



BL O/012/06

16 January 2006

PATENTS ACT 1977

APPLICANT	Andrew Scanlan
ISSUE	Whether patent application number GB0205144.9 complies with section 1(1)(a)
HEARING OFFICER	B Westerman

DECISION

Introduction

- 1 Patent application GB0205144.9 entitled "Carrier Bag Holder" was filed on 5 March 2002 in the name of Andrew Scanlan.
- 2 A request for preliminary examination and search was filed on 16 January 2003, and on 4 June 2003 there issued an Office letter and search report referring to 11 prior documents, with an addition indicating that, in the view of the search examiner, these were examples of a larger number of prior disclosures which might be relevant. On 14 July 2003, an amended claim was filed.
- 3 Following publication of the application, and the filing of a request for substantive examination on 9 March 2004, an office letter dated 26 January 2005 issued accompanied by an examination report, which formally cited 10 documents from the search report. There followed three rounds of correspondence, from which no agreement emerged between the examiner and Mr. Scanlan, and this culminated in the offer of a hearing which was accepted. A hearing was held before me on 21 December 2005, where Mr. Scanlan appeared in person. The examiner, Mr. Leaning, also attended.

The application

- 4 The invention relates to a carrier bag handle. As originally filed, the statement of claim read as follows:

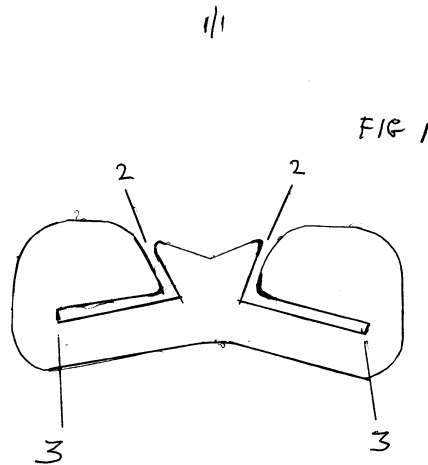
"1. A handle designed to be held comfortably.

2. A handle as claimed in claim 1 with access slots to accomodate carrier bag handles."

5 The single claim before me at the hearing was the amended claim filed in 14 July 2003, which reads as follows:

“1. A handle designed to facilitate the re-use of carrier bags.”

6 The single drawing from the application follows:



Handles from a carrier bag or bags are inserted into slots 2, 3 and the device gripped to carry the bag(s).

The issues

7 The examination correspondence was restricted to the amended claim quoted above. At the hearing, however, there was some reference to the original claims, in the context of explaining what might be different about the invention from the prior art.

8 The examiner's view consistently set forth in the three examination reports was that the amended claim was to advantage rather than being defined in terms of any technical or physical features; the claim did not clearly express how the device facilitates re-use of carrier bags; and that he was unable to see any difference expressed by the claim from the constructions in the documents cited, which he said all seemed to him to facilitate the use of carrier bags be they new or old. He also said that, in his opinion, he felt it highly unlikely that Mr. Scanlan would be able to incorporate a feature or features of a technical nature which would differentiate the device from those already disclosed.

9 Mr. Scanlan, in the correspondence and at the hearing, took issue with some of the detailed wording of the reports from the examiner; submitted that none of the documents cited had any disclosure of the use of the devices described therein for re-use of carrier bags; and also tried to distinguish his claim from the examples of paragraph 11 of "How to Prepare a Patent", which had been drawn to his attention by the examiner in the correspondence in trying to explain what was meant by his reference to a claim to advantage.

- 10 Mr. Scanlan demonstrated an example of his device at the hearing, and used this to try to explain how his device differed from the prior documents. I also pressed him, at the hearing, to try to elucidate what he felt was included and excluded by the form of words currently adopted in the claim. We also tried to explore what constructional features made his device different from those in the documents cited. Mr. Scanlan again relied upon the absence of explicit disclosure in the documents cited as to re-use of bags. He also said that in his opinion the constructions of the prior documents were not as easy as his device to insert the carrier bag handle; did not so securely retain the bag; nor, in his submission, facilitate re-use. He also drew attention to at least one of the documents describing itself as disposable. I have to say however that no definite constructional differences were drawn to my attention.
- 11 As I have said above, Mr. Scanlan made reference, during the hearing, to the comfort feature of the original claim, but seemed to accept that this was not a feasible distinction.
- 12 Also at the hearing Mr. Scanlan explained the need for re-use of carrier bags, stressing the very significant use of resources involved in disposal of bags after a single use. He produced a letter from a trade organization (WRAP) and mentioned some discussion and correspondence that he had had with ASDA confirming this view.

The law

- 13 The examiner's objection has been consistently presented as being fundamentally one of lack of novelty. This is governed by section 1(1)(a), which states:

“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).....”

- 14 In the discussion about this issue, there has been some debate as to whether the claim is clear and precise.

Assessment

- 15 To determine whether the invention is novel under section 1(1)(a), I must first construe the claim, that is, determine what it means. The function of the claim is to define what the patentee desires to protect and to express what others may not do without his permission. The wording contained in the claims is the expression of the area protected. Whilst, in some circumstances, recourse may be had to the description, where the words in the claim have a clear meaning, then the first presumption is that they stand to be construed alone. It is also settled law that, in construing the claim, I must take a purposive view, that is take a reasonable view consistent with what an informed reader would take trying his best to understand the whole specification.

