INTELLECTUAL PROPERTY OFFICE

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1st August 2011

PATENTS ACT 1977

APPLICANT Martin Lister

ISSUE Whether patent application GB0520147.0 complies with sections 1(1)(a) & (b) of the Patents Act

HEARING OFFICER Dr. S. Brown

DECISION

Introduction

1. Patent application GB0520147.0 concerns a device which is a combined spoon, fork, knife & can opener. It was filed on 3rd October 2005 in the name of Martin Lister and was published as GB2430607.

2. During the examination process the examiner objected to novelty on the basis of four citations. The applicant and the examiner were unable to resolve this issue despite several exchanges of correspondence so the case was sent for a hearing on 7th June 2011. Mr. Lister has not responded to various attempts to arrange a date for said hearing so this decision is being made on the papers.

The Application

3. The single claim was filed on 3rd October 2005. It reads:

A device which is a spoon, fork, knife, and can opener.

4. Figure 1 of the application shows this device. The accompanying one page description explains that 1 is the spoon, 2 the fork, 3 the knife, 4 & 5 the can opener.

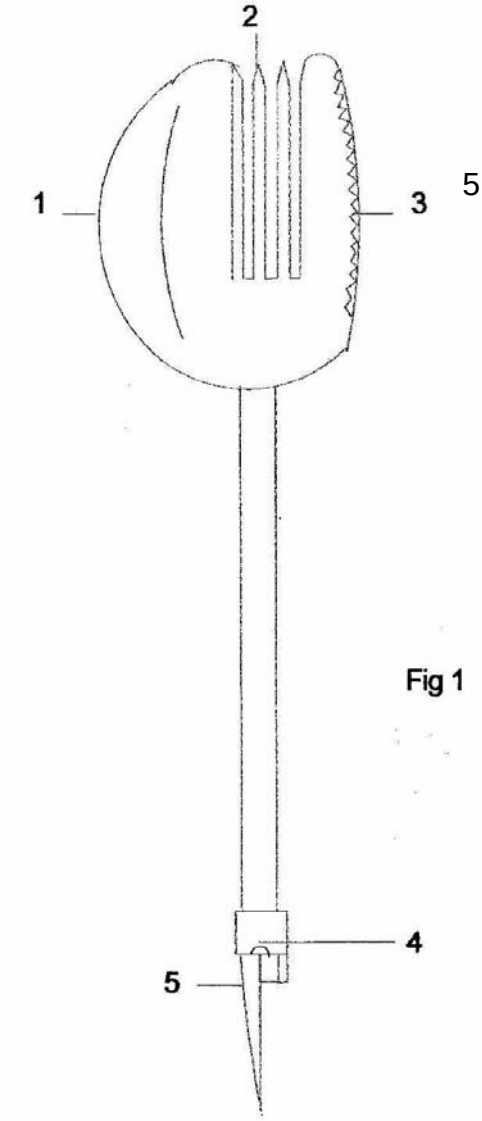


Fig 1

The law and its interpretation

5. 5. Section 1(1) of the Patents Act begins:

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;

Sections 2(1) & 2(2) of the Patents Act read:

An invention shall be taken to be new if it does not form part of the state of the art.

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.

Section 3 of the Act reads:

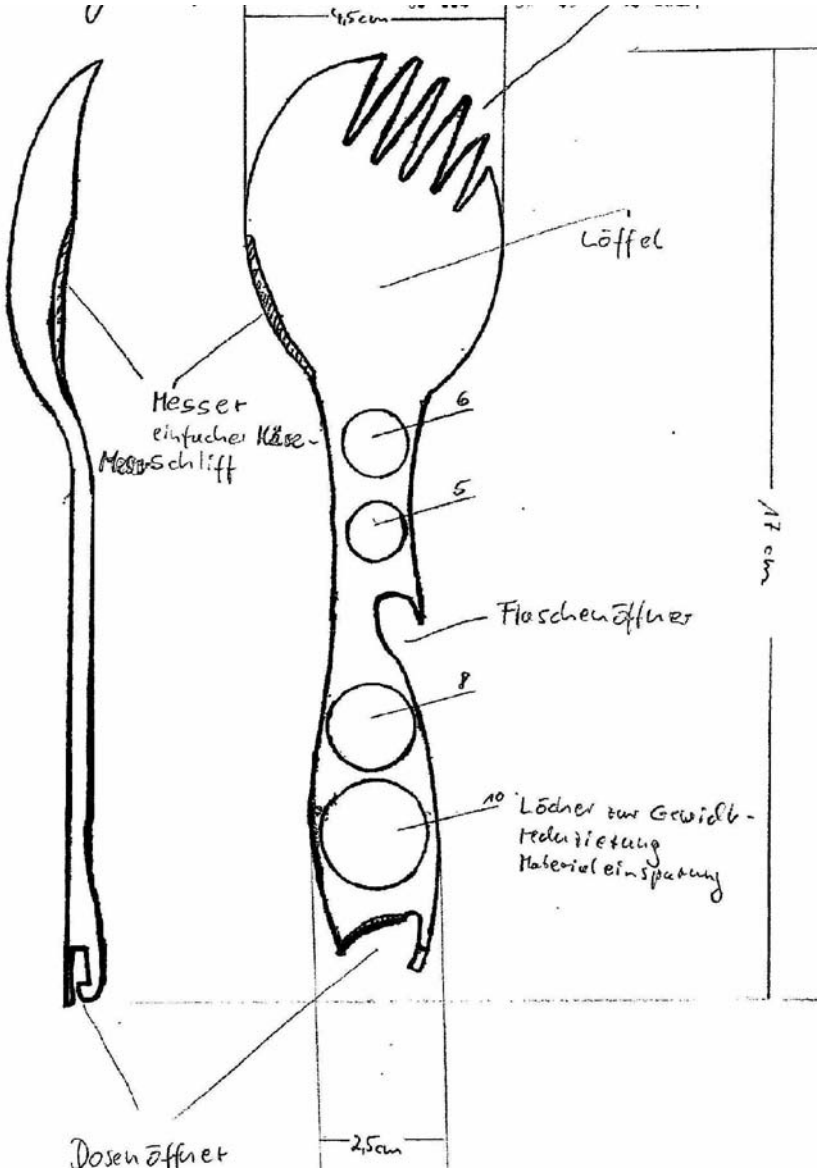
An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

6. The key question is thus were combined spoon, fork, knife, can openers known before the filing date of this application.

Novelty

7. The examiner has identified four pieces of prior art: DE10235746, US849098, US1451542 & FR2760955. All four of these documents were published before the filing date of the current application.

8. DE10235746 is perhaps the most illustrative. Its single figure is reproduced below:



9. This disclosure clearly relates to a single device with a fork, a spoon (Löffel), a knife edge (Messer), and a can-opener (Dosenöffner). All of the features in the claim of the current application are clearly shown in this document.

10. Figure 1 of US849098 likewise shows a single utensil which comprises a fork, a spoon, a knife and can opener. US1451542 and FR2760955 disclose somewhat different devices - what might be called 'Swiss-army' knife/fork/spoon/can-openers. However, they still show all the features of claim 1 of the current application.

11. In his responses to the examiner, Mr. Lister observed that he has never seen 'his' device for sale in shops. However, the Patents Act does not define 'new' in terms of whether or not a device is commercially available. Section 2(2) makes it clear that any earlier disclosure to the public is enough to destroy the novelty of an application. I am content that the four documents identified above each meet this criterion.

Inventive step

12. Mr. Lister also argued that his device is 'different' to those in the citations. For example, he argued that his device would be better at cutting certain foods, such as burgers.

13. As stated above, each of the four documents discloses a device with all of the features of the claim of the current application. That is enough to destroy the novelty of the application in its' current form. Furthermore, I can see nothing anywhere in the current application that is any different except for the exact physical layout of the features shown in figure 1.

14. While this exact layout may make it easier to cut certain foods, the differences, especially when compared to DE10235746, are very minor. Even were they to be included in a claim these differences would not, in my opinion, be enough to provide the inventive step required by section 1(1)(b). The person skilled in the art of utensil design would, I believe, consider the differences between the device of DE10235746 and that of the current application to be obvious.

Added matter

15. To differentiate his device from those in the four documents, Mr. Lister submitted a new figure on 19th October 2010. In a further letter, dated 15th April 2011, he explained that this figure showed that the spoon/fork/knife section of his device could be separated from the can opener section.

16. Now section 76(2) of the Act reads:

    No amendment of an application for a patent shall be allowed under section 15A(6), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

17. I'm afraid that I cannot see any reference to the can opener being removable anywhere in the application as it was first filed. This new material is thus not an allowable amendment of the application.

Decision

18. I have found that the invention defined in the claim is not new. I have read the specification carefully and I can see nothing that could be reasonably expected to form the basis of a valid claim. I therefore refuse this application under section 18(3).

Appeal

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

Dr. S. Brown

Deputy Director acting for the Comptroller