

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

- 4 Matter which “forms part of the state of the art by virtue only of section 2(2)” is all matter which was made available to the public before the priority date of the application in question. In this case this means all matter published before 21 March 2011.
- 5 The task for me is therefore to determine whether Mrs Duncan’s invention does or does not involve an inventive step, or in other words to determine if it is obvious having regard to any matter made public before 21 March 2011. The approach to determining obviousness has been considered at length by the Courts most notably by the Court of Appeal in the cases generally referred to as *Windsurfing*¹ and *Pozzoli*².
- 6 What the Courts provided in those cases was the idea of using a structured approach to the problem of deciding whether an invention involved an inventive step. That structured approach involved the following steps:
 - (1) (a) Identify the notional “person skilled in the art”
(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?
- 7 I will return to this shortly but first it is useful to say a little about the invention.

The Invention

- 8 The invention set out in GB1104730.5 relates to a heat therapy bra. The purpose of the invention is to provide relief from breast pain. Heated pads are inserted into sealable pockets contained within the cups of the bra. The pads contain flax seed and lavender flower which are heated for example in a microwave, before being inserted into the sealable pockets within the bra cups. The latest claims are amended claims filed in response to the examination report dated 26 June 2014. Earlier amended claims submitted in response to examination reports dated 8 August 2013, 7 October 2013 and 23 January 2014 were rejected as they contained

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

² *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

added subject matter; I am satisfied that these claims are acceptable and add no further subject matter. I have made my decision on the basis of these claims, the main claim of which is recited below:

Claim 1

A therapy bra which provides heat therapy by the use of heatable flax seed and dried lavender flower filled pads where the bra comprises supporting cups with internal pockets fitted with hoop and loop fastening tape so as to be re-sealable thereby enabling filled pads to be inserted and positioned securely to mould smoothly over the entire breast area.

Does the invention involve an inventive step?

- 9 I continue to the question of whether the invention as claimed involves an inventive step, applying the *Pozzoli/Windsurfer* test as set out above.

Identify the Person Skilled in the Art and the relevant common general knowledge of that person

- 10 The skilled person, is a person who has the skill and knowledge to make routine workshop developments but not exercise inventive ingenuity or think laterally. Mrs Duncan made no argument as to the identity of the skilled person in this case. In my view the skilled person will be a person tasked with designing therapy and nursing bras and in particular bras that provided pain relief through the application of heat. They will be aware of techniques and materials for the construction of such bras and further aware of materials that may be utilised to provide a therapeutic effect when heated, for example the provision of pads filled with seeds and beads infused with well known aromatic formulations comprising herbs etc³.

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

- 11 The inventive concept as set out in the amended claim is in my opinion the provision of a bra comprising internal pockets into which heated pads may be inserted, said pads filled with flax seeds and dried lavender flowers.

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

- 12 The state of the art has been maintained by the examiner to be represented by two patent documents.
- | | | |
|---|--------------|------------|
| a | US7081034 B1 | (ZOELLNER) |
| b | US 5050595 | (KRAFT) |

³ For example the examiner cited US2008/0066233 A1 (RUSSELL). The disclosure of Russell explicitly refers to heatable inserts (for a cushion) that may contain ‘[H]erbs such as lavender’.

- 13 Both documents Zoellner and Kraft disclose bras into which 'heatable' pads are inserted into the cups to provide pain relief. Both documents utilise 'gel' packs which may be heated in for example a microwave oven (note Kraft in column 2, lines 57 – 60). Both documents are silent as to the use of Flax seeds and lavender as required by the claim of Mrs Duncan's application, Zoellner suggests other materials such as 'heating/cooling beads' (Zoellner column 2, lines 60 – 61).

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?

- 14 The final step of the approach set out in *Windsurfing* and *Pozzoli* takes us essentially to the statutory test i.e. is the invention obvious? This does not mean the earlier steps were unnecessary. Rather they are intended to ensure that a consistent approach is taken to determining whether an invention it is or is not obvious.
- 15 Although both Zoellner and Kraft are silent as to the use of flax seeds and lavender, they clearly point to a range of alternative materials that are suitable for this application. It would be obvious for the person skilled in the art to consider alternative fillings of the pads used in both Zoellner and Kraft and without the need to exercise inventive ingenuity to arrive at the use of flax seeds infused with lavender.
- 16 I believe the answer to this final question of the test is a clear yes, and It follows that I therefore do not consider the invention of claim 1 as amended to contain an inventive step.

Conclusion

- 17 I conclude that the invention claimed in the amended claim 1 is not patentable because it lacks an inventive step. I conclude that the dependant claims also lack an inventive step.
- 18 I have considered carefully the specification as a whole but am unable to find anything upon which an allowable claim might be based. I therefore refuse the application under section 18(3) for failure to comply with section 1(1)(b).

Appeal

- 19 Any appeal must be lodged within 28 days after the date of this decision.

Peter Mason