Patents Act 1977 **Opinion Number** **11/20**

OPINION UNDER SECTION 74A

Patent	GB 2406342 B
Proprietor(s)	HW Martin Holdings Limited
Exclusive Licensee	
Requester	Swindell & Pearson Ltd
Observer(s)	
Date Opinion issued	22 September 2020

The request

1. The comptroller has been requested by Swindell and Pearson ("the requester") to issue an opinion under section 74A(1)(b) of the UK Patents Act 1977 (herein after "the Act") regarding the validity of GB 2406342B ("the patent"), in relation to whether claim 1 is lacking novelty over WO 03/074820, EP 1016768 or GB 2393741; whether claim 1 is lacking an inventive step over GB 2256447 when taken alone, or in combination with WO 95/33113, WO 03/074820 or EP 1016768; whether claim 17 is lacking novelty over WO 93/074820, GB 2256447, WO 95/33113, GB 2393741, EP 1016768, or a traditional/conventional palisade fence; whether claim 17 is lacking an inventive step over GB 2256447 when taken alone, or in combination with WO 95/33113 or WO 03/074820; and whether the dependent claims are also not novel or inventive over the above prior art.

2. The request was received on 2 July 2020 and was accompanied by a statement explaining the request, details of which being provided in Appendix A, as well as copies of the documents below:

   WO 03/074820 A2 (herein after "WO'820") – publication date 12 September 2003

   EP 1016768 A2 (herein after "EP'768") – publication date 5 July 2000

   GB 2393741 A (herein after "GB'741") – publication date 7 April 2004, priority date 2 October 2002

   WO 95/33113 A1 (herein after "WO'113") – publication date 7 December 1995

   GB 2256447 A (herein after "GB'447") – publication date 9 December 1992

Observations and observations in reply

3. Observations were received from the proprietor's representative on 12 August 2020.

4. Observations in reply were submitted by the requester on 26 August 2020.

Matters to be considered by this opinion

5. The requester has asked me to consider GB'741 and GB'447 which I note have been previously considered by the IPO examiner during pre-grant prosecution of the patent.

6. Section 74A(3) of the Act provides that:

> *(3) The comptroller shall issue and opinion if requested to do so under subsection (1) above, but shall not do so;*
> *(a) in such circumstances as may be prescribed, or*
> *(b) if for any reason he considers it inappropriate in all the circumstances to do so.*

7. Given GB'741 was considered by the examiner during examination of the application, it would not be appropriate to consider it again in this opinion.

8. Although GB'447 was considered by the examiner during the original examination process it has not been assessed in light of the potentially new prior art documents and corresponding new arguments relating to what constitutes the common general knowledge of the person skilled in the art. I consider these to be new questions and it is therefore appropriate for me to reconsider GB'447 in this opinion.

9. In the observations in reply the requester comments *"From the starting point of conventional palisade fencing, the novel distinguishing feature of claim 1 of the patent over a conventional palisade fencing is the claimed feature: "the rails defining apertures for receiving the pale"* and goes on to state *"Accordingly, it is submitted that the invention lacks an inventive step over a conventional palisade fence/common general knowledge in combination with each of GB'447, GB'741, WO'820 and EP'768"*, however I can find no corresponding comments in the request. Any observations should be confined to the issues raised by the request and should not broaden the request by raising new issues. I consider that this is a new issue and as such will not be considered in this opinion.

10. In the request the requester has provided very general comments in relation to inventive step including: *"the dependent claims are also not considered to be…inventive over at least the above prior art"* and *"Claims 2-21 relate to features that are conventional/obvious design variants and modifications, else non-inventive implemental details that merely relate to differences of such minor importance that they merely represent design choices for a skilled person and hence are not inventive over WO'820, EP'768 or GB'447 when considered alone or in combination"*. In my view I do not consider these statements to provide clear arguments in relation to inventive step. Inventive step in relation to WO'820, EP'768 and WO'113 when considered alone or in combination will therefore not be

considered in this opinion.

The patent

11. The patent entitled *"Palisade fencing"* was filed on 26 August 2004, having a priority date of 15 September 2003, and was granted on 15 April 2008. The patent remains in force in the United Kingdom.

12. The patent relates to improvements in palisade fencing. The patent explains that palisade fencing typically comprises a number of upright support posts fixed in concrete. Upper and lower rails extend between the posts to which a plurality of pales are mounted. The pales are commonly fixed by centrally located bolts to L-section rails which are in turn secured to H-section supports using fish plated. It is explained that unauthorised pale removal or displacement is typically achieved by cutting one or both bolts which secure the pale to the vertical arms of each L-shaped cross rail.

13. The patent further describes an alternative prior art fence configuration which seeks to overcome this problem. The horizontal arm of each L-section rail is cut to define a number of apertures, each aperture being adapted to receive the end of a pale. The pales are configured to allow only a selected length of each pale end portion to pass through the respective aperture. This is achieved by forming dimples on the centre line of each pale to act as stops. This arrangement allows a secure fence to be constructed without the requirement to bolt the pales to the rails. The patent explains that pales of fences made according to this arrangement have been, at least, partially detached from one or both cross rails by deforming or cutting portions of the apertured arm of the L-shaped cross rail, thus enlarging the aperture to allow displacement or removal of the rail.

14. The invention seeks to overcome the problems associated with the prior art palisade fences discussed above. The invention is shown in Figure 1 and is reproduced below for reference.

