



**PATENTS ACT 1977**

BETWEEN

Linpac Packaging Ltd Proprietor

and

Ingenium IP Ltd Opponent

PROCEEDINGS

Application under section 74B for  
review of Opinion 23/16 in respect of  
GB 2478028B

HEARING OFFICER Stephen Probert

For the proprietor: Mr Reuben Jacob of Maucher Jenkins

For the opponent: Dr Anna Molony of Ingenium IP Ltd

Hearing date: 10 July 2017

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**DECISION**

***Introduction***

1. Linpac Packaging Ltd (“Linpac”) is the registered proprietor of UK patent GB 2478028B (“the patent”), which concerns containers suitable for use in packaging, storage, transportation and/or display of products such as eg. fresh food. A cross section of a typical container according to the invention is shown below. Opinion 23/16 was requested by Ingenium IP Ltd (“Ingenium”) to address the question of whether the patent is valid in light of nine earlier patent documents (D1 to D9). The examiner’s opinion was that the patent is not valid. The registered proprietor has requested a review of the opinion under section 74B.



2. In addition to the statement and counter statement, both parties provided helpful skeleton arguments. I also had the benefit of hearing oral submissions on behalf of both parties during a telephone hearing.

## ***The law***

3. Reviews of statutory opinions are permitted by section 74B of the Act, and prescribed by rules 98 to 100 of the Patents Rules 2007 (as amended). The most relevant parts read as follows:

### **Review of opinion**

98. (1) The patent holder may, before the end of the period of three months beginning with the date on which the opinion is issued, apply to the comptroller for a review of the opinion.
  - (2) ...
  - (3) ...
  - (4) ...
  - (5) The application may be made on the following grounds only—
    - (a) that the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent; or
    - (b) ...

### **Outcome of review**

100. (1) On completion of the proceedings under rule 99 the comptroller shall either—
    - (a) set aside the opinion in whole or in part; or
    - (b) decide that no reason has been shown for the opinion to be set aside.
  - (2) ....
  - (3) No appeal under section 97 shall lie from a decision to set aside the opinion under paragraph (1)(a), except where the appeal relates to a part of the opinion that is not set aside.
4. My role as hearing officer in this review is as explained by Kitchen J (as he then was) in *DLP Limited*<sup>1</sup>. The following is an extract from paragraph 22 in which the judge begins by describing a statutory opinion:-

“22. .... It was only an expression of an opinion, and one almost certainly reached on incomplete information. Upon considering any particular request, two different examiners may quite reasonably have different opinions. So also, there well may be opinions with which a hearing officer or a court would not agree but which cannot be characterised as wrong. Such opinions merely represent different views within a range within which reasonable people can differ. For these reasons I believe **a hearing officer should only decide an opinion was wrong if the examiner has made an error of principle or reached a conclusion that is clearly wrong**. Likewise, on appeal, this court should only reverse a decision of a hearing officer if he failed to recognise such an error or wrong conclusion in the opinion and so declined to set it aside. Of course this court must give a reasoned decision in relation to the grounds of appeal but I think it is undesirable to go further. **It is not the function of this court (nor is it that of the hearing officer) to express an opinion on the question the subject of the original request.**”

(My emphasis)

## ***The patent***

5. The patent has one independent claim (claim 1) and it is the only claim that was discussed during the hearing. It reads (again with my emphasis):-

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<sup>1</sup> DLP Limited [2008] RPC 11

1. A container comprising a base and a continuous side wall extending **substantially perpendicular** to the base with a peripheral flange formed along the upper, in use, edge of the continuous side wall,
  - wherein the base and the continuous side wall consist essentially of polyethylene terephthalate (PET)
    - wherein a layer of adhesive is located on an upper, in use, surface of the peripheral flange and said layer of **adhesive does not extend onto the vertical, in use, surfaces of the continuous side wall and does not extend onto the base**
  - wherein the container further comprises a lidding film which may be sealed to the peripheral flange to create a sealed space between the base, continuous side wall and lidding film; and
    - wherein the lidding film is **a multi-layer film comprising a seal layer and the seal layer comprises polypropylene (PP) and/or PE.**

