



5 July 2010

## PATENTS ACT 1977

APPLICANT                                Mr William Kostuj

ISSUE                                        Whether patent application number GB  
    0709515.1 complies with sections 1(1)  
    and 14(5)

HEARING OFFICER                        Ceri Witchard

---

## DECISION

### Introduction

- 1    This decision relates to application 0709515.1, which is derived from international application WO 2006/049997, published on 11 May 2005, and was published in the UK on 25 July 2007 under the serial number GB 2434322.
- 2    An examination report was issued on 9 October 2008 and rounds of correspondence between the examiner and the applicant followed. During this time the examiner has maintained that the claims do not clearly define the protection the applicant is seeking and are generally unclear. He has also raised objections relating to the novelty and patentability of the claims. Despite numerous rounds of amendment no agreement could be reached.
- 3    In the final examination report, issued on 18 December 2009, the examiner raised a number of objections with regards to the claims on file. Principally that the claims did not define clearly the scope of the invention and were not novel.
- 4    These matters came before me on 12 April 2010. The hearing was held via telephone conference. The applicant, Mr Kostuj, represented himself at the hearing. The hearing was also attended by the examiner, Mark Sexton. Following the hearing Mr Kostuj requested the opportunity to file additional arguments in writing. I agreed to this request. Submissions in writing were filed on 10 May 2010 and I have taken these into account in my decision.

## **Period for putting the application in order**

- 5 The prescribed period for putting this application in order expired on 9 December 2009. The unextended period would have expired on 9 October 2009, twelve months after the issue of the first examination report. This period was extended, as of right, by two months. Although the applicant could have requested a further discretionary two month extension to this period he did not do so. Of course, he would have needed to provide evidence that such an extension should be granted and this may have been refused. The possibility of seeking such an extension ended on 9 February 2010.
- 6 Mr Kostuj indicated at the hearing and in his written submissions that he felt he might have been misled regarding the possibility of seeking an extension to the compliance period, in that he believed the examiner was telling him not to seek an extension as it would not be granted. I have treated this as a request to extend the compliance period under Rule 107(3). This rule reads:
- 107 (3)** A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if
- (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and
- (b) it appears to the comptroller that the irregularity should be rectified.
- 7 For this Rule to apply it is necessary to show that there has been an irregularity in procedure which is attributable, at least in part, to the Office.
- 8 Mr Kostuj was made aware of approaching end of the compliance period on a number of occasions, the examiner explained in examination reports that the period would expire on 9 October and the means by which it could be extended. He also made clear to Mr Kostuj the implications of the expiry of the compliance period in that he would not be able to make amendments to his application after the period had expired.
- 9 On 14 October the examiner wrote to Mr Kostuj confirming that he was entitled to a two month extension of the compliance period, as of right, and stating that further extensions were discretionary and would require evidence, a further form and payment of an additional fee. This letter informed Mr Kostuj that a discretionary extension was unlikely based on the evidence that had been filed so far. This left it open to Mr Kostuj to request the extension, possibly filing additional evidence. He chose not to do so. I therefore find that Mr Kostuj was not misled regarding his options for seeking an extension for the compliance period.

- 10 From the papers on file it appears that the first examination report was issued by the Office on 9 October 2008. At the time the report was issued Mr Kostuj was professionally represented and the report was sent to his representative, as standard procedure dictates. However, Mr Kostuj did not receive the first substantive examination report from his representative until March 2009. I cannot determine why the report that was issued from the Office did not reach Mr Kostuj sooner than it did, but there is no indication of any irregularity within the Office. Further, Mr Kostuj received the examination report when there was still seven full months of the unextended period for putting the application in order remaining. This is sufficient time to complete the examination process.
- 11 The period for compliance has expired and I find that Mr Kostuj was not misled regarding his options for seeking extension and had a reasonable time within which to put his application in order. Further, I find that there was no procedural irregularity within the Office that may have caused any delays to the processing of this application. Therefore the decision before me is whether on 9 December 2009 the application was in order. If the application was not in order at that point no further amendments can be made and it will be refused.

### **The law**

- 12 Section 14(5) is concerned with the claims:
- The claim or claims shall -
- (a) define the matter for which the applicant seeks protection;
  - (b) be clear and concise;
- ...
- 13 Further, section 1(1) defines the requirements for a patentable invention, namely that:
- 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;

## **The claims**

- 14 The claims under consideration are those filed by the applicant on 8 December 2009. There is one clearly independent claim, claim 182. All other claims are, at least notionally, dependent upon this claim. Claim 182 reads:

A method comprising:

Analyzing the movement of at least one test golf club as moved by at least one golfer during at least one pre-swing movement using data obtained via at least one sensor means disposed about said at least one test golf club; and

Determining a golf club rotation point existence and location via said analysis, whereby the determined rotation point location is output as a fulcrum location about which a golf club rotational force measurement may be determined and used by said at least one golfer.

