Article Information

Authors: Tim O'Callaghan, Travis Shueard, Zara Cox
Service: Corporate & Commercial, Dispute Resolution & Litigation, Intellectual Property & Technology

Glass Hardware v TCT Group: Patents all hinge on sufficient disclosure

Sufficient disclosure of an invention is of critical importance to a patent application, and a distinct requirement of section 40 of the Patents Act 1990* (Cth). *This requirement, and the consequences of non-compliance, was highlighted in the recent Full Court decision of Glass Hardware Australia Pty Ltd v TCT Group Pty Ltd [2024] FCAFC 95.

Background Facts

The appeal concerned an innovation patent for an invention comprising a hinge that could be used for soft closing glass panelled doors such as shower screens or pool fences (**918 Patent**).[1]

The claim for the 918 Patent described the hinge as involving a second leaf assembly which included "*a striking surface to cooperate with the dampener*".[2]

The respondent, TCT Group, sold hinges in Australia under the "Orion" brand (**Orion hinges**).[3] The Orion hinges involved dampeners being orientated in such a way that there was no direct contact between the dampener and the surface of the opposite leaf assembly.[4]

The appellant and exclusive licensee of the 918 Patent, Glass Hardware, claimed that the Orion hinges infringed the 918 Patent.[5]

However, the Orion hinges were being sold in Australia prior to the filing date of the 918 Patent.[6] As such, Glass Hardware claimed priority from an earlier specification (the **Parent**) in order to establish infringement.[7]

In the primary judgment, Burley J found that the Orion hinges fell within the scope of the claims of the 918 Patent.[8] However, his Honour held that the 918 Patent could not claim the priority date of the Parent.[9] As such, the Orion hinges anticipated the invention claimed by the 918 Patent and the 918 Patent was therefore invalid.[10]

Glass Hardware appealed this decision to the Full Court of the Federal Court of Australia.

Decision

In a joint judgment, Yates, Charlesworth and Rofe JJ rejected the appeal and upheld the primary judge's findings.

By reason of section 43 of the *Patents Act 1990* (Cth) and its combined effect with the relevant regulations, the 918 Patent would have been entitled to the priority date of the Parent if the Parent "clearly disclosed" the invention claimed in the 918 Patent.[11] To meet this requirement, the invention in the claim of the 918 Patent had to be disclosed in the Parent 'in a manner that (was) clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.'[12]

This disclosure requirement is known as external sufficiency.[13] The Full Court agreed with the primary judge that the disclosure requirements for external sufficiency are the same as those required for internal sufficiency, being that a patent specification must sufficiently describe the manner in which the invention is to be performed in order for it to be valid.[14]

The primary judge held that the invention claimed in the 918 Patent was not clearly disclosed in the Parent.[15] The primary judge considered the Parent's description of the hinge as involving a dampener which came "into contact with" the second lead assembly.[16] His Honour found that the language of the Parent clearly described direct contact between the dampener and the second leaf assembly.[17] In contrast, the language of the 918 Patent contemplated both direct and indirect contact between the dampener and the second leaf assembly.[18]

His Honour concluded that a person skilled in the art would not have been able to perform the invention claimed in the 918 Patent by looking at the Parent specification and, therefore, the priority date of the Parent could not be claimed.[19]

In its appeal submissions, Glass Hardware contended that the primary judge employed "*an over-meticulous verbal analysis*" rather than adopting a purposive construction, and that the description of the invention in the Parent was merely an example of a preferred embodiment of the invention claimed in the 918 Patent.[20]

The Full Court, whilst agreeing that a purposive construction of a claim was the correct approach, held that '*purposive construction does not displace or override the clear ordinary English meaning of the words chosen by the patentee.*'[21] It does not allow the words to be broadened beyond their ordinary English meaning, even if that is what the patentee intended.[22]

The Full Court agreed with the primary judge that the claim of the 918 Patent was narrower than the claim of the Parent, and therefore the Parent did not disclose the invention of the 918 Patent in a manner that was clear enough and complete enough for the invention to be performed by a person skilled in the art.[23]

Key Takeaways

Careful selection of language when describing the invention to be claimed in a patent is critically important to patentees.

Sufficient disclosure is required both internally, in order for the patent to be registered, and externally, in order for a patent to claim priority from an earlier-filed patent. The specification must be clear enough and complete enough for a person skilled in the relevant art to be able to perform the invention, in order to comply with statutory requirements.

Piper Alderman has a nationally recognised practice in intellectual property enforcement and protection, with experience in all jurisdictions. Please contact Tim O'Callaghan and his team if you require intellectual property advice.

[1] *Glass Hardware Australia Pty Ltd v TCT Group Pty Ltd* [2024] FCAFC 95 [2].

[2] Ibid [16].

[3] Ibid [4].

[4] Ibid [26].

[5] Ibid [5].

[6] Ibid [4].

[7] Ibid [5].

[8] Ibid [27].

[9] Ibid [5].

[10] Ibid [52].

[11] Ibid [78].

[12] Ibid; *Patents Act 1990* (Cth) s 40(2).

[13] Ibid [79].

[14] Ibid.

[15] Ibid [49].

[16] Ibid [38].

[17] Ibid.

[18] Ibid [37].

[19] Ibid [52].

[20] Ibid [62]-[63].

[21] Ibid [94].

[22] Ibid [96].

[23] Ibid [97].