

IN THE MATTER of an application under
Section 72 by Ultra Marketing (UK) Ltd
for the revocation of UK Patent No.
2241601 in the name of JAT Extrusions
Limited.

Bridges 1/4/96

Revocation
(unrepresented applicant)

DECISION

Patent application No. 9104209.3 was filed in the names of James Alfred Till and Euro UK Sign and Display Systems Ltd ("Euro") on 28 February 1991, claiming priority from five separate applications, the earliest having a filing date of 1 March 1990. The application was published under serial number GB 2241601 A on 4 September 1991 and subsequently granted on 28 September 1994. By virtue of assignments dated 5 January 1993, title passed to the present proprietors, JAT Extrusions Limited (JAT).

The patent relates to framing of sign panels in which a sign panel is mounted in a rectangular frame typically comprising extruded aluminium sections. The frame sections are channel-shaped and the panel is suspended from within the upper frame member by means of a projecting rib at or near the upper edge of the panel which engages a flange provided within the channel. The panel can be mounted in the frame from the front by holding it at an angle to the frame, inserting the upper edge of the panel into the channel of the upper frame member and returning the panel to the vertical, thereby engaging the rib and flange.

The claims of the application as filed were considered by the examiner to comprise more than one invention, and matter relating to certain aspects of the sign construction were divided out and made the subject of separate applications under section 15(4). Patents were subsequently granted on these applications. They play no part in these proceedings.

During prosecution of the patent application in the Patent Office, observations under Section 21 were filed *inter alia* by the applicant for revocation and on 17 November 1994, shortly following grant of the patent, an application for revocation was filed in the name of Rodney Jesse Roy Coombes. Since the filing of an amended Form 38/77 on 17 February 1995, the application for revocation has been proceeding in the name of Ultra Marketing (UK) Ltd ("Ultra"), of which Mr Coombes is managing director.

Evidence filed by the applicants comprises affidavits by Mr Coombes, and also by Messrs. T. A. Scott and C. J. Warbutton. Mr Scott is a self-employed sales and design agent. In addition to collaborating on sign designs with the applicants, he is also alleged to be a director of the proprietor company, JAT. Mr Warbutton is currently works manager of Ultra, but was previously associated with a manufacturing company known as Warbutton Aluminium Sign Products ("WASP"), which also traded as Samson Security Shutters Ltd. WASP was the manufacturing company used by Ultra.

The proprietors evidence in defence of their patent comprises statutory declarations by Mr B M Nudds, company secretary of JAT and three other associated companies (Lion Profiles, ETL Sign Systems and ETL Sign Products); Mr D L Brown, the patent agent who acts for the proprietors; and Mr P J Till, one of the co-inventors of the patent in issue who is also a shareholder in the proprietor company and an employee of ETL Sign Products.

During these preliminary stages, the applicant filed a large number of copies of drawings and of correspondence both as appendices to the pleadings and as exhibits to the evidence. These documents were not clearly paginated and this has given rise to some confusion as to the extent and association of the submitted documentation. A number of issues were raised by the Office and the proprietors during the preliminary stages regarding the adequacy and admissibility of the pleadings and evidence. Some were resolved, others left to be decided as preliminary issues at the substantive hearing.

The matter first came before me at a hearing on 5 December 1995, at which Mr Coombes, managing director of the applicant company, appeared in person, and Mr David L Brown of Page Hargrave, appeared for the proprietor.

At the hearing a number of preliminary issues in regard to the applicant's pleadings and proposed evidence were immediately raised by Mr Brown. As a consequence, I made rulings concerning certain documents which the applicants sought to introduce and further adjourned the proceedings to allow the applicants to file an amended statement of case. This they did on 14 December 1995. The proprietors filed an amended counterstatement on 15 January 1996.

The basis of the applicant's case as set out in their amended statement of case is that the invention is claimed too broadly and is not original because the following features are known in the art of sign panels:

(a) "Back hanging" of sign panels. This is where the sign panel is provided with a rib on its rear (from the perspective of the onlooker) face which in use engages a flange towards the rear of the upper channel member of the sign frame. The applicants assert that this is shown in UK Patent No. 2136624 and was an industry standard prior to the priority date of the patent in issue, as demonstrated by certain of the documents filed as evidence.

(b) The manner of insertion of the sign panel into the frame according to which the opening of the upper frame member is so designed that the panel may be inserted at an angle to the plane of the frame and rotated into position. The applicants assert that this is shown in UK Patent No. 1386409 and that this patent is infringed by the proprietors' signs.

(c) The method of corner jointing whereby the frame members incorporate horizontal grooves into which corner cleats may be inserted. The applicants state that sign frame components comprising these features have been marketed since September 1988, and that the proprietors' signs infringe the applicants' copyright in drawings of such components.

(d) The bead shown in one embodiment (Figure 7) of the patent in which the frame member comprises separate wall members and beads. The applicants state that sign frame systems comprising such beads have been marketed since 1987.

(e) The assembly of the sign box as illustrated in Figure 6 of the patent. The applicants state that the illustrated assembly arrangement has been used, with slight changes, for 20 years.

In addition, the applicants assert that the arrangement of leaf springs used in the frame of the patent in issue is unworkable without the horizontal groove in the frame member, although they do not claim that the leaf spring arrangement as such is lacking in novelty.

In reply, the proprietors deny the allegations of invalidity and state that "the patent relates to certain improvements in signs in which sign frame members have longitudinal channels therein to receive the edges of a sign panel, the panel is suspended from within the upper frame member so that the panel edges normally lie invisible within the frame, and the panel is fittable in the frame from the front by inserting an upper edge of the panel, provided at or near the panel edge with a projecting rib, into the channel of the upper frame member at an angle to the plane of the frame and then moving the panel into the suspended condition in which the rib rests on a flange provided within the channel. UK Patent No. 1386409 is acknowledged in the specification to disclose an earlier, inferior, version of such a sign. The Patent Office Examiner took UK Patent No. 1386409 fully into account when examining the application for Patent No. 2241601, and found patentability. None of the instances of prior publication (including use and printed publication) pleaded by the Applicant discloses the invention of Patent No. 2241601. The existence or otherwise of horizontal grooves in an extruded frame member before the priority date is irrelevant as such grooves are not claimed as essential elements. The subsistence or otherwise of copyright in the designs of such extruded frame members is irrelevant as this is not evidence of prior publication."

The matter came again before me for substantive hearing on 27 February 1996, at which Mr T A Scott appeared for the applicants, and Mr D L Brown of Page Hargrave appeared for the proprietors.

I opened the proceedings by expressing concern to the applicants that in their amended statement, they had directed their attack against the figures of the patent in suit rather than to the claims and against inventions now divided out from the granted patent. In the light

of their response, it became clear that they not appreciated the distinction between the published application and the granted patent and were working from a copy of the former. In answer to my enquiry, Mr Scott confirmed that he had not actually seen a copy of the specification in its final granted form, the claims of which are of considerably narrowed scope compared to those of the original published application. However, despite this disadvantage and following a brief adjournment to allow him the opportunity to study the granted patent, Mr Scott indicated that the applicants still considered the invention claimed to be not new and said that they wished to proceed with the action.

At this point, it is perhaps worth my commenting that the applicants as unrepresented litigants have struggled to come to grips both with the procedural requirements of revocation proceedings before the Comptroller and, it would appear also, with the concept of what they need to establish to be successful in their application to revoke the patent in issue. As a result much of their argument and evidence has perhaps been misdirected.

In the present case, revocation is sought under Section 72(1)(a) of the Patents Act 1977, that is on the grounds that "the invention is not a patentable invention". The expression "patentable invention" refers back to Section 1 of the Act and thence to the definitions in Sections 2-4 of the Act. Although the applicant's statement of case in referring to lack of 'originality' does not identify clearly the grounds on which revocation is sought with reference to the terminology used in the Act, Mr Brown did accept that the application could be regarded as a general attack on the novelty of the claims. I agree with this view. I therefore take the application as being primarily made on the grounds that the invention claimed is not new as required by Sections 1(1)(a) and 2 of the Act, although I do not rule out the need to also consider the issue of whether the invention comprises an inventive step as required by Section 1(1)(b). I should add here that it is the claims which define the invention, as provided in Section 125(1), which states

"For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings

contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly".

This is a vital point which the applicants do not appear to have found it easy to grasp. No part of the applicant's statement clearly relates what is said to be old to the invention as defined in the claims. This is despite them having been given a clear indication as to what was required at the preliminary hearing and an opportunity to amend their statement. It is not enough for them to show that the proprietors' signs embody *inter alia* concepts that are old, rather they need to show that the particular sign constructions defined by the proprietors claims are not new or non-inventive.

Further, much of the argument put forward by the applicants in their statement and at the hearing was directed to purported infringement, both of copyright in respect of drawings relating to designs of frame elements in which they claim ownership and which they have filed as evidence, and also of prior UK patent No 1386409, now expired but in force at the time of filing of the patent in suit. As I indicated to the applicants at the hearing, I have no jurisdiction in these proceedings other than in relation to Section 72 of the Patents Act 1977 and must limit my considerations to the question of the patentability of the claimed invention. On a related theme, it was put to me by the applicants that the patent should not ever been granted and could not be valid because the signs described in it infringe UK patent No 1386409. With respect to the applicants, this is a commonly held misconception. The fact that an invention cannot be worked without infringing an earlier patent is no bar to granting a patent for the later invention. It happens all the time. Indeed, the vast majority of inventions are improvements on what has been done before. The crucial requirement is that what is claimed must be new and non-obvious.

Because of the clear difficulties the applicants have, from the start, had in dealing with the complexities of this action and being aware that it is perhaps particularly in procedural matters including the filing of evidence where the layman is likely to encounter such difficulties, the Patent Office has been lenient as regards the form in which the pleadings and the evidence has been filed and in allowing the applicants to file numerous separate items. Now, however, it is necessary for me to be rigorous in the view I take of the evidence.

Further, whilst in view of their unfamiliarity with such proceedings and with Mr Brown's indulgence, I gave the applicants considerable latitude at the hearing as to the manner in which they presented their case, I must emphasise that the onus for establishing grounds for revocation lies with the applicant for revocation, and it is not the role of the Patent Office to make the applicant's case for him by seeking evidence in addition to that submitted by the applicant. That can be no different simply because the applicant for revocation represents himself in proceedings before the Comptroller, and consequently also does not have the advantage of legal advice. In my earlier preliminary decision I drew the applicants' attention to the benefit to be gained from having professional legal advice and representation, and the great difficulties that may exist in making one's best case without it in a complex field of law.

Following the adjournment to study the claims of the granted patent, the applicants did however manage to redirect their attack against the claims as such, in particular against claims 1, 2 and 4, and it is on this basis that I have been able to consider the issue in the light of the evidence filed and the prior patent documents referred to in the proceedings.

The main claims of the granted patent relate to four separate embodiments of sign constructions and read as follows:

1. A sign in which sign frame members have longitudinal channels therein to receive the edges of a sign panel, the panel is suspended from within the upper frame member so that the panel edges normally lie invisible within the frame, and the panel is fittable in the frame from the front by inserting an upper edge of the panel, provided at or near the panel edge with a projecting rib, into the channel of the upper frame member at an angle to the plane of the frame and then moving the panel into the suspended condition in which the rib rests on a flange provided within the channel, wherein the flange carries an upwardly projecting portion and the rib is adapted to engage with the upwardly projecting portion in such a way that the fitted panel is resistant to movement in one or more horizontal direction (as herein defined).

2. A sign in which sign frame members have longitudinal channels therein to receive the edges of a sign panel, the panel is suspended from within the upper frame member so that the panel edges normally lie invisible within the frame, and the panel is fittable in the frame from the front by inserting an upper edge of the panel, provided at or near the panel edge with a projecting rib, into the channel of the upper frame member at an angle to the plane of the frame and then moving the panel into the suspended condition in which the rib rests on a flange provided within the channel, wherein the upper frame member has a front wall and a back wall spaced apart by an interposed web to define the longitudinal channel, first and second flange means being provided, the said first flange means extending forwardly from the back wall into the channel and the said second flange means extending rearwardly from the front wall into the channel so that the said first and second flange means define between them a channel mouth for admitting the upper edge of the panel on fitting of the panel into the frame, the said second flange means and front wall being adapted to at least partially shield the channel mouth from front-on view.

3. A sign in which sign frame members have longitudinal channels therein to receive the edges of a sign panel, the panel is suspended from within the upper frame member so that the panel edges normally lie invisible within the frame, and the panel is fittable in the frame from the front by inserting an upper edge of the panel, provided at or near the panel edge with a projecting rib, into the channel of the upper frame member at an angle to the plane of the frame and then moving the panel into the suspended condition in which the rib rests on a flange provided within the channel, wherein the upper frame member has a front wall and a back wall spaced apart by an interposed web to define the longitudinal channel, and an additional wall is provided, generally upstanding within the channel and spaced in front of the back wall.

4. A sign in which sign frame members have longitudinal channels therein to receive the edges of a sign panel, the panel is suspended from within the upper frame member so that the panel edges normally lie invisible within the frame, and the panel is fittable in the frame from the front by inserting an upper edge of the panel, provided

at or near the panel edge with a projecting rib, into the channel of the upper frame member at an angle to the plane of the frame and then moving the panel into the suspended condition in which the rib rests on a flange provided within the channel, wherein the frame members are formed of wall members and front beads releasably secured thereto to provide a box sign in which the bead of the upper frame member includes a first portion which overlies the front upper edge of the panel and a second portion which extends rearwardly of the panel and is releasably secured to the upper wall member, the said first bead portion and a front portion of said upper wall member being adapted to provide respectively a front wall and a back wall and the said second bead portion being adapted to provide a spacing web between the said front and back walls to define the longitudinal channel.

As can be seen there is a common introduction to the claims defining "a sign in which sign frame members have longitudinal channels therein to receive the edges of a sign panel, the panel is suspended from within the upper frame member so that the panel edges normally lie invisible within the frame, and the panel is fittable in the frame from the front by inserting an upper edge of the panel, provided at or near the panel edge with a projecting rib, into the channel of the upper frame member at an angle to the plane of the frame and then moving the panel into the suspended condition in which the rib rests on a flange provided within the channel"

There is, I think, no dispute that this type of arrangement is known *per se*, in particular from prior UK patent No 1386409, and this construction is acknowledged as prior art in the patent in suit. Claim 1 of the present application, as filed and originally published, related to no more than this with the additional restriction that the rib was rearwardly facing, and in consequence the applicants' view that such a broadly claimed construction lacked originality (remembering that they were considering said original version rather than the granted version) looks understandable. To successfully attack the granted patent, however, they need to take account also of the additional features now combined with those originally present.

Much of the argument at the hearing concerned illustrations of cross-sections of profiles for the hanging frame members and purported to be marketed before the priority date of the

patent in issue under trade names such as 'Panatrim', 'Panacase', 'Dualcase', 'Vulcanframe', 'Ultraframe' and 'Ultracase', the applicants having usefully provided some samples of such profiles as visual aids. Having listened to the applicants' case, I am satisfied that companies known as Universal Components, WASP and Samson Security Shutters were trading before the priority date of the patent in issue, and that they were involved in the business of sign panel manufacture and marketing. I am also satisfied that such products as 'Ultraframe', 'Ultracase' etc. were manufactured in commercial quantities and marketed during that period, although I do not see prior public use being established for all of the large number of profiles of which drawings have been filed as exhibits to the evidence. In the event, however, specific argument was raised at the hearing only in respect of a small number of these drawings and none of the remainder seem to me to form the basis of a credible attack on the novelty or inventiveness of any of the claims and I need to consider them no further.

There was also a good deal of argument at the hearing about the manner in which various sign systems function, in particular as regards whether or not angled insertion as required by the present claims was feasible, the applicants intending to prove that certain prior constructions were capable of being used in this way. Whilst I take the applicants' point that I should not be misled into dismissing prior constructions simply because they were not specifically intended for angled insertion when they are anyway suitable for such use, equally I must interpret them in a sensible way and not regard them as suitable for such use merely if that arises from notional use of a paper-thin sign panel unlikely to arise in reality. Mr Scott, further, devoted some effort to proving that "back hanging" of panels was known before the priority date, but this is of limited relevance to the matter at issue because it is not an essential feature of any of the independent claims, although it was a feature of original claim 1 which, of course, was one of the claims which the applicants were expecting to have to attack in the light of the published application.

Considering now the claims of the patent in issue, the main argument by the applicants was in respect of claim 4, which requires that the frame member be formed in two parts with a front bead releasably secured to a rear wall member. There was an assertion by Mr Scott that two companies (Universal and Spandex) had been involved in production of a two-part frame which anticipates claim 4, but there is no documentary evidence before me which

supports this. I was also referred to the exhibits 1C, 5C and 6C said to show the applicants' prior 'Vulcanframe' system which, it was argued could operate with angled insertion given a thin enough sign, but this shows a different type of two part member which clearly lacks a bead portion having the required attributes of claim 4, ie *"which extends rearwardly of the panel"*. I was further shown a section of frame corresponding to an exhibit labelled 29C which resembles the arrangement illustrated in Figure 7 of the patent in issue and possesses some of the features of claim 4 including a bead portion extending rearwardly of the panel, but as illustrated it would not be possible to insert the panel at an angle as required by claim 4 once assembled because the front and rear walls of the channel are of similar depths. The applicants sought to introduce an advertisement by 'Universal' showing profiles for a range of their products, but the 'Panatrim/Panacase' products there shown appear to be one-piece and the 'Dualcase' products are not clearly suitable for angled insertion. Reference was also made to prior UK patents Nos 1386409 and 2136624, but neither to my eyes shows a construction within the terms of claim 4. The applicants, in consequence, have failed to make out a case of lack of novelty against claim 4. The issue of obviousness was not specifically raised in respect to this claim and, in the absence of any argument from the applicants as to why the prior angled-insertion and two-part constructions should be combined, I do not see any case of lack of inventive step as being established.

Turning to claim 1 which requires the angled-insertion concept to be combined with engagement between the rib on the sign panel and an upwardly projecting portion of the hanging flange such as to resist horizontal movement of the panel, the applicants have not shown both features in a single construction but they did argue that both were independently known - in effect raising an allegation of lack of inventive step. They did not further develop this case, however, in particular as regards the feature for preventing horizontal movement, and I cannot find that they have established that the claim 1 construction is obvious and lacks inventive step.

Turning to claim 2 which combines angled-insertion with use of a second flange on the front wall to hide the panel edge, there was some discussion about the meaning of the expression in claim 2 *"the said second flange means and front wall being adapted to at least partially shield the channel mouth from front-on view"*. Mr Brown explained that this feature is

intended to reduce the shadow effect which arises in rear-lit panels having an upturned rear flange (which he described as the "key" invention). In Figure 7, for example, this feature is exemplified by the front part of the front flange extending further down than part of the channel mouth. Mr Scott argued that this feature is not distinguished from the arrangement disclosed in Universal's patent No. 1386409. However, whilst I would remark that this embodiment is not clearly shown in the drawings of the patent in issue where the distinction from the prior construction is not readily apparent, I must give weight to the intention of the front flange as set out in the claim and description to at least partially hide the channel mouth. In contrast the front flanges illustrated in the prior patent all lie perpendicularly to the plane of the panel and I do not consider that any of them could be said to at least partially shield the channel mouth from front-on view. Once again I find that the allegation of lack of novelty is unsuccessful. The issue of inventive step does not arise since there has been no evidence of any prior constructions produced with hiding of shadow at the panel edge in mind.

