BLO/153/90

PATENTS ACT 1977

IN THE MATTER OF an application
by The Secretary of State for Health
under Section 72 for revocation of
Patent No 2168106 in the name of
Weston Hydraulics Limited

DECISION

The application for revocation was filed by the Secretary of State for Health on 28 September 1989, the statement of case being filed on 9 October 1989. Revocation is sought under section 72(1) (a) and 72(1) (b). The proceedings have not followed the normal course of pleadings followed by evidence. At the same time as the application for revocation, the Secretary of State for Health also filed a reference to the comptroller under section 37 as to rights in the same patent. On the accompanying Form 2/77 it was alleged that

> "if the facts relating to prior art and obviousness outlined in the statement of facts accompanying this form and the co-filed form 38/77 [the revocation action] were to be ignored, rights in the granted patent would rightly belong to the Secretary of State for Health ...".

The same statement was filed in both actions. The patentees did not file a counterstatement in response in either action, but instead filed an offer under section 29 to surrender the patent. No evidence has been filed in any action, and the parties were informed in an official letter of 17 May 1990 that the Patent Office proposed to stay the proceedings under section 37 and 29 until the application for revocation had been dealt with. Subsequently, in an official letter of 24 August 1990 copied to the applicants

for revocation, the patentees were informed that the Office proposed to issue a decision revoking the patent, and that the offer to surrender would not be accepted unless this course of action was opposed within one month of the letter. No such opposition was registered, and the applicants for revocation have added nothing further to their statement. Neither party has requested a hearing.

It has been necessary to settle the revocation issue on the sole basis of the statement, taking any facts alleged therein as uncontested. It has not been possible for me to consider the ground for revocation under section 72(1) (b) (grant to person not entitled), since the reference under section 37 has not been determined.

Under section 72(1) (a) the statement alleges that the invention is not a patentable invention, being obvious to a person skilled in the art having regard to written descriptions forming part of the art at the time of the application. Twenty-one prior documents are referred to, all of them being stated to have been cited against corresponding foreign applications. It is alleged that "in view of these citations UK Patent 2168106 is clearly invalid". The statement goes on to suggest a way in which claim 1 might be limited in scope, but then, by reference to two of the cited documents, to "common engineering practice" and to a further incompletely defined prior publication, alleges absence of patentability. I would observe at this point that, although the ground appears to be constructed primarily in terms of obviousness, there is an implication of lack of novelty, and in addressing this ground I have proceeded on the basis that it encompasses both.

The statement then goes on to allege prior use. Although this is presented as pertinent to both subsections 72(1) (a) and 72(1) (b), I have, for the reason given above, been able to consider it only in relation to the former.
As I have stated, the Office has already indicated in the

official letter of 24 August that it proposes to revoke the patent. The main purpose of this decision is therefore to confirm that revocation, which I regard as warranted under section 72(1) (a). Since neither party has expressed any opposition to that indication, I do not consider it necessary to discuss my reasons for coming to that conclusion as fully as would have been necessary had there been dispute in the matter. I do, however, consider it desirable to set out my reasons briefly.

Claim 1 of the patent in suit reads as follows:

> "A joint for an orthotic device, said joint comprising a first member formed integrally with or capable of connection to one part of the device, and a second member formed integrally with or capable of connection to a second part of said device, said first and second member being mounted for limited pivotal movement relative to each other in both pivotal directions from a predetermined relatively angular position of said first and second members and wherein adjustment means are provided for adjusting the amount of said limited pivotal movement and wherein release means are provided, operation of which permits of relative angular movement of said first and second members beyond the limited angular positions".

In the described embodiment, one of the joint members carries a pair of adjustably mounted screw threaded members which are securable in their adjusted positions by locking screws. The ends of the screw threaded members define first abutment surfaces. The other joint member carries a slidable member provided with second abutment surfaces engagable with the first abutment surfaces to define the limit of relative pivotal movement of the joint members in either direction. The slidable member can be slid so as to move one of the second abutment surfaces out of contact with the corresponding first abutment surface thereby allowing increased relative

pivotal movement of the joint members.

