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For Creativity and Innovation

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31st December 2007

PATENTS ACT 1977

APPLICANT Hideaki Koiwai

ISSUE Whether patent application number GB0512872.3 complies with sections 1(1), 1(2) and 76.

HEARING OFFICER P Marchant

DECISION

Introduction

1 Patent application number GB0512872.3 relates to an improved golf putter. As well as its normal function of putting the ball, it has a measurement scale and sighting means so that a golfer can use it to estimate the distance to the hole. The examiner issued a number of reports, the first dated 12 December 2005 raising issues of novelty, inventive step and excluded matter. After amendments had been filed, the question of added subject matter also arose. Exchanges of correspondence with the patent attorney and further reports culminating in the most recent attorney's letter of 13 July 2007.

2 The examiner and the applicant were unable to reach agreement on these matters and the case came before me for a hearing on 22 November 2007 at which the applicant was represented by Mr Tom Hutchinson and Mr Nicholas Manly of W P Thompson & Co.

Added subject matter

3 Mr Hutchinson initially addressed the added subject matter question. Section 76 of the Patents Act provides among other things that:

> *"No amendment of an application for a patent shall be allowed under section 17(3), 18(3) or 19(1) if it results in the application disclosing matter*

extending beyond that disclosed in the specification as filed."

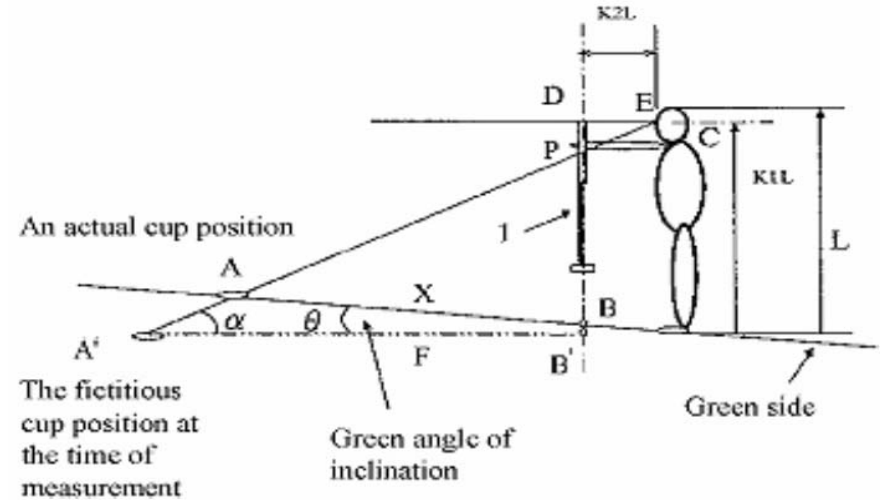
4 In order to asses whether a later, amended version of a specification involves added subject matter, it is necessary to compare the disclosure of the later version with that of the original. Mr Hutchinson referred to the cases of *Bonzel (T.) and Anr v Intervention Limited and Anr* [1991] RPC 553 and *A C Edwards Ltd v Acme Signs & Displays Ltd* [1990] RPC 621 which considered the added subject matter issue. In the *Bonzel* case, Aldous J set out his approach to the question as follows:

> *"The decision as to whether there was extension of disclosure must be made on a comparison of the two documents read through the eyes of a skilled addressee. The task of the court is threefold:*
> *(1) To ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly in the application.*
> *(2) To do the same in respect of the patent as granted.*
> *(3) To compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition. The comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly."*

5 The *A C Edwards* judgment confirmed a point relevant to the present case, that the claims, although primarily intended to set out the scope of the monopoly, are also valid as a source of disclosure in the same way as the body of the specification.