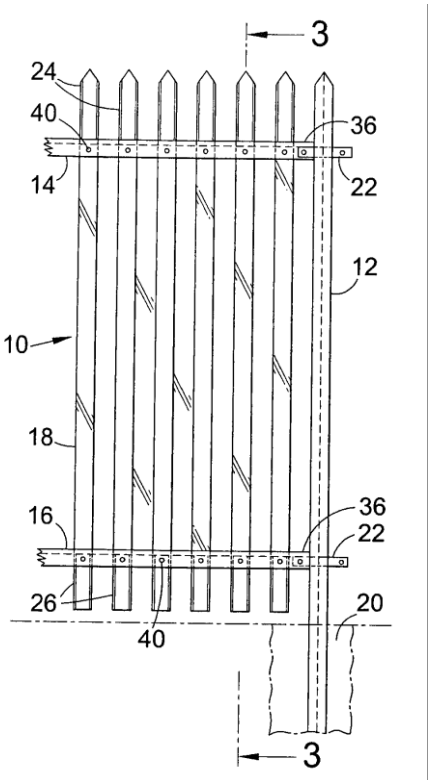


Fig. 1

15. The fence 10 comprises a number of support posts 12 having upper and lower horizontal rails 14, 16 extending therebetween. Spaced, upright angle section pales 18 extend between the rails 14, 16. The posts 12 are set in concrete foundations 20 and have a H-section. The rails 14, 16 have an inverted L-section and are fixed to the posts 12 by means of fish plates 22 which pass through slots in the posts 12.

16. Figures 3 and 4, reproduced below, depict an embodiment of the invention. The pales 18 are of an angled section, defining a shallow “V”. Corresponding generally v-shaped apertures 28, 30 are provided in each rail 14, 16. The ends of each pale 18 pass through the apertures 18, 30 in the rails 14, 16. The pale ends 24, 26 pass through the apertures 28, 30 until beads or dimples 32, 34, pressed from the pales 18, engage the lower or upper surface of the horizontal arm 36, 38 of the respective rail 14, 16. In addition to a central rearwardly directed bead 32a on each pale, two rearwardly directed dimples 32b, 32c are also provided towards the edges of the pale. Thus, when the rails 14, 16 are fixed between a pair of posts 12, the pales 18 are fixed and retained relative to the rails 14, 16. The pales are additionally secured to the rails 14, 16 by fasteners in the form of bolts 40 which pass through the vertical forward arms 42, 44 of the rails 14, 16 and the central portions of the pales. The bolts 40 are secured by nuts 46 which are located in the centre of the “V” of the pale 18.

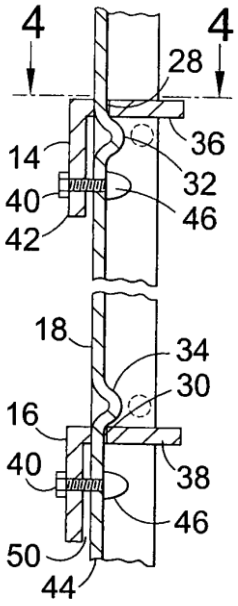


Fig. 3

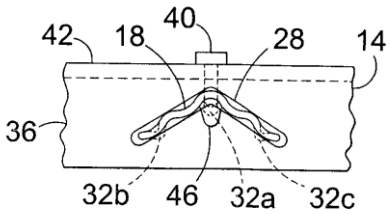


Fig. 4

17. The patent suggests that the invention has the advantage over the prior art in that cutting or deforming of an aperture portion of a rail would not alone be sufficient to allow displacement or removal of a pale because the pale will remain secured to the rail by the fastener. Furthermore, where the rail is an L-section, the rear face of the vertical portion of the rail and the front face of the pale through which the fastener passes are preferably directly adjacent one another. Thus, there is little, if any, possibility of gaining access to the very short portion of fastener extending between the rail and pale, thus protecting the fastener from attack by a chisel or the like.

18. There are twenty-one claims, including two independent claims 1 and 17 and omnibus claim 21.

19. Claim 1 of the patent reads as follows with the features separated out according to the notation 1.1-1.6 used by the requester in Appendix A:

1.1	*A palisade fence comprising:*
1.2	*support posts;*
1.3	*rails for extending between the posts;*
1.4	*and pales for mounting between the rails*
1.5	*the rails defining apertures for receiving the pales*

1.6	*and the pales additionally being secured to the rails by fasteners*

20. Claim 17 of the patent reads:

> *A palisade fence comprising a plurality of pales, each pale having a face for location directly adjacent a face of a support rail and fasteners for securing the pales to the rail and passing through the faces.*

21. Claims 2-16 and 18-20 are reproduced in Annexe 1 of this opinion

Novelty and inventive step – the law

22. Section 1(1)(a) of the Act reads:

> *1(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say –*
> *(a) the invention is new,*
> *(b) it involves an inventive step*

23. The relevant provisions in relation to novelty are found in section 2(1) and section 2(2) of the Act which read:

> *2(1) An invention shall be taken to be new if it does not form part of the state of the art;*
> *2(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.*

24. The provisions in relation to inventive step are found in section 3 which states:

> *3. An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).*

25. The Court of Appeal in *Windsurfing*[1] formulated a four-step approach for assessing whether an invention is obvious to a person skilled in the art. This approach was restated and elaborated upon by the Court of Appeal in *Pozzoli*[2]. Here, Jacob L.J. reformulated the *Windsurfing* approach as follows:

> *(1)(a) Identify the notional "person skilled in the art";*
> *(1)(b) Identify the common general knowledge of that person;*

[1] Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd, [1985] RPC 59
[2] Pozzoli SPA v BDMO SA [2007] EWCA Civ 588

(2) Identify the inventive concept of the claim in question or if that cannot be readily 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 claim as construed;
(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps that would have been obvious to the person skilled in the art or do they require a degree of invention?

26. I will begin by determining whether claims 1 and 17 are novel. Throughout I will consider the cited documents where relevant and as proposed by the requester. I will consider the novelty of the dependent claims should that become necessary after my assessment of the independent claims.

Claim construction

27. When considering the validity of the claims of the patent I will first need to construe them. This means interpreting them in light of the description and drawings as instructed by section 125(1) and take account of the Protocol to Article 69 of the EPC. Section 125(1) of the Act states:

> *125(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.*

28. In doing so I must interpret the claims in context through the eyes of the person skilled in the art. Ultimately, the question is what the person skilled in the art would have understood the patentee to be using the language of the claims to mean. This approach has been confirmed in the recent decisions of the High Court in *Mylan v Yeda*[3] and the Court of Appeal in *Actavis v ICOS*[4].

29. I note in relation to inventive step, the requester has identified the person skilled in the art as a *"fencing engineer"*. The proprietor has not put forward any arguments in relation to this and I think that the requester's assessment is a reasonable one. I consider that such a person would be aware of different types of fence construction and common fixings used in the assembly thereof.

30. Whilst most of the claim(s) do not cause any problems, the requester has raised the following terms/phrases as requiring clarification *"palisade fence"*, *"pale"*, and *"fastener"*. I will construe each of these in turn giving due consideration to the requester's comments. Whilst the proprietor clearly has a certain construction of at least some of these terms in mind (see paragraph 41 below), the proprietor has

[3] Generics UK Ltd (t/a Mylan) v Yeda Research and Development Co. Ltd & Anor [2017] EWHC 2629 (Pat)
[4] Actavis Group & Ors v ICOS Corp & Eli Lilly & Co. [2017] EWCA Civ 1671

neither provided any comments or arguments regarding how these terms should be construed nor disputed the requester's construction of these terms.

31. The requester submits that the term *"palisade fence"* in claim 1 in not accurately defined in the patent and, in view of the disclosure in page 1 lines 10-14, asserts that this term should be construed as *"fencing that comprises a number of upright support posts, with upper and lower rails which extend between the posts that provide mounting for a plurality of upright pales secured to the rails"*.

32. Page 1 lines 10-14 of the patent read *"Palisade fencing typically comprises a number of upright support posts fixed in concrete foundations and upper and lower rails which extend between the post and provide mounting for a plurality of upright pales secured to the rails"*. Whilst I note that this passage states *"typically"* I am satisfied that the person skilled in the art would consider that a palisade fence comprises support posts, upper and lower rails extending between the posts and pales mounted to the rails.

33. I note that page 1 lines 14-18 goes on to state *"The pales are usually of corrugated or angled section and may have spiked or rounded upper ends, depending on the fence application. The pales are fixed by centrally located bolts to the L-section rails which are in turn secured to the H-section support posts using fish plates"*, however, I do not believe that the person skilled in the art would consider the features disclosed in page 1 lines 14-18 to be essential technical features of a palisade fence.

34. Firstly, the term *"usually"* does not limit the pales to having a corrugated or angled cross-section, and thus the person skilled in the art would not consider a pale having a corrugated or angled cross-section to be an essential requirement of a pale of a palisade fence; secondly, page 3 line 22-page 4 line 4 makes reference to the form of the rails "*Reference will be made primarily herein to L-section rails…However, those of skill in the art will recognise that the arms of the rail could of course be at angles other than 90º, and may be inclined to the horizontal or vertical, may have a C, I or H-section, or a box-section, or indeed may take a non-rectilinear form"*. In view of this disclosure the person skilled in the art would understand that the rails may have other forms of cross-section and thus would not consider L-section rails to be an essential requirement of a palisade fence; and thirdly, the patent describes a prior art palisade fence which does not comprise pales fixed by centrally located bolts to L-section rails.

35. Furthermore, whilst page 5 lines 4-6 read *"Palisade fencing will generally comply with British Standard BS1722: Part 12: 199. Specification for steel palisade fences"*, this is merely the British Standard requirement of a particular type of palisade fence and it is not stated in the patent that this is an essential requirement of the palisade fence of the claimed invention.

36. In view of the above I am in agreement with the requester's interpretation of the term *"palisade fence"*, that is to say a fence that comprises a number of upright support posts, with upper and lower rails which extend between the posts and having a plurality of elongate upright pales mounted to the rails.

37. The requester submits that the term *"pale"* in claim 1 is not accurately defined in the patent and, in view of the disclosure in page 1 lines 14-16 of the patent, asserts that

this term should be construed as *"a vertical fencing member (that may or may not be spiked)"*.

38. As I have discussed above, in my view the person skilled in the art would not interpret *"pale"* to mean that the pales of the claimed invention must have a corrugated or angled cross-section. I also note that prior art document GB'741 (page 1 lines 8-10) states *"each pale being formed from a solid rod, bar or hollow tube"*. I therefore consider that the term *"pale"* is used in the art as a synonym to describe vertical fence members not having a particular shape associated therewith and thus includes fence members of rod, bar, hollow tube, picket, corrugated or angled etc. cross-section. I am therefore in agreement with the requester's interpretation of the term *"pale",* that is to say a vertical elongate fence member.

39. The requester further submits that the term *"fastener"* in claim 1 is not accurately defined in the patent and asserts that this term should be *"construed to have its usual broad meaning as a device that mechanically joins or affixes two or more objects together namely, in the context of the patent, a device for securing the pale to the rail"*.

40. The only specific reference to the *"fastener"* in the patent is at page 5 line 21-page 6 line 1 which states *"The fastener may take any appropriate form, and is preferably a bolt. Preferably, the fastener passes through the front portion of the rail, typically a substantially vertical portion of the rail, and through a central portion of the pale. The bolt may be secured by a nut which engages with the rear face of the pale"*. In view of this disclosure I consider that the person skilled in the art would understand the *"fastener"* to mean a device which is capable of mechanically attaching the pale to the rail. I am therefore in agreement with the requester's interpretation of the term *"fastener"*, that is to say a device that mechanically joins or affixes the pale to the rail.

41. In relation to novelty I note the proprietor makes a repeated assertion that each document *"fails to disclose a palisade fence comprising pales"*, and *"rather discloses a picket fence comprising pickets"* (WO'820) or *"…a tubular fence comprising tubular fence members"* (EP'768). Given I have construed the terms *"palisade fence"* and *"pale"* above, I do not need to consider these arguments put forward by the proprietor any further in my analysis of novelty with respect to WO'820 and EP'768.

