

PATENTS ACT 1977

IN THE MATTER OF
Application No GB 9801077.0
in the name of James Shanley

DECISION

Introduction

1. Patent application number GB 9801077.0, was filed on 16 January 1998 in the name of James Shanley. A search report under section 17 issued on 6 May 1999, and the application was published on 21 July 1999 as GB 2333304A. On 22 October 2001 a first examination report under section 18(3) issued. Correspondence between the examiner and Messrs Brookes Batchellor, patent attorneys representing the inventor Mr Shanley, failed to resolve certain issues under sections 1(2) and 3. In consequence, a hearing was appointed for 16 September 2002. The applicant declined to attend the hearing and it therefore falls to me to decide the issues on the papers.

The application

2. The application relates to demountable partitions for buildings. The claims currently on file read as follows:
 1. A demountable partition for buildings comprising a frame constructed of frame members supporting generally plane panels constructed of panel members, in which two or more panel members are separated by frame members curved in the plane of the panel.
 2. A partition as claimed in claim 1, wherein at least one of said two or more members is made of a material through which light propagates, and at least one is opaque.
 3. A partition as claimed in claim 1 or 2, wherein the curved frame members are arcuate.
 4. A partition as claimed in any preceding claim, wherein frame members are formed with longitudinal grooves, and one frame member is joined to another by straps or brackets extending from a groove in the one frame member to a groove in the other, so maintaining the frame members in alignment.
 5. A partition as claimed in claim 4, wherein frame members are joined by said straps or brackets both at their ends and intermediate their ends.

Section 1(2)

3. The examiner has raised objection that the invention as claimed in claims 1 and 3 is distinguished from the known art by a feature which has an aesthetic rather than a technical function, and is therefore excluded under section 1(2)(b).
4. The applicant's counter-argument, made through his agent Brookes Batchellor, is largely based on the decision by the Technical Board of Appeal of the European Patent Office in *Pension Benefits Systems Partnership* [2001] 10 OJEP 441 (T 931/95). In a letter dated 14 January 2002 the applicant argued:

“There is no requirement in the Act that an invention should have an objective, and the expression of an objective in terms of providing a different appearance does not destroy the industrial nature of the product or the technical terms in which it is expressed. A new process of polishing jewellery would have as an objective improvement in appearance but would not be precluded from patentability because of that. This position is supported by the European Board of Appeal in their decision [in *Pension Benefits*]. The application concerned business methods and it was held there that there is no basis for the so-called contributory approach. Applied to the present case, this would mean that even if the novelty of the claim were, say, an entirely aesthetic feature (which it is not since it is expressed in technical terms) the claim has to be considered as a whole to determine whether or not its subject matter is excluded”.

5. In response the examiner drew the applicant's attention to two decisions in which *Pension Benefits* is discussed, namely *Hutchins' Application* [2002] RPC 8 and *Pintos Global Service Ltd's Application* (SRIS O/171/01). The applicant has made no substantive response to this, other than to state that the reasons for not refusing the application are on the record.
6. The part of section 1(2) relevant to this decision reads:

1(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 -*

- (a) ...
- (b) *a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;*
- (c) *a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;*
- (d) ...

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.

7. The corresponding part of Article 52 EPC has similar provisions, and the applicant has rightly drawn attention attention to section 130(7) in this context. Section 130(7) states that certain provisions of the Act - and these specifically include section 1(2) - are so framed as to have, as nearly as practicable, the same effects as the corresponding provisions of the EPC. Following this, it is accepted practice that, when interpreting those provisions, account should be taken of how corresponding Articles of the EPC have been interpreted by the EPO. Indeed decisions of the Boards of Appeal of the EPO are regarded as persuasive, but it is the case that they are not binding by themselves unless approved and adopted by a court of record. The position is clearly set out in *Gale's Application*, [1991] RPC 305 where in the Court of Appeal, Nicholls LJ said:

" it is of the utmost importance that the interpretation given to section 1 of the Act and the interpretation given to Article 52 of the [EPC] should be the same. When interpreting the Act an English court should have due regard to decisions of the Board of Appeal and take them into account, although the English court is not bound by them."

The Pension Benefits approach

8. In *Pensions Benefits*, in which the case in suit concerns methods and apparatus for administering a pensions system, the Board reached a number of conclusions which appear relevant to the circumstances of the present case. These may be summarised by quoting from the Headnote to the decision:
- I. Having technical character is an implicit requirement of the EPC to be met by an invention in order to be an invention within the meaning of Article 52(1) EPC.
 - II. Methods only involving economic concepts and practices of doing business are not inventions within the meaning of Article 52(1) EPC.
 - III. An apparatus constituting a physical entity or concrete product, suitable for performing or supporting an economic activity, is an invention within the meaning of Article 52(1) EPC.
 - IV. There is no basis in the EPC for distinguishing between "new features" of an invention and features of that invention which are known from the prior art when examining whether the invention concerned may be considered to be an invention within the meaning of Article 52(1) EPC. Thus there is no basis in the EPC for applying this so-called contributory approach for this purpose.
9. In its decision, the Board addressed relevant parts of the *Guidelines for Examination in the EPO* as they stood at the time. The Board agreed with the statement in the

Guidelines that the basic test of whether there is an invention within the meaning of Art. 52(1), is separate and distinct from the questions whether the subject-matter is susceptible of industrial application, is new and involves an inventive step. However the Board found “some contradiction” between this approved approach and the following explanation of the contribution approach in the *Guidelines*:

“the examiner should disregard the form or kind of claim and concentrate on its content in order to identify the real contribution which the subject-matter claimed, considered as a whole, adds to the known art. If this contribution is not of a technical character, there is no invention within the meaning of Art. 52(1).”

In the Board’s view this confuses the requirement of “invention” with the requirements of “novelty” and “inventive step”

10. The Board then went on to consider the question of inventive step. The approach taken by the Board in this case was to use the “contributory approach” to determine the improvement in the claimed subject matter over the closest prior art. Having done that the Board concluded that the improvement “is an essentially economic one”, does not therefore solve any technical problem or make any technical contribution and cannot therefore contribute to inventive step (Article 56 EPC).

The approach laid down by the UK courts

11. As noted above, the applicant’s attention has been drawn to two Patent Office decisions, *Hutchins* and *Pintos*, in which *Pension Benefits* is discussed. Although not binding, they provide a useful guide. In *Hutchins*, in which the application in suit related to a computer system for providing guidance to rescue personnel, it was held that there were a number of decisions of the courts of the United Kingdom which confirmed that the fact that claims were directed to apparatus did not avoid the terms of exclusion of section 1(2), that the question of patentability should be decided as a matter of substance and not by the actual form of the words used in the claim; and that the comptroller was bound to follow the decisions of the UK courts. In *Pintos*, in which the application in suit related to a system for exchanging information (eg between prospective lenders and borrowers), similar conclusions were reached.
12. In *Hutchins* and *Pintos* attention is drawn to a number of well known precedents which positively and clearly affirm the approach taken by the UK courts. I note in particular the view of the Court of Appeal in *Merrill Lynch's Application* [1989] RPC 561, where Fox LJ in considering the interpretation of section 1(2) confirmed the approach taken in *Vicom/Computer-related invention* [1987] 1 OJEPO 14 (T208/84) saying [italics added]:

“..... it seems to me to be clear, for the reasons indicated by Dillon LJ, that it cannot be permissible to patent an item excluded by Section 1(2) under the guise of an article which contains that item - that is to say, in the case of a computer program, the patenting of a conventional computer containing that program. Something further is necessary. The nature of that addition is, I

think, to be found in the *Vicom* case where it is stated: "*Decisive is what technical contribution the invention makes to the known art*". *There must, I think, be some technical advance on the prior art in the form of a new result*"

and more recently, again in the Court of Appeal, in *Fujitsu's Application* [1997] RPC 608, where Aldous LJ followed the decision of the Court of Appeal in *Merrill Lynch* and said [italics added]:

"By that statement [ie as quoted above] Fox LJ was making it clear that it was not sufficient to look at the words of the claimed monopoly. The decision as to what was patentable depended upon substance not form. He also went on to point out the *importance of considering whether the invention made a technical contribution*, despite the fact that neither the statute nor Article 52 of the Convention lays down that the matter, which would result in the invention not relating to the thing as such, must provide a technical contribution. It would therefore seem as a matter of words, if for instance the patent was not confined to a computer program, then it could not be excluded under subsection (2), as to an extent the patent would not relate to the computer program as such. However it is and always has been a principle of patent law that mere discoveries or ideas are not patentable, but those discoveries and ideas which have a technical aspect or make a technical contribution are. *Thus the concept that what is needed to make an excluded thing patentable is a technical contribution is not surprising. That was the basis for the decision of the Board in Vicom. It has been accepted by this Court and the EPO and has been applied since 1987. It is a concept at the heart of patent law.*"

13. Although the decisions discussed above relate to exclusions under section 1(2)(c), it seems to me that the principles as stated by Aldous LJ go more widely than that and I am bound to follow them when considering exclusions under section 1(2)(b). It also seems to me that the argument that these are principles of general applicability has inevitably to be the basis of the applicant's case in citing *Pensions Benefits* in the first place. I conclude therefore that I am bound by the decisions of the UK courts to approach the issue in the present case by assessing whether or not the claimed invention makes a technical contribution. Whether or to what extent this aligns with the approach in *Pensions Benefits* I shall consider below.
14. Before moving on to apply these principles to the circumstances of the present case, it may be helpful to set out how they are interpreted in the Patent Office Manual of Patent Practice. Again, although not binding, this provides a useful guide. Paragraph 1.12 states:

"In general, the question of whether an invention is excluded [by section 1(2)] should be approached by construing the claimed invention as a whole, without regard for its constituent features or integers, and determining whether the whole invention solves a technical problem, or makes a contribution to the art in a non-excluded field, or whether the invention is, in substance, no more than an excluded item or is merely an excluded item in disguise."

The application of this general principle to the specific area of aesthetic creations

excluded by section 1(2)(b) is described in paragraph 1.18:

It is necessary to disregard the form of presentation in the claim and concentrate upon its content in order to identify the novel contribution to the known art and to determine whether the essential character of this contribution is aesthetic or technical . If an article is distinguished from known articles solely by its design, ornamentation or colour, then it will not be patentable if this has a purely aesthetic function, but if the distinction has a practical effect then this could save it from exclusion.

Analysis

15. I now turn to the present case. On page 1 of the application, by way of introduction, the applicant describes what is known and then makes a comparison between this and the invention. The second and third paragraphs of page 1 read:

“Conventional demountable partitions .. are constructed exclusively of rectangular and square panels supported by a frame assembled from straight members.

The invention seeks to provide a different appearance by providing a demountable partition .. for buildings, comprising a frame constructed of frame members supporting generally plane panels constructed of panel members, in which two or more panel members are separated by frame members curved in the plane of the panel.”

16. Thus the contribution of the invention as claimed in claim 1 to the art of demountable partitions, which contribution can be judged on the applicant’s own ground by comparing what he acknowledges as known with what he claims, is to take a frame comprising straight frame members and replace it with a frame which includes some curved frame members; and the reason for this substitution is, he states, in order “to provide a different appearance”.
17. It follows inevitably it seems to me that this contribution is not a technical one. It is manifestly physical in nature, but it is directed solely to altering appearance. It seems to me to offer no more by way of technical contribution than would say a painting or sculpture mounted on a partition, although the means for mounting it might. I conclude that the invention as claimed in claim 1 neither solves a technical problem nor makes a contribution in a non-excluded field; and that on the contrary the contribution is wholly aesthetic and therefore in a field specifically excluded by section 1(2)(b). In the light of this, measured against the principles set out by the UK courts, I find that the invention so claimed is not an invention for the purposes of the Act.
18. Claim 2 introduces the feature that at least one of the panel members “is made of a material through which light propagates, and at least one is opaque”; glass and fibre board are exemplified. It seems to me that claim 2 involves the same contribution as does claim 1, but applied to a narrower range of partitions, that is to say that claim 2 provides additional definition only to what might be described as the pre-characterising

part of the claim. It follows that the invention claimed in claim 2 is also an aesthetic creation and is not in consequence an invention for the purposes of the Act.

19. Turning to claim 3, it seems to me questionable whether this claim introduces any effective limitation to the scope of the invention as claimed in claims 1 or 2 given that arcuate essentially means curved. Whether or not it does provide such a limitation, I find, for similar reasons to those given above in respect of claims 1 and 2, that the invention claimed in claim 3 is also an aesthetic creation and is not in consequence an invention for the purposes of the Act.
20. I see no objection under section 1(2) standing against the remaining claims.
21. For completeness, I return to the applicant's letter of 14 January 2002 where he argues that a new process of polishing jewellery would have improvement in appearance as its objective but would not be refused because of that. I have to say that I find no assistance from this. I agree that a claim to such a process would not be precluded simply on the grounds that the objective was to improve the appearance of something. However this is not a direct parallel with the present case. What would be a parallel is a claim to a jewel characterised by the aesthetics of its appearance; and on the above principles I have no doubt that such a claim would indeed be objectionable.
22. I return now to *Pensions Benefits*, and in particular to the principles summarised in paragraphs I and IV of the Headnote quoted above. Since what is claimed is a partition for buildings, and since this, taken as a whole and without regard to whether or not any technical contribution is involved, manifestly has "technical character", then I conclude that, if I were to follow those principles, I would have to find that what is claimed in claims 1, 2 and 3 is an invention under section 1(2). Since however I am bound by the courts, I find the reverse.

Section 3

23. I turn next to the objection under section 3. The examiner has objected that the subject matter of claims 1, 2 and 3 does not involve an inventive step. The applicant's response to this objection is set out in a letter dated 27 March 2002, and I quote it in full:

"As to what is obvious or not, the Examiner is referred, for example, to *Technograph v Mills and Rockley*, EPO Decision T2/28 [T 2/ 83?], *Oneac v Raychem*, and *American Cyanamid v Ethicon* all of which are reported on pages 88 and 89 of CIPA Guide to the Patents Act, Fifth Edition."
24. Before moving on to the substance of this objection, I should add for completeness that it is at least possible that the applicant may have assumed during the course of prosecution that the section 3 objection was not being pursued, since after the objection was raised, subsequent correspondence between the examiner and agent focussed largely on the section 1(2) issue. With this in mind the examiner has made it clear to the applicant that the issue of inventive step is to be considered in this decision, in particular the objection that claims 1 to 3 lack inventive step in the light of common general knowledge, and has given him the opportunity to make further submissions; an

opportunity which he has not taken up. The applicant has not indicated how he considers the authorities quoted by him relate to the particular circumstances of this case, but I shall consider them to the extent that I can. Nor has he referred to the approach to determining inventive step followed in *Pensions Benefits*, the other authority quoted by him; but I shall return to that below.

25. Turning then to the quoted authorities, the CIPA Guide has a number of sections dealing with various aspects of the approach to determining the issue of inventive step. The decisions in *Technograph v Mills and Rockley* [1969] RPC 395, *EPO Decision T 2/83*, *RIDER/Simethicone tablet* (OJEPO 1984, 265), and *Oneac v Raychem* (BL C/32/98) are cited in a section which deals with what the Guide calls the “would” not “could” test, namely that “it is not sufficient for a finding of obviousness that the person “could” have done what has been claimed; it is necessary to satisfy the court that, on the usual standard of proof in civil cases, he “would” have done so on the balance of probabilities”. The decision in *American Cyanamid v Ethicon* [1975] RPC 513 is quoted in a section dealing with the need to answer the question “If obvious, why was it not done before?”
26. Turning to the circumstances of the present case, I do not think that the applicant is disputing the validity of the contributory approach when examining questions of novelty and inventive step; indeed this forms the basis of the approach followed in *Pensions Benefits*. As noted above, the contribution of the invention as claimed in claim 1 to the art of demountable partitions, judged on the applicant’s own ground by comparing what he acknowledges as known with what he claims, is to take a frame comprising straight frame members and replace it with a frame which includes some curved frame members.
27. I have to say that I regard the use of curved frames in space dividing structures, “ in which two or more panel members are separated by frame members curved in the plane of the panel” to be common general knowledge in the building and civil engineering arts , that is to say that their use is a wholly conventional option available to the skilled man. A number of documents have been cited during the prosecution of this case showing the use of such frames in panels and windows, although not in demountable partitions as such. A stroll around any city centre is likely to reveal other examples. For instance it is not uncommon to find stained glass partitions used as space dividers in public houses, and the use of curved lead elements as frame members in stained glass is centuries old. The application of such widely known options or techniques to known, glazed demountable partitions is difficult to my mind to regard as inventive.
28. Turning to the questions raised in the precedents cited by the applicant, on the “would” or “could” test, it seems to me that there would be nothing to dissuade the skilled man from adopting curved frame members in order to change the appearance of a known partition. On the contrary if a technique is a wholly conventional option, it seems to me inevitable that the opposite would be the case, and that “would” rather than “could” applies. I note that the applicant has provided neither argument nor evidence to support the contrary view.
29. On the “If obvious, why was it not done before?” test, I think the point there is that if a problem has been long standing, it is difficult to argue that its solution by a particular

