



PATENTS ACT 1977

Mathys & Squire LLP

Claimant

PROCEEDINGS

Application under Section 72 of the Patents Act 1977
to revoke UK Patent No. GB 2 451 566 B

HEARING OFFICER

Stephen Probert

Hearing date: Decision off the papers

DECISION

1. This decision concerns an application by Mathys & Squire LLP to revoke patent number GB 2 451 566 B (“the patent”). The registered proprietor of the patent, Milwaukee Electric Tool Corporation, was sent a copy of the application to revoke, and was invited to file a counter-statement if they wished to oppose the application. No counter-statement has been filed, and therefore this application is unopposed. Furthermore, in accordance with rule 77(9), I must treat the registered proprietor as supporting this application to revoke.
2. The basis of the application to revoke is that the invention claimed in the patent does not involve an inventive step having regard to five pieces of prior art and the relevant common general knowledge.

The Invention

3. The invention concerns a power tool (eg. a drill press) with a base that magnetically couples the power tool to a workpiece. According to the invention, the power tool has an internal battery, a mains power input, and a switching unit that allows the power tool to be supplied by one or other power source.

The Law

4. The Comptroller's powers to revoke a patent on the application of another person are set out in section 72(1). With respect to the validity of the claims, the relevant parts read as follows:

Power to revoke patents on application

72.-(1) Subject to the following provisions of this Act, the court or the comptroller may by order revoke a patent for an invention on the application of any person (including the proprietor of the patent) on (but only on) any of the following grounds, that is to say –

- (a) the invention is not a patentable invention;
- (b) ...

5. In relation to section 72(a) above, I must also consider section 1(1) which defines the requirements for a patentable invention. It reads:

Patentable Inventions

1.-(1) 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;
- (c)

and references in this Act to a patentable invention shall be construed accordingly.

6. Section 3 is also relevant, since it defines what is meant above by 'inventive step'.

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).

The claims

7. There are two (2) independent claims, and twenty three (23) subsidiary claims in the patent. Claim 1 (below) is the broadest and, as it turns out, the only claim that I needed to consider. It reads as follows:-

1. A power tool comprising:
 - a housing;
 - a base coupled to a portion of the housing, the base operable for magnetically coupling the tool to a workpiece;
 - an electric motor supported by the housing;
 - a DC power source for providing power to the motor;
 - an AC power input for providing power to the motor, the AC power input configured for receiving power from an AC power source; and
 - a power supply switching unit electrically coupled to the DC power source and the AC power input, the switching unit selectively coupling the motor with one of the DC power source and the AC power input.

The prior art

8. The statement of case refers to five prior art documents, all published before the priority date of the patent (which is 27th July 2007):-

A1	US 4,639,170	(Palm)
A2	US 2007/0103119	(Young)
A3	US 5,415,503	(Strange et al)
A4	US 2007/0059186	(Weaver et al)
A5	US 4,835,409	(Bhagwat et al)

9. A1 and A3 describe power tools with magnetic bases for magnetically coupling the power tool to a workpiece. A2, A4 and A5 relate to various examples of electrical equipment (eg. power tools, compressors, vacuum cleaners) that are capable of being powered by internal batteries (DC power source) or a mains input (AC supply).

The Claimant's case

10. The statement of case is extensive, and suggests several ways in which the prior art identified above may be combined in different ways to attack the inventive step of each of the claims. In essence, the claimant says that there is no unexpected benefit or synergistic effect from combining the features relating to a magnetic base with the features relating to a selectable AC/DC power supply. In respect of claim 1 for example, it is specifically alleged that the subject matter of the claim is a mere collocation or aggregation of known integers, and as such there is no inventive step.
11. Having read the description and claims of the patent, and the prior art above, I agree with the claimant's assessment of claim 1.

Conclusion

12. I have concluded that claim 1 of the patent is invalid because it does not involve an inventive step. As there appears to be no prospect of any amendment of the patent under section 75, I can see no reason for me to go on and consider whether any of the other claims are also obvious. I therefore order that patent GB 2 451 566 B be revoked in accordance with Section 72(1) of the Patents Act 1977.

S J Probert

Deputy Director, acting for the Comptroller