Whether the claims are novel in view of WO 03/074820 (WO'820)

42. The requester argues that claims 1 and 17 of the patent are not novel in view of WO'820. In Appendix A of the request the requester refers to figures 1 and 2 of WO'820 which are reproduced below.

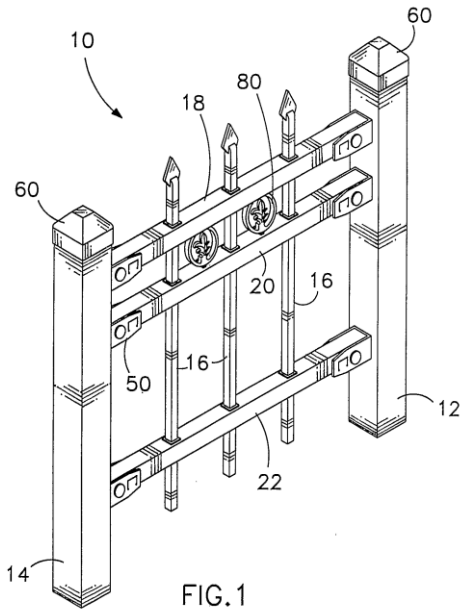


FIG.1

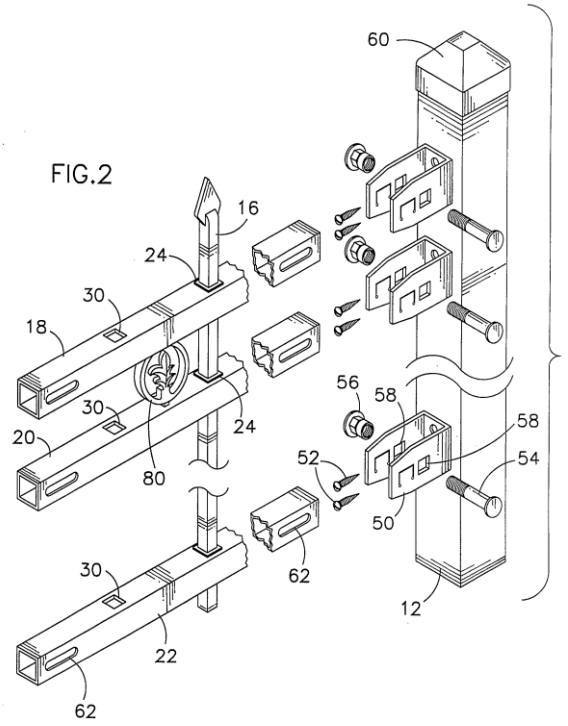


FIG.2

43. Figure 1 shows a modular fence 10, comprising vertical posts 12, 14 and horizontal rails 18, 20, 22 extending between vertical posts 12, 14 and being affixed thereto by metal brackets 50. Pickets 16 are mounted on the rails 18, 20, 22. Figure 2 shows apertures 30 in rails 18, 20, 22 for receiving the pickets 16. The final paragraph on page 11 specifies *"The modular fence further includes bolts and nuts, where each bolt is inserted through a respective horizontal rail and picket for further securing the pickets to the rails"* (this is depicted in figure 6(e) reproduced below).

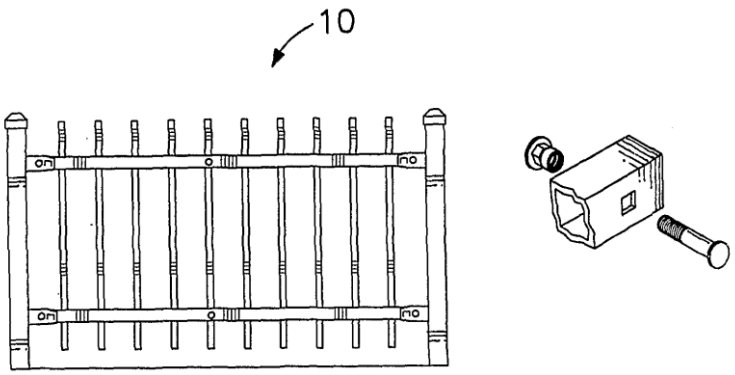


FIG.6 (e)

44. Given my construction of the terms *"palisade fence"*, *"pale"*, and *"fastener"* above, I consider (using the annotation provided by the requester in Appendix A) claim integer 1.1 is shown by modular fence 10; claim integer 1.2 is shown by vertical posts 12,14; claim integer 1.3 is shown by horizontal rails 18, 20, 22; claim integer

1.4 is shown by pickets 16; claim integer 1.5 is shown by apertures 30 in rails 18, 20, 22 for receiving pickets 16; and claim integer 1.6 is shown by bolts and nuts (figure 6(e) and final paragraph page 11) for securing pickets 16 to rails 18, 20, 22.

45. Accordingly, I consider that claim 1 lacks novelty based on WO'820.

46. Furthermore, I consider that the modular fence as shown in figures 1, 2 and 6(e) comprises all of the required technical features of claim 17, namely: A palisade fence (modular fence 10); a plurality of pales (pickets 16); each pale have a face for location directly adjacent a face of a support rail (figure 2); and fasteners for securing the pales to the rail and passing through the faces (figure 6(e) and final paragraph page 11).

47. Accordingly, I consider that claim 17 lacks novelty based on WO'820.

48. As I have found claims 1 and 17 to lack novelty, I will now consider the dependent claims.

49. With respect to claims 2-4, whilst figures 1 and 2 show the rails 18, 20, 22 having a square tubular cross-section I consider they nevertheless comprise an L-section having a front vertical arm and a rear horizontal arm. Figures 1 and 2 show that the rear horizontal arm comprises apertures 30 to receive the pickets 16 and figure 6(e) shows that the vertical arm receives the fastener. Accordingly, I consider that this disclosure meets the requirements of claims 2-4 and therefore these claims lack novelty over WO'820.

50. With respect to claim 5, WO'820 fails to disclose each pale being provided with a projection spaced from an end of the pale such that only a selected length of each end portion passes through the associated aperture in the rail. I consider that claim 5 and subsequent dependent claims 6-10 are novel over WO'820.

51. In view of Figures 1 and 2 (rails 18, 20, 22) I consider claim 11 lacks novelty over WO'820.

52. As I have discussed above, the final paragraph on page 11 discloses *"The modular fence further includes bolts and nuts, where each bolt is inserted through a respective horizontal rail and picket for further securing the pickets to the rails"* and figure 6(e) shows a nut and bolt fastener for securing pickets to the rails wherein the fastener passes through the vertical arm of the rail and through a central portion of the picket such that the nut engages with the rear face of the picket to secure the bolt. I am satisfied that this disclosure meets the requirements of claims 12-14 and therefore these claims lack novelty over WO'820.

53. With respect to claim 15, whilst I note that the nut shown in figure 6(e) depicts an outer portion shaped to connect with a conventional tool such as a spanner, and an inner portion which is round and thus not easily gripped by a conventional tool, it is not stated in WO'820 that the two portions are frangibly connected. I therefore consider claim 15 is novel over WO'820.

54. With respect to claim 16, because the pickets of WO'820 do not have an angle section I consider claim 16 is novel over WO'820.

55. The conclusions I have reached in relation to claim 2, discussed above, also apply to claim 18, and will not be repeated here. I consider that claim 18 lacks novelty over WO'280. Furthermore, I consider claim 19 lacks novelty.

56. As I have discussed in relation to claim 16 the pickets of WO'820 do not have an angle section I consider claim 20 is novel over WO'820.

Whether the claims are novel in view of EP 1016768 (EP'768)

57. The requester argues that claims 1 and 17 of patent are not novel in view of EP'768. In Appendix A the requester refers to figures 1-3 of EP'768.

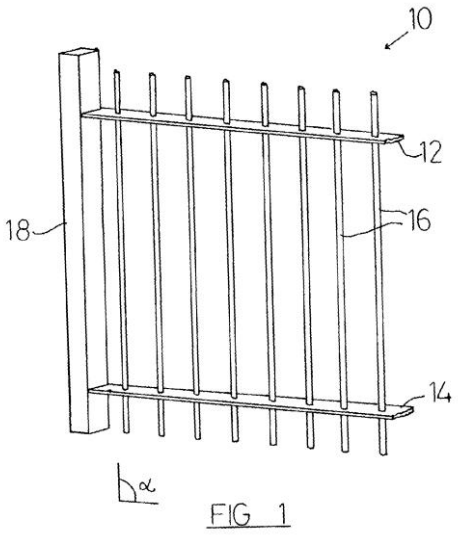
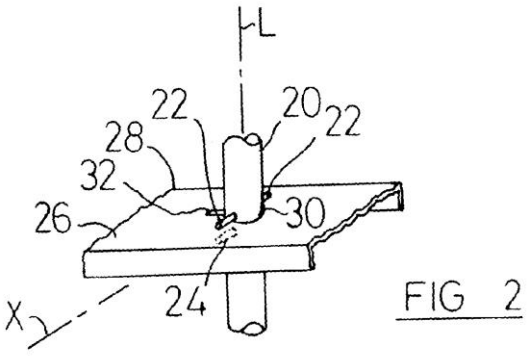
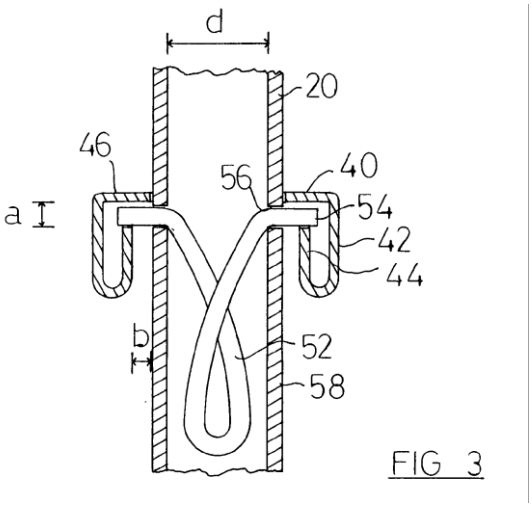


FIG 1

58. Figure 1 depicts a vertical fence section 10 comprising support posts 18 having upper and lower rails 12, 14 extending between the posts 18. Fence members 16 are mounted to the rails 12, 14. Figure 2 (depicted below) shows pivotable or adjustable attachment of a fence member to the rail. An aperture 30 is provided in rail 28 for receiving a fence member 20. The fence member 20 has three fixed pegs. When assembled pegs 22 lie above the wall 26, while peg 24 lies below the wall 26. The pegs 22 prevent the fence member from being moved downwards relative to the rail 28, whilst peg 24 prevents the fence member 20 from being moved upwards relative to the rail 28.



59. Figure 3 (depicted below) shows attachment of a fence member to the rail using a spring clip 52 which limits movement along the longitudinal axis and limits rotation. The ends 54 of the spring clip 52 project through opposed openings 56 in the wall 58 of the tubular frame member and engages with a recess in the rail.



60. Given my construction of the terms *"palisade fence"*, *"pale"*, and *"fastener"* above, I consider (using the annotation provided by the requester in Appendix A) claim integer 1.1 is shown by tube fence 10; claim integer 1.2 is shown by vertical posts 18; claim integer 1.3 is shown by horizontal rails 12, 14; claim integer 1.4 is shown by tube fence members 16; claim integer 1.5 is shown by apertures 30 in rails 28 for receiving tube fence members 20; and claim integer 1.6 is shown by spring clip 52 (figure 3) for securing fence members 20 to rail 40 and further by paragraph [0046] which states *"the use of the attachment of fig.3 to both rails of a fence section"*. Equally, claim integer 1.6 is disclosed in paragraph [0045], the fence 20 being attached to one rail of the fence section as in fig. 2 and by attachment to the other rail as in fig. 3.

