



PATENTS ACT 1977

APPLICANT Janan Leosawathipong

ISSUE Whether patent application number GB 0908792.5
complies with section 1(1)(b)

HEARING OFFICER Andy Bartlett

DECISION

Introduction

1. This decision addresses the issue of whether the invention claimed in patent application number GB0908792.5 involves an inventive step as required by section 1(1)(b).
2. The application was filed in the name of Janan Leosawathiphong on 21 May 2009. It was subsequently published as GB2470397 on 24 November 2010. Despite numerous rounds of correspondence and amendment the applicants (via their attorney Jennifer Unsworth of the firms Hepworth Browne and subsequently Clifton Cowley Legal, and attorney Gary March of the firm Clifton Cowley Legal) have been unable to satisfy the examiner that the claimed invention involves an inventive step over the prior art. In light of that impasse, the applicants were offered the opportunity to be heard on the matter but opted instead for a decision to be taken on the papers on file.
3. I confirm that I have taken account of all the papers on file in reaching my decision including the numerous rounds of correspondence between the examiner and the applicants' attorneys, the amendments that have resulted and the two expert witness statements supplied by the applicants.

The Law

4. Section 1 of the Act sets out a number of requirements that an application must comply with before a patent can be granted. The relevant parts of that section read as follows:

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

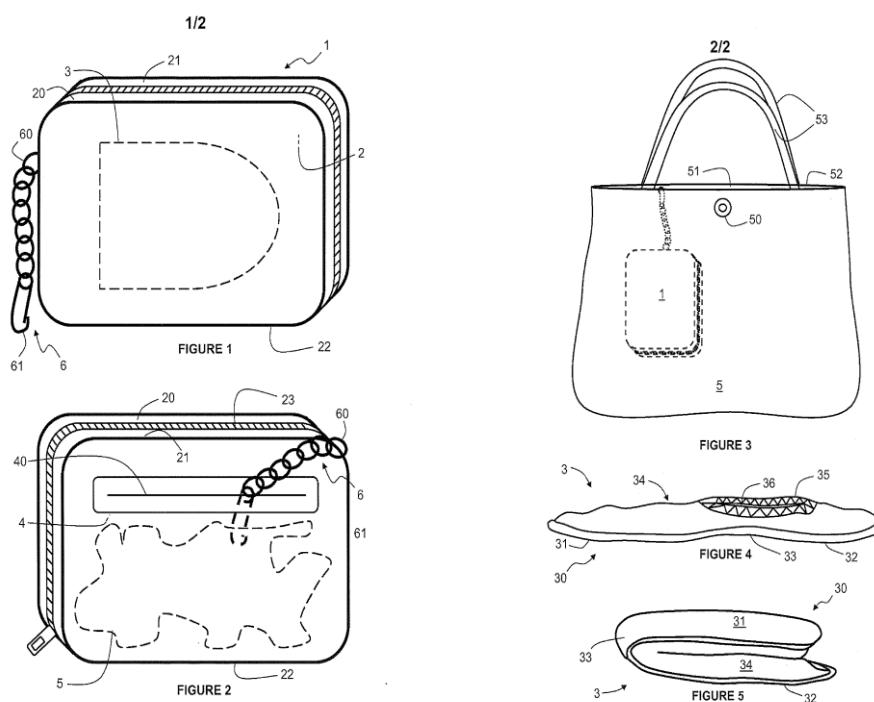
5. Further explanation of the inventive step requirement is provided in section 3:

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 Application

6. The application addresses the problem of how to conveniently transport a pair of comfortable shoes during a night out so that the user can change out of their less comfortable formal footwear at the end of the night and transport those formal shoes home. The applicants' attorney has confirmed that the form of application that I should consider comprises the claims filed with his letter dated 20 January 2014 and the description filed with his letter of 21 March 2014 (an earlier version of the claims having been inadvertently filed with the March letter).

7. With reference to the figures reproduced below, the invention comprises the combination of a pair of foldable shoes 3 and their carrier 1. In addition to the main compartment 2 in which the foldable shoes are housed, the carrier also includes a second compartment (4, fig 2) in which a collapsed bag 5 is housed, that bag being bigger than the carrier when removed and unfolded as shown in figure 3. The carrier



also includes a releasable attachment means eg a chain and hook for attaching the carrier to either the handbag of the user or to the bag 5.

8. The application as currently on file comprises twenty three claims in total of which claim 1 is the only independent claim. It reads

1. *In combination, folded portable shoes which are deformable, foldable or rollable together with a footwear carrier comprising a main compartment sized and shaped to surround said folded portable shoes, a releasable attachment means and a secondary compartment containing a collapsed bag usable independently of the carrier, wherein the collapsed bag is separably removable away from the secondary compartment and is expandable, in use, to have a larger capacity than the main compartment and wherein the releasable attachment means is configured to releasably attach, in use the carrier to a handbag or to the collapsed or expanded bag.*

9. I think it is fair to say that claim 1 is not very precisely defined. For example it is not clear to me what limitation “deformable, foldable or rollable” imposes on the “folded shoes” of claim 1. Likewise, the requirement that the carrier comprises a main compartment sized and shaped to surround the folded portable shoes does not place much of a limitation on the carrier – it merely has to be capable of containing the folded shoes. That though does not cause any particular problem. More significant is the uncertainty in meaning of the section specifying that the “collapsed bag (is) **usable independently of the carrier**, wherein the collapsed bag is **separately removable away from the secondary compartment**”. This limitation was introduced in an attempt to distinguish the claimed invention from the prior art cited by the examiner and appears intended to mean that once removed from the second compartment, the bag is detached and independent from the carrier. That is how I will interpret the claim even though as reported by the examiner this is inconsistent with claim 19 which purports to be dependent on it but which teaches that the bag can be “securedly connected to the carrier” such as by stitching.

