

PATENTS ACT 1977

APPLICANT/ PATENTEE	Cable Technology Limited
OPPONENT/ REQUESTER	Barker Brettell LLP
ISSUE	Application under section 74B for review of Opinion 20/19
HEARING OFFICER	H Jones

DECISION

Introduction

- 1 Opinion 20/19 addresses the question of whether patent EP(UK)1790053B1 (“the patent”) is novel in the light of GB263928 A (D1, published on 5 January 1927) and/or is obvious in the light of two further publications (D2 and D3). The patent relates to an electrical earthing nut comprising a nut body having a threaded aperture in its external surface for receiving a bolt that allows fixing of an earth connector to the external surface. The earthing nut has a further threaded aperture in its external surface for receiving a grub screw that can lock movement of the nut with respect to the threaded shaft on which it is threaded.
- 2 It is the examiner’s conclusion that claims 1 and 12 of the patent lack novelty with regard to D1 that is the subject of this review: the patentee, Cable Technology Limited, asserts that the examiner’s conclusion is wrong and asks that the Opinion be set aside, while the requester of the Opinion (and the opponent in this review), Barker Brettell LLP, opposes the request. It should be noted that while the opponent does not agree with the examiner’s conclusion that claims 1 and 12 of the patent are inventive over D2 and D3, it is the patentee’s request to set aside the Opinion that it opposes in this review.
- 3 In accordance with the overriding objective specified in rule 74 of the Patents Rules 2007 of dealing with cases in ways which are proportionate, I invited both sides to agree to having the matter decided on the basis of their written submissions. The patentee declined to have the matter dealt with in this manner and so a hearing eventually took place by videoconference on 18 February 2021. The patentee was represented by Mr Neville Walker of IP Consult and the opponent was represented by Mr John Lawrence of Barker Brettell LLP.

Grounds for review

- 4 Both sides accept that the principles for setting aside an Opinion are those set out by the Patents Court in *DLP Limited [2007] EWHC 2669*, i.e. that an Opinion should only be set aside if the examiner made an error of principle or reached a conclusion that is clearly wrong.
- 5 The patentee asserts that the examiner was clearly wrong in his conclusion that claims 1 and 12 are not novel in the light of D1. The patentee's main contentions are that claims 1 and 12 have 'novelty of purpose' over D1, i.e. the invention is an electrical earthing nut as opposed to the locking nut of D1, that the claims require the presence of a bolt and earthing connector (which is a different construction to that adopted by the examiner) and that it is implicit that the claims require aperture threads of the same sense, which D1 does not have.
- 6 The opponent argues that the examiner's interpretation of the claims was correct and that the claims specify a nut *per se* and not a method of using a nut, hence 'novelty of purpose' is not applicable to the claims. They argue that the bolt and earthing connector are not required by the claim and that the examiner's construction requiring an 'aperture suitable for' a bolt and earth connector was correct.

Argument and Analysis

Claim construction

- 7 The examiner summarises the disclosure of the patent in paragraph 6 of the Opinion and incorporates figure 1 of the drawings for ease of reference. Claim construction is discussed in paragraphs 8-15, wherein the examiner sets out the legal basis for interpreting the claims of a patent, namely the statutory requirement set out in section 125(1) of the Act and the further guidance provided by the courts in *Yeda* and *Actavis*. The examiner's construction focusses upon various aspects of the claims, namely:
 - a) claims 1 and 12 both refer to the term 'an electrical earthing nut', which the examiner construes as any nut that provides a conductive path;
 - b) claim 1 specifies that the earthing nut comprises at least one threaded aperture 'to receive' a grub screw or an earthing bolt (or, more precisely, a bolt to secure an earth connector). Here, the examiner concludes that the only requirement is that the apertures should be configured to receive a grub screw or earthing bolt and that the grub screw and earthing bolt themselves are not claimed. He adds that the earthing nut must include two threaded apertures on its external surface and that at least one must extend through to the threaded shaft on which the nut is placed, i.e. a through bore, to be suitable for the grub screw of claim 1.
- 8 The patentee submits that the examiner was wrong to conclude that an electrical earthing nut should be construed as any nut that provides a conductive path. The patentee does not set out any alternative construction of this feature in their written submission, nor do they present any argument which identifies clear errors in this particular aspect of the examiner's construction. Instead, they rely upon the concept of novelty of purpose as set out in *Hickman v Andrews [1983] RPC 147*, *Improver v Remington [1990] FSR 181* and *Catnic v Hill Smith Ltd [1982] RPC 183*, to argue

that patents should be read in a purposive manner and that D1 should not be read as disclosing an electrical earthing nut when that particular purpose was not disclosed or suggested in the document. In other words, the potential error is in respect of the examiner's assessment of D1 and not in the way that he construed this feature of the claim. I shall return to this point below in relation to the examiner's assessment of novelty. As far as claim construction is concerned, I agree with the examiner that an electrical earthing nut should be interpreted, when construed purposively, as any nut that can provide a conductive path.

