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Dr. Ferdinando

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PATENTS ACT 1977

IN THE MATTER OF an application under
Section 72 by Gang-Nail Systems Limited for the
revocation of Patent No GB 2089389 B in the
name of Easybuild Structures Limited

17/2/94

SECOND INTERIM DECISION

The patent in suit is for a roof truss. In an Interim Decision dated 16 August 1993 following a hearing, I held that certain of the three granted claims and of the eleven proposed as amendments ("the amended claims") lacked novelty, but that the remaining claims were novel and inventive. I allowed two months for the proprietor to submit fresh amendments and a further month for the applicant to comment on them.

Under cover of a letter dated 14 October 1993, Swann Elt & Co, as agents for the proprietor, submitted a statement explaining fresh proposed amendments ("the fresh amendments") which are shown in red on a copy of the patent annexed to it. The fresh claims, which are proposed in place of all previous claims, number only two. Fresh claim 1 essentially comprises all three granted claims rolled together and as such is an omnibus claim tied to the construction shown in figure 1. Fresh claim 2 is new but is similar in scope to the amended claim 4 that was before me at the hearing. Consequential amendments are proposed to pages 1 and 2 of the description; amendments proposed to page 3 of the description emphasise that the truss is a roof truss.

In a letter dated 15 November, Marks & Clerk, as agents for the applicant, opposed the fresh amendments, and in consequence I conducted a second hearing on 21 January 1994 at which Mrs G R Smith appeared as agent for the applicant. The proprietor was not represented.

The granted claim 1 was for a truss having several specified constructional features; granted claim 2 was for a truss as claimed in claim 1 with a further constructional feature, and granted claim 3 claimed "a truss as claimed in claim 1, substantially as hereinbefore described with reference to and as shown in Fig 1 of the accompanying drawings". Fresh

claim 1 contains all the features of granted claims 1 and 2, with the further limitation "and said truss is substantially as hereinbefore described with reference to and as shown in Fig 1 of the accompanying drawings". Granted claim 3 was appendant to granted claim 1, whereas the fresh claim 1 is a composite of granted claims 1, 2 and 3. As a matter of construction, therefore, fresh claim 1 is equivalent to granted claim 3 with the additional limitation of granted claim 2.

Mrs Smith submitted at the second hearing that fresh claim 1 was not clear and concise and did not adequately define the matter to be protected. She based this objection on the difficulty of identifying the differences between the details of Fig 1, and the prior art as represented by Exhibit TB1. The objection focusses on the side member 3 of the roof truss, which is depicted in Fig 1 in a manner which might be taken to indicate that the side member is a unitary block of wood, whereas in the prior art the corresponding member is shown as being a framework of several smaller members. Mrs Smith's objection was that one cannot rely on this as a difference, because Fig 1 is consistent, in view of the absence of a line across the down member 5 where it meets the side member 3, with the side member 3 being a framework covered with plywood.

There are in my view two answers to this objection. One is that Fig 1 must be interpreted in conjunction with the description, which says, at page 3, lines 12 to 25 of the granted specification that the truss comprises a wooden polygonal first portion made from framework members 1, 2, 3 joined together by nails, and a wooden polygonal second portion made from framework members 4, 5, 6 joined together by nails. The first and second portions are joined by nails to give the appearance of Fig 1. This description would not in my view support a claim for a construction in which the member 3 consisted of a covered framework, though I can understand Mrs Smith's difficulty in determining what claim it would support.

However, the boundaries of a claim to a product as described and shown in a drawing are necessarily less clearly defined than those of a claim defined solely by constructional features, but it is well settled that such claims are allowable. Fresh claim 1 has both a list of constructional features and a limitation referring to Fig 1, but I do not consider the claim to be any less clear in scope than the generality of omnibus claims.

The second answer is more fundamental. Having found in my Interim Decision that granted claim 3 was novel and inventive, I must already have answered the point that is now being raised. I said in the earlier decision, at pages 15 and 16:

"Granted claim 3 is directed to " a truss as claimed in claim 1, substantially as hereinbefore described with reference to and as shown in Fig 1 of the accompanying drawings". Mrs Smith submitted that the truss shown in figure 1 has all the features of the prior truss. The only possible difference she could point to is that the side members 2,3 as shown in figure 1 are broad, whereas the prior truss effectively replaces those broad side members by two uprights and a connecting diagonal web. She contended that the prior construction was functionally identical to a broad single upright member and hence that granted claim 3 is directly anticipated by the prior truss as manufactured. She added though that if there was any functional difference between the two, the patent gives no indication of any advantage of the broad member of figure 1. Mr Jukes argued that the reference to figure 1 constituted a narrowing of the broad terms used in granted claim 1, for example so that "framework member" as used in claim 1 is of broader scope than a framework member which is actually shown in the drawing of figure 1. He also remarked that the drawing of the prior truss as in exhibit LW1 does not correspond to figure 1 of the patent. I agree, it also seeming to me, on a comparison of figure 1 of the patent with the drawing of the prior truss on page 3 of exhibit LW1, that there are material differences between the two structures shown. Accordingly, I find granted claim 3 to be novel."

Although fresh claim 1 differs from granted claim 3 in that it contains the additional limitation of granted claim 2, the issue that Mrs Smith raises now is one that I have already disposed of. In my view, I have no jurisdiction to reconsider my decision on this point.

Fresh claim 2 is for:

"A (100%) complete roof comprising at least two roof trusses as claimed in claim 1."

This is similar in scope to amended claim 4, which I held in my Interim Decision to be novel and inventive. Amended claims 4 was for:

"A building's roof as claimed in claim 3, substantially as hereinbefore described with reference to and as shown in Fig 1 of the accompanying drawings."

and amended claim 3 was for a building's roof comprising at least two roof trusses as claimed in claim 1 and/or claim 2 with a constructional limitation.

Mrs Smith objected to the wording "A (100%) complete roof" which was not previously present in the specification. It derives from a form of words used at page 11 of the Interim Decision to emphasise the distinction from a 95% complete roof structure. An important piece of evidence at the first hearing in June 1993 was a note of a site meeting on the priority date of the claim, at which it was reported that the roof structure constituting the alleged prior use was 95% complete on that date. Mrs Smith argued that there was no basis for the new wording in the specification, and contended that the new wording lacks clarity due to the presence of parentheses, and might therefore add matter.

I consider that this objection is correct. I had held that a claim to "a roof" was not anticipated by a "roof structure" that was said to be 95% complete. I can see that the amendment to claim "a (100%) complete roof" may well be intended to emphasise the difference between the claim and the prior art, but I do not believe the formula is sufficiently clear to be appropriate to a patent claim. By the conventional rules of construction, there is presumed to be a difference between "a roof" and "a (100%) complete roof", and it is not clear to me what the difference is, nor what the basis for the difference is in the description.

I therefore refuse to accept the fresh claim 2. I will allow the proprietor one month from the date of this decision in which to file an amended claim 2. Since fresh claim 2 was considered in detail at the second hearing on 21 January, I can say that I would accept a new claim 2 to "a roof comprising at least two roof trusses as claimed in claim 1", or to "a building's roof comprising at least two roof trusses as claimed in claim 1". If either of these amendments is filed within the period I have set, I shall allow it and issue a decision allowing the fresh claim 1, the new claim 2, and the consequential amendments to the description to which Mrs Smith has raised no objection. It will be necessary for the proprietor to supply a copy of the specification incorporating the amendments.

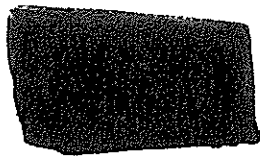
If different amendments are filed, I allow the applicant for revocation a further four weeks in which to objections to them.

I shall defer considering the question of costs, for which both parties have requested an award, until the issue of the final decision. I should say however, that it would be consistent with the Comptroller's normal practice for me to make a modest award of costs in favour of the applicants for revocation, because they have been helpful in securing the limitation of an invalid patent. I am aware that the proprietors submitted voluntary amendments under section 27, but the first hearing last June would not have been necessary if they had conceded that, as I held, some of the amended claims then proposed would be invalid.

Mrs Smith asked whether such an order for costs should be awarded against the registered proprietor or against an unregistered assignee. I said at the hearing that my provisional view was that the registered proprietor Easybuild Structures Ltd was the party against whom the order should be made. That remains my provisional view, but I am prepared to consider further submissions on the point, provided they are received within the timetable I have set out above.

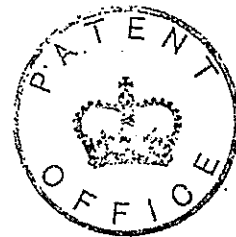
This being a substantive matter, the time within which an appeal may be lodged is six weeks from the date of this decision.

Dated this 17 day of February 1994



W J LYON

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE

