

PATENTS ACT 1977

BETWEEN

Leonard S Stockley

Opponent
(Applicant for
Revocation)

and

Husqvarna UK Ltd

Patentee

PROCEEDINGS

Application under section 75 of the Patents Act 1977
to amend Patent EP(UK) 1367016 B1 in proceedings
before the Comptroller under section 72.

HEARING OFFICER Stephen Probert

Mr Ian Wood (of Mayer Brown International LLP) for the patentee
The opponent, Mr Leonard Stockley, appeared in person

Hearing date: 13th May 2010

DECISION

- 1 This is an application to amend patent EP 1367016 B1 (“the patent”) made by the patent proprietor, Husqvarna UK Ltd, (“Husqvarna”). The application was made under section 75, during proceedings for revocation that were brought by Mr Leonard Stockley. The facts are as set out in my earlier decision, BL O/402/09, in which I gave Husqvarna six weeks to amend the patent to my satisfaction — as provided by section 72(4) & (4A).
- 2 Three alternative sets of amended claims were proposed by Husqvarna on 10 February 2010, within the period that I had set. The Office would have advertised the third set of proposed amendments for opposition purposes, but Husqvarna requested a hearing so that they could argue in favour of the first and/or second sets of amended claims. At the hearing, Mr Stockley opposed all three proposed sets of amended claims. I now need to decide whether any of the proposed amendments is satisfactory.
- 3 The main difference between the three sets of proposed amended claims is conveniently illustrated in claim 1 of each set. These were the only claims that were discussed at the hearing. I have reproduced the three alternatives proposed

for claim 1 below; in each case the additions to the text are emphasised by double-underlining:

The first set - “Principal Request”

1. A lawnmower comprising a grass-box, a main body structure housing an electric motor and a cutting chamber, and a cable storage device comprising a spool (11) for storing an electric cable (14) in a wound-on configuration, the spool being rotatably mounted in a spool holder (2), **characterised in that** the spool holder is integrally formed with the grass-box of the lawnmower on an outside surface thereof and contains a spool which is rotatable manually.

The second set - “First Auxiliary Request”

1. A lawnmower comprising a grass-box, a main body structure housing an electric motor and a cutting chamber, and a cable storage device comprising a spool (11) for storing an electric cable (14) in a wound-on configuration, the spool being rotatably mounted in a spool holder (2), **characterised in that** the spool holder is integrally formed with the grass-box of the lawnmower on an outside surface thereof and contains a spool which is rotatable manually using an upstanding knob which is formed on the spool.

The third set - “Second Auxiliary Request”

1. A lawnmower comprising a grass-box, a main body structure housing an electric motor and a cutting chamber, and a cable storage device comprising a spool (11) for storing an electric cable (14) in a wound-on configuration, the spool being rotatably mounted in a spool holder (2), **characterised in that** the spool holder is integrally formed with the grass-box of the lawnmower on an outside surface thereof and wherein the spool (11) is rotatably mounted in a complementary recess (5) formed in the spool holder (2).

- 4 It was clear to me at the previous hearing that the invention **described** in Husqvarna’s patent is different from Mr Stockley’s invention. Mr Stockley’s invention concerns an arrangement for maintaining a small amount of tension in a lawnmower cable when the lawnmower is **in use**, in order to reduce the likelihood of users accidentally mowing across the cable. This was described at the hearing as “cable management”. On the other hand, Husqvarna’s invention is the idea of storing the lawnmower cable on a reel attached to (the outside of) the lawn mower when the lawnmower is **not in use**. This was described as “cable storage”.
- 5 I found the unamended patent to be invalid because the inventive concept in claim 1 did not involve an inventive step when compared with what Mr Stockley made available to the public when he showed Dr Cox his prototype. It seemed to me that Husqvarna should be able to amend the claims of their patent to more clearly distinguish their invention from that disclosed by Mr Stockley, and Mr Wood explained that the amendments he was proposing were intended to do precisely that — ie. emphasise the cable storage aspects of his invention. So for example, by narrowing the claims to spools that are rotatable manually, Husqvarna is seeking to exclude cable management systems, such as Mr Stockley’s, in which the spool is rotatable automatically. That is to say, where the spool is rotated in one direction by moving the lawnmower away from the power socket (thereby releasing more cable), and rotated in the other direction by

a spring (to wind cable back onto the spool) when the lawnmower is moved towards the power socket.

