



**PATENTS ACT 1977**

BETWEEN

Monkey Tower Limited

Claimant

and

Ability International Limited

Defendant

PROCEEDINGS

Application under section 72 for  
revocation of UK patent GB2432573

HEARING OFFICER

H Jones

---

**DECISION**

**Introduction**

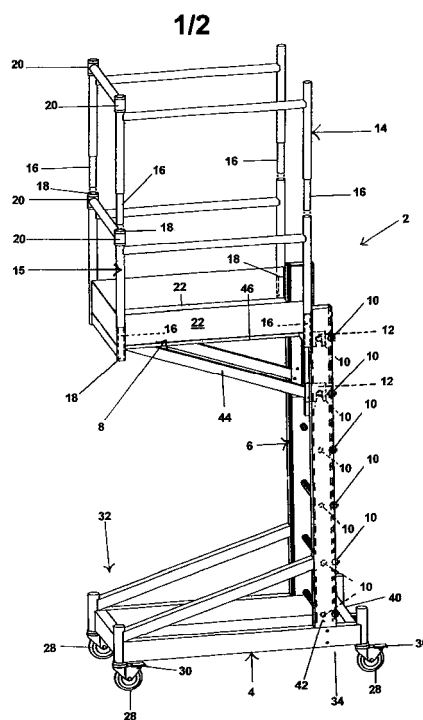
- 1 This decision relates to an application under section 72(1)(a) of the Patents Act 1977 (“the Act”) by Monkey Tower Limited (“MTL”) for revocation of UK patent [GB2432573](#) in the name of Ability International Limited (“AIL”). The patent relates to a platform for allowing overhead access in an office environment and has previously been the subject of a separate claim to entitlement before the comptroller ([BL O/247/11](#)).
- 2 MTL’s grounds for revocation as set out in their statement of case are that the invention is either anticipated by the earlier disclosure in [US2961060](#) (D1) or that it comprises trivial design features regarded as obvious in the light of this earlier disclosure. In their counterstatement, AIL deny that D1 anticipates or renders obvious any of the claims in the granted patent. Their counterstatement also includes a set of conditional amendments and other proposed changes to the claims in an attempt to further distinguish their invention from D1 in the case that the patent is found to be invalid.
- 3 I issued a written preliminary evaluation on the case in December 2012 with the aim of focussing attention on the main issues in dispute and to make further prosecution of the case as smooth as possible. In this evaluation I expressed a non-binding view that D1 appeared to anticipate claim 1 of the granted patent. At the first of two case management conferences held after issuing my preliminary evaluation, AIL maintained their position that the patent was valid in its current form, so I invited MTL to submit a supplementary statement in relation to the conditional amendments. I also gave AIL an opportunity to file a supplementary counterstatement in reply. In their supplementary statement, MTL submit that the conditional amendments to the claims and other changes proposed by AIL would either introduce additional subject matter contrary to section 76(3)(a) or would not assist in avoiding anticipation or

being rendered obvious by D1. AIL deny this, and maintain that the patent is valid in its current form.

- 4 A timetable for submitting evidence was agreed at the second case management conference and both sides were invited to consider the possibility of deciding this application for revocation on the basis of the papers on file. Evidence was received in the form of witness statements from Michael Holborn, who is one of the named inventors in the patent, and Alan Watt, who is a founder of MTL, together with further examples of documented prior art. AIL object to the introduction of new prior art during the course of the evidence rounds on the basis that it broadens MTL's pleaded case, and they have asked for it to be disregarded.
- 5 Both sides have indicated that they are content for the matter to be decided on the basis of the papers on file and have submitted skeleton arguments in advance of this decision.

