



BL O/054/06

21st February 2006

PATENTS ACT 1977

BETWEEN

Black & Decker Inc.

Applicant

and

GMCA Pty Ltd.

Opponent

PROCEEDINGS

Application under Section 27 of the Patents Act 1977 to amend
EP (UK) 0673730 B1

HEARING OFFICER

Peter Back

DECISION

Introduction

- 1 European patent EP (UK) 0673730 B1 ("the patent") was granted on 17 June 1998. The proprietor, Black & Decker Inc. ("the Applicant"), filed a request to amend the patent under section 27(1) on 8 October 2002. The proposed amendments were advertised in the Patents and Designs Journal on 5 March 2003. On 2 May 2003, a notice of opposition under section 27(5) to the proposed amendments was filed by GMCA Pty Ltd. ("the Opponent") and their statement of grounds of opposition followed on 15 May 2003.
- 2 An amended statement of grounds was filed by the Opponent on 25 June 2003 omitting reference to a Japanese document mentioned in its original statement of grounds. In response, a counter-statement was filed by the Applicant on 21 August 2003 requesting a further amendment to the new claim 3.
- 3 A further amended statement of grounds was filed on 18 February 2004 addressing the amendment of new claim 3. An amended counter-statement was filed on 19 March 2004. A yet further statement of grounds was filed on 21 October 2004.

- 4 The matter came before me at a hearing on 19th December 2005. The Applicant was represented by their patent attorney, Mr Ian Bell. The Opponent did not appear and was not represented at the hearing but had made clear before the hearing that it still maintained its opposition to the amendment. I have taken full account of the Opponent's arguments set out in all of its written submissions.

The patent

- 5 The patent relates to a router including the feature of a hollow support column through which debris, for example wood chips, generated by the cutting action of the router can pass ("the feature"). The purpose of the invention is to provide a router in which dust/debris removal can be carried out in a simple and reliable manner in the area of the cutter or like. The removal is assisted by way of a suction extraction column running inside the hollow guide column. A connection for a suction extraction device is provided at the upper end of the guide column.
- 6 The unamended specification contains 5 claims. Independent claim 1 defines the construction of the router, and reads:

1. A router: with a cutter head (1) containing the drive motor (2) and held in a displaceable manner at guide columns (30,31) which are secured at a base plate (20) and which extend away from it vertically to its workpiece engagement surface, and with a tool holder (4) for a cutter or the like provided at the side of the cutter head (1) facing towards the base plate (20) and coupled to the drive motor (2), in the axial extension of which the base plate (20) is provided with an opening (21) or recess for the passage of the cutter or the like, wherein the base plate (20) contains a suction intake channel (23) which surrounds the opening (21) or recess over at least the larger part of its periphery which channel has at least a suction intake opening facing towards the opening (21) or recess and to which channel at least a suction extraction channel (36) is connected which extends upwards from the base plate (20) in the area of a hollow guide column (31) and runs in this area coaxially with this guide column (31) and the end of which is remote from the base plate (20) can be connected to a suction extraction device, characterised in that said suction extraction channel (36) runs inside the hollow guide column (31).

This claim is easier to understand by reference to Figs 1 and 2 of the drawings accompanying the patent and which are reproduced below.

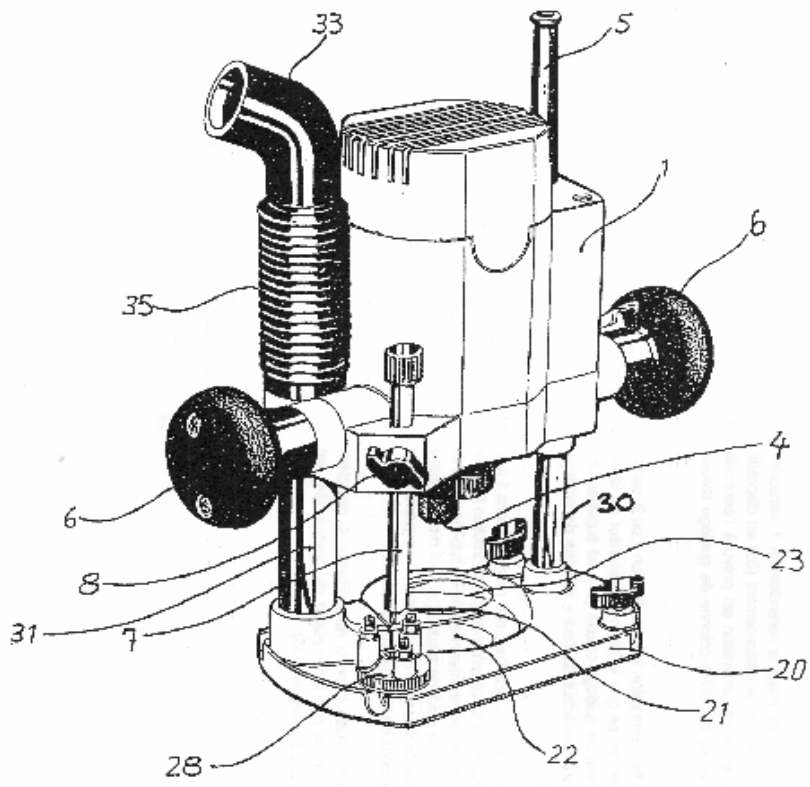


Fig. 1

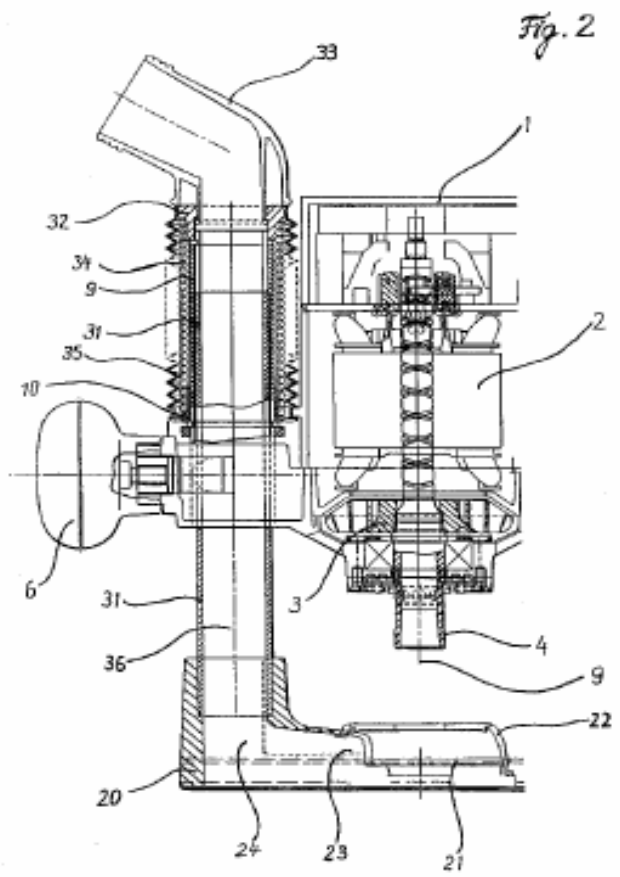


Fig. 2

7 Claims 2 to 5 are dependant on claim 1 and are concerned with additional details of the router. Claim 2 is particularly relevant in these proceedings, and reads:

2 A router according to claim 1, characterised in that the connection (33) for the suction extraction device is provided at the upper end of said hollow guide column (31).

The proposed amendments

8 The proposed amendments essentially involve the incorporation of the matter of claim 2 into claim 1.

9 Claim 1 as proposed to be amended reads:

A router: with a cutter head (1) containing the drive motor (2) and held in a displaceable manner at guide columns (30,31) which are secured at a base plate (20) and which extend away from it vertically to its workpiece engagement surface, and with a tool holder (4) for a cutter or the like provided at the side of the cutter head (1) facing towards the base plate (20) and coupled to the drive motor (2), in the axial extension of which the base plate (20) is provided with an opening (21) or recess for the passage of the cutter or the like, wherein the base plate (20) contains a suction intake channel (23) which surrounds the opening (21) or recess over at least the larger part of its periphery which channel has at least a suction intake opening facing towards the opening (21) or recess and to which channel at least a suction extraction channel (36) is connected which extends upwards from the base plate (20) inside a hollow guide column (31) coaxially with this guide column (31) and the end of which suction extraction channel (36) which is remote from the base plate (20) can be connected to a suction extraction channel device, via a connection (33) which is provided at the upper end of the hollow guide column (31) so that the complete suction extraction channel runs from the base plate to the connection for the suction extraction device inside the hollow guide column.

10 The Applicant originally also submitted amended claims 2,3,4 and 8. However, at the hearing the Applicant requested that these claims should be deleted to avoid any section 76(3) issues and the remaining claims be renumbered accordingly. The Applicant argued that the deletion of these claims and the resultant renumbering of the remaining claims did not prejudice the Opponent's position in any substantial way. I have considered the Opponent's position and also the wider public interest in coming to a decision on this point. I believe that neither would be unduly harmed by the deletion of these claims as the subject matter of the renumbered remaining claims was claimed in the granted patent. Indeed, as will emerge later in this decision, deletion of these claims addresses one of the Opponent's objections.

Background to request for amendment

- 11 The reason given for the request to amend is "*the location of more prior art*". The Office deemed this reason insufficient: since it did not explain when, and in what circumstances, the prior art in question came to the Applicant's attention. The Applicant responded in a letter dated 28 November 2002 in which it gave reasons for making the proposed amendments.
- 12 The background to the request is given in the Applicant's counter-statement where it explains that during mid-2001 it had cause to consider whether a router, newly introduced to the UK market, encompassed the feature and its granted patent in the UK. Before considering whether it was necessary to bring this fact to the attention of the importer of the router, as part of the Applicant's internal procedure, it seeks to verify the validity, within reason, of its patent. Validity searches in relation to the patent are normally conducted in the USA, Germany and the Far East. As this feature is used on an existing product, patent infringement clearance searches had already been conducted in Germany and the USA as standard procedure. After consideration, the Applicant felt that any additional searches in the US and in Germany, together with those conducted by the EPO and USPTO during the prosecution of the patent and its US equivalents would not uncover any new prior art. Validity searches were therefore requested in Japan and Taiwan on 18th December 2001.
- 13 The results of the Japanese validity search were received by the Applicant on 11th January 2002. Amongst the patents uncovered by the search was Japanese Utility Model JP63-92702 ("D1") which was to result in the present section 27 amendment request. In the Applicant's view, even though D1 appeared to anticipate the claims of the patent as granted, after review of the patent and discussions with one of the inventors and other engineers from the Applicant, it decided that the feature covered by the patent was still inventive in view of this piece of prior art and that a new set of claims could be generated based on the specification which would be both novel and have inventive step. On 5th March 2002, the Applicant's external patent attorney generated seven proposals for amended claims which could be filed at the UK Patent Office as a post grant amendment based on the these discussions. After review, the Applicant decided to file a set of proposed amended claims which form the basis for this section 27 amendment request.

Witness statement

- 14 A witness statement and supplementary witness statement from Mr Bell were filed on 21 October and 25 November 2004 respectively both of which I have taken full consideration of. The witness statement was accompanied by 39 annexes which related to the prosecution history of the present patent and its foreign equivalents.

The Opposition

- 15 The basis of the opposition as set out in the Opponent's statement of grounds amounts to the following three issues:
- i the Opponent contend that no satisfactory explanation is given for the proposed addition of new claims 2,3,4, and 8 and that the duty of full and frank disclosure has not been discharged in relation to any of these new claims;
 - ii the proposed amended claims 1,2,3,4,8 lack novelty and inventive step in view of D1 and European patent EP 0191509 ("D2");
 - iii the proposed amended claims are not clear as required by section 14(5) and therefore should not be accepted by the comptroller. I shall first consider the matter of discretion.

Discretion - The law

- 16 The application to amend is made under section 27 of the Act, the relevant paragraphs of which read as follows:

Section 27(1)

Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.

Section 27(5)

A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.

Section 27(1) makes amendment subject to the provisions of section 76. The relevant part of which reads as follows:

Section 76(3)

No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it -

(a) results in the specification disclosing additional matter, or

(b) extends the protection conferred by the patent.

- 17 Amendment under section 27 is a discretionary matter. The patentee must demonstrate that the application to amend was made in good faith, that the

request for amendment is justified, and that there are no statutory grounds for refusal. It is well established that the burden of proof to demonstrate allowability of the amendment is on the patentee.

- 18 In the present case, the Opponent initially raised the question of lack of good faith with respect to the proposed amended claims 1,2,3,4, and 8, which was later limited to the amended claims 2,3,4 and 8. However, this objection now falls away due to the Applicant requesting the deletion of amended claims 2,3,4 and 8 and the renumbering of the resultant claims. I will therefore not need to consider this point any further.
- 19 I will not need to consider the question of general discretion initially raised by the Opponent with regard to the amendment to claim 1 as although it was raised by the Opponent on the grounds of delay or failure by the Applicant to make a full and frank disclosure to the Comptroller concerning the amendment to the claim, this particular opposition was withdrawn in a letter from the Opponents dated 4th October 2004.

Discretion - the facts

- 20 The Applicant believes it has acted in good faith and in an expedient manner from the time that the existence of the prior art came to its attention and the filing of a request for an amendment in accordance with section 27. After reviewing the submissions from the Applicant on this point I consider that the 9-month period between the Applicant becoming aware of the Japanese specification and filing the request for amendment is not an unreasonable time period given that the Applicant is a large multinational company and communication regarding the amendment was necessary between individuals located in different countries. Consequently, I find that the Applicant has acted in good faith and in an expedient manner from the time that the existence of the prior art came to its attention to the filing of the present amendment request.
- 21 Furthermore, I find that the proposed amended claim 1 meets the requirements of section 76(3) because the proposed amendment essentially involves the incorporation of the matter of granted claim 2 into granted claim 1 and basis for this matter is to be found in column 2, lines 15-20 of the specification as filed.

