations more or less apply to accordion doors”.
27. The requester then goes on to postulate how an embodiment of US 3783456 with accordion doors might look, and has provided a diagram as reproduced below.



Requester's impression of what US 3783456 would look like as an accordion door

28. The requester argues that such an embodiment would meet all of the features of claim 1 of the patent, in particular that there are two or more panels hinged together, the screen is pivotally mounted relative to the bath, and that the panels are clear of the front side in the stowed position.

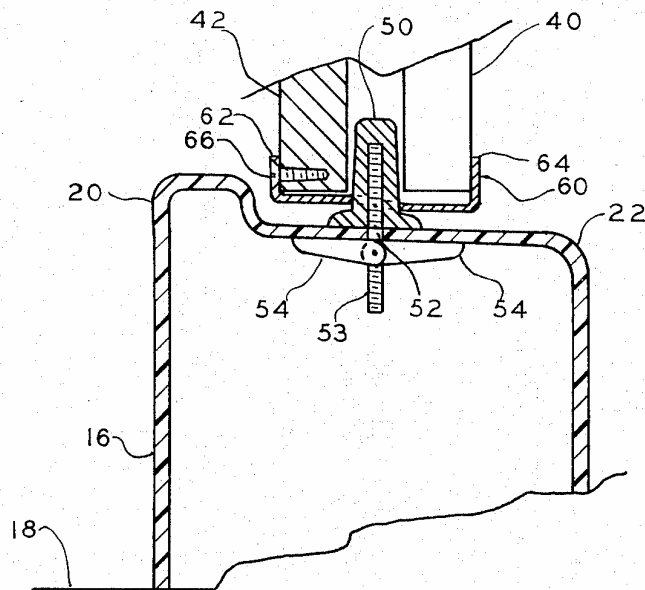


figure 2 of US 3783456

29. He then argues in relation to figure 2 of US 3783456 as reproduced above that the remaining features of claim 1 of the patent are known, that is, the rib 20 of the bath has a stepped construction, the bottom edge of the door is in use over the rim 20, the door is prevented from being swung over (and beyond) the rim, and the rim prevents unwanted egress of water by the pin 50. Although the pin 50 may not at first sight look like a shoulder, the requester maintains that it "constitutes part of the upward facing rim 22 below the top level of the rib 20 and so corresponds to the shoulder of the claim". The requester then goes on to say that the shoulder (pin 50) is therefore engaged by the bottom edge of the screen (door 40) and it clearly serves to hold it in the in use position and so satisfies element G of the claim (i.e. that the shoulder is engaged by the bottom edge of the screen 28 in the in use position so as to hold the screen 22 in the in use position).

Accordion Doors

30. The requester argues that the claim merely states that the screen is "pivotally mounted relative to the bath 10" and therefore that accordion doors fall within this phrase as there is no restriction in terms of other modes of movement, i.e. sliding and/or swinging. I agree with the

requester as the innermost panel of the accordion door, i.e. that closest to the end of the bath, must be pivotally mounted on the bath, so it is also pivotally mounted relative to the bath.

31. The observer, however, says however that an accordion door as understood in the art would be a folded continuous panel and therefore could not qualify as “a single front panel or two or more front panels hinged together” as required by claim 1, citing US 3500481 as an example of such a screen construction. I do not agree with the observer here as I think the skilled person would think that an accordion door could be either of a folded continuous panel or discrete panel subsections hinged together, i.e. both alternatives would fall within the words of the claim.
32. The requester continues that the folded back position of the accordion screen is such “that the screen can be swung from an in use position and a stowed position in which the screen is clear of said front side 22”. The observer however points out that even in the diagram of a possible accordion embodiment provided by the requester, the panels of the accordion arrangements are not clear of the front side of the bath. Although I agree with the observer that the panels are not totally clear of the front side in the diagram, in practice I think that they would be folded back so as to be substantially parallel to each other, so that they would be predominantly clear of the front side of the bath.

