

present his arguments personally. This offer was made under the heading "Opportunity to be heard".

- 7 The legal basis under which such a hearing is offered is section 18(3) and section 101. Section 18 (3) provides that the comptroller may refuse an application if the applicant is unable to satisfy him that the requirements for obtaining a patent have been met. Section 101 provides that the comptroller shall not exercise his discretion in this respect without first giving the applicant the opportunity to be heard. The letter dated 20th May gave Mr Goodenough this opportunity to be heard.
- 8 Following the issuing of this letter there followed a series of communications, including telephone calls from Mr Rodrigues challenging amongst other matters whether a formal hearing had in fact been offered and whether Mr Rodrigues was able to participate in any hearing without Mr Goodenough first completing a Form 51 to formally appoint Mr Rodrigues as his agent.
- 9 In this instance, given in particular that Mr Goodenough's was unable to participate in the hearing I decided to allow Mr Rodrigues to present arguments on behalf of the applicant without a Form 51 having been completed. I did, as is customary, record the hearing and I sent a copy of the recording to Mr Goodenough shortly after the hearing.
- 10 I would add finally that Mr Goodenough informed the IPO in a letter dated 20th September 2013 that he had dispensed with the services of Mr Rodrigues. Mr Goodenough did however confirm that it was his understanding that Mr Rodrigues had obeyed his instructions in pursuing a narrow form of claim for his invention.

The law

- 11 Section 1(1) deals with the conditions that must be met for a patent to be granted. It states that:

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;*
- [other provisions not relevant]*

- 12 Section 3 then sets out how the presence of an 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

- 13 Matter which "forms part of the state of the art by virtue only of section 2(2)" is all matter which was made available to the public before the priority date of the application in question. In this case this means all matter published before 14th November 2012.
- 14 The task for me is therefore to determine whether Mr Goodenough's invention does or does not involve an inventive step, or in other words to determine if it is obvious

having regard to any matter made public before the 14th November 2012. The approach to determining obviousness has been considered at length by the Courts most notably by the Court of Appeal in the cases generally referred to as *Windsurfing*¹ and *Pozzoli*². The approach set out in these cases was followed by the examiner most noticeably in her examination report of 20th May 2013.

- 15 Mr Goodenough, presumably on the advice of Mr Rodrigues sought to challenge the relevance of this approach to his application. His argument, which was pursued at some length in the hearing by Mr Rodrigues, was that the *Windsurfing* and *Pozzoli* cases were “contentious”, which I took to mean that they involved a dispute between two parties. In contrast the application in issue here is “not contentious” and hence these cases had no relevance. I can I believe be brief on this. I will leave the question of whether or not this application is contentious or not. What matters is that the law that the Courts were applying in those cases is the exact same law that the comptroller is required to apply when considering whether to grant a patent. In those cases the issue considered by the Court was whether a granted patent should be revoked because it did not meet the requirements of section 1(1). Here the issue is whether a patent application should be refused because it does not meet the requirements of section 1(1). It follows that the guidance provided by the Courts in those cases as to how the requirements of that section should be determined are equally applicable here. I turn now to the nature of that guidance.
- 16 What the Courts provided in those cases was the idea of using a structured approach to the problem of deciding whether an invention involved an inventive step. That structured approach involved the following steps:

(1)(a) Identify the notional “person skilled in the art”

(1)(b) Identify the relevant common general knowledge of that person;

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

- 17 I will return to this shortly but first it is useful to say a little about the invention.

¹ *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd* [1985] RPC 59

² *Pozzoli SpA v BDMO SA* [2007] EWCA Civ 588, [2007] FSR 37

The invention

- 18 The invention set out in GB1220457.4 relates to a retractable additional half step for use with a flight of stairs. The half step is intended to assist people who would otherwise struggle to climb normally spaced stairs. With reference to figure 4 of the description (shown below) the half step comprises a board or plank 1 attached at one end by a hinge 2 to a side panel 3 provided with holes for fastening to a staircase side wall 4. The other end of the plank 1 is fixed to a riser board 5 designed to stand erect on a stair tread 6 when the half step is deployed. The hinge 2 enables the plank 1 to be folded up against the side wall up to clear the flight for normal use. The side panel; and riser board may be the same height so that the device is self-aligning and levelling for quick DIY installation. The half step may be held securely in the retracted, folded up position by provision of magnetic or catch holding means. In an alternative embodiment the riser board 5 is fixed to the plank 1 by hinges so that it folds down against the plank when the half step is retracted by folding up.

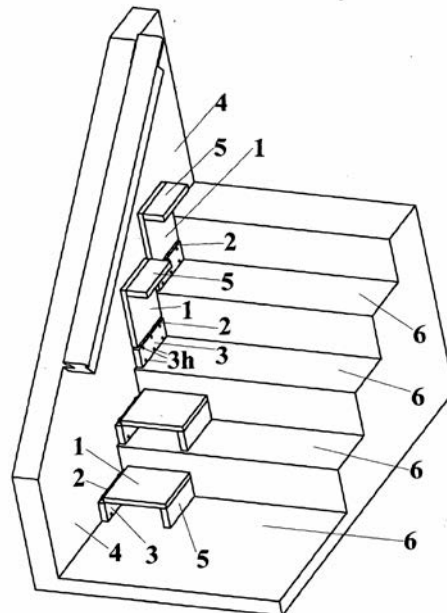


Fig 4

- 19 The latest claims are those filed on 15th April 2013. The scope of these claims was narrower than originally filed and focused specifically on the embodiment where the riser or side panel is rigidly fixed to the step. The amended claims include the following main claim 1:

1. Retractable, Half Step, Stair Climb Aid, for installation on stairs to help users with weak legs, comprising a small plank attached at one end by hinged means to a side panel provided with holes for fastening to a staircase side wall, the other end of the plank is rigidly fixed to a riser board designed to stand erect on a stair tread; the hinge means and catches provided enables the plank to retract up securely to clear the stairs for normal use.

Does the invention involve an inventive step?

20 I return now to the question of whether the invention as claimed involves an inventive step. Section 3 refers to the “skilled person” and the first step of the test set out in *Pozzoli* and *Windsurfer* requires me to identify the skilled person and the relevant common general knowledge of that person.

Identify the Person Skilled in the Art and the relevant common general knowledge of that person;

21 In this case the skilled person will be a person tasked with designing staircases or modifying existing staircases. The skilled person is however typically a person who has the skill and knowledge to make routine workshop developments but not to exercise inventive ingenuity or think laterally.

Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

22 The scope of the claims in this application has been narrowed during the course of the application. The inventive concept as set out in the amended claim is in my opinion the provision of a foldable half step for use on stairs wherein the side panel or riser is rigidly fixed to the part forming the step.

Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

23 The matter cited as forming part of the state of the art in this instance is the matter disclosed in JP 2002201778 A. Before I consider the contents of this document I need to address a point raised by Mr Rodrigues. This is that JP 2002201778 A is a patent application that was not granted and hence is not citable. However as noted above, section 2(2) makes it clear that the state of the art shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of the invention in issue been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way. Hence it is not relevant whether JP 2002201778 A was or was not granted as it was clearly made available to the public when it was published in 2002. That it was published in Japanese does not alter the fact that it has been made available to the public.

24 I turn now to the question of what this document discloses. The drawings of this document are reproduced below.

28 Hence when comparing the disclosure in this document with the inventive concept in set out in the latest claim, it would appear that the only difference of note is that in the claimed invention the riser or outer side panel is rigidly fixed to the plank forming the step. In JP 2002201778 A the outer side panel is fastened to the step by a hinge which allows it to fold inward when the step is folded up to its out of use position (see figure 1).

Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

29 The final step of the approach set out in *Windsurfing and Pozzoli* takes us essentially to the statutory test i.e. is the invention obvious?. This does not mean the earlier steps were unnecessary. Rather they are intended to ensure that a consistent approach is taken to determining whether an invention it is or is not obvious. In this case I believe the answer to this final question is a clear yes. A person skilled in the art looking at the disclosure in JP 2002201778 A would readily appreciate that the outer side panel or riser could be rigidly fixed to the step. The skilled person would have no difficulty achieving that. He would for example not have to overcome any technical problems. It would simply be a case of screwing or gluing or otherwise rigidly fixing the two parts together. It is possible that such a construction would be more rigid than an arrangement where the outer side panel is connected to the step by a hinge though in the latter it would be straightforward to provide additional bracing. Indeed this is what appears to be provided in JP 2002201778 A by brace 16. The skilled person would readily appreciate this and would also recognise, in the same way that Mr Goodenough did, the disadvantage with a rigidly fixed side panel of having that panel protruding into the staircase when the step is folded up. Hence I can see nothing inventive in providing a rigidly fixed outer panel or riser.

30 It follows that I do not consider the invention of claim 1 as amended to contain an inventive step.

31 The other four amended claims are all dependent on claim 1. Claim 2 refers to the width of the step being a quarter of width of the stair to which it is attached and the height of the riser being half the height of the step. Whilst at least the width differs from that disclosed in the embodiment shown in JP 2002201778 A, this difference would be no more than an obvious variation to the skilled person. Claims 3 and 4 relate to possible variations in materials for the foldable step and types of catches to secure the step in its retracted position. Again all of these would be obvious to a person skilled in the art.

32 The final claim states that the height and width of the side panel is so provided that the plank is "self-levelling and self-aligning for quick DIY installation". The side panel referred to is the inner side panel which is fixed to the staircase. Again there is nothing inventive in this. Indeed the arrangement of side panels shown in JP 2002201778 A would equally provide a level and aligned step.

Conclusion

- 33 I conclude that the invention claimed in the amended claim 1 is not patentable because it lacks an inventive step. I conclude that the dependant claims also lack an inventive step.
- 34 I have considered carefully the specification as a whole but am unable to find anything upon which an allowable claim might be based. I therefore refuse the application under section 18(3) for failure to comply with section 1(1)(b).

Appeal

- 35 Any appeal must be lodged within 28 days

Phil Thorpe