

PATENTS ACT 1977

IN THE MATTER OF

an application under Section 72
by Derek Spring for the revocation
of Patent Nos GB2240577 and GB2241729
in the name of Wallguard Limited

DECISION

Introduction

1. The two patents in suit were both filed naming Tony Frederick Newell as inventor and applicant. GB2240577 was filed on 1 February 1991, declaring a priority date of 2 February 1990. GB2241729 was filed on 5 March 1991, declaring a priority date of 9 March 1990. Both were granted in 1993 and lie in the field of combating rising damp using porous ceramic tubes inserted into walls. On 4 December 1997, Wallguard Limited became the registered proprietor of both patents.

2. On 20 November 1996, Derek Spring filed Form 2/77 and a statement applying for the revocation of both patents under section 72(1) of the Patents Act 1977 ("the Act"). After a telephone conversation between Mr Spring and the Patent Office, it was confirmed in an official letter of 18 February 1997 that the application for revocation was being made under sub-section (1)(a) of section 72. Counterstatements were filed both by the original proprietor, Mr Newell, and by Mr Karl Wilby, Managing Director of Wallguard Limited.

3. Evidence was then filed. The applicant's evidence-in-chief comprises an affidavit by Mr Spring, accompanied by 17 exhibits. Mr Spring, who trades as Hydrotek Damproofing, is according to his affidavit a qualified surveyor specialising in damp and has been so involved for over thirty years. The proprietor's evidence-in-chief comprises an affidavit by Mr Karl Wilby, who is as I say the Managing Director of Wallguard Limited. The applicant chose not to file any evidence-in-reply.

4. The matter came before me at a hearing on 5 May 1998, at which neither party was legally represented: Mr Spring, the applicant for revocation, appeared in person, and Mr C G Fox of Wallguard Limited attended for the registered proprietor.

The Patents

5. The invention of GB2240577 relates to systems for combating rising damp in walls. Its stated object is to provide, in combination with ceramic damp-migration plugs, a skirting board having ventilation holes formed therein to allow air to enter the hollow plugs from an interior room and so expedite the drying out of the plugs. It has two main independent claims, numbered 1 and 6, which read:

“1 An arrangement for eliminating rising damp in walls of a building comprising, in combination, one or more hollow ceramic damp-migration plugs located in a wall, and a skirting board so formed as to define a cavity between itself and the wall, and having a first array of holes so arranged as to allow air from an interior room to enter the interior of the damp-migration plugs in order to assist in drying, and having a further array of holes from which moisture laden air may egress.”

“6 A method of eliminating rising damp in walls of a building comprising providing one or more damp-migration plugs located in a wall, providing a skirting board to define a cavity between itself and the wall, the skirting board having an array of holes therein and causing air from an interior wall of the building to enter the interior of the damp-migration plugs and so absorb moisture therein, the moisture laden air being caused by its natural circulation to egress from one or more further holes within the skirting board.”

6. The invention of GB2241729 relates to a ceramic plug for use in buildings, and in particular to a method for inserting such a plug into the wall of a building. One stated problem is that the act of inserting the plug into a hole coated with mortar disturbs some of the mortar, which tends to fall into the hollow interior of the plug. Another is the difficulty of ensuring that the plug is inserted reasonably concentrically in the hole in the wall. It is a stated object of the invention to provide a method of and means for inserting a tubular plug into a wall which

overcomes these problems. The patent has two main independent claims, numbered 1 and 4, which read:

“1. A method of assembling a hollow ceramic plug within a wall of a building to prevent rising damp in the wall comprising:-

- [a] drilling a hole in the wall, the hole having a diameter greater than that of the plug;
- [b] coating the interior surface of the hole with a mortar;
- [c] securing an end cap onto the plug, the end cap being provided with outwardly projecting fins having a dimension substantially equal to the diameter of the hole in the wall and
- [d] inserting the plug with its end cap into the hole in the wall.”