Inventive Step

- 6 The only question I need to decide in relation to these proposed amendments is whether they overcome the lack of inventive step that would otherwise invalidate the patent. There is no suggestion that any of the amendments adds matter or extends the scope of protection, both of which would be grounds for revoking the patent — see section 72(1)(d) & (e) of the Act. In approaching the question in each case I have gone back to the *Windsurfing/Pozzoli* approach as set out in my previous decision; the skilled person and the common general knowledge remain the same as before.

The first set - “Principal Request”

Step 2 — The Inventive concept

- 7 With regard to the first set of proposed amended claims, the inventive concept is a cable storage device integrally formed on an outside surface of the grass-box of an electric lawnmower, comprising a spool holder with a manually rotatable spool.

Step 3 — The difference from the prior art

- 8 I can see how the patentee has tried to differentiate the claimed inventive concept from the prior art, but I don't think the first set of proposed amended claims achieves it. For example, whenever Mr Wood stressed that Husqvarna's invention concerned cable storage as distinct from cable management, Mr Stockley responded by saying that when his lawnmower is not in use, the spool is essentially a cable storage device. The disclosure of his prototype may or may not have included disclosure of a spring to (automatically) wind the cable onto the spool. But in either case, Dr Cox would have seen a spool that was rotatable manually, regardless of whether it was also capable of being rotated by a spring or some other means.

- 9 As Mr Stockley reminded me, in my earlier decision I said at paragraph 54:

“54. I also note that Dr Cox, and/or any other member of the public who saw Mr Stockley's modified lawnmower before the priority date of the patent in suit, did not see a working prototype. The evidence is clear that, even with the assistance of Messrs Trehern and Patel from Magiglo, Mr Stockley did not manage to assemble a working prototype before the relevant date. Therefore, Mr Bowden's point in relation to the skilled person being interested in a retractable lawnmower cable (ie. that feeds and retreats to keep the cable off the ground when in use), carries less weight; because all that Dr Cox saw was a spool holder for holding a lawnmower cable, mounted on the inside lid of the grass-box. I have no doubt that Mr Stockley explained what his intentions were in relation to his invention, but that does not reduce the force of what Dr Cox actually saw, and what he was at liberty to pass on to others — ie. a spool of cable attached to the inside lid of a lawnmower grass-box.”

- 10 So the difference is the same as it was for the unamended claim, and since I have already found that that difference constitutes a step that would be obvious to the

person skilled in the art I do not need to go any further in relation to the first set. The principal request fails.

The second set - "First Auxiliary Request"

Step 2 — The Inventive concept

- 11 With regard to this set of proposed amended claims, the inventive concept is a cable storage device integrally formed on an outside surface of the grass-box of an electric lawnmower, comprising a spool holder with a spool that is rotatable manually using an upstanding knob formed on the spool.

Step 3 — The difference from the prior art

- 12 The difference here is undeniably greater than it was with the first set of proposed amended claims. The spool holder that Dr Cox saw in Mr Stockley's garage was not integrally formed with any part of a lawnmower. It was not on an outside surface of a lawnmower's grass-box. And he didn't see an upstanding knob formed on the spool with which the spool could be rotated.

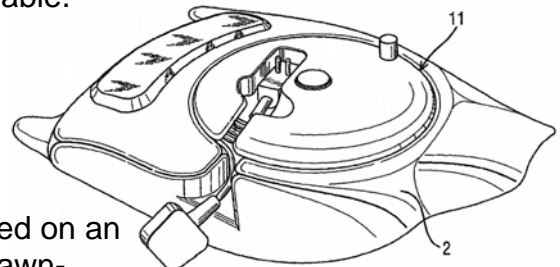
Step 4 — Is it inventive?

