

PATENTS ACT 1977

IN THE MATTER OF

patent application GB9517077.5

in the name of Victor John Colley

DECISION

Introduction

1. Patent application GB9517077.5 was filed on 21 August 1995 in the name of Victor John Colley. A search report under section 17(5) was issued on 9 August 1996, the application was published on 19 March 1997, and a request for substantive examination was filed on 8 April 1997; followed by a request dated 12 February 1998 that examination be accelerated.

2. Before the request for accelerated examination could be complied with, observations under section 21 from Mr C R Tasker of Alvista Wardrobes were received on 20 February 1998; observations which the examiner in an examination report under section 18(3) dated 5 March 1998 used to support an objection under section 1(1)(a) to lack of novelty against claims 1 to 3, 6, 7 and 9 to 13 of the application. In a response dated 20 March 1998, Mr Colley's representatives, Page White & Farrer, argued that the objection to lack of novelty should be withdrawn on the grounds that the section 21 observations amounted to a mere allegation and were unsupported by evidence.

3. On 14 April 1998 further observations under section 21 were received from Mr Tasker including sworn evidence, and on 17 April 1998 the examiner issued a second report under section 18(3), maintaining the objection to lack of novelty and supporting the objection by reference to the evidence filed with the further observations. In a response dated 28 April 1998, Mr Colley's representatives argued, *inter alia*, that the material submitted under section 21 "does not provide the level of proof necessary to justify refusal on the basis of lack of

novelty".

4. In a third report under section 18(3) dated 4 June 1998, the examiner maintained the objection to lack of novelty in the light of the sworn evidence, arguing that it was not clear in what way the required level of proof was not met and noting that any counter evidence from the applicant should also be sworn. In a response dated 23 June 1998, Mr Colley's representatives argued that the allowability of the application should be resolved on the basis of the information currently on file at the Patent Office and requested a hearing to resolve the outstanding matters.

5. However on 13 July 1998, before the date of the hearing, still further observations were received from Mr Tasker including further sworn evidence. These further observations were copied to Mr Colley's representatives by the examiner on 27 July 1998 who stated that he would consider them in future reports but in the meantime would place them on the open part of the file. Mr Colley's representatives responded on 29 July 1998 objecting strongly to the examiner's action, principally on the grounds that these latest observations were directed to allegations of design right infringement previously made by Mr Tasker and should not be considered under section 21 against a patent application.

6. The matter came before me at a hearing on 7 September 1998, at which Mr Christopher Morcom QC instructed by Page White & Farrer appeared for the applicant Mr Colley. Also in attendance were Mr Roger Palmer of Page White & Farrer, and the examiner Mr John Rowlatt.

The application

7. The application in suit relates to doors, particularly to sliding doors for storage units such as wardrobes. It is explained in the application that doors for storage units commonly comprise a frame having vertical styles and horizontal rails, and one or more panels mounted within the frame. The styles and rails are now commonly made of materials such as medium density fibre board (MDF) which are inexpensive and can be easily shaped, but which suffer

from the disadvantage of lacking rigidity. The invention addresses this problem by constructing the frame of four metal stiffening elements, and mounting decorative styles and rails of lower rigidity material on the exterior of the stiffening elements. The stiffening elements may for instance be aluminium extrusions, the decorative styles and rails of MDF and the panel a mirror.

8. The main claim of the application, which has remained unamended throughout these proceedings, reads as follows:

"1. A door comprising a rectangular frame and a central panel supported within a rectangular frame, said frame providing structural rigidity for the door and being formed by four metal stiffening elements each extending along a respective horizontal or vertical side of the frame, the four metal stiffening element[s] being secured to each other at respective corners of the frame, and decorative door styles and door rails being mounted on the exterior of the stiffening elements to conceal the stiffening elements, the door styles and door rails being formed of a material of less structural rigidity than the stiffening elements."

