

Argument and Analysis

Claim construction

- 6 The examiner sets out the legal basis for interpreting the claims in paragraphs 27-28 of the Opinion, referencing section 125(1) of the Act and guidance provided by the Courts in *Mylan v Yeda* and *Actavis v ICOS*. The patentee adopts the same approach and quotes these paragraphs, therefore there is no dispute in this regard.
- 7 At paragraph 29 of the Opinion, the examiner considers that the skilled person is a fencing engineer after being invited to do so by the requestor. The patentee does not contest this and refers to fencing engineers in its arguments.
- 8 The disagreements in construction essentially amount to two questions: “What is a palisade fence?” and “What is a pale?”. I will deal with each in turn in the same way that the patentee has done in its statement of grounds.

Palisade Fence

- 9 The examiner sums up the construction of palisade fence in paragraph 36 of the Opinion as “a fence that comprises a number of upright support posts, with upper and lower rails which extend between the posts and having a plurality of elongate upright pales mounted to the rails.”
- 10 At paragraph 35 of the Opinion, the examiner points out that while British Standard BS 1722: Part 12 1990: Specification for Steel Palisade Fences is mentioned on page 5 of the description, the claim is not limited to fences of this type.
- 11 The patentee argues that the use of the term ‘palisade fence’ clearly means that a specific sort of fence is intended. It says that the skilled person would understand that a palisade fence is specifically a “security purpose and/or defensive” structure, and that this limitation can be implied into the claim construction. The patentee provides support for this argument in the form of a witness statement by a Mr Mooney (Exhibit 3), in which he initially sets out his extensive experience in the fencing industry and then at paragraphs 9-20, provides opinions on the prior art. I will return to Mr Mooney’s assessment of the prior art when considering the question of novelty below.
- 12 At paragraph 21 of his witness statement, Mr Mooney reiterates that prior art fences are ‘railings’ for decoration and demarcation, and are not palisade fences. He states that palisade fencing is security fencing. At paragraph 22, Mr Mooney notes that ‘Steel palisade fences’ had previously been called ‘corrugated steel pale fencing’ and had a particular configuration of pale. Finally, at paragraph 23, Mr Mooney draws the distinction between BS1722: Part 9, which he calls ‘vertical bar railing’, and BS1722: Part 12 Steel Palisade Fencing.
- 13 Exhibit 4 is essentially a contents page for BS1722 and sets out the various parts of the standard. The patentee draws attention to “Part 6: Fencing. Wooden Palisade Fences” and “Part 12: Specification for Fences. Steel Palisade Fences”. As noted above, Mr Mooney also refers to “Part 9: Fencing. Mild Steel or Wrought Iron Unclimbable Fences”, the official title being somewhat different from Mr Mooney’s ‘vertical bar railing’ description.

