



BL O/145/04

25 May 2004

PATENTS ACT 1977

BETWEEN

Yeoman Group plc

Claimant

and

Trevor Evan Parry

Defendant

PROCEEDINGS

Application under section 72 for revocation of
UK patent GB 2236610 B

HEARING OFFICER

S N Dennehey

DECISION

Introduction

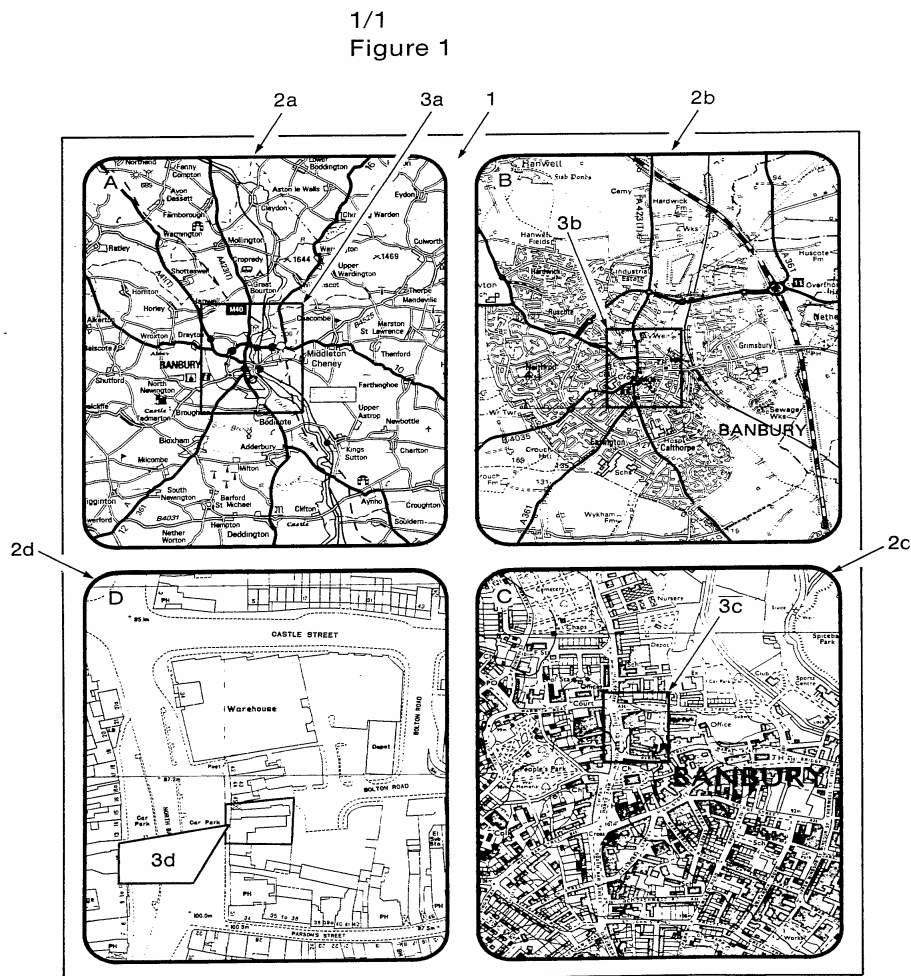
- 1 The patent in suit, GB2236610, was filed on 29 September 1989 and granted to Trevor Evan Parry (“the proprietor”) on 2 February 1994. The patent does not claim an earlier priority date.
- 2 An application for revocation under section 72(1)(a) of the Patents Act 1977 (“the Act”) was filed by Yeoman Group plc (“the applicants”) on 27 February 2000, on the grounds that the invention is not new as required by section 1(1)(a) of the Act, does not involve an inventive step as required by section 1(1)(b) of the Act, consists of a literary and/or artistic work excluded from patentability under section 1(2)(b) of the Act and consists of nothing more than the presentation of information excluded under section 1(2)(d) of the Act. The proprietor's counter-statement was filed on 20 December 2000.
- 3 The applicants filed an amended statement of case listing additional prior art documents on 20 March 2001. The proprietor's amended counter-statement, filed on 30 May 2001, included three sets of conditional amendments to be considered if, and only if, claim 1 in the form as granted is found to lack novelty and inventive step. The conditional amendments

were advertised on 18 July 2001 and a supplementary statement, directed solely at the proposed amendments, was filed by the applicants on 23 July 2001.

