

0/117/91

PATENTS ACT 1977

IN THE MATTER OF an application by  
PSC Freyssinet Limited to amend the  
specification of Patent No 2189544

and

IN THE MATTER OF an opposition  
thereto by Tangye Limited

DECISION

Patent No 2189544 is dated 23 April 1987, and has a declared priority date of 26 April 1986. The patentees have applied under Section 27 to amend their specification, the reasons given on Form 14/77 filed on 5 March 1990 being to distinguish constructions according to the invention more clearly from the constructions disclosed in DE-U-8401412, which was published in March 1985. As the result of an official objection that further amendment of the specification appeared necessary the patentees submitted revised proposals as shown in red ink on a copy of the published specification which accompanied their agent's letter dated 6 June 1990. Following advertisement, these proposed amendments were opposed by the present opponents on 23 October 1990 on the grounds that the patentees have not shown good faith in stating their reasons for making the application to amend, in that they have not drawn to the attention of the Comptroller the relevant part of the Search Report of the corresponding European Patent application 0245988, which refers to Figure 2 and claims 1 and 3 of DE-U-8401412. They also contend that all significant features included in proposed claim 1 of the specification in suit are disclosed in Figure 2 of DE-U-8401412.

In their counterstatement the patentees maintain that Form 14/77 properly states their reasons for seeking to amend the specification and that it was never the intention of the patentees or their agents to try to conceal the Figure 2 embodiment of DE-U-8401412 from the Patent Office in the application to amend. They

also deny that all the features of the proposed Claim 1 are embodied in Figure 2 of DE-U-8401412.

At a hearing before me on 1 October 1991, Mr G K Gibson appeared as agent for the opponents and the patentees were not represented.

The patentees' specification relates to a fluid operated door opener allowing rapid and quiet entry to closed and locked premises. The device comprises two fluid-operated actuators the first (11) of which is provided with jamb-engaging elements (16, 22) and acts in a direction substantially parallel to a closed and locked door. This provides a support for the second actuator 12 which acts in a direction normal to the door to burst it open.

By their proposed amendments the patentees seek to limit the scope of their claims to the embodiment shown in Figure 5 and claimed in claim 11 of the granted patent. Thus the amendments involve the deletion of claims 1-10, the renumbering of claim 11 to claim 1, the addition of new claims 2-4 which are appendant to claim 1, and renumbering and revision of claim 12, with consequential amendment to the description.

New claim 1 reads as follows:-

1. A door opener comprising
  - a rectangular block having six faces of which four faces are interrupted by a plane which is parallel to and located between the two remaining faces;
  - first and second hydraulic actuators adapted to produce linear motion and each including a piston housed in a cylinder and a piston rod connected to the piston and extending through one end of the cylinder to provide a free end;
  - two jamb-engaging elements;
  - one of said jamb-engaging elements being connected to the free end of the piston rod of said first hydraulic actuator;
  - the cylinder of said first hydraulic actuator extending outwardly from a first face of said four faces of the block;

the other of said jamb-engaging elements being mounted on a second face which is opposite to said first face of the block;

the cylinder of the second hydraulic actuator extending outwardly from a third face which is adjacent to said first face and to said second face of the block;

a door-engaging member;

the piston rod of said second hydraulic actuator extending through said block towards and through the fourth of said four faces of said block;

said door-engaging member being connected to said free end of the piston rod of said second hydraulic actuator; and means operable to supply a liquid under pressure to each of the hydraulic actuators in turn;

whereby operation of the first hydraulic actuator causes the jamb-engaging elements to engage the door jambs and, subsequently, operation of the second hydraulic actuator causes the closed/locked door to be pushed out of the doorway.

In their statement the opponents contend that when applying to amend on 5 March 1990 the patentees should have drawn the attention of the Comptroller to the Search Report dated 20 March 1989 on the corresponding European application No 0245988 which lists inter alia DE-U-8401412 with particular reference to Figure 2 and Claims 1 and 3. They point out that in the Patent Office file of the application to amend are pages 530 and 531 of the German Patent Office publication GMA-HEFT 13 dated 28 March 1985 which include an extract of the Gebrauchsmuster DE-U-8401412 consisting of the title, Claim 1 and Figure 1, and explain that this extract in the German Patent Office publication is the only disclosure in relation to the Gebrauchsmuster publicly available in Great Britain.