61. Accordingly, I consider that claim 1 lacks novelty based on EP'768.

62. Furthermore, I consider that the tubular fence disclosed in EP'768 comprises all of the technical features as defined in claim 17, namely: a palisade fence (figure 1); a plurality of pales (figure 1, fence members 16); each pale having a face for location

directly adjacent a face of a support rail (figure 2); and fasteners for securing the pales to the rails and passing through the faces (figure 3).

63. Accordingly, I consider that claim 17 lacks novelty based on EP'768.

64. As I have found claims 1 and 17 to lack novelty, I will now consider the dependent claims.

65. With respect to claims 2-4, as shown in fig. 3 the rail 40 is of channel section comprising a horizontal wall 46 having an aperture therein, and a side wall 42 having an inturned part 44. I consider that this configuration shows an L-section composed of the horizontal wall 46 and the vertical arm formed of the side wall 42 and inturned part 44. The spring clip 52 engages with notches 50 on inturned part 44 of the vertical arm and thus meets the requirement of the vertical arm receiving the fastener. Accordingly, I consider that this disclosure meets the requirements of claims 2-4 and therefore these claims lack novelty over EP'768.

66. With respect to claim 5, whilst fig. 2 shows pale 20 having pegs (projections) 22, 24, EP'768 fails to disclose that the pegs (projections) are provided on both ends of the pale. Therefore, I do not believe the disclosure of EP'768 meets the requirement of *"the end portions of each pale being provided with a projection"*. I consider that claim 5 and subsequent dependent claims 6-10 are novel over EP'768.

67. EP'768 fails to disclose that the fence can contain three rails. Therefore, in my view claim 11 is novel over EP'768.

68. EP'768 does not disclose that the fastener may be a bolt and nut. I consider that claim 12 and subsequent dependent claims 14-16 are novel over EP'768.

69. With respect to claim 13, Fig. 3 shows spring clip 52 engaging with notch 50 on inturned part 44 of the vertical arm. However, I do not believe that this arrangement shows the fastener passing through the vertical arm of the rail. I therefore consider that claim 13 is novel over EP'768.

70. The conclusions I have reached in relation to claim 2, discussed above, also apply to claim 18, and will not be repeated here. I consider that claim 18 lacks novelty over EP'768.

71. As I have discussed above EP'768 fails to disclose the pale being fastened to the rail by a bolt secured to a nut. I consider that claim 19, and subsequent dependent claim 20 are novel over EP'768.

Whether claim 17 is novel over WO 95/33113 (WO'113) or a traditional/conventional palisade fence known in the art

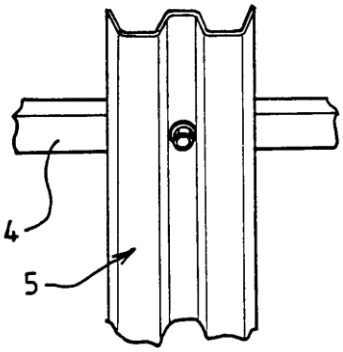
72. The requester submits that claim 17 is not novel in view of WO'113.

73. The requester submits *"WO'113 discloses "…improvements relating to fence pales, particularly as are afforded by elongate members which in use are bolted or otherwise secured to a supporting structure…" (Page 1 lines 1-4). WO'113 shows a*

conventional W-section pale Figs. 1 and 2. As illustrated in fig.1, the conventional W-section pale has a flat central face which locates against (i.e. directly adjacent to) a face of a support rail 4; and a fastener, passing through the faces, for supporting the pale to the rail". The proprietor has not submitted any comments in relation to this argument put forward by the requester.

74. I am in agreement with the requester's arguments. I consider that the features of claim 17 are clearly disclosed in figure 1 (shown below), which shows a conventional pale secured via a screw to a support rail. Furthermore, page 1 lines 1-4 state that in use the fence pale is to be bolted or otherwise secured to the support rail.

FIG 1



75. Accordingly, I consider claim 17 to lack novelty in view of WO'113.

76. WO'113 fails to disclose *"the horizontal arm being aperture to receive the pales"* as required by claim 18, therefore I consider claim 18 to be novel over WO'113.

77. As discussed above page 1 lines 1-4 state that the fence pales are to be bolted to a supporting structure, and figure 1 shows the pale having an angled section. I consider these features to meet the terms of claims 19 and 20 and thus are lacking novelty.

78. The requester further submits that claim 17 is not novel in view of traditional palisade fences known in the art.

79. The requester submits *"…typical/conventional palisade fences, e.g. such as have been in use for over one hundred years (as mentioned in GB'447 page 1 lines 6-7). For example, a wooden palisade fence nailed to horizontal wooden rails that are supported by wooden support posts fixed into the ground. Clearly, in such a palisade fence, a face of each pale would be directly adjacent a face of each rail and fasteners securing the pales to the rail would pass through the faces"*. The proprietor has not submitted any comments in relation to this argument put forward by the requester.

80. I am in agreement with the requester's arguments. Wooden palisade fences of the type outlined by the requester are known. Furthermore, as disclosed in page 1 lines 6-19 of GB'447, palisade fences comprising support posts, upper and lower rails extending between the posts and a plurality of pales mounted to the rails are known. Commonly, the pales are corrugated or are of angle section and are bolted to L-section rails.

81. In view of the above I consider claims 17, 19 and 20 to lack novelty over traditional/conventional palisade fences known in the art.

82. The requester has also asked me to consider whether the claims lack an inventive step as outlined in the request. In relation to the arguments put forward regarding GB'447, I note that the requester uses the problem and solution approach in their assessment of inventive step. As I have outlined above, the UK approach to assessing inventive step is that as laid out in the four step *Windsurfing/Pozzoli* test. I will now consider inventive step using the *Windsurfing/Pozzoli* steps.

Whether claim 1 lacks an inventive step in view of GB'447

83. I note the requester argues in two ways in relation to inventive step, as follows: (i) claim 1 lacks an inventive step in light of GB'447 when taken alone; and (ii) claim 1 lacks an inventive step on the basis of GB'447 in combination with WO'113, WO'820 or EP'768.

Step 1(a) and 1(b): identify the notional "person skilled in the art" and the relevant common general knowledge of that person.

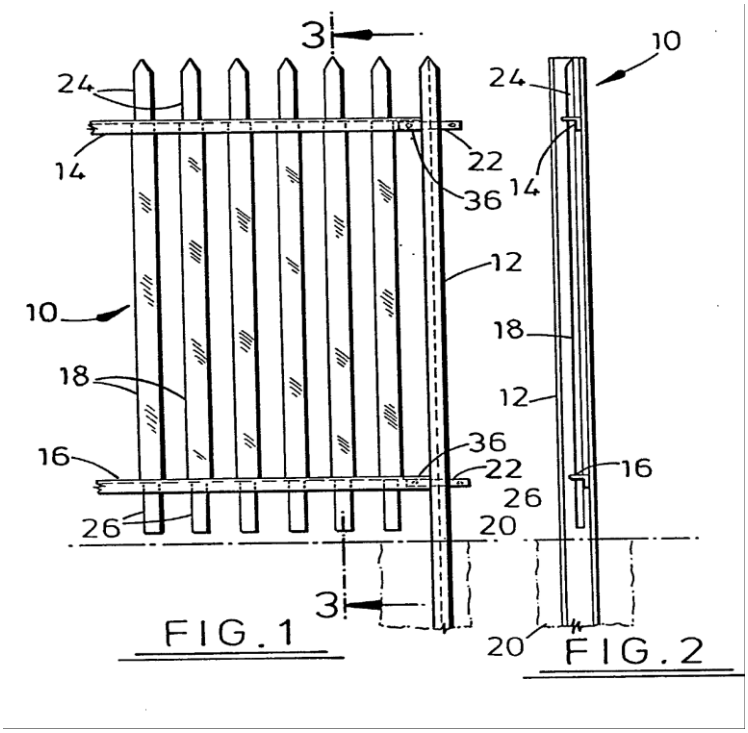
84. As discussed above I consider that the person skilled in the art is a fencing engineer. I consider that such a person would be aware of different types of fence construction and common fixings used in the assembly thereof.

Step 2: Identify the inventive concept of the claim in question or, if that cannot be done, construe it.

85. I have construed claim 1 above.

Step 3 and 4: Identify what, if any differences exist between the matter as cited as forming part of the state of the art and the inventive of the claim or claim as construed; and viewed without any knowledge of the alleged invention as claimed do those differences constitute steps that would have been obvious to the person skilled in the art or do they require a degree of invention?

86. The requester submits that *"GB'447 clearly and explicitly discloses each of the claim integers 1.1 to 1.5 of claim 1 of the patent"*. Figures 1 and 2 of GB'447, shown below, disclose a palisade fence comprising support posts 12, rails 14, 16 extending between the posts 12, and pales 18 for mounting between the rails 14, 16. The rails 14, 16 include apertures for receiving the end portions of the pales 24, 26. The end portions of the pales 18 are configured to engage and seat on the respective rails 14, 16 to limit the extent to which the end portions of the pales 24, 26 extend through the rails 14, 16, this is achieved by providing projections on the end portions of the pales to prevent the ends of the pale passing through the aperture. I am satisfied that GB'447 discloses claim integers 1.1 to 1.5.



87. The requester and proprietor agree that claim 1 of the patent is distinguished from GB'447 by claim integer 1.6, namely *"the pales additionally being secured to the rails by fasteners"*.

88. The requester argues *"The technical effect of the distinguishing feature of claim integer 1.6, namely its use of fasteners, is that it improves the securing of the pales to the rails, i.e. it improves the strength of the fixing of the pales to the rails thereby making them more secure and resistant to attack. It is submitted that, in order to further secure one object to another, it is a widely used engineering principle and entirely conventional practice to secure the two objects together by providing an additional fastening means. Accordingly, it would have been obvious to additionally use fasteners to further secure the pales to the rails of GB'447's palisade fence"*.

89. The requester further argues that *"It is common general knowledge in the field of palisade fencing to use bolts to secure pales to rails…Accordingly a person skilled in the art would be well aware of the widespread customary use of fasteners (not least such as bolts) to secure pales to rails"*.

90. The proprietor contends that claim 1 is not obvious over GB'447, because GB'447 teaches away from the use of fasteners to secure the pales to the rails and references page 10 of GB'447 which states *"From the above description it will be evident that a fence in accordance with the present invention provides for secure mounting of pales to the rails of a palisade fence without the use of bolts or rivets and provides for secure mounting of pales which only permits the removal or movement of pales through removal of the rails"*. The proprietor concludes that *"GB2256447 specifically instructs the person of ordinary skill in the art not to use fasteners. Moreover, this constitutes a principle feature of the prior art document"*.

91. The requester argues that the passage highlighted by the proprietor *"does not specifically instruct the person of ordinary skill in the art not to use fasteners but,*

instead, merely indicates that, in various examples of GB'447's palisade fence, pales can be securely mounted to the rails without the use of bolts or rivets" and goes to conclude *"Accordingly, in the absence of any specific instructions for the person of ordinary skill in the art not to use fasteners with GB'447's palisade fencing system, it would be obvious to the person skilled in the art, seeking to additionally secure the pales to the rails, to do so by the use of fasteners"*. However, I am not convinced by the requester's arguments.

92. In view of the disclosure of GB'447 I do not believe that the person skilled in the art would seek to additionally secure the pales to the rails as suggested by the requester. In this respect I can find no teaching in GB'447 to suggest that fasteners are an additional and necessary requirement to ensure adequate securing of the pale to the rail. Furthermore, GB'447 exemplifies a palisade fence where the constructional features of the pales are such that they are secured to the rail without [emphasis added] having to be further fastened to the rails by a fastener (see figure 6 reproduced below). Therefore, I do not believe that the person skilled in the art would be motivated to use fasteners to secure the pales to the rails as they would deem such fastenings to be unnecessary. Moreover, in my view the person skilled in the art would consider that the use of such fastenings would be contrary to the object of the invention disclosed in GB'447 of providing a fence which is *"easier and less time consuming to assemble than existing conventional fencing"*.

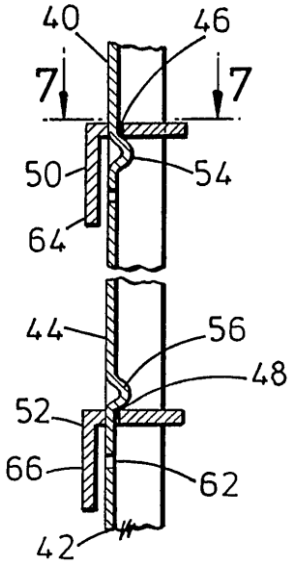


FIG. 6

93. As highlighted by the proprietor page 10 of GB'447 discloses *"the present invention provides for the secure mounting of pales to the rails of a palisade fence without the use of bolts or rivets"*. Furthermore, I note that page 2 of GB'447 discloses "to *provide a fence in which the pales are more easily and securely located relative to the rails of a palisade fence"*, this is achieved without the use of bolts or rivets, as it is outlined that such fastenings have technical problems associated therewith including assembly time, cost and are not particularly effective. In my opinion GB'447 directly teaches away from using bolts and rivets to fasten the pales to the rails. I

note that the requester argues that GB'447 *"does not specifically instruct the person of ordinary skill in the art not use fasteners"*. However, aside from bolts and rivets, the requester has not provided any further evidence regarding other types of fastener which are deemed to be conventional in the art and which form part of the common general knowledge. In light of the teachings of GB'447 I consider that the person skilled in the art, in view of their common general knowledge, would not arrive at the invention as defined in claim 1 of the patent.

94. Furthermore, in light of my conclusions above regarding the teachings of GB'447, I do not believe that the person skilled in the art would consider the use of the fasteners disclosed in any of WO'113, WO'820 of EP'768.

95. Accordingly, it is my opinion that claim 1 is inventive in light of GB'447 when taken alone, or when used in combination with WO'113, WO'820 or EP'768.

Whether claim 17 lacks an inventive step in view of GB'447

96. The conclusions I have reached in relation to claim 1, discussed above, also apply to claim 17. I consider that regardless of alternative documents showing fasteners, based on the teachings of GB'447, there is no motivation to provide them. I therefore consider that claim 17 is inventive over GB'447 when taken alone or when used in combination with WO'113, WO'820 or EP'768.

Conclusion

97. In view of the disclosures of WO'820, EP'768, WO'113, and traditional/conventional palisade fences known in the art, I consider claims 1-4, 11-14 and 17-20 lack novelty.

98. However, I consider claims 1-20 are inventive over GB'447 when taken alone or when used in combination with WO'113, WO'820 or EP'768.

Application for Review

99. Under section 74B and rule 98, the proprietor may, within three months of the date of issue of this opinion, apply to the comptroller for a review of the opinion.

Natalie Cole
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.

Annexe 1

Claim 2. A palisade fence of claim 1 wherein at least one rail comprises an L-section having a front vertical arm and a rear horizontal arm, the horizontal arm being apertured to receive the pales while the vertical arm receives the fastener.

Claim 3. A palisade fence of claim 2, wherein the rear face of the vertical arm of the rail and a front face of the pale through which the fastener passes are directly adjacent one another.

Claim 4. A palisade fence of any preceding claim, wherein the apertures are of complementary shape to the pales.

Claim 5. A palisade fence of claim 4, wherein the apertures are of complementary shape to the end portions of the pales and the ends of the pales extend through the apertures, the end portions of each pale being provided with a projection spaced from an end of the pale such that only a selected length of each end portion passes through the associated aperture in the rail.

Claim 6. A palisade fence of claim 5, wherein the projection on each pale end portion comprises at least one bead pressed from the pale.

Claim 7. A palisade fence of claim 5, wherein at least one projection on each pale end portion is a welding bead.

Claim 8. A palisade fence of any of claims 5 to 7, wherein a projection is provided centrally of the pale.

Claim 9. A palisade fence of any of claims 5 or 7, wherein a projection is provided spaced from a centre line of the pale.

Claim 10. A palisade fence of claim 8, wherein at least one further projection is provided spaced from a centre line of the pale.

Claim 11. A palisade fence of any preceding claim, comprising three vertically spaced rails.

Claim 12. A palisade fence of any preceding claim, wherein the fastener is a bolt.

Claim 13. A palisade fence of claim 2, or any of claims 3 to 12, when dependent on claim 2 wherein the fastener passes through the vertical arm of the rail and through a central portion of the pale.

Claim 14. A palisade fence of claim 12, or claim 13 when dependent on claim 12, wherein the bolt is secured by a nut which engages with a rear face of the pale.

Claim 15. A palisade fence of claim 14, wherein the nut has an outer portion for engagement with a tightening tool, and an inner portion of a shape which is not easily gripped by a conventional tool, the two portions being frangibly connected.

Claim 16. A palisade fence of either claims 14 or 15, wherein each pale has an angle section and the nut is located centrally of the pale.

Claim 18. A palisade fence of claim 17, wherein at least one rail comprises an L-section having a front vertical arm and a rear horizontal arm, the horizontal arm being apertured to receive the pales while the vertical arm received the fastener.

Claim 19. A palisade fence of either claims 17 or 18, wherein the fastener is a bolt secured by a nut which engages with a rear face of the pale.

Claim 20. A palisade fence of claim 19, wherein each pale has an angle section and the nut is located centrally of the pale.