## **Clarity and scope of the protection sought**

- 15 The examiner has raised a number of objections in relation to the clarity of the claims and whether the claims clearly define the scope of the protection sought by the applicant.
- 16 At the hearing the applicant said that it was important to understand that patent applications are drafted by a person who is skilled in the area to be read by a person who is skilled in the area. I agree with Mr Kostuj's assertion. It is a well understood feature of patent law that claims must be interpreted in the manner in which the skilled reader would construe them. I also agree with the applicant's assertion that, in this instance, the skilled reader would be an individual who has knowledge regarding the making and fitting of golf clubs.

## **Claim 182 – the main independent claim**

- 17 The pre-hearing report raises a number of issues with claim 182, stating that the claim lacks the required clarity to enable the skilled reader to determine the scope of the protection being sought.
- 18 The examiner has objected that the claim refers to analyzing 'test golf club movement' but does not specify the form the club should take and that the description defines two possible golf clubs, which may take a number of forms. Mr Kostuj argued that the two golf clubs described are for different purposes within the description, and that no confusion arises.
- 19 The description of the two test golf clubs is not particularly detailed but clearly states that the golf clubs might be any club, and that no special modifications are necessarily required.

- 20 Whilst this wording is not ideal, I find that the skilled reader would simply interpret this wording as 'a golf club'. It is clear that the claim is intended to be a method of fitting golf clubs generally. The use of the word 'test' is somewhat unnecessary and non-limiting, but does not overly obscure the meaning of claim 182.
- 21 The examiner also raises an objection to the second half of claim 182, which indicates that the method looks for the existence of a rotation point, which may or may not exist. The examiner argues that this implies that the second half of the claim is optional. At the hearing, Mr Kostuj argued that the claim is a method of determining a rotation point when a golfer swings a club so that the club can be fitted to the golfer. In some cases there may be no rotation at all, in which case the method of fitting a golf club using the rotation point would not apply.
- 22 I accept Mr Kostuj's arguments here. The part of the claim is directed to a step in a method of fitting a golf club which can only take place if a rotation point has been identified. This rotation point is then named a 'fulcrum location' within the claim.

### **Pre-swing**

- 23 Much of the discussion between the examiner and the applicant, and at the hearing, related to the definition of the term 'pre-swing' and what movement the skilled reader would consider this term to cover. This is critical in determining the scope of the claims. In particular the examiner has argued that the term pre-swing would cover a practice swing taken by a golfer, ie a full swing of the club or similar motion where no ball was actually hit. The applicant has argued that this is not the case. The description actually contains definitions of the terms 'swing' and 'pre-swing'. These are found on page 1 of the published specification and read:

A swing is any movement begun with a conscious intent to strike a golf ball.

A pre-swing starts with any thought or action to prepare for striking the golf ball and ends with the start of the swing.

- 24 The term 'waggle' is also defined within the specification, and is clearly a part of the pre-swing but this term is not contained within the claims and therefore its definition is not directly relevant to their interpretation.
- 25 At the hearing Mr Kostuj explained at length the difficulties with defining this, and similar, terms in golf. He stated that a pre-swing did not include a practice swing. He said that the skilled reader would know that this action was not within the scope of the term 'pre-swing'. The invention, in his argument, was one for golf-fitting purposes undertaken away from the golf course and that the invention would be complete and the required measurements determined before any swing was taken. I accept that, in practice, the act of fitting a golf club would take place away from a golf course. However, the important factor for determining the scope of the claim is identifying the type of motion to be analysed.

26 However, Mr Kostuj also said that the term pre-swing could cover any type of motion of the golf club and that the 'pre-swing' period could be deemed to start as soon as a swing was completed. He further explained the meaning of the term 'waggle' and, at the hearing, this was closer to the interpretation he was placing on the word 'pre-swing' as used in the claims. He explained that this was not an easily defined term and that he had written lengthy papers on its definition.

27 In his written submissions Mr Kostuj further explains the meaning of the term 'pre-swing'. These submissions state that the pre-swing period ends when a swing starts, which in most cases is the start of the backswing but if there is no backswing the end of the pre-swing is marked by the start of the downswing where there is intent to hit a ball. All movement before this is part of the pre-swing.

28 I agree with Mr Kostuj's view that the correct reading of a patent specification is that which would be taken by the skilled reader. However, the skilled reader of this application would find that they have a definition of the term pre-swing provided and it is this definition that would be applied to the claim. From this definition, supported by Mr Kostuj's written submissions and arguments at the hearing, it is clear that this term encompasses the entire time from the thought to swing the club to the time the club is actually swung with intention to hit a ball. In his written submissions Mr Kostuj states that:

'A pre-swing period can vary significantly in its length of time, from a very short period if for example being on a driving range hitting balls in quick succession at one extreme, to a very long period if on a golf course where one swing is completed and the next swing is not begun until after one walks hundreds of yards to the golf ball at the other extreme (assuming that no practice swing or other subcategory of swing is performed in the interim).'

29 This highlights the difficulty for the skilled reader in determining the scope of the claim. The term 'pre-swing' can encompass any type of movement and, in the current application, is defined purely in terms of the intention of the golfer at the time he makes the movement. The nature of this movement is therefore completely undefined as there is no limit as to what is being done with the club during this time.

30 As such I find that the term 'pre-swing' provides no meaningful limitation to the scope of the claim. The skilled worker would read the claim as analyzing a particular type of movement but would not be able to determine what that movement is; as such the skilled worker would be unable to identify the scope of protection of claim 182, contrary to the requirements of Section 14 of the Act.

### **Novelty of claim 182**

31 The examiner has cited one document, GB 2236682 (MARUMAN) in the pre-hearing report, stating that the lack of clarity around the term 'pre-swing' results in the claims not being adequately distinguished from the prior art.

- 32 MARUMAN describes a swing analyzing device which uses sensors to analyse the movement of golf club during a golfer's swing. Page 8 of the specification describes the use of sensors to locate the position of a rotation centre during the swing.
- 33 I have found that the term 'pre-swing' has no limiting effect on the type of motion being considered. Therefore claim 182 currently defines a method of analyzing movement, using a sensor, of a golf club to determine a rotation location point. All of these features are present in the method described in the cited document. I therefore find that claim 182, as far as it can reasonably be construed, is not novel over the disclosure of MARUMAN.

### **Dependent claims**

- 34 In the pre-hearing report the examiner made a number of objections to several of the dependent claims. As I have found that the application is not in order for grant there is no need for me to consider the dependent claims in detail. I shall briefly discuss some of the major issues raised regarding the dependent claims.
- 35 The examiner has argued that claims 190, 191 and 192 claim golf clubs having the rotation point and rotation force identified in earlier claims. These claims are to standard golf clubs, which have simply been subjected to the method of claims 182, 185 and 186. At the hearing Mr Kostuj argued that the courts would not allow him to enforce a claim to a golf club and therefore there was no legal implication in allowing these claims, which in his view have not been fully discussed during the examination process which has focused on the main independent claims. I cannot accept this viewpoint. The Office cannot grant patents with claims that are known to be invalid on the basis that the court would not allow them to be enforced across their full width. The skilled reader must be able to identify the scope of protection of any claim so that he can judge whether his actions might be infringing. I agree with the examiner on this point. These claims do cover any golf club which has been used in the method of the earlier claims. The golf club itself remains unchanged. Mr Kostuj argued that it is clearly not his intention to claim any golf club. Whilst I accept that this was not his intention the result is claims which are not novel, as they encompass any golf club. These claims cannot be considered valid.
- 36 The examiner has objected to claim 200 which claims 'a computer implemented process to perform or aid in performing the method of claim 182' as being unjustifiably broad. On reading claim 200 it is not clear exactly what it is intended to cover. It includes any computer implemented process which aids in performing the method, it does not have to perform the full method. This could be a process for performing a mathematical calculation, and does not require the presence of the essential features of claim 182. Therefore, I agree with the examiner that this claim is lacking clarity and does not define the scope of protection being sought.

### **Corrections to remove dependent claims**

- 37 In his written submission Mr Kostuj seeks to make 'corrections' to his application, as amendments are no longer possible. This is directed to deleting claims 190-192 if I find that these claim no more than a golf club but that the application is otherwise in order. As I have found that claim 182 is not novel I do not need to decide this point. However, I shall discuss this point briefly.
- 38 It is possible to make corrections to patent applications only if there is an obvious error and it is clear to the skilled reader what was intended in place of that error. Whilst I accept that it was not Mr Kostuj's intention to file claims that are not allowable, it is not clear that there is an error or that what is currently being suggested (ie deletion of certain claims) is what was originally intended. There are many possible alternative claims that could have been intended. It is not clear to the skilled reader what form the claim was intended to take. Therefore Mr Kostuj cannot correct his application to remove claims in an attempt to place the application in order for grant after expiry of the compliance period.

### **Conclusion**

- 39 I find that this application is not in order for grant as the claims do not clearly define the scope of protection sought and lack novelty. I also find that there was no procedural irregularity under rule 107 and refuse to extend the compliance period. I therefore refuse this application.

### **Appeal**

- 40 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