



PATENTS ACT 1977

APPLICANT	Ms Tracy Buckland
ISSUE	Whether the application complies with Section 14(3) and Section 1(1)(b) of the Patents Act 1977
HEARING OFFICER	Peter Mason

DECISION

Introduction

- 1 Patent application GB 1604348.1 entitled “Physicians Eye” has a filing date of 24 March 2016 and is in the name of Tracy Buckland. It has already been the subject of a previous joint decision BL O/020/19 along with application GB 1500399.9. In that previous decision, while I concluded GB 1500399.9 was insufficient and refused it under S 18(3), I remitted GB 1604348.1 to the examiner for further investigation into the prior art. Following several further rounds of correspondence, the applicant was unable to agree with the examiner that the invention meets the requirements of the Patents Act 1977 (hereafter, the Act). The application has been referred to me once again.
- 2 The applicant presented their views to me in a telephone hearing on 21 September 2020. The compliance date has been extended a number of times and is currently due to expire on 15 May 2021.

Summary of previous decision BL O/020/19

- 3 In respect of this application, the previous decision was to address only added matter and inventive step, including whether the invention was a collocation of inventions. I dismissed the issue of added matter. On the issue of inventive step, while I did not agree with the examiner’s arguments; the investigations of the prior art were not complete enough to form a view on the patentability of the claims. I instructed the examiner to perform additional searching to confirm if such an interrelationship of integers was new and inventive.

Matters to decide here

- 4 The examiner has reflected on the sufficiency of GB 1500399.9 and reached the conclusion this application must have a similar issue to overcome. Furthermore, in

their letter of 26 February 2020, the examiner states the application is insufficient on signal processing detail between the components of the invention.

- 5 Following my direction in the previous decision, the examiner has performed additional searching to determine the novelty and inventiveness of what I termed in that decision the non-collocated features. The examiner's assessment excludes the features they feel are not sufficiently enabled. The examiner is of the view the claims lack an inventive step.

Sufficiency

The Law

- 6 The law relating to sufficiency is set out in Section 14(3) of the Act:

The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

- 7 As I stated in the previous decision when considering the sufficiency of the other application, the purpose of this section of the Act is to prevent an applicant laying claim to products or processes which the teaching of the patent application does not enable the skilled addressee to perform. In other words, does the patent application provide enough information for a person with a reasonable knowledge and understanding of the technical area described in the application to be able to carry out the invention?
- 8 In *Blacklight Power Inc. v The Comptroller-General of Patents*¹, the judge held the benefit of doubt should be given to the applicant where there is a reasonable prospect it would be resolved in the applicant's favour if the issue were to be fully investigated at trial with the benefit of expert evidence.

Analysis

- 9 Reflecting now on the applicant's other application (GB 1500399.9), that application had several problems in respect of insufficient disclosure, one of which concerned the wireless ultrasound scanner. Reconsidering what I stated in paragraph 64 of my previous decision², and reflecting on the clear instruction from *Blacklight*¹, I feel I may have taken too strict a view of the expectations on the skilled addressee. I should have given the benefit of the doubt to the applicant in this regard. But only in this regard, the outcome of my decision would have remained unchanged.
- 10 Turning to this application, the issue to be decided is whether the wireless ultrasound scanners required by the invention of the main claim are sufficiently disclosed. Taking into account my reasoning above in respect of the other application, I believe that the skilled person would have an understanding of how both conventional ultrasonic and infrared detectors work with a view to the uses set out in the application. Furthermore, wireless ultrasound scanners were sufficiently well-known before the filing date of this application and the disclosure does not place any

¹ *Blacklight Power Inc. v The Comptroller-General of Patents* [2009] RPC 6

² BL O/020/19, paragraph 64

particular expectation upon them. That is, we can assume they are off-the-shelf scanners. Ms. Buckland was equally of this view and stated as much in the hearing.

- 11 Turning to the wider issue of whether this application as-a-whole provides sufficient details on how the signals from each component are communicated within the system, the application gives direction to the skilled addressee on what is expected and none of those expectations appear to be beyond the normal functioning of each component. The wireless components of the application will be using standard protocols to communicate. I do not believe there is anything unduly challenging for the skilled addressee here. As Ms Buckland put it at the hearing, she has not created new technology, she has created a system out of technology that is already available. In the hearing I summarised this as the individual devices are known but the invention brings them together in a potentially novel and inventive way.
- 12 I am, therefore, prepared to give the benefit of the doubt in this application. I am of the opinion that no further information would be required by the skilled person to enact such an arrangement. Consequently, the disclosure is sufficient in this regard.

Inventive Step

The Law

- 13 The law relating to inventive step is set out in Section 1(1) of the Act:

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) is capable of industrial application;

(d) the grant of a patent for it is not excluded by subsections (2) and (3) or section 4A below;

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

- 14 Section 3 of the Act sets out how inventive step is determined:

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).

- 15 The approach to determining whether an invention has an inventive step or would be obvious to a person skilled in the art is set out in *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*³. This approach was restated and elaborated upon

³ *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd* [1985] RPC 59

by the Court of Appeal in *Pozzoli SPA v BDMO SA*⁴ where Jacob LJ reformulated the Windsurfing approach.

- 16 In *SABAF SpA v MFI Furniture Centres Ltd*, Lord Hoffmann held that we must decide what the invention is before we can ask whether it involves an inventive step. The first step will include deciding whether there is one invention or, for the purposes of section 3, two or more inventions. To do this we must consider the integers of the claimed invention. If two integers interact upon each other then they constitute a single invention having a combined effect and we will apply section 3 to the idea of that combination. But if each integer performs its own proper function independently of any of the others, then each is a separate invention for the purposes of section 3. The combination of a series of known or obvious features, each playing its usual part in the final entity, is a matter of design, not of invention. Lord Hoffmann noted that:

“If the two integers interact upon each other, if there is synergy between them, they constitute a single invention having a combined effect and one applies section 3 to the idea of combining them. If each integer “performs its own proper function independently of any of the others”, then each is for the purposes of section 3 a separate invention and it has to be applied to each one separately.”

- 17 Further guidance on this can be found in the EPO Technical Board of Appeal decision in T 1054/05 where it was noted that:

“Two features interact synergistically if their functions are interrelated and lead to an additional effect that goes beyond the sum of the effects of each feature taken in isolation. It is not enough that the features solve the same technical problem or that their effects are of the same kind and add up to an increased but otherwise unchanged effect.”

Analysis

- 18 In my last decision² I stated this application’s main claim was undoubtedly a collocation of a number of inventive concepts but that there may be synergy in respect of certain features. However, while some of those features were similar to those which I had concluded were insufficiently enabled by the very similar disclosure on the erstwhile co-pending application GB 1500399.9, I did not review or comment on any similarity because sufficiency was not put at issue in the present application. Undoubtedly, this put the examiner in a difficult position for which I must take some responsibility. Understandably, the examiner concluded they must exclude the scanners from their considerations because they could not overlook my decision on the sufficiency of the scanners of GB 1500399.9. In excluding the scanners, the examiner has formed the view that published patent applications US 2015/0105883 A1 and US 2012/0095315 A1 demonstrate the state of the art and that this feature is another collocated concept which is not inventive in its own right.
- 19 The applicant has considered the disclosures of US 2015/0105883 A1 and US 2012/0095315 A1. In their view neither describes features which are similar to their claimed nametag, clipboard and master board with their required interoperability. I

⁴ *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588; [2007] All ER (D) 275 (JUN)

tend to agree. While I am able to map some features between the claim and the prior art, there are not enough similarities. For example, I do see how separate athletic collection and output devices as described by US 2015/0105883 A1, or the glucose monitors of US 2012/0095315 A1 can be mapped across to the nametag of the present application.

- 20 Consequently, I will not refuse this application based on the evidence presented. Ordinarily, when an application is not refused after a hearing in respect of section 18(3), it would be remitted to the examiner for further processing as previously happened in this case. On this occasion due to availability, it was necessary to remit the examination to a different examiner to complete searching which they considered necessary to complete the expectation of Section 17(4). That search identified some documents which were communicated to the applicant in the interest of transparency⁵. However, on consideration of Section 18(2), none of those documents anticipate or cast doubt on the inventiveness of the main claim.

Other issues

- 21 At the hearing the applicant stated their expectation the claim needed to be clearer. The claims were last amended on 27 February 2017 and comprise a single independent claim 1 (reproduced in the annexe) with 13 dependent claims. Although the claims could be stylistically clearer, in this instance I am content the skilled addressee can determine the scope of protection the applicant is seeking.

Next steps

- 22 Having found that the invention is sufficient, novel and inventive, I will remit the application to an examiner to complete the formalities of our internal processing. The natural next step will be the issue of a letter indicating the intention to grant.

Peter Mason

Deputy Director, acting for the Comptroller

⁵ Official email of 14 December 2020

Annexe

Independent claim 1, filed 27 February 2017:

1. According to the present invention there is provided not least, a vital signs and physician, patient communicating system including: a size adjustable, size adaptable, digital wireless nametag which obtains constant vital signs readings from the wearer, using the latest technologies, displaying results to one side of a size adaptable, size adjustable, double-sided digital split touchscreen curved top, clipboard, a colour changing screen for allergy alert, displaying name, date of birth, ward number, bed number and blood group, said nametag is powered by rechargeable battery which is chargeable in charging dock supplied and can also be connected to said clipboard for charging or using, said clipboard for not least communication and protection for patient and physician and a size adaptable double - sided split touch screen master board with multiple attached wireless ultrasound and infrared scanners for not least receiving information from said clipboard, said clipboard and master board are mains adapted, have a rechargeable battery which is charged when said clipboard and master board are plugged into mains, both are also adapted for in car charging, all mentioned are coated in a wipe clean antibacterial material.