

When is an invention ‘made available to the public’?

1. The law as to what constitutes a disclosure made available to the public has appeared settled in the UK for some time.

2. The law typically regards this as anything which is in the possession of any member of the public which he is free in law and equity to use as he pleases and so may disclose to others without any inhibiting fetter of confidence, either express or implied.¹

3. When relating to a public display of an invention before the priority date of a patent, this has typically been interpreted such that it is of no consequence whether or not a member of the public actually saw or understood the invention. It is enough that the notional “skilled person” *could* have seen and understood the invention.²

4. However, in the recent decision in *Folding Attic Stairs*³, Peter Prescott QC, sitting as a Deputy Judge, offered something between a refinement to and a departure from this law.

5. The defendants, in response to a claim for infringement, had alleged that the patent (GB 2319051) was invalid over a prior disclosure by the Claimant. The Claimant had, before the priority date of the patent, invited an Irish Minister for Trade and Tourism to its factory, together with a photographer, to mark the recently required company’s ISO accreditation.

6. A prototype of the patented invention, an ordinary set of folding stairs having small but crucial adjustments to the folding system, was in a particular room of the factory, into which the minister was neither directed nor asked to refrain from entering. However, the photographer did enter the room and a resultant photograph of the Managing Director of the Claimant, stood in front of the prototype, appeared in the local press. The photographer had apparently been given free

reign to “take photographs of whatever he wanted”. Neither guest was invited to particularly regard the prototype.

7. In a relatively uncontroversial part of the decision, Mr. Prescott noted that the photograph itself did not form an enabling disclosure as the inventive parts of the prototype were not fully visible. The photograph itself, therefore, did not anticipate the Claims of the patent.

8. The more interesting question was “was there a public disclosure, potential or real, to the minister and/or the photographer?” A simple analysis of the earlier law might have suggested that there was. After all, both the photographer and the minister could have examined the prototype and would have been free in law and equity to disclose the information to the public.

9. However, Mr. Prescott found that there was not, despite finding a fact that both the photographer and the minister could have gazed at all parts of the prototype should they have wished.⁴

10. The reasoning given was that the prototype was not on display in a public place and was only available for viewing by a small and defined class: the photographer and the minister.⁵

11. As neither the minister or the photographer were skilled in the art of folding stairs, and there was no evidence to suggest that either had any special interest in the field, Mr. Prescott proposed that the nuances of the invention could not have been imparted into their minds and thus that they could not have further disclosed the invention, despite being free in theory to do so.⁶

12. This premise appears to be based on the fact that the prototype in question appeared to the untrained eye to be an ordinary set of folding stairs, a sight which, in a folding stairs factory, would have excited few. Only the skilled person, who, of course was not

¹ See *Catnic v Evans* [1983] F.S.R. 401

² *Lux v Pike* [1993] RPC 107, *Windsurfing v Tabur Marine* [1985] RPC 59

³ [2009] EWHL 1221 (Pat)

⁴ See Paragraph 81

⁵ See Paragraph 87

⁶ See Paragraph 86

present, would have even noticed, let alone understood, the novel feature of the prototype.⁷

13. In demonstrating this, Mr. Prescott asks whether it would be a public disclosure of a chemical formula if that formula were displayed in a house where the only people who could see it were a child who could not understand it, a lady who was not wearing her glasses or a man who was focusing all his attention on a football match.⁸

14. While the decision makes a certain sense based on the facts of this case, the question certainly arises as to where the line is to be drawn between disclosures which can only be understood by a person skilled in the art and those which could be more widely interpreted.

15. Surely, for example, had the prototype been conspicuously different in appearance from the standard stairs made at the factory, the court would have been more likely to find that there had been a disclosure to the public and that the patent was therefore anticipated.

16. Finding the answer to this question is made no easier in that the law relating to novelty states that an invention forms part of the state of the art if it has previously been made available to the public,⁹ not made available to a person skilled in the relevant art.

17. It would therefore not seem prudent to allow visitors to enter one's premises without being under a condition of confidentiality, or at least to file patent applications for all new and potentially accidentally disclosable inventions before they arise!

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⁷ See paragraph 89

⁸ See paragraph 87

⁹ S2(2) UKPA 1977