6 The present invention can be described as follows with reference to figure 1:

Fig. 1

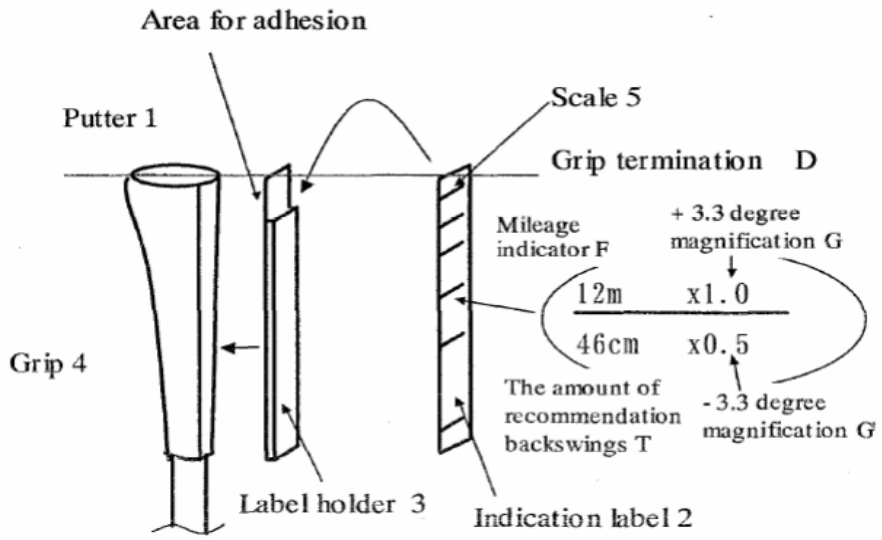


Assuming for the moment that the green on which the putt is being prepared is level (ie as shown by the line A'B'), the player holds the putter at arms length so that it is vertically above the ball B'. He positions the end of the grip D so that it is at the same height as his eye E. He then sights the hole (which is also referred

to as the “cup”) A’ against the grip and finds the point P on the grip which is in line with it. Since triangle EDP is similar (in the geometrical sense) to triangle A’B’P, and knowing DE, DP and PB’, it is possible to work out the distance A’B’. Those calculations are done in advance for a number of different positions P, and a scale is provided on the grip labelling each point P with the corresponding distance to the hole. The scale can be calibrated for players of different heights, and can give a “recommended amount of backswing” as well as or instead of the distance to the hole. A correction can be made for the slope of the green, and the putter can also contain a sensor for measuring the slope.

7 Looking in more detail at the grip and the scale, figure 6 shows the scale of distance and backswing (the specification’s use of “mileage” for “distance” arises from the translation from Japanese) together with correction for the slope of the green surface.

Fig. 6



8 The scale starts from a datum position which is aligned with the end of the grip. And it is the case that the whole of the description places the scale with its datum position at the end of the grip. This is clear from the figures above and from the corresponding text. It is also clear from figure 5 which shows a view of the scale with the zero point labelled “grip termination position”. There is no disclosure anywhere in the descriptive part of the specification which discloses a datum for the scale as being anything other than the end of the grip.

9 The original claim 1 however reads as follows:

> *“The putter with a distance measurement function characterized by to determine a distance to a cup geometrically from a grip part intersected by the line of sight, forming a scale on said grip with some intervals from a basis of grip end or a penetration hole, suspending said putter above the ball on the green to align said scale basis with the height of eyes while*

stretching the arm and backbone, and looking at said cup beyond said grip."

Mr Hutchinson explained, and I accept, that the "basis" referred to in the claim means the datum from which the scale runs. The claim discloses something not disclosed elsewhere in the specification, namely that the basis of the scale can run from a "penetration hole" instead of from the end of the grip. There is no further explanation or mention of a penetration hole anywhere in the description or in the other claims.

10 Claim 1 has been amended during prosecution and is currently in the following form, which has a lot more to say about the penetration hole:

> *"A putter comprising:*
> *a shaft having a longitudinal axis;*
> *a head located at one end of the shaft;*
> *a grip disposed on the opposite end of the shaft; and*
> *a scale secured to the grip, the scale having a through hole whose longitudinal axis is oriented at right angles to the longitudinal axis of the shaft, the through hole being used for horizontally aligning an end of the scale with the eye of a user holding the putter in a measuring position in which the shaft is held vertically by the user with a horizontal arm, directly above a ball to be putted, and wherein the distance to a cup on a putting green corresponds to the position on the scale where the line of sight from the user's eye to the cup intersects the scale when the putter is held in the measuring position."*

11 The examiner had objected that the details of the configuration and use of the penetration hole now set out in the claim amount to added subject matter. Mr Hutchinson argued that the skilled person would necessarily infer these features from the description. In his view it was clear that in a putter having a penetration hole as the datum, the user must sight through the hole, and in order to do so, the hole must be aligned horizontally with the user's eye, in the same way as the end of the grip, where that is used, is aligned with the eye. It follows in his view that the hole must be suitable for making a horizontal alignment with the eye, and to do that it must be of narrow bore. Mr Hutchinson had fabricated such a putter himself and explained that even a 6mm diameter hole was insufficiently precise and it was only with a much smaller diameter hole that one could reliably achieve a horizontal alignment. Clearly, in this arrangement, it is possible to describe the hole as having a longitudinal axis, and the hole would have to be at right angles to the axis of the shaft when the shaft is hanging vertically, in order to be used to align the hole horizontally with the eye in the way Mr Hutchinson describes. Mr Hutchinson considered that the skilled person would inevitably arrive at this arrangement from the directions in the specification and that the features now set out in the claim did not amount to added subject matter but were implicit in the disclosure.

12 I do not agree. The original claim 1 says only that the basis of the scale may be a penetration hole and that the scale basis is to be aligned with the height of the eyes. Mr Hutchinson has lighted on one particular configuration, but that is not the only one that is possible. I do not even think it is the most plausible. I would

consider it more natural given that the entire description is in terms of sighting over the end of the grip, for the skilled person to suppose that the penetration hole was provided with a large flat internal surface similar to the flat surface on the end of the grip shown in the embodiments. The user would sight over this surface in the same way as he has been taught by the specification to sight over the end of the grip.

13 However, that arrangement as with Mr Hutchinson's is just one possibility. The fact is that the specification contains no detail whatsoever about the nature of the hole. Consequently any configuration that the skilled reader might care to imagine which allows the hole to be used for horizontal alignment will be consistent with the disclosure and will satisfy the claim. It follows that there can be no implicit disclosure by the specification of any particular form or mode of use for the penetration hole. I therefore consider that the features introduced into the present claim 1 which specify details of the configuration of the hole amount to added subject matter contrary to section 76 of the Act.

14 I find in particular that there is no basis in the original disclosure for the features that the scale has a through hole, that the hole has a longitudinal axis or that the longitudinal axis of the through hole is oriented at right angles to the longitudinal axis of the shaft of the putter. Regarding the scale having a through hole, the original disclosure recites "*forming a scale on said grip with some intervals from a basis of grip end or a penetration hole"*. This discloses a scale formed on the grip, and the scale having intervals which start from either the grip end or from a penetration hole, but it does not disclose the scale itself having a through hole. The scale and the penetration hole are separate features of the putter. The hole may be in the scale or it may not be. The feature in claim 1 of "the scale having a through hole" consequently amounts to added subject matter.

15 In relation to the feature that the hole has a longitudinal axis, this requires by implication that the hole be to some degree long, thin and regular, whereas there is no basis for such a presumption in the original disclosure. It is apparent from the discussion above that the hole can have any geometry which allows the user to find a horizontal alignment with his eye. That will include large and irregularly formed holes which cannot be said to have any sort of axis.

16 Finally, in relation to the feature that the longitudinal axis of the hole is oriented at right angles to the longitudinal axis of the shaft, since as I have already found, it is not possible without adding subject matter to specify that the hole has a particular geometry, it follows that it is not permissible to specify any orientation of the hole relative to the shaft.

17 I have considered whether the term "penetration hole" even requires there to be a through hole, since a hole can penetrate an object without passing all the way through it. With a hole of that sort alignment might be made simply using the exposed end of the hole as a marker for example. However I have come to the conclusion that the skilled addressee would take "penetration hole" to mean a hole that penetrates all the way through. I consequently accept that the substitution of "through hole" for "penetration hole" does not add new subject matter.

18 I made my finding on added subject matter at the hearing. I gave Mr Hutchinson the opportunity at this point to adjourn the hearing in order to lodge an appeal against it. He did not wish to do so, but the opportunity to appeal remains, and indeed the time to do so runs from the date of the present written decision, not the date of the hearing, in accordance with paragraph 17.4 of the practice direction to Part 52 of the Civil Procedure Rules, since although I gave outline reasons for my finding at the hearing, this written decision explains them fully.

