Intellectual Property Office

BL O/534/18

28 August 2018

PATENTS ACT 1977

BETWEEN

Burren Precast Concrete Ltd Claimant

PROCEEDINGS

Application under section 72 for revocation of patent number EP(UK)1522638

HEARING OFFICER Phil Thorpe

DECISION

Introduction

1. Burren Precast Concrete Ltd ("Burren") initiated revocation proceedings in respect of EP(UK)1522638 ("the patent") on the 10th January 2018. The statement of case was served on the proprietor of the patent, Carlow Precast Concrete Engineering ("Carlow") on the 19th January 2018. Carlow was invited to file a counterstatement by 2nd March 2018.

2. In correspondence dated 21st February 2018 Carlow sought strikeout of parts of the statement of case and an extension to the period for filing its counterstatement. All of this was resisted by Burren.

3. At a preliminary hearing on 13th April 2018 I ordered[1] strike-out of part of the statement of case. I further ordered Burren to provide an amended statement of case more clearly setting out the grounds on which they wished to challenge the validity of the patent.

4. Burren filed its amended statement and in a letter dated 20th April 2018 Carlow were invited to file its counterstatement by 11th May 2018. No counterstatement was filed. In letters dated 24th May and 28th June Carlow were informed that in the absence of a counterstatement the application will

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be deemed to be unopposed and that Carlow will no longer be considered a party to the proceedings. Carlow did not respond to either of the letters.

5. In accordance with rule 77(9) I must therefore treat Carlow as supporting Burren's case.

The invention

6. The invention relates to a tank which is designed for use as a buffering device to collect excess storm water for slow release to a municipal sewer. The tank 10 (see Figure 1 of the patent reproduced below) comprises a modular perimeter wall 14 consisting of a plurality of precast wall units 16 secured in a reinforced concrete floor 18. In addition the tank 10 comprises a roof 20 consisting of an array of pre-cast roof units 22. A line of precast internal walls 24 is provided in order to support the roof units 22. The internal walls are seated directly on the concrete floor without fixing or sealing reducing the time to manufacture the tank and providing structural continuity to the floor underneath. The patent explains further that conventional storm water tanks when manufactured from concrete would often be cast as a monolithic structure on site. In the invention of the Patent, the wall units 16, roof units 22, and internal walls 24 are all precast offsite reducing the time taken to manufacture the tank 10.

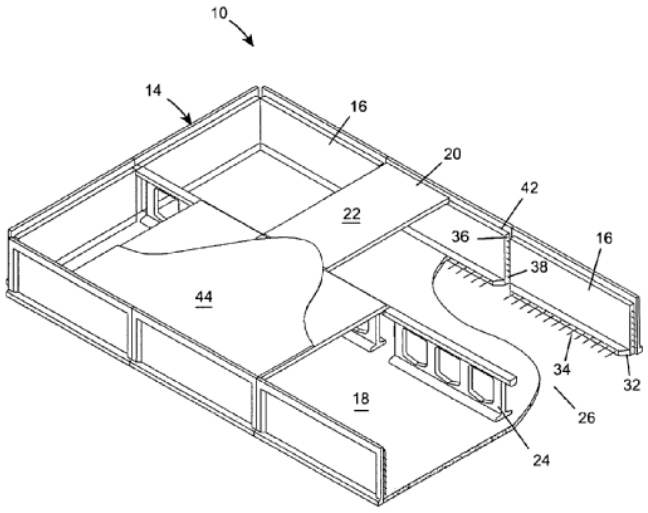


Fig. 1

7. The patent has 15 claims including independent claim 1 directed to a storm water attenuation tank. Claim 11 defines a method of manufacturing an

attenuation tank according to any of the previous apparatus claims. Claim 1 reads as follows:

> A stormwater attenuation tank (10) comprising an inlet through which to channel storm water; an outlet adapted for fluid communication with a sewerage system; a steel fibre reinforced floor (18) incorporating steel reinforcing elements; a modular perimeter wall (14) comprising precast wall units (16); at least one precast internal wall having an enlarged foot which stands directly on the floor without requiring fixing in order to maintain structural conformity to the floor beneath the at least one internal wall, and without a seal being formed between the floor and the internal wall; and a roof (20) comprising precast units (22) supported on the at least internal wall (24).

8. The patent was granted on 3rd May 2017 with a priority date of 6th October 2003.

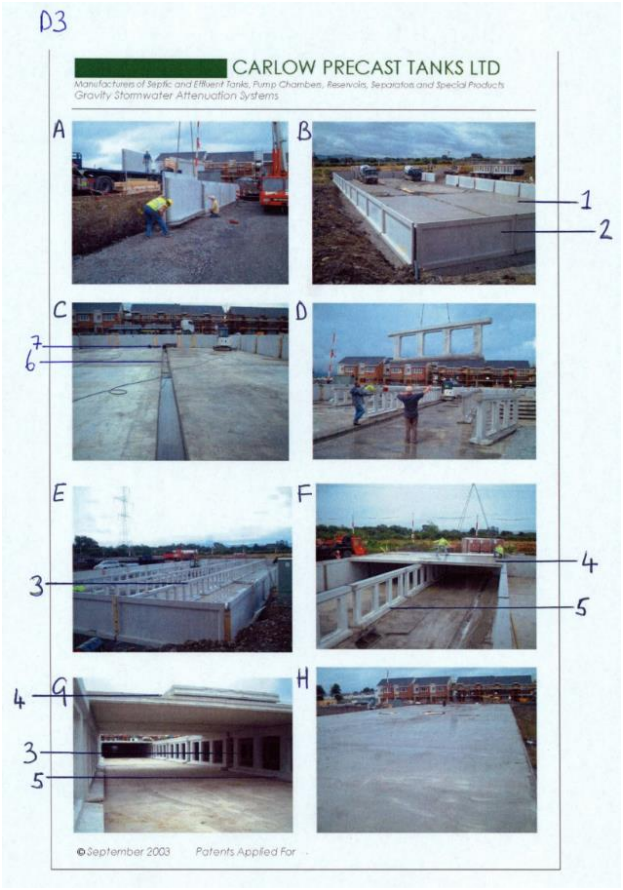
Argument and discussion

9. Burren argues that the patent contains subject matter not disclosed in the application as filed. It also argues that claims 1 and 11 at least lack novelty as a result of at least two instances of prior use before the priority date. In the alternative it also argues that these claims at least lack an inventive step.

10. The prior use included the sale of a storm water tank to SM Morris Ltd together with the subsequent installation of the tank. Burren has provided a witness statement from Mr Michael Joseph Lomax dated 10th July 2017. Mr Lomax was the General Manager of Carlow Precast Tanks Ltd at the time of the prior disclosure. Carlow Precast Tanks Ltd were the original applicant of the patent in issue. In his witness statement Mr Lomax states that the storm water tank disclosed in the patent was unconditionally supplied to SM Morris Ltd and then installed at Hanstead Way Adamstown Co Dublin. The installation, which was publicly and freely accessible was commenced on 21st July 2003 and was completed by 1st August 2003.

11. Burren has also provided further witness statements from a number of people involved in the installation together with other documentary evidence to support its claim that the installation predated the priority date of the patent. Burren also argues that the installation constituted a public disclosure since unfettered access was provided to a number of people who were not employees of Carlow including some of those who provided witness statements.

12. Burren has set out in some detail how the storm water tank installed at Hanstead possessed all the features of claim 1. Central to this is the figure shown below. Additional evidence is provided in relation to those features not clearly visible in these photographs. On the basis of the evidence provided, which I must treat Carlow to be supporting, I am satisfied that the invention of claim 1 is lacking in novelty on the basis of prior use. On the basis of the evidence provided I am also satisfied that the remaining claims of the patent including independent method claim 11 are also lacking in novelty.



13. Having found at least one ground for revocation it is not necessary for me to consider the further grounds for revocation set out by Burren.

Order

14. I order that patent EP(UK)1522638 B be revoked.

Phil Thorpe
Deputy Director acting for the comptroller