### ***The issues***

6. Having read the opinion and the skeleton arguments before the hearing, there appeared to me to be four main issues on which I was particularly keen to hear the submissions of Dr Molony and Mr Jacob. They were:-
  - (i) The English language translation of D2 (EP 0440550 A1).
  - (ii) Whether the opinion examiner was right to not consider D1 (WO 2009/121834 A1).
  - (iii) The construction of 'substantially perpendicular' & 'vertical' in the opinion..
  - (iv) Whether D9 (US4538651A) clearly discloses a sealing layer comprised of PP and/or PE.
7. During the hearing, Mr Jacob added a fifth point:-
  - (v) Does the adhesive in the prior art examples extend onto the vertical surfaces and base of the container.

#### ***Issue (i)***

8. D2 (EP 0440550 A1) is a French language patent application. As stated at paragraph 39 of his opinion, the examiner disregarded a machine translation (into English) of D2 because the date of the translation (May 2016) is much later than the priority date of the patent. In my view he had no reason to disregard the translation. In most cases, and certainly in this one, the date of the translation is totally irrelevant. However, nothing turns on this point because the examiner did consider an Australian family member (or equivalent) of the D2 patent — referred to in the opinion as D2\*.

#### ***Issue (ii)***

9. As explained in paragraphs 3 to 8 of the opinion, the examiner chose not to consider D1 (WO 2009/121834 A1) because it was used as a citation during the pre-grant examination process. Although he accepted that there could be circumstances in which it would be appropriate to reconsider a document that had already been

considered pre-grant, he was not persuaded that it would be appropriate to do so in this case. Dr Molony (for Ingenium) argued that the scope of Linpac's corresponding EP divisional application (EP2845819) has been significantly narrowed during examination proceedings before the EPO as a direct result of the relevance of D1. She says that Linpac has acknowledged through amendment of claim 1 (to incorporate the features of claim 6) that D1 anticipates all the features of claim 1 of the patent in suit. On this basis, Dr Molony submits that this acceptance of the relevance of D1 by Linpac constitutes "exceptional circumstances" as set out at Paragraph 3.4 of the Opinions Manual, and that the examiner should therefore have considered D1 in forming his opinion.

10. With the advantage of having read the statement, counterstatement and skeleton arguments, and having heard the oral submissions of the parties in this review, I believe that the opinion would have been much more useful to the parties if the examiner had considered D1. However, I do not accept that the examiner erred in deciding not to consider D1. It was entirely reasonable for him to come to that conclusion, even though - with the benefit of hindsight - I would have decided otherwise.
11. I think Dr Molony would have liked me to substitute my own opinion of the validity of the patent on the basis of D1, but as Kitchen J confirmed in DLP (see above), that option is not open to me. Dr Molony indicated that if I were to set the opinion aside, Ingenium might choose to request another statutory opinion from the IPO. In that event, the opinion examiner should consider D1.

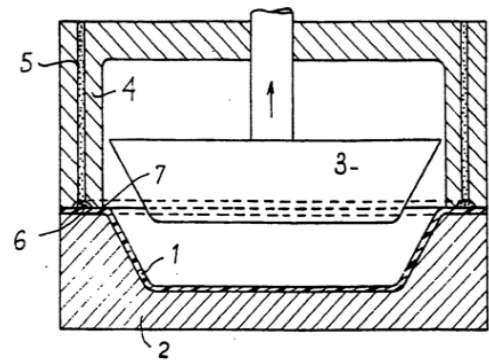
*Issue (iii)*

12. This issue is relevant to the examiner's opinion regarding inventive step, particularly in connection with D2\*. He concluded that claim 1 is obvious in light of D2\*. In order to apply the well known 'Windsurfing' test for inventive step, he needed to construe the claim. Claim 1 of the patent defines a container with (inter alia) a continuous side wall that is substantially perpendicular to the base. Claim 1 also refers to the vertical, in use, surfaces of the side wall.
13. At paragraph 24 of the opinion, the examiner construed these two expressions, and came to the following conclusion:-

