

**IN THE HIGH COURT OF JUSTICE**  
**CHANCERY DIVISION**  
**INTELLECTUAL PROPERTY ENTERPRISE COURT**

Royal Courts of Justice, Rolls Building  
Fetter Lane, London, EC4A 1NL

Date: 06/03/2014

Before :

**HIS HONOUR JUDGE HACON**

Between :

**F H BRUNDLE (a private unlimited company)** **Claimant**

- and -

**RICHARD PERRY** **Defendant**

- and -

**(1) BETAFENCE LIMITED**

**(2) BRITANNIA FASTENERS LIMITED** **Third Parties**

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**Stuart Baran** (instructed by **Collyer Bristow LLP**) for the **Claimant**  
**The Defendant** appearing in person  
**Jeremy Heald** (instructed by **Wake Smith LLP**) for the **First Third Party**

Hearing date: 23<sup>rd</sup> January 2014

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**Judgment**

**Judge Hacon :**

1. This is an action brought pursuant to section 70 of the Patents Act 1977 (“the Act”) to restrain alleged groundless threats of proceedings for infringement of a patent.
2. The Defendant (“Mr Perry”) is the proprietor of UK Patent No. 2 390 104B (“the Patent”) which relates to a fence bracket.
3. The Claimant (“Brundle”), a private unlimited company, is a wholesaler of metal products, including fences and component items for fences. In its range are a bracket used to attach fence panels to a post called the “Nylofor 3D Bracket”, which is sold in

two forms: the “Beam” and “Universal” forms, and a fence panel known as the “Nylofor 3M Panel”. These three products are all supplied to Brundle by the First Third Party (“Betafence”).

4. Brundle was represented by Mr Baran. Mr Perry appeared in person. Betafence was represented by Mr Heald.

### **The letters**

5. On 5 October 2012 Mr Perry wrote to Brundle (“the October Letter”). It was in the following terms:

**“FAO: Chief Executive/Chairman**

#### **Notice Before Proceedings**

Infringement of Patent GB2390104, 4 August 2003 - October 2011 Through Sales Of Betafence’s Nylofor 3D Bracket And 3M Panel

#### **Claim for Damages Under the Patents Act 1977.**

**Sirs,**

I have written to your Company in the past to see if you would have any interest in stocking any of my fencing products and your reply was that you didn’t sell any of these products or that type of fencing and your Company had no interest.

It has now been brought to my attention that your Company has been selling a product of Betafence known as Nylofor 3D bracket that is used to install Nylofor fencing, for over at least 5 years, according to your Southampton office and you in fact still sell these products.

This Nylofor product infringes my Patent and I demand that you provide an Account of Profits of direct profit on sales of:

1. The quantity of the Nylofor 3D bracket you have sold between August 2003 – October 2011.
2. The number of Nylofor 3M fence panels that have been sold during the same period that are installed using the Nylofor bracket.
3. The number of fence posts sold corresponding with the number of fence panels sold during the same period.
4. The quantity of add on products sold such as the allen key tool specifically designed to use with the Nylofor 3D bracket.

I am legally entitled to a share of these profits whilst the Patent was in force and which is currently being restored to the register, as it had lapsed temporarily due to Patent Office error in late 2011.

I intend to take proceedings against your Company in the High Court if no amicable solution can be reached regards paying me my share of the profits for your use of my inventions without any licence to do so. Please respond within 14 days or I will commence proceedings against your Company.

