

Patents Act 1977

Opinion
Number

06/23

OPINION UNDER SECTION 74A

Patent	GB 2554714
Proprietor(s)	Lee Jackson
Exclusive Licensee	
Requester	Saunders & Dolleymore LLP
Observer(s)	Mewburn Ellis
Date Opinion issued	23 October 2023

The request

1. The comptroller has been requested by Saunders & Dolleymore LLP to issue an opinion as to whether GB 2554714 B (the Patent) is valid.

The patent

2. The Patent was filed 6th October 2016. The Patent was granted 26th January 2022 and remains in force.

3. The Patent is entitled 'Worktop fitting' and relates to a jig providing a template for accurately cutting mating worktop surfaces. The Patent finds particular advantage in accurately cutting worktop surfaces that are *out-of-square* i.e. at an angle that is other than 90°.

4. The jig, illustrated in figure 1 below, comprises a body having a guide template 61 and a plurality of peg holes 66, 67; these features are typical of jigs used to cut worktops. In use, a female cut is made in a first workpiece by aligning the jig on the first workpiece using peg holes 66 and 67, wherein an edge 61a of the guide template provides a guide for the female cut. A male cut is made in a second workpiece by aligning the jig on the second workpiece using peg hole 68, wherein an edge 61b of the guide template, oppose to edge 61, provides a guide for the male cut.

5. The jig is characterised by facilitating out-of-square joints; this is primarily achieved by the provision of a positioning member 70, for example a pointer 74, as shown in figure 2 below. The pointer may be used to mark the start of the female cut to the first workpiece by positioning both workpieces in a corner and marking, with the pointer, the intersection between the first and second workpiece. Perhaps more significantly, the pointer is used to mark the start of the male cut in the second workpiece 2 which would be scribed onto this workpiece using the female cut as a template. The pointer defines a datum point 24' on the second workpiece about

which the jig is rotated until edge 61b is parallel to a marked line of the cut. Once properly aligned with respect to the second workpiece the jig is clamped in place and the positioning member is moved such that it does not interfere with a cutting/routing tool.

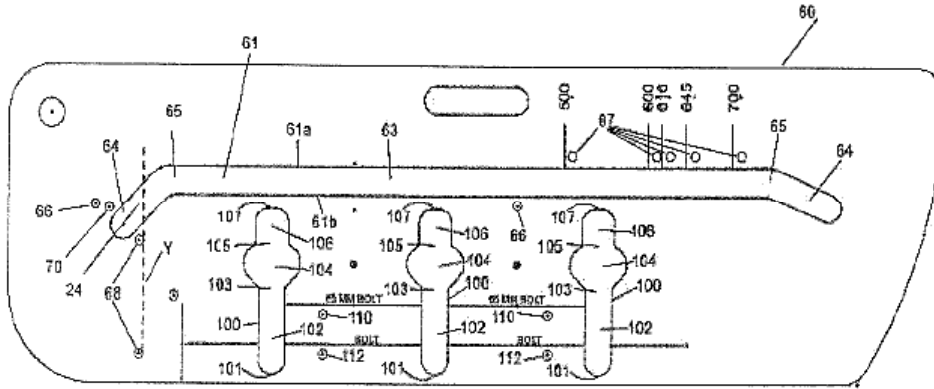


Figure 1

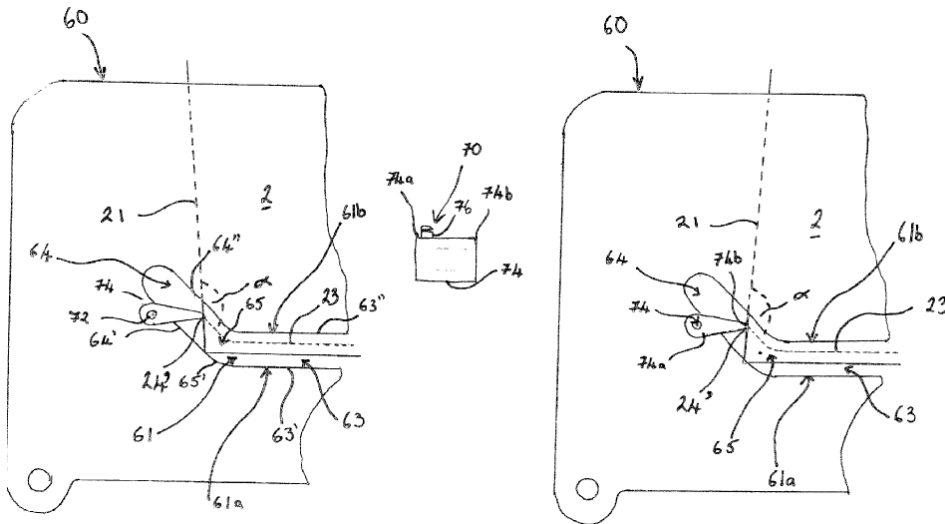


Figure 2

6. Throughout the Patent the start point 24' of the cut is arranged with respect to presentation edge 21; therefore a left-to-right cut, referred to as a *push cut*, is necessary.

