

OPINION UNDER SECTION 74A

Patent	GB2428272 and GB2434830
Proprietor(s)	E T Paine
Exclusive Licensee	Unika
Requester	ET Paine
Observer(s)	Dummett Copp on behalf of Quaytech UK Unlimited
Date Opinion issued	18 January 2024

The request

1. The comptroller has been requested by E T Paine “the requester” to issue an opinion as to whether the claims of GB2428272B “the first patent” are infringed by the “ZipClip” bolt holder sold by Quaytech UK Unlimited. The requester has also asked me to consider the validity of the claims of his patent GB2434830B “the second patent” in light of prior art documents US4332495A (D1), DE3146805A1 (D2) and US2004009036A1 (D3) which accompanied the request. The requester is the proprietor of both GB2428272B and GB2434830B.
2. The requester also included a letter from Lawbriefs acting on his behalf to Quaytech UK Unlimited dated 14th December 2022, which expressed his concern that the ZipClip product infringed the claims of the first and second patents.
3. Also attached to the request was a reply from Dummett Copp on behalf of Quaytech UK Unlimited dated 28th December 2022, “the Quaytech response”.

Observations

4. Observations were filed by Dummett Copp on behalf of Quaytech UK Unlimited on 23rd November 2023. Observations in reply were filed by Edward Paine on 29th November 2023.

The Patents

5. The first patent and the second patent are a parent application and divisional application. The claims of the first patent relate to a holder for use when joining two component parts of an assembly together, with particular relevance to joining two parts of a worktop e.g. in kitchen installations. The patent sets out the prior art situation where a female and male component parts are abutted along a joint line and joined using wood adhesive. On the underside of the worktop, recesses

4, 5 and 6 with an oval shaped head are formed and a screw or bolt assembly 10 is used to hold the component parts in place while the adhesive dries. Once the bolts have been tightened the worktop is positioned with the laminate on the upper side. It can be difficult to access the bolts if they become loose for any reason once the worktop has been placed in its final position. The invention seeks to mitigate the problem of loose bolts by providing a holder which secures the bolts snugly in the recess and holds them in place.

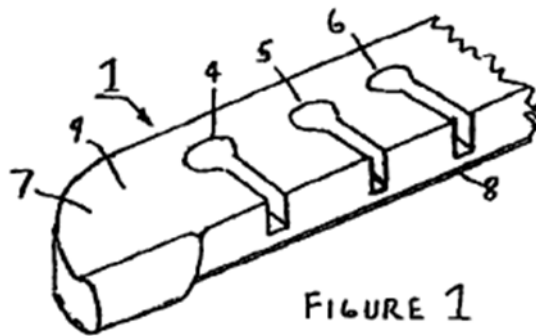


FIGURE 1

6. Figure 1 shows the recess formed in the underside of the female component of the worktop, which faces upward in this figure.

