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PATENTS ACT 1977

IN THE MATTER OF a reference under
Section 8(1)(a) by Eugene Richard Mitchell in
respect of Patent Application No 8807822 in
the name of Mark John Charles Stevens

DECISION

Patent Application No 8807822 was filed on 31 March 1988 in the name of Mark John Charles Stevens without the assistance of a patent agent and was searched and subsequently published under the serial no GB 2218170A. No request for substantive examination on Form 10/77 was filed and the application was terminated before grant on 6 September 1990.

The current reference under Section 8(1)(a) was initiated by Mr Eugene Richard Mitchell on the filing of a Form 2/77 together with a statement on 8 May 1990 claiming that he is the owner of the invention disclosed in the patent application. The reference proceeded through the usual evidence stages and the matter came before me at a Hearing on 26 April 1993 at which Mr P Colley appeared as counsel for the referrer and Mr Stevens was neither present nor represented.

The specification as filed and published is very short and describes a stud bolt of the type used for clamping materials together. The original claims did not define clearly the monopoly sought but the following amended claim filed on 20 June 1988 was incorporated into the application:

"The Tension Control Stud bolt has a spline attached to its head which is detached by a torsional shear action, when the specified tension is achieved."

Thus, in application, the operator tightens the bolt using the spline and, when a certain tension is reached, the spline shears off to leave a bolt with a mushroom shaped head which cannot easily be removed, for example, by unauthorised persons.

In his opening remarks Mr Colley took me to the applicant's evidence which consists of a declaration by Mr Stevens and six exhibits numbered MS1 to MS6. In his submission exhibits MS1, MS2, MS4 and MS6 are not properly exhibited to Mr Stevens' declaration, MS3 appears to have been certified before somebody unrelated to the preparation of the statutory declaration and, although MS5 is certified by the same person who certified the statutory declaration, the date of the verification of MS5 precedes the date of the statutory declaration by some 9 months. In support of his submission, Mr Colley referred to Order 41, rule 1 in the White Book, which requires that "every affidavit sworn in a cause or matter must be entitled in that cause or matter", and to Order 41 rule 11 which requires that "(1) Any document to be used in conjunction with an affidavit must be exhibited and not annexed, to the affidavit." and "(2) Any exhibit to an affidavit must be identified by a certificate of the person before whom the affidavit is sworn". In Mr Colley's view much of this evidence is hearsay and whilst he did not invite me to strike it out, indeed I indicated I would be reluctant to do so in the absence of the other side, I accept his argument that much of the applicant's evidence is procedurally defective and should be treated with caution.

The applicant and named inventor of application no 8807822, Mr Stevens, is a director of Stevens TCB Ltd, a UK company which was an authorised distributor of a tension control stud bolt supplied by a Dutch company Struckton TCB until the agreement was ended in May 1989.

The referrer Mr Mitchell has an interest in Struckton TCB and alleges that the tamper-proof design of the tension control stud bolt which is the subject of the patent application was devised by him in the course of acting as an agent in connection with the distributorship agreement. In support of his claim Mr Mitchell states in his declaration dated 14 October 1991 that he was the author of the drawing (Exhibit A) dated 18 September 1987 of a tamper-proof bolt similar to that described and illustrated in patent application no 8807822, which drawing also bears a message written by Mr Mitchell to a Mr Ikeda of

the Japanese company K Sakai & Co Ltd, Osaka concerning the nature of the bolt; Mr Mitchell also refers to a more detailed drawing (Exhibit B) dated 20 November 1987 prepared at Mr Mitchell's request by a Japanese bolt manufacturer, Mitsuboshi, who were interested in supplying quantities of the bolt to Struckton TCB through the agency of Mr Ikeda.

Mr Mitchell goes on to say that the design of the bolt shown in Exhibits A and B was conceived by him in response to a request from Unistrut, a British company and that, after Unistrut had expressed satisfaction with samples made by another Japanese bolt manufacturer, Sumitomo, he placed an order for volume production with Mr Ikeda as shown by Exhibit C, after Mr Stevens had been appraised of this development.

Turning to Mr Stevens' account of the invention, he declares that the design of the tamper proof bolt was conceived by him at a meeting with Brian Thomas, a director of Unistrut (UK) and Derek Hindle the then Northern Regional Manager of Unistrut. The fact of this meeting, but not its date or place is confirmed by declarations from both Mr Thomas (MS1) and Mr Hindle (MS6), the former also declaring that Unistrut have never had any business dealings with Mr Mitchell. Mr Stevens states that a drawing (Exhibit MS3) of his design for a tamper proof bolt was made by a fellow Director of Stevens TCB Ltd, Roger Arthur Stokes, who supports this statement in a declaration Exhibit MS4. This drawing is dated "September 1986" but it was more than a year later on 30 September 1987 when this drawing was submitted to Fuchs Schraubenwerke who produced a production drawing (MS5), no explanation of this delay being given.

In his declaration Mr Stevens goes on to dispute the authenticity of the drawing shown in Exhibit A of Mr Mitchell's evidence and denies that he was appraised of developments or shown samples of a bolt made by Sumitomo as stated by Mr Mitchell.

Although Mr Colley disputed much of Mr Stevens' evidence and its reliability, he did not dispute the provenance or the date of the Fuchs Schraubenwerke drawing, namely 30 September 1987, but observed that it was preceded by the Mitchell drawing (Exhibit A) of 18 September 1987; instead Mr Colley concentrated his attack on the Stokes drawing of

September 1986 and to the meeting of Mr Stevens with the Unistrut personnel which preceded it.

Mr Colley pointed out that although there is testimony of a meeting, nothing is exhibited in support; there are no diary entries, minutes or memoranda which could give a date or place to the meeting. As to the Stokes drawing, Mr Colley noted that Mr Stokes does not say when he produced the drawing or whether the drawing was a depiction of the matter discussed between him and Mr Stevens. Mr Colley later took me to the declaration of Mr Garton, a director of Kinnings Marlow Ltd and formerly Marlow Manufacturing, and the drawing (Exhibit E) dated 31 August 1988, prepared by Lancashire Bolt, a sister company of Marlow Manufacturing; comparison of this drawing with the Stokes drawing shows a remarkable similarity. Mr Colley posed the question why, if Mr Stevens was already in possession of the Stokes drawing, should he request such a similar drawing from Marlow Manufacturing nearly two years later. Mr Colley submitted that Mr Stevens' account of the sequence of events which led to the filing of application no 8807822 was inherently implausible with unexplained delays and gaps in the evidence and he went on to contrast the referrer's account of the genesis of the invention.

Although I accept Mr Colley's arguments as to the unreliability of Mr Stevens' evidence and his submission that I can put little weight upon it, it seems to me that the evidence on behalf of the referrer is not beyond criticism.

According to Mr Mitchell, he conceived the design of the tension control stud bolt shown in Exhibit A in response to a request from Unistrut. Mr Colley pointed out that the evidence on behalf of Mr Stevens given by Mr Thomas and Mr Hindle was not as precise and informed as it might have been, nor as conclusive as Mr Stevens stated, but the fact remains that Mr Mitchell's evidence is not supported by any Unistrut personnel or by any letters, minutes, or memoranda which might confirm the link which he claims existed. Further the date of the Mitchell drawing has not been established unequivocally; the original is not on file and there is no supporting evidence from the recipient in Japan, Mr Ikeda. There is however a fax to Mr Ikeda dated 28 October 1987 which refers to the tamper-proof bolt in terms of the round head shape "as explained in September".

There is however a further matter which is not dealt with by either side in the evidence which goes to the nature of the invention the ownership of which is in dispute.

In paragraph 1 of his counterstatement Mr Stevens states that he "was the Applicant and sole inventor of British Patent Application No 8807822.5 which I intentionally abandoned in the face of prior art, especially GB 2156934A and GB 1437383" and in paragraph 2 he goes on to say that "I therefore filed British Patent Application No 8807822.5 relating to my "tamper proof tension control stud bolt only to subsequently find that the concept was already basically known".

The Act makes no provision for the question of validity to be raised in entitlement proceedings but, if the applicant's admission in the counterstatement is correct, and it is not disputed by the referrer, then prima facie the invention is known and neither the original applicant nor the referrer can claim to be the true and first inventor.

In response, when I put this point to Mr Colley, he took the view that the prior art in question is not properly exhibited in the evidence. He went on to say that the application as originally filed was unhelpful and did not adequately define the invention and that the referrer is effectively seeking to submit a new application claiming priority from the filing date of the original application; the referrer is of the view, he explained, that there is a disclosure contained in the drawing beyond which a formulation in words would not constitute new matter in contravention of Section 76 of the Act. In any case, Mr Colley argued, the issue is the ownership of the invention as opposed to the patent and that, as a matter of discretion, the comptroller should allow the referrer to file a fresh application which formulates the invention as disclosed in the drawing.

With regard to Mr Colley's first point, I accept that the prior art in question is not properly exhibited but I am not persuaded that this is relevant. The referrer has had prior art drawn to his attention and has not disputed Mr Stevens' assessment that the invention for which he sought protection in his original application was already known.

The relief which the referrer is seeking, although Mr Colley did not take me to this subsection, is provided for under Section 8(3) which reads:

"Where a question is referred to the comptroller under subsection (1)(a) above and
.....

- (c) any such application is withdrawn before the comptroller has disposed of the reference, but after the publication of the application;

the comptroller may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 76 below, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application".

If I understood him correctly, Mr Colley did not argue that the invention as perceived by Mr Stevens and as defined in the original application could be re-monopolised by Mr Mitchell, but he did suggest the presence of other subject matter in the original drawings which could form the basis of a fresh application in accordance with Section 8(3)(c), although he did not specifically identify the subject matter in question.

I have studied the original application carefully and it is not clear to me that there is any subject matter over and above that which Mr Stevens identified and Mr Colley accepted as already known, nor, as far as I can see, is there any suggestion in Mr Mitchell's evidence of there being any invention other than the general concept of the tamper proof bolt.

It seems to me that, where the referrer is seeking an order Section 8(3)(c) allowing him to file a fresh application in respect of matter comprised in the earlier application, it is incumbent upon him clearly to identify the subject matter of which he is claiming ownership. Any such order which the comptroller might make would have to specify the subject matter

to be included in the new application and it is not sufficient, in my view, for the referrer merely to state that there is subject matter somewhere in the specification to which he is entitled and which could form the basis for a fresh application.

Thus even if, on the balance of probabilities, I had been able to find that the referrer rather than Mr Stevens is entitled to the invention, the referrer has not in my judgement identified the invention of which he claims ownership.

This reference therefore fails and it remains only for me to consider the matter of costs. Although the original applicant has been caused some inconvenience in this action, there is little by way of evidence and he did not attend the Hearing. I therefore award Mr Stevens the sum of £300 (three hundred pounds) and direct that this sum be paid to him by the referrer, Eugene Richard Mitchell.

Dated this 20 day of May 1993

P J Herbert
Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE