



BL O/331/06

23 November 2006

PATENTS ACT 1977

BETWEEN

Withers & Rogers.

Claimant

and

Jon Henry Dobson

Defendant

PROCEEDINGS

Application under section 72(1)(a) of the Patents Act 1977
for the revocation of patent number GB2312386.

HEARING OFFICER

Peter Back

DECISION

Background

1. An application for revocation of UK patent number GB2312386 ("the Patent") in the name of Jon Henry Dobson ("the Defendant") was made by a firm of Patent Attorneys, Withers & Rogers ("the Claimant"), on 8 July 2005.
2. The patent was filed on 14 August 1996, claiming a priority date of 25 April 1996, and was granted on 29 September 1999. The invention relates to a mortar raking attachment for an angle grinder and the Claimant alleges that in view of certain prior disclosures the invention would have been obvious to a person skilled in the art at the priority date.
3. The Claimant's statement of case relied upon United States Patent US5347765, published 20 September 1994, and the skilled person's common general knowledge in the art. The Defendant filed his counter-statement on 19 October 2005, denying the allegations.
4. However, the Claimant also introduced a non-patent literature disclosure, together with supporting evidence, in the first round of evidence. This disclosure appeared to be an advertisement brochure ("Joran") for a tungsten carbide tipped mortar raking tool by a company called Joran Bor A/S. It was apparently published on 18 February 1994.

5. After some correspondence about the admissibility of this disclosure, both parties agreed to complete the evidence rounds on the basis of this new disclosure.

6. Evidence filed by the Claimant included a witness statement by Mr David John McWilliams (who also presented the Claimant's case) which referred to four exhibits including the aforementioned Joran disclosure. He clearly has some technical knowledge in the field and this view is supported by his technical expertise in his previous career as a patent examiner. However, I think it is fair to say he does not have quite the level of technical expertise in the particular field as some of the other witnesses and he is employed by the Claimant. Accordingly, I have taken that into account when weighing up the evidence.

7. The Claimant also provided a further exhibit accompanying their Expert's Report by Mr Keith Thomas Skinner of Xcalibre Equipment Limited. Mr Skinner has been involved with diamond cutting equipment since the early 1980's and from 1987 has owned his own company which produces such equipment specifically for the construction industry. He clearly understands his role in the proceedings, shows a good working knowledge of diamond cutting tools and their use in the relevant industry. His opinions appear to be reasonable and I am inclined to attach suitable weight to them.

8. The Defendant's evidence consisted of a witness statement by Mr Dobson himself. Arguably he knows as much as anybody about the particular art in question but he is the patentee and so I think it is reasonable to lean towards putting a little more weight on views of the Defendant's more impartial witnesses.

9. A further witness statement was submitted Mr Chris Fenwick, the owner of Progrout Ltd, a company which manufactures and sells machines for re-pointing work and which also carries out specialist work in that field. He stocks Mr Dobson's product alongside other tungsten carbide raking bits and diamond raking discs for use in restoration projects.

10. The Defendant provided an Expert's report by Mr Geoff Howell. In addition to being a trained brick-layer he is a senior college lecturer teaching construction technology and building science at South Bank University, London. He has written reviews about such equipment for at least one national newspaper.

11. Both of these witnesses provide impressive credentials and clearly know their business and I give weight to their views on an equal footing with those of Mr Skinner.

12. A hearing date was set for 28 September 2006. Mr. David John McWilliams and Mr. Adrian Chettle appeared on behalf of the Claimant whilst Mr Michael Butler and Miss Andrea Hughes, both of Frank B Dehn & Co., appeared

for the Defendant. None of the witnesses or experts were called to give oral evidence.

Admission of new grounds

13. At the outset of the hearing, Mr Butler referred to paragraph 9 of the Claimant's skeleton argument which refers to documents considered by the examiner pre-grant. The Claimant had suggested they represent examples of diamond coated raking bits and specifically mentioned the following published patent applications: GB2038214, GB1443977, US5354155, US5137098 and BE 852189.

14. Mr Butler vigorously requested that these documents should not be admitted into the proceedings because they were not part of the Claimant's case until the skeleton was submitted just two days before the hearing and so the Defendant was not in a position to respond adequately.

15. Though no formal request was made to amend the statement of case, Mr McWilliams stressed that the documents had been considered previously by the Patent Office and that it was important that they be borne in mind when considering the validity the Patent's claims. Suggesting they supported some of the arguments made in their statement, he said:

"I would simply say that the prior art that we do refer to.... was cited by the examiner during the search stage, and was considered and cited in two examination reports (the first and the second) to express the examiner's view that claims 2 to 5 were not deemed inventive.....in our statement of case we said that those claims represent non-inventive features, simply backing up the arguments that were mentioned..."

16. However, when pressed on how Mr. Butler could be expected to respond at such short notice, Mr. Chettle said:

"If I can just say, we don't propose to make any specific arguments on the papers....We are not about to open those documents up, no."

17. I think Mr McWilliams sees the views expressed in the examiner's reports as having some weight, but, this is not necessarily so. In my view there is a clear distinction between pre-grant proceedings, where an examiner expresses his opinion on the patentability of an invention but which he ultimately grants, and revocation proceedings taking place some time later. The point is that the Patent was granted by the Patent Office and we begin a fresh set of proceedings when considering the validity of claims post-grant.

18. Furthermore, it is well established practice that throughout *inter partes* proceedings the legal and evidential burden-of-proof lies with a claimant and is to be made to the usual civil standard - on the balance of probabilities. So the

Claimant should make a case, even in relation to documents considered pre-grant.

19. Strictly, arguments which have not been presented in a claimant's statement cannot be raised at the hearing unless a request to amend the statement is made as set out in *Bradford Dyers Association Ltd's Application*, [1966] FSR 79 and *Roussel-Uclaf (Joly and June 2006 Warmant's) Patent*, [1971] RPC 304). If allowed, a defendant may file an amended counter-statement in reply.

20. Since, as I understood it, the Claimant did not intend to make much of an issue of these documents I decided that they should be admitted *de bene esse*. In other words, they are there if needed later and if they have a significant impact on my decision the defendant will be allowed to make submissions.

The Law

21. The Comptroller's powers to revoke a patent on the application of another person are set out in section 72(1). With respect to the validity of the claims the relevant parts reads as follows:

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

- (a) *the invention is not a patentable invention;*
- (b)
- (c)
- (d)
- (e)

22. Withers & Rogers have admitted they are acting for an anonymous client, who the Defendant initially requested should be revealed, arguing that without this disclosure they did not know if the Claimant's experts or witnesses were impartial. However, Mr. Butler did not pursue this point at the hearing. I also note that this issue was dealt with in *Oystertec Plc's Patent* [2003] RPC 29 where the Patents Court upheld a hearing officer's decision to allow a firm of patent attorneys to apply for the revocation of a patent without disclosing their principle. Primarily this is because the act allows "any person" to make an application, although the right to a fair trial under human rights legislation was also considered.

23. Further to section 72(a), I must also look to Section 1(1) which defines the basic requirements for patentability, which includes a requirement for an inventive step. It read as follows:

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).....*
- d).....*

and references in this Act to a patentable invention shall be construed accordingly.

24. To be successful, the Claimant must make a case to show that on the balance of probabilities the Defendant's invention lacks an inventive step.

The main arguments

25. The case made in pleadings, evidence and the points argued at the hearing itself focussed on two main documents: the Joran disclosure and US5347765. At the beginning of the hearing Mr McWilliams indicated that although both were valid, the nature of Joran was such that it would be his starting point.