Sincerely,”

6. On 15 October 2012 Brundle’s solicitors replied, denying infringement by Brundle and alleging that Mr Perry had made unjustified threats. Mr Perry was invited to undertake that he would make no more such threats.
7. Mr Perry responded in a letter dated 21 November 2012 (“the November letter”). He asked for information about Brundle’s sales and addressed the sixth paragraph of the letter from Brundle’s solicitors as follows:

“Para. 6 Just to clarify, according to you, your client will be ignoring the Cease and Desist Notice and will continue to sell the infringing products. As you and your client both take the Patent Infringement very seriously, you will be providing the information I have asked you for and in the meantime I will put a hold on taking any legal proceedings against your client.”
8. In a letter dated 29 November 2012 Brundle’s solicitors enclosed an invoice from Betafence to show that Betafence had supplied Brundle and invited Mr Perry to take up his complaint with Betafence. Mr Perry was again asked for undertakings.
9. Mr Perry’s reply on 18 December 2012 (“the December Letter”) included the following:

“In your initial letter you are claiming ‘unjustified threats of legal action for alleged patent infringement’ and I pointed out that your client may still have a liability to me between 2004 – 2011 whilst the Patent GB2390104 was in force, ...”
10. Brundle alleges that the October, November and December Letters all contained threats within the meaning of section 70 of the Act; in the case of the latter two letters Brundle relies in particular on the passages I have quoted.
11. Brundle says that it is a person aggrieved by those threats, within the meaning of that section, and that the threats cannot be justified pursuant to section 70(2A) of the Act because sale of the relevant Nylofor products by Brundle (and any other acts done in relation to those products) did not infringe the Patent.

### **Counterclaim and Part 20 Claim**

12. The Claim Form and Particulars of Claim were served on 13 February 2013. Mr Perry served a Defence on 11 June 2013 together with a Counterclaim. He repeated and expanded on his Counterclaim in a letter served on 26 June 2013. The

Counterclaim alleges that Brundle infringed the Patent and Mr Perry's Part 20 Claim makes the same allegation against Betafence and Britannia Fasteners Limited.

13. I should also note that in the Counterclaim Mr Perry says, in the context of relief claimed (at paragraph 7), "I had filed designs on my products that have been copied at the OHIM". Nowhere has Mr Perry identified particular designs, or particular rights of any kind relating to designs of which he claims ownership. He referred to none at trial. I infer that Mr Perry in fact raises no claims in relation to designs and even if he had, I would have struck them out on the ground that they were not sufficiently identified and explained in the Counterclaim.

### **Opinion of the IPO under s.74A of the Act**

14. On 18 April 2013 Mr Perry filed a request at the Intellectual Property Office ("IPO"), pursuant to section 74A of the Act, for an opinion as to whether Betafence and Britannia Fasteners had infringed the Patent. In Mr Perry's submissions to the IPO the only product alleged to fall within the claims was the 'Beam' variant of the Nylofor 3D Bracket.
15. The written opinion was prepared by Susan Dewar, an Examiner at the IPO, and issued on 17 July 2013 ("the IPO Opinion"). The Examiner concluded the Nylofor Beam 3D Bracket did not fall within the claims of the Patent and therefore there was no infringement. I will return below to her reasons.
16. In an application made on 16 October 2013 Mr Perry requested a review of the Examiner's Opinion before the Comptroller of the IPO pursuant to section 74B of the Act. I was informed that the IPO has told Brundle's solicitors that the review has not taken place and will not take place before the trial of these proceedings.

### **Lapse of the Patent**

17. The Patent lapsed on 8 August 2011 due to non-payment of renewal fees. Mr Perry applied to the Intellectual Property Office and in a written decision dated 11 November 2013 G. J. Rose Meyer, Hearing Officer acting for the Comptroller, restored the Patent.

### **Issues set out at the CMC**

18. A case management conference was heard on 22 July 2013 before Arnold J. at which the following were identified as the issues to be determined at trial:
  1. Do the letters sent by D to C constitute a threat of proceedings for patent infringement?
  2. Is C a person aggrieved by D's threats?
  3. Were the threats unjustified as a result of the lapse of the Patent before the making of such threats?
  4. Is any of the products in respect of which threats were made a product falling within the claims of the Patent, namely:

- a. the Nylofor 3M fence panel
  - b. the Nylofor 3D bracket (“Beam” form); and/or
  - c. the Nylofor 3D Bracket (“Universal” form)?
5. Do C’s acts in respect of which proceedings were threatened by D constitute an infringement of the Patent?”

