



BL O/067/06

15 March 2006

PATENTS ACT 1977

BETWEEN

Archibald Kenrick & Sons Limited

Applicant

and

Laird Security Hardware Limited

Opponent

PROCEEDINGS

Application under section 27 to amend patent number GB 2297796

HEARING OFFICER

D J Barford

DECISION

Introduction

- 1 Archibald Kenrick & Sons Limited ("Kenrick") filed a request to amend patent number GB 2297796 ("the patent") under section 27 on 29 July 2003. Correspondence with the Patent Office resulted in some changes to the proposed amendments, following which they were advertised for opposition in the Journal on 17 March 2004. On 17 May 2004, a notice of opposition to the proposed amendments together with a statement of grounds was filed by Laird Security Hardware Limited ("Laird").
- 2 Kenrick filed a counter-statement accompanied by a letter dated 6 September 2004 objecting that Laird's statement was "purely speculative", accusing it of delaying tactics and requesting that the opposition be dismissed with costs. On 15 October 2004 Laird filed a supplementary statement entitled "Further particulars in support of the opposition". In response, Kenrick filed what is effectively a supplementary counter-statement accompanied by a letter dated 17 November 2004 opposing admission of the supplementary statement, and repeating its request that the opposition be dismissed.
- 3 This preliminary matter was considered in a decision dated 13 June 2005 in which I admitted Laird's supplementary statement but made an award of costs in favour of Kenrick.

- 4 Kenrick indicated that it did not wish to file any further supplement to its counterstatement. Both sides then declined to file any evidence and agreed that the substantive matter should be decided on the papers.

The issues

- 5 On 29 July 2003 Kenrick requested amendment in order to distinguish the patent from certain prior art brought to its attention on 6 June 2003 during correspondence with a suspected infringer.
- 6 The prior art in question comprises patent specifications GB 2280469, GB 2217770, US 3120970 and DE 4006687. Kenrick states that the patent at grant is distinguished from GB 2280469 (which was considered pre-grant), and from US 3120970 (for reasons given), but accepts that amendment is required to distinguish it from GB 2217770 and from DE 4006687. Kenrick notes that DE 4006687 is equivalent to EP 0411271 and has filed a certified English translation of the latter to facilitate matters.
- 7 Laird opposes the requested amendment on the grounds that:
- (i) it contravenes section 76(3)(a) in that it introduces additional matter
 - (ii) it contravenes section 14(5)(b) in that claims 1 and 2 are not clear and concise
 - (iii) it does not rectify the stated defect in that the invention is not novel and inventive over GB 2217770 and EP 0411271.

The law

- 8 The relevant parts of section 27 read:

27.-(1) Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.

(2) ..

(3) ..

(4) ..

(5) A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.

- 9 Also relevant are section 76(3)(a), section 14(5)(b), section 1(1)(a) and (b), section 2(1) and (2) and section 3. These read:

76.-(3) *No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it -*

(a) results in the specification disclosing additional matter

(b) ..

14.-(5) *The claim or claims shall -*

(a) ..

(b) be clear and concise;

(c) ..

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:

(c) ..

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

(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.

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).

The patent

- 10 The patent relates to a locking mechanism, for instance for a sash window. Figure 7 of the patent is reproduced below and shows an operating member 24b having a channel-like recess 56b in which a bolt 30b is mounted to slide. One side of the bolt 30b carries a series of raised angled guides 50b which cooperate with correspondingly angled channels in a fixed housing of the mechanism. When the operating member 24b is moved (to the right as shown in Figure 7) it carries with it the bolt 30b. Through the engagement of the angled guides 50b with the fixed channels on the housing, the bolt 30b is moved at an angle A into a locking position in which it extends outwards from the housing.

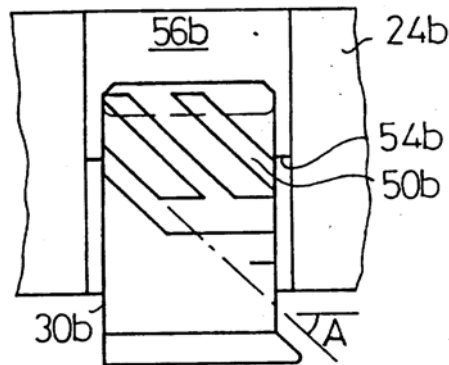


FIG 7

11 Claim 1 is the only independent claim and at grant reads:

A locking mechanism which includes an operating member and bolt means mounted to be moved by and with the operating member in which the bolt means is mounted to slide relative to the operating member.