At the hearing Mr Gibson argued that the patentees had shown lack of due care in their application to amend in that they should at least have referred to the particular reference of Figure 2 of the Gebrauchsmuster as stated in the search report of the corresponding European application. He explained that in accordance with Article

92(2) of the European Patent Convention the patentees would have been supplied with a full text of the Gebrauchsmuster when the search report was issued. Furthermore the patentees' representatives would have been aware that the full text of Gebrauchsmuster were not publicly available in the United Kingdom, and that the full text thereof is only available outside the European Patent Office by applying to the German Patent Office in Munich. With the full text in their possession they should therefore have provided a translation of the full text to the Patent Office when applying to amend.

Turning to the counterstatement the patentees say that neither they nor their agents envisaged that the Patent Office Examiner would rely on the abstract of DE-U-8401412 in considering the application to amend. In a statutory declaration which accompanied the counterstatement Mr Ben-Nathan, the agent who prepared the application to amend, says that it never occurred to him that the Examiner may rely only on the abstract, and that there was no intention on his part to conceal from the Examiner the Figure 2 construction in the cited document. He did not consider it necessary to indicate the specific parts of DE-U-8401412 which were the most relevant, because it seemed to him that this would be immediately obvious from the short and relatively simple document. The patentees also contend in their counterstatement that the abstract refers to the Figure 2 embodiment by reference to further hydraulic cylinder (17) in door frame (21).

Whilst it would have been of assistance to the Patent Office had the patentees supplied a copy of the prior art document, it is observed that the Office is empowered by virtue of the provisions of Rules 106 and 113(1) to direct that such documents, information or evidence as may be required be provided, accompanied, if necessary, by a translation thereof into English. Thus in order to determine whether or not the proposed amendments were sufficient to distinguish the invention now claimed from the cited prior art, the Examiner, when considering the application to amend, would have been able, had it been deemed necessary, to require the patentees

to furnish a copy of the cited document, together with a translation thereof. Moreover I am not persuaded that the statement by the patentees on Form 14/77 that the reason for the application to amend under Section 27 is to distinguish the invention from the disclosure of DE-U-8401412 is misleading. As pointed out by Mr Ben Nathan the cited document is relatively short, and it seems to me that its relevance to the specification in suit would be apparent to the skilled reader. Accordingly I do not consider that I should withhold discretion to permit amendment of the specification on the grounds that the patentees have not shown good faith or due care in stating their reasons for amendment.

With reference to the translation furnished by the opponents, Figure 2 of the cited Gebrauchsmuster is concerned with a hydraulic device for breaking open locked doors in which a hydraulic pressure cylinder 13 which acts in a direction normal to the door is clamped into a door frame 21 by means of another hydraulic pressure cylinder 17. The hydraulic cylinder 13 is fixed in a guide rail 14 having a tubular attachment 15 in which slides tubular section 16 provided with another hydraulic pressure cylinder 17. In their statements the opponents contend that the guide rail 14 constitutes a block having six faces in relation to which the first and second actuators extend at right angles to each other with the actuator cylinders extending outwardly from the block, as required by the proposed Claim 1, and that the application to amend should therefore be refused. In their counterstatement the patentees maintain that all the features of the proposed Claim 1 are not embodied in Figure 2 in that their claim requires a rectangular block (50), with the cylinder (51) of the first hydraulic actuator extending outwardly from the face of the block. They point out that there is no disclosure in DE-U-8401412 of the rectangular block since the guide rail 14 shown in the drawing is a flanged beam. Moreover a tubular, connector 15 is required to join the second hydraulic cylinder (16) to the guide rail (14).

Mr Gibson sought to persuade me that the guide rail in Figure 2 of the Gebrauchsmuster is in the form of a rectangular block. Referring to the Shorter Oxford Dictionary he relied on three definitions of the term "block", namely (1) "A solid mass of matter with an extended surface", which he contended could be equated with a rail, (2) "A piece prepared for building purposes" which he regarded as close to the function of the patentees' block which was to be used on buildings, and (3) "A piece, for example, of wood which acts as a support". He also considered the definition of a beam which is a support, and relied upon the definition of a beam as "A large piece of squared timber". Whilst conceding that this would not have the function of a rail, in his view it would have the appearance of a rail. From these definitions he contended that the normal meaning of the word "block" is not distinguishable from that of a rail, or at least encompasses a rail.

Having considered the definitions of the term "block" to which Mr Gibson invited my attention I would observe that they are selected from many alternative definitions and are of very general scope. Moreover they apparently fail to take account of the use in the patentees' invention of a rectangular block having six faces of which four faces are interrupted by a plane which is parallel to and located between the two remaining faces. I am satisfied that there is no disclosure in the cited Gebrauchsmuster of such rectangular block with the cylinder of the hydraulic actuator which acts in a direction parallel to the closed door extending outwardly from a face of the block.

I am less satisfied that there is an inventive distinction between the use of a block and the use of a rail, but I have come to the conclusion that without expert evidence on the state of the art at the date of the patent, I should resolve the matter in favour of the patentees.

With regard to the other structural difference relied upon by the patentees in their counterstatement, Mr Gibson pointed out that the patentees have not argued that there is any significance in

relation to their disclosure in having a direct connection between the hydraulic cylinder and the block, compared with having an intermediate tubular connection detachably secured between the cylinder and the rail as shown in the Gebrauchsmuster. He also submitted that the two structural differences to which the patentees have referred were not inter-related and were of no significance, being merely differences in structure and not features of substance. In contrast to my opinion of the distinction between a block and a rail, I am quite satisfied without expert evidence that there is no inventive step in using a relatively long cylinder as opposed to using a relatively short cylinder plus an extension piece. I am also clear that, as Mr Gibson submitted, there is no relationship between the two structural differences. However, the distinction between the block and the rail is in my opinion sufficient to distinguish the invention claimed from the disclosure of the cited Gebrauchsmuster.

In an attempt to persuade me that the patentees had shown lack of due care when applying to amend, Mr Gibson also drew my attention to US specification 4657225 cited on the Search Report of the corresponding European application No 0245988. The US specification was published on 14 April 1987, that is, between the claimed priority date and the filing date of the patent in suit. Mr Gibson's point was that the claims as proposed to be amended would not be entitled to the claimed priority date, and therefore this US document became a document which should have been considered. I have considered the US specification, which differs from the proposed claim by having a screw jack as a brace across the doorway rather than a hydraulic actuator, and an inflatable bag for bursting the door open rather than a hydraulic actuator.

These differences are in my view of a similar kind to the differences between the proposed claim and the Gebrauchsmuster. I could not decide without expert evidence that the differences do not constitute an inventive step. Although I do not consider, at least in the absence of expert evidence, that the US patent

establishes lack of inventive step in the proposed claims, I do consider that it is sufficiently close for it to have been brought to the Comptroller's attention in amendment proceedings. That is on the assumption, which is in my view prima facie correct, that the proposed amendment involves the loss of priority date.

In these circumstances, the appropriate course of action should be to adjourn the proceedings to allow the opponents to apply to amend their statement of case. It could be said in favour of that course of action that it is the only opportunity to consider whether discretion should be exercised against the patentees on grounds of lack of care in preparing their application to amend.

On the other hand, the objection based on the US Patent was raised for the first time during the hearing, and I have now found that if that document had been properly brought to the Comptroller's attention, I would still have allowed the amendment.

In these circumstances, I allow the application to amend the patent subject to the patentees filing within two months of the date of this decision a copy of specification incorporating the amendments and complying with Rule 40(7) of the Patents Rules 1990.

In all the circumstances of this case I make no award as to costs.

Dated this 31 day of OCTOBER 1991



W J LYON  
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE