

EIP

Added matter and omnibus claims: a UK perspective

Environmental Recycling Technologies Plc v Upcycle Holdings Ltd [2013] EWPC 4 – 5 February 2013.

Summary

This decision of the UK Patents County Court provides insight into the differences between UK and EPO practice. It demonstrates a possibly more lenient approach to amendments based solely on the drawings and confirms that omnibus claims are allowable in the UK, although their clarity was questioned.

Background

In June 2010, the claimant (ERT) commenced invalidity proceedings against the defendant (Upcycle) in respect of UK Patent 2460838 entitled “Process for moulding plastic articles”. During the course of the proceedings the defendant applied to amend the patent so that it comprised a single independent claim 1 and a single omnibus claim 2.

Amended claim 1 was directed to a process. It generally corresponded to a combination of the features of claims 1, 2, 4, 5, 9 and 12 as granted. The claimant argued that this added matter over the application as filed because inter alia it defined use of a machine with a reinforcing structure but not an insulating jacket, whereas, they argued, use of such a machine with a reinforcing structure but without an insulating jacket was not disclosed in the application as filed. The defendant submitted that figure 4 of the patent showed a machine with reinforcing ribs and an insulating jacket which could be removed without changing the reinforcement structure. This was supported by evidence given at

the trial by their expert witness.

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The claimant also argued that amended claim 2 should be refused on discretionary grounds. The UK Patents Act 1977 states in s75(5) that: "in considering whether or not to allow an amendment...the court ... shall have regard to any relevant principles under the European Patent Convention". The claimant contended that, since the EPO only allows omnibus claims in exceptional circumstances and the defendant did not show any such circumstances, amended claim 2 should be refused as a matter of discretion.

Decision

HHJ Birss QC ruled in favour of the defendant and held the patent valid as amended.

Regarding claim 1, it was held that taking the application as filed as a whole and, in particular, keeping in mind what was disclosed by the drawings as supported by the expert evidence, the insulating jacket and reinforcement structure were both optional features which were independently disclosed. On that basis, a claim requiring the reinforcement structure but not the insulating jacket did not illegally add subject matter to the application.

Regarding claim 2, it could not be refused on discretionary grounds because the claim was in the patent as granted; it was only renumbered and not amended of itself in the amendments that were being sought. HHJ Birss QC did comment obiter that: "the UK IPO might like to consider whether omnibus claims serve any useful purpose today save in exceptional circumstances. I question whether they can really be said to satisfy the requirement of clarity".

Conclusion

This case shows the importance attributed to expert evidence in the UK courts. It is interesting to note that the expert witness mentioned that Figure 4 was difficult to understand. Nevertheless, his interpretation of the drawing was not challenged and no doubt assisted the patentee-defendant's case.

This case also demonstrates differences between UK and EPO practice with respect to omnibus claims given that, as a practical matter, omnibus claims are practically never permitted in the EPO.

As to the obiter comment that the UK IPO "might like to consider whether omnibus claims serve any useful purpose today save in exceptional circumstances", this seems to ignore a number of British patent cases where omnibus claims were the only claims held to be infringed, and indeed were the only claims to be valid and infringed in some cases.

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