Does the amendment cure the defect?

- 22 It is of course not sufficient for an Applicant for amendment to demonstrate that the circumstances and its behaviour are such that the comptroller should favourably exercise his discretion. To be allowable, the proposed amendments must also resolve the defect which they seek to cure. In these proceedings, the states in their statement of reasons that the proposed amendment is intended to *“provide a claim with the broadest protection to which the Patentee is entitled and which is both novel and has inventive step in view of D1 either in isolation or in combination with any other piece of prior art”*. In deciding whether the proposed amendments will cure the defect of invalidity

of claim 1, I shall therefore need to consider both the novelty and the inventive step of the proposed amended claim.

- 23 The case put by the Opponent appears to be that the amendments to the claim should be refused because the patentee has not provided a satisfactory explanation as to how the amendments patentably distinguish the alleged invention over the prior art identified by the patentee. I take the word “distinguish” in the context of the 1977 Act, as embracing both potential novelty and obviousness objections.

Assessment of Novelty

- 24 I will first turn to novelty. The relevant section of the Act is section 2, which reads:

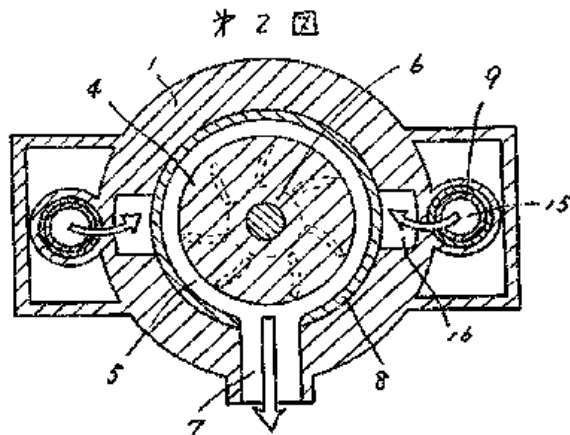
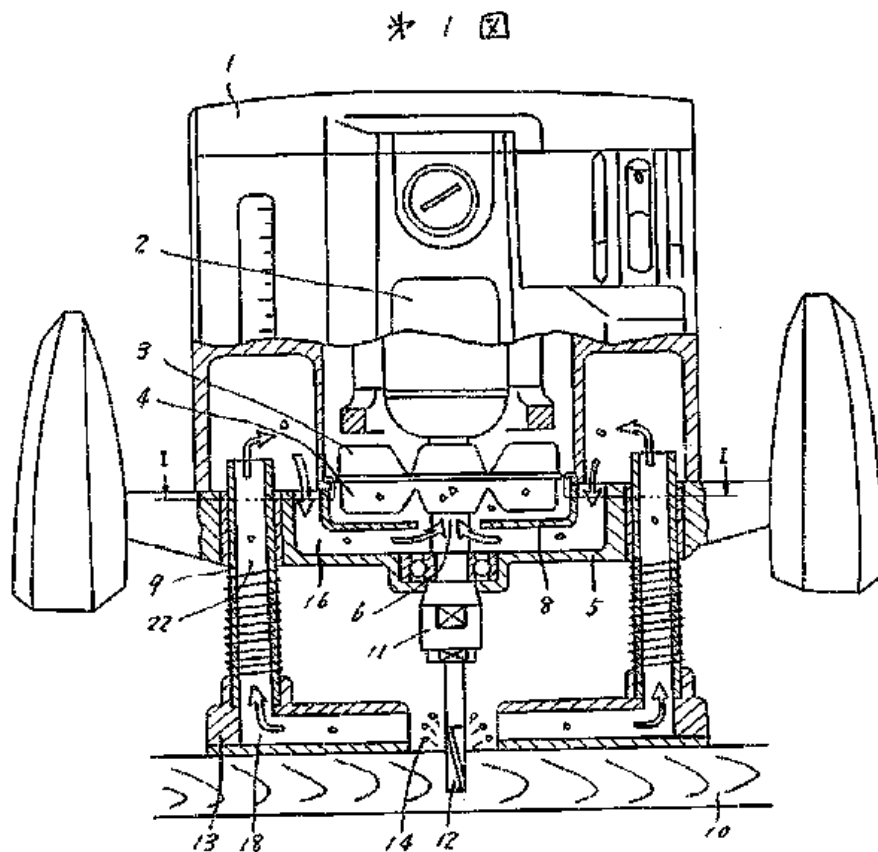
Section 2(1)

An invention shall be taken to be new if it does not form part of the state of the art.

Section 2(2)

The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

- 25 The specification D1 discloses two embodiments of router. The embodiment, shown in figures 1 and 2 reproduced below, discloses a router having two hollow guide columns (9) to which a cutter head (1) is slideably mounted to enable it to plunge with respect to a base (13). Dust is extracted from around the cutting bit (12) through the base and then through the first channel portions (22) formed by the router guide columns. The dust then travels through second channel portions (16) extending within the cutter head housing of the router to a suction extraction source. The suction extraction source is formed by an internal fan (4) rotatively driven by a motor (2) of the router and the dust is blown into a dust bag (17) attached to the side of the cutter head (1). In my view this embodiment anticipates the unamended claim 1 of the patent.



26 In considering claim 1 as amended, Mr Bell argued that the restriction imparted by the incorporation of claim 2 was not disclosed in this embodiment of D1. The Opponent argued in its statement of grounds that this embodiment discloses a suction extraction device connected to the upper end of the column which would anticipate the amended claim 1. What I must now decide is whether this embodiment does in fact disclose such an arrangement as suggested by the Opponent. In order to do this, I must interpret the meaning of the claims of the specification in accordance with the description and drawings. For this purpose I will need to consider section 125 of the Act, the relevant paragraph of which reads:

Section 125(1)

For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

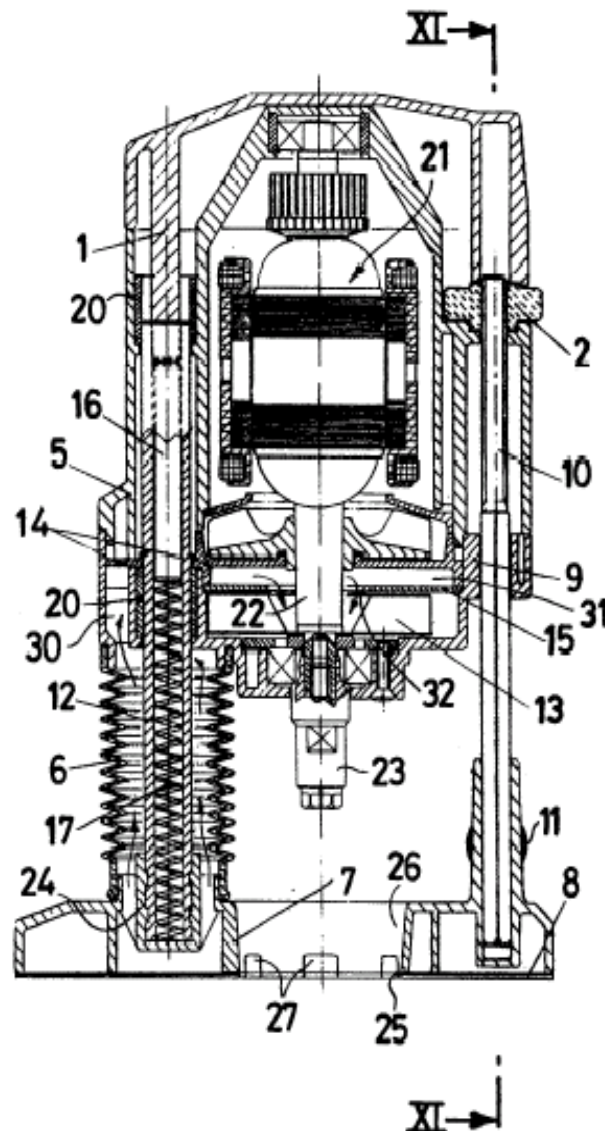
- 27 Mr Bell argued at the hearing that the amended claim 1 requires a connection to be provided at an upper end of a hollow guide column. This, he said, should be interpreted in view of the text of the specification, as a “*physical connector*” located directly at the top end of hollow guide column (31), as shown by the connection (33) located at the top of this column. His interpretation of a connector, if I understood him correctly, is a device which is capable of connecting to a separate or external suction extraction device, or at least, is capable of doing such a thing. He referred me to various parts of the specification to support his case, including: column 1, lines 19 to 23, which states that the connection is remote and away from the base plate; column 1, lines 55 to 58, which states that the connection is provided at the upper end of the hollow guide; column 3, lines 45 to 47, which mentions the holding ring being secured at the upper end of the guide column “*and the suction extraction connection is inserted into the holding ring in a detachable manner. The suction extraction connection (32) can be, for example, for a vacuum cleaner or the like.*” He also brought my attention to column 2, lines 12 to 18, which refers to the connection for the suction extraction column being at the upper end of the guide column. He stated that he did not believe that D1 disclosed any such connector directly connected to the top of the suction extraction device which he argued is further supported by the specification where the suction extraction device is a separate unit and if, as the Opponent argued in its submissions that it does not have to be a separate unit, it at least must be capable of connecting to a separate vacuum cleaner, that is to say a separate unit.
- 28 I have also considered column 1, lines 31 to 37 of the specification which makes reference to D2 to which I will come to later. This passage, Mr Bell argued, when the patent was originally drafted, distinguishes between the concept of having an internal fan, a fan chamber and a suction extraction device which is separate, that is a vacuum cleaner which can be attached. He argued that the meaning of the suction extraction device, as in the amended claim 1, should be interpreted as referring to an external or a separate suction unit. Even if it is argued that it could be an internal fan, he believed that the way the claim is worded, in view of the specification, that it should at least be interpreted that it was capable of being connected to an external vacuum cleaner unit, which is an assertion which I agree with. I have also considered column 3, lines 48 to 49 of the specification from which I consider that a skilled addressee is taught that the router can be connected to a separate external vacuum cleaner or device of some kind.