### The patent

- 6 The patent was applied for on 23<sup>rd</sup> November 2005 and granted on 27<sup>th</sup> May 2009; there is no earlier claim to priority. It relates to an apparatus for permitting overhead access in areas such as large open plan offices filled with desks and computer equipment where space is at a premium. In order for maintenance engineers to access facilities such as light fittings mounted either at ceiling level or within ceiling voids, it is usually necessary for ladders and scaffolding to be used with bridging platforms placed over the desks. Ladders are generally regarded as being unsafe, and scaffolding equipment can take up a lot of space and requires more than one individual to erect and dismantle it safely. The invention avoids these problems by providing a stable platform that can be easily positioned over desks, as shown in the figure below:



7 The patent has a single independent claim, claim 1, which reads as follows:

1. Apparatus for permitting overhead access for a workperson, which apparatus comprises a base section, mast means which in use upstands from the base section, and a platform which is secured to the mast means remote from the base section, and the apparatus being such that in use the platform extends outwardly from the mast means, the base section extends underneath the platform and thereby enables the platform to be stable when occupied by the workperson, the base section is constructed so that it is able to extend underneath at least desk tops whereby the platform then provides access over desk areas, the mast means is a telescopic mast means which is adjustable in height in order to support the platform at different working heights, and the mast means includes rungs whereby the person is able to climb to the platform when the platform is at a desired height.

### The law

8 Section 72(1)(a) of the Act gives the comptroller power to revoke a patent on application by another person if the invention is not a patentable invention. An invention is patentable if it meets the conditions set out in section 1(1), namely that the invention is new, it involves an inventive step, it is capable of industrial application and is not excluded.

9 Sections 2 and 3 of the Act define what is meant by “new” and “inventive step” respectively. Section 2 states that an invention shall be taken to be new if it does not form part of the state of the art; it goes on to define the state of the art as comprising anything made available to the public before the priority date of the invention. Section 3 states that an invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art. Finally, section 125 of the Act specifies that an invention shall be taken to be defined by the claims as interpreted by the description and any drawings in the patent specification.

10 There is no issue between the parties as to the applicable law.

### The case for revocation

11 MTL argue that the apparatus for permitting overhead access defined by claims 1, 2, 5, 6, 7, 11-15, 17 and 22 of the patent is anticipated by the disclosure in US 2961060 (document D1 as referred to above).

12 In my written preliminary evaluation I referred to the comments of Sachs LJ in *General Tire and Rubber Company*<sup>1</sup>, pages 485-6, as the leading authority on anticipation:

*"If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated."*

This approach was approved by the House of Lords in *Synthon BV*<sup>2</sup> (cf Lord Hoffman's

---

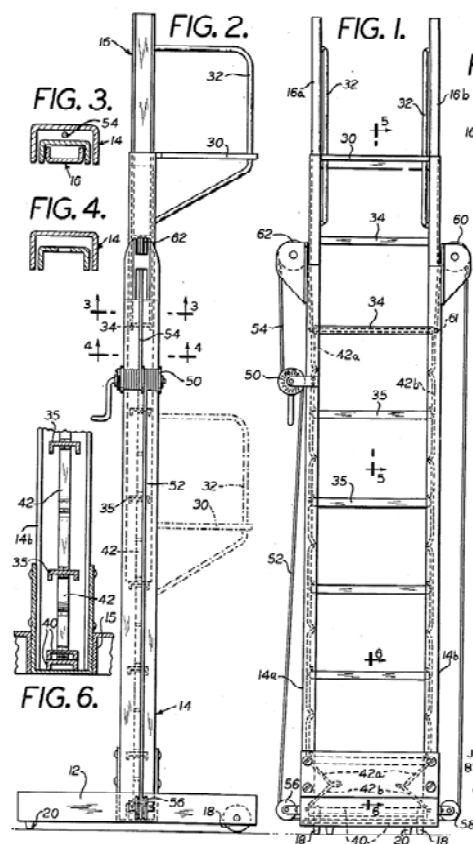
<sup>1</sup> *General Tire and Rubber Company v The Firestone Tyre and Rubber Company Ltd* [1972] RPC 457

<sup>2</sup> *Synthon BV v Smithkline Beecham Plc* [2005] UKHL 59

leading judgment at paragraph 24):

*“...that anticipation requires prior disclosure of subject-matter which, when performed, must necessarily infringe the patented invention.”*