I conclude that the wording of the claim, taken with the whole of the specification, teaches the existence of separate "adjustment" and "release" functions. Thus the terms of the claim are not met by arrangements where the limit of angular movement imposed by a particular setting of an adjustment means is overriden by merely resetting of the adjustment means to increase the angular movement.

Of the cited documents, I find French specification FR1422891 to be the most relevant. It discloses an orthopaedic device for fitting to the lower limbs to aid walking. The device includes a hip joint , a knee joint and an ankle joint. The hip joint has a free articulation condition and means to lock the joint in a condition of limited articulation, the extent of which is adjustable.

The joint includes a locking plate and a disc, peripheral notches in which overlap to form a control notch. The length of the control notch can be adjusted by rotation of the knurled disc relative to the plate. A stop stud formed on the lower member of the joint moves in the control notch during angular movement of the joint. A locking bolt is carried by the upper member of the joint and is normally held in a retracted position against the action of a spring. In use, with the locking bolt in the retracted position and the disc and plate free to rotate together, the joint is freely articulated. To restrict the articulation of the joint to the limits imposed by the control slot, the locking bolt is released to engage in a slit in the locking plate. This locks the plate and the disc against rotation. This effectively provides a fixed control slot which allows only restricted movement of the stop stud and thus restricted angular movement of the lower member.

In my opinion, this arrangement anticipates claim 1 of the

patent in suit in that, with the locking bolt operative, the joint has an angular movement, the extent of which is "adjustable" by adjustment of the length of the control notch. To "release" the joint for articulation beyond the limits of the control notch, the bolt is withdrawn from the slit. Thus there are distinct "adjustment" and "release" functions as required by claim 1. As a consequence I find that the invention claimed in the claim lacks novelty in the light of the disclosure of the French Patent specification 1422891.

In case I am wrong in this finding, I will briefly consider also the allegation of lack of inventive step. Of the rest of the specifications referred to by the applicant for revocation, I consider the most material to sustaining an obviousness objection to be WO 8403433, US 4463751, EP 0059472, US 2573866 and US 4370977. The first three all disclose orthotic joints in which the degree of pivotal movement is adjustable but in which there is no means with a specific release function. The last two disclose orthotic joints in which the degree of pivotal movement is fixed but in which means are provided to release the pivoted members to allow pivotal movement beyond the fixed range.

If it were to be established that a man skilled in the field of orthotics would have regarded it as obvious to combine these two features then, I consider, it would equally be established that claim 1 of the patent in suit lacked an inventive step. However, this is in general a question of fact to be established by evidence, which, as I have indicated, is lacking in this case. I find, in the absence of such evidence or even of clearly stated assertion in the applicants' statement of case, that the allegation of lack of inventive step in relation to the cited specifications is not established on the balance of probabilities.

In support of his contention that the invention is obvious, the applicant for revocation also refers to two articles in the journal "Prosthetics and Orthotics International". It is

stated that the articles, one published in 1979, and one published in 1981, illustrate a first version of the invention in which the construction of a toggle override device is clearly visible. The photographs in the articles do seem to show some kind of releasable stop device but neither text specifically refers to the operation of the device. I find these articles of no assistance to me in relation to the allegation of obviousness.

As to the allegation of prior use, I do not regard the facts set out in the statement of case sufficient to establish that the invention was prior used. I would have required clearer indication of exactly what devices were fitted to patients, and when, before I could be satisfied that orthotic devices embodying the invention were in public use at the pertinent time.

In summary, then, I find that the invention the subject of the patent in suit lacks novelty, and I hereby order that the patent be revoked.

In their statement the applicants for revocation requested an award of costs. However, having particular regard to the fact that the matter has been determined without a hearing, and that the proprietors of the patent have not entered the proceedings except to offer surrender, I do not regard any order for costs as appropriate.

Dated this 27th day of December 1990

DR P FERDINANDO
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE