

PATENTS ACT 1977

APPLICANT Mr Andrew Emery

ISSUE Whether patent application number GB
0404649.6 complies with sections 1(1)(b)
14(3) and 14(5)

HEARING OFFICER Mr B S Wright

DECISION

Introduction

- 1 The application was filed on 2 March 2004 and was published under serial no. GB 2411598 A on 7 September 2005.
- 2 Despite amendment of the claims during substantive examination and written argument, Mr. Emery, who is not professionally represented, has been unable to persuade the examiner that the invention is not obvious in light of prior art and that there is sufficient disclosure in the application as filed to enable a person skilled in the art to carry out the invention. The applicant, in his letter of 26 April 2008, indicated that he would like the application to be considered by a Senior Officer. This was confirmed by the applicant in his letter of 18 June 2008. Mr. Emery chose not to appear in person.

The application

- 3 The application relates to a cricket training mat. The upper surface of the mat is described as being divided into equal sized quarters by two white lines; one extending along the length of the mat, the other extending across the width. A series of coloured, geometric shapes are also provided on the surface of the mat which, in combination with the white lines, offer guidance and feedback to both left and right handed batsmen and bowlers on the line and length of a delivery.
- 4 The amended claim page as received on 13 November 2007 reads as follows:

“UK Patent application no. GB2411598A, is a device that acts as a gauge to define areas in order that best practice feedback can be delivered to cricket players while training and in particular as an aid to determine the

line and length of a delivery.

GB2411598A enables bowlers to amend and correct their actions through direct visual feedback and allows batsmen to do the same by the use of peripheral vision (as batsmen will be looking directly at the ball), and through subliminal feedback, through markings on the floor that act as a gauge.

The markings are of a symmetrical nature and describe an area of best practice for both batsmen and bowlers of a left and right handed orientation and this acts as a gauge for feedback.”

Issue to be decided

- 5 The examiner’s report of 28 January 2008 details the issues that I need to decide upon. The issues are: (i) there is a lack of an enabling disclosure; (ii) that the mat lacks an inventive step over an earlier mat produced by the applicant, as shown in Registered Design 2054038; and (iii) the claims lack clarity. Further correspondence was exchanged between the examiner and the applicant on these points and this has been taken into account.

The law and its interpretation

- 6 The law regarding inventive step is found in sections 1 and 3 of the Patents Act 1977 (as amended). The relevant part of section 1 reads as follows:

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) ...*
- (b) it involves an inventive step;*
- (c) ...*
- (d) ...*

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

- 7 The following part of section 3 is relevant since it defines what is meant above by ‘inventive step’.

3. 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 ...

- 8 In accordance with established practice the examiner has assessed the invention for an inventive step by following the four-step approach set out by Jacob LJ in *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588 (hereinafter “*Pozzoli*”). In *Pozzoli* the court reviewed the case law on the interpretation of section 3 and reformulated the four-step approach to assessing obviousness previously set out in *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*, [1985] RPC 59 (hereinafter “*Windsurfing*”). The court in *Pozzoli* concluded that the following test should be applied:

(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?*

- 9 The law regarding enabling disclosure (often referred to as “sufficiency of disclosure”) is found in section 14(3) of the Act. The section reads as follows:

14.-(3) The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

- 10 The law regarding the requirements for the claims is found in section 14(5) of the Act. The section reads as follows:

14.-(5) The claim or claims shall –

(a) define the matter for which the applicant seeks protection;

(b) be clear and concise;

(c) be supported by the description; and

(d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.

Sufficiency of disclosure

- 11 Firstly I will consider whether the application meets the requirements of section 14(3).

- 12 The specification does not need to disclose all the details of the operation to be carried out in order to perform the invention if these details are obvious and clear on the basis of either common general knowledge or of expert knowledge in the field concerned. A useful test, given in *Edison and Swan Electric Light Co v Holland*, 6 RPC at page 282, consists in asking whether anything new has to be found out by a person of reasonably competent skill following the directions in the specification in order to succeed; if the answer is yes, the disclosure is not complete enough.

- 13 The examiner has argued that there is insufficient information in the application as filed for a person skilled in the art to work the invention. During correspondence, the examiner has stated that it is not clear where the mat would

be placed i.e. at the bowlers end, somewhere between the bowlers end and batsman's end, or at the batsman's end. Furthermore the examiner argues that the application does not set out how the mat is to be used or the significance of the various coloured areas and markings.

- 14 I have studied the application carefully and must disagree with the examiner on this point. I am of the opinion that someone of competent skill would be able to construct the mat of the application. The mat is not of a special construction; the application merely requires it to be of certain dimensions and to be made of a durable material which can replicate a real cricket pitch. From the figures and accompanying description, I believe the competent person would have no trouble replicating the markings on the upper surface of the mat.
- 15 With regard to the mat's intended use, I believe that if presented to a cricket coach, someone who would have considerable knowledge in the field and possibly also having experience of using other cricket coaching mats, the coach would fully understand that the mat was to be placed at the batsman's end. The cricket coach would also understand that the mat was for use as a training aid by both left and right handed bowlers and batsmen. Furthermore, the coach would clearly understand the significance of the coloured markings and areas, and that they provide reference points from which both batsmen and bowlers can evaluate the merits of both the line and length of each delivery. As Mr. Emery has stated in his letter of 29 January 2008, the markings are not intended to show someone where to stand or which shot to play. The coach would not have to find out anything new following the directions in the specification in order to create or use the coaching mat.
- 16 Having concluded that a skilled person would be able to perform the invention, I find that the application meets the requirements of section 14(3) as set out above.

Clarity of the claims

- 17 I will now consider whether the claim or claims of the application meet the requirements of section 14(5) as this will have a bearing on my assessment under section 1(1)(b).
- 18 In his report of 25 September 2007, the examiner spelt out the importance of the claims to the application, and explained the need for the claims to define the "essential technical features" of the invention. The examiner pointed out that the claims would need to distinguish the mat from the applicant's own prior art.
- 19 Following the examiner's report, Mr. Emery filed the claim page now under consideration. Although the examiner raised clarity objections in relation to this and also provided Mr. Emery with an indication of what he might expect in a claim, no amendments were made. The claim page contains three unnumbered paragraphs, as reproduced above.
- 20 I should add that in his examination report of 21 April 2008, the examiner has also alluded to the fact that amended claims might contain added matter. Since

an added matter objection has not been formally raised I will not be making a decision on this issue.

- 21 It is not clear whether the paragraphs are intended as one claim or whether each paragraph is a separate claim. If I take the three paragraphs as relating to a single claim then I agree with the examiner that the claim does not clearly define the invention for which protection is sought. I am of this opinion since the claim would contain a number of sentences and defines the invention largely by reference to its purpose and by benefits/results obtained from use of the mat rather than in terms of technical features of the described mat. If the three paragraphs are treated as being just a single sentence, then I am still of the opinion that the scope of the claim would be wholly unclear.
- 22 If I consider the three paragraphs as being three separate claims then I must conclude that the first two claims fail to define the invention in a manner that complies with section 14(5) as they define the invention largely by reference to its purpose and by the benefits/results obtained from its use. They do not define the invention in terms of its tangible technical features, for example its construction, and I consider both to be of indeterminate scope. The third claim, whilst appearing to broadly define technical features of the invention, does not meet the requirements of section 14(5) as it does not clearly define the matter for which the applicant seeks protection, i.e. it does not even refer to a mat. I must add that if the three paragraphs are treated as three separate claims, there is no indication that the second and third read on from the first.
- 23 I therefore agree with the examiner that the claims do not meet the requirements as set out in section 14(5) above. In particular the claims are not clear and do not define the technical features of the invention for which the applicant is seeking protection, as required by sections 14(5)(a) and (b).

Inventive step

- 24 The examiner followed the *Pozzoli* test for inventive step in his substantive examination report of 28 January 2008.

Step 1(a) – The person skilled in the art

- 25 The examiner considered the person skilled in the art to be a cricket coach or a physical education teacher. Mr. Emery has not disagreed with this assessment. I take a slightly narrower definition of who the person skilled in the art would be. I would not consider a physical education teacher to be necessarily skilled in the art of cricket coaching. Not all schools play cricket and not all PE teachers coach cricket or have a cricket coaching qualification. Therefore I define the person skilled in the art as being someone who is well versed in the game of cricket who can transfer his/her knowledge to coaching.

Step 1(b) – The common general knowledge

- 26 The examiner has stated that the skilled person would know about where bowlers should bowl for maximum effect, and what types of shots batsmen should play to

different types of bowling and individual deliveries. He adds that the skilled person would know that there are both left and right handed cricketers. I do not disagree that these are things that the skilled person would know, but I consider it to be more accurate to say that the skilled person would know of coaching methods including coaching aids, and that he/she would be familiar with right/left handed players, variations in bowling line and length (and its effects), and the shots a batsmen should play (or not) in order to effectively deal with the variations in bowling line and length.

Step 2 – The inventive concept

27 Rather than base his analysis on the claim(s), the examiner has apparently looked at the application as a whole to identify the inventive concept. In his report of 28 January 2008, the examiner has identified the inventive concept to be (i) the addition of markings [to the applicant's earlier coaching mat for right handed players, as disclosed in Registered Design 2054038] for the left handed players, and (ii) the change of colours used (so as to increase contrast with a cricket ball).

28 As I have found above, the claims do not clearly define the invention, and I can quite understand the examiner's decision to take a 'whole contents' approach to determining the inventive concept. However, the fact that a claim, or a set of three claims has been provided cannot be overlooked and I must use this as a starting point to determine what the 'claimed inventive concept' is. Taking all three paragraphs into account, I consider the claimed inventive concept to be a cricket coaching mat with a set of symmetrical markings to offer left and right handed batsmen and bowlers with a visual aid to help determine the line and length of a delivery.

Step 3 – Difference(s) over the prior art

29 The applicant's Registered Design 2054038 is identified as the closest prior art. This disclosure relates to a cricket coaching mat that appears to give feedback to right handed batsmen and bowlers on line and length of deliveries. The abstract (as originally filed) of the present application highlighted two main differences between the "design" of the present mat and the mat of Registered Design 2054038: (i) that the mat of the present application can be used by left and right handed cricketers, and (ii) the mat has been coloured to contrast with a cricket ball. I agree with the examiner that these represent the difference between the described mat and the earlier mat. However, I have identified the inventive concept to lie within the provision of symmetrical markings on the mat and this constitutes the only difference between this mat and the mat of the Registered Design.

Step 4 – Are the differences obvious?

30 Having identified that the difference between the claimed invention and the prior art lies in the provision of symmetrical markings I must consider whether this difference is something that would be obvious to the skilled person. The examiner has also considered this point and concludes that it would not be

inventive to provide additional markings for a left handed cricketers as they would essentially be the right handed markings reflected on to the other half of the mat. I agree with this assessment. I consider a skilled person presented with the mat disclosed in the Registered Design and faced with the problem of needing to provide a mat for use by both left and right handed players would consider it quite obvious to modify the mat such that it is provided with a mirror image of the markings for a right handed player. This modification to provide "symmetrical markings" would not require any inventive ingenuity to be exercised. I therefore conclude that the claimed inventive concept, as identified above, lacks an inventive step over the applicants prior Registered Design 2054038.

- 31 For completeness I would add that if I were to instead adopt the examiner's assessment of the inventive concept, my conclusion would remain the same. In cricket, it is very well known to provide and use sightscreens and clothing that contrast with the ball. To modify the mat shown in Registered Design 2054038 to ensure a contrast between the mat (or any area thereof) and a cricket ball would be an obvious thing to do and would not involve any form of inventive step. Therefore I consider that a person skilled in the art would also consider this an obvious feature.

Conclusion

- 32 In the light of my findings above, I conclude that the invention fails to meet the requirements of section 1(1)(b) and section 14(5).
- 33 As things stand, the unextended compliance period has expired (2 September 2008). Thus 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. However, it is still possible for the compliance period to be extended by two months and, having examined the application carefully, I can see that Mr. Emery might be able to make some saving amendments to the claims such that they satisfy the requirements of sections 1(1)(b) and 14(5). In order to make further amendments Mr. Emery would need to make a request under rule 108(2) to extend the compliance period by two months. The request can be made by filing Patents Form 52 and paying a fee of £135. If extended, the compliance period would expire 2 November 2008. The request would need to be received by the Office no later than 2 November 2008.
- 34 At this point I should make it quite clear that if Mr. Emery were to extend the compliance period, any amendments he decides to file would be referred back to the examiner for consideration and it is possible that other issues, beyond those I have decided upon here, may need to be considered. The application may still be refused if the examiner finds that the requirements of the Patents Act are not met by the end of the extended compliance period.
- 35 I order that:
- i) in the event that the compliance period is not extended, the application is treated as refused under section 20(1);

ii) in the event that the compliance period is extended and amendments are filed, the application is referred back to the examiner for further consideration

iii) in the event that the compliance period is extended but no amendments are filed, the application is treated as refused under section 20(1) on expiry of the extended compliance period.

Appeal

- 36 The applicant can appeal to the Patents Court if he disagrees with my decision. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

B S Wright

Deputy Director acting for the Comptroller