7. The Patent has two independent claims; claims 1 and 25 relating to an apparatus and method, respectively. Adopting the references used by the Requester the independent claims read as follows;

Claim 1.

1.1 A jig for use in cutting an edge on a first workpiece and a complementary edge on a second work piece,

1.2 said jig comprising a guide template for use in cutting said edges,

1.3 *and further comprising a positioning member for, in use, aligning the jig with a workpiece to be cut,*

1.4 *wherein the positioning member is movable between a first position in which it is positioned to at least partially obstruct the guide template to define a datum point for the start point of the cut,*

1.5 *and a second position in which it is positioned clear of the guide template so as to allow a cutting or routing operation to be performed using the guide template starting at said starting point.*

Claim 25.

25.1 *A method of cutting a joining edge on a second workpiece to complement a joining edge present on a first work piece,*

25.2 *the method comprising the steps of: a) deriving a line of cut on said second workpiece based on the joining edge present on the first workpiece and the required joining angle of the second workpiece relative to the first work piece;*

25.3 *b) arranging on the second workpiece a jig having a cutting guide template and a positioning member;*

25.4 *c) cutting the second workpiece using said guide template to provide said complementary joining edge;*

25.6 *wherein the step b) comprises arranging the positioning member to at least in part obstruct the cutting guide template to define a datum point for the start point of a cut and aligning the jig relative to the second workpiece using the positioning member,*

25.7 *and wherein the step c) comprises moving the positioning member from the cutting guide template to enable cutting in the guide template from the start point.*

Claim construction

8. Before considering the issues in the request I need to construe the claims of the Patent, which is to say I must interpret them in the light of the description and drawings as instructed by Section 125(1). In doing so I must interpret the claims in context through the eyes of the person skilled in the art. Simply put, I must decide what the person skilled in the art would have understood the patentee to be using the language of the claims to mean. This approach has been confirmed in the decisions of the High Court in *Mylan v Yeda*¹ and the Court of Appeal in *Actavis v ICOS*².

9. I consider the person skilled in the art to be a worktop jig manufacturer or

¹*Generics UK Ltd (t/a Mylan) v Yeda Research and Development Co. Ltd & Anor* [2017] EWHC 2629 (Pat)

²*Actavis Group & Ors v ICOS Corp & Eli Lilly & Co.* [2017] EWCA Civ 1671

worktop installer.

10. The Requester asserts that the limitation of 1.4 and 25.6 relates to a datum point being *suitable* for the start point of a cut. In their argument the Requester refers to the Manual of Patent Practice section 2.12 and 2.12.2 providing the following extracts, including their emphasis, in the observations in reply;

2.12 A claim to an apparatus for a particular purpose (e.g. for carrying out the process of another claim) is normally construed as a claim to apparatus suitable for that purpose. The words do not restrict the claim to the apparatus when used in that way (L'Air Liquide Societe's Application, 49 RPC 428). Apparatus which otherwise possessed all of the features specified in the claims, but which would be unsuitable for the stated purpose, or which would require modification to enable it to be so used, should not normally be considered anticipating the claim. For example, if a claim refers to "A hook for a crane" this implies particular dimensions and strength in the hook. Therefore a fish-hook could never anticipate the claim, but a hook having the necessary dimensions and strength and possessing all the other features specified in the claim would deprive the claim of novelty whether it was stated to be for use in a crane or not.

2.12.2 ... The question in each case is whether the apparatus, as it stands, is suitable for use in a particular way. If the apparatus has to undergo physical modification before it can be used, then it is not suitable for that particular use.

11. There is no disagreement from the Observer. Furthermore, I have no problem in construing 1.4 and 25.6 as suggested by the Observer.

12. Additionally, the Requester has assumed that the limitation of 1.5 and 25.7 includes the removal of the positioning member from a body of the jig. This feature is evident throughout the Patent and is unopposed by the Observer. Similarly, I find the Requesters assessment accurate.

