

OPINION UNDER SECTION 74A

Patent	EP 0989255 B1
Proprietor(s)	3S Systemtechnik AG
Exclusive Licensee	
Requester	Williams Powell
Observer(s)	J A Kemp
Date Opinion issued	20 May 2016

Request

1. The comptroller has received a request from Williams Powell to issue an opinion on the validity of EP 0989255 (“the Patent”) in light of a number of prior art documents. The proprietor of the Patent is 3S Systemtechnik AG.

2. The following evidence was supplied in the request:

US 3886616	(Hayes)	Exhibit II
US 4835809	(Roumagnac)	Exhibit III
WO 90/09498	(Sunnen)	Exhibit IV
JP H6-225847	(Sanden)	Exhibit V
US 4168557	(Rasch)	Exhibit VI
EP 0017974	(Karsten)	Exhibit VII
US 5569371	(Perling)	Exhibit VIII
US 3676885	(Wulc)	Exhibit IV
US 5172445	(Chandler)	Exhibit X
US 4798670	(Treene)	Exhibit XI
JP- A-54-105831	(Shin Meiwa)	Exhibit XII

3. English language translations and abstracts have also been provided in the form of Exhibits IVa, Va, VIIa, XIIa

Observations

4. Observations were filed by J.A.Kemp on 29 March 2016 which asserted the claims were novel and inventive over the supplied evidence. A validated translation of the Patent was also included.

Observations in reply

5. Observations in reply were filed on 12 April 2016. As part of the observations in reply the requester filed new evidence in the form of US 6473927 which is an equivalent application to the Patent. Also filed were the examination history for US 6473927 and documents showing examples of lamellar filters.

Allowance of the request

6. Two of the documents above have already been cited and considered by the EPO, namely WO 90/09498 and US 4168557. WO 90/09498 was cited under category Y in combination with another document and US 4168557 was cited under category D, A (cited as background art by the applicant). Rule 94 of the Patent's Rules is therefore potentially relevant and this reads:

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

(b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.

7. I note that the two documents above were cited in the search report against the original claims and, as I have indicated above, in categories Y and A, D. I have not been given any evidence that the arguments proposed in the present Opinion request regarding the relevance of these two documents was ever put before the EPO. I have also not been provided with any evidence regarding arguments put before the EPO in relation to the claims as granted. On balance, therefore, there is sufficient doubt in my mind as to whether the two citations were sufficiently considered, especially in light of the arguments put forward in the present Opinion request. I will therefore consider their relevance.

8. Turning to the documents filed as part of the observations in reply on 12 April 2016, I note that Rule 93 (4) states that the request for an Opinion “*shall be accompanied by a copy of any evidence or any other document...*”.

9. The requestor has stated that the patentee has “sought to make an analogy between the claims of the corresponding US patent and those of the European patent the subject of this request”. The requestor has seemingly made this statement for reasons of claim interpretation, specifically with regard to the following feature in claim 1 “a cover (10) which can be arranged above the interior chamber” which is referred to in the US equivalent as “a removable cover with an underside arranged over the inner chamber.” I do not however accept the argument the

patentee/observer has made use of the US equivalent in the alleged manner. The observer has indeed argued the claim should be interpreted as the cover being removable but has not used the US equivalent to back up that argument.

10. Given said Rule and the fact that the observer has had no opportunity to specifically address the requester's observations pertaining to US 6473927 and its prosecution history, or the documents showing lamellar filters it would not be correct for me to consider them as part of this Opinion.