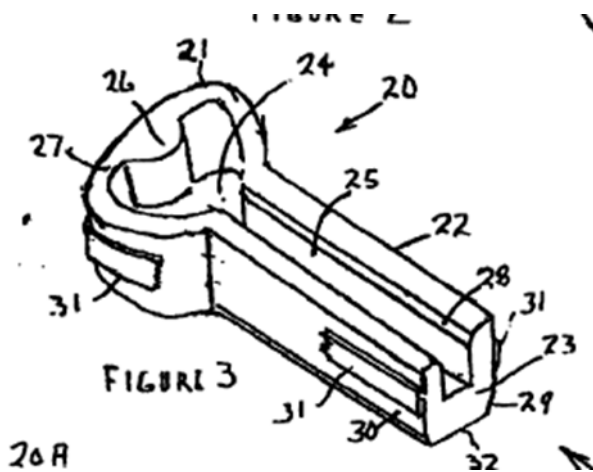
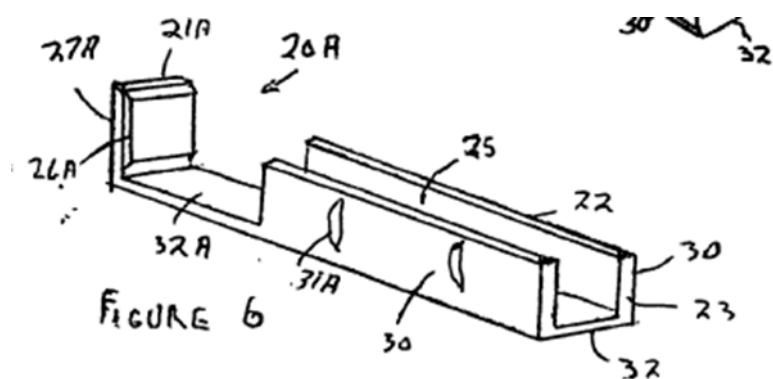
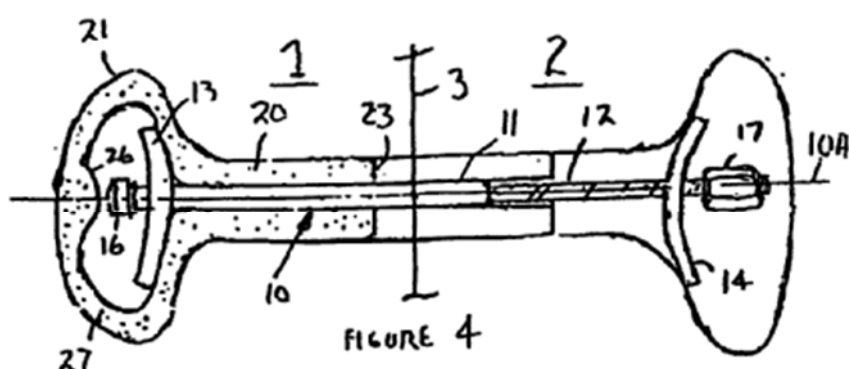


FIGURE 3

7. Figure 3 shows one embodiment of a holder which is used to secure the bolt within the recess.



8. Figure 6 shows a second embodiment of the holder.



9. Figure 4 shows the holder 10 positioned in the recess in component 1 with the tightening bolt being held in place. The component parts 1 and 2 are joined along line 3.

10. The claims of the second patent relate to a method of joining the worktop parts together using a bolt holder to hold the bolt in the recess. The description and figures of the first and second patents are the same.

Scope of the opinion

11. Section 4.2 of the Opinions Manual sets out that any observations should be confined to the issues raised by the request and should not broaden the scope of the opinion by raising new issues. If an observer wishes to explore validity issues not raised by the requestor then they must file a separate request.

12. Using screws to jam the bolt head in position was part of the prior art acknowledged in the description of GB 2434830B. The observations set out a number of arguments as to why this disclosure anticipates claim 1. However, since this is not something the requester has asked me to consider I feel it broadens the scope of the opinion by raising issues not set out in the request. As such I will not consider these arguments in this opinion.

13. The Quaytech response makes the brief suggestion that a user's hand or Blu Tack™ may potentially be used as bolt holders. In the absence of a clear request to consider whether these scenarios show a lack of validity of the claims on GB2434830B I do not consider it appropriate to give my opinion here.
14. For the same reasons I also do not consider it appropriate to address the issues of added matter raised by the observer in their observations beyond the extent that it may be necessary to construe the claims.
15. Since there are no substantive arguments in the request relating to inventive step I have restricted the validity assessment to the issue of whether the documents show a lack of novelty in claim 1.

Allowance of the request

16. Section 74A(3) of the Patents Act 1977 provides that:

(3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so;

(a) in such circumstances as may be prescribed, or

(b) if for any reason he considers it inappropriate in all the circumstances to do so.

17. Rule 94(1) of the Patents Rules 2007 provides that:

(1) The comptroller shall not issue an opinion if—

(a) the request appears to him to be frivolous or vexatious; or

(b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.

