

claims which, though formally independent, gave the appearance of having some form of dependency relationship with each other. These claims bear very little similarity with the claims suggested by the examiner and their provenance is not clear, although claim 1 in each case does resemble the first element of claim 1 of Mr Keyes's PCT application (published as WO2004/043712 A1).

- 6 The set headed "Claims" was taken to be the one intended by Mr Keyes to be used to replace the original claims on file and this was done. The resultant amended claim 1 was similar to, but somewhat broader in scope than, the claim that had been suggested by the examiner, and as a result she reported it to be unacceptable in an examination report dated 12 December. The grounds for coming to this conclusion were not set out in great detail (possibly because the examiner hoped that Mr Keyes would agree to go along with the claim 1 she had previously proposed to him), but the report did include an implicit objection that the claim was anticipated by common knowledge. In the report Mr Keyes was also warned about the rule 34 period due to expire on 14 December 2005 and the need to file a Patents Form 52/77 and appropriate fee if he wished to extend it.
- 7 In his response dated 10 December 2005, Mr Keyes maintained his insistence that his application was in order and stated that the amended claim1 which he had filed in his previous letter was "the same as your suggested claim 1". He commented that "he should not need a hearing as it is the Government Office for the North West who you are acting on behalf of, as to deliberately standing in my way for obtaining a patent for this invention at the Patent Office".
- 8 Also in his letter dated 10 December, Mr Keyes disagreed with the need to extend the rule 34 period. The reason he gave for this was that the application was in order as of 14 December 2005.
- 9 In a further examination report, the examiner invited Mr Keyes to do one of two things: (i) to request an as-of-right extension to the period under rule 34 for putting the application in order and file amendments (with the suggestion that these should comprise the claims which the examiner had suggested previously) or (ii) request a hearing on the basis of the application as it stood at the end of the unextended rule 34 period. In response, Mr Keyes opted for a hearing.
- 10 In an attempt to move the situation forward without the need for a hearing, the examiner issued a new report citing five further documents with the objective of demonstrating that the amended claim 1 was not novel and persuading Mr Keyes to agree to the claims that had been suggested to him. In a letter dated 25 January 2005, Mr Keyes re-stated his request for a hearing.
- 11 On 1 February 2006 a letter was sent to Mr Keyes proposing two dates for a hearing (6 or 7 February 2006). It was pointed out that although normal practice is to give applicants fourteen days' notice of hearing dates it was in this case in Mr Keyes's own interest for the hearing to take place well before 14 February 2006 in order that he would be able to amend his application should the hearing officer decide that this was an option.
- 12 When nothing was heard back from Mr Keyes, the Office wrote on 6 February 2006 to inform him that a hearing had been appointed for 10 February 2006. The

letter also made it clear that if he did not appear, the matter would be decided on the basis of the papers on file.

- 13 The Official letter of 6 February apparently crossed with a letter from Mr Keyes dated 4 February which was received in the Office on 8 February. In this, he indicated his willingness to attend a hearing on 14 February in Newport or London.
- 14 Mr Keyes did not present himself at the Office to be heard on 10 February. On the assumption that this was because the Official letter appointing the hearing had not reached him in time, I adjourned the hearing until 14 February, this being the date he had indicated he could attend. A letter was immediately dispatched informing him of this, and inviting him to come to the Office at Newport on that day. This letter repeated the warning that if he did not appear, the matter would be decided on the basis of the papers on file.
- 15 Mr Keyes did not arrive either at Newport or at the Patent Office's premises in London on 14 February, and as of the date of this decision nothing further has been heard from him. I should also remark here that a note on the file indicates that attempts have been made to contact Mr Keyes by telephone, but he has been unreachable on the number he supplied.
- 16 In the light of the above, I shall proceed to decide the matter on the basis of the papers on file.