- 13 Taken by themselves, the individual differences noted in the paragraph above would almost certainly not be inventive. But that is not the correct way to approach this question. Considering the differences together, I believe they constitute steps that would **not** be obvious to the person skilled in the art. I have come to this conclusion fully conscious of the fact that Dr Cox did not see a working prototype. The inventive step involved is not a particularly big step, but I do believe it is an inventive step (and not an obvious step) to go from what Dr Cox saw, to what is now claimed in this proposed set of amended claims.
- 14 Ideally that would be the end of the matter, since Mr Wood made it clear that the patentee preferred this proposed set of amended claims to the third set. But I noticed after the hearing that claim 1 of the third proposed set of amended claims ("set three" — which I have not so far considered) has been incorporated as a new independent claim (claim 2) in the second proposed set of amended claims ("set two"). Fortunately the claim was discussed at the hearing — not as claim 2 in set two, but as claim 1 in set three. Consequently I still need to decide whether the third proposal for amending claim 1 is allowable.

The third set - "Second Auxiliary Request"

Step 2 — The Inventive concept

- 15 The inventive concept in this set of proposed claims is a cable storage device integrally formed on an outside surface of the grass-box of an electric lawnmower, comprising a spool holder (**2**) with a spool (**11**) that is rotatably mounted in a complementary recess in the spool holder.



Step 3 — The difference from the prior art

- 16 The difference between the inventive concept in this claim and the prototype that Dr Cox saw in Mr Stockley's garage is that the spool is mounted in a recess in the outer surface of the lawnmower.

Step 4 — Is it inventive?

- 17 Mr Wood was not expecting to have to defend this set of claims at the hearing, since I had previously indicated in an official letter of 15 March 2010 that I proposed to advertise this set of claims for opposition purposes. Furthermore, claim 1 of this proposed set of claims corresponds to claim 2 of the patent as granted, and Mr Stockley had not attacked claim 2 in the revocation proceedings; which raised the possibility that Mr Stockley might be estopped from opposing this form of amendment.
- 18 However, Mr Stockley argued strongly that this claim set was not inventive. For example, he pointed out that recessing the spool into the outer surface of the grass-box lid meant that in practice it was occupying the same physical space as the spool of his prototype that was mounted inside the lid. This is true, but I can see several very significant differences between these two alternatives. Recessing the spool into the outer surface means that the spool is protected from the loose (and potentially wet) grass chippings etc. inside the grass-box. It also means that the spool can be rotated manually without having to open the grass-box — a more important factor for Husqvarna given the nature of their invention.
- 19 But by far the most compelling of Mr Stockley’s arguments against this version of claim 1 was that I had already indicated in my previous decision that it was not inventive. Mr Stockley referred me in particular to two passages in that decision (at paragraphs 52 & 53) where I said:
- “52 ... I agree with Mr Stockley that the ‘step’ of incorporating the spool holder in a complementary recess in the lid of the grass-box would not require any degree of invention. I think it is something that the skilled person would instinctively consider when taking a crude prototype (which is all that Mr Stockley’s modified lawnmower was meant to be), forward into a polished and cost-effective production design suitable for a consumer market. ...”
- “53 ... For example, incorporating the spool holder in a complementary recess (which I have already found to be matter of routine design rather than invention) overcomes most if not all of the disadvantages that Mr Bowden highlights.”
- 20 Regardless of whether I am bound to follow these statements in my earlier decision, I have come to the same conclusion now when I consider the matter afresh. Once one has realised the benefits of mounting the spool on the outer surface of the grass-box, the additional step of recessing it into the lid really is a matter of styling preference such as would be considered as part of preparing the design for production. I therefore find that the third set of proposed amended claims (labelled “Second Auxiliary Request”) would not be allowable.

Next Steps

- 21 As the last (third) set of proposed amended claims is not allowable, it follows that I cannot accept the second set (labelled “First Auxiliary Request”) in its current form because claim 2 is identical to claim 1 of the third set. I am therefore allowing the patentee three weeks (from the date of this decision) in which to re-file the second set of amended claims with the current claim 2 deleted. The Office will then advertise this set of amended claims for opposition. If the claims

are not amended as I have indicated, I shall order the patent to be revoked under section 72 as stated in my earlier decision.

Costs

- 22 The issue of costs has been held over for some time, and I indicated to the parties at the hearing that I intended to deal with the parties' costs to date when issuing this decision. The costs were incurred during the main revocation action under section 72 that have not yet concluded, but which I expect to conclude shortly with (hopefully) no further cost implications between the parties.
- 23 I have received written submissions from both parties, which I have read carefully before completing this part of the decision. Both parties have, in different degrees, argued for costs above the standard scale, but I am satisfied that there was no unreasonable behaviour on either side that would justify off scale costs. The scale I have followed was published in Tribunal Practice Notice (TPN) 4/2007.
- 24 A written preliminary decision¹ was issued on 6th May 2009 in the revocation proceedings, dealing with various deficiencies with Mr Stockley's statement of case. The decision was made on the papers; there was no oral hearing. The matter of costs was specifically deferred until the end of the proceedings. It is clear from the decision (see paragraph 8) that Husqvarna played little or no part in the proceedings up to that point. I accept that Husqvarna did incur expense having to consider several versions of Mr Stockley's statement, and amending its own counterstatement. I therefore believe that Mr Stockley should pay Husqvarna £400 as a contribution towards those costs.
- 25 Mr Stockley was successful in the main revocation action. If the patent survives, it will only be because I have allowed Husqvarna to amend it to delete the claims that Mr Stockley proved were invalid. He is therefore entitled to a contribution to his costs in the action. I consider that Husqvarna should pay Mr Stockley costs as follows:

Preparing his statement and considering Husqvarna's counterstatement	£200
Preparing his evidence and considering Husqvarna's evidence. (The evidence in this case was definitely towards the 'light' end of the scale.)	£600
Preparing for and attending the hearing on 15 Dec 2009. (The hearing lasted 2½ hours.)	£500
Official fees	£50
Total	£1,350

- 26 Mr Wood submitted on behalf of Husqvarna that, had this action been subject to the Civil Procedure Rules, as a litigant in person Mr Stockley's costs would have been restricted to a maximum of two thirds of the costs he would have been awarded had he been represented. (See Rule 48.6(2) CPR.) I want to make it

¹BL O/118/09 by Mr A C Howard

clear that I have not reduced Mr Stockley's award of costs on this basis. If I was going to follow Rule 48.6(2) and apply a limit of two thirds, I would need to know how much a claimant with a legal representative would have been awarded under the Civil Procedure Rules.

- 27 Proceedings before the Comptroller are intended to be a lower cost alternative to the High Court; the published scale of costs is not intended to compensate parties for the expense to which they may have been put, but merely represent a contribution to that expense. Consequently I suspect that the figure I have awarded Mr Stockley according to the Comptroller's published scale is already substantially less than two thirds of the amount a legally-represented claimant would have got in the High Court according to the Civil Procedure Rules.
- 28 I am not making any award of costs to either party in relation to the application to amend under section 75. The hearing on 13th May 2010 was held by telephone and lasted just over an hour. Although Husqvarna's application to amend was (provisionally) successful, the hearing and any associated expense were not caused by Mr Stockley and it would not be right to expect Mr Stockley to bear any part of the cost of Husqvarna's application under section 75.

ORDER

- 29 The two awards of costs partially cancel out each other. Therefore, in view of the respective awards of costs, I order Husqvarna to pay Mr Stockley nine hundred and fifty pounds (**£950**) as a contribution to his expenses in the revocation proceedings.

Appeal

- 30 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

S PROBERT

Deputy Director acting for the Comptroller