- 4 During the normal evidence rounds, the applicants and proprietor entered into negotiations concerning a potential settlement of their dispute. Deadlines for filing evidence were extended to accommodate these negotiations, with the applicants' evidence-in-chief being filed in two parts on 23 July 2001 and 10 September 2001, and the proprietor's evidence being filed on 2 May 2002. The applicants did not file any evidence in reply.
- 5 With the apparent failure to agree mutually acceptable terms for a settlement, both parties agreed that I should decide the matter on the basis of the papers before me, without the need for a hearing.

The Patent

- 6 The invention provides a sequence of maps to different scales to assist a user in navigating from a remote location to a particular destination. To avoid reference to several maps, the maps at the various scales are arranged in a series on the face of a single document and the particular destination to be located is specifically indicated on the largest scale map (see fig.1).



7 Conventionally, as is stated in the patent, it would be necessary to rely either on detailed verbal instructions or reference to a number of disjointed maps in order to plan a route to an intended destination. Whilst small scale road atlases having supplementary larger scale town maps are known, the correspondence between the smaller and larger scale maps is often obscure and the selection, range and level of detail of the town maps frequently excludes the chosen destination or does not allow precise identification of it.

8 The patent specification as granted contains 7 claims which read:

"1. A portable device for enabling a pre-selected destination to be located, said device comprising: a carrier means; a first, second, third and fourth maps on said carrier means viewable from one side of the carrier means, said maps being arranged on said carrier means as a series, each map of which is to a progressively larger scale; the first map having means thereon, in a substantially central location thereof, marking the area represented by the second map; the second map having means thereon, in a substantially central location thereof, marking the area represented by the third map; the third map having means thereon, in a substantially central location thereof, marking the area represented by the fourth map; and the fourth map having thereon means other than the name of the destination for rendering the destination clearly identifiable on the fourth map.

2. A device as claimed in claim 1, wherein the carrier means comprises a board of plastics material.

3. A device as claimed in claim 1, wherein the carrier means comprises a board of cellulosic material.

4. A device as claimed in any of the preceding claims, wherein the carrier means is hinged or folded about a centre line, with at least one of said maps disposed on a first side of the centre line and at least one of said maps disposed on a second side of the centre line.

5. A device as claimed in claim 4, wherein the maps are disposed on an inwardly facing surface of the foldable carrier.

6. A device as claimed in any preceding claim, wherein said marking means comprise visible lines.

8.[sic] A portable device, for enabling a pre-selected destination to be located, substantially as described herein with reference to the accompanying drawings."

Grounds for revocation

- 9 Revocation is sought on the grounds that the patent lacks novelty and inventive step and that the invention consists of nothing more than a literary and/or artistic work or the presentation of information. In particular:

a) Novelty

- 10 The applicants contend that the portable device specified in the claims was made available to the public before the priority date of the patent in the following documents:

D1: Visual Atlas; George Philip & Son Ltd., 1971; page 3

D2: Caribbean Social Studies Atlas; George Philip & Son Ltd., 1986; page 2

- 11 D1 presents four maps set out in series on a single page of an atlas, the maps increasing in scale from 1:1,000,000 to 1:50,000 with the effect of illustrating the nature of scale in maps. The smaller scale map (1:1,000,000), positioned in the lower half on the right hand side of the page, has a rectangle which represents the area of a larger scale map (1:500,000) positioned immediately to its left. This 1:500,000 map also has a rectangle which represents the area of a larger scale map (1:250,000), the larger scale map being positioned in the top right hand side of the page. The fourth map, positioned in the top left hand side of the page, is a larger scale map (1:50,000) of the area represented by a rectangle marked on the map in the top right hand side.