Screen Swinging

33. The requester says that the pin 50 shown in figure 2 of US 3783456 corresponds to the shoulder of the patent and therefore that the shoulder (pin 50) is engaged by the bottom edge of the screen (door 40) and serves to hold the screen in the use position as required by claim 1. The observer however says that the pin 50 is a separate member, is not part of the rim 22 and is upstanding from it. The observer also points out that the sliding doors of US 3783456 are guided primarily by the rail from which they are hung and therefore that they cannot swing about a vertical axis, as in the embodiment of the patent. This means that the rib 70 only prevents swinging about a horizontal, not a vertical, axis.
34. I note in this respect that claim 1 of the patent merely states that the swinging is prevented and is unfortunately not precise about which axis the swinging occurs. At first sight the skilled addressee would certainly assume that the swinging would occur about a vertical axis as in the embodiment, but I think that detailed analysis of the scope of the claim does not preclude swinging about a horizontal axis alternatively.
35. In my view, however, pin 50 itself is certainly not a shoulder as that implies a significant extent longitudinally of the bath/shower front side, which

discrete pins do not have. If there is a shoulder disclosed in US 3783456, it can only be rim 20 and therefore in the strictly literal sense the shoulder of US 3783456 is not engaged by the bottom of the screen. The requester says that the pin 50 “corresponds to the shoulder of the patent” which implies a functional equivalence, but I don’t think the pin 50 acts in the same way as it would primarily be a guide for the bottom edge of the screen, as the accordion screen moves in a fundamentally different way to that of the patent.

Summary re novelty

36. I therefore conclude that claim 1 of the patent is novel over US 3783456 as US 3783456 does not have a shoulder which is engaged by the bottom edge of the screen 28 in the in use position, so as to hold the screen 22 in the in use position, as required by claim 1. As the remaining claims are all appendant to claim 1, they must also be novel.

Inventive Step

37. In *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588, Jacob LJ restated and elaborated upon the Windsurfing approach, so to determine if there is an inventive step I shall use the Windsurfing/Pozzoli approach as set out by Jacob LJ at paragraph 23:-

1)(a) Identify the notional “person skilled in the art”

(1)(b) Identify the relevant common general knowledge of that person;

(2) identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

38. The skilled person is in my view primarily a designer of shower and bath assemblies, although I think they could also be the designer of either baths or showers alone.

39. The common general knowledge imputed to the skilled person would

include the shower screens and baths available at the filing date of the patent, which is now thirteen years ago. I have no particular evidence before me to guide me as to what was common knowledge at that time other than the patent specifications furnished by the requester many of which, as discussed, above, I do not think that I should discuss all in detail as they have already been considered in the prosecution of the patent application and/or in the earlier opinions. As I said in the earlier opinion 27/06, to my knowledge pivoting or folding screens which seal against an upper surface of the bath and fold back against a wall were known at the priority date and this is confirmed by the patent specification (paragraphs 0005-0006) which discusses existing panels which are "rigid and which can be stacked by folding or sliding and may be hinged away to a stored position in which they lie parallel to an adjacent wall of the bathroom in which they are used." On the other hand from my knowledge baths with a stepped side were not in common use at this time. I therefore conclude that the skilled addressee would have known of folding panels but not of baths with a front side which is stepped and shouldered.

40. Although the inventive concept requires some effort to interpret fully, I think my conclusions in paragraphs 20 to 26 above are such that its scope can readily be deduced for the purposes of determination of inventive step. It is not however just the verbiage of the claim, but according to Jacob LJ in *Pozzoli* (paras 17 and 18), it is the essence of the claim that is paramount. In my view the essence of the claim is a screen which is pivotally mounted relative to a bath such that it can swing to an in use position over a side of a bath, but is prevented by engagement with a shoulder from swinging over and beyond that bath side.
41. GB 2264233 clearly remains much the closest of the prior art and as it was published on 25th August 1993 therefore gives a clear view of the state of the art at the priority date of the patent in 1994.
42. Now I will evaluate the difference between the inventive concept of claim 1 of the patent and the state of the art. In particular the requester thinks that the screen of GB 2264233 is "prevented from being swung outwards over said front side 22" as required by claim 1 as the specification of GB 2264233 says that "the blade seal 21 will prevent unwanted, unforced further outward movement". The observer however maintains that the outward movement is not prevented in GB 2264233, at least not in the sense of the word as used in the specification of the patent. In view of the discussion in paragraph 25 above as regards interpretation of the word "prevented" it will be no surprise that I concur with the observer here. It is clearly envisaged in GB 2264233 that a push on the screen would move it beyond the front side of the bath as indicated in lines 6 to 9 on page 6 - "If the bias is gentle, the blade seal 21 will prevent unwanted, unforced

further outward movement, but the screen can be swung out by flexing the blade member 21", so I cannot see that the screen is prevented from swinging out over and beyond the front side of the bath in the normal sense of the word and as would be understood by the skilled addressee from the specification of the patent.

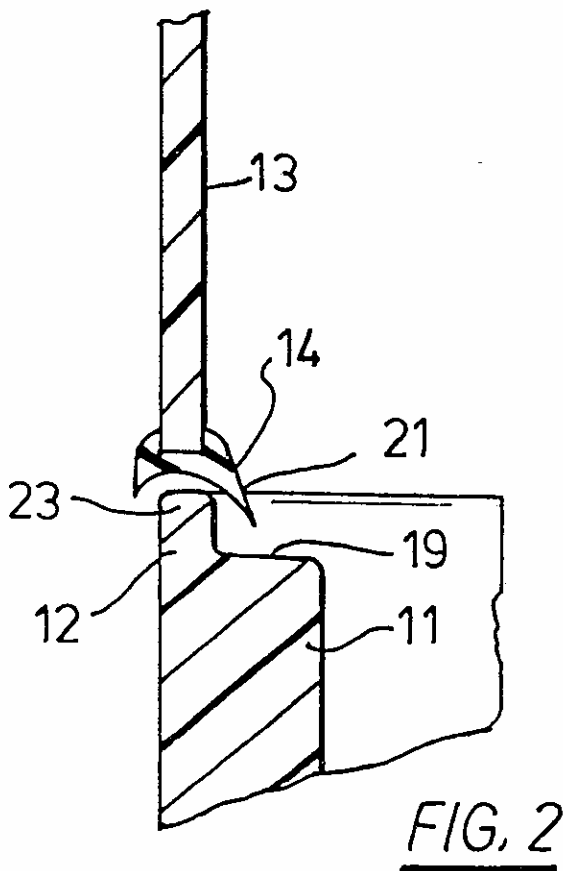


Figure 2 of GB 2264233

43. As discussed by the requester, the inventive concept also differs from GB 2264233 in that the shoulder is not "engaged by the bottom edge of the screen 28 in the in use position, so as to hold the screen 22 in said in use position." As shown in figure 2 above, the screen 13 of GB 2264233, even including the seal 14, does not engage the shoulder 19 at all, but in any case I think there is no question that the screen of GB 2264233 is not held in the in use position in the meaning of the patent, as acknowledged by the requester.

44. I therefore consider the difference between the inventive concept of the patent and GB 2264233 to be both that the screen is prevented from being swung outwards over and beyond front side and also that the screen is held in the in use position by the bottom edge of the screen engaging the shoulder.
45. Would these differences be obvious to the skilled person, the designer of bath and shower assemblies? As regards the screen being prevented from swinging out (and beyond) the front side of the bath, the pin 50 clearly does so, as contended by the requester. The observer however points out that the screen of US 3783456 must necessarily hang from an upper rail parallel to the front side and that the nature of the movement of the screen along the rail in an accordion type embodiment means that the screen cannot pivot about an in use vertical axis as in the patent.
46. I agree with the observer that the movement of the projected accordion screen embodiment in US 3783456 is indeed fundamentally different from that shown in the embodiment of the patent, but the inventive concept is unfortunately not specific about the orientation of the axis of swinging and therefore I must conclude that it does indeed prevent swinging over and beyond the front side of the bath.
47. As regards whether the screen is held in the in use position, the requester maintains that the pin 50 of US 3783456 holds the screen in the in use position. The observer says that the pin 50 of US 3783456 is a distinct component separate from the rim 22 so that the lower edges of the door do not engage the rim at all. For me the "shoulder" of the inventive concept of the patent can only be the rim 22 and the pin 50 simply does not qualify as a "shoulder" or even part of one. I also note that the "in use" position of the screen in US 3783456 will, as shown in figure 2 above, be such that it is spaced from the "shoulder" in the form of rim 22. I therefore cannot see that the accordion arrangement of US 3783456 will be such that "the shoulder is engaged by the bottom edge of the screen 28 in the in use position, so as to hold the screen 22 in said in use position" as required by claim 1.
48. These clear differences between the inventive concept of the patent and the disclosure of US 3783456, indicate to me that the skilled addressee would not think the inventive concept obvious, especially considering the differences in the construction and type of motion of US 3783456 in comparison with the embodiments shown in the patent. Having come to this conclusion I have no need to decide whether US 3783456 is in any way indicative of the common general knowledge that the skilled addressee would have had.

49. I therefore conclude from the above that claim 1 of the patent has an inventive step over GB 2264233. Having come to that conclusion there is no point in considering the appendant claims.

Opinion

50. I find that all claims of the patent are valid.

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 the observations have chosen to put before the Patent Office.

Jim Calvert
Examiner