19 As a result of my finding, Mr Hutchinson formulated a revised form of claim, and I accepted it at the hearing as permissible from the point of view of added subject matter. It consists of the existing claim 1 with certain parts (indicated below in strikeout) deleted. It reads as follows:

> *"A putter comprising:*
> *a shaft having a longitudinal axis;*
> *a head located at one end of the shaft;*
> *a grip disposed on the opposite end of the shaft; and*
> *a scale secured to the grip, ~~the scale having~~ a through hole ~~whose longitudinal axis is oriented at right angles to the longitudinal axis of the shaft, the through hole being~~ used for horizontally aligning an end of the scale with the eye of a user holding the putter in a measuring position in which the shaft is held vertically by the user with a horizontal arm, directly above a ball to be putted, and wherein the distance to a cup on a putting green corresponds to the position on the scale where the line of sight from the user's eye to the cup intersects the scale when the putter is held in the measuring position."*

20 Having established the appropriate form of the claim in relation to added subject matter I will go on to consider Mr Hutchinson's representations on novelty, inventive step and excluded matter. This does not dispose of the added subject matter issue entirely since as it currently stands, the specification contains a consistory clause corresponding to claim 1 before amendment. I indicated at the hearing that if I found the application otherwise in compliance with the Act, or that it could be brought into compliance by amendment, that I would refer it back to the examiner and in that event the remainder of the added subject matter should be removed.

Construction

21 Guidance on claim construction was provided by Hoffmann LJ in *Kirin Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46. The key point made in that judgment was that the approach in construing a claim should be to establish "what a person skilled in the art would have thought the patentee was using the language of the claim to mean." I shall follow that guidance here. The claim as it now stands consists partly of the physical features of the putter and partly of directions for the use of the putter to find the distance to the cup. I asked Mr Hutchinson what limitation in his view the features relating to directions for use of the club placed on the claim. He replied that the putter must be configured such that it is suitable for performing each of the directions relating to the specified

use. I agree with that interpretation and shall apply it in determining the scope of the claim and its relationship with the prior art.

Novelty and inventive Step

22 Section 2 of the Act provides that an invention shall be taken to be new if it does not form part of the state of the art, that is, anything made available to the public before the priority date of the invention. The speech of Sachs LJ in *The General Tire and Rubber Company v The Firestone Tyre and Rubber Company Ltd* [1972] RPC 457 at pages 485-6 is often cited to explain what is meant by anticipation:

> *"If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated."*

The disclosure:

> *"must contain clear and unmistakable directions to do what the patentee claims to have invented"*

And the prior inventor:

> *"must be clearly shown to have planted his flag at the precise destination before the patentee".*

23 Section 3 of the Act provides that 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 forming part of the state of the art. In assessing inventive step, the well-established approach is set out in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59. It involves identifying the claimed inventive concept and establishing the common general knowledge known to a skilled but unimaginative addressee in the art at the priority date. The third step is to identify the differences, if any, between the matters cited as being "known or used" and the alleged invention. One must finally assess "whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention".

24 In *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588, Jacob LJ preferred that the identity of the skilled addressee and his common general knowledge be established as the first step, so that the inventive concept can be identified though the skilled addressee's eyes. This also needs to be borne in mind in making the assessment.

25 The prior art cited and currently maintained by the examiner in relation to novelty and inventive step comprises patent specifications JP03242161, US5415408, US5957782 and US6155930. Taking into account the considerations relating to anticipation noted above, I indicated at the hearing that I did not consider any of

the prior art impugned the novelty of the invention and Mr Hutchinson accordingly addressed me on inventive step.

26 No representations were made at the hearing as to the identity of the skilled person or, generally speaking, the common general knowledge. The skilled person would in my view be someone involved in, or knowledgeable about the construction of golf clubs which incorporate features so that they can be used as sighting or measuring devices to help set up golf strokes. Without expert witness evidence it is problematic to assess the common general knowledge known to the skilled addressee but I have made what assessment I can in relation to the prior art below. I consider the inventive concept to be a golf putter having a scale secured to the grip, and a through hole which can be used (in any suitable way) to align the end of the scale horizontally with the eye of the user when the club is held vertically by the user at arm's length. The scale must be such that when the putter is held in the measuring position, points on the scale intersected by the user's line of sight when it is directed towards the cup indicate distances to the cup.