Joran's publication date

26. In clarification, Mr McWilliams told me that Joran was a brochure or promotional leaflet. He suggested it was dated 18 February 1994. I note there is a mark, "smc 18.02.94", printed in the bottom left hand corner of the first page. It was sent to Mr McWilliams, with an accompanying E-mail by Morten Anderson of Irwin Industrial Tools Limited on 9 December 2005. In his E-mail, Mr Anderson merely pointed out the date on the document and gave no further information on how he came across it or what its history was. We have no other evidence from him.

27. The only other evidence in relation to the Joran disclosure is that of Mr McWilliams himself. He provided a witness statement confirming how he obtained document and what he believes it shows. I note that in addition to being a Patent Attorney, when he was a patent examiner he dealt with patent applications made in the field of earth and rock working which includes borehole drilling, prospecting and related matters.

28. Mr Butler conceded that the mark on Joran looked very much like a date. However, I think it is fair to say that the main thrust of his argument was that, regardless of what it discloses, it represents no more than a piece of paper with a date printed on it. He said there was no evidence as to when, or indeed if, the document had actually been made available to the public.

29. The date in question is some two years before the priority date of the Patent and though Mr McWilliams suggested it was unreasonable, on balance, to believe it was not published, he did concede to me that he had no evidence that anyone had seen the tool or the brochure.

30. Of course, the legal requirements for demonstrating an inventive step are covered by section 3, which reads:

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).

31. Hence, the prior art which is required to show obviousness is that defined under section 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.

32. Accordingly the cited matter must have been made available to the public before the priority date of the Patent. Some disclosures speak for themselves. Most notably, a published patent specification has a publication date on the covering page. Other documents such as articles in journals, text books or even newspaper articles may have easily verifiable dates. Where this is not the case, I think the Claimant should be required to show that the citation was made available to the public before the priority date. Otherwise, the road could potentially be left open to unfounded allegations.

33. It may be enough to show, with evidence, that it was probably published sometime in the spring of 1994. Perhaps a witness statement from a publisher would suffice or in this case written or oral evidence from Mr. Anderson. Unfortunately, Mr McWilliams admitted he had been unable to get further co-operation on this point.

34. Although Mr McWilliams thought it unlikely, I have to say that without evidence to the contrary this document could well have been a first draft that was never published (or it might have been published some time after). I really do not know and to revoke a patent on that basis would be grossly unfair and so I cannot revoke the Patent.

35. However, I shall for completeness go on to consider what the situation might be if the date had been proven.

Objective test for obviousness

36. Though I was not specifically addressed on it, the long established objective test for determining inventive step is the four-step test postulated by Oliver LJ in *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd.* [1985] RPC 59, that being (at pages 73 and 74):

1. to identify the inventive concept embodied in the patent in suit,
2. 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 in question,
3. to identify what, if any, differences exist between the matter cited as being “known or used” and the alleged invention,
4. to ask whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.

The invention

37. In applying this test, the first step is to identify the inventive concept. As I said earlier, the patent relates to an elongate mortar raking tool which has a diamond grit cutting surface and is adapted so that it may be directly attached to the threaded drive shaft of an angle grinder. There are six claims of which claim 1 is the only independent claim (excluding an omnibus claim) and it reads:

1. An attachment for an angle grinder comprising an elongate bit formed as a single component having a mortar raking portion providing with a diamond cutting surface, and further comprising a hollow cylindrical fastening portion provided with an inner thread which matches and is adapted to engage with the outer thread of a drive shaft of an angle grinder; wherein the fastening portion has a greater outside diameter than that of the mortar raking portion.

38. To decide how to construct the claim I must use the principles set out by Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9. He said that a purposive construction must be put on the claim. It must be interpreted in the light of the description and drawing as instructed by section 125(1) and one must take account of the Protocol to Article 69 of the EPC. Using his Lordship’s words (at paragraph 75) I must simply decide:

“what a person skilled in the art would have thought the patentee was using the language of the claims to mean.”

39. What is generally meant by the claim is pretty clear when viewed in the light of the specification as a whole. Though it does not specifically say where the diamond cutting surface is situated on the attachment, given that it is for raking mortar in a direction lateral to its axis of rotation, it is clear to me that at least a part of the outer (cylindrical) surface is required to have a diamond (grit) cutting surface. I also think a skilled person with common general knowledge in the art of cutting, grinding and routing would take it as implicit that the diamond cutting surface was in the form of diamond grit bound by some form of carrier material. I do not see that it can be anything else.

Claims 2 to 6

40. Incidentally, claim 2 indicates that in a first embodiment the raking portion may be cylindrical and has a rounded end which is substantially entirely coated in diamond grit. Claim 3 covers a second embodiment where the raking portion may have a pointed end. This pointed end is described on page 4, lines 9 to 13 of the Patent, where it says, "the end of the raking portion is conical, forming a point". Claim 4 merely includes one or more grooves or dust flutes in the cutting surface whilst claim 5 claims the combination of an angle grinder and the attachment of the previous claims. Claim 6 is of the omnibus type and refers to the drawings.

The skilled person

41. Going on from there, the second step of the *Windsurfing* test is to assume the mantle of the normally skilled but unimaginative addressee at the priority date, imputing to him what was common general knowledge at that time. It is well accepted that the notional skilled person is a workman or technician (or a team of such men in certain circumstances) who is aware of everything in the state of the art and who has the skill to make routine workshop developments. But he does not have the ability to exercise inventive ingenuity or lateral thinking, as indicated for example by Laddie J in *Pfizer Ltd's Patent* 2001 FSR. 16 (at paragraphs 62 and 63).

42. In this case I think the art in question is more than mortar raking and perhaps lies in the more general field of drilling, grinding, routing or raking hard materials such as mortar, masonry, etc. I would expect him to be aware of commonly used tools in this art and be aware of the materials they would be made of and their relative properties or applications. He may be a skilled worker or craftsman but what is clear is that he is not an inventor.

The Joran tool

43. The third step of the objective test requires me to identify the differences between the Defendant's invention and the cited matter. To do this I must first establish what is actually disclosed.

44. Joran shows a tungsten carbide tipped mortar raking tool designed for the removal of mortar between brickwork. Photographs on the second page show that it has similarities with the attachment of the Patent. It clearly has a mortar raking portion having various diameters ranging between 6 and 12 millimetres, so that it can rake between bricks. It has a larger diameter fastening portion having an M14 internal thread so that it may be screwed directly onto an angle grinder's spindle. The disclosure refers to it having a sharpened point for starting work by drilling a hole.

45. The raking portion appears to me to be based on what would have started out as a substantially cylindrical cross-section but with flutes cut into it to provide cutting edges. Mr Butler described it in slightly different terms as being of

cruciform shape with three or four cutting blades. It is not clear what the exact profile is, but I think all present understood more or less what it must look like.

46. Critically, Joran says the tool is tungsten carbide tipped which suggests to me that a part of the tool is made of tungsten carbide whilst another part is made of another material, perhaps high speed steel. But does this literally mean the tip is made of tungsten carbide to improve the tool's ability to drill into mortar before raking, just like a tungsten carbide tipped drill bit, as Mr Butler suggested.

47. Firstly, paragraph 8 of the Claimant's skeleton suggests that the difference is as follows:

"Exhibit JD1 (Joran) shows a mortar rake which differs from claim 1 only insofar as it has a tungsten carbide cutting surface rather than a diamond cutting surface."

48. I find this statement a little vague. When I asked Mr McWilliams if he was going to reply to Mr Butler's defence submissions he began by saying:

"Yes. Starting with the issue of the Joran tool. I think it was agreed that the skilled person reading the document would be able to see what is shown in the drawings - they are not all clear - and show a tungsten carbide tipped mortar rake that has a sharpened point, but also cutting surfaces which are clearly elongate along the length or portion of the tool for raking out mortar. And we agree with that assessment..."

49. Therefore, I do not think he was disagreeing with Mr Butler's assessment at this point. Secondly, I note that the Concise Oxford Dictionary's first and I think most relevant definition of the word "tip" is as follows:

"the pointed or rounded extremity of something slender or tapering".

50. Though it is not absolutely clear, I must take a view on what I think Joran discloses. On balance, I believe it has an elongate bladed or fluted portion providing the necessary cutting edges for raking mortar and it has a tungsten carbide tip at its extremity for drilling into hard material. Of course it also has a wider fastening portion like the claimed invention.

51. The difference between the citation and the claim invention is that instead of the features mentioned in the previous paragraph, the claimed invention, as I have construed it, has a diamond (grit) cutting surface on at least a part of its outside raking surface. Non-essentially it may also have diamond grit on its rounded end or tip as suggested by claim 2.

52. The fourth step requires me to ask whether the differences would be obvious to the skilled person, using his common general knowledge, and without the benefit of hindsight?

Evidence for the Claimant

53. The Claimant argues that diamond cutting surfaces are well known, obvious to use and their Expert's report reaches the same conclusion. Mr Skinner acknowledges the Joran tool and says diamond cutting surfaces have generally replaced tungsten carbide for a variety of cutting, drilling, milling, grinding or polishing applications and particularly so for working hard materials found in the construction industry. He clearly says,

"it would be obvious to use diamond grit as a replacement for tungsten carbide at that date".

54. Mr Skinner provided Exhibit KTS1, a web-based owner's manual form Inland Craft Products Ltd, dated 1984. It shows that a router having a diamond grit surface on its cutter was known before the priority date. In this case it was for cutting glass.

55. Mr McWilliams makes the same basic point in his witness statement. In addition to exhibits JDM1 (Joran) and JDM2 (Mr Anderson's E-mail), he also refers to exhibit JDM3, a response by the Defendant to a pre-grant examination report. He points to a comment made in the Defendant's letter about there being, *"no teaching whatsoever in any of the prior art documents of an elongate cylindrical cutting bit, either with or without a diamond cutting surface, having an internal thread."*

56. Furthermore he says this statement is now contradicted by the Joran disclosure. That may be so, but it does not help me to decide if the invention is obvious in the light of this new piece of prior art.

57. Also, his exhibit JDM4 shows a print of information on Prema Diamond Tools Ltd's web-site. I believe this is Mr Dobson's company. It is presented to demonstrate similarities between the Joran tool and those being sold by Mr Dobson and presumably protected by his patent.

Evidence for the Defendant

58. In his witness statement Mr Dobson's says he developed an elongate mortar raker in 1996 and according to him it was the first of its type. It provides advantages over disc-like raking tool and has been successfully marketed. Exhibit JD1 shows several newspaper and magazine articles as evidence of it being well received in the industry.

59. He does not dispute that diamond cutting tools are known, but he makes the point that if the Joran tool was known and diamond surface cutters were well known, then why were there not any elongate diamond raking devices on the market before the priority date?

60. Mr Chris Fenwick in his witness statement basically says that each has its own particular uses, advantages and, therefore, place in the market. He does not say whether he thinks the invention is inventive or obvious but his statement gives me guidance on what a skilled person might be expected to be aware of.

61. Mr Geoff Howell provided an Expert's report for the Defendant. He wrote a complementary article (exhibit JD1) in the Sunday Telegraph about Mr Dobson's tool and claims he had not seen anything like Mr Dobson's invention before. He notes that the router in Mr Skinner's exhibit is bench mounted and for cutting glass as it moves past the cutter and so it has no similarities to a mortar raker. Mr Howell also says he was not aware of the Joran tool previously and he could not say whether it is obvious to adapt the Joran tool by using a diamond coating. But again, his views are useful in determining what the skilled person's common general knowledge might be.

Submissions on the evidence

62. In his submissions Mr Butler discussed the qualifications of the witnesses and experts in relation to the particular art in question. Specifically, he suggested that the Claimant's expert, Mr Skinner, did not have any real expertise in the particular field, that is, mortar raking using angle grinders and he made a point of his exhibit. Whereas, in his view, Mr Dobson clearly was an expert in that particular field and Mr Howell's experience as a qualified bricklayer, in addition to his academic qualifications, made his evidence more relevant.

63. In response Mr McWilliams said of Mr Skinner:

"It is clear from the various statements that his business is diamond tools, and that he has been in that business for a long time. And he concludes simply by saying that he believes that diamond coatings were a replacement for tungsten carbide."

64. As I said before, though there is no doubting Mr Dobson's expertise, there is also no denying that he has a vested interest in the outcome of this case. Mr. Howell's expertise is also not in doubt though he seems, perhaps understandably, to be non-committal on the subject of obviousness. His point about the relevance of Mr Skinner's example is fair. However, I do think Mr Skinner's knowledge of the different types of tools, including diamond cutting tools, used in the construction industry is relevant. His experience equally puts him in a position in which he can give a reasoned opinion of what the skilled person's common general knowledge would be and also about his ability to make workshop variations.

Is it obvious?

65. In coming to the last *Windsurfing* step I have considered all that has been said on this issue and I take the following view. The replacement of a tungsten carbide cutting edge with diamond grit does seem to be an option that I would expect the notional skilled man to consider if tungsten carbide produced unsatisfactory results when working on hard materials. Indeed, it must meet the requirements of the obvious-to-try test formulated by Diplock LJ in *Johns Manville Corporation's Patent* [1967] RPC 479 at page 494, where he said:

“...it is enough that the person versed in the art would assess the likelihood of success as sufficient to warrant a trial.”

66. The mere fact that such a tool had not gone on the market before could be due to a variety of reasons, not least of which is the cost. However, the difference between the cited matter and the claimed invention is more than just replacing a tungsten carbide cutting part with diamond grit. The person skilled in the art would have to decide to replace the tungsten carbide tip of the Joran tool with diamond grit (which is not an essential feature of the claimed invention) and then decide to replace the fluted or bladed cutting edges with a cylindrical surface covered in diamond grit. This is not taught by Joran and, I believe, is a step too far for our notional skilled person and therefore I do not find that claim 1 is obvious – even if a date had been proven.

Disclosure of US5347765

67. US5347765 formed the basis of the arguments made in the original statement of case. I will not go through *Windsurfing* in detail again, the first two steps have been dealt with in any case, but I will apply its methodology in relation to this citation.

68. The invention of this citation really is to an adaptor which allows a drill chuck to be attached to an angle grinder. Quoting the opening lines of the description of the US citation, it says:

“The invention relates to a device for use with a portable angle grinder and the use of the device as an interface between the grinder and a drill chuck head”.

69. A variety of tools may be placed in the drill chuck. The adapter itself has a larger diameter end which has an internal thread for receiving the angle grinder’s threaded spindle and a smaller diameter elongate part having an external thread for screwing into the rear of the drill chuck.

70. Mr McWilliams did not make much of this disclosure in his initial submissions other than to say he still thought it was valid. His own witness statement focuses on Joran. Earlier I noted that exhibit JDM3, a response to the examiners report, also refutes the examiners assertions with respect to US5347765 and I do not find it helpful. Mr Skinner’s report does not appear to refer to it either.

71. The only argument made is in the statement of case where the Claimant goes through a point by point analysis of individual features or limitations of claim 1. For example, they argue that the term, *“...comprising an elongate bit formed as a single component...”*, is anticipated because the citation’s adaptor is in the form of single component elongate bit.

72. Also, the Claimant argues that the limitation of, *“(An elongate bit...) having a mortar raking portion...”*, only limits the claimed invention to a component which is capable of raking mortar and that the thread on the adaptor

can do this. They also say a skilled man would know that any standard drill bit can meet this requirement because drilling between bricks (and moving the bit around) to remove mortar is a known technique in the field of DIY.

