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For Creativity and Innovation

BL O/275/08

9 October 2008

PATENTS ACT 1977

APPLICANT	Gram Engineering Pty Ltd
ISSUE	Whether patent application number GB0621836.6 complies with section 1(2)
HEARING OFFICER	Dr E P Plummer

DECISION

Introduction

1 Patent application number 0621836.6, entitled "A panel", was filed in the name of Gram Engineering Pty Ltd on 2 November 2006. It claims priority from Australian patent application number AU2005906129 filed on 4 November 2005. It has not yet been published.

2 The examiner raised objections that the application was excluded from patentability under section 1(2) on the basis that it was, in substance, no more than an aesthetic creation. After two rounds of correspondence and amendment, the examiner concluded that agreement was unlikely and the matter came before me to decide at a hearing. I subsequently agreed to give a decision on the papers, and allowed the applicant a final opportunity to submit written arguments and/or amendments *in lieu* of oral arguments. These were dated 11 August and were received on 12 August; they comprise both amendments and further argument.

The application

3 The most recent set of claims includes four independent claims (1, 25, 26 and 27). Claim 1 is typical, and reads:

> *A cladding panel formed from sheet material having opposite top and bottom edges and opposite longitudinal side edges, and being profiled to incorporate a plurality of longitudinally extending major formations of generally common shape lying substantially parallel to one another, each said major formation having a portion delineated from the remainder of that*

formation and which is not of constant size across the panel, ones of the portions being sloped differently to one another in a direction across the panel and respective of said portions extending along the major formations from the top edge to the bottom edge of the panel.

Claims 25 and 26 are similar. Claim 25 relates to a roof structure incorporating such a panel and claim 26 relates to a wall or barrier incorporating such a panel (both omitting the word "cladding"). Claim 27 relates to an apparatus, having suitable rolls, for fabricating such a cladding panel.

4 The description states that this is done to make it more visually appealing (page 1 line 19), to give it a more natural feel and make it more aesthetically pleasing (page 2 lines 11, 12; page 5 line 29, page 6 line 13, page 7 line 13), and to provide a consistent appearance (page 7 lines 8, 9).

The law and its interpretation

5 The examiner has reported that the application is excluded from patentability under section 1(2) of the Act, as relating to an aesthetic creation as such. The relevant parts of section 1(2) read:

1(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of:

……

(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;

……..

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or an application for a patent relates to that thing as such.

6 As regards the interpretation of section 1(2), it is common ground that the approach to be taken is that laid down by the Court of Appeal in *Aerotel/Macrossan*[1] and the Practice Notice issued by the Patent Office on 2 November 2006[2]. In *Aerotel/Macrossan* the court reviewed the case law on the interpretation of section 1(2) and approved a new four-step test for the assessment of patentability, namely:

1) Properly construe the claim

2) Identify the actual contribution

3) Ask whether it falls solely within the excluded matter

[1] Aerotel Ltd vs Telco Holdings Ltd & Macrossan's Patent Application [2007] RPC 7
[2] Patents Act 1977: Patentable subject matter [2007] RPC 8

4) Check whether the actual contribution is technical in nature.

7 However, the fourth step of checking whether the contribution is technical in nature may not be necessary because the third step - asking whether the contribution is solely of excluded matter - should have covered that point (see paragraphs 45 - 47 of the judgment).

8 I note that, by virtue of section 130(7) of the Act, section 1(2) is so framed as to have, as nearly as practicable, the same effects as the corresponding provisions of the European Patent Convention. However, the reliance that I can place on decisions of the Boards of Appeal of the European Patent Office under the corresponding Article 52 of the EPC must now be limited in view of the contradictions in these noted by the Court of Appeal in *Aerotel/Macrossan* and its express refusal to follow EPO practice.

9 The agents have referred me to two other authorities. The first is the CIPA guide. I would note that the CIPA guide is of interest, but it is not authoritative on me.

10 The agents appear to suggest that the CIPA guide teaches that section 1(2)(b) is somehow limited to the fine arts, and is not applicable to the applied arts. I do not believe that it does. All the CIPA guide says is that section 1(2) continues the prohibition of earlier acts on patenting fine arts. It does not limit the present section 1(2) to the fine arts, quite correctly.

11 The Patents Act 1977 is a new act of which section 1(2) expands significantly on the prohibitions of earlier acts. There is no limitation in the Patents Act 1977 to the fine arts, and I see no reason to infer one. Had Parliament intended section 1(2) to be limited to the fine arts, it would have said so.

12 To take an extreme case, a conventional motor-car would not become patentable merely because it was painted in a new and attractive colour. It would be excluded from patentability under section 1(2), however applied the arts concerned are.

13 The other authority that I was referred to is the EPO's book "Case law of the boards of appeal". As I have observed above, *Aerotel/Macrossan* severely limits the reliance that I can place on this.

14 The agents have referred me to the first two paragraphs of section 1.5 on page 19, and have provided me with a copy of the section. These are too brief to give me much in the way of useful guidance.

15 The first paragraph states that an aesthetic effect is not patentable, neither in a product or a process claim. Thus it is clear that a product, characterised solely by its aesthetic effects, is not patentable. This needs to be borne in mind when construing what follows.

16 The paragraph goes on to state that a means for producing an aesthetic effect may be patentable. That is of course true. For instance, a paint-brush for artists with novel and inventive technical features could be patentable, irrespective of the fact that it produces aesthetic paintings. But the paintings themselves would

not be patentable, and I am sure that the paragraph does not suggest otherwise.

17 I do not find the second paragraph useful. This describes a decision of an EPO board of appeal in very general terms. Every case must be considered on its own facts and its own merits; and there is simply not enough information here about the facts to give me useful guidance.

18 Despite this, I have read the granted claims of the European Patent (EP 0 169 509 B1) that was the subject of the appeal. They include a number of non-aesthetic features, such as sealing to protect the composite structure from weathering and mechanical influences, in addition to the aesthetic ones. I therefore do not find this precedent useful in deciding the present case for reasons that will become clear.

19 One final authority that I mention in passing is Shanley's application GB9801077.0 which was rejected at a hearing BLO O/422/02. Case law has moved on significantly since then, and this was argued differently, so I will not rely on it in any way. I merely note that my decision is consistent with it.

Arguments and analysis

20 I shall first address claim 1, and apply *Aerotel/Macrossan*.

21 There is no dispute about how to construe claim 1. It is a cladding panel characterised by a particular longitudinal profile pattern.

22 With regard to step 2, it is common ground that the actual contribution to the prior art is a panel having a particular pattern of formations.

23 Applying step 3, the examiner concluded on the basis of paragraph 4 above that the contribution was solely aesthetic.

24 Step 4 was therefore unnecessary.

25 On this basis, she concluded that the invention is excluded from patent protection.

26 In their last letter, the agents have helpfully listed four features that they consider to be provided by their panel, and which they believe to be technical in nature:-

(1) The panel provides an enhanced distribution of glare, with an overall reduction of glare from any single vantage point

(2) The panel has a complex profile and the invention provides a relatively inexpensive and rapid method for the manufacture of the panel

(3) The panel provides an illusion of increased width introduced by the varying size of the portions of the major formations across the panel

(4) The panel is reversible as its opposite sides (i.e. front and back) are mirror images to one another, thereby essentially providing the same profile.

27 On this basis the agents concluded that the contribution has significant technical contributions, and so passes step 3.

28 They also argued that these features rely on the physical features of the panel, and so are technical in nature, as required by step 4.

29 I will consider these four features in turn.

30 The issue of glare is not disclosed explicitly in the application. The only advantages of the invention disclosed are aesthetic ones (see paragraph 4 above). If the application were to be amended by deleting these, and replacing them with statements that glare is improved, I would consider the application to disclose a substantially different invention from that originally disclosed, and thus to add matter. For this reason alone, I do not believe that the issue of glare is one that I can take into account.

31 I would next comment that the agents have not indicated the reference with which the reduction or redistribution of glare takes place. I am prepared to accept that the glare will be improved relative to a flat panel, or relative to a panel with regular rectangular corrugations.

32 However, I am not convinced that there will necessarily be an improvement in glare relative to the panels cited by the search examiner, or relative to a simple panel such as a conventional sheet of corrugated iron. In the absence of any evidence to the contrary, I believe that there will not be any improvement in glare relative to these.

33 For either of these reasons, I do not consider that glare improvement provides a feature that enables me to allow the claims.

34 Whilst the application does describe the panel as inexpensive to manufacture, I am not convinced that it would be any less expensive or more rapid to manufacture than a panel with a different profile. Again, there is no indication of the baseline against which this is assessed, which makes the nature of this alleged advantage very nebulous.

35 The illusion of width is not disclosed in the application. The only reference for this that the agents can muster, that the applicant's reference is "Lookswide", hardly qualifies, and furthermore it does not appear to have ever been used in communications with the Office.

36 In any case, this is purely a matter of appearance. The fence, or the garden that it surrounds, or building that it clads, looks bigger, and this is more pleasing aesthetically. In my view this is an aesthetic effect, not a technical one.

37 There is no requirement in the claims that the panel is reversible. Thus it does not contribute to the invention.

38 In any case, the reversibility is one of the pattern and its appearance, and not of the physical construction of the way that the panels are attached to their mounts. All it means is that the panel looks the same from either side. Consequently, even if this feature were to be introduced into the claims, I would not consider it to be a

technical feature: in my view, it is purely aesthetic.

39 Thus the contribution provided by claim 1 is purely aesthetic, and claim 1 relates to excluded matter as such.

40 Step 4 is therefore unnecessary.

41 I therefore conclude that the invention in claim 1 resides solely in its aesthetic features. It is an aesthetic creation as such, and is excluded from patentability by section 1(2)(b).

42 Turning to the remaining claims, claims 2 to 26 fall for exactly the same reasons.

43 Claim 27 relates to apparatus comprising rolls for modifying the shape of sheet material passing through the nip of one or more sets of rolls, the forming rolls or the apparatus being collectively adapted to shape the sheet material to form a cladding panel as in claim 1.

44 Any contribution in this claim lies in shape of the rolls, which is determined only by the shape of the panel that is produced, and I have held that the shape of the panel is purely aesthetic. The purpose of the rolls' shape is aesthetic, not practical. In substance, this is a claim to the aesthetic creation so produced. It must fall with claim 1.

Conclusion

45 I therefore conclude that the invention relates to an aesthetic creation as such, and therefore is excluded under section 1(2).

46 I have read the application in its entirety, and I can find nothing which could be incorporated into the claims so as to provide conformity with section 1(2). I therefore refuse the application.

Appeal

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

Dr E P PLUMMER
Deputy Director acting for the Comptroller