



2 March 2009

PATENTS ACT 1977

APPLICANTS Christopher Norris and Veronica Norris

ISSUE Whether patent application number GB
0617647.3 complies with section 1(1)

HEARING OFFICER R C Kennell

DECISION

- 1 This application was filed on 8 September 2006 with no claim to any earlier priority. It was published under serial no. GB 2448862 on 5 November 2008.
- 2 The applicants are not professionally represented. Mr Norris has handled the prosecution of the application, but has been unable to persuade the examiner that the invention involves an inventive step as required by section 1(1)(b) of the 1977 Act. He does not wish to attend a hearing to resolve the matter, and I am therefore deciding it on the basis of the papers on file.

The invention

- 3 The invention is a bed extension for use in a touring caravan. The disclosure in the specification originally filed consists of a very brief description and a single drawing. The salient features of the invention as described are that the extension extends one single bed to a width of 104 cm, can quickly be clipped into place and will fold in half for simple storage in a bed locker. No other extras beyond a back cushion are said to be required, and the usual gap between the two single beds found in most touring caravans can be retained. The constituents of the extension shown in the drawing are identified merely by a specification of materials, but the drawing appears to show a hinged tubular frame of 335 mm width and a folded length of 715mm supporting a mesh surface and having folding legs with a tilting foot arrangement.
- 4 As to the size of the extension, Mr Norris explained in correspondence that the unfolded dimensions of 1430 mm x 330 mm were dictated by the usual width of a back cushion and the need to accommodate a locker at the end of the bed, and would make the device unusable elsewhere, eg behind lorry seats. The examiner thought it implicit that the extension would be shorter than a

conventional lying surface.

The law

- 5 By virtue of section 3 of the Act an invention involves 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 of section 2(2) above and disregarding section 2(3) above”. I do not need to quote sections 2(2) and (3) in full, but they have the effect that the prior art to be considered comprises all matter made available to the public, whether in the UK or elsewhere, before the priority date of the invention (in this case the filing date of 8 September 2006).

Arguments

- 6 The original claim was filed later than the application. It was not in the format usual for a patent claim, and was not clear in scope. However, insofar as it could be understood, the examiner considered that the claim defined the invention in its broadest form as a free-standing bed extension which would make beds in most touring caravans 50% wider, the extension folding in half for storage and having the legs folding flat (although he thought that the reference to folding flat would be unallowable as adding matter to the original disclosure).
- 7 Accordingly the examiner considered the invention obvious in view of US 3208407 (Maskew). This document discloses a portable folding table which can be placed between the front and rear seats of a car to provide a sleeping surface. In the preferred form it comprises two flanged sheet metal top sections which are hinged together at the flanges on facing edges so that the table can be folded in half for stowage; each section has legs which can be folded inwards to lie flat against the underside of the top section.
- 8 In response to arguments and amendments made by Mr Norris, the examiner made a number of further points in his report of 30 January 2008:
- Restriction to a use with a touring caravan would not of itself constitute a patentable distinction since touring caravans came in a variety of shapes and sizes and could be large enough to contain conventional beds.
 - Even though the prior art did not disclose the specific size mentioned in the application, this was a matter of non-inventive choice dictated by the particular circumstances.
 - It was known to extend the width of a bed for only a part of its length by means of a device which could be folded for stowage and clipped into place (see US 1331647 (Jaklich) discussed below).
 - The original specification merely mentioned that the extension was to be clipped “into place” and specifically did not mention clipping on to the bed. (Mr Norris had previously explained that the brackets to clip the device to the bed were omitted from the original drawing, although the holes to take them were shown.)

- It was common practice to provide height adjustable legs on beds, this being disclosed for example in US 5996145 (Taylor), US 3031689 (Sark) and GB 363730 (Williams).

9 Mr Norris accepted in his letter of 29 August 2008 that the clip, the size and the adjustability were not in themselves new products. However, he argued that the uniqueness of the invention lay in the combination of these features to provide the “standard touring caravan configuration” with a further option for the sleeping arrangements - although the examiner did not accept that there was any such standard. Mr Norris accepted that this further option would not be necessary for the Winnebago style caravan with traditional beds. In a further letter dated 6 December 2008 he pointed out that none of the beds in the three above-mentioned specifications showing adjustable legs would be capable of fitting inside a standard touring caravan, and drew attention to differences between the leg constructions in the invention and Williams.

Analysis

- 10 It is settled from case law that the question of obviousness must be assessed objectively against the standard of the notional person skilled in the art, not on whether it was obvious to the inventor or to some particular person. For this purpose the skilled person is the fully competent worker in the art in question, capable of considering the practical significance of the information he or she is deemed to have and of making routine workshop improvements - but not of exercising inventive ingenuity. Also, it is important that obviousness should not be assessed with the benefit of hindsight. To avoid falling into this trap a structured approach has been established by case law which requires me (1) to identify the notional skilled person and the common general knowledge in the art which is to be attributed to that person; (2) to identify the inventive concept of the claim; (3) to identify the differences between the inventive concept and the prior art; and finally (4) to ask whether those differences are obvious or would require a degree of invention.¹
- 11 The examiner saw the skilled person as being someone who worked in the field of beds. I agree, and I consider that such a person faced with the problem of extending the sleeping space available in a touring caravan would see this simply as a problem of extending the size of a bed in a limited space; this would not require specialised input from a caravan manufacturer. The skilled person would therefore consider the field of beds in general when looking for solutions to the problem; in my view (given what is stated in Williams at page 1 lines 10-17) it would be part of the common general knowledge in this field that a bed could be widened by means of a detachable device hooking on to the side rail of a bedstead and having pivotal legs to support it on the ground.
- 12 The absence of a clear claim makes it difficult to define the inventive concept but I agree with the examiner that in its broadest form it appears to be a free-standing

¹ A full discussion of the case law on obviousness will be found in Chapter 3 of the Office's Manual of Patent Practice; see <http://www.ipo.gov.uk/practice-sec-003.pdf>

bed extension capable of making beds in most touring caravans 50% wider, the extension folding in half for storage and having the legs folding flat. I also agree with him that there is no clear meaning to be attached to terms such as “standard touring caravan configuration”; in my view the reference to a touring caravan in the claim, if it can be construed at all, can only be understood as dictating a certain size for the bed extension.

13 Turning to the prior art found by the examiner:

- Maskew (published 1964) is outlined above.
- Williams (published 1931), although cited primarily for the disclosure of adjustable feet, discloses a full-length frame and mesh extension hookable over the side rail of a bed to extend the width, and the construction of the legs enables it to be used also as a settee. However, the extension is not foldable and nor, as Mr Norris rightly points out, is it free-standing when used as bed extension.
- Myers (GB 183181, published 1922) and Jaklich (published 1920) both disclose foldable bed extensions with legs which can be retracted, but in each case the extension remains attached to the bed when not in use, forming side valences in Myers and being retractable under the bed in Jaklich.

(For the moment I will pass over Taylor (published 1999) and Sark (published 1962); they do not disclose bed extensions and would appear to be of interest only as examples of the disclosure of height-adjustable legs.)

14 Although most of these documents are relatively old, in my view they are all documents which the notional skilled person faced with the problem of extending the sleeping space in a restricted area such as a touring caravan could be expected to find and consider. That said, with the exception of Maskew I do not consider that they would point the skilled person towards the inventive concept identified above; Williams does not disclose anything foldable, whilst the foldable extensions in Myers and Jaklich are intended to remain attached to the bed. (I would emphasise that I have relied above on Williams only for what it states to be the common general knowledge in the art).

15 However in my view the skilled person armed with the common general knowledge identified above - a bed extension hookable to the side rail of a bedstead and having pivotal legs to support it on the ground – would immediately realize from Maskew that such an extension could be made foldable parallel to its width and made free-standing by means of legs which could be pivoted to lie flat for storage. I accept that the “carbed” in Maskew is not a bed extension and is not used in a caravan, but it is directed to providing something which can provide extra sleeping space in a confined area (the space between front and rear car seats) and can be folded for storage when not required.

16 That leaves the size of the extension as the only difference between the inventive concept and the cited prior art (which is silent on the matter). However,

notwithstanding Mr Norris' explanation of why the device has to be produced to a particular size, I agree with the examiner that this is a matter of routine workshop practice and is not something that requires inventive ingenuity. If there was evidence that the particular size of the device resulted in some unexpected advantage, then that might have pointed towards inventiveness, but I do not think that is the case here: the inventor would seem to have done nothing more than calculate the dimensions necessary to fit the device into the space available in a touring caravan.

- 17 On the question of whether it was obvious to make an extension to the width of the bed which was shorter in length than the bed which was to be extended (as the examiner thought likely to be necessary with the present invention), the examiner cited Jaklich in which a crib for an infant is attached to the side of the bed. However, although for the reasons explained above I am not inclined to rely on Jaklich to make the point, I think this would still be nothing more than a routine workshop procedure for the skilled person, again dictated by the dimensions of the available space.
- 18 I therefore agree with the examiner that the invention in its widest form does not involve an inventive step, even if as Mr Norris has argued, there is novelty in the integration of the product into a touring caravan and the overall combination has never before appeared on the market. I have considered the specification and drawings very carefully, but I cannot see anything in them which might conceivably form the basis for a patentable invention.
- 19 Thus, even if the incorporation of clips or brackets to hook the device on to the bed could be regarded as part of the original disclosure, this is not inventive in my view having regard to the common general knowledge identified above. Nor would the use of legs of adjustable height seem to be anything other than a conventional feature in the art having regard to Taylor, Sark and Williams. As regards the other constructional differences between the particular device illustrated in the application and the devices shown in the prior art, these in my view are nothing more than conventional options for a manufacturer.
- 20 In relation to a finding of obviousness the question is often asked why, if the invention is obvious, it has not been carried out before (as Mr Norris suggests is the case here). However the fact that an invention has not previously been put into practice may be due to commercial considerations and is seldom conclusive that the invention involves an inventive step.

Conclusion

- 21 The invention does not involve an inventive step and, since it is not possible to add new matter to the original disclosure, no amendment is possible to overcome this finding. I therefore refuse the application under section 18(3) of the Act.

Appeal

- 22 If the applicants disagree with my decision, they have a right to appeal to the Patents Court. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any such appeal must be lodged within 28 days of the date of the decision stated above.

R C KENNEL

Deputy Director acting for the Comptroller