73. The Defendant denies this arguing a skilled person would not consider adaptor to be suitable for raking mortar – it is an adapter. A standard drill would not be considered by a skilled man to have a mortar raking portion. He would also not consider replacing the adapter with a drill bit – it would not be obvious since its purpose is to connect a chuck and not to drill or rake.

74. The Claimant's statement also suggests the limitation of being, "*...provided with a diamond cutting surface...*" is well known and so there is nothing inventive in providing the mortar raking portion with a diamond cutting surface.

75. It is also argued that, "*...wherein the fastening portion has a greater outside diameter than that of the mortar raking portion*", is nothing more than a functional imperative which is wholly conventional.

76. Mr Butler describes the argument in relation to US5347765 as "tortuous" and suggested it was not dealt with in the evidence. He basically argued that it is not realistic to use the adapter as a raking tool. You could try to use it but you would destroy it and it certainly would not be obvious to coat the adaptor with diamonds. Furthermore, the prior art document contains a list of tool or bits and yet does not disclose a raking tool and Mr Butler specifically referred to a tool called a pencil rock as being unsuitable.

77. Mr McWilliams response was to say that the US prior art discloses many tools that can be used in combination with the chuck and adaptor. He contended that this raises the question of what the term "mortar raking portion" means and he drew my attention to the last paragraph of the Patent. This paragraph says the attachment can be used for other purposes, including cutting fibre glass. He suggested the term in question means nothing more than a cutting part and the US prior art shows many tools which could be used.

78. On that last point, I think the Patent both claims and discloses a mortar raking attachment. Yes, you can use it for other things, but it has been designed to rake mortar and that is what needs to be looked for in terms of citable matter.

79. It seems to me that it is very easy to take integers from a claim and, in isolation, suggest they are individually obvious or a lacking in novelty. But, I think in applying the objective test one has to look at the invention, construe the claim as a whole and then identify how it differs from the citation. After that one must ask whether the difference would be obvious to the person skilled in the art.

80. If the Claimant is saying that it is obvious to consider using the adaptor as a mortar raking tool and then cover it with diamond grit then I do not think this is obvious to our skilled addressee. Why would he do that?

81. Another argument is, I think, that the adapter attaches a chuck to an angle grinder and you might put any number of tools in the chuck. The use of a mortar raking tool is not mentioned in this document, but even if a diamond grit mortar raking tool was used in conjunction with the chuck, there is no evidence to suggest it would be obvious to modify the arrangement by removing the chuck and combining a mortar raking tool with the adapter to form a unitary tool.

82. Overall, I do not think that the case for claim 1 being obvious in view of US5347765 has been successfully argued by the Claimant with supporting evidence. I can only conclude that claim 1 is valid.

The public interest

83. Since claim 1 has been held valid in relation to the main prior art citations there is no need consider the relevance of the examiner's cited patent specifications to claims 2 to 5, which Mr. McWilliams appeared to request at the beginning of the hearing (see paragraph 15 above).

84. However, towards the end of the hearing Mr McWilliams asked for my "*discretion to consider the revocation of your own volition on the basis of the prior art that was cited during the file prosecution history.*" Quite understandably Mr Butler protested very strongly.

85. On reflection I am not sure if at this point Mr McWilliams was asking me consider these documents in their own right in relation to claim 1. I did not think so at the time but having read the transcript, I will take it that he was.

86. It is established practice for the Comptroller to continue with a section 72 action in the public interest when, for example, a claimant has withdrawn after revocation proceedings have been properly launched. If the Comptroller determines that a clear case of lack of novelty or inventive step has been made out he may issue a formal decision. This approach is at variance with that of the Court because the Comptroller has scientific and technical staff to assist him in making such a decision and it was endorsed by Laddie J in *R v Comptroller-General of Patents, ex parte Ash & Lacey Building Products Ltd* [2002] RPC 46.

87. The reason for this procedure is clear. It would simply not be in the public interest to allow an invalid patent to remain on the register when that was clearly the case.