- 13 There is no major issue regarding the understanding of the invention or how the claims should be construed: MTL suggest that the word “outwardly” in claim 1 to describe the position of the platform with respect to the mast is not entirely unclear, and in their analysis of the prior art they say that they have construed the term in a way which is consistent with that shown in the drawings, i.e. that the platform extends horizontally in a perpendicular direction away from the mast.
- 14 Document D1 (US2961060) was published before the priority date of the patent and describes an extensible ladder and scaffold construction as shown in the figures below:



- 15 MTL argue that claim 1 is wholly anticipated by D1. They say that the extensible ladder and scaffold construction in D1 is quite clearly intended to allow overhead access to a workperson. It has a base section (12), a mast/ladder (14) which in use upstands from the base section, a platform (30) secured to and which extends horizontally and perpendicularly from the mast, and the base section extends underneath the platform such that it provides stability to the device when the ladder “is in its fully extended position and supporting a man” (column 2, lines 29-33). The part of the base section to the right of the ladder in fig. 2 above may be pushed underneath a desk and the platform (30) would overlie (but may be spaced from) the desk top. MTL say that the ladder is telescopic, which allows the platform to be raised and lowered as required “to meet the needs of individual jobs and that convenient access may be had to said platform, irrespective of its working elevation”

(column 1, lines 65 to 69). The ladder has rungs 34 and 35, the rungs 34 being fixed steps associated with the platform arrangement and the rungs 35 being movable steps whose number and position vary depending on the position of the platform.

- 16 Reference is made in Alan Watt's witness statement to a further piece of prior art shown in [US4427093](#) and in an associated operating manual. He also refers to a device called the "Genie Runabout™" and provides a copy of the operating manual as an exhibit. AIL object to the introduction of this new prior art on the basis that it broadens MTL's pleaded case, and they have asked for it to be disregarded. I would have been minded to agree with AIL on this point, but in view of the fact that MTL do not rely on this prior art in their skeleton arguments then I do not need to consider it any further.
- 17 AIL argue that the inventive concept of the patent is an apparatus comprising a C-shaped structure which permits overhead access over desks in an office environment. They say that document D1 does not disclose a C-shaped structure and therefore it cannot anticipate the present invention. The reference to a C-shaped structure derives from the Hearing Officer's comments in the earlier decision concerning entitlement (*BL O/247/11*), where it was found that the inventive concept was "the combination of the C-shaped structure with the mast and rungs." In that case it was necessary for the Hearing Officer to identify the actual deviser of the invention, and in order to do so he needed to determine the inventive concept of the patent and then proceed to identify who devised that concept. This is what the law requires in entitlement proceedings. However, as far as anticipation is concerned, the law is quite clear in that it is the claimed invention that is important, not the inventive concept. MTL argue that claim 1 of the granted patent has no limitation to a C-section structure, as such, and I agree with them.
- 18 AIL argue that the mast in D1 is not telescopic in the sense required by claim 1 of the patent. They say that the correct construction of the claim is that "telescopic" applies to the entire mast which extends from the base section to the platform, and that the concept of telescopic is of a mast with inner and outer portions where one fixed mast portion slides in relation to another fixed mast portion. They say that D1 does not disclose this because the lower portion of the mast arrangement has a series of movable (or "collapsible") steps 35, which are said to be quite different from "telescopic". They add that in D1 it is the folding/unfolding action of the mast which adjusts the height and supports the platform at the different working heights, which in claim 1 of the patent is required to be achieved by the telescopic effect.
- 19 The various dictionary definitions of the word "telescopic" describe an arrangement of two or more concentric tubes designed to slide into one another to provide a shaft of variable length. This is consistent with the meaning of "telescopic" taken from the specification, which describes the telescopic mast as comprising an outer mast portion and an inner mast portion, where the outer mast portion is fixed to the base section and the inner mast portion is extendable and retractable with respect to the outer mast portion. In D1, fig.2 shows a upper ladder section 16 consisting of a pair of channel members 16a and 16b, which are said at column 2, lines 50-54 to be "slidably and telescopically supported" by the lower channel members 14a and 14b of the lower ladder section 14. I agree with AIL that the rung arrangement of the lower ladder section of D1 is quite different to the one described in the patent, i.e. the rungs are collapsible/foldable and not fixed, but I do not accept their argument that the entire mast/ladder arrangement in D1 cannot be described as being telescopic.

- 20 In their counterstatement, AIL argue that D1 is not relevant because the size of the platform allows for only “spot” access as opposed to the relatively substantial area of the platform shown in the patent. This argument has not been put forward in their skeleton arguments, but for completeness I should say that I agree with MTL’s observation in their supplementary statement that D1 also describes the platform as being relatively large. I also note that claim 1 of the patent does not limit the size of the platform in any way other than it needs to provide access to a workperson.
- 21 Turning to MTL’s analysis of claim 1 and the relevance of D1 as summarised above, I find that I am in total agreement with them that each and every one of the features specified in the claim can be found in this piece of prior art. In particular, D1 is an apparatus for providing overhead access to a workperson; it has a base section, a telescopic ladder mounted onto the base and a platform secured to the telescopic ladder which extends out from the ladder and above the base; the height of the platform can be adjusted by extending or lowering the telescopic ladder, and the platform is accessible to the workperson by climbing the telescopic ladder; the base is able to fit under desks and the telescopic ladder is mounted in such a position on the base that the platform would provide access over a desk area. The extensible ladder and scaffold construction disclosed in D1 would, in my view, infringe claim 1 of the granted patent, and so the claim must be anticipated.
- 22 Having found that claim 1 is anticipated by D1, I do not need to consider MTL’s further arguments that the remaining claims are either anticipated or lack an inventive step; MTL’s case for revocation of the granted patent has been made out. I now turn to consider the conditional amendments proposed by AIL in the event of an adverse finding on the validity of the granted patent.

### **Conditional amendments**

- 23 Section 75 of the Act gives the proprietor of a patent an opportunity to amend the patent in any proceedings before the comptroller in which the validity of the patent is put in issue. In the conditional amendments submitted with their counterstatement, AIL propose to amend claim 1 by specifying that the mast means “includes permanently spaced apart” rungs “which enable the person to be able to climb to the platform when the platform is at a desired height”. The aim is to distinguish the fixed rung arrangement of the invention from the collapsible/foldable arrangement disclosed in D1. They also propose to add a new claim 2 relating to the C-shaped structure of the apparatus, as referred to above, and to add new claims 3 and 4 relating to the lower support struts, which extend between the base section and the mast, and the upper support struts, which support either side of the underneath of the platform, respectively.
- 24 MTL oppose these amendments on a number of grounds. They argue that the proposed amendment to claim 1 does not require all of the rungs of the mast to be permanently spaced apart, but rather only for the mast to include rungs which are spaced apart. They say that the upper ladder section disclosed in D1 has a number of permanently spaced rungs for climbing to the platform and that this satisfies the proposed limitation to claim 1 of the patent. I agree with MTL that the word “includes” does not require the whole of the mast section to have permanently spaced apart rungs. The upper ladder section of D1 is described as having permanently spaced apart rungs and therefore would, in my view, infringe the amended claim. In other words, amended claim 1 is anticipated by D1.

25 MTL argue that the proposed amendment to claim 2 adds subject matter contrary to section 76(3)(a) of the Act. The proposed form of claim 2 reads as follows:

2. Apparatus according to claim 1 in which the mast means in use upstands from a rear part of the base section.

MTL say that the specification of the patent makes it clear that the mast upstands from a location adjacent a rear part of the base section, not from the rear part of the base section. They say that there is no basis in the specification for a mast means upstanding from a rear part of the base station. They also argue that if the proposed amendment to claim 2 does not offend against section 76(3)(a) then the actual position of the mast is a mere design choice, so long as the base extends forwardly under the platform. Since the “rear part” of the mast is of a wholly indeterminate length, though presumably less than one half the length of the base, they suggest that the ladder of D1 is also adjacent the rear part of the base. Thus, claim 2 either lacks novelty or is a mere design detail lacking in any inventive step.