The Application

- 17 The application concerns a container for wallpaper adhesive or paint which is supported on a stand. A wall of the container is formed with an inclined portion for use in loading a roller. The purpose of the stand is to elevate the container off the ground to a suitable height so as to prevent a user from continually having to bend down. The height of the stand is adjustable insofar as it consists of interconnectable/stackable units/sections and the base unit can be filled with a ballast material to provide stability to the container and stand arrangement.
- 18 As remarked above, Mr Keyes filed three sets of claims on 28 November with his letter dated 1 November. Having reviewed the papers, I am satisfied with the view taken in the Office at that time that the claims to be used should be the first set referred to above, namely those that most closely resemble those suggested by the examiner. These read as follows:
 1. A decorators device comprising a container for holding adhesive supported on a stand wherein the container comprises a base and sidewalls extending upwardly from the base to form a reservoir with one side wall having a ramp portion and wherein the stand is serving to elevate the container off the ground which would result in the user not having to continually bend down to load a brush or roller.
 2. A decorators device according to claim 1 wherein the container is provided with attachment means for releasably supporting decorating implements.

3. A decorators device according to claims 1 and 2 is made from plastic material.
4. A decorators device according to any preceding claim wherein the container comprises a lid.
5. A decorators device according to any preceding claim comprises a handle to provide an easy means of moving the device around when required.
6. A decorators device substantially as herein described and illustrated in the accompanying drawings.

The Issues

- 19 Consistent with the objections made by the examiner, the substantive issues to be decided are whether the invention defined in the amended claims is new, as required by Section 1(1)(a) of the Patents Act 1977 and/or whether the invention involves an inventive step, as required by Section 1(1)(b) of the Patents Act 1977.
- 20 The relevant prior art comprises the following documents, all of which have publication dates earlier than the filing date of Mr Keyes's application. They have all been brought to the attention of Mr Keyes. Other documents were also cited at various stages during the application process, but it is not necessary for me to refer to them in this decision.

D1: US 4424949	(KIMMETT)
D2: US 4815604	(O'NEIL)
D3: US 5460391	(GANTZ);
D4: US 5190303	(SCHUMACHER)
D5: US 5624093	(GEMMELL)
D6: US 3837034	(LEFFERT)

- 21 There is also on the file an indication that Mr Keyes did not, at least at one stage, accept the examiner's warnings about the expiry of the Rule 34 period, although there is some hint in later correspondence that his position on this point might have changed. Therefore, for the avoidance of doubt, I have taken this to be a further question in dispute which must be formally decided.

The Law

- 22 What constitutes a patentable invention is defined in Section 1 of the Patents Act 1977 ("the Act"), and the relevant part of this section reads as follows:

Section 1(1):

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;
- (c)
- (d)

and references in this Act to a patentable invention shall be construed accordingly.

Novelty

23 The novelty of an invention is defined in **Section 2(1)** of the Act as:

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

24 What constitutes the “state of the art” referred to in Section 2(1) is defined in **Section 2(2)** of the Act as:

“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.”

Inventive Step

25 What constitutes an inventive step is defined in **Section 3** of the Act as:

“An invention shall be taken to involve an inventive step if it is not obvious to a skilled person 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).”

For current purposes, the last part of section 3 is not significant since the application was filed without declaration of priority. Therefore all of the documents taken into consideration in this decision fall into the section 2(2) area.

Period for putting application in order

26 The statutory basis for the period for putting an application in order is **Section 20(1)** of the Act which reads as follows:

“If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.”

27 The actual period for doing so is defined by **Rule 34** of the Patents Rules 1995 as

amended, the relevant parts of which read as follows:

34.-(1) Subject to the provisions of paragraph (2) below and of rule 83(3), for the purposes of sections 18(4) and 20(1), the period within which an application for a patent shall comply with the Act and these Rules-

(a) subject to subparagraphs (b) and (c) hereof and paragraph (1A) below, shall be-

(i) the period of four years and six months calculated from its declared priority date or, where there is no declared priority date, from the date of filing of the application; or

(ii)

- 28 The provisions of subparagraphs (b) and (c), as well as Rule 34 paragraphs 1A and 2 and Rule 83(3) are not relevant for the present purposes. Thus, in the case of the present application (which was filed without any declaration of priority), the relevant period is four years and six months from the application date. This period can, as of right, be extended by two months under **Rule 110(3)**, if an extension is requested and the requisite fee paid by the end of the thus extended period.

