

BLO / 025 / 89

PATENTS ACT 1977

IN THE MATTER OF AN application
under Section 71 by
Stäubli-Verdol Sarl for a
declaration of non-infringement
in respect of Patent No 2047755
in the name of Bonas Machine
Company Limited

PRELIMINARY DECISION

This preliminary matter arises out of an application by Stäubli-Verdol Sarl seeking a declaration that the disposal of, the offer to dispose of, the use or the importation of a mechanism, the construction and operation of which is as described in a document annexed to their statement of case, would not constitute an infringement of Patent No 2047755. The patentees have objected in their Counterstatement that the particulars provided by the applicants are not sufficient and, more specifically, that not all of a list of questions which they put to Stäubli-Verdol before these proceedings were initiated have been answered. The applicants are reluctant to supply further details and requested a preliminary hearing to determine whether further particulars are necessary. At the hearing before me on 31 January 1989 the patentees were represented by their counsel Mr Nicholas Bragge and the applicants by their Patent Agent Mr Harrison of Mewburn, Ellis and Co.

Patent No 2047755 is concerned with a jacquard mechanism for a weaving loom. The pertinent part of this mechanism consists of two parallel-arranged members, referred to as rods, which are reciprocated longitudinally 180° out of phase with each other by two continuously oscillating lifting members termed knives. To control the weaving process it is required to selectively latch one or other, or both, of the reciprocating members at the top of their travel. Release of a latched member should only occur

when the associated knife reaches its upper position since otherwise an uncontrolled fall of the member would occur. In the main embodiment an electromagnet is placed between the rods so that when energised it deflects a rod in its upper position so that it hooks onto a fixed bar. De-energisation of the magnet allows the rod to be unhooked from the bar by the associated knife as the latter again reaches its upper position. In other embodiments, instead of the rods themselves being deflected, the rods are latched by spring hooks which are attracted by the electromagnet either to cause engagement with the rods or to permit disengagement therefrom.

The basic arrangement of the applicants' mechanism as described in Annex 2 to their statement of case is similar to the last mentioned variant described in the Patent. However in place of spring hooks deflected by the electromagnet the applicants use pivoted latches biased towards an active position by a compression spring and arranged so that when the associated reciprocating member is nearly at its top dead centre position it pushes against part of the latch thus causing the latch to pivot to an inactive position where its tail contacts the pole piece of an electromagnet. If the electromagnet is energised at this time the latch is held in its inactive position and the reciprocating member is lowered by its knife, whereas if the electromagnet is not energised the latch pivots back to the active position under the action of the compression spring and catches the reciprocating member as the knife is lowered. The reciprocating member includes a resilient tongue which effects the final movement of the tail of the latch into contact with the electromagnet and ensures that the tail of the latch is pressed resiliently against the polepiece. This is said to compensate for any wear which may take place in use of the mechanism.

Claim 1 of the Patent reads -

1. A jacquard heald control means for an open shed jacquard loom characterised in that at least one heald is

controlled by means including a pair of oscillatable rods, there being means intermediate the ends of the rods for selective engagement with an oscillatable knife means adapted to raise its associated rod, and means adjacent the free end of each rod for engagement with a retainer element adapted to hold the rod in a raised position, the means for causing engagement of the retainer element and the means on the free end of the rod for both rods of said pair being in the form of a single electromagnet located between the paths of travel of said rods, the electromagnet when energised causes relative transverse movement between the retainer element and the free end of the rod.

Of particular significance is the last phrase of this claim which requires the electromagnet to cause relative transverse movement between the retainer element and the free end of the rod. This is to be contrasted with the description of the applicants' mechanism on pages 5 and 6 of which it is made clear that the transverse movement is caused mechanically and that the action of the electromagnet is merely to retain the latch and not to cause the transverse movement.

The applicants' description is a translation of a patent application and contains introductory paragraphs referring to 'the invention' and two final paragraphs indicating that the description is merely by way of example and that equivalents may be utilised. Now this may be acceptable in a patent specification which contains a precise statement of the scope of the invention, but in the present circumstances where the description itself defines the mechanism in respect of which the declaration is sought it is possible that such passages could result in a lack of precision of description sufficient to prevent the granting of the declaration, indeed, Mr Bragge intimated that some such submission would be made by the patentees at the substantive hearing. This was not argued before me however and for present purposes I shall assume, without deciding, that the declaration sought is in respect of

a mechanism arranged and operated in the manner particularly described in Annex 2 and that any variations encompassed by the description do not modify the basic principle of construction and operation as submitted to me by Mr Harrison, that the tail of the latch is brought into contact with the electromagnet by the spring tongue before the electromagnet is energised.

In paragraph 5 of their counterstatement the patentees say that they intend to show that "the mechanism as illustrated in Annex 2 could infringe at least claim 1 of UK Patent 2047755". The whole tenor of their argument before me was that there was a possibility that as a result of wear or deliberate adjustment the mechanism might in use infringe the patent, but it was not suggested that the mechanism when operating in the manner specified in Annex 2 would constitute an infringement, and I presume that this is what they intended to convey by the use of the word "could".

What the patentees are concerned about is the possibility that wear, for example of the pivot of the latch, might result in modification of the operation of the mechanism or that an operator might adjust the timing or energisation current of the magnet to compensate for wear or damage or to improve the reliability of operation of the mechanism. Mr Bragge also argued that fuller details of the actual operation of the machine were necessary, because in a practical machine with a large number of such mechanisms all operating at high speed it was conceivable that energisation of an electromagnet could cause some transverse movement of the associated latch and that in this condition the machine would infringe the patent. For these reasons the patentees have objected that the written particulars supplied by the applicants are insufficient.

The applicants are of course required to supply sufficient written particulars to show that none of the acts for which they seek a declaration could constitute an infringement of the patent. In this context I was referred to the judgment of the Court of Appeal in Mallory v Black Sivalls and Bryson, [1977]

RPC 321, in which it was emphasised that where a declaration of non-infringement is sought on the basis of a description, and that description is capable of referring to more than one article, the description must be completely precise and such as will enable the court to decide that no article corresponding to that description could infringe the patent. I think it follows that where a patent defines a mechanism in terms of its manner of operation the description of another mechanism in respect of which a declaration of non-infringement is sought must also contain sufficient detail of the manner in which that other mechanism operates. However I do not think that the judgment in the Mallory case constitutes an authority which necessarily precludes the granting of a declaration in respect of a mechanism constructed and designed to operate in a manner which does not infringe the patent merely because it may be possible to cause the mechanism to operate in a way which does infringe.

When a declaration of non-infringement has been made, a patentee may find himself in the difficult position of having to decide whether or not a subsequent act by another party falls within the terms of the declaration or lies outside and constitutes an infringement, but his position is really no easier when no declaration has been made. In respect of this particular application, it would appear that the essence of the patentees' case is not so much that the applicants' mechanism may be perversely modified so as to result in infringement of their patent, as that use of the mechanism in practice would inevitably result in infringement either directly or as a consequence of modification of the mechanism, the modification being a deliberate and necessary adjustment made by the operator and/or an inescapable consequence of wear occurring in use of the mechanism.

For the applicants to be able to refute these suggestions they may need to provide further details about their mechanism and its behaviour under operating conditions, but I am of the opinion that, at least in some respects, this could only be

done satisfactorily by adducing evidence, and as I am not convinced at the present time that the objections raised by the patentees are of real substance, I am not inclined to order the applicants to file further particulars at this stage.

In the pleadings the patentees have stated that they intend to show that the mechanism illustrated in Annex 2 could infringe at least claim 1 of the patent, so presumably they are prepared to file evidence in support of that contention. That being so, I consider the best course to follow would be for the normal evidence stages under Rule 74 to proceed, the applicants having already filed their evidence in chief. If, when the patentees have filed their evidence in chief, the applicants feel that there is a case to answer in respect of the patentees' objections they have the right to file evidence in reply and could at that time, if they saw fit, answer at least some of the outstanding questions which were put to them by the patentees.

Although the applicants are not willing to provide the patentees with an example of their mechanism for testing purposes, they have offered to allow the patentees to inspect a mechanism in actual operation if and when a declaration of non-infringement is given. The patentees say that this would not be satisfactory. Clearly it is much more difficult for the patentees to voice their objections to the application when they have not been allowed the opportunity to extensively test the applicants' mechanism, but the applicants are not required by the Statute to do any more than furnish full particulars in writing. Nevertheless I should point out that the onus remains on the applicants to show that none of the acts for which they seek this declaration could constitute an infringement of the patent.

I direct therefore that the normal procedure of filing evidence should be resumed with the patentees having a period of 3 months from the date of this decision within which they may file their evidence in chief.

Dated this 14th day of March 1989

K E PANCHEN
Superintending Examiner acting for the Comptroller



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