



04 August 2009

PATENTS ACT 1977

APPLICANT Timothy Adam Kieck

ISSUE Whether patent application number
GB 0427064.1 complies with
section 1(1)(a).

HEARING OFFICER John Rowlatt

DECISION

- 1 Patent application GB 0427064.1 was filed on 10 December 2004, without priority, in the name of Timothy Adam Kieck, entitled '*Vacuum apparatus for foodstuffs*', and has been published as GB 2422286.
- 2 From his first report the examiner objected that, notwithstanding the considerable lack of clarity in the claims, the invention was not new.
- 3 As an unrepresented applicant in the USA, problems with his mail forwarding service have caused the applicant some difficulty, as have the differences in procedure between the IPO and those in the USPTO. Nevertheless, there has been considerable correspondence by email between Mr. Kieck and the examiner, including that he was assured by the examiner that there was no limit on the number of times he could communicate with the IPO and file amendments, as long as those fell within the period set for placing an application in order for grant (10 June 2009). It was also clearly explained that he could not add new features or developments to his application and that any divisional application could only be based on matter in the original application.
- 4 However, although there have been several examination reports, only at one point did the applicant put forward any argument on whether he considered his invention to have differences over the cited art, at other times merely filing broadening amendments, as will be apparent from paragraphs 8 & 9 below. During prosecution of the case, a further search was performed on broadened claims dated 04 March 2009. It was this search which revealed the most relevant citation against the application. Despite the warning that he could not add matter, there have been several objections by the examiner that amendment has done so. Due to lack of progress on the case, the examiner suggested a hearing on

more than one occasion so as to proceed to a conclusion. Mr. Kieck had been informed more than once that the application would need to be in order for grant by 10 June 2009.

- 5 Yet broader claims were filed and, as a result, with only a very short time remaining to put the application in order, following guidance a hearing was initiated by the examiner.
- 6 Even after the hearing had been initiated, Mr. Kieck wanted to continue filing amendments. The hearing process and what it would consider was explained on more than one occasion to him. However, rather than address the particular patentability issues concerned, Mr. Kieck asked if he could use the hearing process to press a complaint. He was advised that, although the content of his submissions was up to him, the hearing was his opportunity to argue against the examiner's objections and present the case as to why his application should be granted; the decision would be whether the application complied with UK patent law. He was also informed that it was permissible to file further amended claims for consideration as part of the hearing process if he so wished.
- 7 Unfortunately, Mr. Kieck then decided to disengage from the process entirely and has chosen not to address any of the issues either by argument or proposed amendment. I have, therefore, not been made aware of any circumstances on this case which have any bearing on my decision other than those currently on file. Consequently, this decision on the papers is based solely on correspondence and amendment present on file up to the date of the last action on this case, when the hearing was arranged by the examiner, since no other argument or amendment has been forthcoming.

The Application

- 8 The application as originally filed related to an airtight apparatus for storage of baked goods and foodstuffs with a built-in vacuum pump. The original main claim was very specific:

"1. An airtight apparatus for the universal storage of baked goods and foodstuffs with a built in vacuum pump which can be comprised of:

(a) a contoured plastic enclosure with air ports, which is used to store baked goods and foodstuffs, which can be transparent;

(b) an automatic vacuum pump and/or system with air ports used to expel air from within the enclosure, which can be built into the apparatus or connected separately, and regulated by a timer, sensor, or circuit;

(c) tubing to connect the vacuum ports to the enclosure;

(d) air filters to clean the air before it enters the vacuum pump;

(e) a lid, door, or sliding door which can be transparent or contain a

transparent window to allow visibility within the enclosure, or a transparent lid which can function as the enclosure itself, either of which can be equip with a handle and/or a latching handle, and shaped to form an air-tight seal with the enclosure;

(f) hinges which will connect the lid to the enclosure;

(g) a rubber gasket used to form an air-tight seal between the lid or door and the enclosure;

(h) an air actuator and/or vacuum release valve to release the vacuum pressure within the enclosure, which can use air filtration and can be activated manually or by a circuit;

(i) an LED display to indicate the date, time, and the use of various apparatus functions;

(j) buttons to initiate apparatus functions;

(k) circuit(s) and/or circuit board(s), which can be connected to various parts of the apparatus which will control various functions;

(l) electrical sensors, switches, integrated circuits, and circuit components to control the apparatus's functions;

(m) a standard 120 volt power cord to give the apparatus electrical power.”

9 The claims have been amended more than once during prosecution. By the time it came to me for decision it had been broadened significantly, despite the requirement for a further search and despite objections to added matter; the latest independent claim, dated 23 April 2009, reads:

- “1. *An apparatus comprising:*
- a. *An enclosure;*
wherein provides means for opening or closing of the enclosure;
 - b. *A seal to keep the enclosure sealed.”*

The law

10 As indicated above, the examiner has maintained objection to lack of novelty. The relevant sections read:

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) it is capable of industrial application;*
- (d) the grant of a patent for it is not excluded by subsections (2) and (3) or section 4A below;*

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

2(1) An invention shall be taken as new if it does not form part of the state of the art.

2(2) 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.

Interpretation

- 11 Although the examiner objected to the lack of novelty of the original claim 1 based on five citations, it has become clear during prosecution of the application that the closest prior art is a sixth document, US2004/0099332, by Mr. Kieck himself, published on 27 May 2004. The current UK application was filed on 10 December 2004, without priority, over six months after its publication; the citation therefore clearly falls within S.2(2) and forms part of the state of the art.

The arguments

- 12 Very clearly, the latest claim 1 at paragraph 9 above can never be novel – for example, it is met by any container having a seal and a closure. Conventional household items meeting the requirements of that claim 1 would be as diverse as a vacuum flask, a kitchen food container, or a domestic freezer.
- 13 Although he asked many questions of the examiner on procedure, the applicant has chosen throughout prosecution not to respond with argument to any of the examiner's objections to lack of novelty, except on a single occasion in which he attempted to distinguish the pump of his apparatus with that of GB2401528 (internal rather than external), a point which has become moot on location of US2004/0099332; substantive response has solely been by amendment of the claims, by broadening which has resulted in objections to added matter. Further, as I have already outlined, he has declined the opportunity to file anything for this hearing.
- 14 A useful starting point is original claim 1; it has very many features yet the examiner originally considered it to be known, at least from five patent documents, on the basis that the claim left it open that those features may be optional. Since then, US2004/0099332 has provided him with a more precise line of attack.
- 15 It is immediately apparent that figures 1-9 of the current application, except for an additional feature within figure 2 and one of the three alternative formations of figure 9, correspond exactly with figures 1-9 (the only figures) of US2004/0099332. The disclosure corresponding to the two sets of figures make it incontrovertibly clear that the fundamental basis of the invention, how it operates, and most of its additional features, is known. Indeed, original claim 1 of the current application corresponds with claim 1 of US2004/0099332 with the

addition of only minor features, which minor features are in any case disclosed in the description of US2004/0099332.

- 16 Clearly, the very comprehensive claim 1 as originally filed, despite its 13 itemized parts, is also not new.
- 17 It appears, therefore, that it is only necessary for me now to establish whether there is anything in the application as originally filed, or in the appendant claims, which is not present in the applicant's own US2004/0099332 and which might result in a patentable invention, and which might make it necessary for me to refer the case back to the examiner for further consideration. To my mind, there are four features which need to be considered – the manual pump, the alternative latching mechanisms, the various seal and lip shapes and the addition of the toaster and other heating mechanisms. Other features shown in the drawings of the application, such as the hinged lid, are described in US2004/0099332, as are separators, trays and the like.
- 18 The manual pump of figure 14 appears as a conventional piston mechanism, with a piston ring, valve and air holes, which operates in the same technical way as does a common balloon pump and other simple hand pumps. I can see nothing in the design which would not be familiar to users of such pumps.
- 19 I have considered the alternative latching systems disclosed in the application, as shown in figures 13 & 15, but cannot find anything which is not entirely conventional and well known to the public, the hook and pin at least in briefcases and suitcases, the clasp being ubiquitous.
- 20 The figures show various configurations for engaging the lid with the enclosure, which use lips, rims or grooves. Two of the configurations of figure 9 are disclosed in US2004/0099332; in the third, instead of having a groove on the lid with a lip on the enclosure the roles are reversed, an entirely expected alternative; a rounded, rather than angular, shape for the lip would likewise be expected, particularly as a rounded lip 9 is in any case shown in the first of the figure 9 alternatives. The description of figure 10 acknowledges that the rim/lip and seal configuration can be readily compared to "how a beverage cooler would close" and is therefore well known to the public. I can see nothing in the alternate shapes of figure 11 which would be unexpected or unfamiliar.
- 21 Figure 2 of the application shows a toaster as part of the apparatus. However, although there is no toaster in the corresponding figure in US2004/0099332, the citation specifically discloses that the appliance may have a built-in toaster or heating element. There is no disclosure of a magnetron, that is for microwave heating. However, whether there is an inventive step in such combinations of disparate articles has been covered by the House of Lords decision in *SABAF*¹.
- 22 Lord Hoffmann held that before you can ask whether the invention involves an inventive step, you first have to decide what the invention is. In particular, you have to decide whether you are dealing with one invention or two or more inventions. If two integers interact upon each other, if there is synergy between

¹ *SABAF SpA v MFI Furniture Centres Ltd* [2005] RPC 10

them, they constitute a single invention having a combined effect and one applies section 3 to the idea of combining them. But if each integer performs its own proper function independently of any of the others, and the claim is a mere aggregation or juxtaposition of features, the combination of a series of known features, each playing its usual part in the final entity, will therefore be a matter of design or mere collocation, and not of invention.

- 23 The toaster, heating element or magnetron (microwave generator), has no synergy whatever with the food enclosure; each plays its usual part and is therefore mere collocation, not invention. Further, there is no specific disclosure of any of the heating mechanisms, which are taken to be entirely conventional. I therefore do not need to undertake further analysis.

Conclusion

- 24 I have found that the invention, both in the latest main claim on file and that originally filed, is not new. Further, there is nothing in the original disclosure which has either not been explicitly disclosed in the applicant's own prior art, would not be thoroughly familiar concepts to the public, let alone a person skilled in the art, or is not simple collocation. I have considered the application in detail, but have been unable to find any saving amendment. I therefore refuse the application under section 18(3).

Appeal

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

John Rowlatt

Deputy Director acting for the Comptroller