The issues

9. At the hearing Mr Morcom took me through two principal lines of argument regarding the observations, namely that they do not meet the required standard of proof, nor do they show a construction which destroys the novelty of claim 1. He also made the more general point that in *ex parte* proceedings, in contrast to revocation proceedings post grant, the applicant is denied the opportunity of, for instance, discovery and cross examination. That may or may not be so, but in any case I do have sympathy with the general point; there is little doubt to my mind that these issues could have been more thoroughly and satisfactorily aired post grant. That said however, the provisions of section 21 and rule 37 exist, no doubt with a view to the public interest, and have to be administered accordingly. I see the task before me then to be to determine what standard of proof is required in the present circumstances,

whether or not the observations meet that standard of proof and, if they do, whether or not the invention is new (and inventive) in the light of the evidence before me.

Standard of proof

10. At the hearing Mr Morcom took me to two decisions of the European Patent Office Technical Board of Appeal, *Demmeler Maschinenbau GmbH & Co KG* T908/95 (unreported; for headnote see Special edition of OJEPO 1998, Case Law in 1997, page 114) and *Sekisui Kaseihin Kogyo* T472/92 (OJEPO 4/98), both of which are concerned with the issue of prior use in the context of third party observations.

11. The text of decision T908/95 is in German. Mr Morcom read from a translation of the "Reasons for the Decision" in T908/95 as follows

"The criteria necessary for the recognition of a published prior use, in particular with regard to public availability, but also the details of place, time period and the object relating to the alleged prior use, are not so well substantiated or proved by the evidence submitted that they can be considered to be established. Further investigations necessary for this, possibly the hearing of a witness, could only be carried out in co-operation with the "third party", but this is not possible with a party not concerned in the proceedings. The .. assertion of the third party must therefore remain outside consideration."

12. In the "Reasons for the Decision" in T472/92 (OJEPO 4/98), Mr Morcom referred me to the following passage

"3.1 Concerning the standard of proof that needs to be applied, the established legal practice of the Boards is to use the self-same standard of proof in prior public use objections as it does in others covered by Article 100 EPC: the balance of probability (see, eg T 270/90 (OJEPO 1993, 725)). In that case the Board expressly refused to accept a submission that the much more rigorous standard of "beyond all reasonable

doubt" should apply, even if, as was the case there, **both** parties were able to access and to adduce evidence relating to the decisive issue of confidentiality of the transactions alleged to constitute prior public use.

The Board reaffirms this approach, subject to the following caveat. Deciding any fact at issue by applying the above standard requires making a choice as to which one of the two contradictory propositions espoused by the parties is more likely to be true, since two contradictory propositions cannot, in logic and therefore in law, be either true or false. In judging the truth or falsity of either, regard must be had to the nature, content and likely source of the evidence that is available and can be adduced by the parties.

Generally speaking, in cases not involving the issue of prior public use, both parties are able to obtain and to adduce the evidence upon which their respective case rests. By contrast, in the majority of prior public use cases practically all the evidence in support of an alleged prior public use lies within the power and knowledge of the opponent, so the patentee seldom has any ready, or indeed any access to it all. All he can, in practice, do is to challenge that evidence by pointing out any inconsistencies contained in it or to draw attention to any gaps in the chain of commercial transactions that needs to be established by the opponent in order to succeed on this ground.

In consequence, an opponent must prove his case **up to the hilt**, for little if any evidence will be available to the patentee to establish the contradictory proposition that **no** prior public use had taken place."

