



PATENTS ACT 1977

BETWEEN

Barker Brettell LLP	Opponent
and	
Cable Terminology Limited	Proprietor

PROCEEDINGS

Opposition to a proposed amendment of
EP(UK) Patent EP1790053 under section 27

HEARING OFFICER

John Lawrence and Matthew Philpotts for Barker Brettell
Hearing date: 04 April 2024

DECISION

- 1 EP(UK) 1790053 B1 (“the patent”) was granted on 23rd February 2011. An opinion, Opinion 20/19, was issued on 18th February 2020. The opinion, which was requested by Barker Brettell LLP, concluded that claims 1 and 12 of the patent were not novel.
- 2 The proprietor of the patent, Cable Terminology Limited (“the Proprietor”), requested a review of the opinion under section 74B. In a decision¹ (“the earlier decision”) dated 5th March 2021, the Hearing Officer could find no reason to set aside the opinion. The Proprietor then filed several requests to amend the patent under section 27 culminating in the latest request filed on 30th March 2023.
- 3 The request to amend was duly advertised in the Patents and Designs Journal on 2nd August 2023. On 25th August 2023, a notice of opposition under section 27(5) to the proposed amendments together with a statement of grounds was filed by Barker Brettell LLP (“the Opponent”). The Proprietor was informed that under Rule 40(4) of the Patent Rules 1995 it had until the 20th October 2023 to file a counter statement.
- 4 The Proprietor, through their attorney, IP Consult, responded with a letter dated 1st November 2023. This letter noted that the Opponent “cites neither new prior art, nor

¹ BLO/139/20

arguments above and beyond that already reviewed". The letter goes on to contend that the amended claims are novel.

- 5 The Proprietor was advised on 9th November 2023 that their letter of 1st November did not comply with the requirements of a counterstatement as set out in Rule 78 which states that:

78.—(1) Any counter-statement filed by the defendant must—
(a) state which of the allegations in the statement of grounds he denies;
(b) state which of the allegations he is unable to admit or deny, but which he requires the claimant to prove;
(c) state which of the allegations he admits;
(d) be verified by a statement of truth;...

- 6 The Proprietor was further advised that a counterstatement according to Rule 78 should be filed as soon as possible together with a request to extend the period for filing the counterstatement. Further if nothing was filed within 4 weeks of the letter, which was dated 9th November 2023, then in accordance with Rule 77(9) they would be taken to supporting the Opponent's case.
- 7 No response was received. The Proprietor was therefore informed that they would be treated as supporting the Opponent's case and that also they had forfeited the right to be a party to these proceedings.

Subsequent procedure

- 8 This is not the first time that a proprietor who has sought to amend their patent under section 27 then decided not to contest an opposition to that amendment. In *Norsk Hydro*² the Hearing Officer found that an application to amend a granted patent was considered to be withdrawn when no counter statement was filed in response to an opposition to the allowance of the amendments filed by another party. The merits of the opposition were therefore not considered.
- 9 A different approach was however taken in *Rita Rusk and Wilson Gunn LLP*.³ There the Hearing Officer observed that in *Norsk Hydro* there were also pending revocation proceedings under section 72. Those proceedings also included amendments filed under section 75. Consequently, whether or not there was a consideration of the merits of amendments submitted under section 27, the merits of the amendments under section 75 were free to be considered as part of the revocation proceedings. The opponent for revocation could have its substantive objections fully considered and the public interest in properly examining the proposed amendments would be upheld. That was not the position in *Rita Rusk*. The Hearing Officer therefore went on to note that:

"11. I have considered the Opponent's position with regard to Norsk Hydro, I am mindful of the fact that the Applicant could have withdrawn its request to amend or could have contested the opposition and it chose to do neither. I have also taken account of the wider public interest in coming to a decision on this point, and I am of the opinion that the opposition to the amendments should be allowed to proceed and be heard."