26 I do not agree with MTL on these points. First of all the specification does in fact show the mast as being positioned towards one end of the base as opposed to being at the centre, and this is deliberately so in order to provide the maximum amount of platform space over the desks that can be supported by the base section. The upper and lower struts introduced by proposed amended claims 3 and 4 provide the necessary stability for the mast and platform, but it is the offset position of the mast with respect to the centre of the base which allows the platform to extend significantly over desk areas. I accept that there may be issues concerning the clarity in which the position of the mast is defined with respect to the base section, but that is not to say that there is no basis for making an amendment which seeks to limit the apparatus to the C-shaped (or offset) configuration quite clearly described in the specification. Second, I do not think that the position of the mast is a matter of design choice. Its position towards one end of the base section is important in maximising the amount of platform space over the desks which the base section can support. Finally, although the way in which proposed claim 2 is worded means that D1 can be said to anticipate the invention, i.e. in that the mast in D1 can be said to be positioned adjacent the rear part of the base, I do not consider that document D1 discloses an offset mast for the same purpose and benefits set out in the specification of the patent. On the basis of the evidence submitted as part of these proceedings, I consider that it would be perfectly possible to encapsulate the offset mast arrangement of the invention into a form of words that is clear and does not add subject-matter, and to avoid anticipation or be rendered obvious by document D1.

27 As far as the proposed amendments to claims 3 and 4 are concerned, MTL argue that the triangular struts provide support to the mast (in claim 3) and to the platform (in claim 4) in a way that is well known in the engineering industry. They argue that there cannot be anything inventive in providing such triangulation struts, which would have been obvious to an ordinary skilled design engineer and would form part of his common general knowledge. As AIL point out, no expert evidence has been provided by MTL to substantiate this, but even my limited knowledge of engineering techniques would lead me to conclude that, on the balance of probabilities, MTL are right to say that the addition of triangulation struts would be an obvious way to enhance stability. As a result, I find that amended claims 3 and 4 when dependent on claim 1 are lacking an inventive step over D1.

## **Conclusion**

- 28 I have found that claim 1 of the granted patent is anticipated by US2961060 and that the patent should therefore be revoked. I have considered the conditional amendments submitted by the patentee and I have found that there is a reasonable basis for an allowable form of claim based on the offset-mast arrangement disclosed in the specification of the patent and that AIL have attempted to specify in amended claim 2. The invention defined by amended claim 1 is anticipated by D1. The invention defined by amended claim 2 is anticipated by D1 and its scope is unclear, but it should be possible to revise the wording in order to overcome these deficiencies. Amended claims 3 and 4 when dependent on amended claim 1 are lacking an inventive step.

## **Order**

- 29 I order that amendments to the claims should be formally requested within six weeks of the date of this decision and that they should be advertised in accordance with section 75(1). If amendments are not formally requested then the patent will be revoked. If the patent is not amended to the satisfaction of the comptroller in the light of the findings in this decision or to any notice of opposition under section 75(2), the patent will be revoked.

## **Costs**

- 30 MTL have succeeded in their case for revocation of the granted patent and have asked for an award of costs in their favour. They have asked that the award be enhanced to reflect the fact that AIL insisted on maintaining the patent in its unamended form despite the non-binding view I expressed in my preliminary evaluation and the unnecessary work the say was consequent upon it. Neither side has argued for an award of costs departing from the standard Office scale.
- 31 Tribunal Practice Notice 4/2007<sup>3</sup> sets out the standard scale of costs and explains how costs are to be determined. The award of costs to MTL will need to reflect the cost in preparing their statement of case, for commenting on AIL's conditional amendments, for the preparatory work leading up to the case management conferences, for preparing skeleton arguments based on the unamended claims, which they say was unnecessary, and for preparing skeleton arguments based on the conditional amendments. I am not prepared to make an award of costs to MTL for preparing their evidence on the basis that, as AIL rightly point out, it introduced new prior art into proceedings and broadened their pleaded case. Taking all of this into account, I order that AIL pay MTL a sum of £1400 as a contribution to their costs in the revocation proceedings, this sum to be paid within seven days of the expiry of the period for appeal.

---

<sup>3</sup> <http://www.ipo.gov.uk/p-tpn-42007>



## **Appeal**

32 Any appeal must be lodged within 28 days.

**H Jones**

Deputy Director, acting for the Comptroller