

FIG. 6

5. The clip is comprised of plastics material, comprising a first limb 16 which in use is anchorable relative to said support, a second limb 20 upon which an edge zone of said panel is to bear temporarily, and a web 28 interconnecting and transverse to the first and second limbs and having a frangible or reduced section bridge 33 effective between said first and second limbs. In use a tab 34 is struck by a hammer, shearing the bridge section, resulting in the first limb remaining in position and the remainder of the clip being 'knocked away'.
6. A further embodiment is depicted in Figures 8 & 9 and is replicated below.

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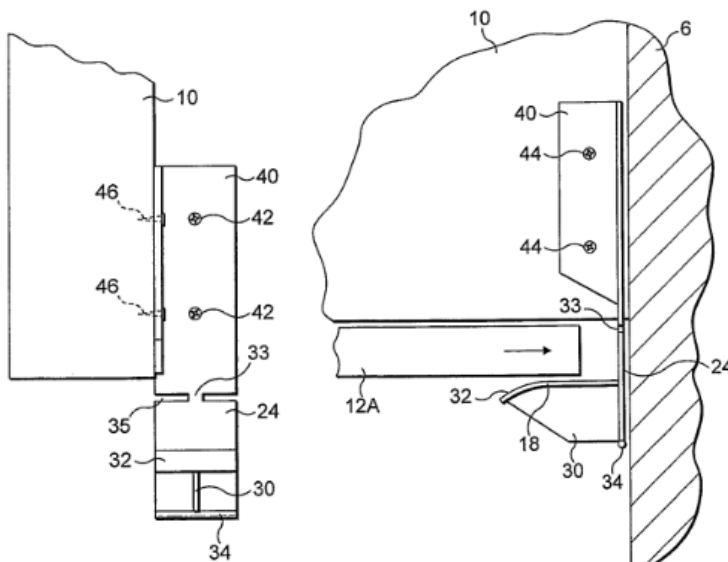


FIG. 8

FIG. 9

## The claims

7. The application contains two independent claims, claim 1 and claim 19. As of 24<sup>th</sup> October 2014, current claims 1 & 19 read:

1. A clip made of plastics material and for use in mounting a panel relative to a support, comprising a first limb which, in use of said clip, is anchorable relative to said support, a second limb upon which an edge zone of said panel is to bear temporarily and readily removable from connection with said support, and a web interconnecting and transverse to the first and second limbs and having a frangible bridge effective between said first and second limbs, the clip being such that, following anchoring of said clip to said support by way of said first limb and anchoring of said panel relative to said support, said second limb can be knocked away by a hammer blow and consequent breaking of said bridge.
19. A method comprising anchoring relative to a support a first limb of a clip made of plastics material, bringing an edge zone of a panel to bear upon a second limb of said clip connected to said first limb by way of a web transverse to the first and second limbs and having a frangible bridge effective between the first and second limbs, fixing said panel relative to said support, and thereafter removing said second limb by knocking away by a hammer blow producing breaking of said bridge.

8. On 23 February 2015 proposed amended independent claims 1 & 19 were filed:

Claim 1 as follows:-

A clip made of plastics material and for use in mounting a panel relative to a support, comprising a first limb which, in use of said clip, is anchorable relative to said support, a second limb upon which an edge zone of said panel is to bear temporarily and readily removable from connection with said support, ~~and~~ a web interconnecting and transverse to the first and second limbs and having a frangible bridge effective between said first and second limbs, and a projecting portion to the opposite side of the second limb from the web and disposed to be hit by a hammer, the clip being such that, following anchoring of said clip to said support by way of said first limb and anchoring of said panel relative to said support, said second limb can be knocked away by a hammer blow on said projecting portion, said bridge being broken as a consequence of said hammer blow, ~~and consequent breaking of said bridge.~~

and of Claim 19 as follows:-

A method comprising anchoring relative to a support a first limb of a clip made of plastics material, bringing an edge zone of a panel to bear upon a second limb of said clip connected to said first limb by way of a web transverse to the first and second limbs and having a frangible bridge effective between the first and second limbs, fixing said panel relative to said support, and thereafter removing said second limb by knocking away by a hammer blow on a projecting portion of said clip to the opposite side of the second limb from the web, said hammer blow producing breaking of said bridge.

9. At the beginning of the hearing I attempted to clarify what the expression “anchorable relative to said support” was intended to define. In particular, what the “support” actually comprises (in light of the description). Both Mr Burrows and Mr Mayhew stated that the support could be either a joist to which the plasterboard(s) is/are secured to or an adjacent plasterboard. I am happy with this assertion.

## The law

10. The sections of the Patents Act<sup>1</sup> (“the Act”) considered in this decision are set out below. The relevant parts have been highlighted in bold.
11. Section 1 of the Act sets out what is required of a patentable invention, subsection 1 reads:

***1(1) 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;***

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

12. Section 2 of the Act sets out what novelty means; subsections (1) and (2) are relevant here:

***2(1) An invention shall be taken to be new if it does not form part of the state of the art.***

***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.***

13. Section 3 sets out how the presence of an inventive step is determined:

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<sup>1</sup> <http://www.ipo.gov.uk/patentsact1977.pdf>

***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).***

14. Section 14 of the Act sets out the requirements that need to be met by a patent application. Section 14(5) relates to the claims and reads:

***(5) The claim or claims shall:***

*(a) define the matter for which the applicant seeks protection;*

***(b) be clear and concise;***

***(c) be supported by the description; and***

*(d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.*

15. Section 125(1) of the Act states:

**125.-(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.**

16. A patent specification should be given a purposive construction. In *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9 the House of Lords said that the question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean.

## **Assessment**

17. I think it logical to deal with the outstanding issues in the order they are addressed in the final examination report of 11 November 2014.

## **Clarity**

18. Paragraphs 5 – 8 of the final examination report of 11 November 2014 raised several objections with regards to clarity and in particular how claim 1 had been drafted.
19. Mr Burrows accepted the examiners view on how claim 1 was construed in paragraphs 3 & 4 of the final examination report. However, I should add that the claim should have been construed to clearly define which limb is removable by defining ‘wherein the second limb is removable’, i.e. so that it is clearly distinguished from the first limb. With this aside, it is in my opinion that the proposed amended claim (dated 23/02/15) goes some way in defining this, but it appears it would be clearer if the claim reads ‘bear temporarily and is readily removable’.
20. Mr Burrows also accepted the examiners view in points 5 & 6, but thought that his proposed amendment to claims 1 & 19 (dated 23/02/15) overcomes point 5.
21. As Mr Burrows has accepted how claim 1 has been construed and with regards to my point above, it is my opinion that point 7 of the final examination report is rendered moot.

22. With the above in mind and following Kirin-Amgen, I have to determine what the person skilled in the art would have understood the patentee to be using the language of the claim to mean. It is in my opinion that the proposed amended claim 1 (dated 23/02/15) goes some way in overcoming the clarity objections raised in the final examination report. However, it is not clear from the incorporated text “and a projecting portion to the opposite side ... to be hit by a hammer” what constitutes as the “projecting portion” and what side is the “opposite side”. Mr Burrows and Mr Mayhew stated that item 34 in fig 6 is what is hit by the hammer, which therefore suggests that it is the “projecting portion”. Clarification was also sought in this regard to the embodiment disclosed in figs 8 & 9 and Mr Burrows explained that it is the thickened portion 34 that is the projecting portion and that is hit with the hammer. I am of the opinion that this interpretation is acceptable, but its relative position in relation to what defines the “opposite side of the second limb” is still unclear. A similar interpretation is also applied to the proposed amended claim 19.

### **Witness statement**

23. Before continuing my consideration of Novelty and Inventiveness I should consider the Witness Statement (dated 20 February 2015) in support of the application, submitted by Mr. David Winchester a professional plasterer and lecturer. Mr Winchester offers his opinion of the citations, but based on his subjective view of their practical nature and that he personally ‘had never come across them’. Although I note the points raised by Mr. Winchester, they do not add anything to the application of The Act in this matter, and I will not consider this statement any further.

### **Novelty**

24. The examiner cited three patent documents, all of which claimed priority and were published before the priority date of this application, which she used to demonstrate a lack of novelty for claim 1 at least.

D1 DE 19804930 A1 (GRUENERT)  
D2 US 4112636 A1 (HAYS)  
D3 EP 1882793 A2 (AMLANG)

I will now consider each of these documents in turn.