- 12 D2 presents a similar illustration of scale, having six maps set out in series in the lower half of the page, the maps ranging in scale from 1:15,000,000 to 1:100. Five of the maps have a rectangle marked on them to indicate the area represented by the next map in the series, with the sixth map, having a scale of 1:100, illustrating the position of a desk within a Caribbean classroom.

b) Inventive Step

- 13 The applicants assert that claims 1-6 include a number of features that were well known in the field of cartography before the priority date of the application, and that the combination of such features does not constitute an inventive step. In particular, they argue that the provision on a map of means other than the name of the destination to render the destination clearly identifiable is shown in the following documents:

D3: GB321823; 21 Nov 1929; fig. 1

D4: London School Board Atlas; George Philip & Son Ltd., 1900; page I

- 14 D3 discloses a wall mounted map with numbers used to identify locations such as railway stations, banks and hotels, while D4 shows a linear outline marked on a map to clearly identify the location of Westminster Abbey. In addition, the applicants also allege that identifying symbols, handwritten or otherwise, such as arrows, crosses or numbers, have

been used for many years before the priority date of the patent to mark on a map the exact location of a destination.

- 15 The arrangement of maps as a series in which the same geographical features are shown to different scales is said to be disclosed in the following documents:

D1: Visual Atlas; George Philip & Son Ltd., 1971; page 3
D2: Caribbean Social Studies Atlas; George Philip & Son Ltd., 1986; page 2
D4: London School Board Atlas; George Philip & Son Ltd., 1900; page I
D5: Times Atlas of the World; Times Books Ltd., 1985; plate 114
D6: Newnes' Motorists' Touring Atlas; John Bartholomew & Sons Ltd., 1960; pages (v) to (vii)
D8: The AA New Book of the Road; Reader's Digest Association Ltd., 1975; Index to maps and pages 78-81

- 16 D5 is split into three sections, the uppermost of which shows the Hawaiian islands to a scale of 1:10 million, the middle section showing a number of the islands including the island of Oahu to a scale of 1:1 million and the bottom right-hand section of which shows the city of Honolulu, which is on the island of Oahu, to a scale of 1:250,000. In D6 and D8, the series of maps are positioned on different pages. The applicants assert that both the number of maps in a series and the number presented on one page were a well known matter of choice before the priority date of the patent.

- 17 The provision of a series of maps to different scales covering the same geographical features and indicating in a smaller scale map the area covered by a larger scale map, is said to be disclosed in the following documents:

D1: Visual Atlas; George Philip & Son Ltd., 1971; page 3
D2: Caribbean Social Studies Atlas; George Philip & Son Ltd., 1986; page 2
D4: London School Board Atlas; George Philip & Son Ltd., 1900; page I
D7: "How to get to Great Witchingham Hall the Headquarters of Matthews Norfolk Farms"; Ordnance Survey, 1980
D16: London A-Z Street Atlas Ed 12a; Geographers' A-Z Map Co. Ltd., 1988; pages 2-3, 60-61 and 138-139
D17: London Streetfinder; Nicholson Publications Ltd., 1984; pages 142 and 160

- 18 D7 presents a series of three maps to different scales on two opposing faces of a laminated sheet of A4 size material. It bears the title "How to get to Witchingham Hall the headquarters of Matthews Norfolk Farms" and has on one face a first map of Norfolk to a scale of 1:625000 and on the reverse face a second map to scale 1:50000 and a third map to a much larger scale. The boundary area of the third map is indicated on the second by a black rectangle and the boundary areas of the second and third maps are similarly indicated on the first. D16 and D17 both show a small scale map of London as an index page, with rectangular boxes identifying the area covered by larger scale maps on subsequent pages. These larger scale maps have their own boundary markings indicating the area covered by further larger scale maps.

c) Literary/artistic work and/or presentation of information

19 The applicants point out that a map is defined as an artistic work in sections 4(1)(a) and 4(2) of the Copyright, Designs and Patents Act 1988 and contend that, as such, the patent is therefore invalid. They also argue that it was common practice in the field of publishing before the priority date of the patent to divide pages into a number of sections and provide different information in each section:

D8: The AA New Book of the Road; Reader's Digest Association Ltd., 1975;
Index to maps and pages 78-81

D10: The Collins Dictionary and Thesaurus in one volume; HarperCollins, 1987;
pages 610-611

D11: European Patent Convention; EPO, 1989; pages 64 and 65

D12: "The nine symphonies of Beethoven in score"; Harcourt, Brace and Co.,
1935; pages 56 and 57

D13: "The Gardener's guide to flowers, trees and shrubs"; David & Charles
(Publishers) Ltd., 1980; pages 78 and 79

D14: Philips' Modern School Atlas; George Philip & Son Ltd., 1984; pages 14-
17

D15: Britannica Atlas; Rand, McNally & Co, 1980; pages 266-267

20 The subject matter of the patent and of its claims differs, the applicants say, from the examples given above only in the literary, artistic and information content provided in each of the sections. As such, the invention makes no technical contribution to the art.