- 16 Taking this into account, it is clear to me that the claim requires a handle which is separate from, but of use with, a carrier bag, and I find no difficulty in understanding this. Additionally, however, it requires that this handle is “designed to facilitate the re-use”. Here I have more difficulty. These words, in my view, should not be read as restricting the protection to some presumption as to what was in the mind of the deviser when designing the device. In my judgment, it must carry the meaning that the handle is suitable for the purpose of “re-using” carrier bags. In this context, having read the whole specification and considered all of the submissions made in the correspondence and at the hearing, I am at a loss to see what distinguishes “re-use” from “use”.
- 17 I therefore find that the protection claimed boils down to “A handle suitable for use with a carrier bag”, where it is implicit that the handle is not the integral handle found in all carrier bags.
- 18 There was some discussion at the hearing about the guidance of paragraph 11 of “How to apply for a patent”, which explains that the Patent Office will not accept claims to advantage, and includes a list of examples. Mr. Scanlan took exception to his claim being put in the same category as what he described as these “nonsense examples”. Whilst I agree with him that these are deliberately extremes, I have to say that I can see no order of magnitude difference in principle between the example which says “My box trailer is cheaper and more easily convertible than any other box trailer” and Mr. Scanlan’s claim, as he explained it at the hearing. The reason for this exclusion is because of the difficulty of determining the scope of the protection, which I have dealt with this above, and to emphasise that the claims need to be directed to technical features of the invention.
- 19 The documents cited in the examination correspondence are as follows:
- | | | |
|-----------------|---------------|-----|
| GB 2341085 A | (SHAW) | D1 |
| GB 2321182 A | (NEALE) | D2 |
| GB 2293309 A | (DEVLIN) | D3 |
| GB 2281691 A | (NATHAN) | D4 |
| GB2274579 A | (IXL LIMITED) | D5 |
| EP 1000564 A1 | (DUFOUR) | D6 |
| WO 91/11368 A1 | (STOFT et al) | D7 |
| US 5368393 | (NORMANN) | D8 |
| BE 1004331 A3 | (LEFLOT) | D9 |
| JP 2000109100 A | (REKKU KK) | D10 |

- 20 Having carefully considered the content of these documents, I find that they all disclose separate handles to which the usual handles of a carrier bag or bags can be attached. All of them have slots or other formations into which the loop handles of carrier bags are, in use, inserted and the devices are intended to assist in carrying the bag(s). In my judgment, therefore these documents demonstrate that devices falling within the scope of the claim that I have determined above are known, and that therefore the claim does not meet the requirement of section 1(1)(a).
- 21 Turning now to the further submissions as to differences from these documents made by Mr. Scanlan, I must first say that I do not consider that the distinctions mentioned are in fact expressed by the wording of the claim, as I have construed it above. However, a consideration of these submissions might assist in determining whether there is any possibility of amendment to meet the finding of lack of novelty.
- 22 Mr. Scanlan drew attention to the clear desire to recycle and save consumables by reference to the correspondence with ASDA and WRAP. Whilst I have personal sympathy with this aim, I do not feel that this helps take his application further. All of the documents cited seem to me to be capable of furthering this aim, and the desire does not help to define his invention.
- 23 With regard to Mr. Scanlan's submission that the documents do not explicitly mention the possibility of re-use of carrier bags, I draw attention to column 3 lines 2 to 5 of document D8, which does in fact explicitly refer to the device encouraging re-use of bags. Having carefully considered the others, whilst they do not explicitly mention re-use, I can see no constructional reason which would preclude re-use of carrier bags by the devices, or why the reader would be led to believe that they could not be used to re-use carrier bags.
- 24 I also agree that at least document D10 describes the device of that document as disposable. Mr. Scanlan submitted that this should exclude this document from consideration, but I can see no constructional or other reason on the face of this document why the fact that it can be disposed of would preclude it from being re-used, although, being made of paper board, I can see that the number of times of re-use may in practice be limited. All of the other devices are variously made of wood, metal or plastics, and thus more clearly repeatedly usable.
- 25 Mr. Scanlan also submitted that the construction of his device was, on the one hand, easier for the user to insert the carrier bag handle, and on the other, more reliable in retaining this handle when so inserted. He was unable to explain to me why this is so, and what makes his handle different in this way. I also note that most of the documents cited seem at least implicitly to include these advantages.
- 26 As for the ease of inserting the handle, the cited documents show a range of options of slots into which the bag can be inserted, and I can see no clear reason why they should not be as easily used as Mr. Scanlan's device. As one specific example, referring to page 4 of D7, the construction is said to "allow a shopping bag to be easily inserted".

- 27 As to the reliability of retention aspect, D3 refers to the carrier as being “less prone to being dislodged” in the last paragraph of page 3; D5 says the bags are “securely retained” (page 1 lines 27 – 30); D7 refers to “allows the bags not to be dislodged” (page 4) and the carrier being “locked in place until such time as they are deliberately removed” (page 4); D8 says the bags “cannot be easily dislodged” (column 6 lines 3 – 16).
- 28 In view of the reference to the feature of the original claim at the hearing, I feel that I should also consider this, even though it was not put forward as a definite proposal for amendment. I have difficulty in determining the scope of the protection of the original claim 1 – comfort being a subjective, individual judgment. However, having carefully considered the documents cited in this case, almost all of them refer explicitly to avoiding carrier bag handles cutting into the user’s hands, or as being more comfortable. Thus, I consider that, even though this is not a clear and precise claim, it is clearly disclosed in the prior documents. It also is clear to me that all of the documents cited disclose handles with slots into which carrier bag handles can be inserted, so the constructional features added by claim 2 can not distinguish.
- 29 Taking all of this into consideration, I can see nothing in the specification which could distinguish Mr. Scanlan’s invention to meet the requirements of section 1(1)(a).

Summary

- 30 I refuse the application as not meeting the requirements of section 1(1)(a), for the reasons given above. As I can perceive of no possible amendment based on the disclosure of the application as filed to which this finding would not apply, I do not allow any further opportunity to amend.

Appeal

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

B WESTERMAN

Deputy Director acting for the Comptroller