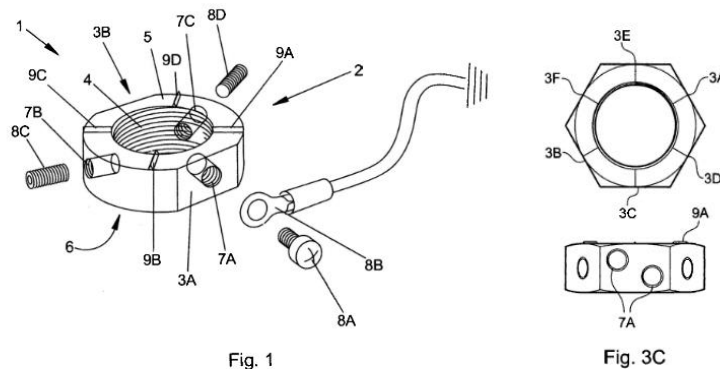
² *Norsk Hydro AS's Patent* [1997] RPC 1989

³ *Rita Rusk and Wilson Gunn LLP* BL O/109/08

- 10 The situation here mirrors that in *Rita Rusk* such that if I were to deem the amendments withdrawn then there would be no consideration of the merits of the opposition. I therefore intend to adopt the approach taken in *Rita Rusk* and consider the merits of opposition. When the Opponent was informed of this, they asked to be heard on the matter.
- 11 The hearing duly took place on 4th April 2024 with John Lawrence and Matthew Philpotts from Barker Brettell on behalf of the Opponent. I am grateful for the skeleton argument provided in advance of the hearing by the Opponent.

The Patent

- 12 The patent relates to an electrical earthing nut. The earthing nut as illustrated in figures 1 and 3C (shown below) is characterised in that it has a number of threaded openings (7A-7C) extending radially into the body of the nut to enable an earthing cable to be secured to the nut using a screw (8A). The provision of multiple openings enables the earth cable to be fitted where space is cramped and where access to a single opening might be restricted. They also allow the nut to be secured to the threaded shaft to which it is attached by means of one or more grub screws (8C,8D). The raised ribs (9A-9C) are arranged to scrape or cut the surface against which a planar face of the nut is to abut to improve electrical conductivity. Figure 3C shows an alternative shaped nut to that of figure 1.



- 13 The claims as granted include two independent claims. Claim 1 is directed to the nut whilst claim 12 is directed to a method of forming an earthing nut. These read as follows:

Claim 1

An electrical earthing nut (1) comprising a nut body (2) having an internal thread (4) and an external perimeter shaped to receive a tensioning device, such as a spanner, said nut body having opposing generally planar faces (5, 6), comprising: at least one threaded aperture (7C) on the nut body (2), extending into the nut body from the nut body perimeter, to receive a grub screw (8D) to contact a threaded shaft on which the nut (1) is placed, characterised in that there is at least a second threaded aperture (7A) on the nut body (2), extending into the nut body (2) from the nut body perimeter, to receive a bolt (8A) to secure a nut connector (8B) to the nut body (2) the two threaded apertures (7A and 7C) are handed the same.

Claim 12

A method of forming an electrical earthing nut (1) comprising the steps of:

a) forming a nut body (2) having an internal thread (4) and an external perimeter shaped to receive a tensioning device, such as a spanner, said nut body (2) having opposing generally planar faces; and b) forming at least two threaded apertures (7A, 7B) extending into the nut body (2) from the nut body perimeter.

The proposed amendments

- 14 The latest amendments submitted, and on which this decision is based, are those filed on 30th March 2023. These include an additional independent claim, claim 2. The proposed amended independent claims read as follows:

Claim 1

An electrical earthing nut kit of parts comprising: a) an electrical earthing nut (1) comprising a nut body (2) having an internal thread (4) and an external hexagonal perimeter shaped to receive a tensioning device, such as a spanner, said nut body having opposing generally planar faces (5, 6), comprising: at least one threaded aperture (7C) on the nut body (2), extending into the nut body from the nut body perimeter, to receive a grub screw (8D) to contact a threaded shaft on which the nut (1) is placed, characterised in that there is at least a second threaded aperture (7 A) on the nut body (2), extending into the nut body (2) from the nut body perimeter, to receive a bolt (8A) to secure a nut connector (8B) to the nut body (2); b) a bolt to secure an earth connector directly to the nut body by way of a first threaded aperture on the nut body, the first threaded aperture extending into the nut body from the nut perimeter; and c) a grub screw to contact a threaded shaft on which the nut is placed by way of a second threaded aperture on the nut body, the second threaded aperture extending through the wall of the nut body from the nut body perimeter.

Claim 2

An electrical earthing nut (1) comprising a nut body (2) having an internal thread (4) and an external, polygonal perimeter shaped to receive a tensioning device, such as a spanner, said nut body having opposing generally planar faces (5, 6), comprising: at least one threaded aperture (7C) on the nut body (2), extending into the nut body from the nut body perimeter, to receive a grub screw (8D) to contact a threaded shaft on which the nut (1) is placed, characterised in that there is at least a second threaded aperture (7 A) on the nut body (2), extending into the nut body (2) from the nut body perimeter, to receive a bolt (8A) to secure a nut connector (8B) to the nut body (2) and at least one raised rib (9B) is provided on one planar face (5) to engage a surface against which the nut (1) is to abut.

Claim 10

A method of forming an electrical earthing nut (1) comprising the steps of:

a) forming a nut body (2) having an internal thread (4) and an external, polygonal perimeter shaped to receive a tensioning device, such as a spanner, said nut body (2) having opposing generally planar faces;
b) forming at least three threaded apertures (7 A, 7B and 7C), extending into the nut body (2) from the nut body perimeter to receive a grub screw (8); and
c) forming at least one raised rib (9) on one planar face on the nut.

The opposition

- 15 The Opponent contends that the proposed amendments lack an inventive step over one or more of the following prior art documents, either alone or in combination:

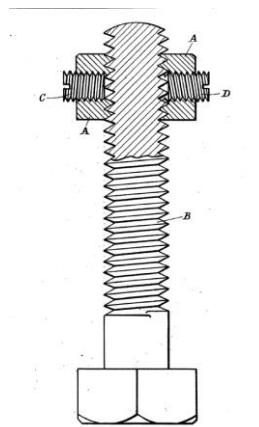
GB263928A (published 5 January 1927)

EP0512361A (published 11 November 1992)

- 16 It notes that each of the above documents was published before the priority date of the patent which is 19th August 2004, and that the patent identifies EP0512361A as prior art.

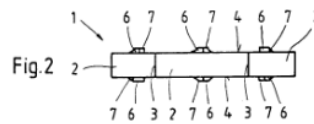
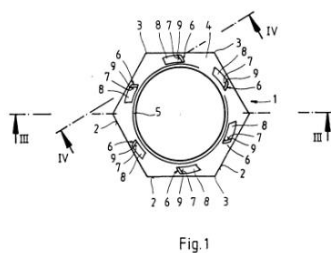
GB263928A

- 17 As shown in the figure below, GB263928 discloses a nut and bolt arrangement wherein the nut can be locked to the bolt by means of grub screws screwed into the nut. The description refers to there being two or more holes into which the grub screws C and D can be screwed. It further notes that the thread of opposite holes is different, one being left-handed and the other right-handed, to reduce the possibility of the nut working loose through vibration.



EP0512361A

EP0512361A discloses a hexagonal shaped earthing nut (1) with raised portions (6,7) designed to cut into surface against which the nut engages to ensure a good earth connection.



The Law

- 18 Section 1(1) reads:

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) it is capable of industrial application;

(d) the grant of a patent for it is not excluded by subsections (2) and (3) or section 4A below;

19 Section 3 then sets out how the presence of an inventive step is determined. It says:

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).