JP03242161

27 JP03242161 describes a golf club for measuring the distance to the pin. Only an English abstract and the figure were available to me for consideration so the discussion below reflects that disclosure. In this prior arrangement the player holds out the club at a "prescribed distance in front of the eyes", lines up a reference position on the grip with the top of the pin and then sights the cup against a scale marked on the shaft. This operates in the same way as the present invention except that the user aligns with the top of the pin instead of with a horizontal datum (as a result of which the scale will be somewhat different) and uses the zero graduation on the scale instead of a through hole to make the alignment. The prior art does not specify that the club should be held over the ball and does not specify a putter as such. Although there are those differences, both arrangements make use of the club being held out in front of the player at a particular distance to establish a known measurement; both use alignment of the zero of the measurement scale to provide a datum, both involve the intersection made by the line of sight to the cup with the shaft of the club to make the measurement and both use a scale on the shaft or grip to show pre-calculated distances at intersection points.

28 Considering how the invention specified in claim 1 differs from this prior art in terms of the third *Windsurfer* step; first of all, it requires a through hole suitable for horizontal alignment of the end of the scale. Secondly, the scale in the prior art embodiments will be different from the scale in embodiments of the present invention, in the sense that they will show differing distances to the hole at equivalent positions of the scale relative to its zero point. This does not to my mind amount to a material difference from the prior art scale however: the claim requires that when "*the shaft is held vertically by the user with a horizontal arm, directly above a ball to be putted" … "the distance to a cup on a putting green corresponds to the position on the scale where the line of sight from the user's eye to the cup intersects the scale when the putter is held in the measuring*

position." The prior arrangement fulfils that requirement. The calibration of the present scale will itself vary from one situation to another; for example it will be different for different height players and can involve corrections for slope of the green as is explained in the specification. Consequently, the claim does not require the scale to have any particular calibration but rather requires it to comply with the principle that distances to the cup correspond with intersection points of the line of sight to the cup with the shaft of the club, and that is true of the prior arrangement. This feature, as a result, does not contribute to any inventive difference between the prior art and the claimed invention. Thirdly, the present claim requires the putter to be held over the ball, but there is no reference to any particular positioning of the club in relation to the ball in the prior disclosure. This feature imposes a limitation on the scope of the claim only in that it will govern the calibration of the scale to some degree. Since I do not find the calibration of the scale to be a material difference between the prior art and the invention, no further difference relevant to the inventive step arises from this feature. The final difference is that the prior art refers to a "golf club" whereas the present invention requires a "putter".

29 Summing this up, the difference between the prior art and the invention is that the invention has a through hole suitable for aligning the end of the scale horizontally and that it is applied specifically to a putter rather than any other golf club. Would the skilled person in possession of the common general knowledge require inventive ingenuity to arrive at the present invention starting from the prior art? That would require only the addition of a through hole instead of or as well as the zero point of the scale, plus application of the idea specifically to a putter. In view of my finding on added subject matter and construction above, the through hole can be of any suitable form to allow horizontal alignment so there is very little constraint on its configuration. The use of holes in golf clubs for sighting to line up a shot is fairly commonplace, as is demonstrated by the prior US patents discussed below. It may be common general knowledge in the art but if it is not, I would expect the skilled addressee to be aware of the teaching of the US specifications or equivalent disclosures. These are in precisely the same area of technology and their disclosures relate in an entirely equivalent way to golf clubs with holes for sighting so as to set up shots, so there can be no suggestion that the skilled person would not appreciate their relevance. Replacement of the zero point of the scale with a through hole consequently seems to me simply to substitute one known sighting arrangement with a different equally well known arrangement having the same purpose and effect. No doubt there are pros and cons to the two constructions, for example a through hole may be easier to line up, but may require an extra manufacturing step, but these are just the variations that are to be expected in any choice of technical features. It is my view that it would be obvious for the skilled person to make that substitution.

30 I do not consider that applying the measurement principle to a putter rather than to an unspecified golf club requires any inventive ingenuity. There is nothing special about a putter that would preclude its use in this way. Indeed for the arrangement to work the player must be in clear sight of the pin which implies use of either a putter or a short iron. It is therefore obvious in my view to specify that the prior arrangement be applied to a putter. I note that there is no synergistic connection between the use of a through hole on the one hand and the

application of the measurement system to a putter on the other, such that the inventor would have to appreciate anything further in making these two developments together.