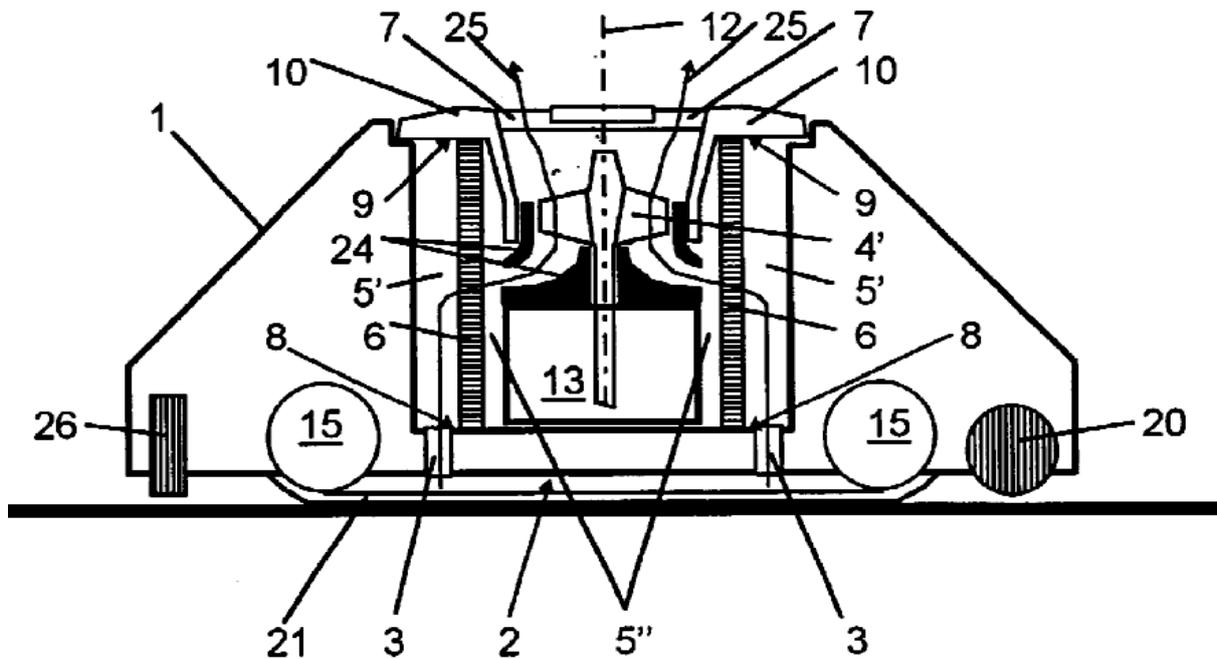
The patent

11. The patent was granted on 28.04.2004 and is still in force. It relates to a cleaning apparatus with particular application in cleaning swimming pools. One of the objects of the invention is to provide a cleaning device where the filter can be exchanged and contaminated parts cleaned without the need to raise or tilt the device.

12. There is one independent claim and fifteen appendant claims. The independent claim reads.

Cleaning apparatus, in particular for cleaning swimming pools, comprising a housing (1) and at least one suction aperture (3) arranged at the base (2) of said housing, through which aperture by means of a pump (4, 4') a liquid to be cleaned can be conveyed into an interior chamber (5) which is at least partly enclosed by the housing (1), through a filter (6) which can be arranged in this interior chamber for separating a part (5') exposed to dirt from a clean part (5'') of the interior chamber and can be conveyed by way of an outlet aperture (7), characterised in that the filter (6) of an upper surface (8) of the bottom of the interior chamber (5) and of an underside (9) of a cover (10) which can be arranged above the interior chamber fits closely so as to provide a seal; and the pump (4') is in effective connection by means of an arbour (12) with an electric motor (13), and is vertically arranged in the interior chamber (5) together with said electric motor.

13. The following drawing helps with the understanding of the claim.



Claim construction

14. The claims are a translation from the original German language. I agree with the requestor the translation is somewhat clumsy but I think it would be understandable to the person skilled in the art and this is a point which is broadly accepted by the observer. There is however one aspect of the claim which requires particular consideration, that being “a cover (10) which can be arranged above the interior chamber fits closely so as to provide a seal”. To interpret this aspect of the claim I shall follow the guidance set out in *Kirin-Amgen and others v Hoechst Marion Roussel limited and others [2005] RPC 9*. The key point being “what a person skilled in the art would have thought the Patentee was using the language of the claim to mean”. I will therefore interpret these aspects of the claim in a purposive manner and interpret them in light of the descriptions and drawings, taking in to account the Protocol to article 69 of the EPC.

15. There are at least two aspects relating to the cover which are disputed by the two parties. The first being the interpretation of “a cover (10) which can be arranged above the interior chamber” and the second in relation to the phrase “fits closely so as to provide a seal”. To broadly summarise the positions taken by the two parties, the requestor argues that the phrase “a cover (10) which can be arranged above the interior chamber” does not mean the claim is limited to having a removable cover. The observer argues to the contrary and that the claim would be understood by the person skilled in the art to be limited to having a removable cover.

16. In support of the interpretation that the cover should not be construed as being removable the requestor has stated that “the principles set out by the House of

Lords in *Kirin-Amgen* relate to whether terms of a claim can be construed to have a broader scope than they might appear to have at face value having regard to whether the description permits such a broader construction.” The requester further asserts that “Neither *Kirin-Amgen*, nor any of the other cited decisions before it, addressed whether a patent claim could be construed more narrowly than the wording of the claims reasonably permits.”

17. It may have been the case that *Kirin-Amgen* involved a case where a broader interpretation of the claims was justifiable but I do not agree that this means that “the principles of *Kirin-Amgen* cannot be applied” in the present case to determine how the person skilled in the art would construe the claim. From both *Catnic Components Ltd and another v Hill and Smith Ltd [1982] RPC 183* and *Kirin-Amgen and others v Hoechst Marion Roussel limited and others [2005] RPC 9* the aim was to determine “what a person skilled in the art would have thought the Patentee was using the language of the claim to mean”, in other words a purposive construction and this is how I will apply the principles of *Kirin-Amgen*, taking in to account the Protocol to article 69 of the EPC. I further note that part h of the Principles of Claim Construction makes it clear that it is possible to interpret a term both narrow and wide in the context of the patent.

18. I refer next to the Principles of Claim Construction which were summarised by Jacob LJ in *Technip France SA’s Patent [2004] RPC 46* in paragraphs 41(a)-(k). These were approved by Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd [2005] RPC 9* apart from subparagraph (e), where Lord Hoffmann held that there is no presumption about the width of the claims when considering fairness to the patentee. In *Mayne Pharma v Pharmacia Italia SpA [2005] EWCA Civ 137*, Jacob LJ summarised these principles, but omitting subparagraph (e) as follows

- (a) The first, overarching principle, is that contained in Art 69 itself.
- (b) Art 69 says that the extent of protection is determined by the terms of the claims. It goes on to say that the description and drawings shall be used to interpret the claims. In short the claims are to be construed in context.
- (c) It follows that the claims are to be construed purposively the inventor’s purpose being ascertained from the description and drawings.
- (d) It further follows that the claims must not be construed as if they stood alone the drawings and description only being used to resolve any ambiguity. Purpose is vital to the construction of claims.
- (f) Nonetheless purpose is not the be-all and end-all. One is still at the end of the day concerned with the meaning of the language used. Hence the other extreme of the Protocol a mere guideline is also ruled out by Art 69 itself. It is the terms of the claims which delineate the patentee’s territory.
- (g) It follows that if the patentee has included what is obviously a deliberate limitation in his claims, it must have a meaning. One cannot disregard obviously intentional elements.

(h) It also follows that where a patentee has used a word or phrase which, acontextually, might have a particular meaning (narrow or wide) it does not necessarily have the meaning in context.

(i) It further follows that there is no general “doctrine of equivalents”.

(j) On the other hand purposive construction can lead to the conclusion that a technically trivial or minor difference between an element of a claim and the corresponding element of the alleged infringement nonetheless falls within the meaning of the element when read purposively. This is not because there is a doctrine of equivalents: it is because that is the fair way to read the claim in context.

(k) Finally purposive construction leads one to eschew what Lord Diplock in *Catnic* called (at p.243):

“the kind of meticulous verbal analysis which lawyers are too often tempted by their training to indulge.”

19. Taking these principles into account it is clear that the phrase “a cover (10) which can be arranged above the interior chamber” needs to be construed in light of the description and drawings. As discussed in part g of the principles the patentee has included the phrase as a deliberate limitation and it cannot be ignored. As set out in parts c and d “purpose is vital to the construction of the claims.” The requestor has set out in detail how this aspect of the claim should not be interpreted but has not provided me with any guidance of how I should interpret the limitation. I shall therefore use the description and drawings to ascertain the purpose for the restriction.

20. The Patent relates to a cleaning device for particular use with swimming pools. A number of prior art known devices for performing such a function have been acknowledged by the patentee and include filters and pumps. The problem the patentee has identified with the prior art devices is that devices have to be inclined or tilted to access the interior of the devices so that filters can be replaced and a visual inspection of the interior surfaces can occur. The object of the invention, as set out by the patentee, was to allow the filter to be replaced and the dirt exposed portions of the cleaning unit to be cleaned without the device needing to be raised or tilted and in which no pump parts come into contact with contaminated liquid. These objects have been met, as shown in the description and drawings, by the inclusion of a removable cover portion 10 which can be removed so that the internal chamber of the device can be accessed from above without the need for tilting or inclining the device.

21. In this regard *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors UK Ltd [2010] RPC 8* is of relevance. In said case, the Court of Appeal held that the skilled reader is taken to suppose that the patentee knew some patent law – that his claim is for the purpose of defining the monopoly and that it should be for something new and that knowledge of that may well affect how the claim is construed. For instance, the patentee would not be expected to have claimed what he had expressly acknowledged was old. As discussed above, the patentee has set out what was old and also set out what was new in terms of the object of the invention, that being the cover which can be removed to access the interior of the device.

22. The above sets out how, in my opinion, the person skilled in the art would interpret this aspect of the claim, specifically the person skilled in the art would interpret “a cover (10) which can be arranged above the interior chamber” to be a removable cover which can be arranged above the interior chamber to allow access to the interior chamber.

23. There is a further aspect of claim 1 which requires interpretation and that is in relation to the formation of a seal by the filter.

24. The requestor has argued that the claim “does not specify the structure required by the words “fits closely so as to provide a seal”. The requestor goes on to state that the claim merely requires the filter must be sealed to the housing. The observer has argued this is an incorrect interpretation of the claim.