13. There is no contention over how the remainder of the claims 1 or 25 ought to be construed. However, I note that claim 1, particularly 1.3, defines the jig in terms of its interaction with the workpiece. It is my understanding that the term '*in use*' used in 1.3 merely gives some context to the jig, and in particular the positioning member with respect to its application. In the absence of any specific method steps, I do not think the term '*in use*' specifically limits the claim to the use of the jig with the workpiece as would be associated with the term '*when used in*', or similar. Claim 25, however, clearly and unambiguously limits the use of the jig with respect to an associated workpiece.

14. I find the language of the remaining claims plain, presenting no further issues regarding construction.

The request

15. The opinion request refers to the following prior art:

A1. *Trend COMBI650 Instruction Manual dated 2002.*

A2,A2a. <https://www.youtube.com/watch?v=OCs7RdGFP2c> and various screen shots, dated 20th January 2010.

A3. Website extract from: <https://community.screwfix.com/threads/what-is-the-best-kitchen-worktop-jig.103132/>, "What is the best Kitchen Worktop jig?", dated 20th-23rd March 2008.

A4. Website extract from: <https://www.diynot.com/diy/threads/out-of-square-worktop-joints.69890/>, "Out of square worktop joints", dated 22nd November 2006 to 27th November 2007.

A5. Website extract from: <https://www.diynot.com/diy/threads/help-with-worktop-jigs-routers-biscuit-joints.235643/>, "Help with worktop jigs, routers, biscuit joints", dated 6th to 12th August 2010.

A6. Website extract from: <https://web.archive.org/web/20021024171543/http://www.trendmachinery.co.uk/combijigs/>, dated 24th October 2002.

A7. Website extract from: <https://web.archive.org/web/20021027105010/https://www.trendmachinery.co.uk/combijigs/combi650.shtml>, dated 27th October 2002

A8. Extract from Trend Routing catalogue 2000, dated 2000.

16. The Requester alleges that the Patent is invalid in respect to the Trend Combi 650 (the Product), disclosed in document A1, and relies on the remaining documents to demonstrate that the Product was available to the public prior to the filing date of the Patent.

17. Observations were filed 1st September 2023 by Mewburn Ellis LLP, having been awarded an extension of time to submit said observations. Observations in reply were filed 15th September 2023.

18. Observations in reply are strictly limited to matters raised in the observations, and anything new will not be considered. The observations in reply filed 15th September 2023 include the following submissions;

A7, A8. Video A. <https://www.youtube.com/watch?v=V57rRFypRuQ> and various screen shots, dated 12th September 2023.

A9. A3. Website extract from: <https://www.finewoodworking.com/2011/07/15/climb-cutting-dont-believe-the-naysayers>, Finewoodworking, "Climb-Cutting: Don't Believe the Naysayers" dated July/August 2011.

A10. Video B. <https://www.youtube.com/watch?v=mrE4HyXiwqs>, dated 16th December 2016.

A11. Website extract from: <https://www.formica.com/en-gb/articles/commercial-interiors/what-is-postforming#:text%20term%20postforming%20is%20used,cylindrical%20conca>

[ve%20or%convex%20curves](#), undated.

A12. Witness statement dated 14th September 2023.

19. The Observer asserts that performing a right-to-left cut using a router, referred to as a *climb cut*, makes the router difficult to control and dangerous to operate. The Observer further asserts that climb cutting increases the likelihood of the router blade overheating and failing catastrophically. The Observer concludes that climb cutting would inevitably result in a ruined worktop that would be unusable.

20. A7 and A8, submitted by the Requester, attempt to demonstrate that a climb cut may be achieved effectively with a Tend Combi 640H jig, which A12 attests is much the same as the Product. A9 and A10 merely illustrate the common general knowledge of the skilled person in regard to climb cutting and worktop nomenclature.

21. The observations in reply are restricted to addressing arguments set out in the Observations and are therefore acceptable. However, where the publication date of the submission cannot be substantiated or is later than the filing date of the Patent then the appropriate consideration will be given.

The Product

22. The Requester has provided a comprehensive description of the Product in reference to the instruction manual provided at A1. The Product, entitled Trend COMBI650, is a jig used in conjunction with a router, to cut worktops. The Product comprises a guide template, a plurality of location bushes and a mitred end stop to facilitate out-of-square joints. The Product is illustrated in figure 3 below, which is an extract from A1.

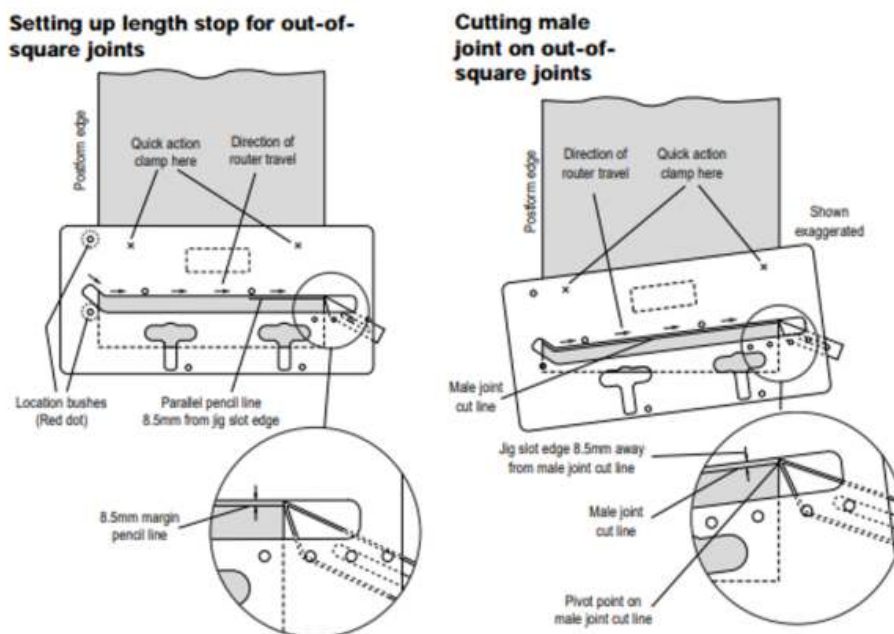


Figure 3

23. In order to create an out-of-square joint a female cut is first provided on a first

workpiece; this is achieved by arranging the jig on the first workpiece such that appropriate location bushes abut a postformed edge, and a length stop is set with respect to the male workpiece, to ensure a correct cut width is achieved. The jig is clamped in place on the first workpiece, the length stop is removed, and a router is used to perform a push cut from left to right along the guide template indicated by the arrows shown in figure 3.

24. A postformed edge typically relates to a laminated worksurface wherein postforming concerns shaping a composite fibreboard prior to application of a laminate surface. When reading A1 the skilled person would understand that the jig is not intended to be exclusively used with laminated workpieces and instead could be used with any work surface that requires a routing operation. Therefore I understand the term '*postformed edge*', when used in A1, to relate to any presentation edge of the workpiece i.e. the edge which is visible when installed.

25. A male cut is made by overlaying a second workpiece onto the female cut and scribing the profile of the female cut onto the second workpiece. Location bushes are used with respect to a second workpiece presentation edge to ensure the jig is orthogonal with the presentation edge, a mitred edge of the length stop is positioned at the end of the cut line and secured thereby creating a length stop datum. The location bushes may then be removed allowing the jig to rotate about the datum such that an appropriate guide surface of the guide template is parallel with the scribed profile. The jig is then clamped to the second workpiece and the length stop removed before a push cut is made along the guide template with the router.

26. It is important to note that A1 exclusively directs the user to use a push cut and throughout, but particularly at pages 8 and 15, specifically teaches away from any alternative direction cut.

27. A1 is dated 2002 and the product is either discussed or otherwise disclosed with respect to A2-A8, however none of documents A2-A8 illustrate, or otherwise discuss, how the Product is used with the mitred end stop. However, on the balance of probability it appears that the Product was available to the public prior to the filing date of the Patent and particularly in light of the date on A1, this is understood to include the tapered length stop and associated instructions for use. It is noted that the Observer does not contest prior use.

Novelty – the law

28. The requester alleges that claims 1-30 lack novelty in light of the disclosure of document A1 provided with the request.

29. Section 1(1)(a) of the Act reads:

A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -

(a) the invention is new;

30. The relevant provisions in relating to novelty are found in section 2(1) and section 2(2) which read:

An invention shall be taken to be new if it does not form part of the state of the art.

The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

Inventive step – the law

31. The Requester additionally alleges that claims 4, 25, 30, 32, 33 and 34 lack an inventive step in light of the disclosure of document A1 provided with the request. However, it is noted that the request lacks any significant reasoning with regard to inventive step.

32. Section 1(1)(b) of the Act reads:

1(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say

(a) ...

(b) it involves an inventive step;

33. The provisions in relation to inventive step are found in section 3 of the Act which states:

3. An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above)

Is the Patent novel, and does it involve an inventive step with respect to the Product?

34. The Requester argues that A1 discloses features 1.1-1.5 of claim 1 and similarly discloses features 25.1-25.7 of claim 25. There is no contention with respect to features 1.1-1.3 and 1.5 or 25.1-25.4 and 25.7. Furthermore it is clear to me that features 1.1-1.3, 1.5 and 25.1-25.4, 25.7 are entirely typical of worktop jigs and are clearly evident in A1. Therefore I will not labour on these features any further, instead I will direct my consideration towards the characterising features of the Patent, specifically those set out in 1.4 and 25.6.

35. The Requester argues, with respect to 1.4, that the mitred edge of the length stop of A1 is positioned to define a datum point that would be *suitable* for the start point of a cut, and the skilled person could perform a climb cut from this datum point. Consequently, the Requestor alleges that the skilled person *could* use the datum point marked by the mitred edge of the length stop to mark the start of a climb cut.

36. Notwithstanding the argument set forth in the preceding paragraph, the Requester alleges that it would be obvious to the skilled person that a climb cut

could be used. Therefore, accordingly, the Patent lacks the necessary inventive step.

37. The Observer argues that the datum point defined by the mitred edge of the length stop cannot be used as a starting point for the cut. In doing so the Observer relies on the text of A1 which stipulates that using a climb cut would be contradictory to the teaching of A1. The Observer further asserts that performing a climb cut, using a router, makes the router difficult to control, and consequently dangerous to operate. The Observer additionally claims that climb cutting increases the likelihood of the router blade overheating and failing catastrophically. The Observer concludes that climb cutting would inevitably result in a ruined worktop that would be unusable.

38. The Requester, in their observation in reply, relies on A7 and A8 in attempting to demonstrate that cutting a workpiece with a similar jig to the Product, whilst using a climb cutting operation, is achievable. The Requester additionally relies on A9 and A10 to establish the benefits of climb cutting in specific situations. It is noted that whilst A7 is illustrative, it does not form part of the state of the art and so cannot be considered for either novelty of inventive step.

39. A push cut, illustrated on the left of figure 4 which is an extract from A9, is the conventional way to cut a worksurface. During a push cut the router is pushed along the workpiece in an opposite direction to the rotation of the bit; this ensures a quick and smooth cut and is also considered safer. When using a push cut, depending on the orientation of a grain of the worksurface, a phenomenon known as tear-out can occur. Tear-out is caused by an aggressive push cut and can cause unsupported wood fibres ahead of the bit to tear out. Climb cutting, illustrated on the right of figure 4, can mitigate tear-out however it requires a greater degree of skill in order to control the router. Push cutting and climb cutting are both well-known methods for cutting workpieces and the skilled person would be familiar with both methods.

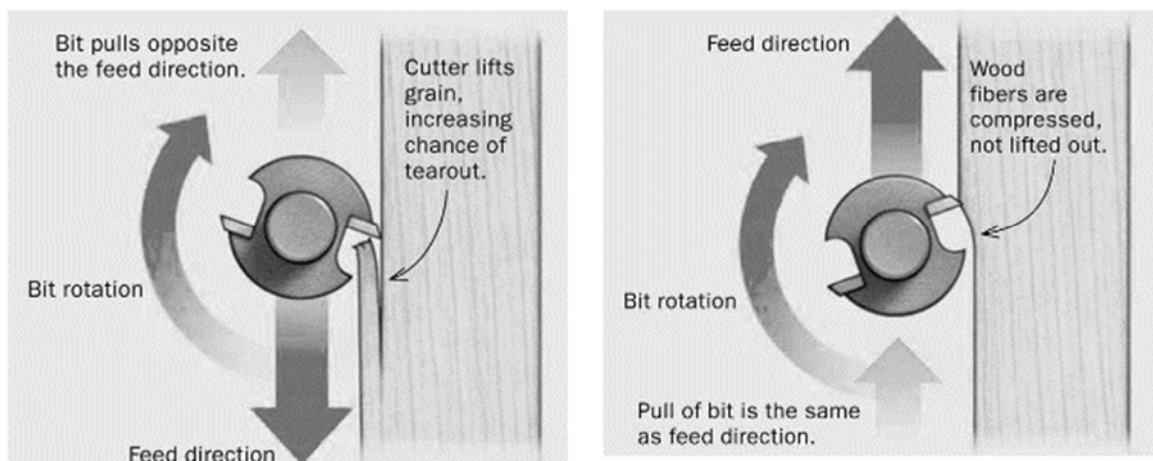


Figure 4

40. Claim 1 of the Patent is directed to an apparatus and does not have any limitation with respect to how it is to be used. The skilled person, when using the jig disclosed in A1 would position the jig as directed in A1, positioning the mitred end of the length stop at the end of a potential push cut. However, it would be expected that the skilled person would use the best cut suitable for a particular worksurface composition and, particularly when using non-engineered worksurfaces, would

