

BLO/067/86

PATENTS ACT 1977

IN THE MATTER OF an application  
by Rocol Limited for the revocation  
of Patent No 2,030,197B in the name  
of Moseley Rubber Company Limited

DECISION

Revocation of the patent under Section 72 of the Patents Act 1977 is sought on the grounds of (i) lack of inventive step having regard to US Patent Specification 1,914,830 and to general practice in the field of warning, speed restriction and other devices for use on road surfaces as exemplified by the following patent specifications: US 3,720,181, GB 546,580, GB 689,791, US 3,357,370, GB 520,155 and GB 767,574; (ii) that the specification does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art; and (iii) that the matter disclosed in the specification extends beyond that disclosed in the application for the patent as filed.

At the hearing on 21st November 1985, Mr G S Bedggood of Messrs Haseltine Lake & Co appeared as Agent for the patentees, and Mr W R Farwell of Messrs Phillips and Leigh appeared as Agent for the applicants for revocation, for convenience hereinafter referred to as the opponents.

In September 1985, shortly before the Hearing, the opponents requested leave to amend their statement in relation to ground (i) by adding to the end of the list of documents, exemplifying general practice in the field of warning, speed restriction and other devices, a reference to a further document, namely a leaflet entitled "Speedbumps slow down your traffic", which was already in the proceedings as Exhibit III attached to the evidence-in-chief of the opponents, filed in December 1984. The patentees declined to give consent to amendment of the statement, and the matter fell

to be decided at the Hearing as a preliminary matter.

Mr Bedggood accepted that the patentees had taken up the reference to this leaflet and had replied to it in their evidence, and he conceded that they had not been taken by surprise, but explained that their objection to its introduction was that it represented a change in the line of attack, since all of the other documents relied upon by the opponents are directed to hose ramps and markers, whereas the leaflet in question relates to speed bumps. Moreover, there was no proof of publication of the leaflet other than an internal reference indicating that "Speed Bumps" were launched in 1970.

Mr Farwell submitted that the opponents were merely seeking to tidy up their statement, the leaflet having been referred to in the evidence as showing what a man in the field had available to him.

I indicated at the Hearing that I would allow the leaflet into the proceedings, and that I would give my reasons in my decision. They are (a) that the patentees were not taken by surprise, since although the formal request to amend the statement was made at a late stage, the leaflet was already in the proceedings and dealt with in the evidence on both sides, (b) that proceedings would not be delayed since both Mr Bedggood and Mr Farwell indicated to me that they would not wish to file evidence nor did they further seek an adjournment, and (c) the relevance of the document, since much of the argument on the lack of inventive step issue centred around fastening of devices to a road surface, which the "Speedbumps" leaflet shows. I do not accept Mr Bedggood's submission that the line of attack is thereby changed in any significant way, since the opponent's statement referred to general practice in the field as exemplified by several listed documents, and the stated field is wide enough as set out to embrace this further document.

Accordingly I hold that the opponent's statement at paragraph 2(a) should be deemed to be amended by addition to the end of the paragraph of a reference to the Speedbumps leaflet in the form set out in their agents letter dated 13 September 1985, and that the patentee's counterstatement be deemed to deny the relevance of said leaflet. If either party wishes to formalise the situation by filing amended statements the amendments be<sup>ing</sup> strictly limited to those that I have indicated, they may do so within two months of the date of this decision, but for the purposes of this decision I regard both of their statements as notionally so amended.

Coming now to the substantive issues, the opposed patent relates to devices to be placed on a road to restrict the speed of vehicles, commonly known as "speed bumps" or "sleeping policemen". The specification states that known devices of this type take the form of shallow humps made of concrete, tarmac or asphalt, and are permanent fixtures on a road. The patent is directed to such devices formed from a plurality of individual portable sections designed to be assembled side by side, as illustrated for example in Figure 3 of the drawings attached to the specification.

Claim 1 of the patent reads as follows:

"A portable speed restriction device adapted to be secured on a road surface, the device comprising a plurality of individually portable, rigid or semi-rigid members, each of generally segment-shaped cross-section with a flat base and an upper surface which is shaped to present a hump, the members being adapted to be assembled side by side to form an elongate hump of continuous uniform section across the path of road-vehicles, and each member being provided with fastening holes formed in the body of each member for removably securing it to a road surface whereby in use the device does not become dislodged."

The opponents case on lack of inventive step rests primarily on US Specification 1,914,830 in the name of Kostohris, which discloses

a portable hose jumper, that is to say a device for protecting a fire hose from damage caused by wheeled vehicles passing over it. It comprises a moulded body having a flat base and two wedge-shaped portions either side of a central trough in which the hose rests. Several units may be joined together end to end, for example by dovetail lugs, and the base may include suction pads or vacuum cups to prevent the device from shifting in use.