13. Mr Morcom also quoted from the Encyclopaedia Of United Kingdom and European Patent Law (published by Sweet and Maxwell) where paragraph 6-117 of the commentary reads as follows on the subject of third party observations

"Probably the only sort of "observation" likely to have much effect is one including the citation (accompanied by a copy) of some prior publication outside the normal search; or, possibly, a full account of some prior use"

14. It is generally accepted I think that the standard of proof in pre-grant proceedings is

the civil standard of proof on the balance of probabilities as opposed to the more rigorous standard of proof beyond all reasonable doubt. The decision by the EPO Technical Board of Appeal in T472/92 supports that approach for opposition proceedings under the European Patent Convention. In that case as noted above, the Board added a caveat, that “.. an opponent must prove his case **up to the hilt** ..” in circumstances where “.. making a choice as to which one of the two contradictory propositions espoused by the parties is more likely to be true, since two contradictory propositions cannot, in logic and therefore in law, be either true or false”. I am not persuaded that we are wholly in that position in these proceedings, since I have no contradictory evidence from the applicant to set against the third party observations. However it is clear from that decision, T472/92 and from the other quoted by Mr Morcom, T908/95, that in cases of alleged prior use, mere assertion is insufficient; place, time and details have to be provided. The above quotation from the Patents Encyclopaedia is I think consistent with that approach. I conclude therefore that the required standard of proof is proof on the balance of probabilities, with the rider that place, time and detail are essential.

The observations

15. The first observations (unsworn) received on 20 February 1998 comprise a covering letter from Mr Tasker and several attachments. The covering letter states that Mr Tasker has been designing and manufacturing wardrobes since 1985 and describes a visit that he made on 23 August 1994 to Mr Colley “then trading as Ideal Doors, and as a potential customer showed him samples of Alvista Wardrobe systems”. The letter goes on to refer to correspondence dated 16 February 1998 from Mr Colley's representatives to Mr Tasker and to a company called Global Mirror Wardrobes notifying them of Mr Colley's patent application; copies of this correspondence being included amongst the attachments. Finally Mr Tasker states that “Claims 1 to 15 (except 5) are very similar to my series 400 Mk 1 launched onto the UK and export markets in 1991. As can be seen .. the major difference is that .. I used two MDF mouldings at right angles to each other, separated by 1.3 mm of aluminium”. This reference is to an attached drawing (the first drawing) which shows sections of two frames, one entitled “FIG 3 APPLICATION NO 9517077.5” and the other entitled “ALVISTA WARDROBES SERIES 400 MK 1 SOLD IN UK IN 1991”

16. The attachments also include a drawing (the second drawing) which shows sections of two frames, one entitled "FIG 4 APPLICATION NO 9517077.5" and the other entitled "ALVISTA WARDROBES SERIES 300 MK 1 SOLD IN UK IN 1988", and finally a draftsman's drawing of an aluminium section, marked "Clientsname: Alvista Wardrobes" (the third drawing).

17. The second set of observations received on 14 April 1998 includes an affidavit from Lawrence James Ladbroke proprietor of Maldon (Essex) Glass Co Ltd dated 8 April 1998 stating that he purchased a 400 series system, as shown in the first drawing, on Alvista Wardrobes' Invoice No 2308. Mr Ladbroke exhibits a copy of that invoice which bears a despatch date of 15 March 1993 and an invoice date of 18 March 1993. He also exhibits a copy of the first drawing.

18. At the hearing I referred Mr Morcom to the third set of observations received on 13 July 1998; those whose relevance Mr Colley's representatives queried in their letter of 29 July 1998 and which the examiner has, as yet, done no more than copy to the applicant. As pointed out by Mr Colley's representatives in that letter, these observations were filed in connection with allegations of design right infringement. This point was reiterated by Mr Morcom at the hearing, but at my request he went on to examine the observations in some depth. It is convenient therefore at this juncture to consider the status of this third set of observations.

19. The observations include affidavits from Ronald Woodhouse and Timothy Peter Hallett. That from Mr Woodhouse is dated 30 June 1998 and states that he has 18 years experience in the sliding mirror wardrobe industry and that, as far as he is aware, Alvista Wardrobes is the first company to have marketed a sliding mirror wardrobe system in which an aluminium extrusion was used to stiffen MDF profiles. The affidavit from Timothy Peter Hallett, managing director of a company called Panavista, is dated 2 July 1998 and states that he purchased a 300 MK 1 system, as shown in the second drawing, on Alvista Wardrobes' Invoice No 2077 dated 13 February 1992 and a 400 MK 1 system, as shown in the first drawing, on Alvista Wardrobes' Invoice No 2309 dated 15 March 1993. Mr Hallett exhibits copies of the first and second drawings (without the figures from the patent application) and

although he refers to the invoices as exhibited, they are not.

