



13 January 2011

PATENTS ACT 1977

APPLICANT Philip Nixon

ISSUE Whether patent application
GB0611220.5 complies with section
1(1)(b), and whether to extend its
compliance period under rule 107

HEARING OFFICER J E Porter

Introduction

- 1 Patent application GB 0611220.5 entitled “Furniture raiser leg clamp, button, and raiser” was filed on 8 June 2006 in the name of Mr Philip Nixon, with no claim to an earlier priority date. The application was published on 12 December 2007 as GB 2 438 925 A.
- 2 Between September 2007 and February 2009 there were several rounds of examination. An impasse was reached on the questions of novelty and inventiveness, and the matter went to a hearing. On 23 July 2009, Mr Peter Marchant, a Hearing Officer acting for the Comptroller, issued his decision (BL O/218/09), in which he held that the invention of claim 1 (as it then stood) lacked novelty and inventiveness. I shall refer to this as “the first decision”.
- 3 For the reasons set out in the first decision at paragraphs 7 to 9, the Hearing Officer did not decide on the novelty or inventiveness of the dependent claims. Nor did he consider the amended claims which were offered at the hearing by the attorney for the applicant, Mr William Jones of ip21 Ltd. Instead, the application was remitted to the examiner.
- 4 In due course the applicant proposed an amendment to claim 1 in light of the first decision. After further examination rounds, the examiner agreed that the current set of claims define an invention which is novel, but the examiner and the applicant continue to disagree as to whether the invention as now claimed is inventive or not. As a result, on 6 October 2010 the applicant requested to be heard on the matter – but later requested that a decision be made on the papers.
- 5 The applicant also requested an extension to the compliance period on the basis of what his attorney referred to as “Office-attributable delays” in progressing the application.

The law

- 6 Section 1(1) sets out the requirement that an invention protected by a patent must, amongst other things, involve an inventive step:

A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -

- (a) the invention is new;*
- (b) it involves an inventive step;*
- [...]*

- 7 Section 3 sets out how the presence of an inventive step is determined:

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).

- 8 The attorney's written submissions in response to the examination reports cover various points in respect of the way in which I should apply these provisions to the invention in question. I have considered these submissions carefully as a part of my analysis below.

- 9 Separately, rule 107 of the Patents Rules 2007 provides a general power to rectify an irregularity of procedure. The compliance period (set out in rule 30) is one to which rule 107(3) applies, as follows:

A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if –

- (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office;*
- and*
- (b) it appears to the comptroller that the irregularity should be rectified.*

The invention

- 10 The invention lies in the field of devices for raising the height of a piece of furniture. It concerns a furniture raiser having two linked end supports, each end support having a cup-shaped leg clamp, which is designed to receive the furniture leg. A clamp screw with a clamping button on the end is tightened so that the clamping button presses onto the furniture leg.
- 11 The latest claims set, which was filed on 12 April 2010, comprises 1 main independent claim, 5 dependent claims and an omnibus claim in the usual format. The main claim reads as follows:

A furniture raiser comprising two end supports inter connected by a link [and with each such end support] incorporating a leg clamp having a clamp screw whose leg-contacting end carries a clamping button for contacting a furniture leg in use as the screw is driven home to clamp the leg against a wall of a cup in which the leg, in use, is supported, the clamp thereby spreading the force on the leg, and the button and the cup walls being free of any substantial protrusion so as to minimise wear to the surface of the leg.

- 12 The version of claim 1 that was found to lack novelty and inventive step in the first decision had the same wording as the present claim 1 but without the underlined wording shown above.
- 13 In order to overcome an objection by the examiner to a lack of clarity, the applicant proposed on 6 October 2010 the additional wording that I have shown in square brackets. This has not been filed formally as an amendment to the claim but I note it here nonetheless.

Arguments and analysis

- 14 The examiner maintains that the claims define an invention which is lacking in inventive step. His position is set out in detail in his examination report of 24 August 2010, and is summarised in his pre-hearing report of 12 October 2010. The applicant maintains that the invention as now claimed is inventive, and his position is set out in detail in the responses made by his attorney on 20 January 2010 and 11 August 2010.
- 15 What I must do is determine whether the present set of claims define an invention which is inventive, bearing in mind all of the documents at issue and also the first decision.
- 16 The Hearing Officer in the first decision worked through the well-established steps set out by the Court of Appeal in *Windsurfing*¹ and restated by that Court in *Pozzoli*². There is no disagreement that I should do the same. The steps are:

(1)(a) Identify the notional "person skilled in the art"

(1)(b) Identify the relevant common general knowledge of that person

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

(3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

- 17 With regard to step 1(a), in paragraph 29 of the first decision the Hearing Officer held that the person skilled in the art was:

a skilled technician familiar with furniture construction, familiar with devices for adjusting the height of furniture and familiar with the surrounding technical and engineering fields relating to such devices.