The applicants produced no evidence against claim 3 and, as I understand it, acknowledged that they were not aware of any such system being used. No argument was produced against any of the remaining claims of the patent, although I did ask Mr Brown for his interpretation of claim 15, which relates to a process for manufacturing various "novel frame elements". Whilst, as Mr Brown acknowledged, the wording of that claim is perhaps somewhat abbreviated, I do not find it clearly objectionable for lack of novelty or inventive step, particularly in the absence of any argument from the applicants in this regard.

I therefore conclude that the attack on the validity of the patent in issue under section 72 fails on all the grounds pleaded.

The patentees have requested the grant of a certificate of contested validity. The conditions of section 65(1) regulating the issue of such certificates have been met and, in view of my findings on the issue of patentability, it is appropriate that I should accede to the request. I therefore certify that the validity of patent No. 2241601 has been contested in proceedings under section 72(1)(a) and that the patent has been found valid in respect of those grounds where validity was put in issue.

Turning to the question of costs, Mr Brown has requested costs as he puts it "at the very minimum the upper end of the range of costs", and possibly a punitive order.

Neither party has referred me to any authority in the matter of costs before the Comptroller. That being the case I consider myself bound to take as a starting point the decision of Mr A Watson QC sitting as a Deputy Judge of the Patents Court in *Rizla Ltd's Application* [1993] RPC 365. This case concerned entitlement proceedings before the Comptroller in which costs had been awarded by the superintending examiner on a compensatory basis. The Deputy Judge stated at page 377 lines 24-33:

"Counsel was unable to refer me to any reported case where such a strong order for costs has been made by the Comptroller and therefore there is no established yardstick to measure what might be regarded as exceptional. I believe a case such as the present can only be regarded as exceptional if it can be shown that the losing party has abused the process of the Comptroller by commencing or maintaining a case without a genuine belief that there is an issue to be tried. In my view, this is not shown to be such a case. There are of course a large number of other circumstances such as deliberate delay, unnecessary adjournments etc where the Comptroller will be entitled to award compensatory costs but it is unnecessary to attempt to define what is clearly a wide discretion."

In the present case therefore the onus is on the proprietor to show that the applicant either initiated proceedings without genuine belief that there was a triable issue, or delayed deliberately in their prosecution of the case, or that there are some other circumstances which would justify a compensatory award of costs.

Mr Brown has put it to me that the proceedings have been dragged out and the system has been abused by the applicants. He cited in support of his argument the fact that the applicants came to the hearing today unprepared and not having seen the granted patent.

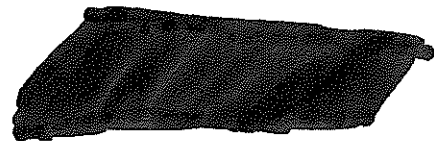
It is certainly true that the applicants have been severely hampered by their lack of knowledge about the patent system and the way the various rules of procedure operate.

However, I am not convinced that they have at any time acted in bad faith or tried deliberately to delay the proceedings. On the contrary, I have had the impression of a party who genuinely believed they had a grievance to pursue and were doing their best to navigate their way through a minefield of substantive and procedural questions. I note that the applicants at all stages urged that matters should proceed with maximum speed, and it was the proprietors who raised the procedural objections which led to delays. It is unfortunate that the applicants got as far as this on the basis of fundamental misconceptions about the nature and scope of the monopoly conferred by the patent they were attacking, and it may well be that they would not have proceeded had they had access to sound legal advice. But this is pure speculation and has nothing to do with whether or not they acted without genuine belief that there was a triable issue. Accordingly, I find no suggestion of an abuse of the process of the Comptroller or any other circumstances of the kind referred to by the Deputy Judge in *Rizla*.

I therefore conclude that there are no circumstances which would justify a compensatory award of costs, and that costs should therefore be awarded in accordance with the Comptroller's usual practice which is to give a contribution only towards incurred costs. Since I have found that the applicant has failed on all the grounds pleaded, I award the patentee JAT Extrusions Ltd the sum of £850 (eight hundred and fifty pounds) as a contribution toward their costs and direct that this sum should be paid by the applicant Ultra Marketing (UK) Ltd.

This being a substantive matter, the time in which an appeal may be lodged is six weeks from the date of this decision.

Dated this | day of April 1996



G M Bridges

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