“4. Apparatus for use in the insertion of a hollow ceramic plug within a wall of a building to prevent rising damp in the wall comprising a set of tools which includes a mandrel adapted to fit freely within the hollow plug to be inserted, an end cap capable of fitting on the end of the plug, the end cap being provided with fins having an end-to-end dimension substantially the same as the diameter of the hole in the wall.”

7. The other claims of both patents are either dependent on the main claims or are of the usual "omnibus" type claiming an arrangement, method or apparatus substantially as described with reference to the drawings.

The Law

8. The grounds on which a patent may be revoked are set out in section 72 of the Act. Mr Spring's application for revocation is made under sub-section (1)(a), which reads:

“72. - (1) Subject to the following provisions of this Act, the court or the comptroller may on the application of any person by order revoke a patent for an invention on (but only on) any of the following grounds, that is to say -

(a) the invention is not a patentable invention;”

9. What constitutes a patentable invention is defined in section 1 of the Act and in particular, for present purposes, in sub-section (1), which requires that a patent may be granted only for an invention which (a) is new and (b) involves an inventive step. According to sub-section (1) of section 2, an invention shall be taken to be new if it does not form part of the “state of the art”; and according to section 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 the “state of the art”. For the purposes of the present case, the “state of the art” against which novelty and inventive step are to be judged is defined in section 2(2), which reads:

“(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.”

10. The passage I have emphasised in italics is key. If a use or description of something is to form part of “the state of the art”, and so be used to show that an invention is not new or lacks an inventive step, it must have been made available *to the public* and *before* the priority date of the invention.

11. It is also worth noting at this point that section 125(1) indicates what is to be understood to be the “invention” protected by a patent. It explains in effect that an invention for which a patent has been granted shall be taken to be that specified in the *claims* of the patent specification, as interpreted by the description and any drawings.

12. Taken together in the context of the present case, these legal provisions mean that I need

to decide whether there was any public disclosure before their priority dates of the inventions as defined in the claims of the patents in suit. I should add that I have to reach this decision on the basis of the evidence which has been put to me.

The Pleadings and Evidence

13. Mr Spring's statement of case, filed with Form 2/77, asserts that the system of porous ceramic damp-proofing has been known of since 1928, and also that his firm, Hydrotek Damproofing, "have carried out installations since 1988 exactly as detailed by Mr Newell using equipment and materials again as detailed". Three photographs are attached variously purporting to show ventilated skirting (said to be "as used by Hydrotek since 1990"), installations and equipment.

14. Mr Newell's counterstatement begins with his expressing amazement that Mr Spring is disputing the ownership of the patents. He acknowledges that he was working in association with Mr Spring's company, making reference to the purchase of ceramic tubes and other items. He then explains how the installation process was demonstrated to him and how he decided to improve on it. Mr Newell's development work led to a "Rig" to assist drilling - said to be the subject of a "lapsed patent". Apparently with regard to this lapsed patent, he specifically says that "At no time until I had applied for a patent did I demonstrate my complete process or mention these developments to Spring ...". He adds that "The difficulty was, and is, that as I was associated with Hydrotek, and I developed the invention for the benefit of Hydrotek licenced installers, Spring considers that the patent belongs to Hydrotek."

15. Mr Newell goes on to refer to what I take to be the invention of GB 2241729, saying that to his knowledge Mr Spring had no items like this in his use. He acknowledges demonstrating the new equipment to Mr Spring and his son. He also asserts that at all times Mr Spring almost forbade installation on internal walls of buildings and that he did some work on this and came up with "the third patent", which I take to be GB2240577. To Mr Newell's belief, Mr Spring had no ideas regarding this until after Mr Newell had submitted details to his agent. Accompanying photographs purport to show equipment for, and installations of, damp-proofing using porous tubes, some of which are said to be "circa Jan 1989".

16. Mr Wilby's counterstatement begins with a review of the history of ceramic tube damproofing, acknowledging (as also did Mr Fox at the hearing) that the general system has been known in the UK since the 1920's. He sets out Wallguard Limited's history of dealings with Mr Spring and Mr Newell, and contends that the system as originally patented by Mr Newell is the correct and only method to use to achieve successful results.

17. Mr Spring's written evidence returns to these points in more detail. He sets out the history of his involvement in the damp-proofing industry, culminating in the setting up of Hydrotek Damproofing, which in 1987 was developing a network of "Approved Installers". In November 1988, Mr Spring says that he agreed to work with Mr Newell in developing Hydrotek's network of approved installers. In addition, I understood Mr Spring to say at the hearing that the relationship went further than this, and that Mr Newell also took on technical developments, while he (Mr Spring) concentrated more on the marketing side.

18. He submits in evidence that Mr Newell was in contact with him during the development of the inventions, and among other things exhibits in support copies of two faxes (one at exhibit 5 dated 29 June 1989 and one at exhibit 6 undated, but said to be after the first) and a letter at exhibit 7 dated 6 December 1989. He also provides at exhibit 9 a copy of a leaflet showing equipment available to installers.

19. The remainder of Mr Spring's affidavit is concerned with setting out his belief that the inventions should have been vested in his firm, Hydrotek Damproofing, rather than in the name of Mr Newell. It also quotes some examples of the opinions of customers.

20. Mr Wilby's affidavit responds to the points made by Mr Spring, but focuses on the assertion of ownership of the patents and implied criticisms of the workmanship of his previous company.

The Issues

21. As neither party appearing before me was represented by a legal practitioner, I was careful to emphasise at the hearing that the only the issue before me is an application for revocation under

section 72(1)(a), as was confirmed by the Office letter dated 18 February 1997, and that my consideration would be restricted to that issue, and the contributory ones of whether the inventions claimed in the patents in suit are new and involve an inventive step. This point is a very important one, since a great deal of the evidence and argument presented to me goes to quite different issues, such as the ownership of the patents in suit and the quality of work undertaken by various firms in the damproofing field. While I have been careful to consider all the evidence and argument put in, much of it is clearly not relevant to the matter of revocation on grounds of lack of novelty or inventiveness and I have therefore felt obliged to take no account of it. I have nonetheless tried to derive from the evidence and argument anything which could be viewed as approaching the matter of novelty or inventiveness.

22. It is common ground between the parties to this action that the use of porous ceramic tubes inserted into a wall to combat damp has been known, publicly, for many years, and certainly before the priority dates of the inventions of the patents in suit. However, Mr Wilby made the point in his evidence, repeated at the hearing by Mr Fox, that this general system is not what the claims of the patents seek to protect, and, as both point out, the patents themselves go so far as to acknowledge this much as known. It is clear to me, in spite of Mr Spring's submission at the hearing to the contrary, that the claims of the patents require more than just the generality of the long-known method of damp-proofing by insertion of ceramic tubes, and hence that the inventions they define are not lacking novelty or inventive step when viewed in the light of that generality. This well-known prior method is not therefore in my view a reason for revoking either of the patents.

23. Turning to the detailed specific evidence presented by Mr Spring, and bearing in mind my earlier remarks that much of it goes to issues unrelated to patentability, it seems to me that the items potentially relevant to considerations of novelty or inventive step are:

- (A) the photographs attached to Mr Spring's statement and those attached to Mr Newell's counterstatement, and that at exhibit 3 to Mr Spring's affidavit;
- (B) the two faxes (one dated 29 June 1989, one undated) and the letter dated 6 December 1989 at exhibits 5, 6 and 7 to Mr Spring's affidavit;

(C) the sheet of details of equipment on offer to Hydrotek installers, at exhibit 9 to Mr Spring's affidavit.

24. As I have already indicated, for any of this matter actually to be relevant to the novelty or inventiveness of the inventions claimed in the patents in suit, it needs to be shown that it was made available *to the public* at any time *before the priority date* of those inventions. Thus, I need to be satisfied that the documents in question meet these conditions. If I can so satisfy myself, and only then, I need to consider what information can be gleaned from the documents in order to determine its relevance or otherwise to the inventions claimed in the patents in suit.

25. I turn first to the photographs of group (A). Whilst Mr Spring's statement and Mr Newell's counterstatement assert dates for some of the photographs enclosed with them, and even though the other party respectively does not challenge the dates asserted, I can find nothing in the evidence which clearly establishes a date upon which these photographs were taken. At the hearing, Mr Spring suggested that the photograph at exhibit 3 to his affidavit was taken in the early part of 1989. Again there is no corroboration of this date. In short, I do not feel they provide the dated public disclosure I require.

26. With regard to group (B), the first fax at exhibit 5 is from Mr Newell to Mr Spring and is dated 29 June 1989. The letter at exhibit 7 is from Mr Newell to Mr Spring dated 6 December 1989. I take these clearly legible dates as being those of their sending, although that may strictly be unproven. The second fax at exhibit 6 is from Mr Newell to his patent agent, copied to Mr Spring. It is undated, and no date has been clearly established for it, although at the hearing Mr Spring expressed the view that it was sent after the first fax, and Mr Fox did not challenge this. Neither side has produced evidence, nor could Mr Fox tell me, of any formal obligation of confidentiality laid upon Mr Spring or Mr Newell in their business association. However, the first fax and the letter are clearly personal communications between Mr Newell and Mr Spring. Whilst no evidence has been adduced about the second undated fax, the content suggests that it was copied to Mr Spring at the same time as being sent to the patent agent. In the context of both sides acknowledging in their evidence and at the hearing that, at or about the time these documents were sent and received, Mr Spring and Mr Newell were working in close business association, it seems to me that, on the balance of probabilities, any disclosure contained in the

correspondence between them would be naturally treated as not being public knowledge. Neither, in the circumstances, do I believe would disclosure to a patent agent constitute public disclosure. Thus, I find that the documents in group (B) do not fulfil the requirement of being made available *to the public*, which is a necessary precondition for them to form part of the “state of the art” and therefore to serve as a possible basis for attacking the novelty or inventiveness of the patent claims.

27. Turning to group (C), this comprises two sheets giving details of equipment on offer to Hydrotek approved installers. Again there is no clear evidence of a date when this document was made available, nor to whom, and Mr Spring could not give me one at the hearing. Given that a number of the items in this document are labelled "PATENT PENDING", I feel that, on the balance of probabilities, it would have been printed after the priority date at least of any relevant patent, and even if made publicly available, this was too late to form part of the state of the art for an attack on the novelty or inventive step of the patented inventions. Even if I am wrong in that inference, the absence of any clear date or evidence of public availability means I cannot rely on the document.

28. At the hearing, reference was made by Mr Spring and Mr Fox to a company called Dorset Mouldings, and it seems to me conceivable that some technical disclosure may at some time have been made to that company. However, Mr Spring made no point of that, and in any case the evidence before me of such disclosure, if indeed it existed, is too slight for me to take any account of it. Also, I should mention that at the hearing Mr Spring referred to “a retired engineer”, who is also mentioned in his affidavit and in the fax of 29 June 1989 at exhibit 5 to it. In the fax there is reference to this engineer as having “suggested design modifications”. The role of the engineer and any disclosure made to him and on what terms might have been significant, but once again the evidence submitted is quite insufficient on this point for me to take it further or to base any substantive conclusion on it.

29. Thus, the conclusion to which I am driven is that there is no evidence before me of public disclosure before the relevant priority dates of any matter relevant to the inventions claimed in the patents in suit, and therefore no basis for my revoking the patents.

Summary

30. In summary, having carefully considered all the evidence and argument submitted to me, I find, for the reasons I have given, that the applicant for revocation has not discharged the onus on him and persuaded me that any of the evidence shows lawful grounds to revoke either patent under section 72(1)(a). I therefore make no order for revocation. I might add that since the registered proprietor has not raised the question of costs, I make no order on that count either.

Appeal

31. This being a decision other than on a matter of procedure, any appeal against this decision shall be filed within six weeks after the date of this decision.

Dated this 11th day of June 1998

S N DENNEHEY

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE