

0/4/97

## PATENTS ACT 1977

IN THE MATTER OF an application under  
Section 72(1)(a) by Mr M V Seaman for the  
revocation of Patent No 2261586 in the name  
of Mr J S Crotty.

### INTERIM DECISION

Revocation of patent number 2261586 is sought by Mr Seaman on the ground that the invention is not a patentable invention because it is not novel and does not involve an inventive step. In particular, claims 1 and 2 are alleged to lack novelty having regard to:

- i) two alleged instances of prior use,
- ii) a US patent specification, US 2708418, and
- iii) a GB patent specification, GB 2254769A.

Claims 6 and 7 are alleged to lack novelty having regard to i) and ii) above.

Claims 1 to 7 are alleged to lack inventive step on the basis of ii) above and common knowledge among those skilled in the art.

Mr Crotty disputed all the allegations and a hearing was arranged for the 21 January. However, at the last minute Mr Crotty was ill and was unable to attend. The hearing was then rearranged and the matter came before me on the 5 February 1997 when Mr Seaman was represented by Mr Iain Whitaker of William Jones and Mr Crotty appeared on his own behalf.

The patent relates to bedding material for animals and the subject matter will be apparent from the claims which read as follows :

1. A bedding of litter materials for animals, comprising short strips of cardboard only cut from waste sheets of cardboard such that the strips predominately have widths in the range of 3.175 mm to 19.05 mm ( $\frac{1}{8}$  inch to  $\frac{3}{4}$  inch) and lengths predominantly in the range 3.175 mm to 76.2 mm ( $\frac{1}{8}$  inch to 3 inches).
2. A material as claimed in claim 1, wherein the strips of cardboard have widths predominantly in the range of 3.175 mm to 12.7 mm ( $\frac{1}{8}$  inch to  $\frac{1}{2}$  inch).
3. Apparatus adapted and configured to manufacture bedding or litter material for animals as claimed in any of the preceding claims, comprising: a first conveyor arranged to feed cardboard to a first shredder from which shredded cardboard is delivered in a first direction; a second conveyor arranged to receive the shredded cardboard from the first shredder and convey the shredded cardboard in a second direction, transverse to the first, to a second shredder and a third conveyor arranged to receive the shredded cardboard from the second shredder and convey the shredded cardboard in a third direction, transverse to the second, to a third shredder, each shredder to have a plurality of cutters spaced across the path of the material to be shredded, the cutters being spaced from 3.175 mm to 19.05 mm ( $\frac{1}{8}$  inch to  $\frac{3}{4}$  inch) apart.
4. Apparatus as claimed in claim 3, wherein the cutters are spaced approximately 12.7 mm ( $\frac{1}{2}$  inch) apart.
5. Materials as claimed in any of claims 1 and 2, after being used for animal bedding or litter and then composted.
6. A process of rearing animals, *eg* for meat, dairy or egg production, including keeping the animals for at least part of their lives in a building, a pen or nest box, the floor of which is covered with a bedding or litter material as claimed in either of claims 1 and 2.
7. A building, pen or nest box for rearing animals, *eg* for meat, dairy or egg

production, wherein the floor or part thereof is covered with bedding or litter material as claimed in either of claims 1 and 2."

At the outset I am bound to say that I was not greatly helped by either party at the hearing because the majority of the, relatively sparse, sworn evidence which had been filed proved to be largely, or indeed wholly, irrelevant to the matters in suit while on the other hand, some of the argument which both parties sought to raise at the hearing relied on facts on which absolutely no evidence had been filed. This being so, on a number of occasions during the hearing I asked Mr Whitaker and Mr Crotty whether they wished to seek leave to file further evidence to support their arguments on the basis that if I were to grant leave, it would be necessary to adjourn the hearing to allow the filing of the evidence and to give the other side an opportunity to consider the new evidence and to file evidence in reply if they so wished. In the event both sides decided that to avoid taking any further time over the matter they would stand on the evidence they had filed. Thus, given that no evidence had been filed in support of one of the two alleged prior uses of the invention, Mr Whitaker did not pursue that allegation. During the hearing Mr Whitaker also withdrew the allegation that claims 3 and 4 lacked inventive step while Mr Crotty accepted that claim 5 stood or fell with claims 1 and 2.

Turning now to claims 1 and 2, I shall begin with the instance of alleged prior use which is referred to in a Statutory Declaration from Mr E S G Pearce. This states that some years prior to the date on which Mr Crotty applied for the patent Mr Pearce carried out public trials of bedding material formed from cardboard sheet cut into strips of sizes which fell within the size ranges specified in claims 1 and 2. Mr Crotty argued that he had spoken to Mr Pearce who had made it clear that the material he had used was not as described in the Statutory Declaration. He had used what Mr Crotty called "corrugated sheet" - ie a single corrugated layer - as distinct from "corrugated board" - ie a corrugated sheet sandwiched between two flat sheets of cardboard. However, as I pointed out to Mr Crotty, he had filed no evidence in support of this allegation, nor had he asked to cross-examine Mr Pearce with a view to establishing the facts. I cannot therefore accept the allegation and must take Mr Pearce's declaration at face value. Mr Crotty also argued that his own product was based on the use of corrugated cardboard with some

solid board, which was not what Mr Pearce used. However, the present claims are not limited to this because they refer simply to the use of "cardboard", and it became apparent that Mr Crotty had only put forward this argument because he had not fully appreciated that the issue was whether Mr Pearce had publicly used material which fell within the scope of any of the claims of the patent. Mr Crotty also sought to argue that the words used by Mr Pearce in his declaration were not his own but were drafted by William Jones, Mr Seaman's agents, and sent to Mr Pearce for signature. Be that as it may, and although the material from Mr Pearce originally appeared in these proceedings in the form of a signed letter exhibited to a Statutory Declaration by Ms P L Rush, Mr Pearce's declaration was subsequently executed properly and though uncorroborated, was not challenged by evidence or through cross-examination. In those circumstances, again I must accept it at face value. Finally, after discussion at the hearing of the significance and meaning of the term "waste" in "waste sheets of cardboard" in Mr Crotty's claim 1, Mr Crotty accepted that Mr Pearce would inevitably have used material which could properly be described as "waste". It therefore seems to me that Mr Pearce's declaration does describe a public prior use of the invention claimed in claim 1 and 2 of Mr Crotty's patent and therefore that these claims were not new at the date on which the patent was applied for.

I turn now to the other attacks on claims 1 and 2. US 2708418 describes bedding material formed from waste paper which is repulped, made into pulp-board sheets, and cut into strips of various sizes falling within the ranges specified in claims 1 and 2 of Mr Crotty's patent. The only question in my mind is whether this constitutes, in the terms of claim 1 of Mr Crotty's patent, cardboard cut from "waste" sheets of cardboard and in my view it does not. The American specification describes what is in effect a process of manufacturing cardboard sheet which is then cut to form bedding. Thus, while the cardboard is made from waste paper, the cardboard itself is made expressly for the purpose of making bedding which therefore cannot in my view properly be described as being cut from "waste" sheets. I therefore find that the allegation that the invention claimed in claims 1 and 2 is not new having regard to US 2708418 fails.

As to whether claims 1 and 2 lack an inventive step having regard to US 2708418, I am

handicapped by the absence of any substantive argument. Mr Whitaker simply asserted that the slitting and chopping process described in the US patent was the obvious way to cut material into the form claimed in Mr Crotty's patent. However, that is not I think the point. In the absence of any relevant argument it seems to me that the best I can do is to note that the only difference between what is described in the US patent and what is claimed in Mr Crotty's patent is the use of "waste" sheets of cardboard to produce the bedding material. I then ask myself whether it would have been obvious in the light of the US patent to cut cardboard into the sizes specified from waste sheets of cardboard and in my view it would not. It seems to me that the disclosure in the US specification of the process the pulping of waste paper to manufacture cardboard specifically for the purpose of making bedding is so central to the invention in that patent that, in the absence of any other pointers, I see absolutely no reason why the notional skilled man would depart from that process and simply cut the bedding from waste sheets of cardboard. Therefore, the attack that claims 1 and 2 lack an inventive step in the light of US 2708418 fails.

Finally, I must turn to GB 2254769A. The first point to note is that this patent application was published on 21 October 1992 which is later than the 10 October 1991, the date on which Mr Crotty's application was filed. Thus, to determine the statutory relationship between these cases it is necessary to determine their respective priority dates. In the case of Mr Crotty's patent there is no argument since this was filed on the 10 October 1991 with no claim to an earlier priority date. GB 2254769A however was filed on the 19 February 1992 with a claim to an earlier priority date of 19 February 1991 stemming from an earlier British application GB9103442. Thus under section 2(3) of the Act, the matter in this application will form part of the state of the art in relation to Mr Crotty's patent only in the event that it is entitled to its earlier priority date. However, Mr Whitaker had not addressed this question at any stage of the proceedings and appeared somewhat surprised when I drew it to his attention. I have not, therefore, had the benefit of any argument from the parties on it. Nevertheless, on inspection it appears that the earlier specification from which priority is claimed is substantially identical to the later version and therefore that, *prima facie* the subject matter disclosed is entitled to the earlier priority date.

GB 2254769A relates to the use of cardboard strips for bedding. In the preamble it says that a shredding machine can be used to produce strips with cut edges for bedding but that this is not recommended. It then goes on to describe the invention which uses torn, irregular pieces of cardboard with feathered edges. Mr Whitaker rightly pointed out that, even though the invention is quite different from Mr Crotty's, the specification does disclose the use of cut strips, albeit only to dismiss them, and in principle there is absolutely no reason why such a disclosure cannot anticipate Mr Crotty's claims. However, I do not think the specification discloses cardboard strips cut from "waste" cardboard sheets" as is claimed in claims 1 and 2 of Mr Crotty's patent, nor, more importantly, do I think it discloses cut strips having sizes within the ranges specified in those claims. The reference in the cited specification to cutting strips of cardboard is very brief and general, essentially because the idea is rejected in favour of using torn cardboard pieces with feathered edges. While it is true that the detailed description of the invention which follows does disclose pieces with sizes falling within the range of sizes claimed in Mr Crotty's claims, I see absolutely no reason why any of these details of the disclosure of the invention can be read across to the disclosure in the preamble that cut strips can be used and therefore I see no disclosure of the use of cut, as opposed to torn, strips of the particular sizes claimed by Mr Crotty. The two parts of the specification are quite separate and I see no basis for combining them in a way designed to anticipate Mr Crotty's claims. Thus, the attack of lack of novelty against claims 1 and 2 based on this specification fails. No attack of lack of inventive step on the basis of this specification can be, or indeed was, mounted.

I now turn to the other claims in the patent. As mentioned previously, Mr Whitaker withdrew his attack on claims 3 and 4. Consequently, and in the absence of any evidence on which I could consider whether or not the question should nevertheless still be resolved in the public interest, claims 3 and 4 stand. On the other hand, Mr Crotty accepted that claim 5 stood or fell with claims 1 and 2 on the basis that disposing of bedding material by composting was routine and that the notional skilled person would not have been in the least surprised at the suggestion that this could be done with cardboard bedding in accordance with claims 1 and 2. I believe that that is right and since I have found that claims 1 and 2 fall, it follows that claim 5 is obvious and fails for

lack of an inventive step.

This then leaves claims 6 and 7 which relate to a method of rearing animals using the bedding material of claim 1 or 2 and to a building, pen or nest box containing the bedding material of claims 1 or 2. I have not been helped by the fact that neither side has offered any argument in respect of these claims. However, I find it quite impossible to believe that the trials which Mr Pearce describes would or could have been undertaken without anticipating claims 6 and 7, and Mr Crotty did not dissent when I suggested at the hearing that claims 6 and 7 must stand or fall with claim 1. Thus it seems to me that the prior use described by Mr Pearce does in substance disclose the subject matter of claims 6 and 7 and that these claims must fail for lack of novelty.

In summary then, I have found that claims 1, 2, 6 and 7 do not define a patentable invention because at their priority date they were not new contrary to section 1(1)(a) of the Act and that claim 5 also falls because it does not involve an inventive step, contrary to section 1(1)(b). There are therefore grounds to revoke the application under section 72(1)(a). On the other hand, claims 3 and 4 have not been impugned, and so I am prepared to give Mr Crotty an opportunity to amend his patent to overcome my finding that the other claims are invalid. It is for Mr Crotty, not me, to propose suitable amendments if he so wishes. However, clearly one possibility that is open to him is to strike out claims 1,2,5,6 and 7. Since the reference in the second line of what is currently claim 3 to "any of the proceeding (*sic*) claims" would not then make sense, he would also need to amend this claim, eg by incorporating the substance of the present claim 1 into what is currently claim 3.

Accordingly, as provided under section 72(4), I order that Patent No 2261586 should be revoked unless, within two months, Mr Crotty submits amendments to the specification to overcome my finding that claims 1,2,5,6 and 7 are invalid. If Mr Crotty does submit amendments, he should also send a copy to Mr Seaman's professional representative. Mr Seaman will then have one month in which to submit any comments on the amendments, and any such comments should be copied to Mr Crotty. I will then determine how matters should proceed. If Mr Crotty does not submit amendments, I shall revoke the

patent.

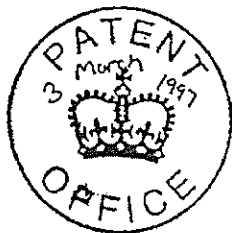
Both sides asked for costs but I will suspend a decision on this until the action is otherwise complete.

Any appeal against this decision must be lodged within six weeks.

Dated this 3<sup>rd</sup> day of March 1997.

**P HAYWARD**

Superintending Examiner, acting for the Comptroller



**THE PATENT OFFICE**