18. Rule 94(1)(b) requires that the question upon which opinion is sought appears to have been sufficiently considered in any relevant proceedings for the opinion request to be refused. What constitutes "relevant proceedings" is set out in section 3.3 of the Opinions manual¹ which states that "normal pre-grant examination of applications at the IPO or EPO does not constitute a relevant proceeding under Rule 92". Therefore, the normal pre-grant examination stage does not constitute a relevant proceeding under rule 92.
19. However, section 3.4 of the Opinions manual explains that an opinion request should be refused if the request does no more than repeat arguments already considered pre-grant. Allowing such a request is considered inappropriate and should be refused under section 74A(3)(b).
20. It is noted that D1 was cited during prosecution of this application at search stage as an X citation and at first exam as a novelty citation. I thus consider this

¹ <https://www.gov.uk/government/publications/opinions-manual/opinions-manual>

document to have been fully considered for novelty and inventive step during examination of the application. No new question has now been raised on the grounds of this prior art. As such I shall follow the hearing officer's decision in [BL O/370/07](#) and decline to issue my opinion on whether US4332495 shows a lack of novelty in the claims of GB2434830B.

Infringement of GB2428272

The law

21. Section 60 Patents Act 1977 governs what constitutes infringement of a patent; Section 60(1) reads:

- a. *Subject to the provision of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say -*
 - (a) *where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;*
 - (b) *where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;*
 - (c) *where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.*

22. In the Supreme Court in *Actavis v Eli Lilly*² Lord Neuberger stated that the problem of infringement is best approached by addressing two issues, each of which is to be considered through the eyes of the notional addressee of the patent in suit, i.e. the person skilled in the relevant art. Those issues are:

- (i) *does the variant infringe any of the claims as a matter of normal interpretation; and, if not,*
- (ii) *does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial?*

23. If the answer to either issue is “yes”, there is infringement; otherwise there is not.

Claim construction

24. Claim 1 reads as follows:

² *Actavis UK Limited and others v Eli Lilly and Company* [2017] UKSC 48

A holder for an elongate fastener member such as a bolt, the holder comprising a head portion and an elongate body portion extending from the head portion, the elongate body portion having elongate sidewalls and an elongate base defining an elongate recess for the insertion therein of the bolt alongside the sidewalls and the base when used in conjunction with the holder, the bolt including a head end having an outwardly facing end surface, the head portion of the holder being arranged to bear against the outwardly facing end surface being such that when the head portion of the holder bears against the outwardly facing end surface the bolt will be held fixed within the holder.

25. Before considering the infringement and validity issues raised in the request, I need to construe the claims of the patent – that is to say, I must interpret them in the light of the description and drawings as instructed by Section 125(1):

125(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

26. In doing so I must interpret the claims in context through the eyes of the person skilled in the art. Ultimately the question is 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 recent decisions of the *High Court in Mylan v Yeda*³ and the *Court of Appeal in Actavis v ICOS*⁴.

27. I will deal with the infringement and validity issues set out in the request individually and construe the claims of each patent as I do so.

28. When construing claim 1 of the first patent, the observer has commented that claim 1 defines the features of the bolt holder by reference to a bolt with which the bolt holder may be used. I agree that this is the case, in particular claim 1 refers to an interaction of the holder with the “outwardly facing end surface” of the bolt head. The requester has made no comments on this matter. As pointed out by the observer, it is clear that the “outwardly facing end surface” of the bolt is an end surface which faces in a direction away from the opposite tip end of the bolt, i.e. facing in a direction away from the end to which the nut 17 is secured. I agree with this interpretation. When in use together with a bolt, the bolt holder has a part of the head portion which bears against the outwardly facing end surface of the bolt. The head portion of the holder is clearly labelled part 21 in the embodiment of figure 4, or clearly labelled “modified head portion” part 21A in the embodiment of figure 6.

29. The observer has commented that an amendment from the phrase “the head portion being arranged to secure the head of the fastener member” to “when the

³ Generics UK Ltd (t/a Mylan) v Yeda Research and Development Co. Ltd & Anor [2017] EWHC 2629 (Pat)

⁴ Actavis Group & Ors v ICOS Corp & Eli Lilly & Co. [2017] EWCA Civ 1671

head portion of the holder bears against the outwardly facing end surface the bolt will be held fixed within the holder” adds subject matter as the head portion is no longer required to secure the bolt. The requester has not provided a reply to this observation. Although I do not intend to fully address the issue of added subject matter as explained above, I will consider how best to construe this part of the claim.

