

0/95/97

PATENTS ACT 1977

Mr P Hayward
3Y46

IN THE MATTER OF

an application under Section 71
by Barclays Property Holdings Limited
for a declaration of non-infringement
of Patent No GB2217361
in the name of Gareth Woodham

Denchev 30-5-97

Declaration of non-infringement

DECISION

Introduction

1. Patent no GB2217361 ("the patent") in the name of Gareth Woodham is concerned with dispensing and/or depositing modules for use, for example, as drive-in banks. Barclays Property Holdings Limited have designed and built in the United Kingdom automated teller machine enclosures ("ATM enclosures") and have applied to the comptroller under section 71 of the Patents Act 1977 for a declaration of non-infringement of the patent. They initiated the proceedings in the prescribed manner by filing Form 2/77 accompanied by a statement (and annexes), but the proprietor, Mr Woodham, failed to file a counter-statement and the application is therefore uncontested. I have therefore to decide upon the papers whether or not the applicants should be granted the declaration they seek.

2. Section 71(1) reads as follows:

". . . a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown -

(a) that that person has applied in writing to the proprietor for a written

- acknowledgement to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and
- (b) that the proprietor has refused or failed to give any such acknowledgement."

I need first therefore to consider whether the requirements of section 71(a) and (b) have been met.

The Act in Question

3. The applicants' statement and its annexes set out a chronology of events leading up to the application to the comptroller under section 71, and also describe the act in question for which the declaration is sought. The main points may be summarised as follows. In or about early March 1996, the proprietor of the patent, Mr Woodham, contacted the applicants to notify them of the existence of the patent. On 1 April 1996, the applicants met the proprietor, when the scope of the patent's claims was discussed and the structure of the applicants' ATM enclosures was described orally and with reference to blueprint building plans. On 10 April 1996, the applicants sent the proprietor a letter, according to the statement constituting an application in writing to the proprietor for written acknowledgement as specified in section 71(1)(a) and fully describing the structure of the applicants' ATM enclosures. The letter was accompanied by a drawing No AD51B.SO3, said in the statement to be a copy of a blueprint of building plans for a representative ATM enclosure "Type B". A copy of the letter of 10 April and of the accompanying blueprint or drawing (which I shall call "the drawing") were attached to the statement as annex 1.

4. The details of the applicants' ATM enclosures, as set out in their letter of 10 April, are as follows:

"Our clients are building in the United Kingdom ATM enclosures using traditional building techniques. The ATM enclosures are timber framed and have brick walls. They are built on-site, over traditional foundations. A general structural configuration of a typical ATM enclosure is illustrated in the enclosed drawing No AD51B.SO3.

You will see from the enclosed building plans that our clients' ATM enclosure has:

- (i) internal walls of a timber framed construction overlaid externally with plywood sheeting and internally with gypsum building board;
- (ii) external walls of brickwork; and
- (iii) a roof having a canopy construction incorporating a timber frame, with the roof being joined to the wall using steel header angles.

The superstructure of our clients' ATM enclosure is constructed using traditional timber frame and brickwork building techniques

It is to be understood that our clients' ATM enclosure may vary in size, shape and appearance whilst retaining the common timber frame/brickwork building techniques referred to above.

Moreover, our clients' ATM enclosure is intended to be built in the vicinity of a supermarket and is not intended to be a "drive-in" unit as required by your client's patent. This is not actually illustrated in the enclosed drawing but we can advise that the front elevation of the ATM enclosure is provided with a pavement upon which pedestrians can stand when accessing the ATM units, the pavement optionally being protected from vehicular access by bollards."

5. I have inspected the drawing and confirm that the structure illustrated there incorporates *inter alia* the features identified at (i), (ii) and (iii) above. I should mention at this point that, as reported in an official letter of 19 November 1996, for reasons of security (of ATM enclosures of the type it shows), the drawing has been made the subject of a direction under rule 94 of the Patents Rules 1995 that it be treated as confidential and is not therefore open to public inspection.

6. The penultimate paragraph of the letter of 10 April reads:

"On behalf of our clients we hereby apply in writing to Mr Woodham for a written acknowledgement to the effect that the making of, disposal of, offer to dispose of or using

of our clients' ATM enclosure, of the typical configuration shown in the attached building plans and described hereinabove, does not or would not constitute an infringement of UK Patent No 2217361."

The applicants' statement makes clear that the declaration sought from the comptroller is for the acts specified in this paragraph.

7. The proprietor responded in a letter dated 17 April 1996 to be found at annex 2 to the statement. This letter is no more than a holding reply. The applicants pressed their request in a letter to the proprietor dated 19 April 1996 (annex 3), and received a further holding reply in a letter of the same date (annex 4). There is no evidence of a substantive response from the proprietor.

8. I have carefully considered the applicants' account of the train of events, which has not been disputed by the proprietor. I am satisfied that the applicants have applied in writing to the proprietor, furnished him with full particulars in writing of the act in question, and that the proprietor has failed to give the required acknowledgement. In short, I am satisfied that the formal requirements of section 71(a) and 71(b) are met.

9. Although I have not been referred to any authorities, it is well established in those relating to applications for declarations of non-infringement both that the onus for establishing non-infringement rests upon the applicants and that the description of the article or process in respect of which the declaration is sought must be clear and precise. It is with these rigorous requirements in mind that I must consider the description of the act in question submitted by the applicants which I have quoted above.

10. In regard to the latter requirement, I should say that the description provided seems to me clear, and, subject to one small proviso, precise. The proviso arises from generalising wording used in the statement and in the letter of 10 April 1996. For example, the statement refers to the drawing as showing a "representative" ATM enclosure "Type B". Also, the letter of 10 April refers at the top of page 2 to the drawing as illustrating "a general structural configuration of a

typical ATM enclosure", and, in the penultimate paragraph, again uses the word "typical" to qualify the configuration of the applicants' ATM enclosure shown in the attached building plans. This wording suggests to me that the configuration shown in the drawing is schematic and may be modified in some immaterial way without falling outside the scope of the ATM enclosure described. Since the proper approach to the construction of patent documents is well established as being a purposive one, I do not believe the presence of this wording in context introduces any uncertainty as to the essential configuration of the applicants' ATM enclosures. Equally though, applying a purposive construction to the definition in the penultimate paragraph of the letter of 10 April of the act in question for which the declaration is sought, makes the word "typical" there unnecessary. In considering the scope of the requested declaration, I shall therefore regard the word "typical" as having no particular effect beyond emphasising the need to adopt a purposive construction.

The Patent

11. Turning now to the patent, it has one independent claim, claim 1, and nine further claims, all of which are appendant to claim 1. Claim 1 reads as follows:

"1. A modular dispensing and/or depositing unit, which comprises a prefabricated structure comprising a floor of reinforced concrete and, secured to said floor, a unitary body of reinforced concrete comprising a roof and side walls integral with said roof, said structure being free standing and self-supporting on said floor; and a substantially unimpeded approach to said structure such that [sic] an automobile can be parked alongside at least one said wall, said structure including an enclosed secure repository and means for obtaining access to said repository through said at least one wall, such that a driver seated in the driver's seat of an automobile parked alongside at least one said wall can either deposit articles into said repository via said means for obtaining access, or conduct a secure transaction such that a selected article or articles stored in said repository can be dispensed to said driver."

12. As I have said, although I have not been referred to any authorities, it is well established

that I must adopt a purposive construction of this claim. On doing so, it seems clear that the claimed unit is essentially a modular, prefabricated structure of reinforced concrete with walls and roof formed as a unitary body freestanding on a floor. That the modular and prefabricated nature of the claimed structure lies at the core of the invention is clear from the first paragraph on page 2 of the patent specification which reads:

"A modular dispensing unit has now been devised which can be transported to a wide range of locations, so that banking services can be provided at a semi-permanent or temporary location. A modification of such a unit has also been devised which can be used for depositing goods, such as packages, into a secure receiving location."

Non-infringement

13. By contrast with that construction of claim 1 of the patent, the ATM enclosure described in the letter of 10 April 1996 and illustrated in the drawing, far from being prefabricated, is built on-site using traditional building techniques with, among other things, internal walls of timber framed construction, external walls of brickwork and a roof of timber framed construction joined to the walls using steel header angles. In view of this fundamental difference from the claimed structure, and in the absence of any contrary argument, I conclude that an ATM enclosure as described in annex 1 to the statement would not infringe claim 1.

14. I note also that whereas claim 1 requires a substantially unimpeded approach to said structure such that an automobile can be parked alongside, the ATM enclosure as described in the letter of 10 April is intended to be built in the vicinity of a supermarket and is not intended to be a "drive-in" unit, and its front elevation is provided with a pavement upon which pedestrians can stand when accessing the ATM units. Thus on this ground too, I conclude that an ATM enclosure of annex 1 to the statement would not infringe claim 1.

15. Having found that the only independent claim of the patent would not be infringed, I do not need to consider the other claims.

Declaration

16. I find therefore that the applicants have discharged the onus on them and are entitled to the requested declaration. Accordingly, I declare that the making of, disposal of, offer to dispose of or using of the ATM enclosure of the configuration shown in the building plans and described in the applicants' letter dated 10 April 1996 attached to the statement does not or would not constitute an infringement of UK Patent No 2217361.

Costs

17. Neither side has asked for an order for costs, and I therefore make none.

Appeal

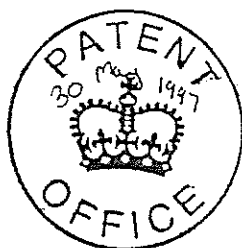
18. Since this is a decision other than on a matter of procedure, any appeal from this decision shall be filed within six weeks after the date of this decision.

Dated this 30th day of May 1997



S N DENNEHEY

Superintending Examiner, acting for the comptroller



THE PATENT OFFICE