20 It is well-established that the approach to adopt when assessing whether an invention involves an inventive step is to work through the steps set out by the Court of Appeal in *Windsurfing*⁴ and restated by that Court in *Pozzoli*⁵. These steps are:

(1)(a) Identify the notional “person skilled in the art” (1)(b) Identify the common general knowledge of that person;

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

Applying the Windsurfing/Pozzoli test

Identify the notional “person skilled in the art” and the relevant common general knowledge of that person;

21 The identity of the skilled person was considered in the opinion where it was noted that they are a designer or installer of electrical earthing apparatus or an electrician. I am not sure it would extend as far as an electrician, but I am content with the remainder of the description.

Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

22 The wording of the claims is straightforward to understand. It was noted in the previous decision and the opinion that the term “electrical earthing nut” should, when construed purposively, be taken to mean any nut that can provide an electrically conductive path. I am happy to accept that.

Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

⁴ *Windsurfing* [1985] FSR 59

⁵ *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

23 The Opponent contends that GB263928A discloses all the features of claim 2 except for:

a) the nut body (A) having an external polygonal perimeter and

b) at least one raised rib being provided on one planar face to engage a surface against which the nut is to abut.

24 I would note that GB263928A does not explicitly disclose that the nut is made of an electrically conductive material. This was addressed in the opinion and the earlier decision. In the latter, where GB263928A was referred to as D1, the Hearing Officer noted that:

"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."

25 I too accept this. Indeed, given the age of GB263928A, and the intended purpose of the invention disclosed in that document, it is I believe implicit that the material of the nut is in all probability metal.

Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

26 The Opponent addresses the issue of the shape of the earthing nut by referring to the examiner's consideration of the earlier amendments filed on 17th March 2021. There the examiner noted that:

"You have requested limitation of claims 1 [granted claim 1 of EP1790053] and 10 (previously 12) to the feature of previous claim 6 (nut body having an external polygonal perimeter) so as to distinguish them over what is disclosed in GB 263928 The skilled person's common general knowledge would include basic mechanical fastenings. The difference to claims 1 and 10 is that there is no disclosure that the nut body external perimeter is a polygon. The use of, for example, a hexagonal nut is well known and would fall within the common general knowledge of the skilled person. The skilled person would also be directed towards this approach given the illustration of a hexagonal bolt head in D1. As such, claims 1 and 10 do not provide an inventive step over D1."

27 The Opponent contends that it is clear from the examiner's succinct reasoning that it would be obvious to provide the nut of GB263928A with an external polygonal perimeter. There can be no inventive step in modifying a known nut to have a polygonal outer perimeter. I agree. I would add that it is arguable that this feature is implicitly disclosed in GB263928A however since it would be clearly obvious to have a polygonal perimeter then I do not need to decide that.

28 I turn now to the second missing feature namely that there is at least one raised rib provided on one planar face to engage a surface against which the nut is to abut.

29 The Opponent notes that the patent in issue recognises at paragraph 9 that:

" EP0512361A discloses an electrical earthing nut with at least one raised rib on one planar face and that the raised rib assists achieving an electrical contact, for example with a metallic cabinet, in which the earthing nut is fitted, by scraping teeth across paintwork and gouging the metal surface."

30 The Opponent notes further that the patent also states that:

"Preferably one or more raised ribs is/are dimensioned and arranged to scrape or cut the surface against which a planar face of the nut is to abut." [§16]

and

"Preferably at least three and preferably four (or more) raised projections or ribs are provided. These projections or ribs are ideally formed on a planar face of the nut." [§17]

31 The patent goes on to explain in paragraphs 38 to 40 that:

"As nut 1 is tightened, so the teeth 9A, 9B, 9C, 9D scrape across and cut into the surface of wall 20. This has three advantages: Firstly, if the wall 20 is metal, paint thereon is scraped away so providing a good electrical connection between the nut 1 and the wall. Secondly, the teeth prevent the nut from unwinding off shaft 11.

Thirdly, once tightened with the teeth engaged with the wall 20, the combined assembly of gland 10 and nut 1 can be tightened merely by rotating gland nut 12 with a spanner or wrench (not shown). That is, a separate spanner is not required to hold nut 1 whilst gland 10 is rotated."

32 This the Opponent argues shows that the second feature is clearly known from the prior art. It also notes that the purpose of the raised ribs in both the patent in issue and in EP0512361A is the same. Hence the skilled person, faced with the problem of providing an electrical earthing nut having an improved electrical connection to a metal surface against which the nut abuts when mounted on a threaded shaft, would have a clear prompt and motivation from the teaching of EP0512361A to modify the nut of GB263928A to include one or more raised ribs on a planar face.

33 There is no argument before me that the teaching of EP0512361A is indicative of the common general knowledge. Rather what the Opponent is essentially arguing is that starting with GB263928A and looking to address the problem of ensuring a good electrical connection, the skilled person would look at the teaching of EP0512361A.

34 I am satisfied that the skilled person would, starting with GB263928A, indeed be minded to consider the teaching in EP0512361A especially given that it addresses the same problem as the patent and is in the same field. And if they did, they would arrive at the invention of claim 2 without any inventive effort. In reaching this conclusion I am also minded that the Proprietor is being treated as supporting the Opponent's case.

35 The Opponent also argues that claim 10 would be obvious for the same reason. Claim 10 differs from claim 2 in being directed to a method of forming an earthing nut and also that the nut has "at least three threaded apertures (7 A, 7B and 7C), extending into the nut body (2) from the nut body perimeter to receive a grub screw (8)". In contrast claim 2 refers to there being at least two threaded apertures: one to receive a grub screw (8D) and one to receive a bolt (8A). The patent however does not distinguish between the apertures for the grubscrews and the bolt. Indeed, given

one of the objectives of the invention is to provide flexibility as to which aperture or apertures are used depending on their accessibility, it would seem that each of the apertures is of the same size and thread. Hence claims 2 and 10 differ essentially just in terms of the minimum number of apertures.

- 36 The Opponent again relies in part on the examiner's response to the earlier suggested amendments. They refer to the examiner's comments on GB263928A in the letter to the Proprietor dated 4th May 2021 where they noted:

"The skilled person would consider adjusting the number of grub screws used, therefore the number of apertures. Claim 3 would be a routine modification and therefore lacks an inventive step."

- 37 The Opponent contends that it is clear from the examiner's succinct reasoning that it would be obvious to modify the nut of GB928 to provide an additional threaded aperture.

- 38 The Opponent also highlights column 1, lines 38 to 41 of GB263928A which states:

"This invention ... consists in forming two or more screw threaded holes in the nut".

- 39 I am satisfied that GB263928A does indeed disclose the possibility of having more than two apertures. Given that there would not appear to be anything inventive in having three holes as opposed to say two, I also find the invention of claim 10 obvious.

- 40 The Opponent is also arguing that the invention in claims 2 and 10 would be obvious by considering the same combination of documents but in effect starting from EP0512361A. I am not persuaded by the strength of that argument, especially compared with the alternative above. Given my findings above I do not need to address this alternative argument further.

- 41 I would add finally that at the hearing, the Opponent sought to raise some clarity concerns against the proposed amended claim 1. This was not part of their initial opposition and consequently I advised them that it might be considered unfair to the Proprietor for me to consider these additional objections now. Indeed, it is possible that the Proprietor might have taken a different position in terms of participating in these proceedings if it had known claim 1 was also being attacked. As such I will not consider these additional objections against claim 1.

Conclusion

- 42 The proposed amendments are not allowable as the proposed claims 2 and 10 do not provide the necessary inventive step over the disclosures in GB263928A and EP0512361A. Accordingly, the request of 30th March 2023 to amend the patent is refused.

- 43 Given that the patent was the subject of an opinion and that opinion concluded that the patent was invalid, then the patent should now be forwarded to the relevant examiner for consideration of possible action under section 73(1A).

Costs

44 No request has been made for costs and therefore I make no order.

Appeal

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

PHIL THORPE

Deputy Director acting for the Comptroller