

BLO/145/88

PATENTS ACT 1977

IN THE MATTER OF European patent  
application 85.301207.8 in the name  
of The Rawlplug Company Limited

and

IN THE MATTER OF an application under  
Section 12(1) by Vereinigte Schlusselfabriken AG  
for an order of entitlement in respect thereof.

DECISION

In these proceedings under Section 12(1) of the Patents Act 1977, Vereinigte Schlusselfabriken AG (hereinafter 'VS') seek an order that they are entitled to at least part of the invention described and claimed in European patent application 85.301207.8, filed on 22nd February 1985 and published under the serial number 0,154,466 on 11th September 1985. The said application claims priority from GB patent application 84-04948 filed on 24th February 1984. Both the EP and GB applications are made in the name of The Rawlplug Company Limited (hereinafter 'Rawlplug'), and the sole inventor is named as Hugh Lafferty.

At a hearing before me on 28th April 1988 VS were represented by their counsel Mr G Hamer, instructed by Messrs Cruikshank & Fairweather, and Rawlplug by their patent agent Mr W M C Purvis of Messrs D Young & Co.

The invention concerns a bolt anchor of the type comprising a sleeve formed with longitudinal slots which weaken the sleeve so that it expands outwardly when a threaded nut is drawn into it from one end by means of a threaded bolt inserted at the other end, thereby causing the anchor to become securely wedged against the walls of a hole into

which it has been inserted, e.g. in brickwork, masonry or concrete.

The various features of the invention are conveniently set out in the claims of the application which are as follows:-

#### CLAIMS

1. A bolt anchor characterised in that it is formed by casting as a single component and comprises a tubular body portion (3,23) having a ring (2,22) at one end with a profiled circumference and longitudinally extending slots (9,10,29,30) in the wall of the tubular body portion (3,23), the longitudinally extending slots extending to or adjacent to the other end of the tubular body portion (3,23) such that a nut (5,25) or bolt head can readily be drawn into said other end of the tubular body portion (3,23) to expand it.
2. A bolt anchor according to claim 1, in which the nut is a tapered nut (5,25) incorporated in the anchor integral with the body portion (3,23) as a nut portion provided at said other end of the body portion (3,23) and coupled to the body portion (3,23) by a portion or portions (12,32) of relatively small cross sectional area such that a force applied to the nut (5,25) to draw it into the body portion (3,23) will fracture said portion or portions (12,32) of relatively small cross sectional area.
3. A bolt anchor according to claim 2, in which the tapered nut (5,25) has longitudinally extending ribs (12a,32a) thereon, which ribs (12a,32a) engage in the longitudinally extending slots in the body member (3,23) to prevent rotation of the nut (5,25).

4. A bolt anchor according to claim 3, in which the portion or portions (12,32) of relatively small cross sectional area are of greater cross sectional area when the nut (5,25) is cast but a screw tapping operation subsequently effected on the nut (5,25) reduces the section of said portion or portions (12,32).

5. A bolt anchor according to claim 1, in which the nut or bolt head is a separate member used in conjunction with the body portion (3,23).

6. A bolt anchor according to any one of claims 1 to 5, in which the ring (2,22) with a profiled circumference at said one end of the body portion (3,23) includes a plurality of projecting fins (7,27) which can engage wall portions of a hole in which the anchor is inserted.

7. A bolt anchor according to claim 6, in which the plurality of projecting fins (7,27) comprises a pair of diametrically oppositely projecting fins.

8. A bolt anchor according to any one of claims 1 to 7, in which the end ring at said one end of the body portion (3, 23) includes axially projecting portions which upon initial fixing project proud of a surface into a hole in which the anchor is inserted but, upon force being applied to the axially projecting portions, collapse so as to bring the item being secured by the anchor down to the surface level of said surface.

VS allege that the subject matter of Claims 1, 3, 5, 6 and 7 belongs to them, and that it was supplied by them to Rawlplug during technical collaboration between the two companies prior to filing of the GB priority application

84-04948. No such allegation is made in respect of Claims 2, 4 and 8.

The relevant Sections of the Patents Act 1977 under which the present application is brought 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 or under any treaty or international convention (whether or not that application has been made)-

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) .....

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."

"82.-(1) .....

(2) Section 12 above shall not confer jurisdiction on the comptroller to determine a question to which this section applies except in accordance with the following provisions of this section.

(3) This section applies to a question arising before the grant of a European patent whether a person has a right to be granted a European patent, or a share in any such patent, and in this section "employer-employee question" means any such question between an employer and an employee, or their successors in title, arising out of an application for a European patent for an invention made by the employee.

(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.

The relevant, comparable, Articles (60 and 61) of the European Patent Convention read as follows:

"Article 60

Right to a European patent

(1) The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee the right to the European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has his place of business to which the employee is attached."

(3) For the purposes of proceedings before the European Patent Office the applicant shall be deemed to be entitled to exercise the right to a European patent.

"Article 61

European patent applications by persons not having the right to a European patent

(1) If by a final decision it is adjudged that a person referred to in Article 60, paragraph 1, other than the applicant, is entitled to the grant of a European patent, that person may, within a period of three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition annexed to this Convention:

- (a) prosecute the application as his own application in place of the applicant,
- (b) file a new European patent application in respect of the same invention, or
- (c) request that the application be refused."

EPC Rule 15 regulates the procedure for filing a new application, and Rule 16 states that if by a final decision it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European application, Article 61 and Rule 15, apply mutatis mutandis to such part.

Before coming to a review of the evidence, I think it is necessary for me to make some preliminary comments concerning the nature of entitlement proceedings. In particular I draw attention to a decision dated

25th February 1987 in Viziball Ltd's application in which the hearing officer stated that for the purposes of such proceedings the term "invention" means that which was conceived by the applicant to be an invention at the time he filed his application whether patentable or not (my underlining). This was not dissented from by the Patents Court on appeal, and I concur with the hearing officer, having reached a similar conclusion in Northern Engineering Industries plc's Application (unreported). This is an important consideration in the present case, since considerable parts of the pleadings and the evidence, and indeed of the submissions made at the hearing itself, are directed to issues of patentability, namely the lack of novelty and inventive step in relation to various aspects of the invention in the light of prior art cited in these proceedings. In my view, it is not proper for me to consider such issues, since it is not relevant whether or not those parts of the described invention which either side claims, or those parts which are left behind when any such parts are taken out of the specification, can give rise to a valid patent. These are questions to be determined at the application stage by the competent departments of the European Patent Office. Similarly, any intention of Rawlplug's to amend their application, and questions concerning the allowability of such amendment, which are raised in the pleadings and evidence, are also improper for me to consider.

What I have to decide is to whom the invention which was the subject of the application at the time of filing belongs, and since from Article 60(3) of the European Patent Convention it is the applicant who is deemed to be entitled to exercise the right to the European Patent, it seems to me that in order to establish their right to an entitlement order VS must prove that there are features in the patent application which they invented and which Rawlplug obtained from them in confidence and had no right to make use of for

their own purposes.

At the hearing Mr Hamer for VS made an application for admission of additional evidence in the form of further declarations from Messrs Lafferty and Wipperfurth. Mr Purvis raised no objection, and I therefore agreed to admit the further evidence.

Turning now to consideration of the pleadings and evidence, the main thrust of VS's submissions is that the invention claimed in Claims 1, 3, 5, 6 and 7 corresponds to a product made by a subsidiary company of theirs. This product, referred to for convenience as the 'Busche' fixing, is shown in Exhibit B and comprises a bolt anchor in the form of a one-piece sleeve to be used with a separate expansion nut. VS's Exhibit C is a copy of notes dated 13th June 1983 concerning a joint meeting between Rawlplug and VS personnel to explore the possibility of a one-piece bolt anchor with an integral nut. These notes state that the original concept was based on the Busche fixing, and also state that "the high confidentiality of this project was understood by and would be respected by all present."