10. I will initially focus my attention on claim 1 since should I find it to be inventive then it will follow that the claims dependent upon it will also be inventive. I will consider the dependent claims separately should I find claim 1 to lack an inventive step.

The Approach for assessing inventive step

11. The approach to be followed when assessing whether an invention provides an inventive step is that laid down by the Court of Appeal in *Pozzoli*¹. That test comprises the following steps:

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

¹ Pozzoli SPA vs BDMO SA [2007] EWCA Civ 588

(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.

12. Before I can apply that test it is incumbent on me to decide what I must apply it to. I say that because the present invention is defined as a combination of features and is thus the sort of invention where the law of collocation potentially applies. Indeed the basis of the examiner’s objection that the invention lacks an inventive step is that it is merely a collocation of known or obvious features.

13. The law of collocation was considered by Lord Hoffman in *SABAF*² where he said at paragraph 24:

“But before you can apply s.3 and ask whether the invention involves an inventive step, you first have to decide what the invention is. In particular, you have to decide whether you are dealing with one invention or two or more inventions.”

14. And at paragraph 26 with reference to the EPO guidelines for Substantive Examination he went on to say:

“ The EPO Guidelines say that “the invention claimed must normally be considered as a whole”. But equally one must not try to consider as a whole what are in fact two separate inventions. What the guidelines do is to state the principle upon which you decide whether you are dealing with a single invention or not. 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 s.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 s.3 a separate invention and it has to be applied to each one separately.”

15. The relevant section of the guidelines to which Lord Hoffman was referring was included at paragraph 18 of his judgment:

1. "9.5 Combination vs. juxtaposition or aggregation

"The invention claimed must normally be considered as a whole. When a claim consists of a 'combination of features', it is not correct to argue that the separate features of the combination taken by themselves are known or obvious and that 'therefore' the whole subject-matter claimed is obvious. However, where the claim is merely an 'aggregation or juxtaposition of features' and not a true combination, it is enough to show that the individual features are obvious to prove that the aggregation of features does not involve an inventive step. A set of technical features is regarded as a combination of features if the functional interaction between the features achieves a combined technical effect which is different from, e.g. greater than, the sum of the technical effects of the individual features. In other words, the interactions of the individual features must produce a synergistic

² *SABAF SpA vs MFI Furniture Centres Limited* [2005] R.P.C 10

effect. If no such synergistic effect exists, there is no more than a mere aggregation of features...

"Chapter IV, Annex 2.1 Obvious and consequently non-inventive combination of features:

The invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working inter-relationship.

16. The key question for me to decide is whether the combination presently claimed is merely an aggregation or juxtaposition of features each performing its own proper function (and therefore a collocation) or whether there is some synergy between them. This is crucial because at no time have the Applicants suggested that any of the individual elements are novel and inventive.

Is the Invention a Collocation?

17. The examiner has reported that in her opinion the invention defined in claim 1 is indeed a collocation of known or obvious features. The Applicants do not agree and have argued consistently that the combination defined in claim 1 is not a collocation and is inventive.
18. As summarised in her pre-hearing letter the examiner identified the individual features as being the footwear carrier, the releasable attachment means and the collapsed bag. I note that this does not explicitly include the foldable shoes which are required in claim 1 and are thus a fundamental part of this consideration. As I see it, the individual features to be considered are the folded or foldable shoes, the carrier for those shoes including a secondary compartment (or pocket), the releasable attachment means and the collapsed bag.
19. So is there any synergy between these elements or is each simply performing its own proper function independently of the others? Taking the carrier first, as I have highlighted above, claim 1 imposes no limitation on the features of the carrier that make it suitable for carrying the shoes other than it must be sized and shaped to house the folded shoes. That amounts to nothing more than a carrier that is big enough to house the folded shoes. I cannot see that there is any synergy between the shoes and the carrier – each is independently performing its proper function. That the carrier includes a secondary compartment or pocket makes no difference to this.
20. As for the releasable attachment means, again I can see no synergy between this and the other elements of the claimed invention. In the embodiment described this is a hook and chain device which can be used to connect the carrier to something else, including the handbag of the owner of the carrier. The claim says nothing about how the attachment means is attached to the carrier itself and indeed does not seem to preclude it merely being provided in the carrier. This sort of device is a common accessory on bags, wallets and the like as can be readily confirmed via a quick internet search and indeed is illustrated in one of the other documents³ cited by the examiner. From this I can only conclude again that the attachment means is performing its own

³ DE29606396U (Esquire-Lederwaren Rupp & Ricker GmbH)

proper function. There is no synergy between it and the carrier.

