

PATENTS ACT 1977

APPLICANT Nicola Puckey

ISSUE Whether patent application
GB 2444119A should be refused
for lack of inventive step

HEARING OFFICER Stephen Probert

Noël Akers (of N J Akers & Co.) assisted by Christian Ziar & Nathalie John for the applicant

Hearing date: 23rd May 2012

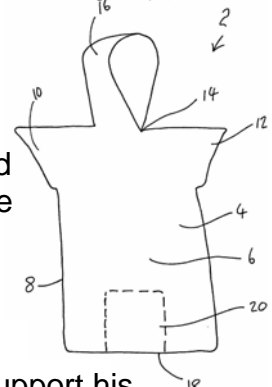
TRANSCRIPT OF ORAL DECISION

1 The invention claimed in this application is a garment with a pocket for storage of the garment. The application was filed on 21st November 2006. The examiner has reported that the invention is obvious in the light of the prior art and common general knowledge.

2 Claim 1 is the only independent claim. It has been amended during the examination process and now reads as follows:—

1. A garment for the torso of a person, the garment comprising a body portion having a front panel, a rear panel and two sleeves, the garment further comprising a lower edge extending around the waist, hips or legs of the person when the garment is being worn; the garment further comprising a pocket in which the garment may be stowed, the pocket being disposed in a portion of the garment adjacent the lower edge of the garment, wherein the pocket comprises an opening extending adjacent the lower edge of the garment.

3 Figure 1 from the application (see right) illustrates the invention well. When I was at school, I had a cagoule (or Pakamac[®]) that was similar to this. It had a central pocket in the front which could be turned inside out to pack it away when I wasn't wearing it. The only significant difference between my cagoule and the garment described and claimed in this application is that the pocket is upside down.



4 The examiner cited four earlier published patent documents to support his objection: three of them disclose garments with pockets that are designed to be turned inside out to stow the garment, and the fourth (US5463783 -"Pope") discloses a combination blanket/garment with an upside down storage pocket adjacent the bottom edge.

- 5 The examiner, during the course of several rounds of correspondence, used the structured *Windsurfing*¹/*Pozzoli*² approach to determine obviousness, and Mr Akers also used it to present his client's case at the hearing.

The Law

- 6 Section 1(1)(b) says that a patent may be granted only for an invention if, among other things, it involves an inventive step. Section 3 then defines what is meant by "inventive step" as follows:

Inventive Step

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).

- 7 The *Windsurfing/Pozzoli* approach involves the following steps:—

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

- 8 The examiner had originally reported that claim 1 lacked novelty in respect of Pope. The application was subsequently amended to overcome this objection by limiting the claims to garments having two sleeves. The garment described in Pope does not have sleeves, as illustrated by figure 4 from Pope below.



- 9 In his final examination report, the examiner formed his objection to lack of inventive step by using the three other documents (each of which discloses garments **with** sleeves) as his starting point. He concluded that the skilled person

¹ *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*, [1985] RPC 59

² *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

would see the advantages of the upside down pocket arrangement of Pope, and would combine this feature with one of the more conventional garments from the other three documents without exercising any inventive thought.

10 At the hearing, Mr Akers argued very persuasively against this objection, and eventually I had to agree that there was no compelling reason for the skilled person to take this step. In effect, it would be like taking a conventional ‘cagoule-style’ garment, and turning the stowage pocket upside down. The skilled person would not be led to do this by reading Pope; therefore it is not obvious from this starting point.

11 I also entirely accept Mr Akers’ submission that a garment of the type described in Pope is not part of the common general knowledge. But it is nonetheless part of the state of the art, and consequently it is a valid starting point when applying the *Windsurfing* test.

Applying the Windsurfing/Pozzoli steps

Step 1(a) The notional “person skilled in the art”

12 I’m taking Mr Akers’ definition of the notional person skilled in the art — ie. a designer or manufacturer of leisure wear.

Step 1(b) The common general knowledge

13 I’m also happy to follow Mr Akers’ assessment of the common general knowledge. As he said, it would include an awareness of all the commonly known arrangements of clothing garments used on the upper torso.

Step 2 Identify the inventive concept

14 Again, I accept Mr Akers’ definition of the inventive concept. It is a garment for the upper torso, with an upside down pocket adjacent the lower edge of the garment.

15 I thought Mr Akers was wise not to rely on the “two sleeves” of claim 1 as being any part of the inventive concept. It seemed to me that the applicant cannot rely on the sleeves as part of the inventive concept, since this would be contrary to the teaching of the application as filed (and thus objectionable as added matter)^{3,4}.

Step 3 Identify the difference(s)

16 I think Pope is the closest prior art, and therefore I have used it as my starting point, rather than the three other documents or the common general knowledge.

17 Looking at the differences between Pope and the inventive concept, I struggled to find any. Pope discloses a garment for the upper torso, with an upside down pocket (adjacent the lower edge of the garment) which can be turned inside out and used to stow the garment. This *is* the inventive concept. It is true that the

³ *Merck’s Application* [2004] FSR 16. See paragraphs 46 - 48.

⁴ It would also be contrary to common sense, as the sleeves clearly have nothing to do with the invention in this case.

garment in Pope is designed in such a way that it can also be used as a groundsheet, but that doesn't detract from the disclosure of a garment. So there is no difference between the state of the art and the inventive concept. This would prevent me from considering step 4 altogether.

- 18 However, step 3 of *Windsurfing* also envisages identifying the difference(s) between the state of the art and the claim as construed. This I can do, and it enables me to consider the all-important step 4. The garments described in Pope do not have sleeves, and claim 1 has been amended to (in effect) disclaim garments that do not have [two] sleeves. So for the purposes of following the *Windsurfing* test, the "difference" is the addition of two sleeves to a garment such as that described in Pope.

Step 4 Is the difference obvious to the person skilled in the art?

- 19 The answer must be 'yes'. There cannot be many things that are more obvious than putting two sleeves on a garment that is intended for the upper torso. Moreover I do not think it would require any inventive skill to modify the particular garment described in Pope to include sleeves. I therefore conclude that the difference between claim 1 and the state of the art (Pope) is a step that would be obvious to the skilled person.
- 20 This is not a lengthy application. I have read it through several times, and I cannot see any amendment that would introduce the necessary inventive step. Consequently I refuse the application under section 18(3) because the invention described and claimed in it does not involve an inventive step as required by section 1(1)(b), and as defined in section 3.

Appeal

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

S PROBERT

Deputy Director acting for the Comptroller