The evidence-in-chief for VS also includes an affidavit (Exhibit F) from their technical director, Mr Wipperfurth, who deposes that during technical collaboration between the two companies for the purpose of them jointly providing a one-piece bolt anchor having an integral nut, VS provided Rawlplug with details of the Busche fixing. He concedes, however, that Mr Lafferty is the sole inventor of the one-piece bolt anchor in which the nut is integrally connected to a one-piece expansion sleeve by frangible webs.

Mr Lafferty himself, although employed by Rawlplug at the time of this technical collaboration, has given evidence on behalf of VS, asserting that what he invented was limited to what is in Claim 2, i.e. a bolt anchor with an integral



nut. He says that he had no opportunity to review the European application prior to filing, and that only when it was published did he notice that Claim 1 was what VS had provided rather than what he had invented. He also stated in his second affidavit (Exhibit G) that he had no recollection whatsoever of amending or reviewing the prior British application. However, Rawlplug have provided evidence (Exhibits A, B and C attached to Mr Purvis's statutory declaration) to show that Mr Lafferty did review, amend and approve a draft specification of the priority application GB 84-04948, but it is not disputed that this draft did not have any claims.

This draft application (Exhibit A) relates to a single component formed by casting and comprising a tubular sleeve having longitudinally extending slots in the wall, a ring with a profiled circumference at one end and at the other end a further ring attached to the tubular sleeve by a web or webs which can be readily fractured by a tapered nut or bolt head drawn into the said other end. The description indicates that the tapered nut may be integral with the tubular sleeve or alternatively the tapered nut or bolt can be a separate member used in conjunction with the tubular sleeve. The further "response" filed by VS states that the description in this draft was "opened up" by Mr Lafferty for the purposes of production rather than to increase the breadth of any claim. While he was aware that the sleeve portion could be used in conjunction with a separate nut or bolt (this being well-known in the art), he never intended to claim such an arrangement as his invention, and all the drawings illustrate the one-piece fixing. In a further affidavit, Mr Lafferty confirms the matters set forth in the "response" and confirms that at no stage did he "review or discuss any claims other than the statement of invention on page 1 of Exhibit 'A'."

Mr Hamer contended that there has been no effective

challenge to the evidence of Mr Lafferty that he conceived his invention to be limited to the form with an integral nut, and similarly that the VS evidence of what took place at the meetings between personnel of the two companies is also unchallenged, since no Rawlplug employee who was present has given any evidence.

A further aspect of the dispute to which I must also refer concerns the provision in Claim 1 of the application of two alternatives regarding the longitudinal slots, namely that they extend either to or adjacent to the end of the tubular body portion. Rawlplug say that in the Busche fixing the slots extend all the way to the end, and this appears to me to be confirmed by the drawing of the Busche fixing, Exhibit B. VS, although not seeking to show otherwise, nevertheless state that this is immaterial, since the device will only work if the slots extend all the way or if they split at the time of insertion of the threaded nut. Mr Hamer put it to me that someone producing a device like the Busche fixing but with the slots stopping just short of the end would be held on purposive construction to be infringing, and that on this basis the whole of Claim 1 is based on what VS have provided.

However, I find myself unable to accept that in an entitlement proceeding I should concern myself with issues such as infringement on purposive construction. Entitlement is concerned with the factual matter of determining whether any aspects of the invention described and claimed have been obtained from someone other than the applicant. VS have not satisfied me that a device in which the slots extend only to a point short of the end of the tubular body portion originated with them and was obtained from them. The Busche fixing does not show it, and there is no other evidence that VS provided Rawlplug with such a feature.

I am, however, persuaded that the embodiment in which the

slots do extend all the way to the end corresponds to the Busche fixing in so far as it does not have an integral nut, and that on the evidence before me this aspect of the invention was obtained by Rawlplug from VS.

It follows, therefore, that VS are entitled to some part of the invention, and that accordingly I have to undertake what was conceded at the hearing to be the difficult task of dividing up the specification. In doing so I am not unmindful of the statement by Mr Justice Falconer in Norris's Patent [1988]RPC 159 that in entitlement proceedings all aspects of the invention need to be considered without regard to the precise formulation of the claims, but the present case has been argued on the basis of the claims and I am satisfied that the claims reflect the invention as a whole and may be regarded as the most convenient means by which to divide the invention as a whole into various constituent embodiments.

It should be understood that in making this determination, I do not make any finding as to whether any embodiment of the invention is novel or non-obvious having regard to the prior art drawn to my attention by both parties, or meets any other requirement of the EPC necessary for adjudging it to be a patentable invention.

Firstly, then, I deal with those embodiments of the invention in which the bolt anchor as manufactured has an expansion nut formed integrally therewith. VS have conceded that this was invented by Mr Lafferty, and these aspects of the invention clearly belong to Rawlplug, who accordingly have exclusive rights to the subject matter of Claims 2 and 4, and to Claim 1 in part as embracing Claims 2 and 4.

As regards the embodiment in which the nut is separate, i.e. Claim 5 and Claim 1 in part as embracing Claim 5, the position is more complex, and I propose to regard this as

embracing two sub-embodiments in one of which (A) the slots extend all the way to the end of the tubular body portion (as in the Busche fixing) and in the other of which (B) the slots extend only to a point adjacent to the end. As is clear from what I have already said earlier, I am persuaded that VS are entitled to (A) but not to (B). Although I accept Mr Lafferty's evidence that he did not invent (B), it is nevertheless in the application as filed, and having regard to the terms of Article 60(3) mentioned above it must be held to belong to the original applicant, namely Rawlplug.

VS have laid no claim to the subject matter of Claim 8, which leaves only Claims 3, 6 and 7 to be dealt with. These are all directed to subsidiary features which have not figured so prominently in the evidence as have those already dealt with. They are alleged to be shown in the Busche fixing of VS, but there is also evidence that they have been known for a long time, and all in all I am not persuaded that either VS or Rawlplug are entitled to exclusive rights to these features. I therefore decide that each of the main embodiments which I have identified, namely the whole of the integral nut embodiment, and each of the sub-embodiments involving the separate nut, may retain the subsidiary dependent features of each of Claims 3, 6 and 7.

I come now to decide the form of order by which to give effect to my findings. Since I do not consider that the correct result would be obtained by joining VS with Rawlplug as applicants in this case, I have come to the conclusion that the application should be divided. Accordingly, I hereby order that Rawlplug shall seek to amend the application so as to exclude those parts thereof corresponding to sub-embodiment (A) above, i.e. in which the nut is separate and in which the longitudinal slots extend all the way to the end of the tubular body portion at which the nut will enter the said portion. This of course,

does not preclude them from seeking more extensive amendment in the light of the prior art.

I am satisfied that VS have no right of entitlement to sub-embodiment (B) as outlined above, nor to any embodiment in which the tapered nut is formed integrally with the bolt anchor, and I therefore decline to make any order in respect of those aspects of the invention.

However, should this become a final decision on the matter, ie in the absence of an appeal, or if my decision is supported on appeal, the way would apparently then be open for VS to file a new European patent application pursuant to Article 61 and Rule 15 EPC in respect of the subject matter of Claim 1 insofar as it relates to the sub-embodiment in which the slots extend all the way to the end of the tubular body portion, together with relevant parts of Claims 3, 5, 6 and 7, but excluding the subject matter of Claims 2, 4 and 8. In saying this, I emphasise once again that I make no finding as to whether the subject matter of these claims constitutes a patentable invention having regard to the state of the art.

Both sides have asked for costs, but since neither party has been entirely vindicated I decline to make any order as to costs.

Dated this 24<sup>th</sup> day of August 1988

J SHARROCK

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