There is no suggestion in Kostohris that the device is used to restrict the speed of vehicles, but the substance of the opponents case is that it will inevitably do so. They say that although the device is intended as a hose jumper it will as a matter of fact act as a speed restriction device because a driver approaching it will slow down before passing over it. The opponents say that all the features of the patentee's Claim 1 are disclosed in Kostohris except for the fastening holes, but that the latter are a routine expedient as demonstrated by the disclosures in US 3,720,181 (Elkins), which shows a portable warning device consisting of an inflatable bag which may be tied down by straps, GB 546,580 (Nicholson) and GB 689,791 (Potts) which relate to devices for making traffic lanes and refer to the use of screws, bolts or nails as fastening means, and the Speedbumps leaflet Exhibit III which shows speed bumps fastened down by rawlbolts.

The patentees on the other hand, if I understand their position correctly, while not denying certain similarities between their device and that of Kostohris, say that the Kostohris device is not a speed restrictor, that there has never been any suggestion that it should be used as one, and that it could not in fact act as one because it would become dislodged. Mr Bedggood conceded that if one wanted to fix the Kostohris device down onto the road then it was easy to say that one could put bolt holes through it, but maintained that to do so would presuppose that one was using it as a speed restrictor. He submitted that the opponents have failed to show that the hose ramps of the prior art would have been thought of for use as speed restrictors before the date of the invention.

Having heard the arguments on both sides, there is no doubt in my mind that a key issue in the inventive step consideration is the use to which the devices of the cited prior art have been put. It is clear to me from the specification of the patent-in-suit that the problem with which the inventor was faced was to provide a portable alternative to the known devices which were permanent fixtures on the road surface. He solved the problem by providing a plurality of individual segments which could be assembled together side by side to produce an elongate hump of continuous cross-section. At the time the patent was first applied for the need to bolt the segments to the road was seen as optional, but Mr Bedggood told me that in practice it had been found technically necessary to bolt them down, which is why the granted patent includes fastening holes as an essential feature of the device.

Was there anything available to the inventor which made this answer to his problem an obvious one? The opponents say that Kostohris does so because it shows portable segments joined together, and it is obvious to bolt them down. The patentees say that an inventor working on speed restrictors would not have gone to the art of fire hose jumpers, and would have not therefore considered Kostohris.

Turning to the evidence, Mr Leitch for the opponents says that an existing device does not become anything different by calling it a speed restriction device and fixing it down. Mr Leitch is the Product Development Manager of the Site Safety Division of the opponent Company, and in his evidence he outlined the steps which led to the development by his Company of a portable speed bump known as the "Pacer", which was introduced subsequent to the date of the patent-in-suit, but which like that of the patentees is in portable segments which are fastened down. In this development the starting point was a Transport and Road Research Laboratory Report on speed bumps, which was attached to Mr Leitch's declaration as Exhibit II, whereas Kostohris and the other early patent specifications under consideration in these proceedings played no part. This seems to me to support the contention of the

patentees concerning the prior art to which the inventor would go, rather than that of the opponents. However, Mr Leitch also says that by looking back at the Kostohris and other specifications he can see that his Company's thinking was not new, and that similar considerations apply to the patentee's device. Mr Thawley, giving evidence for the patentees, says that Mr Leitch is being wise after the event, and that in spite of what Mr Leitch says no one else prior to the date of the patentees invention did think of bolting down earlier hose ramps for use as speed restrictors. At the Hearing, Mr Bedggood put it to me that the evidence of Mr Leitch is not an objective assessment because he was already fully aware of all the features of the patentees invention. Taking the evidence before me as a whole, I consider that the opponents have failed to establish that the art to which the inventor of speed bumps would go includes Kostohris.

Mr Farwell sought to persuade me that the search made, and documents cited, by the search examiner during pre-grant proceedings in the Office shows that the art under consideration is not solely that of speed restricting devices. His point being that the examiner in carrying out his search found and cited at least two hose jumpers as being relevant under Section 2 and/or Section 3. However, I do not accept that the position in which the examiner found himself furthers the opponents case, for two reasons. Firstly, the examiner is concerned with both novelty and obviousness; secondly, he is of necessity searching with hindsight because he has the completed invention before him. That the search examiner went to the art of hose jumpers as well as to speed bumps is no reason in my view for assuming that the inventor working in the field of speed bumps would have done so at the relevant time. In particular once the examiner sees the form of the individual portable members of the invention and is told that they can also be modified to act as hose jumpers (cf p.2 lines 114-116) he may well look at hose jumpers so far as his novelty search is concerned but as I have said he is doing this with hindsight knowing what the invention is and is looking for something identical with the invention claimed by the patentees.

A further point urged upon me by Mr Farwell is that the patentees specification states that the speed bumps of the invention can be optionally adapted for use as hose jumpers, showing that the two are equivalent, but I accept Mr Bedggood's argument that the adaptation of the patentees device for use as a hose jumper does not inevitably mean that one can use a hose jumper as a speed restrictor.