25. D1 discloses an assembly yoke for fitting plasterboards. In particular, reference is made to figs 5 & 6. Plasterboard 5 & 8 is mounted by the use of spacer 9, which comprises a first limb 13 anchorable to a support (first plasterboard 5) and a second limb 6. The web may be considered to be the transverse portion of the spacer radially spaced from the striking pin 18 and in contact with adjacent plasterboard panels. The web comprises a breaking point 17 (frangible portion) between the first and second limbs. Both the current claims (dated 24/10/14) and the proposed claims (dated 23/02/15) disclose that the second limb is knocked away. In relation to D1, the striking of pin 18 breaks a portion of the spacer at breaking point 17, but there is no disclosure that the second limb 6 is knocked away. In fact, the breaking point 17 can only be broken by striking into what can be considered the main plane of the plasterboard. Furthermore, it would appear

that the broken away arms of the transverse portion may be retained between the adjacent plasterboard panels whereby the second limb may have to be manually removed by pulling it away from the plasterboard. It therefore appears that D1 does not appear to provide all the features as set out in claims 1 & 19.

26. D2 (see particularly figures 1 - 3) discloses a temporary wallboard clip. The examiner comments that the first limb is defined as attachment portion 12, the second limb is retaining member 17 and is connected to the first limb by a web, which is defined as supporting portion 15 having a weakened portion 16. In relation to fig 2 and col. 3 lines 4 - 12, it can be seen that the supporting portion 15 is severed by bending it back and forth in line with a seam 22 between the wallboards 18 & 19. Current claims 1 & 19 (dated 24/10/14) and the proposed claims 1 & 19 (dated 23/02/15) define that the "second limb can be knocked away by a hammer blow" and it appears that the examiner has interpreted D2 in light of the expression "can be". I am in agreement with Mr Burrows and Mayhew that there is no disclosure in the application where the supporting portion is knocked away by a hammer. However, there remains ambiguity surrounding the use of the expression "can be", which implies that the second limb is merely suitable for being hit by a hammer blow, and clips having a frangible portion broken by bending back and forth could be broken by a hammer blow as long as the direction of the blow was in the correct path. Both sets of claims (current and proposed) define that it is the second limb that can be struck by a hammer blow. However, it is clear that D2 discloses that it is the supporting portion 15 that is subjected to bending, which the examiner states is the web. It therefore appears that D2 does not appear to disclose knocking a second limb away with a hammer blow and therefore does not provide all the features as set out in claims 1 & 19.
27. D3 appears to be the best citation and discloses an auxiliary element 1 (clip) to aid in the installation of plasterboard. The examiner comments that the first limb is defined as clamping leg 2b, the second limb is midsection 3b and is connected to the first limb by a web, which is defined as initial part 3a having a breaking point 7. It is noted that the clip is anchored to a support by securing first part 1a to the support using a fastener inserted through bore 4. The recess 6 appears suitable for mounting a plasterboard panel therein and fig 5 discloses that the end 3c is pushed such that the second limb 3b is removed. In this regard it is conceivable that the skilled person would readily appreciate that the end 3c could be struck with a hammer blow to effect removal of the second limb. It is therefore my opinion that since the current claim 1 discloses that the second limb "can be" knocked away with a hammer, D3 appears to disclose the features set out in the current claim 1 (dated 24/10/14). Since claim 19 specifically required that the second limb is knocked away by a hammer blow, it is my opinion that D3 does not provide all the features as set out in claim 19.
28. At the hearing, Mr Burrows drew reference to the proposed claims (dated 23/02/15) and compared it with D3. He argued that there was no projection portion opposite the second limb 3b that is struck with a hammer. However, as discussed above with regards to the ambiguity of the expression "opposite side of the second limb" in that it is not clear what this comprises, it is my opinion that end 3c of D3 constitutes as a projection portion on the second limb 3b, and therefore discloses the features set out in the proposed claim 1. Mr Burrows went further to try and clarify the position of the projection portion with regards to fig 6 and argued that the projection portion is at the end of the web and it is this that is struck with a hammer blow so that the second limb can be knocked away.

Clarification was sought in this regard to the embodiment disclosed in figs 8 & 9. Mr Burrows stated that it is the thickened portion 34 that is hit with the hammer. I am inclined to agree with this assessment and a limitation to both claims 1 & 19 whereby they define that the projection portion is at the end of the web appears, prima facie, to circumvent D3 for Novelty.

29. In summary, I find that claim 1 as currently drafted (dated 24/10/14), does not comply with section 1(1)(a) of the Act insofar as it lacks novelty. However, I believe that the novelty objection could be overcome by suitable amendments to claim 1 to limit the scope of the invention. For example, by incorporating the suggested features of the proposed claims (dated 23/02/15) and defining that the projection portion is at the end of the web and it is this that is struck with a hammer blow so that the second limb can be knocked away.

### **Inventive step**

30. In the substantive examination report dated 11 November 2014 the examiner cited all of the above documents (D1 – D3) that were cited against claim 1 for Novelty in support of an inventive step objection against claim 19.

31. For the same reasons under Novelty, D1 & D2 are considered too far removed to render claim 19 obvious. In particular, the differences between the clips in D1 & D2 and the alleged invention constitute steps that would not have been obvious to a 'person skilled in the art' and would require a degree of invention. Therefore, I am not in agreement with the examiners assessment for D1 & D2. However, this leaves D3 for consideration.

32. Although not formally applied by the examiner, in addressing the inventiveness of the invention I used the approach laid down by Jacob LJ in *Pozzoli*<sup>2</sup>. That test comprises the following steps:

- (1) *(a) Identify the notional "person skilled in the art"*  
*(b) Identify the relevant 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.*

33. The notional person skilled in the art is considered to be a builder or plasterer, with access to the usual tools of those trades.

34. Mr Burrows and Mr Mayhew discussed that the 'inventive bit' was that the clip is used to install plasterboard panels by other than known traditional methods, for

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<sup>2</sup> Pozzoli SPA vs BDMO SA [2007] EWCA Civ 588.

example, by more than one person, using poles, lifts and hoists. In my view the inventive concept of claim 19 is the provision of a clip for anchoring plasterboard relative to a support, said clip having support limbs connected by a frangible portion, one of the limbs being removable by breaking of the frangible portion by a blow (from a hammer).

35. D3 appears to disclose all of the features of claim 19, except that it does not explicitly state that the second limb is knocked away by a hammer blow. The examiner asserts that this would be considered commonplace for a person skilled in the art, such as a builder.
36. The notional person skilled in the art would first have to appreciate that the device of this document could be suitable for modification. The clip of D3 is intended for the very specific purpose of installing plasterboard panels. With the known clip of D3, the person skilled in the art would have to modify how the end 3c is manipulated such that the second limb 3b is broken at breaking point 7. In this regard, it is my opinion that the skilled person would readily appreciate the advantages of using a hammer (a readily available tool) to quickly knock away the second limb as an obvious alternative.
37. Therefore, I find the current claim 19 not to be inventive with regard to the disclosure in D3 and does not comply with section 1(1)(b) of the Act. However, I believe that the suitable amendment to claim 19 to limit the scope of the invention by incorporating the suggested features of the proposed claims (dated 23/02/15) and defining that the projection portion is at the end of the web and it is this that is struck with a hammer blow so that the second limb can be knocked away would render claim 19 inventive.

## **Conclusion**

38. I find that independent claim 1, as currently drafted, does not comply with section 1(1)(a) of the Act insofar as it lacks novelty.
39. I find that independent claim 19, as currently drafted, does not comply with section 1(1)(b) of the Act insofar as it lacks an inventive step.
40. However, I believe that the novelty & inventive step objections could be overcome by suitable amendments to claims 1 & 19 to limit the scope of the invention (as outlined in paragraphs 29 & 37). Therefore, I order as follows:
41. The application is remitted to the examiner for further prosecution and for the filing of suitable amendments.
42. If suitable amendments are not made before the end of the compliance period, the application will be refused for failure to comply with section 18(3).

## **Other Matters**

43. I should comment on the administrative processing of the application and the compliance date under s.20 (rule 30) of The Act for putting the application in order. The applicant failed to reply to the initial examination report dated 28 July 2011, however the application was reinstated and a new reply date set for 5 September 2014. The original un-extended period for putting the case in order was 4 January

2015, the applicant extended this date by filing of a Patents form 52/77 to 5 March 2015. The application was thus live at the date of the hearing. No further extensions were requested by the applicant. However in light of the extended delay in issuing this decision I am exercising Rule 107(3) which states:

*107.- (1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.*

*(2)...*

*(a)...*

*(b)...*

*(3) a period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if-*

*(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and*

*(b) it appears to the comptroller that the irregularity should be rectified.*

44. As such I am allowing the Applicant 28 working days to make appropriate amendments as set out above, in line with the time remaining on the extended s.20 period at the date of the hearing.

## **Appeal**

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

## **P Mason**

Deputy Director, acting for the Comptroller