"In the context of the claim I construe the terms "*substantially perpendicular to the base*" and "*vertical, in use, surfaces*" to simply mean surfaces which extend away from the base to create a space."
14. Perpendicular to the base would mean that the side wall makes an angle of 90° with the base (or horizontal). The qualification of the word 'substantially' necessarily introduces a range either side of 90°. The extent of that range will depend to some extent on the context, and must be assessed with regard to the Protocol on the Interpretation of Article 69 EPC (which corresponds to section 125(1)). The opinion examiner referred to the Protocol, but if I have understood correctly, the construction he arrived at is, in my view, significantly outside the extremes mentioned in the Protocol. For example, it encompasses an extremely broad range of angles between the side wall and base - eg. an angle of just 30° or 45° from the horizontal would extend away from the base to create a space. Such a construction would include embodiments with side walls that could not, on any reasonable interpretation, be described as 'vertical' or 'substantially vertical'.

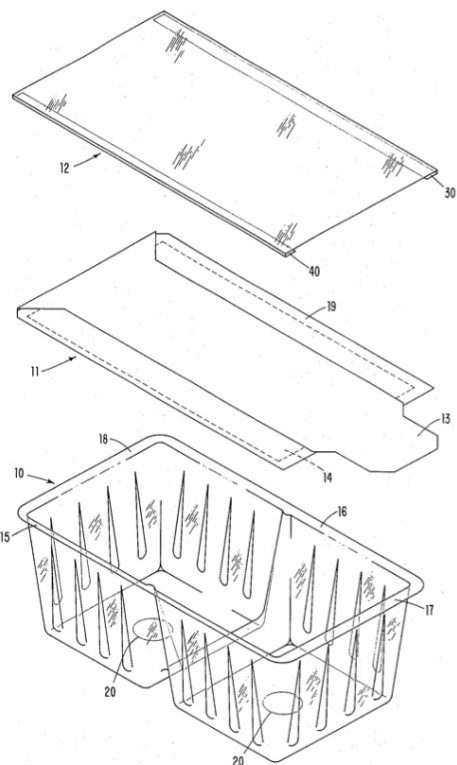
15. Although the claim uses the term 'vertical' rather than 'substantially vertical', the distinction in this instance is not significant because the side walls have already been defined in the claim as substantially perpendicular to the (horizontal) base. I believe it would be implicit to the intelligent reader that the same degree of variation applies.
16. Consequently I consider that the examiner has erred in his construction of these particular terms in the claim. It follows that the opinion should be set aside, at least to the extent to which it relies on this construction.

17. Based (at least in part) on his construction of the words '*substantially perpendicular*' and '*vertical, in use, surfaces*', the examiner came to the conclusion (in paragraphs 42-44) that D2\* demonstrates a lack of inventive step in the patent. Figure 1 of D2\* (see right) shows a container with side walls that are, according to my measurement, 30° from the vertical. I am not going to express my own opinion as to whether this is 'substantially perpendicular'. What I am saying is that there is significant doubt in my mind as to whether the examiner would have formed the same opinion in relation to D2\* if he had not erred in his construction of the claim of the patent.



*Issue (iv)*

18. I found this to be the hardest issue to decide. The opinion concludes that claims 1, 15 & 21 lack novelty having regard to D9 (US4538651A). D9 discloses a toner cartridge (see right) which undoubtedly includes most of the features required by claim 1 of the patent, even though it is not a food container - for claim 1 is not limited by the intended contents of the container.



19. Strip 11 of the toner cartridge (the middle item in the figure) comprises two layers. One is a layer of randomly oriented, bonded polyethylene fibres. The second layer is a low surface energy layer consisting of nylon or PET. In use, the second layer would face the contents of the container. As the opinion states (at paragraph 35), it is not entirely clear whether the second layer extends over the whole of the [lower] surface of strip 11, and in particular whether it extends over the boundary area (19) where the strip would be adhered to the base (10).