- 18 The applicant has not made any further comment on this point. I have no reason to differ from the Hearing Officer's assessment, and I am content to adopt it.

¹ *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd* [1985] RPC 59

² *Pozzoli SpA v BDMO SA* [2007] EWCA Civ 588, [2007] FSR 37

19 The Hearing Officer also discussed step 1(b) and the relevant common general knowledge in his paragraph 29, where he said:

This person will be aware of a wide range of common general knowledge in these fields, but the only point of relevance to the present discussion is whether his common general knowledge includes the provision of buttons on the end of clamping screws. I am sure that it does; the feature is so commonplace that anyone with any technical knowledge will be able to bring to mind examples of clamping screws used in everyday articles which use buttons on the end to spread the load.

20 Again, I am content to adopt this assessment so far as it goes. However, as the Hearing Officer noted, it was only necessary for him to consider whether the common general knowledge included the provision of a clamping button on the end of the clamping screw. Therefore, I must take the point a little further.

21 The examiner contends that the skilled person would also have knowledge of clamping buttons which are shaped to fit better with the object they are clamping and which may be reinforced to resist bending. He also contends that it is conventional for clamping buttons to be fitted loosely to the clamping screw. The applicant, in arguing that the claimed invention is now inventive, does not appear to comment specifically on these points.

22 As noted above, the skilled person is well aware of the possibility of putting a clamping button on the end of clamp screw so that it clamps the article to be gripped more effectively. He is also a generally technically-aware and capable person who is versed in furniture construction, furniture raising devices and related technical and engineering matters. Given all that, I think it is reasonable to conclude that, on the balance of probabilities, the skilled person would understand, as a part of his common general knowledge, that the clamp would work better if the clamping button fitted the article or articles to be clamped and if it was designed so that it did not bend or flex easily. He would also, as a skilled technician, know how those things could be achieved. I also consider that the skilled person would be very familiar with the idea that the clamping button can be fitted loosely to the clamping screw – as can be seen, for example, on many standard G-clamps.

23 Turning to step 2, I did not detect any disagreement, or indeed much discussion, between the examiner and applicant over this point. However, it seems clear that the inventive concept set out in the claim is a furniture raiser comprising two end supports interconnected by a link, where each of those two end supports incorporates a leg clamp, that leg clamp comprising a cup (for receiving and supporting a furniture leg) and a clamp screw with a clamping button on it, arranged so that the clamping button is screwed into contact with the furniture leg and clamps it against the wall of the cup, and where the clamping button and the cup walls are free of any substantial protrusions.

24 With regard to step 3, the relevant prior art for the purposes of this decision is a UK patent application in the name of the current applicant, published on 23 September 1998 as GB 2 323 274 A. I shall call this “the GB document”.

25 It is also the prior art document which, together with the common general knowledge, led the Hearing Officer in the first decision to conclude that claim 1 (as it then stood) lacked inventiveness. He considers its disclosure in paragraph 25 of his decision, where he says that the document

discloses a furniture raiser comprising a cup for receiving the leg of a piece of furniture and a screw clamp for clamping the leg against a wall of the cup. The cup walls are free of protrusions. The specification does not disclose a button on the end of the screw however.

26 As I note above, the applicant's response to the first decision was to add to claim 1 the feature of having two linked end supports, each with the previously-claimed cup and leg clamp. It was therefore a feature which was not considered by the Hearing Officer as a part of that first decision.

27 However, it is immediately apparent that the feature of linking two end supports, each with a cup and leg clamp, is one which is contained in the GB document. This is made clear throughout the description and in the figures.

28 Furthermore, the applicant and his attorney seem well aware that they have added to claim 1 a feature which is already present in the GB document. The attorney himself has pointed to the discussion of that document contained in the specification of the present application as being the basis for including the additional feature in claim 1 now. The first paragraph of the present specification discusses how the GB document discloses "a Chair or Bed Raiser which comprises two end supports interconnected by a link".

29 The Hearing Officer in the first decision concluded that the only difference between the invention of claim 1 before him and the disclosure of the GB document was that the latter did not have a button on the end of the clamping screw (paragraph 30 of the first decision).

30 Given that the applicant has now amended the furniture raiser as defined in claim 1 to include a further feature which is wholly present in the furniture raiser of the GB document, it remains the case that the only difference between the disclosure of that document and the inventive concept of the present claim 1 is the provision of a clamping button on the end of the clamping screw.

31 Turning to step 4, I must determine whether that difference – namely the provision of a clamping button – is inventive. In this respect, two points are made by the attorney in his letter of 20 January 2010.

32 The attorney's first point is that the GB document discloses nothing that is unsatisfactory with the embodiments it shows. Thus, he contends, the skilled person would have no motivation for modifying the disclosure of the GB document. I find this argument, and the implied conclusion that any modification must therefore be inventive, to be unconvincing. The fact that a piece of prior art is silent about any defects an invention may have does not, in my view, remove any motivation for the skilled person to consider making improvements to that invention using his common general knowledge.

33 The second point made by the attorney is that, if the skilled person did decide to modify the disclosure of the GB document, then he would be guided by the modifications suggested on page 6 of that document. As the attorney puts it:

The skilled man already therefore has the solution to the problem of positive leg location without leg damage. No further thought is needed; and the solution is not the one embodied in claim 1.

34 I have considered this argument carefully but I find that I am not persuaded by it. It is of course true to say that the modifications suggested by the GB document do not include the addition of a clamping button. If they did, then this decision would be considering a matter of novelty, not inventiveness. The disclosure referred to by the attorney discusses putting in the base of each cup (which receives the furniture leg or castor) an indentable material which takes on the shape of the part of the leg or castor which engages with that material, thus helping locate the leg or castor properly in the cup without damaging it. While this may be one solution to improving the proper location of the leg or castor in the cup without damage, the GB document also discusses the possibility of the clamp screw arrangement. I cannot see any convincing basis for saying that the discussion of these options would lead the skilled person away from using his common general knowledge to improve the disclosed clamp screw arrangement by fitting it with a clamping button.

35 The Hearing Officer in the first decision concluded that the provision of a clamping button on the known invention of the GB document was not inventive – see paragraphs 31 to 33 of his decision. Having worked through the *Windsurfing/Pozzoli* analysis as it applies to the present claim, and having considered the applicant's further arguments in relation to claim 1 as it now stands, I can see no reason for differing from that earlier conclusion.

36 As such, claim 1 is lacking in inventive step in light of GB 2 323 274 A and the common general knowledge. For completeness, I confirm that the proposed clarifying amendment to claim 1 (which I mention in paragraph 13 above) would make no difference to my conclusion.

37 Claims 2 to 4 set out different shapes that the clamping button may have in order to engage better with different shapes of furniture leg. Claim 5 includes the feature of loosely-fitting the button on the clamping screw and claim 6 refers to shaping the button incorporating webs so that it is resistant to bending when it is clamped.

38 I have already concluded that the skilled person's common general knowledge would include the knowledge that a clamp would work better if the clamping button fitted the article or articles to be clamped and if the button was designed so that it did not bend or flex easily, and that he would know how those things could be achieved. I have also concluded already that the skilled person would be very familiar with the idea that the clamping button could be fitted loosely to the clamping screw.

- 39 It follows that the features of claims 2 to 6 do not bestow inventiveness on the claimed invention. They are, in my view, routine workshop developments which the skilled person could bring to bear on the invention of claim 1 without displaying any inventive ingenuity.
- 40 I have reviewed the contents of the specification carefully, and I can find no other feature which may bestow inventiveness on the claimed invention. This means that the omnibus claim, claim 7, also lacks any inventive step.

Extension of the compliance period under rule 107

- 41 In his letter of 6 October 2010, the attorney states that he expects an extension to the compliance period to be made “automatically” in view of the “Office-attributable delays” in processing this case. This is understood to be a request for an extension under rule 107(3) of the Patents Rules 2007.
- 42 Rule 107 can be invoked to extend a time period if there has been a clearly-identified procedural irregularity which is attributable wholly or partly to the Office. A “procedural irregularity” may be an irregularity in a statutory or well-established non-statutory procedure.
- 43 Looking at the application file, I note that the application appears generally to have progressed at a steady rate, with a total of 7 reports and 2 other substantive letters issued by the examiner between the initial request for examination in May 2007 and now (and that period also of course covers referral to the Hearing Officer who issued the first decision). I also note that 2 of the examiner’s reports were issued within 4 or 5 months, rather than the 2 months that the Office would prefer to achieve, and the examiner apologised for that. Although regrettable, I do not think that these delays were particularly severe, nor unusual in light of the Office’s work priorities and backlog of examination work. I do not agree that they amount to a procedural irregularity within the meaning of rule 107, and I can see no evidence of any particular error or other irregularity in the handling of the case.
- 44 Thus I can find no basis for exercising discretion under rule 107(3) to extend the compliance period. It follows that I do not need to go on and consider whether, and under what conditions, that discretion should be exercised.

Conclusion

- 45 I conclude that the invention as defined in all the claims is lacking in an inventive step. I have been unable to find any other material in the specification which could form the basis of a patentable invention, and so I refuse the application under section 18(3).
- 46 Although refusal of the application makes the point irrelevant, I conclude that there is no basis for extending the compliance period under rule 107(3).

Appeal

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

Dr J E PORTER

Deputy Director acting for the Comptroller