

(b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

Review

- 5 The nature of a review under section 74B was considered by the Patents Court in *DLP Limited*¹, in which Kitchen J said:

"22.....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."

- 6 That is, the Review is a review of the process and a check of whether a clear mistake has been made. It is not intended to be a second opinion on the matters presented in the Opinion. The opponent takes the opportunity to remind me of this in its response dated 2 March 2017.

- 7 The purpose of the Opinions service is to provide an opinion on the matters presented. Whether I necessarily agree or disagree with the examiner's Opinion is not the matter at hand in this review. Furthermore, the matter is not whether any of the parties agrees or disagrees with the Opinion.

- 8 The first matter at hand is whether the proprietor has presented sufficient grounds for me to review the examiner's Opinion. In its statement of grounds the proprietor sets out the examiner's arguments and then responds with counter-arguments:

Section 1 sets out a skeleton explanation of the examiner's argument and opinion.

Section 2.1 concerns how feature (ii) of claim 1 of the patent may be interpreted. The view is presented that this feature is not disclosed in the prior art of E6. In effect, this is a re-presentation of the observations presented in the letter of 24 August 2016 (p14-15) which the examiner will have considered in forming her opinion.

Section 2.2 concerns feature (iii) of claim 1. It discusses how E6 may or may not be interpreted as describing such a feature ("sensor values for evaluating the component quality are derived therefrom"). This appears to be a further re-presentation of the argument set out in the first and second paragraphs of page 15 of the observations of 24 August 2016, albeit with some additional detail. Again, the examiner has formed an opinion of this disclosure.

Sections 2.3 and 2.4 concern features (iv) and (v) of claim 1. They discuss whether, in the light of arguments in section 2.2, the prior art of E6 discloses those features. No new arguments are presented.

Section 3 concerns auxiliary requests and proposed amendments to the claims. These are not matters for a review of the Opinion and as such are not considered (see my comments in paragraphs 16-17 below).

¹ DLP Limited [2007] EWHC 2669

- 9 In presenting technical arguments on the interpretation of the patent and the prior art, I am content that there are grounds for further consideration of the matter and for review of the arguments now presented. The next matter then is to consider the detail of those grounds presented.
- 10 The proprietor has not challenged the principles of the Opinion. That is, it is not challenging the examiner's application of the relevant parts of law. Furthermore, without any undue burden I can immediately see the examiner has presented the relevant tests. Therefore, this does not appear to be at issue and I have no clear cause to review it.
- 11 As I have indicated in paragraph 8 above, in its grounds for review the proprietor has only re-presented and developed arguments already made as part of its observations on the submission for the Opinion. In those grounds the proprietor has not presented arguments which clearly demonstrate how the examiner has misinterpreted the specific prior art, the common general knowledge of the skilled addressee or how the skilled addressee would construe the claim in question. Effectively, the arguments are not new.
- 12 However, in later submissions I note that the proprietor emphasises its interpretation of the role of temperature measurement in the prior art E6 (10 April 2017, page 3): its understanding is that the temperature distribution is fed back to the computer for adjusting the running schedule. Directly responding to this point, the opponent has argued that the examiner's conclusion on this point is not clearly wrong. It says that how the proprietor or I may interpret this part of the disclosure of the prior art is not at issue; the examiner has formed an opinion and stated it in the first sentence of her paragraph 48. I note that the examiner assesses the teaching of E6 on this point at paragraph 47 of her Opinion and, despite the proprietor's submissions, I do not find her conclusion to be clearly wrong.
- 13 Furthermore, the proprietor makes pertinent comments in its submission of 10 April 2017 (sections 5 and 6) concerning the suitability of the sensor values in E6 to evaluate component quality, i.e. that E6 fails to disclose feature (iii) of claim 1 because the measured temperature values are not used in evaluating component quality. The opponent submits that claim 1 does not recite the step of using the sensor values to evaluate component quality, only that the sensor values are suitable for evaluating component quality. The proprietor responds by saying that the fact that respective sensor values are derived from the melt region implies an evaluation step and therefore the use of these values for evaluating component quality. It goes on to suggest that the specific uses of these values, i.e. the storing of the sensor values with coordinate values (feature (iv)) and the displaying of the sensor values in a two- and/or multi-dimensional representation in respect of the capture location (feature (v)), emphasises this implied use. The proprietor says that such use of the sensor values is not disclosed in E6.
- 14 In response to these points, the opponent has provided a direct response on 8 May 2017 (paragraph 4) referring to the well-established interpretation of the term "for", i.e. it is normally interpreted to mean "suitable for" and does not limit the claim to the actual use. It says that claim 1 is limited to sensor values that are suitable for evaluating component quality but not the actual step of evaluating component quality. It argues that the temperature values disclosed in E6 are clearly suitable for

evaluating component quality and that the examiner was not clearly wrong in coming to the same conclusion.

- 15 In arriving at her opinion, the examiner will have used her knowledge and experience to develop those arguments presented by the requestor and observer in the proceedings of the Opinion. In my review of the arguments presented now and in the Opinion, and without having had any further steer from the parties, I can form no clear indication that the examiner's Opinion is clearly wrong.

Other matters and proposed amendments

- 16 In the interest of clarity I must briefly comment on the status of the proposed amendments included in the request for review. I have set out the purpose and remit of the review in paragraphs 4-7 above. The role of the review is not to consider what amendments may be appropriate to address comments made as part of an Opinion. As such, those proposed amendments and arguments accompanying them form no part of this review.
- 17 Furthermore, I am fully aware of the matters of the Official letter of 28 November 2016 concerning action under Section 73(1A). That Official letter and any formal responses thereto do not form part of this review. For the avoidance of doubt, that matter is currently stayed, pending the outcome of this review and any appeal therefrom. When this review has fully concluded, the Officer on that matter will contact the proprietor to clearly set out the next steps and any appropriate timeframes.

Conclusion

- 18 Therefore, considering the points I have set out above, I do not see sufficient reason to set aside the conclusion presented in Opinion 21/16.

Appeal

- 19 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

H Jones

Deputy Director acting for the Comptroller