29 The Opponent argued in their submissions that the suction extraction device was present in D1 in the form of the internal fan 4, and the passageway 16, which connects to two hollow guide tubes 9. The Opponent argued that this is a suction extraction device and as it is in connection with the hollow guide tube(s), it forms a connection as claimed in the amended claim 1. However, Mr Bell disputed this and argued that the connection of D1 would have to be physically located/attached at/to the physical top of the guide tube in order to anticipate the amended claim 1, which is clearly not the case from an inspection of Fig.2 of D1. He went on to argue that as the router body of D1 plunges downwards and slides along on two legs in operation, it is actually moving away from the end of the top of the columns. Consequently, if the router body of D1 actually went all the way downwards, then the top of the column would actually be blocked off by the top of the chamber by sealing in the column. He stated that he did not believe that there was a connection in D1 in the sense of the connection as claimed, which is a view I agree with. The connection of the amended claim 1 should, he contended, be interpreted as meaning a connector for an external unit, or capable of connecting to an external unit. He referred me to column 4, lines 38 to 41, which indicates that the connection remains on the top of the column and is capable of remaining stationary during operation of the router ensuring that the passageway through which the air flow does not alter. I asked Mr Bell during the hearing whether the discharge port 7 of D1 could be considered as a connection in the context of the amended claim 1. He responded by pointing out that in amended claim 1, the channel between the base and the connection device runs inside the hollow column, such that even if the discharge port of D1 was considered to be a connection, as required by the amended claim, then the channel includes the passageway, the fan, and would also extend into the discharge port. The passageway of D1 then ceases to be completely contained within the suction column, as required by the amended claim. In my opinion, the correct interpretation of the proposed amended claim 1 is that put forward by Mr Bell and it follows that the amended claim 1 is not anticipated by D1 as suggested in the Opponent's submissions. I therefore find that D1 does not anticipate the router as required by the amended claim 1 and that the claim is novel over D1. I will now consider the disclosure of D2.

30 D2 discloses a router wherein dust/wood chips are extracted through a first channel portion by bellows (6) extending around a guide column (12) and then through a second channel portion extending through the cutter head housing (1,5,9) of the router to a suction extraction source. The extraction source is formed by a fan (13) driven by the motor (21) of the router. Alternatively, it can be formed by a separate dust extraction device, an external exhaustor, connected beyond the end of the second channel portions. A dust collecting bag or separate suction extraction source can be connected to the end of the handle portion of the router along which handle portion a third channel portion extends from the suction extraction source. If a separate dust extraction device is used, the fan can be removed. A suction channel is defined by the outer wall of the guide column and the inner wall of the bellows (6) surrounding the guide column. I believe that it is clear from an inspection of figure 6, reproduced below, of D2 that this suction system is totally inside the router thus eliminating any external components. Furthermore, D2

discloses the dust/chips passing through a passageway extending outside of the guide column rather than inside the column, but inside a set of bellows. As Mr Bell pointed out that there is nothing in D2 which discloses or suggests that dust/chips generated by the router passes through a passageway inside the guide column as required by the proposed amended claim 1, and I agree with him on this point. I therefore find that the amended claim 1 is novel over D2.