12 The amendments as advertised relate to both the description and the claims.

13 Claim 1 amended as requested reads (new wording in bold):

A locking mechanism **adapted for mounting adjacent to an edge of a panel for use in locking the panel against movement relative to its frame, the locking means including** an operating member which is **movable in a direction substantially parallel to the edge of the panel when the locking mechanism is mounted thereto** and bolt means mounted to be moved by and with the operating member in which the bolt means is mounted to slide relative to the operating member, **the bolt means being constrained to slide relative to the operating member in a direction substantially perpendicular to the direction of movement of the operating member.**

14 Claim 2 amended as requested reads:

A locking mechanism according to claim 1 **having a housing** in which the operating member is movable in a first direction **relative to the housing**, the mechanism having guide means for the bolt means adapted to move the bolt means **relative to the housing** at an angle to said first direction during movement of said operating member.

15 It is proposed to delete claim 15 which at grant reads:

A locking mechanism according to any of claims 1-14 in which the bolt means is slidable relative to the operating member in a second direction substantially perpendicular to the first direction of the operating member.

- 16 The other proposed amendments - to the claims and the description - are consequential to the above amendments.

Added matter - section 76(3)(a)

- 17 With respect to the amendments to claim 1, it is Laird's case that "there is no suggestion in the specification as filed of a locking mechanism in which the operating member moves parallel to the panel and where bolt means are constrained to slide in a direction substantially perpendicular to the direction of movement of the operating member."
- 18 In support, Laird argues as follows. In all of the embodiments described in the patent, the constraint to sliding movement is achieved by guide means acting between the bolt means and the housing, and there is no claim in the patent that requires the bolt means to be "constrained to slide". Claim 15 describes the bolt means as "slidable" but does not say it is "constrained to slide". The only means disclosed or claimed for constraining the bolt means to slide are the guide means introduced by claim 2. Since claim 1 as amended and claim 15 as granted use different words they must mean something different.
- 19 Laird cites four authorities, namely *AC Edwards Ltd v Acme Signs & Displays Ltd* [1990] RPC 621 and [1992] RPC 131, and three decisions of the Technical Board of Appeal of the European Patent Office, namely *Fujitsu Ltd* (T 0685/90); *Gambro Lunda AB* (T 0265/88); and *Boehringer Application* (T 0416/86).
- 20 Laird notes that in *Edwards v Acme*, the court held that a patentee "cannot for the first time describe an invention which had not been described explicitly or implicitly in the application"; and that applied to the present case, the broad feature of constraining was neither explicit nor implicit in the patent as filed.
- 21 Laird notes that in *Fujitsu*, the Board held that specific equivalents of disclosed features could not be added; in *Gambro Lunda AB* the Board refused to allow equivalents to be added by using a wider technical term; and in *Boehringer* the Board held that equivalents had to be considered new if not originally mentioned. Applied to the present case, Laird argues that Kenrick is proposing to cover all means for constraining while disclosing only guide means.
- 22 In response, Kenrick states that the application as filed and the patent as granted both disclose a locking mechanism in which:
- (i) the operating member moves parallel to the edge of the panel and
 - (ii) the bolt means are constrained to slide in a direction substantially perpendicular to the direction of movement of the operating member.