### **Application to transfer**

19. At a hearing before Arnold J on 20 November 2013 Mr Perry also applied to transfer these proceedings to the Patents Court, alleging in particular that he would be prejudiced by the £500,000 ceiling on damages in this Court. In response to this Brundle and Betafence agreed that this Court should have jurisdiction to award damages or profits in excess of that sum pursuant to CPR r.63.17A(3) in the event that Mr Perry were to succeed in his Counterclaim and establish an entitlement to an award above £500,000. Britannia Fasteners did not appear at the hearing. Arnold J adjourned the application to transfer but gave Mr Perry permission to restore it in the event that Britannia Fasteners did not agree to the lift on the cap for damages or profits.
20. As it turned out, Britannia Fasteners has neither served a Defence nor played any part in the proceedings. However the application to transfer the action to the Patents Court was not renewed.

### **The Issues**

21. The issues set out in the Order following the CMC on 22 July 2013 are those which I have to resolve, save for a narrowing of issue 4 and a point about the scope of the alleged threats, as I will explain. I will take the issues in sequence.

### **Do the letters sent by D to C constitute a threat of proceedings for patent infringement?**

22. A letter or other communication contains a threat of proceedings if a reasonable person, in the position of the recipient of the letter, with his knowledge of all the relevant circumstances as at the date on which the letter was written and taking the letter as a whole, would have understood the writer of letter to intended to convey an intention to enforce his rights by bringing legal proceedings, see *Best Buy v Worldwide Sales Corporation España* [2011] EWCA Civ 618; [2011] FSR 30, at paragraph 18. That case was concerned with an alleged threat to bring proceedings for infringement of a registered trade mark, but the principle of law is the same, as appears for example from *Best Buy* itself.
23. It is not necessary for a claimant in a threats action to prove that the defendant has in so many words said “I intend to issue proceedings against you for infringement...”. It is sufficient if the defendant has asserted that he has legal rights in respect of intellectual property and that he intends, as against the claimant, to enforce those rights; the threat to do so may be veiled or covert, conditional or future, see paragraphs 20 and 21 of *Best Buy*.

24. The threat in the October Letter was explicit. Mr Perry said in so many words that he intended to bring proceedings for infringement of his Patent against Brundle if no amicable solution could be reached. The threat was thus conditional on Mr Perry not being satisfied in due course by an offer of settlement from Brundle, but that makes no difference. The letter plainly contained a threat by Mr Perry within the meaning of s.70 of the Act.
25. The passage relied on by Brundle in the November Letter is less confrontational but in my view was still a threat to bring proceedings, this time conditional upon Brundle failing to provide information. It is also to be read in the light of the October letter.
26. Equally the December Letter must be read in the context of the earlier letters. Taken on its own there is no clear threat of proceedings, but it refers back to the earlier correspondence and I think that a reasonable reader would conclude that the earlier threat was being maintained.
27. Mr Perry pointed out that the October Letter was addressed to the attention of “Chief Executive/Chairman”. He submitted that worldly wise CEOs and Chairmen of companies such as Brundle do not take such letters seriously. I doubt that, but it is not to the point. If a reasonable person in the shoes of a CEO or Chairman would understand the words of a communication as containing a threat of infringement proceedings, the extent to which he or she goes on to treat the threat seriously is irrelevant. The threat has still been made.
28. There is a subsidiary issue as to the scope of the threat. The October Letter is directed to alleged infringement by reason of the sale of “Betafence’s Nylofor 3D Bracket And 3M Panel”. The question arises whether the reference to “Nylofor 3D Bracket” (singular) included both variants. The Particulars of Claim assume that it did and Mr Perry’s Defence does not dispute this. I therefore conclude Mr Perry probably intended to refer to both variants and, more to the point, that is what a reasonable recipient of the letter would have understood Mr Perry to mean.