Fig.6



Assessment of Inventive step

31 Section 3 of the Act reads:

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part

of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

- 32 The Opponent has argued that the amended claim 1 lacks inventive step in view of D1 and D2. Having found earlier that the unamended claim 1 lacks novelty, I do not need to consider whether it contains an inventive step. I will now turn to the claim as it is proposed to be amended, which I have already found is novel, and consider whether it has inventive step in view of D1 and D2. The alleged inventive concept of the amended claim 1 is the restriction imported into claim 1 by the incorporation of the features of the previous claim 2.
- 33 Following the four step approach set out in *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd. [1985] R.P.C. 59*, the inventive concept seems to me to be a connection for a suction extraction device being provided at the upper end of a hollow guide column of a router. This differentiates the inventive arrangement from prior art types of routers wherein suction extraction devices are provided within the casing of the router and not by external means. The final question which I need to answer to determine the question of inventive step is whether it would have been obvious to the skilled addressee to provide such a connection at the upper end of a hollow guide column in view of the prior art. In determining whether this concept would have been obvious to a skilled addressee I need to consider, among other things, what was the relevant common general knowledge at the priority date. The extent to which I can do so depends on the relevant prior art documents I have to help me. In this regard, I will have to consider the documents D1 and D2 as referred to by both parties.
- 34 At the hearing, Mr Bell set out the benefits of the present patent, in particular the straightness of the guide column and the connection connected to the top of the column. He underscored the importance of removing wood chips in an efficient manner so as not to impede operation of the router. The arrangement of the claimed invention, he argued, provided a very straight direct passageway without sharp deflections. As the connection is located directly on the top of the column it is capable of being connected to an external vacuum cleaner, which can be extremely powerful, rather than relying on the motor of the unit itself. From a skilled addressee's point of view, because the internal fan of D1 is mounted on to the motor, and if a lot of dust/wood chips produced, then a heavy workload would be placed on the fan which would slow the motor down and in turn slow down the cutting operation as the same motor drives the cutting, which is clearly undesirable. The present patent provides a simple connection to a separate vacuum cleaner which can then be operated at any suction power without an effect on the actual motor driving the router unit. I find this to be a significant advantage offered by the amended claim 1 over D1 where the fan is driven by a motor which also drives the router and a feature I believe would not be obvious to a skilled addressee at the priority date.
- 35 He also explained that because the suction extraction device is connectable on top of the unit it allows use in workshops where the hose of the vacuum cleaner extends down from the ceiling and connects to the top of the router as

opposed to being connected on the side as in D1 where the discharge port is at the side of the unit, which restricts annular movement at vertical access whereas the router of the present patent may be rotated freely through 360 degrees. Again, I consider this feature to be an advantage of the present patent over D1.

- 36 Additionally, he pointed out the convoluted and complex passageway for the air and wood chips in D1, as shown in figure 2 where the passageway travels through the two hollow columns to the chamber above, it then has to pass through a 180 degree turn, and it then has to enter the fan, having done another 90 degree turn, it then does another 180 degree turn, before passing through a fan to the discharge port. The passageway has very sharp turns at the speed at which the air and dust would be travelling. Because the body of the unit of D1 has to slide up and down the two columns, and the end of the column terminates inside a chamber within the housing, there is likely to be complex sealing arrangements between the body and the side of the columns to prevent the dust and wood chips from i) interfering with the operation of a router, as it slides up and down the columns, and ii) to ensure a full seal so it maximises the suction effect. Again I believe D1 teaches away from the present patent where there are no connections or transitions in the passageway which require additional sealing due to the straightness of the guide columns. For the above reasons, I find that the amended claim 1 has an inventive step over D1.
- 37 I will now consider D2 where Mr Bell urged me to consider page 4 lines 19 to 26 thereof which arguably teaches the skilled reader to envisage a router unit with everything enclosed within the unit itself rather than suggesting the use of an external device. In my view, D2 teaches self-containment as opposed to the use of a separate suction unit which would teach away from the present patent rather than towards it. From an inspection of D2 it is apparent that the channel between the base and the fan is located between the column outside and a set of bellows. Mr Bell pointed out that the bellows, because they are usually made of rubber or some kind of similar material, are easily damaged and over a significant period of time, with the constant expansion and reduction of the length of those bellows due to the body of the router going up and down the columns, together with the dust and debris being sucked in turn into those bellows, it is likely to result in the damage of those bellows. In the amended claim 1, the suction extraction channel is clearly inside the hollow guide column and therefore the possible damage to the bellows is not an issue as far as the channel is concerned. In my view this is another advantage offered by the present patent over D2 as the bellows in the present patent are clearly outside the column as shown by figure 2. I therefore find that the amended claim 1 has an inventive step over D2.
- 38 I will now consider D2 in isolation and consider whether new claim 1 has inventive step in view thereof. Mr Bell argued that the straight path created by the column in the amended claim 1 having the connection located on the top of the column is quite unlike the path through the body of the router in D2. Even when D2 refers to using an external suction device, it simply refers to removing the fan, not completely redesigning the pathway. I have noted that the

removal of the fan is not shown in the preferred embodiment of D2 and it arguably teaches a skilled addressee the desirability of an integral fan, or at least a chamber to accommodate one. Additionally, the column of the router disclosed in D2 extends past the point where dust is drawn into the body of the router. This I believe would teach a skilled addressee in the art away from combining D1 and D2. If a skilled addressee were to combine them in this manner, they would either have to utilise a convoluted path to enable the saw dust to reach the fan of the router, which teaches away from the arrangement of the amended claim 1, or need to create a hole on the side of the column to allow the saw dust into the body of the router. However, such a hole then would form part of a complex junction between the column and the body of the router as the column is stationary whilst the body of the router has to move vertically up or down. I believe that such a construction is in no way taught or suggested by D2. I have noted that D1 does disclose the use of bushes but would suffer the sealing problems as discussed above in paragraph 34 and teaches away from the arrangement claimed in the amended claim.

- 39 I will now look at the question of whether the amended claim 1 has inventive step over a combination of D1 and D2. If one begins with D1 and then adds the teachings of D2, Mr Bell stated that he believed that a skilled addressee would end up with a router wherein the dust would actually travel between the base and the body of the unit in a passageway formed by a set of bellows which would be added on to the external side of the two columns, as disclosed in D2. Again, in my view this teaches away from what the claimed arrangement wherein a passageway is located internally of the column. A router in accordance with the amended claim 1 allows the path to be kept as short and straight as possible to prevent small electric shock being transferred to the operator of the router. Again, this is not taught to a person skilled in the art by either D1 or D2.
- 40 If I begin with D2 and then add the teachings of D1, it is possible that a skilled person might come up with the idea of drawing the air through the metal column as opposed to drawing the air surrounding the metal column, between the bellows and column, to overcome the problems described. D2 teaches the skilled addressee, as does D1, that the air is drawn inside into the body of the unit such as by an internal fan and then discharged through a discharge port. The router of the present patent passes to a connector, which is capable of connecting to an external vacuum cleaner. From the amended claim 1, a complete passageway between the connection and the base plate is enclosed within a hollow column. This I believe is an important distinction from D1 and D2 in which the suction channel extends from the base plate, through the hollow columns, but then passes through the internal body of the unit. Neither D1 or D2 teaches the skilled addressee to provide a connection directly on to the end of the hollow column. By contrast, both teach the use of a discharge port which is on the body of the rear of the unit. From a combination of D1 and D2, I believe that a skilled addressee would not derive the invention as claimed in the amended claim 1. For these reasons, I am not persuaded that the Opponent has shown that the inventive concept embodied in the amended claim 1 would have been obvious to the skilled addressee at the priority date.

Clarity of scope of amended claim 1

41 I also need to ensure that the amendment, while overcoming objections of lack of a novelty and inventive step, does not leave claim 1 manifestly invalid on some other count. In this respect, I should say that the question of clarity was initially raised by the Opponent with respect to the amended claims 2,3,4 and 8; however, as I indicated previously these claims have now been deleted and no longer need to be addressed. I will only need consider whether the amended claim 1 is clear as required by section 14(5) of the Act, the relevant sub-section of which reads:

The claims or claims shall -

(b) be clear and concise;

I have carefully considered the Opponent's submission that the amended claim 1 is not clear with regard to the word "complete" in the phrase "so that the complete suction extraction channel runs from the base plate to the connection for the suction extraction device inside the hollow guide column..."; however I am satisfied that it is clear to a skilled addressee that the amended claim requires the whole suction extraction channel to run the whole length inside the hollow guide column and not just part of it. I therefore find that the amended claim is self-explanatory to a skilled person and am satisfied that it meets the requirement of section 14(5)(b).

Conclusion

42 I have carefully considered all of the arguments and submissions before me, and concluded that the comptroller's discretion should be exercised to permit amendment, and that the proposed amendments are such to cure the defect identified by the Applicant. I therefore allow the request to amend EP (UK) 0673730 B1 in the manner sought.

Costs

43 The Applicant have successfully made their case and Mr Bell requested at the hearing that costs be awarded to the Applicant at the Comptroller's discretion. Costs in proceedings before the comptroller are usually awarded to the successful party on a contributory basis from a standard published Patent Office scale and my preliminary view is that I can see no clear reason to depart from that practice. However, I have had no submission on costs from the Opponent who, as I have said, was not present at the hearing. Accordingly I allow the Opponent's **7 days** from the date of this decision to make submissions on cost.

Appeal

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

Peter Back

Divisional Director acting for the Comptroller