25. In my opinion I think the skilled person would clearly understand from the phrase “of an underside (9) of a cover (10) which can be arranged above the interior chamber fits closely so as to provide a seal” that it is the arrangement of the cover which provides a seal. Such an interpretation is fully consistent with the description of the Patent, regardless of which translation is used, for example, from the translation provided by the requestor “. This cover 10 closes thus at least a part of the inner space 5. The filter 6 is preferably formed as a plate filter, and a cylindrical shape comprising on the one hand and touches the surface 8 of the interior bottom and on the other hand, the bottom 9 of the interior cover 10. This contact is such that virtually no water from the soil exposed part 5 of the interior space 5 in the clean part 5' can reach the same”.

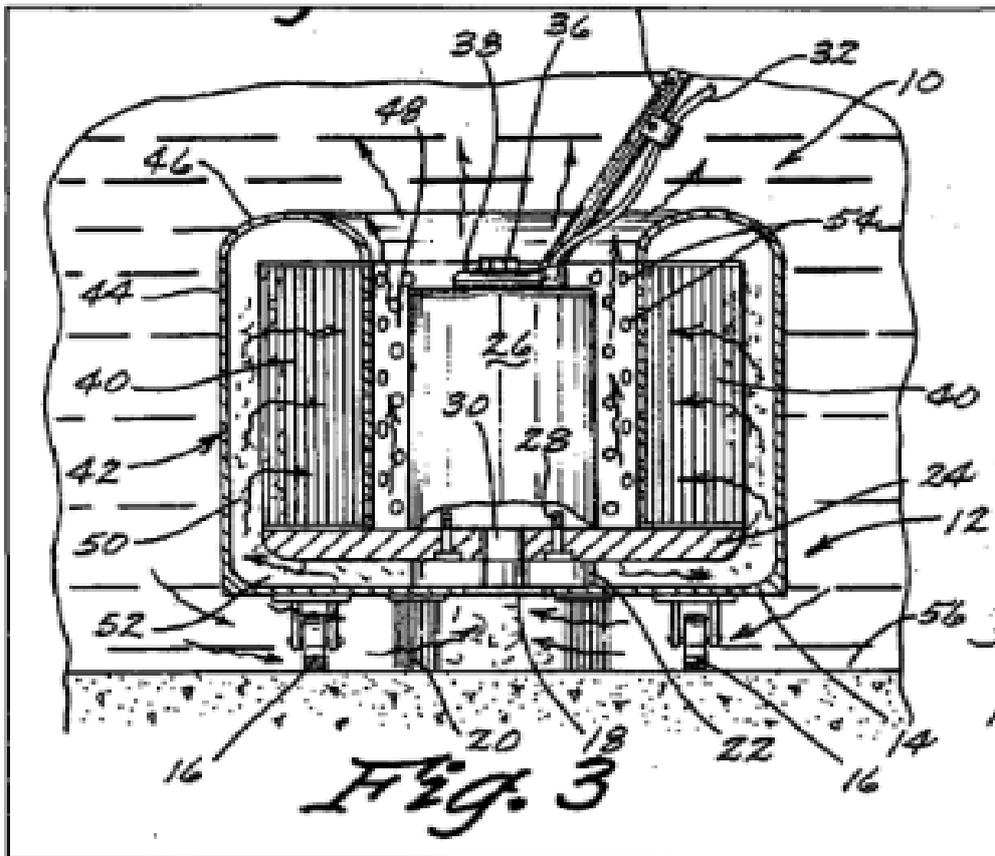
26. Specifically with regard to the interpretation of a “seal”, taking a purposive interpretation, it is clear from the application as a whole that the filter must seal with the cover to a degree sufficient for the device to work as intended. In other words the seal must be such that liquid passes preferentially through the filter and not between the top of the filter and the underneath of the cover. The same is true for the phrase “that the filter (6) of an upper surface (8) of the bottom of the interior chamber (5)...provide a seal”. In other words, the filter must seal to the top surface of the bottom of the chamber to at least the extent which allows the device to function as intended. This is in my opinion how the person skilled in the art would purposively interpret the claim and is consistent with the drawings and description. If it were not the case and contaminated water was allowed to bypass the filter, then the pump would contact contaminated water, which is the opposite of the expressed objects of the invention. I do however agree with the requester the person skilled in the art would not understand the formed seal to include the optional structures, such as sealing lips.

27. In summary it is my opinion the skilled person would interpret this aspect of

the claim to mean the cover seals with the filter sufficiently for the assembly to perform its intended function.

Novelty

28. The requestor has first alleged a lack of novelty for claim 1 with respect to the disclosure in US 3886616, a drawing from which is shown below.

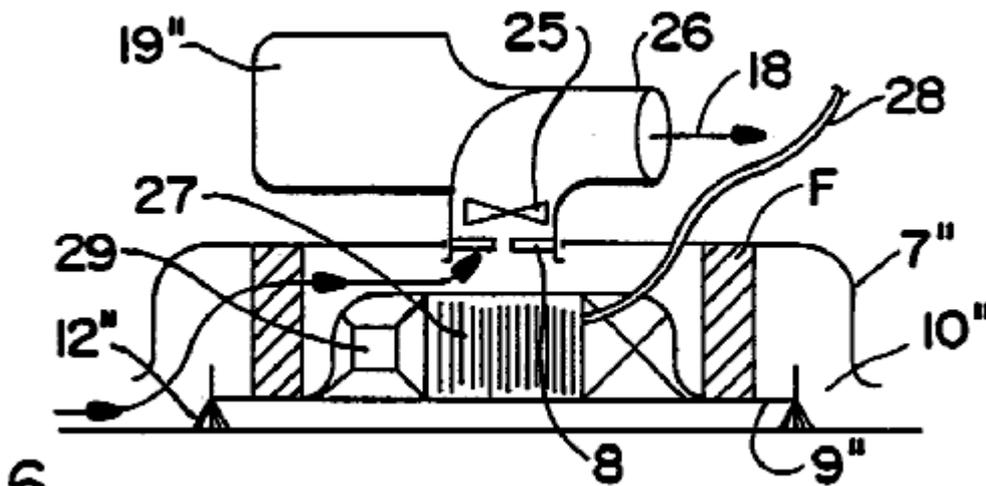


29. The requestor has stated that a pump 22 is connected by shaft 30 to an electric motor 26, the pump being arranged vertically in the chamber 14. The observer has disputed that these features of '616 satisfy the requirements of claim 1.

30. The requestor, in the observations in reply, has identified the apparatus as having a bottom 14, an outer wall member 44, a top 46 and an inner wall 48. The requestor further refers to "the upper portion of the housing 42 may also be provided as a separate component so as to permit the easy insertion of the filter 40 into the cleaner". The requestor further points out that the filter in US 3886616 is as shown in figs 4A and 4B of the Patent.

31. In claim 1 of the Patent the housing defines the boundaries for the chamber and the filter is said to extend from surface of the base of the chamber to bottom surface of the cover of the chamber. This does not seem to be the arrangement shown in '616. The requestor in the request has identified the chamber in '616 as 48. I do not agree with this interpretation. In '616, numeral 48 refers to the inner wall of the housing, as the requester pointed out in the observations in reply. The chamber in '616 is formed by the walls, 44, 48, 46 and 14 and creates a ring shaped chamber where the chamber is referenced by numerals 50, 52. This leads to a number of differences between what is claimed and what is disclosed in '616. Firstly, the filter does not extend from "an upper surface (8) of the bottom of the interior chamber", instead it spaced from the bottom of the chamber and extends from plate 24. Although I agree with the requestor the figures of the Patent show a plate on the bottom of the chamber, no such plate is claimed in claim 1 of the patent. The claim requires the filter forms a seal with the upper surface of the bottom of the chamber and is silent on any plate being present. Secondly the motor 26 is not in the chamber and is instead outside the chamber. Thirdly, because the motor 26 is outside the chamber, the removable lid 42, as identified by the requester, does not cover the chamber in which the motor is disposed. For these reasons it is my opinion claim 1 is novel over the citation.

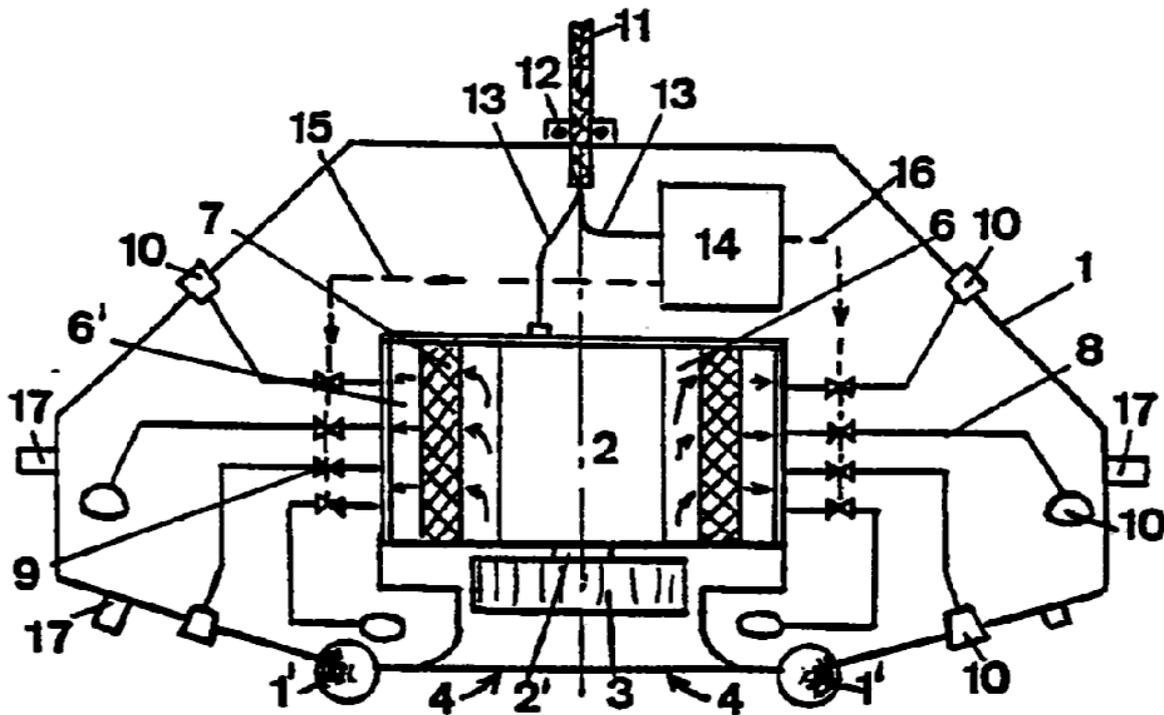
32. US 4835809, a drawing from which is shown below.