31 I consequently find that claim 1 lacks inventive step contrary to section 1(1)(b) of the Act in the light of prior publication JP03242161.

US5415408

32 US5415408 discloses a putter having an elongated slot running along part of the length of the shaft and an aperture through the shaft above the slot. The user sights the ball through the slot and then sights a target position on the green through the aperture. It is said that by aiming the ball at the target area, the player is better able to compensate for slope and undulations in the green. It is explained, at lines 14 to 24 column 4, that the slot and aperture may be provided with markings, such as a line in the plane of the vertical axis and cross hairs. Although it does not say so, these are presumably to assist with sighting. The aperture is suitable for making a horizontal alignment of the club with the eye, but there is no scale which could then be used to measure distance to the hole. Applying the *Windsurfing* test, it is necessary to inquire whether the skilled person with the appropriate common general knowledge in the art would develop the present invention from the starting point of this prior disclosure. To do so it would be necessary for him first to appreciate that a putter with a through hole could be used in a different way to that described in order to measure the distance to the hole, rather than provide assistance reading the lie of the green, and then to modify the putter to provide a measurement scale in accordance with the trigonometrical calculation underlying the present invention. I do not think the skilled person could do so without using inventive ingenuity and I consequently find that this prior publication does not demonstrate lack of inventive step in the present invention.

US5957782

33 US5957782 discloses a putter with a sighting hole through the grip. The hole is oriented so that it is perpendicular to the face of the club. By sighting the flag or cup through the hole, the user can line up the face of the putter so that it is oriented precisely towards the cup. The specification describes different arrangements in which sighting holes can be used to make distance measurements. As shown in figures 3 to 7 the hole is “aligned to form a 9.5 degree angle with the horizontal datum” when the putter is held vertically. This provides a rather crude measurement of distance, since with the putter vertical and resting on the ground, and the sighting hole therefore at a known height, if the user can see the cup through the sighting hole he knows that he is 17.2 feet away from it. If he can see the shaft of the pin hole he is closer than 17.2 feet and if he can only see the green in front of the cup, he is further away. The specification explains that an angle of less than 9.5 degrees can be used to indicate a longer distance in the same way.

34 The figure 8 embodiment describes a sighting hole formed as a pivotable tube. Its angle can be adjusted to view the cup at different distances, and a scale of angles or distances is marked alongside it, the latter showing distances to the hole for each position of the tube. It is clear that this arrangement provides a trigonometrical method of finding the distance to the cup. The through hole is capable of being used to find a horizontal datum and in accordance with my discussion on construction above, I therefore consider that the pivotable through hole in '782 fulfils the requirement for a through hole in the claim. The prior specification does not however disclose a scale configured such that a point on the scale intersected by the user's line of sight when it is directed towards the cup indicates the distance to the cup. Would it be obvious to modify '782 to provide such a scale? As it stands, this disclosure uses the angle of the sighting tube and its height above the ground to calculate the distance to the hole. Although the sighting hole would be suitable for fixing a horizontal datum, that is not what is described. The skilled person presented with the disclosure of '782 would have to arrive at the idea that the club could be used to measure the distance to the hole in a different way than that disclosed, namely by holding it at arm's length and at eye level, and by sighting past the shaft to the hole. Having come up with that idea, the benefit of marking a suitable scale on the grip or shaft would arise automatically. However I do not consider that the skilled person could arrive at the idea of using the club in this way from the disclosure in '782 without making an invention. The fact that the scale marked on the prior art putter is different from that used in the present invention reflects the differences in the way they are used to make measurements. Consequently, I do not think that '782 shows the present invention to lack an inventive step.

US6155930

35 US6155930 is by the same patentee as '782 and has a similar disclosure. It describes only the fixed 9.5 degree sighting tube, not a pivotable tube. The one additional feature relevant to the present case is that as well as viewing through the tube along a "line of sight collinear with the longitudinal axis of the sighting tube" – in which case the distance to the hole is 17.2 feet as before, the player may instead sight at an angle through the tube. If he looks through the tube at a steeper angle than 9.5 degrees and can see the cup, he will be closer than 17.2 feet, and if viewing at a shallower angle, he will be at a greater distance. I do not think this adds anything to US5957782. It involves a geometrical method of measuring distance in the same (but less accurate) way as the figure 8 embodiment of '782. The through hole, since it is tilted downward, would not on the face of it be suitable for making a horizontal alignment and would not in any case suggest that a horizontal alignment could be made. It would therefore require a development of at least as great a magnitude as '782 to arrive at the invention from this prior art. I therefore consider that this prior art disclosure does not show there to be any lack of inventive step.

Excluded matter

36 The well known provisions in the Act relating to excluded matter are set out in section 1(2) which reads as follows:

> *(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) a discovery, scientific theory or mathematical method;*
>
> *(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) 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.*

The interpretation of this provision has been considered comprehensively by the Court of Appeal in the *Aerotel*[1] case. The court set out a four part test for determining whether an invention is excluded from patentability, which runs as follows.

a) Properly construe the claim

b) Identify the actual contribution (or, per paragraph 44 of the judgment, the alleged contribution will do at the application stage)

c) Ask whether it falls solely within the excluded subject matter

d) Check whether the actual or alleged contribution is actually technical in nature.

37 The examiner had raised an objection that the invention is excluded from patentability because it lies simply in the method of calculating the distance to the hole. The apparatus is commonplace, the argument goes, consisting only of a golf club modified with a through hole and a scale to assist with the measurement. Through holes and scales are well known in the prior art as has been demonstrated by the cited patent specifications referred to above. Consequently the advance, with reference to the second step in the *Aerotel*

[1] *Aerotel Ltd v Telco Holdings Ltd* and *Macrossan's Application* [2006] EWCA Civ 1371, [2007] RPC 7

approach, consists only in the particular arrangement of through hole, scale and the mathematical method used to calculate the required distance. Applying the guidance in *Aerotel*, the arrangement of the scale is a method of presenting information and the method of calculation is a mental act or a mathematical method.

38 Mr Hutchinson argued to the contrary, for example in his letter of 12 January 2007, that the invention is effectively a range finder integrated into the handle of a putter, that it uses different physical features – namely a through hole suitable for horizontal alignment and a scale enabling it to be used in a particular way to measure distances in a more convenient and accurate way than was possible with prior arrangements.

39 Assuming the invention to be distinguished from the prior art in respect of its physical features then I would agree with Mr Hutchinson that the advance should be regarded as a golf putter configured as an apparatus for the measurement of distance, and that it should not be excluded under section 1(2). As the specification now stands however as a result of my finding on inventive step, the claims do not define an invention. Consequently it is not possible to apply the *Aerotel* test which requires the advance over the prior art to determined. I order below that the application be referred back to the examiner for further processing. Any resulting amendments will need to be considered by the examiner on their merits in relation to excluded matter.

Conclusion and Order

40 The question of added subject matter has been resolved as set out above with the establishment of a new form of claim 1 which omits the added subject matter as set out in paragraph 19 above. I have found that prior patent specification JP03242161 shows that the invention claimed in the amended claim 1 lacks inventive step. I make no finding on excluded matter since with no invention defined by the claim it is not possible to assess it in this respect.

41 Having considered the specification as a whole however, it appears to me that it may be possible for the applicant to amend so as to write valid claims and I order that the application be remitted to the examiner to continue with its prosecution, whereupon the examiner should issue a report under section 18(3) indicating any respects in which the application is deficient. A number of issues arise in addition to my finding on inventive step which the examiner will need to take into account:

42 Firstly, as explained in paragraph 20 above, added subject matter in the specification corresponding to that in claim 1 will have to be removed before the application can proceed to grant.

43 Also, since features amounting to added subject matter have now been omitted from the claim, it is of somewhat broader scope than before and the examiner may find it necessary to search for further prior art relevant to validity. The applicant should note that the assessment I have made in this decision is not conclusive as to the validity of the present claim.

44 Since I have found that claim 1 lacks inventive step, the question arises whether any of the subsidiary claims also lack inventive step. That was not argued at the hearing however, and I am also conscious that as well as any further searching in respect of the broader claim 1, the examiner may need to consider further searching in respect of any features of the subsidiary claims that are incorporated into claim 1, particularly since it is in other respects broader. I consequently make no finding on the validity of the subsidiary claims.

Appeal

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

P MARCHANT
Deputy Director acting for the Comptroller