88. Strictly this procedure does not apply here because the Claimant attended the hearing and argued a case. However, there might still be a public interest issue with regard to the prior patent specifications admitted *de bene esse*. For example, if one or more of them did strongly suggest the claims were not valid then it would not be in the public interest to ignore them. But, can I simply look at these documents and then decide (having given an opportunity for further submissions) whether to revoke the Patent?

89. In contrast to the situation in *Ash & Lacey*, here the Claimant has simply not spelt out his case. As a result of that, apart from the exceptional

circumstances of documents showing a blatant lack of novelty or obviousness, I think that for me to take matters any further and effectively construct an argument on the Claimant's behalf would be going too far and I would not be deciding the case impartially. It might also encourage claimants to do no more than present the Comptroller with a set of documents and ask him to do the rest – which cannot be correct.

90. The fact that these documents were considered fully by the examiner, as were observations filed by a third party, and the Patent was granted cannot be ignored. Furthermore, it would not be appropriate for the hearing officer to effectively re-examine the case.

91. However, purely in the public interest, I have looked at the documents Mr McWilliams referred to and having done so I do not find a clear case for a lack of inventive step based on them and I see no need to ask for further submissions. I will take the issue no further. For the record, I have not entertained any documents the examiner may have looked at but which the Claimant has not referred me to by number.

Miscellaneous

92. In the event that claim 1 was found to be obvious, the Claimant made the following points in relation to the Defendant's right to amend.

93. Paragraph 15 of page 4 Claimant's skeleton argument refers to the standard of the Patent's drawings and at the hearing Mr McWilliams also asked me to consider the very rough nature of the drawings. It was suggested they were insufficient with respect to defining the invention covered by the omnibus claim – so claim 6 is invalid. This revocation action was pleaded under a lack of inventive step and not for a lack of sufficiency under section 72(c). Also, it seems of little importance in view of claim 1 being found valid and the untested usefulness of omnibus claims, but the drawings look clear enough to me in the light of the description.

94. Also Mr McWilliams discussed the term "rounded end" as used in claim 2, but again I have looked at the drawings and do not have a problem with interpreting claim 2. He also drew my attention to the fact that Mr Dobson said in his witness statement at paragraph 7: "*The Joran....tool.... was known to us.*"

95. It was confirmed by Mr McWilliams that Mr Dobson did not say when he knew of it. So even if claim 1 had been held invalid I do not think this would have had any bearing on the Defendant's right to amend.

Summary of the decision

96. Firstly, I find the Claimant has not provided enough evidence to prove that the Joran disclosure had been made available to be public before the priority date of the Patent. Secondly, even if it had been, based on what I understand

Joran to disclose the step to be taken would not be obvious to the person skilled in the art.

97. Thirdly, US5347765 does not show a lack of inventive step in the invention of the Patent and, finally, I have looked at the documents mentioned in the Claimant's skeleton argument and I see no evidence of a clear case of invalidity based on them and so I will not ask for further submissions. Therefore, this revocation action fails on all grounds.

Costs

98. As usual, both parties requested favourable consideration. In his skeleton, the Defendant has asked for costs in his favour making the point that he had been obliged to defend the allegations and it is argued that his efforts far outweighed the efforts of the Claimant.

99. The Claimant also requested favourable consideration arguing that the Defendant had maintained the validity of a Patent, without amendment, despite invalidating prior art – but this is not what I have found. They also point out that although Joran was not in their original statement it was made available in the first round of evidence and I agree that the Defendant was not put at any significant disadvantage. I also note the Claimant had requested that the issue be decided on the papers. However, I think it is perfectly reasonable for the Defendant to wish to be heard given that revocation of his Patent was a possible outcome.

100. There is nothing particularly unusual here. The Patentee has won and I see no reason not to make an award based on the published Patent Office scale and I award the Defendant the sum of £1200 to be paid by the Claimant not later than 7 days after the expiry of the appeal period. If an appeal is lodged, payment will be suspended pending the outcome of the appeal.

Appeal

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

PETER BACK

Divisional Director acting for the Comptroller