consider cutting techniques other than push cutting. Marking an end of a potential push cut, as clearly depicted in A1, would inevitably mark a suitable start for an alternative cut such as a climb cut. Therefore claim 1 is not novel with respect to A1.

41. However, in consideration of claim 25 which clearly and unambiguously limits the use of the jig with respect to an associated work piece, I must consider the Product in context of the disclosure of A1, including the prescribed methodology of use. Throughout A1 the reader is instructed to use a push cut rather than a climb cut, specifically;

Page 8 reads; *“...for certain joints the worktop will need to be inverted so that all cuts are made into the postformed edge, never out through it.”* and *“Important! In order to prevent breakout of the laminate, rotation of the cutter and feed direction must always be into the postform edge of the worktop.”* .

Page 9 and 11 reads; *“Plunge router and cut joint in a series of passes, feeding left to right.”*

Page 10 reads *“...to cut a male right hand joint, the worktop must be inverted. Remembering to cut into the postformed edge”,* and *“all cuts must be fed left to right”*.

42. The passages outlined in paragraph 41 above, and other passages throughout A1, go beyond simply promoting a push cut, to explicitly teaching against using a climb cut; this is not merely some trivial instruction but is represented, with emphasis, throughout A1. Therefore this is understood to be a primary feature of A1 and the disclosed use of the Product.

43. Consequently, whilst it may be argued that the common general knowledge of the skilled person may lead the skilled person to perform a climb cut using the Product disclosed in A1, the disclosed method explicitly leads the skilled person away from this overarching concept. Therefore the datum point defined by the mitred length stop is not suitable, with respect to A1, for starting a cut. Similarly, the skilled person would not deem it a suitable point for starting the cut in light of the teaching of A1. Therefore the Patent as set out in claim 25 is new and involves an inventive step with respect to A1. It follows that claims 26-34, which are dependent on claim 25, are similarly novel and inventive with respect to A1.

44. The features of claims 2, 13-24 are typical features of worktop jigs having a guide channel comprising a straight section and an inclined section. Furthermore, these features are clearly disclosed in A1; see figure 3 above for example.

45. In A1 the length stop is used as a pivot point about which the jig is rotated; this is clearly disclosed at the fifth paragraph, page 11. Furthermore, figure 3 above clearly discloses the features of claims 3, 5-7.

46. Claim 4 does not place any restriction on which components of the jig comprise a metallic material. A2 explicitly states that the Product is provided with aluminium location bushes. Therefore the Product, which incorporates the location bushes which are used for positioning the jig with respect to a workpiece, discloses the feature of claim 4.

47. In A1 the length stop is secured to the jig using a countersunk bolt, washer and knob used in conjunction with a hole in the jig. The point of the length stop is positioned such that it lines up with an 8.5mm margin line as illustrated in figure 3 above. The illustration shows the length stop having a longitudinal channel wherein a bolt appears to secure the length stop to the jig via a hole. The skilled person would understand that the bolt, in conjunction with the longitudinal channel, would permit the length stop to slide and pivot with respect to the jig in order to accommodate different width worksurfaces. Once the jig is secured, prior to cutting, the length stop is removed from the jig. Therefore the features of claims 8-12 are implied by A1.

Opinion

48. In my opinion, on the basis of the evidence put forward, claims 1-24 are invalid with respect to Section 2 of the Act.

49. It is also my opinion, on the basis of the evidence put forward, that claims 25-34 are valid with respect to Sections 2 and 3 of the Act.

Application for review

50. Under section 74B and rule 98, the proprietor may, within three months of the date of issue of this opinion, apply to the comptroller for a review of the opinion.

Sean OConnor
Examiner

NOTE

This opinion is not based on the outcome of fully litigated proceedings. Rather, it is based on whatever material the persons requesting the opinion and filing observations have chosen to put before the Office.