

PATENTS ACT 1977

IN THE MATTER OF application
No 9020299.5 in the name of Stephen Thomas
Alder

01129/94

DECISION

The application relates to a fencing connector for use with fencing of the type wherein a series of panels are supported between a series of posts by being engaged in slots in the edges of those posts.

The specification explains that it is possible for trespassers to get through fencing of this type by simply raising the panels within the slots. High winds can also blow the panels out of the slots or the panels may rattle in such conditions. The invention provides a connector for securing the panels to the posts to overcome these disadvantages.

Claim 1, as filed, reads -

"A fencing connector unit suitable for use in a fencing system comprising posts with longitudinal slots on opposite sides thereof for the reception of preformed panels comprising an integral strip-like member having a U-shaped portion such as in use to partially surround a post and a linear portion extending outwardly from an end thereof such as in use to lie along a preformed panel wherein the connector unit is such that with the linear portion secured to the panel a frictional engagement would exist between the U-shaped portion and the post"

The specification describes various forms of connector but in one arrangement the connector is a square U section with flanges extending outwards from both arms of the U.

The frictional engagement may be between the floor of the U and the front face of the post, in which case the length of the arms of the U must be matched to the distance from the front

face of the post to the faces of the panels in the slots. Alternatively, or in addition the engagement may occur between the sides of the post and the arms of the U, in which case the length of the base of the U relative to the distance between the side faces of the post becomes a significant dimension.

In the simplest form of the connector (described at page 4 paragraphs 2-4) there is no special modification of the surface of the connector to promote the friction required by claim 1, the frictional engagement being produced by selecting the relative dimensions of the connector and post so that the connector fits tightly against the post when the flanges of the connector are secured to the faces of those panels situated in the slots to either side of the post.

During the substantive examination the examiner objected that the application did not comply with Section 1(1)(a) of the Act since the connector as claimed in claim 1 had been disclosed in a prior published patent specification, US 4 193 584. This specification discloses flanged, U-shaped "straps" having the same general shape as that of the connectors of present invention and shown securing in place panels of a slotted post and panel fence.

The prior document also discloses that the straps are placed around each post and secured to the panels in the manner of the connectors of the present invention but (at column 6 lines 15-18) states that "Straps 70 generally have an inner configuration 72 which is meant to be loosely received around either of the posts 12 or 14 ..."

Although there was some doubt expressed at the hearing as to the true nature of the examiner's objection I believe it is fair to say that it was based on the premise that the references in present claim 1 to the feature of frictional engagement did not serve to limit the form of the connector beyond its general suitability for use in the stated manner and therefore the claim covered any fencing connector of the same general shape and having the potential for such use. The examiner considered that the strap disclosed in the US document was one such connector.

In letters to the Office dated 4th March and 10th August 1994 the agent for the applicant contested the objection and maintained that the references to frictional engagement constituted

a limiting feature which was not disclosed in the prior document. Since these differences could not be resolved, the matter came before me at a hearing on 29th September 1994 when the applicant was represented by Mr D.I.Tapp. Mr D.J.Lovell was present as the examiner in the case and the applicant, Mr S.T.Alder, was present as an observer.

At the hearing Mr Tapp stated that he would firstly seek to establish what he considered to be the correct construction of the claim. He explained that the fencing art was well defined and that the skilled man would have no difficulty in recognising the type of fencing with which the application was particularly concerned. He referred me to British Standard 1722 (part 11) which defines a recommended range of size parameters for such fencing. As I understand it, he was of the view that, to be within the scope of the present claim, not only must the connector be generally suitable for use in the abovementioned well recognised fence type, but must also be such as to produce a frictional engagement of the type specified in claim 1 with an existing fence. Mr Tapp agreed that this would cover a large number of such connectors of different dimensions to fit different known fences but, he submitted, not an infinite number.

To illustrate this point Mr Tapp postulated that to be successful an infringement action based on such a claim would need to demonstrate that any allegedly infringing article of the same general shape and strength (a bracket for supporting a hanging basket was exemplified) would frictionally engage with an existing fence in the required manner.

To further illustrate that his approach to construction was valid Mr Tapp referred me to a prior UK patent specification, GB 935 829, in the field of so called "dummy" electrical plugs. Claim 1 of this specification reads-

"A safety device which comprises a plug with an insulating body and pins to fit within an electric socket whereby when the plug is inserted in the said socket, the electrical conductors of the said socket are externally insulated"

As I understand it, Mr Tapp was not arguing that this specification represented any sort of precedent but that it paralleled the present claim 1 in the requirement for the plug to fit with

a socket which was not part of the claimed device. Mr Tapp submitted that nobody would contend that a piece of wood with pins sticking out of it (which he submitted must have been known at the priority date of this patent) would be an effective anticipation thereof merely because a notional socket could be constructed to match. He submitted that the claim, like the one in suit, must be construed as including only that set of "dummy" plugs which will fit with existing sockets, thus excluding his notional "piece of wood".

Mr Tapp conceded that the US document disclosed a fencing connector of the same general shape as the one defined by present claim 1 and did not appear to dispute that with a suitably matched fence it would function in the required manner. However he submitted that since the US document contained specific instructions to make a connector that fitted the post only loosely (see passage referred to above) it could not be said that the prior document contained instructions to make one of the specific connectors required by present claim 1.

In support of his test for prior publication Mr Tapp referred me to the Court of Appeal decision in the General Tire case [1972] RPC 457 at page 485, line 37 where it is stated:

"When the prior inventor's publication and the patentee's claim have respectively been construed by the court in the light of all properly admissible evidence as to technical matters, the meaning of words and expressions used in the art and so forth, the question whether the patentee's claim is new for the purposes of section 32(1)(e) falls to be decided as a question of fact. If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty".

The judgement goes on at line 49 - "...if carrying out the directions in the prior inventor's publication will inevitably result in something being made or done which, if the patentee's patent were valid, would constitute an infringement of the patentee's claim, this circumstance demonstrates that the patentee's claim has in fact been anticipated".

Mr Tapp maintained that application of this test to the present situation would require the prior document to have specifically disclosed that the straps were in frictional engagement with the posts. There was no such disclosure.

In considering this matter I think it is useful to divide the General Tire "infringement" test into what I believe are its component parts ie firstly it is necessary to determine the scope of the claim in suit, then proceed to determine the teaching of the prior document and finally to see whether the latter on a fair construction reveals something falling within the scope of the former.

Considering the scope of present claim 1 I note firstly that it is directed to a fencing connector unit "suitable for use in a fencing system comprising...etc". To my mind this is a clear and unambiguous direction to construe the claim as a connector per se and not a connector in use in such a system. Mr Tapp did not, as I understand it disagree with this view. Furthermore, there is no indication in the claim that the connector is restricted to suitability for use in any particular standard fence or commercially available range of fences, merely that it must be suitable for use in this general type of fence.

Turning to see what is taught by the description itself, I note that page 2 of the specification states at lines 11 to 13:

"In fencing systems comprising slotted posts and preformed panels rectangular posts are commonly used and these may be manufactured in a number of different notionally standard sizes".

The specification goes on at lines 34 to 35:

"However commercially available posts and panels are seldom manufactured to a high degree of accuracy, and variations are wide"

and at lines 39 to 43:

"The.... British Standard indicates considerable allowable tolerances for the panels in respect of sizes, warpage, moisture content and bending. It must also be said that not all commercially available posts and panels are manufactured to be within the limitations of this British Standard".

To my mind this all goes to show that, although the general type of fence may be well recognised in the art, there is no overriding requirement in its construction that could be said to ensure that the claim covers only fencing of a particular range of sizes.

I am further led to this view by the fact that it is common knowledge that fencing may be constructed on-site from basic materials such that the sizing parameters are determined at the point of construction. Even if it is accepted that the present type of fencing is more likely to be factory produced to a standard, the potential for custom production or adjustment to meet on-site conditions is clearly a real one.

I believe that this is also an important distinction from an art like electrical plugs which must clearly conform to a standard to have practical utility. Thus I cannot accept that there is anything useful to be learnt from this comparison. Moreover, since there is no evidence before me that the validity of the claim of the electrical plug case to which Mr Tapp referred me has ever been tested, I cannot consider this particular analogy further.

I note secondly that claim 1 goes on to state - " the connector unit is such that with the linear portion secured to the panel a frictional engagement would exist between the U-shaped portion and the post"

There is no dispute as I understand it that this is a condition which is dependant (at least in part) upon particular size parameters of the fencing system with which the connector is associated in use. Since, as I have already indicated, I do not consider the claim inherently limited to any specific range of sizes of fence it follows, I believe, that this condition serves only to require the connector to have the potential for such use with fencing systems of the general type in question.

Turning to the prior art document. As I have already indicated the document discloses a connector having the same physical shape as that required by the present claim. There cannot be any dispute that it is suitable for use in the general type of fencing with which the present claim 1 is concerned since it is actually shown and described in this context.

The only other test that the prior connector must satisfy is that it be suitable for use to produce the required frictional engagement. As I have indicated above the prior document shows and describes the connectors (straps) used around the posts in a manner analogous to that required by the present claim 1 except for being "loosely received around the posts".

If the prior connector is dimensioned be "loosely received around the post" disclosed in the prior document it seems to me that on a reasonable construction of that disclosure its dimensions will not be too far removed from those of the post and indeed this appears to be what is shown in Figure 1 of the drawings. In my view the connector must therefore have dimensions such as to give it the potential to provide the frictional engagement required by present claim 1. This could be achieved in a number of ways. For example the post could merely be increased in size or the connector could be displaced sideways so that one arm of the "U" engaged the post.

If what I have said above about the construction of claim 1 is applied to the notional infringement situation contemplated by Mr Tapp, then the question as to whether the similarly shaped bracket designed for hanging baskets constitutes an infringement of the present claim likewise falls to be decided on whether it has the potential for such use. If it has, then technically an infringement is present. I do not agree with Mr Tapp that it would be incumbent upon the plaintiff in such an action to produce a particular existing fence that gave the required effect with the bracket. However, it would be necessary to show that the particular bracket had a range of characteristics (eg overall size, strength and durability) that enabled it to perform in the specified manner with any fence that it was reasonable to construct to the given general type. This would be a matter for the court to decide on the evidence provided.

In his letter to the Patent Office dated 10th August 1994 and again at the hearing Mr Tapp directed attention to another limb of the General Tire test. This is to be found at page 486 line 5 of the judgement where it is stated:

"If on the other hand the prior publication contains a direction which is capable of being carried out in a manner which would infringe the patentees claim but would be at least as likely to be carried out in a manner which would not do so, the patentee's claim will not have been anticipated".

In citing this passage I believe Mr Tapp was relying on the fact that the US document teaches that the strap is loosely applied around the posts. However, I do not think that this is a valid argument. The US document contains a direction to make a connector which has the potential to act in the manner required by present claim 1. The direction will always result in the production of such a connector. The US document shows the connector used in a different way but this does not make it a different connector or remove its potential.

Following the hearing in a letter to the Patent Office dated 5th October 1994 Mr Tapp proposed an amendment to claim 1 and requested that this be taken into consideration for the purposes of my decision. The amendment was to the effect that the end of the claim from the word "wherein" would read:

"...wherein the dimensions of the connector unit are such that with the linear portion secured to the post a frictional engagement must exist between the U-shaped portion and the post"

The covering letter contained no supporting argument save that the amendment was felt to overcome the possibility of frictional engagement being achieved by lateral displacement of the prior connector into contact with the side of an undersized post as I have explained above.

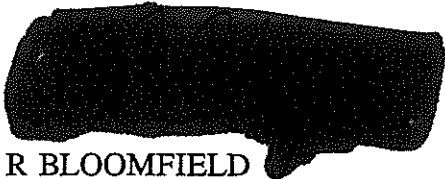
I will assume that the proposal was intended to refer to the linear portion being secured to the "panel" rather than to the "post" since this is the way the connector is described as

working. The effect of this amendment is to further specify the manner in which the connector must perform in use. But, as I have already indicated I regard the claim as directed to any connector having the potential for use in the manner specified with any fence that might reasonably be constructed to the given type. It would only require an adjustment in the size of the post of the fence disclosed in the prior document relative to the size of the connector shown therein to produce this effect. It seems clear to me therefore that the prior connector still has the required potential.

In the result I uphold the view of the examiner that the present specification in its original form or as now proposed to be amended does not meet the requirements of Section 1(1)(a) of the Act in the light of the disclosures of US 4 193 584.

As the period allowed under Section 20(1) of the Act has not yet expired and there appears to be potential for an amendment to meet my findings I direct that the application shall not be allowed to proceed to grant unless a suitable amendment is filed within the period prescribed by Section 20(2) for appeal; which being a technical matter, is 6 weeks from the date of this decision unless an extension is granted.

Dated this 19 day of October 1994



I R BLOOMFIELD
Principal Examiner, acting for the Comptroller



THE PATENT OFFICE