33. With regard to this document I agree the skilled person would consider this document to show a filter (F) extending from an upper surface of the bottom 9" of the interior chamber formed by lid 7" and base 9". The motor 27 can be seen in the chamber thus formed. The requestor has identified the pump as turbine 25. As the requestor points out the pump is "positioned in conduit 26 serving as a pipe." Claim 1

requires that pump is arranged in the chamber along with the motor. As the pump of '809 is not within the chamber then the claim is novel with respect to the document. The observer also argues that the document does not disclose a mechanical shaft/arbor connecting the turbine and motor and the coupling could be of the contactless magnetic type. I agree with the observer that such a shaft is not disclosed and that this is another reason the claim is novel with respect to the citation. Finally, the requester has identified the cover as item 7 but I agree with the observer this does not represent a cover which can be arranged above the interior chamber, as I have construed the phrase earlier. In this regard I agree with the observer, it is the bottom 9 which is removable, as set out in claim 1 of the citation "Apparatus for the automatic cleaning of a bottom surface of a pool...provided with a removable bottom..." Claim 1 is therefore, in my opinion, novel over the citation for the reasons discussed.

34. WO 90/09498, a drawing from which is shown below

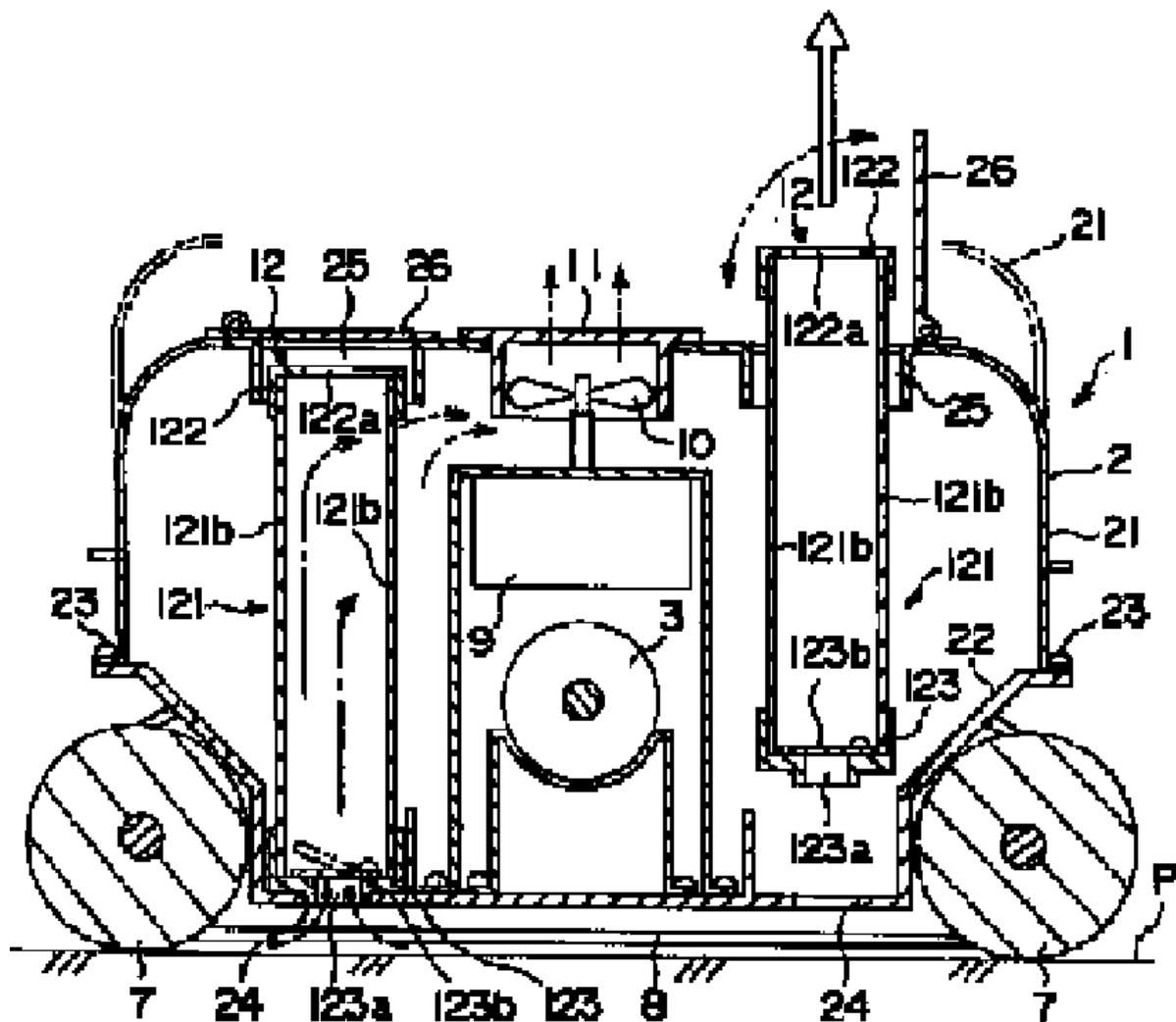


35. The requestor has argued that this document discloses a cleaning apparatus having a housing "around chamber parts 6, 6'" an interior chamber "6, 6'" in which there is disposed a pump 3, a filter 7 and an electric motor 2. The requestor further states "It is to be noted that claim 1 of the patent does not specify the location or nature of the housing in relation to the overall apparatus, save that it is a housing. The housing providing the chambers 6, 6' in this document is properly definable as a housing and it has all the characteristics, features and functionality of the housing of clam 1 of the patent. It is immaterial if the apparatus includes an additional outer casing."

36. The observer argues that if the chamber is, as defined by the requestor, shown by 6 and 6' then the pump 3 is outside the chamber. I agree with the observer, the pump is not in the chamber defined by parts 6 and 6', as required by claim 1 of the Patent and the claim is thus novel with respect to this citation.

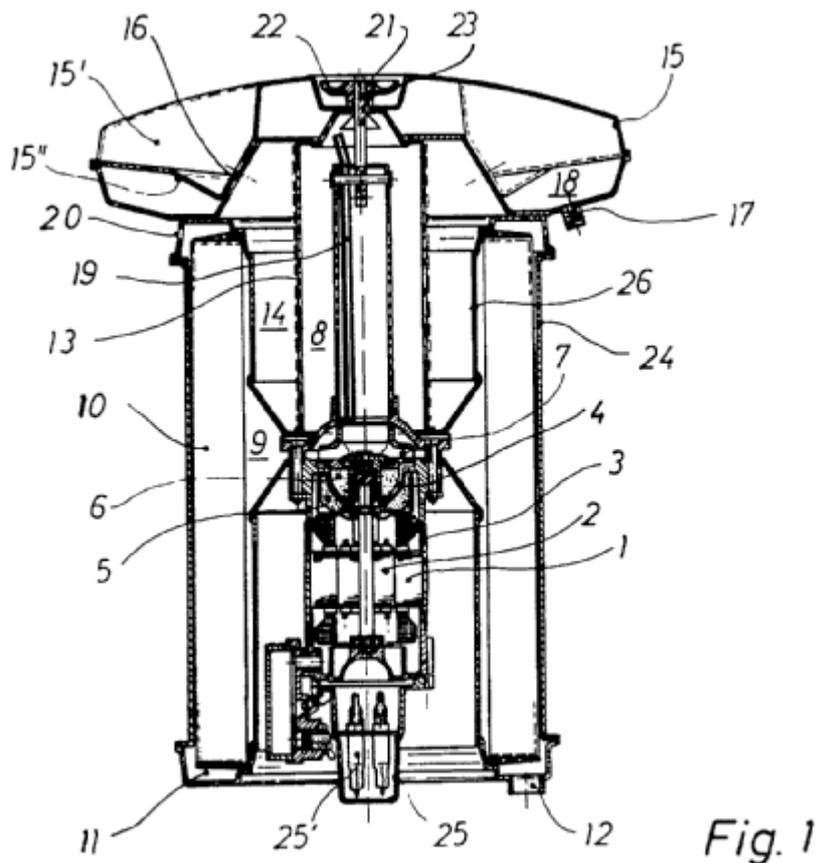
37. In addition to this the requestor has not set out what should be interpreted as the cover and has merely stated a cover is present but not numbered. I cannot identify a cover which can be arranged above the interior chamber, as I have construed it. It is therefore my opinion that claim 1 is novel over the citation for at least two reasons.