Evidence

21 The applicants have filed a witness statement by David Michael Reger, an employee of Bernard Matthews Holdings Limited, relating to the date that D7 was made available to the public. They have also filed an expert report prepared by Herbert Lewis O.B.E., a fellow of the Royal Geographical Society, outlining the common knowledge of a person of ordinary skill and knowledge in the field of cartography before the priority date of the patent.

22 The proprietor has filed two witness statements by individuals employed in the map publication industry, namely a Simon Butler of Z-Publishing Ltd and Alan Horsfield of European Map Graphics Ltd, together with a witness statement by the proprietor himself. These witness statements assert that the map has had a considerable degree of commercial success as a result of user demand for a simple and easy to use navigational aid that was, at the time of its launch, unique in the market.

The Law

23 Section 72(1)(a) of the Act gives the comptroller power to revoke a patent, on application by any person, if the invention is not a patentable invention. An invention is patentable if it meets the conditions set out in section 1(1):

- "(a) *the invention is new;*
- (b) *it involves an inventive step;*
- (c) *it is capable of industrial application;*
- (d) *the grant of a patent for it is not excluded by subsections (2) and (3) below; "*

24 Section 1(2) lists certain categories which, for the purposes of the Act, are not regarded to be inventions:

- "(a) *a discovery, scientific theory or mathematical method;*
- (b) *a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;*
- (c) *a scheme, rule or method of performing a mental act; playing a game or doing business; or a computer for a program;*
- (d) *the presentation of information;*

but the foregoing provisions shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such."

25 Section 4(2) of the Copyright, Designs and Patents Act 1988 lists certain categories of artistic work in which copyright subsists, including:

- "(a) *any painting, drawing, diagram, map, chart or plan"*

26 Neither side has referred me to any case law. I am mindful therefore that where, in this decision, I refer to case law, it should be well-known and its effect long-established, so that there can be no suggestion that I have taken into consideration points on which the parties have not had an opportunity to comment.

Novelty

27 An invention defined in a claim lacks novelty if the specified combination of features has already been disclosed. The well-established test for determining whether an invention lacks novelty is set out in *General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited* [1972] RPC 457, pages 485-6:

"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."

28 Thus, for anticipation, all that is required is to see whether carrying out the teaching in the prior art document would constitute an infringement of the patent in suit. This test was applied in *Glaverbel SA v British Coal Corporation and anr.* [1995] RPC 255, page 283, where it was also held that:

"It is not necessary that the prior art be equal in practical utility or disclose the same invention in all respects as the patent in suit."

29 The applicants assert that the present invention lacks novelty with respect to D1 and D2. The proprietor disagrees, arguing that D1 and D2 were not intended to be devices for enabling a pre-selected destination to be located but merely devices to illustrate the scale of maps. As such, they cannot have anything to do with the clear purpose of the invention as defined in claim 1 of the patent. The latter, in my view, is undoubtedly true. However, insofar as claim 1 defines a device *for* the particular purpose of enabling a pre-selected destination to be located, it has long been established that such a claim should be construed as a claim to a device that is *suitable for* that purpose and not limited to a device when used in such a way (*Adhesive Dry Mounting v. Trapp* [1910] 27 RPC 341, *L'Air Liquide Societe's Application*, 49 RPC 428). Even though D1 and D2 have nothing whatsoever to do with the purpose of the invention, both documents are capable of allowing a pre-selected destination to be located.

30 The proprietor also argues that the invention defined in claim 1 is further distinguished from this prior art by requiring a "means other than the name of the destination" to render it clearly identifiable; in fig. 1 of the patent, the destination is identified by way of a pointer and highlighted boundary. On the other hand, the applicants point out that in most maps, D1 and D2 included, cartographic symbols associated with named locations are sufficient means "other than the name of the destination" for rendering it clearly identifiable. The specific examples given are of a black dot next to the words "Royal Mausoleum" in D1 and a red rectangle adjacent the words "the desk" in D2.

31 I have to agree with the applicants on this point, although the example given in respect of D1 does not, in my opinion, clearly identify the location in the absence of its name. A better example might have been the railway station in Windsor, which is clearly identifiable without an associated label.

32 The proprietor does not contest that D1 and D2 disclose the four map arrangement as required by claim 1. Even so, I am satisfied that both documents do disclose such an arrangement. On applying the test for novelty set out in *General Tire*, and construing claim 1 as set out above, I find that claim 1 of the patent as granted lacks novelty with regard to D1 and D2 despite the fact that neither document is intended to assist a traveller in travelling to a particular destination. However, as is set out in *Glaverbel*, it is not necessary that the prior art be equal in practical utility to the patent in suit.

33 Turning to the dependant claims, neither D1 nor D2 have the plastics carrier required by claim 2 or the foldable carrier arrangements required by claims 4 and 5. They do, however, have a carrier composed of cellulosic material i.e. paper, and both have visible lines for

marking the areas of the map represented by the next map in the series. As such, I find that claims 3 and 6 as granted also lack novelty.

Inventive Step

34 Despite finding that claim 1 lacks novelty with respect to D1 and D2, I will, for the sake of completeness, also consider the applicants' assertion that claim 1 lacks an inventive step.

35 The well established approach for determining whether an invention involves an inventive step is laid down in *Windsurfing International v Tabur Marine [1985] RPC 59* ("*Windsurfing*"). The fourfold structured approach is set out by Oliver L.J. at page 73:

"There are, we think, four steps which require to be taken in answering the jury question. The first is to identify the inventive concept embodied in the patent in suit. Thereafter, the court has to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, at that date, common general knowledge in the art in question. The third step is to identify what, if any, differences exist between the matter cited as being "known or used" and the alleged invention. Finally, the court has to ask itself whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man, or whether they require any degree of invention."

36 The criterion for deciding whether or not the claimed invention involves an inventive step is wholly objective. This was reinforced by the Court of Appeal in *Mölnlycke AB and another v Procter & Gamble Limited and other (No 5) [1994] RPC 49* at page 113:

"The Act requires the court to make a finding of fact as to what was, at the priority date, included in the state of the art and then to find again as a fact whether, having regard to that state of the art, the alleged inventive step would be obvious to a person skilled in the art."

37 It is permissible for the court to consider the opinion of experts in making these findings of fact, although it is for the court to decide the weight to be given to such opinion. *Mölnlycke*, again at page 113, addresses the role of expert witnesses in assisting the court:

"In applying the statutory criterion and making these findings the court will almost invariably require the assistance of expert evidence. The primary evidence will be that of properly qualified expert witnesses who will say whether or not in their opinions the relevant step would have been obvious to a skilled man having regard to the state of the art. All other evidence is secondary to that primary evidence."

38 Turning then to the four steps set out in *Windsurfing*, the first of these requires me to identify the inventive concept embodied in the patent in suit. The use of disjointed maps of different scales is acknowledged in the patent as a conventional way of planning a route to an intended destination. However, the correspondence between the smaller and larger scale maps is often

obscure, and the scale of maps available does not always allow for the precise location of the chosen destination. The invention overcomes these deficiencies by providing a portable device having maps (four as claimed in claim 1) of progressively larger scale arranged in series and viewable from one side of a carrier, where all but the largest scale map have marked thereon, in a substantially central location thereof, the area represented by the next map in the series, and where the destination is clearly identified on the largest scale map by means other than its name. The convenience of having all necessary maps available to the user on a single sheet and the clear relationship between these maps underlies the inventive concept.