- 9 The patentee asserts that claim 1 requires there to be "a bolt to secure an earth connector" to the nut and not just a grub screw. However, no further explanation or reasoning as to how this construction is arrived at is presented. Moreover, it seems that the relevant wording of the claim relied upon by the patentee omits the verb "to receive", which immediately precedes it in the claim and which appears to be crucial in understanding how the claim should be construed.
- 10 The patentee refers to paragraph 42 of the patent, which says that "connector 8B is attached to nut body 2 by a bolt 8A. This arrangement provides a more reliable mechanical and electrical connection to earth than was previously achieved with a banjo nut". In their written submission the patentee says that the use of a second grub screw could not result in a reliable mechanical and electrical connection of an earth connector, because an aperture extending into the nut body must be capable of receiving a bolt to secure an earth connector to the nut body.
- 11 While I agree with the patentee that the function of the bolt is to ensure a more reliable mechanical and electrical connection of an earth connector to an earthing nut, I consider that the wording of claim 1 quite clearly excludes the bolt itself save to the extent that one of the threaded apertures should be capable of receiving such a bolt and be capable of allowing the purpose of the earthing bolt, i.e. the mechanical and electrical connection, to be achieved. This is entirely consistent with the examiner's construction of the claim, and I can find no clear error in this aspect of the Opinion.
- 12 At the hearing the patentee noted that D1 required the apertures to have opposite threads and indicated that the claims of the patent required aperture threads in the same sense. However, the claims make no explicit reference to the sense of the aperture threads, and the description does not mention sense of the aperture threads at all. While close scrutiny of figures 1 and 2 does suggest that the threads as drawn all have the same sense, no particular emphasis is made of this. The patentee argued that it is a convention in the art for threads to have the same sense unless otherwise stated.
- 13 I accept that while it would be reasonable workshop practice to cut threads in the same sense unless otherwise instructed, e.g. in order to avoid adjusting tooling and such like, interpreting the scope of a claim is a completely different question. I consider that it was perfectly reasonable for the examiner to conclude (at paragraph 14 of the Opinion) that neither claim 1 nor claim 12 impose any limitations regarding the size of the apertures, or the pitch, or the direction/sense of the threads within the apertures. I can find no clear error in this aspect of the Opinion.

Novelty

- 14 The novelty arguments raised by the patentee rely upon a different construction of claims 1 and 12 from that adopted in the Opinion, in particular the earthing bolt being an element required by the claim. Since the construction in the Opinion is not in error, the undeniable differences between grub screws and earthing bolts are moot since neither are required by the claims as construed.
- 15 The only other potential error identified by the patentee is the one mentioned above, namely that the examiner ought to have read D1 in a purposive manner and understood that it does not disclose an electrical earthing nut when that particular purpose is not disclosed. While I agree with the patentee that patent claims should be construed in a purposive manner in the light of the description as opposed to a purely literal one, I believe what the patentee is seeking to do here is to apply the concept of purposive construction in reverse, i.e. applying a purposive construction to the description of the prior art.
- 16 In the Opinion, the examiner considered it highly probable that the nut was made of metal and that it would have the same material property as the earthing nut, and so fell within his own construction of that term, i.e. the earthing nut being any nut permitting a conductive path. Having construed the claim in that way, and having made a reasonable assessment of the material composition of the nut in D1, which the patentee does not challenge, I believe that it was perfectly reasonable for the examiner to conclude that D1 discloses an earthing nut. The patentee made reference to established caselaw, for example in the 1908 case of *Flour Oxidizing Co v Carr* [25 RPC 428], which says that it is not enough to prove that an apparatus described in an earlier specification could have been used to produce this or that result, it must also be shown that the specification contains clear and unmistakable directions so to use it. However, as noted by the opponent both in written submissions and at the hearing, *Flour Oxidising* relates to a new method of using known apparatus, rather than to an apparatus itself as in the present case. Method claim 12 relates to a method of manufacturing (or forming) a nut, not to a method of use. I agree with the opponent that the guidance in *Flour Oxidizing* is not relevant in this case.
- 17 The patentee has not identified any errors in the examiners reasoning on novelty as set out in paragraphs 16-24 of the opinion, and hence no clear error in the examiner's conclusions on novelty is evident.

Conclusion

- 18 The patentee has not shown that the examiner has erred in his construction of the claims nor in his assessment of novelty based upon that construction, so the Opinion should not be set aside.

Costs

- 19 The opponent has asked for an award of costs in its favour if the Opinion is upheld, in particular that the patentee should pay its costs in preparing and filing the counterstatement and in attending the hearing. It is Office practice to not award costs in respect of reviews of Opinions given the low-cost nature of the Opinion service and the fact that Reviews can usually be decided on the basis of the papers. However, I consider that I should depart from this norm given that the patentee

requested an attended hearing, which they were perfectly entitled to do, but then presented arguments that were mostly identical to those laid out in written submissions. The opponent could have declined the opportunity to attend the hearing, but it was clearly not in their interest to do so and I expect they felt obliged to be present.

- 20 The hearing lasted less than an hour, so the inconvenience and cost was kept to a minimum. Nevertheless, taking account of the standard scale of costs set out at Annex A of Tribunal Practice Notice 2/2016¹, I consider that an award of costs in favour of the opponent is appropriate in the circumstances and hereby order Cable Technologies Ltd to pay the sum of £200 to Barker Brettell LLP within seven days of the expiry of the appeal period specified below.

Appeal

- 21 Any appeal must be lodged within 28 days after the date of this decision.

Huw Jones

Deputy Director, acting for the Comptroller

¹ <https://www.gov.uk/government/publications/tribunal-practice-notice-22016/tribunal-practice-notice-22016-costs-in-proceedings-before-the-comptroller>