38. JP H6 225847 a drawing from which is shown below.



39. The requester has argued that the citation shows a chamber in which there is disposed a motor 3 and a fan/pump 10. The requester also refers to filters having filter bodies 121 as being disposed in the chamber. The requester further identifies a flaps 25 and 26 which can be arranged above the chamber to provide a seal and also a cover 23 which can be removed if screws 23 are removed. I agree with the requester that the document shows such an arrangement albeit it is not entirely clear whether the requester is designating portions 25, 26 or 23 as the cover. The claim does however also require the filter to seal with the underside of the cover. The requester also argues that “the seal between the upper section of the filter 121 and the structure by closing the door 26 is a must” for the apparatus to function as intended. The observer argues no such seal is formed and there is a space between the filter and the underside of the cover, be that portion 23, 25 or 26 and furthermore no such seal is specified in the citation. I do not agree with the requestor such a seal is essential for the apparatus to function, for the following reason. The filter in the citation acts in a different manner to the filter in the Patent, in that contaminated water enters through port 123a and flows into the interior chamber of the filter. As a consequence no seal is needed at the top of the filter for the apparatus to function as intended. For at least this reason it is my opinion claim 1 is novel with respect to JP H6 225847.

40. EP 0017974 A2, a drawing from which is shown below.



41. The document shows another form of cleaning device for swimming pools and includes filters 10. The requester has argued the device is in an inverted arrangement and discloses a filter which “extends from an upper surface of the bottom of the interior chamber 9 of an underside 11, 12 of a cover. In the observations in reply however the requestor refers to features 11 and 12 as outlets. I do not think there is a reasonable interpretation which would allow me to consider the portion in the region of 11 and 12 to be a cover as I have early construed it. I also do not think that it is possible to interpret the floating body 15 as being a cover, as I have construed it. I also note that it appears that removal of the conical housing 26 allows access and replacement of the filters. It is therefore my opinion claim 1 is novel over EP 0017974 for at least the reasons discussed above.

42. It is therefore my opinion claim 1 of the Patent is novel over the supplied evidence. Claims 2-16 are appendant to claim 1 and thus it follows they are also novel.

Inventive step

43. I have been asked for an opinion on whether the claims of the Patent are inventive in light of any of the citations I have previously discussed above and also in light of US 4168557, US 5569371 and US 3676885.

44. In order to come to an opinion on whether the claims are inventive over the documents I shall rely on the principles established in *Pozzoli SPA v BDMO SA [2007] EWCA Civ 588* in which the well known “Windsurfing” steps were reformulated.

45. The first step is to identify the notional person skilled in the art and then the common general knowledge of that person. Neither the requestor nor the observer has explicitly stated who the skilled person would be or what knowledge such a person would have. I consider the skilled person to be a designer of cleaners having particular knowledge of cleaners for use in swimming pools. Such a person would have knowledge of conventional techniques and apparatus for cleaning swimming pools.

46. The second step is to identify the inventive concept of the claims in question. The inventive concept would seem to be a cleaner for use in swimming pools having an interior chamber in which a pump and motor are disposed and a filter for cleaning the water and where a cover is arranged over the chamber where an underside of the cover seals with the top of the filter.

47. The third step is to identify the differences which exist between the matter forming the state of the art and the inventive concept of the claim.

48. Again there has been no explicit discussion by either party as to what constitutes the state of the art. I have been provided however with a number of documents which are used by both parties in various combinations. To determine what differences, if any, there are between these documents and the inventive concept I have considered each in turn.

49. For the documents which I have already discussed under novelty I have made it clear that I do not consider any of them to disclose "a cover which can be arranged above the interior chamber fits closely so as to provide a seal" as I have construed the phrase. Said feature, in my opinion, is also not disclosed in US 4168557, US 5569371 or US 3676885.

50. The fourth step is to determine whether the difference I have identified above is inventive.

51. It is therefore clear that none of documents I have been asked to consider in this Opinion show "a cover which can be arranged above the interior chamber fits closely so as to provide a seal" and thus do not demonstrate claim 1 lacks invention, if combined in any combination. Furthermore, the inclusion of such a feature in any of the documents would require significant redesign in terms of how each the cleaning devices are constructed and I do not see how the skilled person could make such an alteration without employing imagination or inventiveness.

52. It is therefore my opinion that claim 1 is inventive over the evidence supplied to me. As claims 2-16 are appendant to claim 1 it follows they are also inventive and I do not need to consider evidence US 5172445, US 4798670 and JP- A-54-105831 which were only cited against appendant claims.

Opinion

53. It is my opinion that Claims 1-16 of EP 0989255 B1 are novel and inventive over the supplied evidence.

Lyndon Ellis
Examiner

NOTE

This opinion is not based on the outcome of fully litigated proceedings. Rather, it is

based on whatever material the persons requesting the opinion and filing observations have chosen to put before the Office.