- 39 The second *Windsurfing* step is to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and impute to him what was, at that date, common general knowledge in the art in question. Neither side has addressed the issue of who that person might be. Absent such submissions, I am inclined to the view that the skilled person in this art would inevitably be a person involved in the design or production of travel maps. Messrs. Lewis, Butler and Horsfield all appear to be suitably qualified in this regard, and their expert opinions will need to be given the appropriate weight when addressing the issue of inventive step.
- 40 The third *Windsurfing* step is to identify what differences, if any, exist between the matter cited as being "known or used" and the alleged invention. Of all the documents cited by the applicants, D7 is the only example of a portable device intended to assist a traveller reach a particular pre-selected destination that comprises a series of maps of progressively larger scale arranged on a single sheet where the relationship between the maps and the final destination are both clear to the user. The portable device set out in D7 presents a series of three maps to different scales on two opposing faces of a laminated sheet of A4 size material. It bears the title "How to get to Witchingham Hall the headquarters of Matthews Norfolk Farms" and has on one face a first map of Norfolk to a scale of 1:625000 and on the reverse face a second map to scale 1:50000 and a third map to a much larger scale. The boundary area of the third map is indicated on the second by a black rectangle and the boundary areas of the second and third maps are similarly indicated on the first.
- 41 The proprietor does not accept that this document was made available to the public before the priority date of the patent. As a consequence, it is necessary for me to decide on this issue before proceeding further with the third of the *Windsurfing* steps.
- 42 In a witness statement filed by the applicants, Mr Reger, an employee of Bernard Matthews Holdings Limited, states that copies of D7 were given without any bond of confidentiality to members of the public prior to 31st January 1989. It was common practice, he claims, to give out copies of such a map to customers, suppliers, future employees and other visitors in order to assist them in getting to company headquarters at Great Witchingham Hall. The company name was changed from Matthews Norfolk Farms to Bernard Matthews Foods Ltd on 31st January 1989, and Mr Reger states that the map with the old company name on it was given out before the change of company name. A copy of the "Certificate of Incorporation on change of name" dated 31st January 1989 has been filed by the applicants.

43 The proprietor has not put forward any evidence which contradicts or calls into question that of Mr Reger. For my own part, I have no reason to doubt the evidence provided by Mr Reger on this issue and, without any evidence to the contrary, I accept that D7 was "known or used" before the priority date of the patent.

44 Returning to the third of the *Windsurfing* steps, it seems to me that the following differences exist between D7 and the alleged invention of claim 1: a) D7 has only three maps in a series, not four, b) the maps are not all viewable from one side of a carrier, c) the rectangular box on the smallest scale map identifying the area represented by the next smallest scale map is not located in a substantially central location, and d) the largest scale map does not identify the destination by means other than its name.

45 The fourth *Windsurfing* step is to ask whether, when viewed without any knowledge of the alleged invention, these differences constitute steps which would have been obvious to the skilled man, or whether they require any degree of invention. Considering first the number of maps in series, Mr Lewis suggests that the number of maps employed depends on factors such as the distance travelled and the complexity of the route, and that such factors were well known to cartographers of ordinary skill and knowledge when deciding the layout of maps before the priority date of the patent. It was also common knowledge, he suggests, to provide several maps to different scales depending on the amount of detail to be shown in the largest scale map and on the total area to be covered. D5, D6, D16 and D17, together with the prior art acknowledged in the patent, clearly show that multi-scale mapping was a tool commonly used by cartographers before the priority date: if the required information could not be presented to the user using one map then a larger scale second map was required; if the information could still not be presented in the second map then a third, larger scale, map was needed. The number of maps chosen by the cartographer depended entirely on the information to be conveyed to the user, whether it be with two maps, three maps or four. Indeed, this is also acknowledged within the specification of the patent at lines 22-27, page 3:

"The example shown illustrates the use of four maps to locate the destination. Clearly, where the predetermined destination is in isolated surroundings, less maps may be needed. Conversely, where the destination is in a conurbation, e.g. London, more than four maps may be needed."

46 I am satisfied, therefore, that having four maps in a series instead of three would not require any degree of invention.

47 The second difference between D7 and the alleged invention is that the three maps in D7 are not all viewable from one side of a carrier; a first map to scale 1:625000 is printed on one side of a laminated sheet whilst a second map to scale 1:50000 and a third map to a much larger scale are printed on the reverse side. The question I now need to answer is would it have been obvious to the skilled man to position all three maps on just one side of a carrier. Mr Lewis suggests that the common knowledge of a cartographer of ordinary skill and knowledge before the priority date included knowledge that, depending on the size of the paper and the size of the maps to be printed on the paper, any number of maps could be

arranged on one side of a single sheet. D7 has three maps in series, the size of the paper and the size of the maps dictating that the smaller scale map had to be located on the reverse side to the other two. The fact that two maps have been positioned on one side of D7 suggests to me that this is indeed a function of the size of the paper and the amount of information needed by the user. Without any argument or evidence to the contrary, I am satisfied that if it were possible for all the necessary maps to be positioned on a single side of paper then it would have been an obvious step for the skilled man to do so.

48 The third difference between D7 and the alleged invention is that the rectangular box on the smallest scale map identifying the area represented by the next smallest scale map is not located in a substantially central location. Mr Lewis suggests that the reason for this is that the destination (Great Witchingham Hall) is located close to the sea; had the cartographer centred the smallest scale map on Great Witchingham Hall then half of the map would have represented the sea, which would have reduced the range over which the map could be used. I am persuaded by this argument; whilst there may be certain presentational advantages in having the boxed area positioned centrally on a map, e.g. in drawing the user's attention to the area a lot sooner, the position of the area, it seems to me, is totally dependant on the location of the destination and the scale of the larger scale map. The fact that the second map in D7 (1:50000) has been selected to ensure that the destination is in a substantially central area of the map suggests to me that cartographers were aware of these presentational advantages before the priority date of the patent. Without any argument or evidence to the contrary, I consider that this third difference between D7 and the alleged invention does not require any degree of invention.

49 The final difference noted above is that the largest scale map of D7 does not identify the destination by means other than its name. The map represents the destination of Great Witchingham Hall by its name only, without any other marking identifying its location. Mr Lewis states that cartographers have been identifying locations on maps for centuries using markings other than the names of the destinations, and the prior art documents D3 and D4 clearly support this. On this basis, the applicants argue that simply adding an additional identifying symbol on a map would be obvious to the skilled man. Without any evidence to the contrary, I am persuaded by this argument and consider that identification of the destination by means other than its name does not require any degree of invention.

50 As I have mentioned above, there is little argument from the proprietor regarding the degree of invention required in each of the four differences between D7 and the alleged invention. The proprietor does argue, however, that the substantial commercial success that the map has enjoyed is an indication that the invention fulfils a long-felt want for a simple and effective device to enable a pre-selected destination to be located reliably and with ease. The evidence of Mr Butler and Mr Horsfield supports the view that the map has been a commercial success. However, secondary evidence of this type must be kept firmly in its place (*Mölnlycke AB and another v Procter & Gamble Limited and other (No 5) [1994] RPC 49 at 112-115*); it must not be permitted to obscure the fact that it is no more than an aid in assessing the primary evidence of properly qualified expert witnesses who will say whether or not in their opinion the relevant step would have been obvious to a skilled man having regard to the state of the art. With this in mind, I do not consider that the

secondary evidence of commercial success advanced by the proprietor outweighs the primary evidence of technical obviousness of the applicants.

51 In summary therefore, I find that the invention of claim 1 is obvious in light of D7. Turning to the dependant claims, Mr Lewis, in his evidence, states that the use of plastic and paper for the printing of maps had been standard practice for many years before the priority date of the patent. He also states that it was common practice before the priority date of the patent to design maps that could be folded about a central line, and for individual maps to be arranged around the folds of a foldable carrier depending on the use to which the map was to be put and for the convenience of the user. Mr Lewis also points to the use of visible lines in D1 and D7 as evidence that such markings were used before the priority date of the patent to mark an area covered by the next largest scale map in a series. None of this is contested by the proprietor, and without any evidence to the contrary, I am persuaded that claims 2-6 also lack an inventive step.

Amended Claims

52 The proprietor has filed three sets of conditional amendments to be considered if, and only if, claim 1 in the form as granted is found to lack novelty and inventive step. The first conditional amendment requires that the fourth map of claim 1 has marked on it the names of streets immediately adjacent the pre-selected destination. The proprietor suggests that the effect of this amendment is to limit the scale of the fourth map to allow accurate indication of the pre-selected destination and argues that D1 could not include such information because of the scale of the largest scale map. Whilst there appears to be support for this amendment in the description as filed, I am persuaded by the applicants' argument that the addition of street names to the map of D1 would be obvious to a skilled man; the prior art documents D16 and D17 clearly show that it had been known for some time before the priority date of the patent to add street names to maps as an aid to navigation, especially when the scale of map allowed the names to be presented clearly. I therefore consider that the first conditional amendment of claim 1 lacks an inventive step.

53 Claim 1 of the second conditional amendment requires that the second map has an edge adjacent an edge of the first map, the third map has an edge adjacent an edge of the second map and the fourth map has an edge adjacent an edge of the third map. This seeks to define the relationship between the four maps in such a way that they are arranged in a continuous sequence from the smallest scale map to the largest. In the preferred embodiment of the invention, this continuous sequence is essentially a clockwise progression starting with the smallest scale map in the top left hand corner of the carrier and ending at the largest scale map in the bottom left hand corner. The proprietor claims that this arrangement is particularly effective in assisting those using the navigational aid to move smoothly from one scale map to the next and argues that this feature is neither present nor suggested in any of the documents cited by the applicants. The applicants claim that such an arrangement of maps would be obvious having regard to the cited prior art, with Mr Lewis attesting that this particular arrangement of maps on a page was a well known design choice available to a cartographer of ordinary skill and knowledge before the priority date of the patent. This has not been

contested by the proprietor and, as a result, I am persuaded by the applicants' argument on this point.

- 54 The applicants further argue that the proposed amendment results in the specification disclosing additional matter or extending the protection conferred by the patent – they say that the only order in which the maps are disclosed in the specification is with the maps arranged in a clockwise series as set out in the second complete paragraph on page 2 and as shown in the figure 1. I am not persuaded by this; the specification as filed clearly refers to a number of maps being arranged in series, "each map of which is to a progressively larger scale and has marked thereon, in a substantially central location thereof, a neighbourhood of the said destination, each successive one of said maps in said series being a map of the said neighbourhood of an immediately preceding map in said series". This clearly implies a sequence that could be clockwise, anti-clockwise or any other arrangement which allows a user to scan seamlessly from the smallest scale map to the largest. I therefore find that the amended claim is fully supported by the specification as filed and does not extend the protection conferred by the patent.
- 55 The applicants also suggest that the term "adjacent" in the proposed amendment is indefinite and that the amendment represents an unallowable generalisation. However, the use of this word in the context of the specification seems to me to be reasonable and clear, and I do not regard it as introducing any unallowable generalisation.
- 56 To summarise the position regarding the second conditional amendment therefore, although I have found that the proposed amendment is supported by the specification as filed, does not extend the scope of protection conferred by the patent and does not introduce any ambiguity, I am not persuaded that the invention set out in claim 1 of the proposed amendment involves an inventive step. I find this also to be the case with regard to claim 1 of the third conditional amendment, which merely combines the two features introduced by the first and second conditional amendments.

Omnibus Claim

- 57 Claim 8 of the patent as granted is an omnibus claim to a portable device for enabling a pre-selected destination to be located substantially as described with reference to the drawings. Having read the entire specification in the light of the prior art and of the evidence before me, I can find nothing in it which might form the basis of a patentable invention.

Literary/artistic work and presentation of information

- 58 In view of my findings above, I do not need to consider in detail the remaining grounds for revocation under sections 1(2)(b) and 1(2)(d), namely that the invention consists of nothing more than a literary and/or artistic work or the presentation of information. I will note, however, that whilst the statutory provisions of the Patents Act 1977 and the Copyright, Designs and Patents Act 1988 require that maps be regarded as artistic works and therefore be excluded from patentability, it seems to me that the portable device set out in the patent as granted provides for more than just a map or artistic work - the device comprises a number

of maps that are specifically arranged in a linear sequence from the smallest scale map to the largest, where the particular arrangement of maps goes beyond any literary or artistic considerations.

59 In relation to the presentation of information, the Courts have held that presentation of information can be patentable provided that the presentation serves a technical, rather than merely an intellectual, purpose. In this particular instance, when construing the claimed invention as a whole, the purpose is to present the information contained in a series of maps that are marked and arranged in a particular format that allows the necessary information to be interpreted somewhat quicker than were the maps to be presented individually. On balance, I would say that this does serve a technical purpose; after all, the intellectual information remains the same whichever way the maps are marked and arranged.

Conclusion

60 In summary, I find claims 1-8 of the patent as granted all lacking in either novelty or inventive step and that all three conditional amendments lack an inventive step. Accordingly, as provided under section 72(4), I order that patent number GB 2236610 be revoked.

Costs

61 Since neither party has made any specific representations on costs, I shall make an assessment based on the standard Patent Office scale. In view of the fact that this action commenced before 22 May 2000, the old scale of costs applies. The applicants for revocation, Yeoman Group plc, have been successful in their action and I therefore order Trevor Evan Parry to pay them a sum of £750 as a contribution to their costs. This sum should be paid within five weeks from today, with payment to be suspended in the event that an appeal is lodged.

Appeal

62 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

S N DENNEHEY

Director of Patents, acting for the Comptroller