- 14 The patentee sums up by saying that a palisade fence is not any fence, that it is a “security purpose and/or defensive” fence structure and adopts Mr Mooney’s distinction between security and demarcation/decoration fences.
- 15 Taking the first of these three points, that a palisade fence is distinct from fences in general, it seems to me that the examiner has clearly construed palisade fence to mean a fence with a particular physical structure and thereby distinguished the term from fences in general, as the patentee has asserted. So, on the face of it, there is no dispute and no error on the part of the examiner. Alternatively, the patentee might be suggesting that, because the physical structure ascribed to the palisade fence by the examiner is, by and large, explicitly specified in the claim, the use of the term palisade fence must imply that something beyond the physical structure is intended. For completeness I shall consider this proposition.
- 16 While claims are required to be concise according to section 14(5)(c), their drafting is rarely, if ever, an exercise in perfection. Therefore, had the skilled person adopted the examiner’s construction of palisade fence and then observed the duplication of features that resulted, I do not think that they would clearly conclude that ‘palisade fence’ must mean something more. Instead, I think that it would be perfectly reasonable for the skilled person to conclude that the definition had simply employed a redundant use of language. Therefore, I can see no clear error in the examiner’s assessment in this regard.
- 17 Moving on to the second point, would the skilled person read ‘palisade fence’ and inherently interpret that as being a security/defensive fence? Considering the list of BS 1722 parts, I have accessed the British Standards Institute website that the list was obtained from. Following the links therein it appears that Part 17 and Part 18 did not exist at the claimed priority date of the invention (15 September 2003) but that some form of Parts 1-16 did exist at the priority date of the invention. The parts appear to be updated individually and irregularly, so in many cases the version existing at the priority date is not the current version. However, since we only have the titles of the Parts to consider and not their content, this should not have a bearing on the subject-matter of this review. Thus, the list of Parts 1-16 will be considered as being applicable at the priority date of the patent.
- 18 Some of the parts (e.g. Part 9: Fencing. Mild steel or wrought iron unclimbable fences and Part 10: Specification for fences. Anti-intruder chain link fences) suggest an explicit security application. Most of the remainder (e.g. Part 1: Fences. Specification for chain link fences and Part 14. Fences. Specification for open mesh steel panel fences) only seem to relate to a particular construction of fence. The palisade fence Parts 6 and 12 fall into this latter category, therefore I do not consider that this document clearly indicates a security application for palisade fences.
- 19 Considering Mr Mooney’s witness statement. At paragraph 21 he says that a palisade fence is a security fence and that it can be distinguished from the decorative/demarcation fencing of the prior art. The references in paragraphs 22 and 23 to steel palisade fencing and BS 1722 Part 12 suggest that Mr Mooney may be conflating this particular type of palisade fencing with palisade fencing in general. His lack of reference to the wooden palisade fencing of BS1722 Part 6 also suggests that he may not have been instructed to consider palisade fences in the round.
- 20 The examiner explicitly construed the claim as not being limited to fences which comply with BS 1722 Part 12, and the patentee has not contested this point.

Therefore, the palisade fences specified in claim 1 encompass a broader range of fences than specified in BS 1722 Part 12. I do not consider that Mr Mooney's statements can be clearly and reliably extrapolated to suggest that all palisade fences must be security fences.

- 21 Looking to the patent itself, very little mention of security is made, and none of defence. On page 2 it is stated that the prior art fence from the same inventor, shown in GB 2256447 B, has been supplied for security applications. This form of words is ambiguous as to whether security is a characteristic of the fence or an application of the fence. Furthermore, the passage relates to a specific example of a palisade fence and cannot be reliably extrapolated to palisade fences in general.
- 22 If one follows this thread and looks at GB 2256447 B itself, it says on page 1 that "Palisade fencing has been in use for over one hundred years and has been used in many applications, for example, providing boundary fences for parks and playing fields and in security applications for protecting special security compounds and works." This directly contradicts the patentee's assertion that palisade fencing must be security/defensive fencing.
- 23 Nevertheless, looking at the claimed benefit provided by the invention, it is a more robust attachment of pales to rails through the use of both apertures and fasteners. While this would have a security benefit, it would also provide a more robust fence in general. This would lead the skilled reader away from thinking that limitation beyond the defined structural elements to security specific fences was necessary or intended.
- 24 Taking all of this into account, I do not consider that palisade fences must clearly be security/defensive fences as the patentee suggests. Therefore, I can find no clear error on the part of the examiner in omitting this feature from the construction of the claim.
- 25 For the patentee's third point, which attempts to distinguish between security and demarcation/decorative fences, it seems to me that all fences will demark to some extent, so there is no implicit distinction between security and demarcation fences. In other words, security fences are clearly just a subset of demarcation fences. Similarly, 'security' and 'decorative' are subsets of fences that are not mutually exclusive. Therefore, saying that a fence is decorative says nothing about whether it is secure, and the distinction drawn is not useful in assessing the scope of the claims.
- 26 To summarise, the examiner has construed palisade fence as a class that is distinct from fences in general, the apparent implied duplication of features resulting from the examiner's construction does not clearly imply that a further implicit feature must be present and it is not clear that a palisade fence must be a security/defensive fence. Hence no clear errors in the examiner's construction of palisade fence have been established.