20. The examiner came to the conclusion that the boundary area (19) was not covered by the nylon (or PET) layer - because it is said to be 'of low surface energy'. He therefore found that the boundary or seal layer would comprise PE, by virtue of the polyethylene fibres of the upper layer.

21. Unfortunately I was no wiser after the hearing. Mr Jacob submitted that the low surface energy layer must extend across the whole surface of the strip because one of its primary functions was to enable the strip (11) to be conveniently removed from the cartridge during installation. Dr Molony submitted that it would not, for much the same reason. Mr Jacob also drew my attention to a passage in D9 (line 61 of column 2 to line 21 of column 3) which explains that the edges (15 & 16) of the base are unequal in width to enable the toner cartridge to mate with one of two different types of toner dispenser. As D9 says, the strip 11 can be turned 'end-for-end' in relation to the base in order to fit one or other type of toner dispenser. Mr Jacob submitted that the low energy layer must therefore extend across the whole surface, because otherwise the boundary area on either of the long sides of the strip 11 would not correspond with the different width of the edge on the other side of the base. On balance, I thought this was the more compelling argument.
22. In any event, it seems to me that there is significant ambiguity surrounding this feature of the toner cartridge of D9, and that as a result it is impossible to say for certain whether or not the seal layer of D9 comprises PE and/or PP (as required by claim 1 of the patent) or nylon (or PET). Strip 11 is clearly a multilayer strip, and one of those layers clearly comprises PE. But it is not clear that the PE layer functions as the sealing layer. Without a clear indication in the disclosure one way or the other, it is not apparent to me how the examiner formed his opinion on this issue. If D9 is to destroy the novelty of the patent, it must clearly disclose all the features of claim 1. In my view it does not, and accordingly I find that the examiner reached a conclusion that is clearly wrong.
23. I also note in passing, that the toner cartridge disclosed in D9 is designed to be used upside down. As the description says (column 1 line 13), it 'bottom-dumps' the toner into the dispenser under the force of gravity. Consequently, it does not have a peripheral flange formed along '*the upper, in use, edge*' of the side wall as required by claim 1 of the patent.

#### *Issue (v)*

24. Mr Jacob submitted that D9 was also missing a further feature of claim 1 - ie. that the layer of adhesive does not extend onto the vertical surface of the side walls. He argued, with some support from WO2007/133524A2, that it was common general knowledge that the adhesive would normally be applied to the flat sheet of PET material before it was formed (or pressed) into the shape required for the base. However, Dr Molony pointed out that paragraph [0057] of WO2007/133524A2 describes the application of adhesive to the outer edge of a container, using eg. a roller, in the same way as described in the patent in suit. As Dr Molony expressed it, "*there is no invention in being tidy when applying adhesive*". I agree. I think the examiner was correct to interpret D9 in such a way that the adhesive would not extend onto the vertical surfaces.

#### **Conclusion and Order**

25. In view of the decision I have reached in relation to issues (iii) & (iv), I conclude that the examiner made an error of principle, and reached a conclusion that is clearly wrong. Consequently I order that opinion 23/16 shall be set aside in whole.

### ***Section 73(1A) proceedings***

26. Proceedings under section 73(1A) to revoke this patent were initiated in December 2016 following the issue of opinion 23/16. Those proceedings were stayed in January 2017 pending the outcome of this review. As I have set aside the opinion in whole, those proceedings will now be terminated.

### **Costs**

27. Linpac has been successful in this review, and has requested a contribution towards its costs on the standard scale. The standard scale is set out in Tribunal Practice Notice (TPN) 2/2016; I assess the various categories as follows:-

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	No evidence
Preparing for and attending a hearing (telephone hearing)	£500
Expenses (ie. official fees)	£50
<b>Total</b>	<b>£750</b>

28. I award Linpac Packaging Ltd the sum of £750, to be paid by Ingenium IP Ltd within 21 days of the date of this decision.

### ***Appeal***

29. No appeal lies from this decision.

**Stephen Probert**

Deputy Director, acting for the Comptroller