- 23 In support of (i), Kenrick draws attention to various passages in the description and to the drawings. There is no doubt to my mind that feature (i) is in the application as filed, and indeed I am not sure that Laird is actually objecting to this passage in itself.
- 24 Feature (ii) however is more contentious.
- 25 In support of (ii), Kenrick draws attention to the passage at page 8 lines 18-21 of the patent (which corresponds to claim 15 quoted above) and to the passage at page 15 lines 6-11. This reads “The bolt 30b is mounted to slide within a channel-like recess 56b in the operating member 24b (in this figure, the recess is shown larger than the bolt for clarity, though in actual embodiments of the invention, the bolt will be a tight but sliding fit in the recess)”. Kenrick points out that the recess 56b extends perpendicularly to the direction of movement of the operating member and it is this channel which defines the movement of the bolt. Kenrick submits that “the term “constrained to slide relative to the operating member” is a clear and accurate description of the movement of the bolt 30b within the channel-like recess 56b, so that this feature is clearly disclosed in the patent, and similarly in the application as originally filed.” On the authorities cited by Laird, Kenrick argues that *AC Edwards* is irrelevant in the light of the above explanation; and makes no comment on the EPO decisions.
- 26 I turn then to the authorities cited by Laird. In the *Fujitsu* case, the Board refused to allow the expression “cylindrical platen rotatably mounted” to be replaced in a claim by “platen mounted”, on the grounds that there was nothing in the application as filed to suggest that anything other than a rotatable, cylindrical platen could be used. In the *Gambro Lundia* case, the Board refused to allow a claim in a divisional application to refer to “pressure seals” on the grounds that this would go beyond the initial disclosure of the parent application which referred to “sealing beads”. In the *Boehringer* case, the Board refused to allow specific structural features of an optical aperture set out in a claim to be replaced by a definition of the optical function of the aperture.
- 27 All of these cases relate to questions of straightforward claim broadening. It seems to me that the well known *Edwards v Acme* case is closer to the circumstances of the present case in that both relate to questions of intermediate generalization, that is to say the introduction of further features into a claim but in more general terms than found in the application as filed. In fact such amendment was allowed in *Edwards v Acme*. The defendants in that case contended that the amendment had the result that the claim covered, *and therefore disclosed*, certain variations not disclosed in the application as filed. The court decided that although the claim covered certain variations, it contained no disclosure of any of them; thus there was no added information and the disclosure had not been extended.
- 28 Laird is effectively arguing that the reference in claim 1 as amended to the bolt means being “constrained” to slide is an unacceptable intermediate

generalization, since the “guide means” of claim 2 is the only means disclosed or claimed for constraining the bolt means. Kenrick’s response is that it is not the “guide means” that constrains the bolt means: it is the channel-like recess 56b in the operating member 24b.

- 29 Kenrick’s argument appears to me to have substance. As noted above, as the operating member 24b is moved relative to the housing of the mechanism, guides 50b on the bolt 30b cooperate with complementary channels on the housing to move the bolt at an angle A, the bolt moving downwards within the recess 56b - with which it is “a tight but sliding fit” It seems to me that in this movement the recess 56b constrains the bolt to slide relative to the operating member in a direction perpendicular to the direction of movement of the operating member, as required by the amended claim 1. The embodiment of Figures 15 and 16 appears to operate in a similar manner.
- 30 The question then arises as to whether this is a legitimate intermediate generalization, in that the claim is not limited to the particular arrangement described and shown. Applying the principles of *Edwards v Acme* to the present circumstances it seems to me that the disclosure has not been extended – no other ways of constraining the bolt have been added -and that the amendment is therefore allowable.
- 31 Finally Laird argues that in paragraph 4 of a letter from Kenrick to the Patent Office dated 1 December 2003, the applicant effectively admits breaching section 76(3)(a). This paragraph reads “Claim 1 as amended may not specify that the bolt must move at an angle to the housing (although this is clearly what happens in the structures shown in the patent), but what claim 1 does state, and which clearly distinguishes it from EP 0411271, is that the bolt slides in a direction substantially perpendicular to the direction of movement of the operating member. Laird argues that here Kenrick is saying that claim 1 “covers mechanisms where there is parallel movement of the operating member and movement of the bolt means perpendicular to that parallel movement, but no angled movement relative to a stationary reference. There is no disclosure of any such arrangement in the patent as granted and no claim in the patent as granted covering such a possibility.”
- 32 In response, Kenrick states that this point “is particularly unclear, but as it is presently understood the opponent refers to the proprietor’s apparent admission that the bolt means can move perpendicularly to the operating member, and yet can also move parallel to the operating member during movement of the operating member. The proprietor has not made any such submission. In [this] point, the opponent seeks to use the repercussive effect of claim 2 to introduce into claim 1 structures which (as presently understood) are believed to be mechanically impossible..”
- 33 To the extent that I understand the point it seems to me that Laird is arguing that because claim 1 covers mechanisms that are not described it discloses them. This again is the point decided in *Edwards v Acme* and does not appear to me to be a valid objection.