Pale

- 27 At paragraph 38 of the Opinion, the examiner construes pale to be a vertical elongate fence member and makes the point that the cross section of the pale is unconstrained. The patentee asserts that the skilled person would consider that the elongate fence member should also have an elongate cross section in order to

qualify as a pale. The patentee says that a skilled person understands that the pales of palisade fences are constructed from sheet material which is then cut and formed into a number of different shapes, usually into corrugated and/or angled shapes as referred to on page 1 of the patent. The patentee says that while the shape of the cross-section is not essential, the need for an elongate cross-sectional shape of some description is a requirement of a pale that would be understood by the skilled person.

- 28 The patentee does not provide evidence in support of this position - it is merely an assertion of a position that is different from the examiner's. As such it is not enough to establish a clear error on the part of the examiner. Secondly, if one considers the Wooden Palisade Fences of BS1722: Part 6, it is highly unlikely that their pales are cut and formed from sheet material as asserted. This rather undercuts the patentee's line of reasoning on this point. I am not, therefore, convinced that the cross-section of pales must clearly be limited to pales with elongate cross sections, and hence I can find no clear error in the construction adopted by the examiner.

Novelty

- 29 The patentee makes arguments with respect to the novelty of claims 1 and 2. I shall deal with each claim in turn.

Claim 1

- 30 The patentee argues that the fences in prior art documents D1 and D2 are not "security and/or defensive fence structures" and that their pales do not have elongate cross sections, so do not anticipate claim 1. I have already found that the examiner was not clearly wrong in his construction of the claim, therefore I do not need to consider these points further. However, for completeness, if I wrong on this, i.e. that claim 1 is restricted to security/defensive fence structures, then I will consider novelty of such a claim with respect to D1 and D2.
- 31 In the 'Background Art' section of D1, it is stated that prior art wrought iron fences serve as security barriers and that the invention of D1 is intended to replace those wrought iron fences with a cheaper, more easily constructed modular fence. The skilled reader would therefore understand that D1 was intended to serve as a security barrier. In the Background Art section of D2, it is stated that vertical fencing is adapted as security fencing and includes features to reduce the likelihood of climbing. The invention of D2 then clearly identifies itself as being vertical fencing. Hence, both D1 and D2 disclose fences intended for use as security structures which would still anticipate claim 1 even if the patentee's construction were adopted.
- 32 The patentee also references Mr Mooney's statements that D1 and D2 disclose 'railings' and not 'palisade fences'. While D1 and D2 may resemble railings in the context of BS 1722 defined fences, this does not preclude them from falling within the scope of 'palisade fence' as defined by the proper construction of claim 1. A fence may resemble a railing and also be a 'palisade fence' for the purposes of assessing novelty. Therefore, this line of argument does not demonstrate that the examiner has clearly erred in their assessment of novelty.
- 33 The patentee has not made any arguments asserting that claim 1 as construed by the examiner is novel over the prior art of D1 and D2, therefore I do not need to consider if there is an error in this regard.

Claim 2

- 34 The patentee argues that the L section rail should be construed narrowly and that the 'square tube' of D1 and U-shape section of D2 do not amount to L-section rails. The summary of the invention at page 3 line 22 to page 4 line 4 of the patent says:

“Reference will be made primarily herein to L-section rails having a vertical arm and a horizontal arm, the horizontal arm being apertured to receive the rail while the vertical arm receives the fastener. However, those of skill in the art will recognise that the arms of the rail could of course be at angles other than 90 , and may be inclined to the horizontal or vertical, may have a C, I or H-section, or a box section, or indeed may take a non-rectilinear form.”

- 35 It seems from this that the patentee clearly intended the L-section rail to encompass box section rails and U-section rails (a C-section rail plus a change of perspective), and both D1 and D2 disclose such rails. The examiner's assessment of the novelty of claim 2 is not clearly wrong.

Claims 3, 4 and 11-14

- 36 No arguments are presented with respect to claims 3, 4 and 11-14, therefore I need not consider whether the examiner has erred with respect to these claims.

Conclusion

- 37 The patentee has not shown that the examiner has erred in his construction of the claims nor in his assessment of novelty based upon that construction, so the Opinion should not be set aside. Since the application for review has not been contested, I make no order in respect of costs.

Appeal

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

Huw Jones

Deputy Director, acting for the Comptroller