30. It is clear from page 3, lines 12-15 that the protrusion 26 which bears against the head 16A of the bolt 10 is designed to "assist in snugly retaining bolt 10 within recesses **24, 25**". Thus it is clear to the skilled person that the protrusion snugly retains the head in part 24, but also assists in retaining the rest of the bolt 10 in recesses 24, 25. When referring to the second embodiment shown in figure 6, the description describes the inwardly extending side wall 26A as carrying out a similar function, to "trap the head of a fastener member, such as bolt 10 within the holder 20A". Page 5, lines 6-8, when referring to the worktop being positioned with the recesses facing towards the bottom, states "The use of the insert or holder of the invention ensures that the bolt 10 is securely held suspended within the recess during assembly of the worktop components".
31. The observer argues that the head portion bearing against the outwardly facing surface of the bolt keeps the head end of the bolt engaged with the thrust washer and thus prevents it from turning as the bolt is tightened. They assert that without this feature the bolt would simply rotate in the holder when attempting to tighten the nut. They consider that when the claim states the bolt is "fixed within the bolt holder", it means the bolt is fixed against rotation. I do not agree with the observer that the bolt is only "held fixed within the holder" by engagement of the bolt with the thrust washer, or that the bolt is only held "fixed" if it is fixed *against rotation*. I do however agree with the observer that the description of the thrust washer 13 on page 1, lines 18-22 is intended to carry over to the thrust washers used in the invention, and that the skilled person would understand this to be so. That is, the thrust washer is provided with a hole shaped to complement the shape of the head of the bolt (e.g. square) to stop the bolt rotating within the washer, and the washer will be prevented from rotating within the holder or recess by means of its extended wings. The head of the bolt will come into contact with the hole in the washer as the bolt is tightened. Thus the bolt is fixed *against rotation* within the bolt holder and the recess by the thrust washer. Until the point of tightening where the bolt head comes into contact with the cooperating hole in the washer it is envisaged that the nut may be freely rotatable on the thread of the bolt. The skilled person would understand from the description of the invention that the holder is intended to snugly retain the bolt in the recess so that it does not come loose and fall out, not necessarily to fix it *against rotation*, which is clearly the job of the thrust washer. The bolt is held in the holder by friction between the bolt and the walls of the holder, including the part of the head portion which bears against the outwardly facing surface of the bolt head. In both embodiments the thrust washer 13 is still expected to be present to carry out the additional function of fixing the bolt against rotation when the nut is tightened. I consider the phrase "held fixed within the holder" to mean the bolt is retained within the holder so that it does not come loose or fall out. This much is clear from the original description of the invention and in my opinion

does not add to what the skilled person would have been taught by the original description and claims.

The alleged infringing product

32. The requester expressed concern that marketing and selling of the ZipClip product shown below infringes the claims of the first patent.



33. As can be seen in the figures of the Zipclip holder above, it is designed to clip over the elongate shaft of the bolt and the flexible wings grip the sides of a preformed recess on the underside of a worktop to secure the shaft, and thus the bolt, in position in the recess.

34. The requester argues that the ZipClip appears to do the same job as his patent bolt holder. He has not made any comment as to the technical features of the holder required by the claims on his patent and whether he considers them to be present in the ZipClip.

Does the ZipClip infringe the claims of the patent as a matter of normal interpretation?

35. The observer has helpfully labelled what they consider to be the features of claim 1 and I will reproduce that below to aid with my assessment of infringement:

[B1.1] *A holder for an elongate fastener member such as a bolt, the holder comprising*

[B1.2] *a head portion and an elongate body portion extending from the head portion*

[B1.3] *the elongate body portion having elongate sidewalls and an elongate base defining an elongate recess for the insertion therein of the bolt alongside the sidewalls and the base when used in conjunction with the holder,*

[B1.4] *the bolt including a head end having an outwardly facing end surface,*

[B1.5] *the head portion of the holder being arranged to bear against the outwardly facing end surface,*

[B1.6] *the said outwardly facing end surface being such that when the head portion of the holder bears against the outwardly facing end surface the bolt will be held fixed within the holder.*

36. The observer asserts that the ZipClip holder does not have a “head portion” in the sense of B1.2. Nor does it have any portion which is arranged to contact the head of a bolt. The device also lacks a feature arranged to bear against the outwardly facing end surface of the head of a bolt B1.5 and B1.6.

37. I am in agreement with the observer that there is no part of the ZipClip holder which could be described as a “head”, it is a single elongate piece of consistent cross-sectional area. Even if the ends of the elongate portion were considered to be “heads” there is no part of this device which is arranged to bear against the *outwardly facing end* of a bolt as understood from my construction of the claim. The ZipClip holder has a cylindrical section which receives the shaft of the bolt through an elongate opening and largely encircles the shaft of the bolt, clipping it within the holder. As such it lacks features B1.2, B1.5 and B1.6. In my opinion, as a result of normal interpretation of the claims, the ZipClip holder does not infringe claim 1 of the first patent.

Does the ZipClip device infringe the patent because it differs in an immaterial way?

38. In *Actavis v Eli Lilly*² the questions to ask when determining whether something is an immaterial variation were set out as follows:

i) Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, ie the inventive concept revealed by the patent?

ii) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?

iii) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

39. In order to establish infringement in a case where there is no literal infringement, a patentee would have to establish that the answer to the first two questions was “yes” and that the answer to the third question was “no”.

40. The variations between the claims of the invention and the ZipClip product are features B1.2, B1.5 and B1.6. Namely, a head portion and an elongate body portion extending from the head portion and a specific part of the head portion of the holder bearing against an outwardly facing end surface of the bolt so that

when the head portion of the holder bears against the outwardly facing end surface the bolt will be held fixed within the holder. When construing the claim above I have understood the meaning of "fixed" to be to hold the different parts of the bolt snugly within recesses 24 and 25 but not necessarily to hold them against rotation.

41. The result achieved by the bolt holder of the invention and the ZipClip bolt holder is the same in that the bolt is held snugly within the holder. The bolt is held within the recesses of the holder of the invention by means of frictional contact with the elongate walls of the elongate portion and the part of the head portion which bears against the outwardly facing surface of the bolt. In contrast, the shaft receiving portion of the ZipClip extends around the majority of the circumference of the shaft, and the shaft is held in place because it is wider than the opening of the elongate portion through which it is received. So, although the ZipClip achieves the same result as the elongate body portion of the holder of the invention (holding a bolt within the holder) they do not do it in substantially the same way. The invention achieves the result by means of friction and the ZipClip holder does it by clipping the bolt into the elongate portion via an elongate opening which, after being temporarily widened to allow the bolt to pass through, returns to a dimension which is smaller than the width of the bolt.
42. As the answer to the first of the above questions is no, I do not need to go on and consider the second and third questions. Despite achieving the same functional result, it is my opinion that the ZipClip does not vary from the invention in an immaterial way.

Validity of GB2434830B

43. The requester has asked me to give my opinion on the Quaytech response. In this document Quaytech assert that claims 1-6, 10 and 11 are not valid as they lack novelty or inventive step in light of D1, D2 and D3. As set out in paragraph 15 above, since there are no arguments presented by the requester as to why the invention may involve an inventive step, I will only consider whether claim 1 lacks novelty in light of the indicated disclosures.
44. The requester considers D1-D3 to be irrelevant as his patents are "UK only". It is true that the requester's patents are only enforceable in the UK and as such the monopoly granted is only effective in the UK. Similarly, the monopolies granted to D1 and D3 are only enforceable in the US, and the monopoly granted to D2 is only enforceable in Germany. However, for a granted claim to be considered valid in the UK it must define an invention which was new and inventive at the priority date. The observer has commented with prior art that allegedly shows that the claims were not new or inventive at this time and are thus not valid. This prior art can come from any jurisdiction and take any form as long as it was publicly available before the priority date of the invention.
45. As stated in paragraph 20 above, D1 has been considered for novelty and inventive step during prosecution of the application and no new argument has been put forward regarding this document at this time. As such I will not revisit

decisions already made by the examiner and will not give an opinion on whether this document shows a lack of novelty of claim 1.

The Patent

46. This application is a divisional application, divided from GB2428272. The claims of the second patent relate to a method of joining two components, such as the male and female parts of a kitchen worktop. The description and figures are substantially the same as the first patent. A single independent claim is set out as follows (I have retained the feature labels A1.1-A1.5 inserted by the observer as these are helpful when analysing the claim):

[A1.1] A method of joining with adhesive a first component part to a second component part comprising the steps of:

[A1.2] forming a recess in each of the component parts, each said recess having an open side;

[A1.3] aligning and abutting the open sided recesses and thereby the component parts and

[A1.4] using a bolt, said bolt having locking means, to tighten the two component parts together

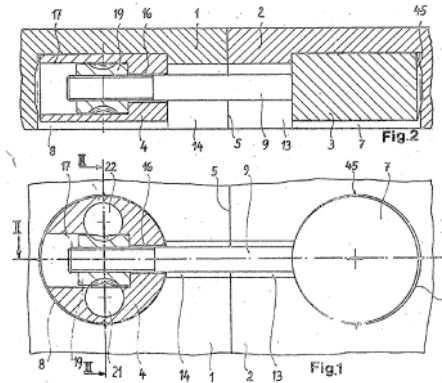
[A1.5] whilst using a bolt holder to hold the bolt in only one of the open sided recesses

[A1.6] wherein the bolt is accessible through the open sided recesses.

The Prior Art

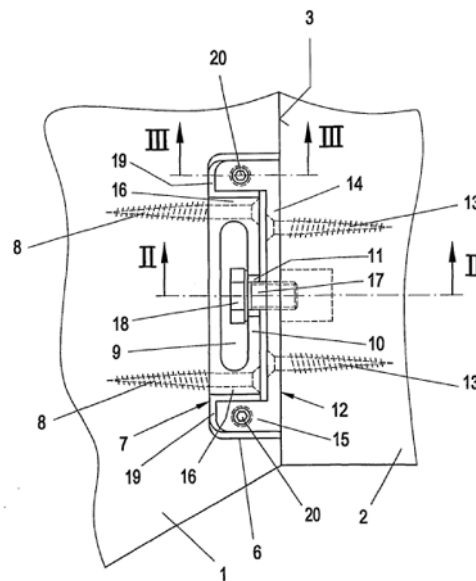
D2 – DE3146805A1

47. This document shows a bolt used for tightening two worktop components together. The bolt comprises anchor parts 3, 4 and a tie rod 9. The anchor parts are received in open sided recesses 7, 8 on the underside of the worktop parts. An elongate open-sided recess extending from the recesses 7, 8 is also provided to accommodate the elongate tie rod 9. The bolt is tightened to lock the two component parts together. This device has projections 45 arranged around the outside of the anchor parts 3, 4 which allow the bolt to be retained in the open sided recesses by means of a friction fit.



D3 – US2004/009036

48. This device has part 7 secured in an open-sided recess in one component part 1. The part 7 has an open sided recess 9 therein to receive the head of bolt 17. Bolt 17 is held in a bolthole (not open-sided) in the other component part 2. Plate 14, which has a threaded hole therein to receive the bolt, is secured to the vertical face 3 of component 2. Bolt 17 is threaded into the hole in plate 14 and the recess 9 in part 7 is lowered over the bolt head. The bolt is then tightened by reaching a tool into the recess 9.



Claim construction

49. Before considering the validity of the claims I need to construe them – that is to say, I must interpret them in the light of the description and drawings as instructed by Section 125(1):

125(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a

claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

50. In doing so I must interpret the claims in context through the eyes of the person skilled in the art. Ultimately the question is 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 recent decisions of the *High Court in Mylan v Yeda*⁵ and the *Court of Appeal in Actavis v ICOS*⁶.
51. The requester does not provide any arguments as to how claim 1 of the second patent should be construed. The observer has, however, raised a number of issues. They argue that the term “locking means” has no basis in the original description of the invention. They accept that the original description referred to “locking bolts”, and that an embodiment is shown in use with a bolt 10 and nut 17. Although I will not consider the issue of added matter in full here, I agree with the observer that there is no clear basis for the broader term “locking means” in the original description. The bolt holder is however clearly shown in use with the bolt 10 and nut 17 (see figure 4) which is used to tighten the bolt. These are referred to on page 1 as “locking bolts” 10. It is my opinion that when construing the claim purposively, the skilled person would understand the locking means in claim 1 to be the locking bolt 10 and the tightening nut 17. For the purposes of assessing novelty I will consider this to be the case.
52. The observer goes on to question the basis for “open-sided” in relation to the recesses, and for the bolt being “accessible through the open sided recesses”. They consider that figure 5 shows a recess which is closed by the base of the bolt holder meaning that the bolt is not “accessible”. I agree that figure 5 does show the bolt holder arranged beneath the bolt (in the final position of the worktop), thus restricting access to that part of it from beneath the worktop. However, it is clear from claim 1 that the bolt holder is intended to hold the bolt in only one of the recesses. This is supported by page 3, lines 23-24 “It should be noted that holder 20 of the invention should only be used in conjunction with the female part 1”. As such the skilled person reading the description and claims would understand that the part of the bolt not held by the holder is still accessible. The skilled person would also understand from reading the description that it is necessary for the bolt to be at least partly accessible for tightening as the description states that the bolt holders are used “prior to tightening” – see page 5, line 15. In my opinion this is a clarity issue rather than one of added matter as suggested by the observer. When assessing novelty and inventive step I will construe this part of the claim to mean that at least part of the bolt is accessible through the open sided recess.
53. The term “recess” is used to describe two different parts in the application, which does make it unclear. The recesses 4, 5 and 6 are described as being “formed in the component parts of the worktop 1 and 2 by the known mason mitre system

⁵ Generics UK Ltd (t/a Mylan) v Yeda Research and Development Co. Ltd & Anor [2017] EWHC 2629 (Pat)

⁶ Actavis Group & Ors v ICOS Corp & Eli Lilly & Co. [2017] EWCA Civ 1671

using a jig and router machine” (see page 5, lines 12-13). These recesses would necessarily be open sided if they are formed this way, and a skilled person would understand this to be the case as forming such recesses on the underside of worktops during kitchen installations would be part of their common general knowledge.

54. The word “recess” is also used when referring to parts 24 and 25 of the holder 20 and 20A. Recess 25 in holder 20A is described on page 4, line 4 as “U-shaped”. Both holders 20 and 20A are clearly shown in the figures to have open sided recess for receiving the bolt.
55. When construing claim 1 of GB2434830B, the recesses referred to are understood to be those formed in the component parts, i.e. recesses 4, 5, and 6.
56. Although I will not be reconsidering the novelty arguments using prior art document D1, I will address some of the claim construction arguments set out by the observer in relation to the relevance of this document.
57. The observer points to the ambiguity of the phrase “using the bolt holder to hold the bolt in only one of the open sided recesses”, and whether this means that the *bolt holder* is used in only one of the open sided recesses, or whether the *bolt* is held in only one of the open sided recesses. I agree with the reasoning set out by the observer that since the bolt is necessarily required to extend across both recesses to perform its function, and this phrase is intended to mean that the bolt holder is used in only one of the recesses.
58. The observer notes that no technical features of the bolt holder are disclosed in the claim and suggests that the term “bolt holder” should cover any suitable device for retaining the bolt in the recess. They go on to state “it appears that claim 1 would be anticipated by use of substantially any object suitable to hold the bolt in the recess whilst the bolt is tightened”. I agree that since there are no delimiting features of the bolt holder in the claim, it can be understood that using any device suitable for the stated purpose in the method set out in claim 1 would anticipate the claim. In my opinion, the skilled person would also understand from reading the claims in light of the description that the bolt and bolt holder are different parts which are provided separately.
59. The observer argues that the word “hold” in the phrase “whilst using a bolt holder to hold the bolt in only one of the open sided recesses” is not limited to holding the bolt against movement in any particular direction, but simply to prevent the bolt from moving out of the recess. I agree that this phrase does not limit the claim to holding bolt against movement in any particular direction.
60. In addition to the above, the claim states “using a bolt...to tighten the two components together *whilst* using a bolt holder to hold the bolt in only one of the open sided recesses”. When interpreting this in light of the description, which describes how the bolt and holder are inserted into the recess before tightening of the bolt, it is clear that the device must be suitable for holding the bolt in the recess while it is being subjected to tightening forces.

61. I have construed to bolt holder to be a device separate to the bolt, which is positioned in one of the recesses and is suitable for retaining the bolt in one of the recesses whilst it is being tightened, where part of the bolt remains accessible through the recesses.