20. Section 21 provides that

" Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations"

21. To my mind there is no doubt that, insofar as they are directed to prior use, the affidavits of Messrs Ladbrooke and Hallett go to patentability. I note also that, although the affidavits themselves refer to design right proceedings, the covering letter for the observations is headed "Comments on Patent Application No 9517077.5" and includes the statement that "You may use these additional affidavits as further evidence for your substantive examination of the application". I conclude therefore that it is right to consider these observations as filed within the terms of section 21. In addition, although these observations have not been formally included by the examiner in support of his objection to lack of novelty, they were copied to the applicant on 27 July 1998, that is to say six weeks before the date of this hearing, and, in the event, were the subject of submissions by Mr Morcom at the hearing. I think therefore that there is sufficient justification for me to take them into account in this decision.

22. I should add for completeness that correspondence additional to that referred to above has been received from Mr Tasker in respect of this patent application. However, I think I am right in saying that there is no dispute that this additional correspondence does not go to patentability as required by section 21, and that in consequence I need make no further reference to it here.

23. Mr Morcom argued that the first set of observations fall far short of establishing prior use; they amount to no more than mere assertion, giving no date and no particulars of the alleged prior use. Turning to the second set, he pointed out that the draftsman's drawing (the

third drawing) is undated. Regarding Mr Ladbroke's affidavit Mr Morcom compared the reference to the purchase of a 400 series with the exhibited invoice which does not refer to the 400 series at all. On the third set he noted that the evidence of Mr Woodhouse gives no dates and no details, that Mr Hallett has failed to exhibit either of the invoices that he refers to in his affidavit and that the fact that Mr Hallett and Mr Ladbroke refer to consecutive invoice numbers 2308 and 2309 is of interest. Mr Morcom also compared the details of the exhibited drawings with the requirements of claim 1 of the application; an issue which I shall deal with later in this decision.

24. I agree with much of Mr Morcom's submission on the content of the observations. The first set, as regards the structure shown in the first drawing, do I think fall short of the required level of detail in terms of time and place. Regarding the description by Mr Tasker of a visit that he made on 23 August 1994 to Mr Colley "then trading as Ideal Doors, and as a potential customer showed him samples of Alvista Wardrobe systems", I agree with Mr Morcom, that this *inter alia* is short on the detail of what those samples were. I have to say however that here, it seems to me, there was a clear opportunity for the applicant to gainsay the observer if he was so able if he so wished; for instance by denying that such a meeting took place, or by describing the samples.

25. On the second set I agree with Mr Morcom that the third drawing, although of draftsman's quality, is of no help, being undated. Mr Ladbroke's evidence, on the other hand, gives a clear description of time, place and detail of a purchase of a 400 series system as shown in the first drawing. There is however the question as to why, in that case, the invoice he exhibits refers only to the 200 and 300 series. The examiner explained at the hearing that in his view the 200 and 300 series were simply aluminium sections, with the 400 series comprising the addition of MDF profiles. This interpretation is consistent with the difference between the 300 and 400 series as shown in the first and second drawings, and is not inconsistent with the details listed in the invoice exhibited by Mr Ladbroke, although all of this is by no means conclusive. On the one hand then I have Mr Ladbroke's sworn testimony as to the details of the purchase, and on the other I have a possible inconsistency which can be fairly readily, if not conclusively, explained. Before reaching a final conclusion on this I shall

consider the remainder of the observations.