step is obvious. I do not think that argument applies to the present circumstances however; it does not seem to me that it can legitimately be argued that the invention as claimed in claim 1 is in any way directed to solving a long standing problem. Again, I note that the applicant has provided neither argument nor evidence to support the contrary view.

30. I do not therefore find the quoted precedents to have any relevance of consequence to the present case. On the basis that the contribution of the invention claimed in claim 1 (or in other words the difference between what is acknowledged as known and the alleged invention) is no more than common general knowledge, I conclude that it does not involve an inventive step. I note that this approach to determining inventive step is itself wholly conventional, approved for instance by the Court of Appeal in the well known case *Windsurfing International inc. v Tabur Marine (Great Britain) Ltd*, [1985] RPC 59.
31. I have examined above the contribution made by claims 2 and 3; and on the basis of that analysis I can see no inventive step in either of these claims. I find therefore that the invention as claimed in claims 2 and 3 also does not involve an inventive step.
32. I now return to *Pension Benefits* and the approach to inventive step adopted there. I note that this approach was described as “erroneous” in *Hutchins and Pintos* by reference to *Merrill Lynch*. Notwithstanding that, I think it might be helpful to assess how the *Pension Benefits* approach would apply in the present case. For completeness I note that section 3 is included under section 130(7) as a provision framed to have the same effect as the corresponding provision in the EPC.
33. The first step then is to apply the contributions approach as I have done above, and the result of this is to identify the improvement in claim 1 as the use of some curved frame members. The second step per *Pension Benefits* is to determine whether that improvement solves a technical problem or makes a technical contribution. In *Pension Benefits*, it was held that “the improvement envisaged by the invention .. is an essentially economic one, ie lies in the field of economy, which, therefore, cannot contribute to inventive step”. In the present case I have already addressed that particular question in some detail, and with the conclusion that the improvement does not solve a technical problem or make a technical contribution but is wholly aesthetic. I find therefore on the basis of the *Pension Benefits* approach that claim 1 does not involve an inventive step. I reach the same conclusion in respect of claims 2 and 3 for reasons already given.
34. I see no objection under section 3 standing against the remaining claims on either of the above approaches.

Conclusion and next steps

35. I have found that the invention as claimed in claims 1, 2 and 3 is an aesthetic creation and is not in consequence an invention for the purposes of the Act. However I note that there is considerable technical detail in the specification on which to draw, and the applicant is therefore offered the opportunity to amend the claims in order to introduce

a technical contribution. If no such amendment is made, I shall refuse the application. I have also found that the invention as claimed in claims 1, 2 and 3 does not involve an inventive step. The applicant is therefore offered the opportunity to amend the claims to meet this finding too. If no such amendment is made, again I shall refuse the application. Amendment to any of the claims should of course be accompanied by any necessary consequential amendment to the rest of the claims and to the description.

36. It was indicated in the first examination report under section 18(3) issued on 22 October 2001 that the normal period for putting the application in order would expire in twelve months, ie on 22 October 2002. This is in accordance with the provisions of rule 34(1)(a). However under section 20, this period is automatically extended until the expiry of the appeal period and the applicant has until then (plus any extension granted by the comptroller or the Court) in which to submit amendments with a view to meeting the terms of the decision. If there is an appeal the Court may prescribe a period within which amendments may be made.

Appeal

37. This being a decision other than on a matter of procedure, the period for appeal is six weeks from the date of the decision.

Dated this 16th day of October 2002

DAVID BARFORD

Deputy Director, acting for the Comptroller

THE PATENT OFFICE