BL O/020/90

PATENTS ACT 1977

IN THE MATTER OF a reference under
Section 12(1) by Latchways Limited
in respect of European Patent Application
No 85400859.6 (Publication No 0163563)
in the name of Cleveland E Dodge Jn.

DECISION

Latchways Limited, a British company based in Chippenham, Wiltshire, filed a reference under Section 12(1), with an accompanying statement of case, on 10 August 1988. They claim to be entitled to be granted a patent for the invention disclosed in European patent application No 0163563, (which I shall call the European application) and seek an order under Section 12(6) entitling them to make an application for a patent under the Patents Act 1977 for that invention, with the application being treated as having been filed on the filing date of the European application.

A copy of the statement of case was sent by the Patent Office to the applicant Mr Dodge, care of a firm in Paris which is recorded on the Register of European patents as his representative. He was given further opportunities to comment by letters sent both to his representatives' address and to his address in the United States as recorded in the Register of European patents. No evidence or comment has been received from the applicant, and in these circumstances, the Comptroller's normal practice, in a dispute between two parties, is to proceed on the basis that the facts stated in the statement of case are true. In this case, however, Latchways are asking for new public rights to be granted to them, and they were therefore required to file evidence to support their case.

Their evidence, which I accept as true, consists of three statutory declarations with accompanying exhibits, filed on 10 August 1989. The declarants are Mr Alan Tupper, founder of, and now consultant to, Latchways; Mr Peter Flux, co-inventor with Mr Tupper of a Latchways rope grip; and Mr Laurence Ben-Nathan, Patent Agent for Latchways.

The facts relevant to the making of the European application and this reference under section 12 are as follows. Latchways are in the business of manufacturing and supplying rope fastening equipment. They are a small company, and there is no indication that they operate other than in the United Kingdom. As far as the applicant is concerned, his place of residence is the United States of America.

The European application was published on 4 December 1985, and withdrawn on 5 August 1986. The current reference was made on 10 August 1988. The delay of two years in making application is a matter to which I shall have to return later.

The determination of this matter is governed by sections 12 and 82, the relevant parts of which read as follows:

> "12(1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom .... (a) any person may refer to the comptroller the question whether he is entitled to be granted ... any such patent for that invention ... and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.
>
> "(3) Subsection (1) above, in its application to a European patent and an application for any such patent, shall have effect subject to section 82 below.
>
> "(6) In the following cases, that is to say -

(a) where an application for a European patent (UK) is refused or withdrawn, or the designation of the United Kingdom in the application is withdrawn, after publication of the application but before a question relating to the right to the patent has been referred to the comptroller under subsection (1) above or before proceedings relating to that right have begun before the relevant convention court;

the comptroller may order that any person (other than the applicant) appearing to him to be entitled to be granted a patent under this Act may within the prescribed period make an application for such a patent for the whole or part of any matter comprised in the earlier application (subject, however, to section 76 below) and that if the application for a patent under this Act is filed, it shall be treated as having been filed on the date of filing the earlier application."

"82(1) The court shall not have jurisdiction to determine a question to which this section applies except in accordance with the following provisions of this section.

"(4) The court and the comptroller shall have jurisdiction to determine any question to which this section applies, other than an employer-employee question, if either of the following conditions is satisfied, that is to say -

(a) the applicant has his residence or principal place of business in the United Kingdom; or

(b) the other party claims that the patent should be granted to him and he has his residence or principal place of business in the United Kingdom and the applicant does not have his residence or principal place of business in any of the relevant contracting states;

and also if in either of those cases there is no written

evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom."

Firstly then I have to consider whether the Comptroller has jurisdiction to consider the reference; that is, whether the conditions as set out in section 82(4) as satisfied. As noted above the referors' place of business is in the United Kingdom, while the applicant resides in the USA, which is not a contracting state of the European Patent Convention. There is no evidence that the parties have agreed to submit to any other jurisdiction. In these circumstances I am satisfied that the comptroller has jurisdiction to decide this reference.

Further, since the European application was withdrawn after publication, and the reference follows such withdrawal, the necessary conditions of section 12(6) have been met, and the Comptroller therefore has the discretionary power to allow a new patent application to be filed.

I now turn to the history leading up to the reference, as revealed by the evidence. Mr Tupper describes the first rope grip or 'transfastener', invented by himself and Mr Flux in 1977 as part of a safety system for protecting workers at great heights from falling to the ground. Various modifications followed, culminating in what they call the 'camlatch', the subject of British Patent application No 2096959, filed in April 1981. Further development work led to a device, known as the 'climblatch', which is described by Mr Flux in paragraph 4 of his declaration. Copies of drawings prepared on 6 May 1982 and a photograph of the prototype are exhibited to his declaration as Exhibits PRF1 and PRF2 respectively. The key feature of the camlatch is the spring loading of a cam locking (or wedge) member.

Mr Tupper refers to Mr Dodge as someone who would exploit or develop Latchways' products in the United States. He states that at a meeting at the Institute of Directors in Pall Mall, London in June 1982, Mr Dodge was shown the 'climblatch' prototype. He was subsequently provided with a 'camlatch' device. At a later meeting in November, in Mr Tupper's cottage in Castle Coombe, Mr Dodge was again shown the 'climblatch'. Mr Tupper also exhibits a letter from Mr Dodge dated 17 November 1982 (Exhibit AWT 7) in which Mr Dodge agrees to treat the matters under consideration "with every confidence".

According to Mr Tupper, Mr Dodge was also working on rope grip devices. He subsequently filed a United States application, which resulted in the grant of US Patent 4502668. I note here that the design shown differs significantly from both the 'camlatch' and 'climblatch' devices, in that it has no slotted rotary wheels. In May 1984 Mr Dodge applied for a United States patent for a rope grip and claimed priority from that US application in the European application which is the subject of the present proceedings.

Meanwhile, according to Mr Tupper (paragraph 6), "owing to other higher priority business projects, the development of CLIMBLATCH took place gradually over the next few years at a low priority in relation to other products". In fact it was not until 14 November 1986 that a British Patent application was filed. A European application based thereon was filed on 4 November 1987, eventually published as EPA 0272782, on 29 June 1988. The European search report reached Latchways, via their agent, on 28 April 1988, and included as a prior publication EPA 0163563, the European application in suit. As noted above, the current reference was subsequently filed on 10 August 1988.

It is now necessary to consider the various "inventions" involved. These are those of the Dodge and Latchways European applications and the "original" as sketched by Mr Flux. The

Dodge application concerns a system comprising a grip having a pivotably mounted wedge in spaced facing relationship with a retaining member. The worker's safety line passes between the wedge and the retaining member. The grip is able to bypass anchors securing the line to a structure by virtue of the fact that the retaining member is held in place by rotating wheels, slotted to allow passage of the grip past the anchors. Further, the wedge is urged by a spring in such a way that jamming occurs automatically if tension on it is removed ie if the worker falls.

This invention differs from the "original" principally in the point of action of the spring on the wedge. It seems to me that this can be attributed either to imperfect recollection of the device on Mr Dodge's part (as noted above he was only shown that device), or some further refinement of it on his part. I should also note here that the Dodge claims were broad enough to cover the earlier Latchways 'camlatch' device, the relevant patent application for which, GBA 2096959, was cited by the European search examiner. The spring is firstly defined only in claim 2. I shall need to refer to this point later. The Latchways invention disclosed in their European application again differs from the "original" principally in the point of action of the spring.

I am satisfied from this evidence that there is subject matter in the Dodge European application that was obtained from Latchways in confidence, and that Latchways are in principle entitled to be granted a patent under the Patents Act 1977 for it: There are however, a number of points of difficulty which need to be resolved before I can exercise the Comptroller's discretion to make such an order.

My first concern is that Latchways' new application, made in say May 1990, would be treated as having a filing date five years earlier. Further, it would give them an application date 18 months earlier than their own British filing, on which their own European application was based.

My concern is compounded by the effect this might have on any other inventors or manufacturers in this field who might have acted on the assumption that this subject was in the public domain following the withdrawal of the European application. Section 12 does not provide any relief for such innocent infringers if they continue to use the invention and I would therefore not make an order for a new application if Latchways were guilty of undue delay in making this reference or of negligence in safeguarding their rights. However, in my view it was reasonable of Latchways to divulge their invention in confidence to Mr Dodge and I consider that they acted with reasonable dispatch after learning of his European application.

Moreover, if an innocent infringer is sued for infringement of the patent that results from a new application, the unusual circumstances of the application will be able to to be taken account of by the court in deciding what remedies to award to the patentee.

I note too that Rule 34 of the Patents Rules 1982 specifies, as the period for putting the application in order, a period of 54 months from the priority date or 18 months from the actual filing date, whichever expires later. The rule therefore contemplates a situation, as here, where there is a period of more than three years between the two filings.

The second point arises in this way. Section 12(6) provides that the new application shall have the application date of the European application. However, the European application has an earlier priority date, and would normally form part of the state of the art by the provisions of section 2(3). There would be no point in allowing a new application for an invention that would inevitably lack novelty.

However, section 78(5) of the Patents Act, as interpreted by the Patents Court in L'Oreal's Application [1986] RPC 19 at pages 27-29, has the effect of removing withdrawn published European applications from the state of the art under section 2(3), so this potential objection is removed.

I note that section 78 will be amended when Schedule 5 of the Copyright, Designs and Patents Act 1988 comes into force, with the result that the continued operation of section 2(3) will not be affected by such withdrawal. That Schedule of the 1988 Act has not yet come into force, and as I understand the Schedule, the amendment will not have the retrospective effect of destroying the novelty of the new application.

My final concern is the exact form the new application should take. It will be seen from the provisions of section 12(6) quoted above, that the new application is subject to section 76 of the Act. That is, the application shall not be allowed to be filed if it discloses matter which extends beyond that disclosed in the earlier application, that is, the European application, as filed. Now as noted above, the three "inventions" that I have had to consider differ in certain details. So, on the one hand, I cannot allow the new application to include the detail from Latchways' original drawings nor of their later European application, for that would include new matter contrary to section 76. On the other hand, as noted above, Latchways are only entitled to protection for such matter comprised in the Dodge application as emanated from them. On the face of it there is no way out this dilemma.

The declaration of Mr Ben-Nathen, Agent for Latchways is accompanied by a specification for the proposed new UK application - exhibit LBN1. The drawings of this specification are identical to those in the European application, and the description, with some amendment, is very similar to that of Dodge. However, those amendments do seem to have been made with a view to deleting matter which Latchways themselves did not originate. In particular, the description of the spring on page 6 has been amended to eliminate any reference to the precise manner in which it is attached to the wedge and side plates. It is true that the drawings remain unaltered. However, if amendment were to have been made to the drawings, that might in itself have been objectional under section 76. In the circumstances I am prepared to regard the drawings as diagammatic. As far as the claims are concerned claim 1 is a combination of claims 1 and 2 of the European application. This has the effect of characterising the invention by the spring, which is the inventive concept in 'climblatch'. A further independent claim, claim 6, is similarly now characterised. During the course of correspondence with the Office, some further amendments have been made to the claims, so that their proposed form is now that accompanying their letter of 12 January 1990. I would just add that the statement of claim does not include any claim to the specific embodiments described or shown in the drawings ie an "omnibus" claim.

The proposed specification then, has avoided the addition of matter contrary to section 76, and broadly discloses the 'climblatch' concept without giving patent protection for the specific embodiments of the Dodge application. I am satisfied that in the circumstances I can make an order permitting the filing of such a specification and that it be accorded the filing date of the European application.

I therefore order that Latchways Limited may make a new application under section 12(6) for a patent in respect of the matter contained in Exhibit LBN1 to Mr Ben-Nathen's declaration, but with the claims amended to the form accompanying the letter of 12 January, referred to above. I further order that the new application shall be treated as having been filed on the date of filing of European application No 0163563 namely 2 May 1985.

Dated this 6th day of ~~February~~ March 1990

W J LYON
Superintending Examiner, acting for the Comptroller

PATENT OFFICE

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