BL O/204/11

10 June 2011

PATENTS ACT 1977

APPLICANT Theresia Marlys Benker

ISSUE Whether patent application GB0822566.6 complies with sections 1(1)(b) and 1(2)(d) of the Patents Act

HEARING OFFICER A Bartlett

DECISION

Introduction

1 PCT application number PCT/GB2007/002486 was filed in the name of Theresia Marlys Benker on 3 July 2007 claiming priority from an earlier GB application 0613303.7 filed 5 July 2006. The International application was published as WO 2008/003955 on 10 January 2008 and entered the national phase in the UK on 11 December 2008 where it was reprinted as GB2451997.

2 Accelerated examination was subsequently requested on 1 June 2010. On failing to reach agreement as to the patentability of the invention claimed, the applicant's attorney Mr Martin White of Patents Designs and Brands Limited requested a hearing to decide the matter. That hearing took place by telephone on 11 April 2011 where Mr White represented the applicant. The examiner, Mr Robert Price, was also in attendance.

The Law

3 Section 1 of the Act sets out a number of requirements that an application must comply with before it can be granted. The relevant parts of that section read 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) The invention is new;

(b) It involves an inventive step

.

(d) the grant of a patent for it is not excluded by subsections (2) and (3) or section 4A below

(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 –

.
.
.
(d) the presentation of information

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 application for a patent relates to that thing as such.

4 Section 3 then goes on to provide some explanation of the inventive step requirement. It states:

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 by virtue only of section 2(2) above (and disregarding section 2(3) above).

The Application

5 The application concerns a measuring container for alcoholic drinks. The container can be a glass for wine, beer or spirits or alternatively a jug or other vessel. As the description explains, conventional vessels and glasses tend to include an indication of volume eg a line on a glass to denote a pint for beer or 175ml for wine. Whilst these are of use in dispensing the correct quantity of liquid, they are of little assistance to a consumer who might be interested in monitoring their alcohol intake – for example to avoid health problems and to ensure they do not exceed the legal limit for driving. Medical guidance on safe levels of alcohol consumption are routinely quoted in terms of units of alcohol but the specification outlines that it is not easy for a consumer to convert the quantity of a drink of a particular strength into units of alcohol. To address this problem the containers of the present invention include an indication of the volume of a particular liquid that would contain a given number of units of alcohol. This indication can take the form of a line or mark on the side of the container such that if the container is filled to that level with a particular drink, the container is holding *x*units of alcohol.

6 The claims I was asked to consider at the hearing were filed on 19 November 2010. They number 25 in total of which claim 1 is the only independent claim. It reads:

1. A measuring container for measuring the alcohol content of a plurality of alcoholic drinks of different strengths; wherein the container indicates the volumes of the alcoholic drinks of different strengths that would contain a given number of units of alcohol.

7 The limitation that the container can be used to indicate the alcohol content for a number of different strength beverages was introduced to overcome an earlier novelty objection raised by the examiner.

Inventive Step

8 The focus of discussion at the hearing was on the inventive step requirement which is where I will begin. I will come back to the issue of excluded matter once I have dealt with inventive step.

9 Whilst he initially expressed some reservations as to the use of a structured approach to deciding whether an invention involves an inventive step, I am grateful for Mr White's acceptance that I am bound to follow the test laid down by the Court of Appeal in *Pozzoli*[1]. That is the test I will apply in deciding this issue.

10 The *Pozzoli* test comprises the following steps:

(1) (a) Identify the notional "person skilled in the art"
(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.

11 During our discussion on the test to be applied and throughout the hearing, Mr White impressed upon me that in assessing inventive step it is incumbent upon me to consider the invention as a whole, that I have to decide what would have been obvious at the priority date of the invention, that I must do so without the benefit of hindsight and that the notional skilled person is a skilled but non-inventive addressee. I am in no doubt that a correct application of the *Pozzoli* test will meet all those concerns.

Applying the *Pozzoli* test

12 The first step requires me to identify the skilled person and the relevant common general knowledge of that person. There was some divergence between the examiner and Mr White on this point. In his final examination report, the examiner characterised the skilled person as being "skilled in weights and measures and especially the measurement of fluid levels". For his part, Mr White proposed a more generalised characterisation - that the skilled

[1] Pozolli SPA vs BDMO SA [2007] EWCA Civ 588

person was someone interested in making containers for liquids. In proposing this he suggested that the examiner's characterisation brought in an element of the invention itself – measurement – to the skilled man. I think Mr White's assessment is a little too general. In my view the skilled person is someone interested in making vessels used for measuring liquids.

13 Moreover the Manual of Patent Practice provides useful guidance as to the qualities that the skilled person possesses drawing together as it does guidance from various court judgments where this has been considered. For example at paragraph 3.20 the Manual makes it clear that the skilled person "is not a highly skilled expert or Nobel prize winner, nor is he some form of lowest common denominator. Instead he is best seen as someone who is good at their job, a fully competent worker". And at paragraph 3.21 the Manual suggests "He should be taken to be a person who has the skill to make routine workshop developments but not to exercise inventive ingenuity or think laterally". I will endeavour to assess the invention through the eyes of a person having those qualities.

14 As for the common general knowledge of that person, Mr White impressed upon me that the skilled person is not aware of everything that has ever been disclosed in his field. In particular he put it to me that the common general knowledge of that person does not extend to the contents of every patent specification that has been published. That is entirely consistent with the advice given in the paragraphs of the Manual of Patent Practice I have referred to above and I agree with him entirely on that point. Whilst in some circumstances a patent document can be used to illustrate what is common general knowledge, the skilled person is not expected to be aware of the contents of every patent document (or other scientific papers) published in their field. The skilled person would though in my view have knowledge of the processes required to make beverage containers and would know that such containers are routinely provided with indicators of the volume of liquid placed in them (for example volume indicators on glasses used in pubs or jugs in kitchens).

15 The second step in the test requires me to identify the inventive concept of the claim in question, in this instance claim 1. At the hearing there was some discussion as to the clarity of the term "units of alcohol" used in the claims. In particular Mr White disputed the objection raised in an initial examination report that the meaning of this term was not clear. For my part I am entirely satisfied that I understand what is meant by that term both from a reading of the description and from its use in everyday language. I note a couple of points in relation to this though. What constitutes a "standard unit of alcohol" varies between countries as acknowledged in the description. In the UK, one unit equates to 8g of ethanol. In contrast in Australia and New Zealand one unit is 10g of ethanol, in the USA it is 14g of ethanol and in Austria it is 20g. I also note that on page 2 of the description a unit is incorrectly defined as being 8g of ethanol per 1000ml.

16 Thus the inventive concept in claim 1 is the provision of a measuring container for measuring the alcohol content of a plurality of alcoholic drinks of different

strengths which includes indicators of the volumes of different strength alcoholic beverages that would contain a given number of units of alcohol.

17 The third step in the test requires me to identify the differences between the matter cited as forming part of the "state of the art" and the inventive concept of the claim. In objecting that the claimed invention is obvious, the examiner has relied upon three pieces of prior art:

i) US2006/0121163 (Holloway)
ii) FR2754340 (Giroux)
iii) BE1007637 (Christiaens)

18 Holloway discloses the provision of markings on a vessel such as a wine glass to indicate the number of "standard drinks" contained in the glass if it is filled to that mark with a particular beverage. From the discussion of what constitutes a "standard drink" in Holloway, it is clear that a "standard drink" is precisely the same thing as the "unit of alcohol" referred to in the present claims. In particular I note that in Holloway a standard drink is said to equate to 10g of alcohol in Europe and Australia, 8g of alcohol in the UK and Ireland and 14g of alcohol in the USA and Canada. Thus the difference between the invention of present claim 1 and the arrangement disclosed in Holloway is that the vessel in present claim 1 provides the alcohol content information for a plurality of drinks of different strengths whereas the Holloway vessel is specific to one particular strength drink.

19 Giroux discloses a container which can be used to indicate the nutritional content of a quantity of food or drink placed in the container. At the hearing Mr White disputed the relevance of this document to the present invention. In particular he argued that the disclosure in Giroux was very general and that I should not give undue weight to the one embodiment in Giroux which mentioned alcohol content as being one of the nutritional elements indicated. In short he suggested that any relevance of Giroux to the present invention only becomes apparent with the benefit of hindsight. I will come back to that point when addressing the final step of the test. But here I am concerned with what is disclosed in Giroux. Giroux is undoubtedly of wider application than simply indicating alcohol content of a drink. Indeed one of the two embodiments disclosed makes no mention of indicating alcohol content. However in its second embodiment, Giroux discloses a cylindrical container provided with a scale that indicates the quantity of calories and alcohol present if the container is filled to various points with various liquids. The scale provides that information for a number of different strength drinks including cognac, whisky, 12%ABV wine and Blonde Beer.

20 Mr White also questioned whether Giroux provides enabling disclosure which is of course required for it to be relevant in an assessment of inventive step. In particular he said that the general reference to "whisky" in Giroud meant that it could not actually be used for specific whiskies which could have widely differing alcoholic strength. Whilst I agree that the Giroud device might be less precise in its indicating alcohol content of a drink of whisky than for the more specific 12% ABV wine that is also included on the scale, I do not consider that amounts to a lack of enabling disclosure.

21 Thus the difference between this disclosure in Giroux and the invention presently claimed is that in Giroux the alcohol content is indicated in grams of alcohol rather than “standard” units of alcohol in present claim 1.

22 Christiaens discloses the provision of a graduated scale on the side of a glass to indicate the alcohol content of the glass if it is filled to various points with a liquid. Moreover, it discloses the provision of several scales to allow the glass to be used for different drinks. In contrast to present claim 1, the alcohol content information is provided in terms of the parts per thousand of alcohol in the drinker’s bloodstream that would result from drinking the contents. Thus the difference between the Christiaens device and that of present claim 1 is the unit in which the alcohol content is expressed.

23 The final step in the test requires me to decide whether, viewed without any knowledge of the alleged invention as claimed, the differences I have identified constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention.

24 In my view the cited prior art provides two equally valid starting points for addressing this question in the present case. This is because the problem the invention presently claimed seeks to overcome can be viewed in two ways. As outlined in the specification, the problem to be overcome is that of providing alcoholic content information to a drinker in a more understandable form. Christiaens is acknowledged by the applicant in the specification as being indicative of the state of the art which the invention is seeking to improve upon. Whilst it was not acknowledged in the specification, I consider that Giroud is also indicative of the state of the art in this respect. Both of these documents disclose providing an indicator on a vessel such that the same vessel can be used to indicate the alcohol content for different strength drinks. When viewed this way, the question becomes is there an inventive step in expressing alcohol content using a different unit?

25 Alternatively, and in light of the amendment to claim 1 that was made to overcome a novelty objection based on Holloway, the problem that present claim 1 seeks to overcome can be viewed as being how to make the vessel applicable to drinks of different strengths. The question then becomes is it obvious to provide more than one scale of the sort disclosed in Holloway on the same vessel?

26 I will address the question from both angles though in the outturn which path is followed does not affect the end result.

27 I think it is entirely reasonable to expect that in seeking a solution to the problem of providing information in a more understandable form than is done in either the Christiaens (the acknowledged prior art) or Giroux devices, the skilled man would become aware of the Holloway document. I have no doubt that its relevance would be immediately apparent to him and he would give it serious consideration. I do not consider that he would need to exercise any degree of invention to replace the units of measure employed in either of those documents with the “standard drink” unit employed in Holloway. In arguing against this, Mr White suggested that if this were an obvious thing to do, why

had no one previously used the familiar “unit of alcohol” measure on a vessel in the way proposed in claim 1. Holloway of course shows that to be a flawed argument – it was indeed known at the priority date of the application to use that particular unit in this way. Thus when viewed in this way I consider that present claim 1 lacks the required inventive step – replacing the unit of alcohol indicated in either Christiaens or Giroux with a different one also known in the field of the invention does not require any degree of invention.

28 Taking the alternative view of the problem to be solved by claim 1, Holloway is the closest piece of prior art and the problem to be solved is the provision of an indicator that enables the vessel to be used for multiple drinks of different strengths. The benefit that that provides is self evident – if glasses can only be used for one strength of drink a pub landlord would need to have a set of glasses for each strength of wine, beer or spirits that (s)he sells. Holloway itself recognises that needing separate glasses for different strength drinks is a problem although it does not propose a solution. In seeking a solution to that problem, I consider it entirely reasonable to expect the skilled person to become aware of the Giroux and Christiaens documents. I do not accept Mr White’s argument that the relevance of Giroud only becomes apparent with the benefit of hindsight. Giroux is not as Mr White tried to argue solely concerned with helping people who want to lose weight. Whilst the embodiment that includes the alcohol content indicator also provides information on calorific content, there is no suggestion that the alcohol information is in any way secondary. That embodiment is entitled “Measure of calories and alcohol in drinks” and the principal applications of the device are stated to include “controlling alcohol consumption in drinks”. Thus the relevance of Giroux, like Christiaens, would in my view be immediately apparent to the skilled person.

29 Mr White also argued that the age of the Giroux and Christiaens documents also count against their relevance in assessing inventive step. Again I do not agree. Whilst age can sometimes count against the relevance of a particular document , Giroux was only published in 1998 and Christiaens in 1995 ie 8 and 11 years respectively before the priority date of the present invention. In a technology such as this I would not expect the skilled man to dismiss the relevance of documents of that age.

30 Mr White also drew my attention at the hearing to a number of shortcomings in Christiaens that he felt counted against its relevance for demonstrating a lack of inventive step. First he said that is does not provide much in the way of detailed disclosure. Second, because of the way alcohol content is expressed in it, the Christiaens device can only provide an approximate indication of the effect on an individual of drinking its contents by virtue of it needing to be calibrated for average body weight and absorption characteristics. Whilst I accept both those propositions, I do not consider them to detract from the relevance of Christiaens here.

31 I consider it entirely reasonable to expect that in seeking to address the issue of providing a vessel that can be used to indicate alcohol content of multiple drinks of different strengths the skilled man would become aware of Giroux and Christiaens, would immediately appreciate their relevance and in light of their teachings would not need to exercise any inventive ingenuity to adapt Holloway

to include indicators for more than one drink. Moreover, Holloway provides the motivation for looking for such a solution in that it acknowledges a shortcoming in the flexibility of the device it discloses. Thus when taking this second view of the problem to be solved, I do not consider the invention defined in claim 1 involves an inventive step.

32 In summary I have found that however the problem is viewed, the invention defined in claim 1 does not involve an inventive step. The remaining claims relate to features such as the alcoholic strength being indicated in whole units, how particular drinks are identified on the containers, the sort of container being used and what it is made of and a kit comprising a number of the containers of claim 1. I can see nothing in any of these claims or indeed in the remainder of the description that could form the basis of a valid claim.

Excluded matter

33 As I indicated above, the examiner has also reported that the invention is excluded as it relates to the presentation of information as such. Having found the claimed invention lacks an inventive step, I do not consider it necessary to decide this point.

Other matters

34 I should also record that during the prosecution of the application the applicant submitted some evidence in the form of letters from various sources expressing an interest in the invention and acknowledging the benefits that it might provide should it be available on the market. Whilst that points strongly towards the usefulness of the invention that is of no particular relevance in determining whether the claimed invention involves an inventive step over the prior art.

Decision

35 I have found that the invention defined in claim 1 does not involve an inventive step. Furthermore I can see nothing in any of the remaining claims or in the description that could form the basis of a valid claim. I therefore refuse the application under section 18(3) as failing to comply with section 1(1)(b).

Appeal

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

A BARTLETT