Nothing has been placed before me, therefore, which leads me to hold that the inventor would or should have gone to fire hose jumpers in order to solve the problem with which he was faced. It follows that I am not persuaded that the patentees Claim 1 is obvious in the light of Kostohris or any of the other patent specifications brought to my attention.

I ought, however, to say something about the "Speedbumps slow down your traffic" leaflet which I have allowed into these proceedings, which unlike the other cited art is directly concerned with speed restrictors. Some question arose as to the publication date of this leaflet, but Mr Bedggood did not seek to deny Mr Farwell's assertion that, coupled with the evidence of Mr Leitch (second statutory declaration paragraph 5), the leaflet shows that devices of the type illustrated therein were available to the public prior to 1978. I accept this to be so, and hold that the leaflet comprises matter which I can properly consider.

The speed restrictor shown in this leaflet comprises a series of raised discs secured to the road, but they do not form a continuous hump, and as shown on the leaflet appear to have sharp edges. It was put to me by Mr Bedggood that these discs are vicious and thus act as a deterrent rather than as something which slows one down by an uncomfortable bump, and Mr Farwell did not seek to persuade me otherwise, relying on the Speedbumps leaflet primarily for the purpose of showing that it is known to bolt speed restriction devices to the road. I take the view that the devices shown in the Speedbumps leaflet are of different construction from, and act in a different way to, those of the

patent-in-suit, and do not render Claim 1 lacking in inventive step.

In short, I find that the opponents attack on Claim 1 on the ground of lack of inventive step fails, and in these circumstances I do not feel it to be necessary to comment on the subsidiary claims.

The second ground on which revocation is sought, that of insufficiency, does not appear to amount to anything more than a contention that the term "generally segment-shaped" in Claim 1 is unclear. It was not pursued at the Hearing, and having considered all the papers I am satisfied that there is no substance in this contention.

The third ground, that of what is customarily called added matter, comprises a lengthy list of allegations as set out on pages 8 to 11 of the opponent's statement. Four specific allegations were pursued at the Hearing.

Firstly it was alleged that Claim 29 extends the disclosure by implication. The claim reads as follows:-

"A device according to any preceding claim, wherein the upper surface of each member is substantially in an unbroken curve, comprising no flattened centre portion".

Mr Farwell put it to me that a claim in these terms inevitably implies that the earlier claims cover devices where the upper surface does have a broken curve and a flattened centre portion, and that since the original specification does not disclose these features the patentees have introduced something new. Mr Bedggood offered at the Hearing to delete the last five words of the claim if this was to be a contentious point, although doubt was expressed as to whether the right of amendment provided by Section 75(1) extended to removal of added matter. I do not need to comment on this latter point or to pursue the question of



amendment of the patent, however, since I am not of the view that the wording of Claim 29 has added new matter. I consider that the claim is merely setting out in clear terms the specific embodiment shown in the drawings, and does not import into the specification a specific alternative embodiment. Even if there is an implication that the specific embodiment thus claimed is not the only possible embodiment, I hold that this was also true of the original specification, and I accordingly reject the allegation that Claim 29 extends the disclosure.

Secondly it was alleged that the term "generally segment-shaped cross-section" in Claim 1 of the patent is different from the original language which referred to a "generally flat base and an upper surface which is curved to present a hump". Mr Farwell raised but did not press the point, and in reply Mr Bedggood put it to me that the applicant is not stuck with the same-words-he originally used, and that the term objected to is well based on the original disclosure. I agree with him, and do not consider that the amendment extends the disclosure beyond that contained in the application as filed.

Thirdly it was alleged that the term "rigid or semi-rigid" in Claim 1 was not present originally, and Mr Farwell suggested that it was an unfounded broadening from the original disclosure. I am unable to agree, since I do not consider that the said term does anything more than make explicit what was already implicit from amongst other things the references to the devices being made of durable rubber, plastic and concrete (cf p.1 lines 113-130 of the original specification), and therefore does not extend the disclosure.

Fourthly it was alleged that the use at page 2 lines 5-6 of the patent of the word "frame" compared with the original use of the word "member" introduced subject matter. During the submissions on this point, however, it came to my notice that this particular allegation was not referred to in the pleadings, and I therefore decline to consider it.

I have considered all the other allegations of new matter as set out in the statement, and am satisfied that none of them are well founded.

Accordingly I find that the application for revocation fails on all of the grounds pleaded. I award the patentees the sum of £500 (five hundred pounds) as a contribution to their costs incurred in these proceedings, and direct that this sum be paid to them by the applicants for revocation.

Dated this 9<sup>th</sup> day of January 1986 .

M F VIVIAN

Superintending Examiner, acting for the Comptroller.



PATENT OFFICE