Assessment

(i) Novelty

- 29 The correct way to determine whether an application meets the requirements of novelty is well established and involves the steps of identifying the scope of what is claimed and comparing this with what was already known. An invention defined in a claim will lack novelty if the combination of features specified in the claim has already been disclosed. In the case of this application (which has no declaration of priority), the relevant date at which novelty is assessed is the application date, i.e. 14 June 2001. Thus, to be relevant, any cited material must have been published before this date.
- 30 The arrangement claimed in claim 1 comprises in essence two elements: a container and a stand. The container is defined to have a base, side walls and a ramp portion and is stated to be “for the storage of viscous substances (wallpaper paste/adhesives)” which, in accordance with accepted practice, I interpret as meaning only that it must be capable of holding such substances. The ramp portion is not further defined in any of the claims, but from the published description (in the paragraph spanning pages 4 and 5) I see that its function is to enable a user to load a roller with paste without needing to dip it directly into the reservoir, thereby reducing overloading and clogging.
- 31 The “stand” of claim 1 is not defined in terms of any of its features, save that it serves to elevate the container off the ground to avoid the user having to bend down. I conclude from this that it would cover not only a purpose-built stand, but also a general-purpose item, such as a step ladder or even a chair, which is capable of supporting a container (as defined) some distance off the ground.
- 32 Turning now to the question of whether the combination of features specified in claim 1 is new, in essence the objection put by the examiner to Mr Keyes in the examination report dated 12 December was that claim 1 covers a conventional

roller tray resting on any suitable support. It was backed up in the report dated 24 January with the citation of documents D1-D4, all of which disclose containers such as paint trays supported on stands.

- 33 Mr Keyes made no specific attempt to refute these objections at least as regards his latest claim 1. There is however on the file a considerable amount of material filed at earlier stages of the application, and some of this includes argumentation which could be regarded as applicable to the present claims. I shall therefore consider these arguments accordingly.
- 34 With his letter dated 1 November, Mr Keyes made submissions seeking to show why documents cited earlier in the proceedings should be disregarded. The basis of these arguments seems to have been that the arrangements in the citations relate to paint trays and are not suitable for an “improved adhesive mechanism for articles of wallpaper for walls, complex wallcoverings for surface areas and paper for ceilings”. He also argued that professional decorators do not use paint trays supported on stands because they would not want to remove the pole from the roller every time they needed to recharge it.
- 35 As I set out above, the key question in assessing Mr Keyes’s application is whether what he has *claimed* is new, and this involves deciding precisely what is actually claimed. Arguments such as those that Mr Keyes has raised can be relevant to such decisions in the sense that a claim has to be interpreted in the light of the description, so if an earlier document discloses an arrangement that is not suitable for the claimed purpose this suggests that the claim is OK.
- 36 The opening sentence of Mr Keyes’s description states “This invention concerns a storage device for viscous substances, in particular, wallpaper paste, *paint* [emphasis added] or the like.” Claim 1 recites “a device for the storage of viscous substances (wallpaper paste/adhesives)”. It is well established that the use of the phrase “a device for ...” in a patent claim is only limiting in the sense that it means a device suitable for the stated purpose. Admittedly, paint is not mentioned specifically at this point, but applying the principle that the claims should be interpreted in the light of the description, it is difficult in the light of the sentence referred to above to escape the conclusion that claim 1 encompasses trays suitable for use as paint trays.
- 37 I have taken account of Mr Keyes’s argument that a skilled decorator might use a paint tray and an adhesive tray in different ways, but I observe that this distinction is not brought out in the way that the invention is described and claimed. Moreover, the tray disclosed in D6, while stated to be for use with paint, is nevertheless relatively deep and resembles quite closely the tray shown in Mr Keyes’s application. It appears to be acknowledged from the description in D6 that this type of tray is favoured by professional decorators, which echoes the point made by Mr Keyes.
- 38 I should also here mention that other material put forward by Mr Keyes included evidence of his professional qualifications and correspondence showing that his invention had been considered by various companies. I have no reason to doubt Mr Keyes’s professional skills, or that he has been in discussions about the commercialization of his invention. However these are not things that I can take

account of in assessing whether or not his invention is new.

- 39 I therefore conclude that claim 1 is not new in the light of common knowledge in the form of a decorator's tray supported on any suitable means such as a ladder or chair, and also documents D1-D6.
- 40 The features of claim 2 are demonstrated in D3 (see Figure 18) and D6 (Figures 3 & 4) where it is clear that the container is provided with attachment means for releasably supporting decorating implements. I am satisfied therefore that D3 and D6 destroy the novelty of claim 2.
- 41 The tray disclosed in D2 is "constructed of a high density, high impact plastic" (see column 4 lines 1-9). This document therefore destroys the novelty of claim 3, which requires the decorator's device to be made from plastic material.
- 42 The tray disclosed in document D5 can also be provided with a cover (see Figure 1, reference numeral 10 & column 2 lines 39-40), which destroys the novelty of claim 4, which requires the container to comprise a "lid".
- 43 Document D3 (see Figure 18, reference numeral 54) discloses a container having a "handle" and therefore the features of claim 5.

(ii) Inventive Step

- 44 Having concluded that claims 1-5 lack novelty, there is no need for me to consider inventive step.

(iii) Period for putting application in order

- 45 In the examination report dated 27 September 2005 Mr Keyes was told that the period for putting his application in order would expire on 14 December. In paragraph 8 of his reply dated 1 November, Mr Keyes wrote that he disagreed with this on the grounds that "[a] patent application can take up to several years to put in order and is known as a late granted patent which you should know with you being in the profession of intellectual property rights". Among the papers Mr Keyes filed with this reply was a copy of a page from what appears to be official literature about how to obtain a patent in which the following statement appears: "It often takes several years to obtain a granted patent".
- 46 As I set out above, the period for putting an application in order is laid down in the Act and Rules and is four years and six months from the filing date. The arguments put forward by Mr Keyes do not address this directly or seek to show why this provision should not apply in the present case, and I am satisfied that it does indeed apply. However what Mr Keyes has said could be interpreted as an allegation that he has been misled in some way by the Office, and I should therefore consider this possibility.
- 47 Mr Keyes has not identified the source of the literature from which he quoted, although I am prepared to accept that it could have originated from the UK Patent Office. The advice conveyed is clearly of a very general nature and appears to be directed primarily at inventors who have not yet made a patent application. I note

that it refers not only to the process of applying for a patent within the UK, but also to the Patent Co-operation Treaty and the European Patent Office. The passage immediately following the extract quoted by Mr Keyes states that the average time to obtain a granted patent is “about two and a half years in the UK; rather longer in the EPO”.

- 48 The passage quoted by Mr Keyes does not refer specifically to the period of four years and six months, but I find nothing in it which is inconsistent with the existence of such a period. Moreover Mr Keyes was given explicit warnings in Official letters dated 27 September, 23 November and 12 December about the implications of the expiry of the Rule 34 period.
- 49 Having considered the above, I am accordingly satisfied that Mr Keyes was not misled by the Office about the Rule 34 period, and that he had no reasonable grounds for doubting that it would indeed expire on 14 December.

General remarks

- 50 I have not expressed any view on the acceptability of the alternative form of claim suggested by the examiner, and I do not now propose to do so, although evidently the examiner did believe the application to be salvageable. It is therefore regrettable that Mr Keyes did not attend the hearing. Had he done so, he might at least have had the chance to agree amendments on the spot which could have permitted the application to proceed to grant – provided of course that he requested a two months’ extension to the Section 20 period at the same time, which would have been allowed as of right. However, 14 February being the very last day on which he could have requested such an extension, this possibility now no longer exists.

Conclusion

- 51 I have found that the period for putting the application in order expired on 14 December 2005, and that on that date claims 1-5 on file did not meet the requirements of Section 1(1) of the Act. In accordance with the provisions of section 20(1), the application must therefore be treated as having been refused by the comptroller as of that date.

Appeal

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

A C Howard

Deputy Director acting for the Comptroller