34 In conclusion I find that the amendment does not contravene section 76(3)(a).

Clear and concise - section 14(5)(b)

- 35 On clarity, Laird submits that claim 1 as proposed amended is unclear on the following grounds:
- (i) claim 1 as amended requires the bolt means to be moved “by and with” the operating member, which phrase is unclear for reasons given.
 - (ii) it is not clear whether the constrained sliding movement takes place when the bolt means is moved “by and with the operating member” or whether it takes place at some other point in the operation of the mechanism.
 - (iii) the extent of movement of the operating member and of the bolt means are undefined, for instance it is not stated whether the movement of the bolt means is a locking movement, an unlocking movement or some other movement.
 - (iv) claim 1 must cover arrangements where the bolt means moves at no angle to the direction of movement of the operating member, since it is not until claim 2 that an angle is introduced.
 - (v) the words “constrained to slide” are indeterminate. The words do not appear in the patent as granted and there is no indication in the specification of their meaning.
 - (vi) the reference to “locking the panel against movement relative to its frame” is unclear. Panels do not by definition include a frame and so there is no antecedent for the frame.
- 36 Laird submits that in claim 2 as proposed amended it is not clear whether movement of the operating member relative to the housing is the movement parallel to the edge referred to in amended claim 1 or a different movement; and in consequence it is not clear whether the angled movement of the bolt referred to in amended claim 2 is part of the movement referred to in amended claim 1 or a different movement.
- 37 Kenrick resists all of these objections.
- 38 On point (i), as pointed out by Kenrick, the phrase in question is present in claim 1 at grant and is not therefore open to objection under section 27. (I note that the phrase was not present in claim 1 of the *application* for the patent, which may or may not have been a cause of confusion.)
- 39 On points (ii), (iii) and (vi) and the point raised by Laird against claim 2, it seems to me that the claims, interpreted by the description and drawings, would be clear to the skilled addressee. Thus it seems to me that claim 1 would be interpreted by a skilled addressee, in the light of the description and drawings, to relate to a locking mechanism in which the constrained sliding movement takes place when the bolt means is moved by and with the operating member, the movement of the bolt means is a locking movement, the panel has a frame, and, in use, the panel is locked against movement relative to its frame by the locking mechanism. Similarly it seems to me that

amended claim 2 would be interpreted by a skilled addressee to relate to a locking mechanism in which movement of the operating member relative to the housing is the movement parallel to the edge referred to in amended claim 1, and the angled movement of the bolt referred to in amended claim 2 is part of the movement referred to in amended claim 1.

40 Points (iv) and (v), I have dealt with under “Added matter” above.

41 In conclusion I find that the amendment does not contravene section 14(5)(b) on the above grounds. I note however that there are a number of passages in the introductory pages 6 to 9 of the patent which are inconsistent with what is claimed and which therefore require amendment on the grounds of lack of clarity.

Novelty and inventive step – sections 1 and 2

EP 0411271 (Karl Fliether GmbH)

42 Laird argues that the amendments do not distinguish the claims from EP 0411271. Kenrick argues that the skilled person would answer “no” to the questions “does the bolt means of the prior art document move in a direction substantially perpendicular to the direction of movement of the operating member?” and “is the bolt means [of the prior document] constrained to slide relative to the operating member in a direction perpendicular to the direction of movement of the operating member?”

43 There are three embodiments in EP 0411271. In the first (shown in Figures 1 to 8) a latch (or bolt means in the terminology of claim 1) undergoes a complex movement with a pivotal component. The second embodiment (shown in Figures 9 to 13; Figures 9 and 10 of which are reproduced below) seems to me to be more relevant.

44 Figures 9 and 10 of EP 0411271 show a lock which is operated by moving a bar 38 in a downward direction (as illustrated) parallel to a rail 36. The bar 38 moves a connecting piece 37, and the piece 37 has a pocket 39 containing a slotted link 41- all of which move in the same direction as the bar 38. A latch 44 is mounted to “slide” on the base 40 of the pocket 39 (page 16 lines 3 and 4 of the translation). The latch 44 has a pin 48 which carries a roller 50 engaging both the large slot in the link 41 and an L-shaped slot 49 formed in the base 43 of the lock. As the edge of the large slot in the link 41 engages the roller 50, the latch 44 is forced leftwards as shown in Figure 10 - that is to say *in a direction perpendicular to the direction of movement of the parts 38, 39 - the latch being constrained to slide in that direction by the engagement of the roller 50 with the longer leg 49’ of the fixed L-shaped slot 49.* The latch 44 continues to move in this direction until the roller 50 reaches the shorter leg 49” of the L-shaped slot 49. Then a second link 55 is urged downwards by a spring 61 to push the latch 44 downwards - that is to say in a direction parallel to the direction of movement of the parts 38, 39 - the latch being constrained to slide in that direction by the engagement of the roller 50 with the shorter leg

49” of the fixed L-shaped slot 49.

- 45 It seems to me to follow that in this embodiment the answer to both of Kenrick’s questions - “does the bolt means of the prior art document move in a direction substantially perpendicular to the direction of movement of the operating member?” and “is the bolt means [of the prior document] constrained to slide relative to the operating member in a direction perpendicular to the direction of movement of the operating member?” - is yes. The latch 44 constitutes the bolt means and the connecting piece 37 and link 41 constitutes the operating member.
- 46 Kenrick has not raised the question of whether or not in EP 0411271 the “bolt means is mounted to be moved *by and with* the operating member”. The latch 44 is clearly moved *by* the operating member 37, 41. The latch also moves *with* the operating member in the sense that both move together. I note in any case that in a letter of 28 July 2003, Kenrick states that (omitting reference numerals) ”The connection between the connecting piece and the bolt is such that the bolt is moved by and with the connecting piece, and can slide relative to the connecting piece, so that this document [ie EP 0411271] prejudices unamended claim 1.”
- 47 This embodiment therefore seems to me to have all the features set out in amended claim 1 – namely a locking mechanism which can be mounted adjacent an edge of a panel and which has an operating member 37, 41 movable parallel to the edge of the panel, bolt means 44 mounted to be moved by and with the operating member, the bolt means being mounted to slide relative to the operating member, and being constrained (by the slot 49) to slide in a direction perpendicular to the direction of movement of the operating member.
- 48 The third embodiment of Figures 14 to 23, which operates on generally similar principles to the second embodiment, appears to me to be equally relevant.
- 49 I conclude that claim 1 as proposed amended is not new having regard to the second and third embodiments described in EP 0411271.
- 50 No argument has been advanced by either side in respect of the novelty or inventiveness of any of the other claims. However amendments have been proposed to claim 2 and it seems to me that this too lacks novelty in the light of EP 0411271. Again referring to the lock shown in Figures 9 and 10, this has a housing 35, and it seems to me that the link 41 constitutes guide means which moves the bolt means 44 relative to the housing at an angle (namely ninety degrees) to the direction of movement of the operating member. I make no decision in respect of the remaining claims.

