

27 May 2010

PATENTS ACT 1977

APPLICANT David Evans

ISSUE Whether patent application
GB 0522362.3 complies with sections
1(1) and 14(5)

HEARING OFFICER C L Witchard

DECISION**Introduction**

- 1 Patent application GB 0522362.3 ('the application') was filed on 1 November 2005 claiming priority from an earlier UK patent application filed on 26 October of the same year. The title of the invention is given as "Golf driving range complex" and was published as GB 2431590 on 2 May 2007.
- 2 Despite several rounds of amendments to the claims accompanied by written arguments during substantive examination, Mr. Evans ('the applicant'), who is not professionally represented, has been unable to persuade the examiner that the invention is clearly described and is novel and inventive in light of the prior art. In his letter of 4 January 2010, Mr Evans indicated that he would like the application to be considered by a Senior Officer. Mr Evans attended the hearing on 27 April 2010. At the hearing Mr Evans stated that he did not wish to consider saving amendments to the claims and decided that he would prefer for a decision to be made based on the papers on file. The examiner, Mr Barnaby Wright, also attended.

The application

- 3 The application relates to a golf driving range having a target towards which users of the range direct their shots.

- 4 There are currently 22 claims, filed on 8 January 2010, with claim 1 being the only independent claim but claim 20 being dependent upon claim 1, but arguably broader in scope. They read:

1. Golf driving range comprising a target which is sufficiently tall so that, at normal golf driving distances, said target is clearly visible as a chimney- like, vertical, linear target in the air to which golf shots can be aimed at and hit.

20. Use of a target or a golf driving range as defined in any preceding claim for aiming shots at and hitting said target.

The law

- 5 The relevant sections are 1(1) and 14(5). These read:

Section 1

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) ...

Section 14

(5) The claim or claims shall -

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

(b) be clear and concise;

(c) ...

(d) ...

Clarity

Claim 1

- 6 The examiner has objected to the current claim 1 arguing that it fails to define the invention in a sufficiently clear and unambiguous manner and, insofar as it is understood, is unduly broad. The examiner argued that the presence of the phrases “sufficiently tall”, “normal golf driving distances” and “chimney- like” are subjective and open to a wide interpretation which thereby render the scope of the claim as indeterminate. The examiner also argued that the phrase “in the air” casts further doubts over the scope of the claim as it suggests that the target might be suspended above the ground rather than extending up from the ground.

- 7 In his letter dated 4 January 2010, and at the hearing, Mr Evans stated that he does understand the concerns of the examiner. However, he was unwilling to consider further amendments to his claims and could not find a clearer way of describing his invention without making the claims, in his opinion, too restrictive to be of value.
- 8 I shall consider the limitations Mr Evans has put on his claim in turn.
- 9 First we have the requirement that the target be 'sufficiently tall' so as to be aimed at and hit from 'normal golf driving distances'. Clearly the target to which a golfer is aiming their swing has to be big enough to be seen, and be hit by a golf ball. The target could not therefore be sized so that it could not easily be seen from a distance. A 'normal golf driving distance' is clearly a significant distance and I consider that this must imply a target that could be seen from around 300 yards away, that being a reasonable distance for a golfer to hit a ball when playing golf. A flag on a golf course is a good guide here, being in the region of 2 metres tall. Clearly golfers are able to aim towards these flags from a 'normal driving distance' as this is what they do on the golf course. The phrase 'sufficiently tall' does not allow a limit to be placed on the maximum height of the target. This phrase does not therefore place a clear limitation on the scope of claim 1, but includes a height anywhere over around 2 metres.
- 10 Second we have the requirement that the target be 'chimney-like'. The claim offers a further limitation to the design of the target by requiring it to be vertical and linear. This phrase brings to mind chimney stacks from factories, or cooling towers from power stations or possibly chimneys on houses. It does not appear to put any limitation on the shape of the structure, nor does it seem to imply any other feature of a chimney structure is required – such as the usually hollow nature of chimneys. The use of the word 'linear' does not provide any real limitation. It could suggest that the target is a straight, cylindrical structure but as it is clear that one option is for the target to be of conical shape the use of the word linear cannot be given this meaning. Instead the word 'linear' appears to be no more limiting than the use of the word 'vertical', in that it indicates an upright structure. Therefore the phrase 'chimney-like, vertical, linear' indicates some form of upright structure but gives little further limitation to the claim.
- 11 Third we have the phrase 'in the air'. This phrase suggests the target is raised from the floor in some way. It could be taken to mean that the target is suspended from something so that it is positioned 'in the air', for example, a target attached to, or hanging from a pole or tree, or it could be taken to mean that the target is formed so that it extends from the ground to 'up in the air', for example in the form of a hoop on a pole. The only option it appears to rule out is that of the target being a hole in the ground, which given the previous limitations of 'chimney-like' and 'sufficiently tall' appears to be no limitation at all. This term in the claim is wholly unclear.

- 12 The many varied interpretations these phrases can be given can only result in the exact scope of claim 1 being indeterminate. Construing the claim, using the limitations placed on its scope by Mr Evans and in light of the disclosure, I find that it encompasses any open space having some form of vertical structure therein, which could be used by a golfer as a target to be aimed at and hit. The scope of claim 1 is therefore unduly broad; indeed a golf flag within a golf course or driving range would fall within the scope of claim 1 as currently drafted. As such I find that the claim fails to clearly define the scope of protection sought and is unclear, contrary to Section 14(5) of the Act.

Claim 20

- 13 The examiner has objected to the current claim 20 as being unclear. The examiner is of the opinion that the claim does not necessarily limit the target to use within a golf driving range and that it seems to seek protection for the use of any target for aiming shots at and hitting.
- 14 Mr Evans has not commented on the clarity of claim 20.
- 15 Claim 20 initially refers to 'use of a target or golf driving range as defined in any preceding claim'. As currently worded, there is no distinction between 'a target', that is, any target, or 'a target as defined in any preceding claim', that is, only the target forming part of any of the preceding claims. Therefore, one possible reading of this claim is 'the use of a target for aiming shots at and hitting said target'. Such a target is not required to be used on a golf driving range. It could be aimed at and hit by anything, anywhere, for example, a gun at a gun firing range. If such an interpretation is taken, then the claim is not linked to the inventive concept of claim 1 and is concerned with any target which can be shot at and hit.
- 16 An alternative interpretation may be that the claim is attempting to make the use of the target referred to in claim 1 the invention and the presence of a golf driving range is not required. This then casts doubt over scope of claim 1, as the focus of the invention has shifted from a golf driving range to a target. The target in this case could be any structure which is 'chimney like' and 'sufficiently tall' but may be situated elsewhere than within the golfing range.
- 17 I find that claim 20 does not clearly define the scope for which protection is sought, contrary to Section 14(5) of the Act.

Novelty

- 18 Notwithstanding the fact that I have found that both claims 1 and 20 are anticipated by, for example, the use of a flag pole on a golf driving range or in the case of claim 20 any target which can be aimed at and hit, the examiner has cited a number of documents as demonstrating that the claims lack novelty. In the examination pre-hearing letter dated 16 March 2010, the examiner listed citations (JP 06098961 A (K D SPORTS), US 2001/002370 A1 (HELSTROM) and WO 98/01190 A1 (DAVIS)), which he argued disclose open spaces containing linear vertical structures that could be used as targets by golfers wishing to take practice shots. I will consider each document in turn.
- 19 KD SPORTS shows a series of steel towers 1 positioned around the boundary of a golf driving range which could be selected by a user of the driving range as a target. Figures 2 and 3 show that the netting is placed between these towers so that the towers are exposed within the range and can be struck by a golfer choosing to aim at them.
- 20 HELSTROM shows a golf driving range having a series of tall posts around its outer perimeter, netting is then suspended from cables between these posts. The posts are sufficiently tall and 'chimney-like' and could be used as a target by the golfers.
- 21 DAVIS shows a golf driving range having a series of poles around its boundary, between which are strung sheets of netting. As shown in figure 2B, the pole (36) is not covered by the netting and could be hit by a user of the golf driving range, should they so wish to aim at them. The pole may be targeted by a user of the driving range to be hit with a golf ball should they wish and falls within the definition of the target given in claim 1.
- 22 I find that claim 1 lacks novelty over the disclosures of KD SPORTS, HELSTROM and DAVIS, as required by section 1(1) of the Act.

Inventive step

- 23 As the current claims fail to comply with the Act for novelty and clarity there is no need for me to consider the inventive step objections made against the appendant claims in detail. Further, these points have not been fully argued. However, I will discuss this issue briefly.
- 24 For a patent to be granted the claims must demonstrate an inventive step over what is already known in the art, in other words the claimed invention must be non-obvious to the skilled person. In this instance the skilled person would be an individual with knowledge of the games and sports arena. Their common general knowledge would include the fact that targets are commonly used for aiming at in a number of sporting activities, particularly ball games, and that it is common for individuals to hone their skills by taking practice shots aiming at some form of target.

- 25 Considering Mr Evans's application, its current claims and his statements at the hearing that the invention was in the tall structure that could be aimed at, I consider that the inventive concept disclosed would be the use of a tall structure, approximately 30 metres tall, having holes with sensors for players to aim for. The closest prior art cited by the examiner is US 3889957 ('KLABACKA'). This document describes a large target, which can be hit from a substantial distance by a golf ball, having a number of holes for the golfer to aim at. If the ball enters a hole it will actuate a signaling device to register the fact. There is also a collection and retrieval system for the balls that enter the target.
- 26 The differences between this disclosure and Mr Evans's application appear to be minimal. It could be argued that the current application envisages a differently shaped target to that of the KLABACKA document. The KLABACKA document does describe a target that is spherical, which could be considered to be different to the target of the current application, but I note that this is referred to as a preferable arrangement and the document does state that the shape is not critical and can take various forms.
- 27 It seems likely that the skilled person would, with no inventive skill, arrive at Mr Evans's target after reading the KLABACKA document and that claims 2, 7 and 8 would not demonstrate an inventive step if combined with claim 1.
- 28 I am not able to fully consider all possible claims that the applicant might put forward for this application but note that many of the claims define trivial features, or well known features of golf driving ranges. Whilst it is still open to Mr Evans to file amendments on this application he would need to consider the scope of claim he files and how this demonstrates the required inventive step if he is to obtain a granted patent.

Saving amendments and the compliance period

- 29 As things stand, the unextended compliance period has expired (on the 26 April 2010). 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. In order to make further amendments Mr. Evans 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 26 June 2010. The request would need to be received by the 26 June 2010.

- 30 At the hearing Mr Evans stated that he did not wish to consider making further amendments to the claims as these would, in his view, result in a patent that was too restrictive to be of any value. It is true that any claim which could be granted for the current application would have to have a considerably narrower scope than that currently filed and would need to clearly demonstrate an inventive step over the cited prior art. However, I cannot conclude, on the basis of what I have considered to date, that no grantable claim can be drafted for this application. I will allow Mr Evans one month to file amendments if he wishes. These will then be remitted to the examiner for consideration as to whether they meet the requirements of the Act, in particular in clearly defining the invention such that an inventive step can be identified.

Conclusion

- 31 Mr Evans has one month in which to file amendments to the claims, and the required Form 52 and fee to extend the compliance period. These amendments will then be considered by the examiner. Both the amendments and the Form 52 must be filed by 26 June 2010.
- 32 If Mr Evans does not file amendments this application will be refused on the grounds that the current claims are not clear, do not clearly define the scope of protection sought and claims 1 and 20 are not novel. If the compliance period is not extended the application will be deemed to have been refused on 26 April 2010. If the compliance period is extended but no amendments are filed the application will be deemed to have been refused on 26 June 2010.

Appeal

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

C L WITCHARD

Deputy Director acting for the Comptroller