26. On the third set I agree with Mr Morcom that since the evidence of Mr Woodhouse gives no dates and no details it falls short of the required standard of proof. Mr Hallett's evidence, on the other hand, gives a clear description of time, place and detail of a purchase of a 400 series system as shown in the first drawing. He refers to an invoice by number but fails to exhibit it. Mr Morcom pointed to the fact that Mr Ladbroke and Mr Hallett refer to consecutive invoice numbers 2308 and 2309, but I find myself unable to draw any useful inference from this fact. Mr Ladbroke's invoice is numbered 2308 and bears a despatch date of 15 March 1993 and an invoice date of 18 March 1993, Mr Hallett's invoice is numbered 2309 and "is dated 15 March 1993". There does not appear to me to be any conflict of evidence there. The absence of the exhibit from Mr Hallett's affidavit is unhelpful, but I am not persuaded that is fatal to his evidence, since I have his sworn testimony as to the details of the purchase.

27. In conclusion it is my view that the only evidence which provides the required level of detail is that of Messrs Ladbroke and Hallett. Despite certain questions over its completeness, I am satisfied that this evidence, namely the sworn testimony of two independent witnesses on matters within the witnesses' personal knowledge does, on the balance of probabilities, establish that the structure shown in the first drawing and headed "ALVISTA WARDROBES SERIES 400 MK 1" forms part of the state of the art by virtue of section 2(2). I note in addition that none of the observations, sworn or unsworn, was refuted by counter evidence.

Novelty

28. Having found that prior use of the structure shown in the first drawing (hereafter the prior drawing) has been established, I then have to determine whether such prior use destroys the novelty of claim 1 of the present application. This issue was not addressed by the applicant's representatives in the correspondence under section 18 with the examiner. At the hearing however Mr Morcom pointed out that in his claim 1 "the metal bit is completely concealed" whereas in the prior drawing "the metal shows".

29. The prior drawing shows a metal stiffening element comprising a box section with a pair of flanges extending therefrom. The stiffening element is concealed by a two part decorative moulding, which leaves just the cross-sectional ends of the flanges visible.

30. The relevant part of claim 1 reads as follows

" ..decorative door styles and door rails being mounted on the exterior of the stiffening elements to conceal the stiffening elements.."

31. I noted at the hearing that claim 1 says "conceal" rather than "completely conceal", and that the intention in the prior drawing is clearly concealment, albeit not total concealment. Mr Morcom felt that "conceal" was sufficient since it was distinct from "partially" conceal, but I note that whereas in the specification itself at page 4 the draftsman feels it necessary to make it clear that "the style is *fully* concealed" (my italics), he chooses not to use similar wording in claim 1. It follows from this in my view that claim 1 should be construed to cover

" .. decorative door styles and door rails .. mounted on the exterior of the stiffening elements to conceal *at least in part* the stiffening elements".

32. The examiner also pointed out at the hearing that in the single embodiment described in the patent application, one side of the metal stiffening element in fact remains completely uncovered. The door is intended for use as a wardrobe door with the uncovered side on the inside in use, but claim 1 is not so limited. Mr Palmer argued that in the case of a cupboard door only one side could properly be regarded as the "exterior" and that claim 1, although not limited to sliding doors, should be so interpreted. However insofar as claim 1 relates to a door *per se* rather than to a sliding door mounted in a cupboard or wardrobe, it is I think necessary on this basis again to construe the claim to cover concealment "*at least in part*".

33. Construing claim 1 thus, I find that the invention as claimed in claim 1 at least is not new having regard to the prior use identified above. I think there is no doubt that claim 1 can be amended to meet the novelty point and I therefore allow two months from the date of this decision for the submission of amendments to the Office. It will also be necessary to ensure

that claim 1 involves an inventive step over the prior art and that consequential amendment is made where necessary. If no such amendments are proposed I shall refuse the application under section 18(3).

Appeal

34. This decision being on a substantive matter, under the rules of the Supreme Court any appeal against it must be filed within six weeks.

Dated this 2nd day of October 1998

D J BARFORD

Principal Examiner, acting for the Comptroller

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