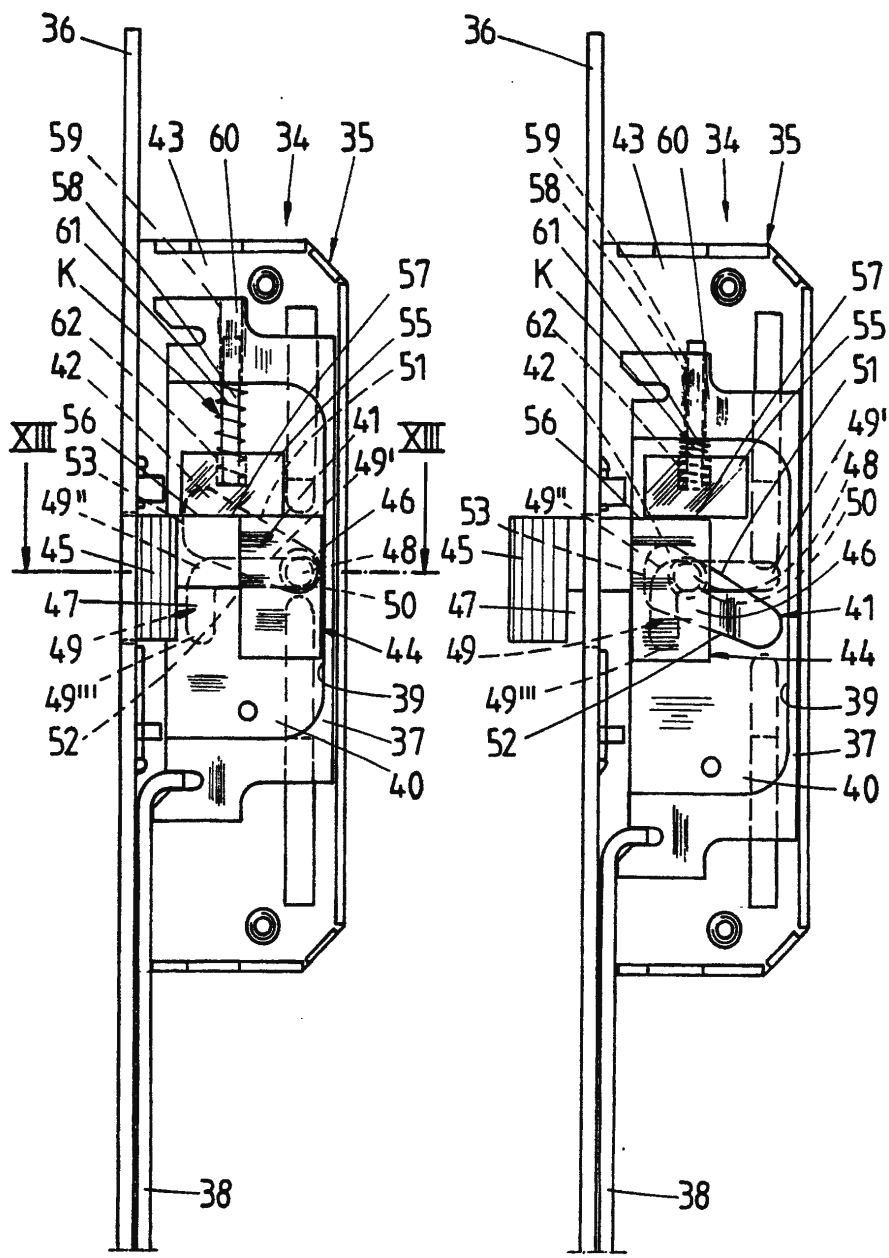


FIG. 9

FIG. 10

GB 2217770 (Tseng Tsai Yu)

- 51 In this document, movement of a plate 11 to the right as shown in Figure 3 (reproduced below) moves two latches 9 and 9', initially in the same direction ie to the right, and then in a perpendicular direction, with the top latch 9 moving upwards and the bottom latch 9' moving downwards. These movements are obtained through the engagement of projections (eg 10') on the latches with angled slots in the plate 11 and in the base 56 of the lock housing.
- 52 Here Laird argues that the plate 11 is the complete mechanical equivalent of the operating member of claim 1. Kenrick however points out that GB 2217770 relates to a mortise lock in which the plate 11 moves perpendicularly to the edge of the panel in which it is mounted, rather than parallel thereto as required by amended claim 1. I agree, and find claim 1 as proposed amended novel over GB 2217770.
- 53 Lack of inventive step has also been argued by Laird on the basis of combining the disclosures of EP 0411271 and GB 2217770, but having found that claim 1 lacks novelty over EP 0411271, I do not need to consider the point.

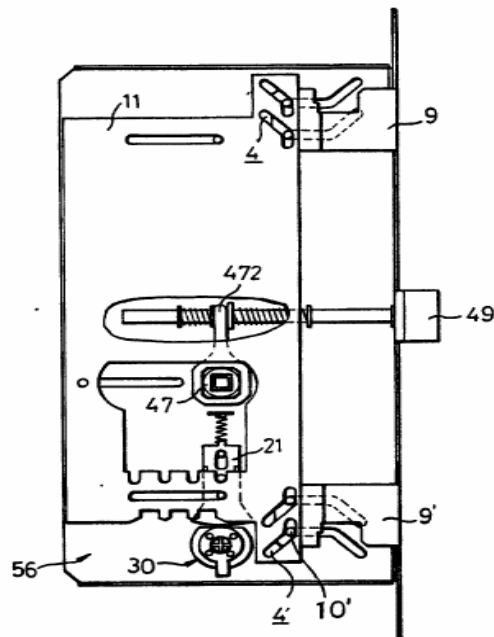


FIG. 3

Conclusion and next steps

- 54 I have found that the amendment requested under section 27 does not contravene section 76(3)(a) or section 14(5)(b) on the grounds raised by Laird, although inconsistencies with the claims in the introductory pages of the patent require remedying.

55 However I have also found that the amendment does not rectify the stated defect, in that the invention as claimed in (at least) claims 1 and 2 as amended is not novel over EP 0411271.

56 Manifestly there are differences between the patent and EP 0411271 which could be brought out in the claims. I have no reason to doubt that the amendments proposed by Kenrick were put forward in good faith, and it therefore seems appropriate to give an opportunity to Kenrick to submit further amendments (and equally to give Laird the opportunity to comment on any such further amendments).

57 I therefore allow Kenrick six weeks from this decision to submit further amendments to meet the outstanding matters, failing which I shall refuse the application to amend.

Costs

58 As noted above, I have already awarded costs in respect of the dispute over preliminary matters.

59 Laird has won on the substantive issue and so is in principle entitled to costs. However the parties have indicated that they are in negotiation and wish to reserve their position on costs. I therefore make no award at this stage. Any submissions on the matter should be made within six weeks of this decision, failing which I shall make no award.

Appeal

60 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

DAVID BARFORD

Deputy Director acting for the Comptroller