### **Is Brundle a person aggrieved by the threats?**

29. It is well established that if the threats complained of are directed at the claimant, the claimant will be a ‘person aggrieved’ (without prejudice to the possibility that a claimant may in law be a person aggrieved, in certain circumstances, even if the threats reached him indirectly), see *Brain v Ingledeu Brown Bennison and Garrett* [1997] FSR 511, at 517 and 521, approved by the Court of Appeal in *Best Buy* (cited above) at paragraph 46.
30. The threats in the September, October and November Letters were all directed at Brundle, the addressee of those letters. Brundle is therefore a person aggrieved.

### **The Patent having lapsed before the making of the threats**

31. At the time the Particulars of Claim were served the Patent remained lapsed for non-payment of renewal fees. As I have mentioned, it was restored on 11 November 2013. The Claimant no longer pursues the argument that the threats cannot be justified solely because the Patent was unenforceable at the time the threats were made.

### **Does any of the products complained of fall within the claims of the Patent?**

32. Mr Perry's skeleton arguments did not allege that sales of either the Nylofor 3M fence panel or the Nylofor 3D bracket in the Universal form infringed the Patent. At the start of the trial he stated that he did not run any argument in relation to those two products. He said that they were relevant to damages or an account: if he proved that sales of the Nylofor 3D bracket in the Beam form ("the Beam Bracket") infringed the Patent, he would claim entitlement to damages or an account of profits in relation to Brundle's and Betafence's sales of associated products, namely the Nylofor 3M fence panel and the 3D Universal bracket.
33. Brundle and Betafence both admitted that if the Beam Bracket fell within the claims of the Patent they infringed.

### **The Patent**

34. Claims 2 to 9 of the Patent are all products claims dependent on claim 1. Therefore I need only consider whether claim 1 is broad enough to cover the Beam Bracket. The IPO Examiner for convenience divided claim 1 into nine features and I will follow suit. They are:
- (i) A bracket for securing a fence panel to a fence post
  - (ii) the bracket being adapted to embrace a corner of a fence panel
  - (iii) and comprising a main body having a rectangular central portion
  - (iv) adapted in use to lie along the top of the panel
  - (v) and two contiguous triangular portions
  - (vi) adapted in use to lie one each side of the panel
  - (vii) with one apex adjacent the post and the other spaced therefrom,
  - (viii) and flange means
  - (ix) adapted in use to lie against and be attached to the post.

### **The Law on Construction**

35. The law on the construction of patent claims is well established, following the principles set out in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46; [2005] RPC 9, as summarised and enumerated in *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors Group* [2009] EWCA Civ 1062; [2010] RPC 8.

### **Infringement**

#### *Person skilled in the art*

36. The Examiner (at paragraph 13) took the person skilled in the art to be "a person, or a team of persons, familiar with the design and manufacture of fence panels, posts and brackets". All parties were content with this definition and I will adopt it with the minor observation that I doubt there is a need for a team in this field.

#### *Characterising the elements of claim 1*

37. Claim 1 is a product claim. It has been divided by the Examiner into 9 features.
38. All 9 features are structural; they are limited by reference to physical form. That said, some of them, such as feature (iv): “[a rectangular central portion] adapted in use to lie along the top of the panel”, define the structure by how the bracket may be used. The Examiner therefore distinguished such features ((ii), (iv), (vi), (vii) and (ix)) from what she called “the main structural features” ((iii), (v) and (viii)). Of the former group, all but feature (vii) are qualified by the words ‘adapted to’ or ‘adapted in use to’. Feature (vii) belongs in this group for a different reason, which I will come to.
39. I agree that there is a distinction between two types of feature in claim 1, but I should clarify what I think the distinction is.
40. Possibly for shorthand, Mr Baran separated the features into ‘functional’ and ‘structural’ features. Strictly however all the features are structural. This is not a use claim.
41. The Examiner explained her understanding of how the terms ‘adapted to’ and ‘adapted in use to’ were to be interpreted. She said they meant ‘specifically designed to’. I am not sure that is exactly right either, since it implies that the structure of the features containing these terms is defined according to the subjective intent of the designer. Only the designer could know whether he was specifically designing something to achieve this or that purpose.
42. I approach this slightly differently. A comparison can be made with feature (i), which was not given any attention by the Examiner or the parties. Feature (i) is: ‘A bracket for securing a fence panel to a fence post’. Conventionally this will be taken to mean ‘A bracket *suitable* for securing a fence panel to a fence post’.
43. In recent years there has been some judicial reflection on the meaning of ‘for’ and ‘suitable for’ in a claim and in particular whether these terms might introduce a subjective element into the claim, see *Folding Attic Stairs Ltd v Loft Stairs Co Ltd* [2009] EWHC 1221; [2009] FSR 24, *FNM Corp Ltd v Drammock International Ltd* [2009] EWHC 1294 (Pat), *Zeno Corp. v BSM-Bionic Solutions Management GmbH* [2009] EWHC 1829 (Pat) and *Schenck Rotec GmbH v Universal Balancing Ltd* [2012] EWHC 1920 (Pat).
44. As this first feature of claim 1 was not the subject of any dispute there is no need for me to discuss its construction at any length. Aside from construing it as a bracket ‘suitable for’ the stated purpose, I add only that I do not interpret this as introducing any subjective element. This feature is to be assessed objectively through the eyes of the person skilled in the art.
45. Turning to features (ii), (iv), (vi) and (ix), I accept that as a matter of ordinary English usage, ‘adapted’ carries a connotation of adaption or modification in design to achieve the purpose stated in the feature. However in my view, like feature (i) these are to be construed such that they contain no subjective element. To my mind it is irrelevant where the designer started and what adaptations were made in the design process.
46. Because these features must be assessed objectively, it seems to me that ‘adapted to’ and ‘adapted in use to’ mean the same thing as ‘suitable for’. I am reinforced in this



view by the judgment of Birss J in *Schenck* (cited above) in which he found ‘constructed to receive’ had the same meaning as ‘suitable for receiving’. As in the present case the relevant claim was a product claim for a mechanical device: for fastening balancing weights to rotors.

47. I do not say that in the context of other claims it will never be possible to discern a difference between ‘suitable for’ on the one hand and ‘adapted to’ or ‘adapted in use to’, or ‘constructed to’ for that matter, on the other. But I think in this claim the first three mean the same thing.
48. So like the Examiner and the parties, I find it convenient to divide the features of claim 1 into two categories. One contains features defined solely in structural terms: (iii), (v), and (viii), and the other contains features with a structure defined by a purpose for which they are suitable: (ii), (iv), (vi), and (ix)), to which I add feature (i).
49. That leaves feature (vii). This feature is not defined by the words ‘for’, ‘adapted to’ or ‘adapted in use to’ However, for reasons that will be explained, its presence in a bracket also depends on the context in which the bracket is used, so it belongs in the latter of the two categories just referred to.

*The implied qualification in ‘suitable for’ claims*

50. ‘Suitable for’ and likewise ‘adapted to’ always bring with them a qualification. It may be that the feature in the product alleged to infringe *could* fulfil the purpose stated in the claim, but only if certain further steps are taken. A point will be reached where the further steps required are such that the need for them renders the feature unsuitable for (or ill adapted to) that purpose in the mind of the skilled person. This will always be a question of fact and degree. In *Qualcomm Inc v Nokia Corp* [2008] EWHC 329 (Pat) Floyd J said this:

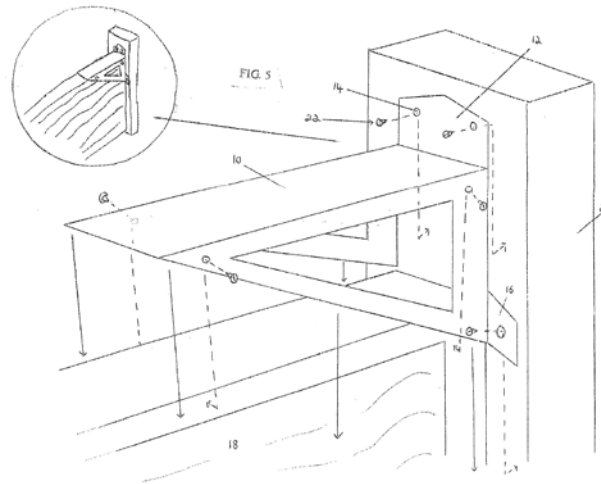
“[73] ... Perhaps more importantly in this particular case, it is important not to take the meaning of “suitable for” too far. Mr Antony Watson QC, who argued the case on the 324 Patent for Qualcomm with Mr Thomas Hinchliffe, started from the premise that an apparatus did not cease to infringe merely because it was switched off. So an apparatus for toasting bread infringes whether connected to the mains or not. He says this is just one example, and there is a general principle that an apparatus is still suitable for performing a particular function if it can be readily modified so as to perform that function. Mr Silverleaf accepts that a claim will be infringed if all that is required is to supply power. But he contends that modifications to the apparatus are not what is contemplated by “suitable for”.

[74] I think Mr Silverleaf is right. Supplying power to a toaster does not change the apparatus: it simply puts into use the apparatus which is there already. The question in each case is whether the apparatus, as it stands, is suitable for use in that way. If the apparatus has to undergo physical modification before it can be used, then *prima facie* it is not suitable for use and does not infringe.”

*Alternative fences*

51. Mr Perry proposed two possible contexts in which the Beam Bracket might be used: two types of fence. Before turning to those, Figure 5 of the Patent shown here

illustrates a wood fence panel and post of the type which the reader of the Patent is primarily invited to consider when being informed by the specification of the inventive bracket being claimed. I emphasise 'primarily' because claim 1 is not limited to a particular type of fence or post.



52. Annex 1 at the end of this judgment shows photographs of a mesh fence attached to a metal panel by a Beam Bracket. They are the sort of fence and panel for which the Beam Bracket is marketed.
53. Annex 2 shows a photograph of a Beam Bracket as used by Mr Perry to attach a wooden fence panel to a wooden post.
54. Mr Perry's case was that it was sufficient for his purposes to show that the Beam Bracket satisfied the features of claim 1 in either of the contexts shown in Annexes 1 and 2. Neither Mr Baran nor Mr Heald disputed this.

Features (iii), (v) and (viii)

55. I will start by assessing those features of the Beam Bracket which do not depend on the use to which the Beam Bracket is put.

Feature (iii)

56. It was common ground that the Beam Bracket has a main body having a rectangular central portion.

Feature (v)

57. The Examiner stated that 'contiguous' in feature (v) of the claim means that the two triangular portions both touch the rectangular central portion. I agree.
58. The Examiner and Mr Heald accepted that in the Beam Bracket the two side portions were triangular and therefore the Beam Bracket exhibits feature (v). Mr Baran argued that each side portion is quadrilateral in shape. This is true in that one of the corners or 'apices' is blunted. But I do not believe that the skilled person reading the Patent

would take the patentee to have intended such strict compliance with the word 'triangular'. It makes no difference that one of the apices of each of the broadly triangular side portions of the Beam Bracket is not sharp. I think feature (v) is present.

Feature (viii)

59. The Examiner said that the person skilled in the art would take the flange to be the 'tab' referred to at page 2, lines 1-6. Mr Perry went along with this and submitted that the tab or flange was the part of the bracket excluding the rectangular central portion and the triangular sides. What remains is broadly in a single plane, though with a number of projections perpendicular to the plane. He said that on this basis the Beam Bracket has a flange means. I agree.

Features (i), (ii), (iv), (vi), (vii) and (ix)

60. I turn now to the remaining features of claim 1, those which depend on how the Beam Bracket is used. I will consider first the Beam Bracket used with a mesh fence (Annex 1) and then as used by Mr Perry with a wooden fence (Annex 2).

*Mesh fence*

Feature (i)

61. It is common ground that the Beam Bracket is suitable for securing a mesh fence panel to a fence post as shown in Annex 1.

Feature (ii)

62. The bracket must be 'adapted to embrace a corner of a fence panel'. Figure 5 of the Patent (shown above) gives the skilled person an illustration of what this means. The corner of the fence panel is that defined by the top surface and the vertical surface adjacent the post. It is 'embraced' in that the rectangular portion lies along the top of the panel at that corner and the two triangular portions lie on each side of and against the corner of the panel.
63. Mr Perry argued that in the context of a mesh fence panel, the 'corner' of the panel is an upper portion of the vertical wire located at the edge of the panel, specifically the upper of the two stretches of the wire near the top of the fence which are each at about 45<sup>0</sup> to the vertical, forming an outwardly projecting 'V' in profile. It is the upper part of the V which is shown clamped to the post by the bracket in image 2 of Annex 1. He suggested that this part of the panel was 'embraced' by the Beam Bracket in that one of the triangular sides of the Beam Bracket was located to each side of the corner in use.
64. I think that the skilled person might take the nominated part of a mesh fence to be one of its corners. But I do not accept that the Beam Bracket is 'adapted to embrace' that corner. The word 'embrace' implies contact or something close to it. The specification indicates that there should be contact or very close proximity between the rectangular top and triangular sides of the bracket and more than one surface of

the corner of the fence panel so as to provide a stable and rigid fence. The following comes from the general discussion of the invention in the fourth paragraph on page 1:

“The bracket fits over the entire corner of the fence panel and not just one surface so that when fence panels and posts are joined with the fence bracket the entire fence structure becomes increasingly stable, rigid, strengthened and is less prone to damage from splitting of the fence panel or post timber.”

65. There need be no contact between the sides of the Beam Bracket and the corner of a mesh fence panel, as appears from Annex 1. At most there can only be contact by one of the sides. In this sense the Beam Bracket does not “fit over the entire corner of the fence panel and not just one surface”. The structure of the bracket is not such that it is adapted to embrace the corner of the fence panel. Feature (ii) is not satisfied.

Feature (iv)

66. Mr Perry argued that in the context of a mesh fence panel, the skilled person would take the top of the panel to be the plane joining the upper parts of the projecting Vs (see above) of all the vertical wires in the panel. I do not accept this. I do not think that the skilled person would identify this plane at all and I agree with the Examiner that the skilled person would regard the Beam Bracket as being attached to the front of the panel. Feature (iv) is not satisfied.

Feature (vi)

67. The triangular portions of the Beam Bracket are adapted in use to lie one each side of the vertical wire at the end of the fence panel. Mr Perry argued that the sides of that vertical wire are the sides of the panel. They are not. Feature (vi) is not satisfied.

Feature (vii)

68. Feature (vii) requires that in use one apex of each triangular side portion of the bracket should be adjacent the post and the other spaced therefrom. ‘Apex’ is not a term used in the description. The Examiner considered this (at paragraph 22). She took the view that it meant any vertex, i.e. corner, of the triangular side portion. She considered, but rejected, an alternative construction namely that the skilled person would conclude that ‘apex’ must mean the corner which is highest in use. This latter construction was supported by Brundle. On balance I agree. Feature (vii) refers to two apices. If both are corners highest in use and therefore both are located at the same height, it would follow that the side of the triangular portion which connects these two apices must be horizontal and above the third corner. This is consistent with feature (iv) which requires the rectangular portion in use to lie along the top of the fence panel. One of these apices must be adjacent to the post and the other spaced apart from it.

69. Mr Perry struggled to give a meaning to ‘apex’ in feature (vii). In my view this feature is not satisfied because the rectangular portion of the Beam Bracket is not horizontal in use and therefore there is only one apex.

Feature (ix)

70. The flange means of the Beam Bracket, as identified above, in use does lie against and is attached to the post. Feature (ix) is satisfied.

*The wooden fence*

71. I next consider whether features (i), (ii), (iv), (vi), (vii) and (ix) are present if the Beam Bracket is used with a wooden panel and post in the manner shown in Annex 2.

Feature (i)

72. There was a general objection to this part of Mr Perry's case raised by the Examiner and endorsed by Brundle and Betafence. I agree with the objection, though I would not identify it in the same way. I think it can most easily be identified in relation to feature (i).
73. If one leaves aside the central rectangular portion and the triangular sides of the Beam Bracket, what remains is what Mr Perry called the tab or flange. This includes a central portion of the flange (the part with a hole in its centre). To achieve the result shown in Annex 2 Mr Perry had to cut an indentation in the top of the fence panel to accommodate the central part of the flange. He was also obliged to create indentations in the posts to accommodate projections on each side of the flange.
74. As I discussed above, if one or more steps are required to render a product suitable for, or adapted to, a stated purpose, then beyond a certain limited point the need for such steps will lead the skilled person to conclude that the product is not suitable for that purpose.
75. Looking at Annex 2 it is clear that this use of the Beam Bracket only works if indentations are made in both the fence panel and the post. I take the view that as a consequence the Beam Bracket is not suitable for securing a fence panel to a fence post in this context.
76. I should point out that this was not the subject of evidence and indeed at the case management conference before Arnold J there was, rightly in my view, an order that there be no expert evidence. However it does not follow from such an order, particularly in this court, that the judge at trial cannot reach a view on a matter merely because it is capable of being influenced by expert evidence. In the present case I do not believe I need expert evidence to decide whether the need to cut indentations in the panel and post renders the Beam Bracket unsuitable for securing a fence panel to a fence post. In my view it does. Feature (i) is not satisfied.

Features (ii), (iv) and (ix)

77. The Examiner found (paragraph 26) that it is evident the Beam Bracket was not designed to be used in the way shown in Annex 2 and therefore does not exhibit features (ii), (iv) and (ix). Broadly I agree, though I would express this in terms of the Beam Bracket not being suitable for, and therefore not adapted to, stated functions because in order for Mr Perry to try to get close to achieving those functions it was necessary for him to make the indentations.

78. Furthermore, even with the indentations, the Beam Bracket does not get close enough. In Annex 2 the rectangular portion does not lie along the top of the fence panel (feature (iv)) and thus the bracket does not embrace a corner of the panel (feature (ii)). In addition the flange means does not lie against the post (feature (ix)). I think it would be possible to achieve either feature (iv) or (ix) separately, but not simultaneously. As shown in Annex 2 neither is achieved.

Feature (vi)

79. The Examiner found that feature (vi) is present. I am not so sure. It is true that as shown in Annex 2 the two triangular portions of the Beam Bracket lie one each side of the panel. But to my eye this is made possible only because of the indentations, without which the triangular portions would be largely raised above the top surface of the panel. On balance I think that feature (vi) is not satisfied because the need for indentations means that the triangular portions of the Beam Bracket are not adapted in use to lie one each side of the fence panel.

Feature (vii)

80. The rectangular portion is not horizontal and so there is only one apex. Even if one were to take both upper corners as being 'apices', the apex nearest the post is not adjacent to it. Feature (vii) is also not satisfied.

**Conclusion on infringement**

81. The Beam Bracket does not fall within claim 1. When used with a mesh fence as shown in Annex 1 it does not have features (ii), (iv), (vi) and (vii). When used with a wooden fence in the manner shown in Annex 2 it additionally does not have features (i) and (ix).

**Overall conclusion**

82. It follows that Mr Perry has no defence to Brundle's action for threats pursuant to section 70(2A) of the Act.
83. Brundle's action succeeds and Mr Perry's counterclaim against Brundle and his Part 20 Claim against Betafence and Britannia Fasteners are dismissed.

**ANNEX 1**



**Image 1**



**Image 2**

**ANNEX 2**

