

## **PATENTS ACT 1977**

### **IN THE MATTER OF**

Patent Application

Number GB9809423.8

In the name of Stephen David Voller

### **DECISION**

1. Mr Voller applied for a patent on 1 May 1998 for the idea of a television set top box in the shape of a hat. "Set top boxes" are known in the art. They supplement the functions provided by television receivers and provide access to services such as digital television, satellite television etc. Mr Voller's idea did not involve any innovation in the functionality of set top boxes. It was confined solely to the outward appearance, namely to the provision of a set top box having the appearance of a hat.

2. The examiner Mr Steven Davies, reported on 10 August 1998 that the application did not comply with the provisions of section 1(2)(b) of the Act which prohibits the patenting of "any ... aesthetic creation whatsoever". He said the specification indicated that the functioning of the set top box was conventional, and that the only way in which it differed from other set top boxes was in its shape, and that was a purely aesthetic feature.

3. Mr Voller replied on 29 December 1998 disagreeing with Mr Davies's view. He contended that the idea was more than an aesthetic creation since, as Mr Voller wrote, "it provided a non-threatening and non-technical fun accessory to take the mystique and technical difficulty out of digital TV". He also said, and I paraphrase, "the aim is to fit conventional electronics into the Hat casing design". Further correspondence followed in which Mr Davies and Mr Voller each maintained their positions, Mr Voller stating further that "the point is to produce a user friendly, and distinctive product that is easily and immediately recognisable by the consumer".

4. In his letters, Mr Voller also put forward various technical features of his set top box which he considered might confer patentability on the idea, such as "the easy lay out of sockets". However, as Mr Davies pointed out in his reports, it was not permissible for Mr Voller to amend his specification to incorporate any such features, since to do so would introduce new subject matter contrary to section 76 of the Act.

5. This exchange of correspondence resulted in a hearing being appointed for Mr Voller to put his case to a senior officer in the Patent Office. Shortly after the hearing was appointed, Mr Voller wrote to the Office saying that he had reconsidered and had now decided not to contest the refusal or attend the hearing. The matter has therefore come before me to determine on the papers whether the application should be refused.

6. I have reviewed the specification and the arguments put forward by the examiner and by Mr Voller during their correspondence. I agree with Mr Davies that the specification

contains no patentable subject matter and I am satisfied that there is no disclosure in the specification which could support a patentable claim. Mr Voller's arguments relating to the purpose of the invention, reinforce this view since they confirm that the novelty in the idea lies in the outward appearance of the set top box and not its technical functionality. I consequently refuse the patent application on the ground that it relates to an aesthetic creation contrary to section 1(2)(b) of the Patents Act.

7. The period for appeal is six weeks from the date of this decision.

Dated this 20<sup>th</sup> day of October 1999

**P MARCHANT**

Deputy Director, acting for the Comptroller

**THE PATENT OFFICE**