The law

62. Section 1(1)(a) and (b) of the Patents Act (henceforth 'the Act') reads:

- a. 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) the invention is new;*
 - (b) it involves an inventive step;*

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

2(1) An invention shall be taken to be new if it does not form part of the state of the art.

2(2) 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.

2(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say –

- (a) that matter was contained in the application for that other patent both as filed and as published; and*
- (b) the priority date of that matter is earlier than that of the invention.*

Novelty

64. The observer argues that since claim 1 puts no limitation on the features of the "bolt holder" of claim 1, the term should cover any suitable device for retaining the bolt in the recess.

65. Comments in the Quaytech response refer to D1-D3 as showing that the claims lack novelty or inventive step. As set out in paragraph 20 above, I will not be reconsidering D1 as no new arguments have been presented over those considered during examination of the application. I will also be restricting my opinion on validity to the matter of whether the claims lack novelty.

66. D2 is patent application DE3146805. This document shows a clamping device used for tightening two worktop components together. Anchor parts 3, 4 are received in open sided recesses 7, 8 on the underside of the worktop parts. Elongate open-sided recesses 13, 14 are also provided to accommodate the

elongate tie rod 9. A tensioning screw 24 which is situated in the anchor part 4 is tightened to cause axial movement of the tie rod 9 within the anchor part 4 and tighten the two component parts together. I agree with the observer that this shows features A1.1-A1.4 of claim 1. The clamping device, comprising anchor parts 3, 4 and rod 9, is accessible through the open-sided recesses as required by A1.6. This device has projections 45 arranged around the outside of the anchor parts 3, 4 which allow the bolt to be retained in the open sided recesses by means of a friction fit. The observer points to paragraph 0017 of the machine translation of this document which describes how the projections press into the wall of the recesses and prevent the anchor parts from falling out. It goes on to state that the first anchor part 3 may be dispensed with entirely if the tie rod can be connected directly to the component part by "hanging or hooking".

67. As set out above when construing the claim, I have construed to bolt holder to be a device separate to the bolt, which is suitable for retaining the bolt in one of the recess whilst it is being tightened, where part of the bolt remains accessible through the recesses. I consider the bolt to comprise both anchor parts 3 and 4 and tie rod 9. I also consider projections 45 to be part of the bolt and thus not a separate holder. Where part 3 is dispensed with and the tie rod is connected directly to the component part as set out by paragraph 0017, little detail is provided as to how this would be achieved. Paragraph 0017 could be understood to mean that a separate device is provided to hang or hook the tie rod in place, or it could be interpreted to mean that the tie rod itself is hook-shaped and directly connects to the component part. In my opinion there is not enough detail in paragraph 0017 to provide a clear and enabling disclosure of a separate bolt holder as required by my construction of the claim. As such I do not consider claim 1 to be anticipated by D2.

68. D3 is patent application US2004/009036. This document shows a method of joining first and second component parts of a kitchen worktop with an adhesive as required by A1.1. Part 7 is secured in an open-sided recess 6 in one component 1. Part 7 itself has an open sided recess 9 therein to receive the head of bolt 17 when the parts are aligned. Bolt 17 is held in a bolthole (not open-sided) in the other component part 2 by means of plate 14 which has a threaded hole therein to receive the bolt. This threaded hole and the bolthole in part 2 into which the bolt protrudes are not open-sided so it is not the case that two open-sided recesses are aligned and abutted as required by claim 1. I do not consider this document to disclose A1.2 or A1.3. Plate 14 is secured to the vertical face 3 of part 2 but is slotted into the open sided recess 6 when the component parts are secured together. I consider plate 14 to be the bolt holder, i.e. the part that holds the bolt in place and stops it falling to the floor. I do not consider plate 14 to hold the bolt in one open sided recess as required by A1.5. I do not consider claim 1 to be anticipated by D3

Conclusion

69. I do not consider the ZipClip to infringe the claims of the first patent, GB2428272B.

70. I consider claim 1 of the second patent GB2434830B to be novel in light of DE3146805 and US2004/009036.

Application for review

71. 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.

Emma Tonner
Examiner

A handwritten signature in black ink that reads "Emma Tonner". The signature is written in a cursive style with a large initial 'E' and a long horizontal stroke at the end.

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.