



BL O/375/06

22 December 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. This request was opposed by Laird Security Hardware Limited ("Laird") 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.
- 2 In a decision dated 15 March 2006, I found that the amendment requested did not contravene section 76(3)(a) or section 14(5)(b) on the grounds raised by Laird. I also found claim 1 to be novel over GB 2217770, but not over EP 0411271.
- 3 Laird also argued lack of inventive step having regard to GB 2217770 (hereafter "770") and EP 0411271 (hereafter "271"), but having found that

claims 1 and 2 lack novelty over 271, I did not go on to consider the point.

- 4 Kenrick has successfully appealed that decision, Lewison J finding the claims to be novel over 271 in judgment [2006] EWHC 1675 (Pat). The case has been remitted to the comptroller for consideration of the issue of inventive step. The parties have now reached an agreement under the patent and Laird has withdrawn its opposition to the request to amend. It remains for the outstanding issue of inventive step to be considered in deciding whether discretion to allow the amendment should be exercised.

The law

- 5 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.

- 6 Also relevant are section 1(1)(b), section 2(1) and (2) and section 3. These read:

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) ..

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

- 7 The patent relates to a locking mechanism, for instance for a sash window.
- 8 Claim 1 is the only independent claim. Amended as requested it 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.**

The judgment on appeal

- 9 In the judgment, claim 1 as amended was held to be distinguished from 271 by virtue of its final clause, which states

“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”

- 10 Both the patent and 271 describe a locking mechanism having a bolt which undergoes two phases of movement, namely:
- (i) In the patent, in a first phase, the bolt is constrained to slide relative to the operating member in a direction perpendicular to the direction of movement of the operating member. In a second phase the bolt and the operating member move together in the direction of movement of the operating member, ie there is **no** relative movement between the bolt means and the operating member in the second phase
 - (ii) In 271, there is also a first phase (discussed below in the context of the judgement) and then a second phase. In this second phase the bolt and the operating member move together in the direction of movement of the operating member, but in this case there **is** relative movement between the bolt and the operating member since the bolt (45) is driven by a spring (61) (see Figures 9 and 10 below)

- 11 In the judgement it was concluded that:

(i) in the 271 patent , in the first phase of movement of the bolt (45) relative to the operating member (37) - shown in Figures 9 and 10 below - the relevant direction is about 60 degrees rather than perpendicular as required by claim 1.

(ii) in any case, claim 1 of the patent is distinguished from 271 by virtue of the fact that, in 271, the bolt moves in its second phase in a direction parallel to the operating member.

EP 0 411 271 A1

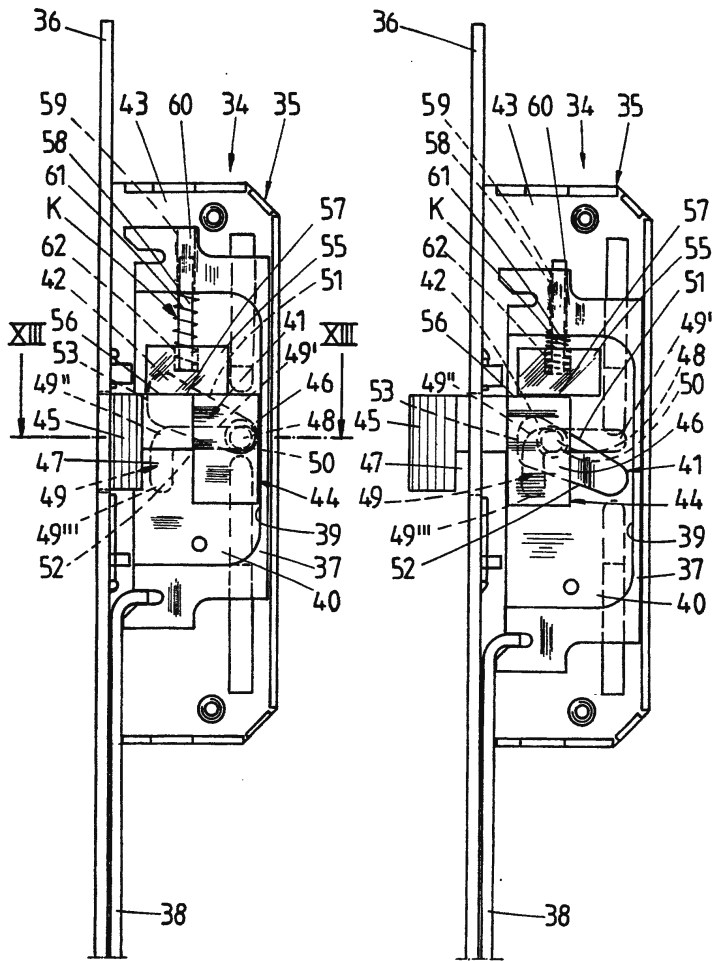


FIG.9

FIG.10

Inventive step

- 12 The well established approach to determining inventive step is that set out in *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd* [1985] RPC 59.

- 13 Four steps are involved in this approach, the first being to identify the inventive concept of the patent. To do this, it is necessary to construe claim 1, and having regard to the above, it is clear that in the judgment claim 1 has been construed to be restricted to locking mechanisms in which the bolt *only* moves as defined, ie any mechanism having a bolt which undergoes a movement as set out in claim 1, but then undergoes an additional phase with a different movement relative to the operating member, lies outside the scope of the claim.
- 14 The second step is to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and impute to him what was at that date, common general knowledge in the art. Here I take the skilled addressee to be an uninventive designer of mechanical locks.
- 15 The third and fourth steps are to identify the differences between the cited matter and the invention; and to decide whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled addressee or whether they require any degree of invention.
- 16 Taking the mechanism of 271 as the starting point, the key differences between the inventive concept of claim 1 and the mechanism of 271 as determined in the judgement are set out in paragraph 11 above. It seems to me that the differences set out there are significant and are fundamental to the particular way that the mechanism of 271 operates. It follows to my mind that it would not be obvious to a skilled addressee to carry out the considerable degree of re-design necessary to obtain the inventive concept. Accordingly I conclude that claim 1 is inventive over 271.
- 17 Taking the mechanism of 770 as the starting point, as noted in paragraphs 51 and 52 of the decision of 15 March 2006, this mechanism comprises a mortise lock in which the operating member moves perpendicularly to the edge of the panel in which it is mounted, rather than parallel thereto as required by claim 1. Again, this seems to me to constitute a fundamental difference which would require a degree of redesign not obvious to a skilled addressee. Accordingly I conclude that claim 1 is also inventive over 770.
- 18 Having concluded that claim 1 is inventive over EP 0411271 and GB 2217770, I do not need to go on to consider any of the appendant claims.

Conclusions and next steps

- 19 Having regard to the above, I allow the request to amend.

Costs

- 20 The parties have not asked for costs and so I make no award.

Appeal

- 21 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