21. The final element is the collapsed bag that is stated to be provided in the secondary compartment (pocket) of the carrier. As stated above, to overcome prior art cited by the examiner, claim 1 has been limited to specify this bag to be completely detachable from the carrier so that it can be used independently of it. To my mind that is a clear indication that the bag does not form part of a true combination as opposed to an aggregation of features; rather it is again simply an element performing its proper function independent of the other features. Indeed claim 1 does not preclude it being anything other than a larger bag (such as a plastic carrier bag) which can be folded up and housed in the pocket of the carrier.
22. Taking the above into account I consider the combination defined in claim 1 to be a collocation of features each independently performing its proper function.
23. That finding is entirely consistent with the passage from the EPO Examination Guidelines quoted with approval by Lord Hoffman in *SABAF* to which I have referred above; the technical effect provided by the combination defined in claim 1 is no more than the sum of the technical effects of the individual features. There is no synergy between them.
24. Having reached that conclusion, then following the approach in *SABAF*, the *Pozzoli* test should be applied to each of the individual elements to determine whether the claimed invention provides the required inventive step, rather than to the combination as a whole. That is not however necessary for all the individual elements in this instance since the releasable attachment means and the collapsible bag are clearly not novel. The specification also acknowledges that foldable shoes are not novel. That just leaves the carrier for the folded shoes though I note that at no time have the Applicants suggested that this or any of the other individual elements is novel and inventive.
25. Applying *Pozzoli* to the carrier element, the first step requires me to identify the skilled person and the relevant common general knowledge of that person.
26. The Manual of Patent Practice provides useful guidance as to the qualities that the skilled person possesses drawing together as it does guidance from various court judgments where this has been considered. For example at paragraph 3.20 the Manual makes it clear that the skilled person “is not a highly skilled expert or Nobel prize winner, nor is he some form of lowest common denominator. Instead he is best seen as someone who is good at their job, a fully competent worker”. And at paragraph 3.21 the Manual suggests “He should be taken to be a person who has the skill to make routine workshop developments but not to exercise inventive ingenuity or think laterally”. I will endeavour to assess the invention through the eyes of a person having those qualities.
27. In this instance I take the skilled person to be the designer of small carriers and bags such as purses, handbags and the like. As regards the common general knowledge of that skilled person, I consider (s)he would be aware of the tools and techniques commonly used in design and manufacture of such carriers and have an appreciation of the various carriers and bags commonly available including their auxiliary and component parts (such as zips and fasteners etc).

28. As for the second step, I consider the inventive concept of this element to be a carrier for folded shoes having a secondary compartment (such as a pocket).
29. As for step 3, I consider the following documents cited by the examiner to be indicative of the state of the art as regards carriers for foldable shoes:

US 5158220	(GLASS MARNE A)
GB 2443937	(FEET FAIRIES LTD)
GB 2449717	(HOPKINS SANCHA et al.)
JP 2003038226	(IWAZAWA MIEKO)

30. These documents all show that such carriers for folded shoes were well known at the priority date of the invention. Indeed *Feet Fairies* is the prior art acknowledged by the Applicants in the present application. A summary of each is provided in Annex A along with some illustrative figures from them. Whilst they might not disclose the carrier having a secondary compartment I consider that the provision of pockets in bags and carriers to be ubiquitous and that providing one in a carrier for folded shoes would have been obvious to the skilled person. In the correspondence on file the applicants' attorneys have rightly stressed that *ex post facto* analysis must be avoided when making that assessment, which I have endeavoured to do.
31. Thus none of the individual elements of claim 1 provides the required inventive step. Moreover, the combination claimed in claim 1 is a collocation of known or obvious features each performing its proper function. In my view it provides no inventive step.
32. I would reach precisely the same conclusion even were it appropriate to consider the combination as a whole as the inventive concept. The provision of secondary compartments such as pockets in carriers such as bags is so common place that it would form part of the common general knowledge of the person skilled in the art of bag or carrier design and manufacture. Likewise the provision of releasable attachment means to attach small carriers to other objects including other bags and belts. As a matter of course people place folded up bags in the pockets of smaller bags so that they are conveniently to hand should they be needed, including for carrying shoes. The differences between the combination defined in claim 1 and the closest prior art listed above would not in my opinion constitute steps requiring the skilled person to exercise any degree of invention.

Expert Witness Statements

33. Somewhat unusually for *ex parte* proceedings concerning section 18, the Applicants have supplied two "expert witness statements" in support of their arguments that the invention is not obvious. Both were from individuals with long histories of involvement in the footwear industry. I have given them appropriate consideration but they are of limited assistance since they are more directed to expressing a view as to the degree of originality of the Applicants' invention than questions of disputed fact to which expert evidence should be directed. Ultimately I do not concur with the views they have expressed as to the inventiveness of the invention in claim 1: whilst the

Applicants may be the first to provide a product with all the features specified in present claim 1 that does not mean it is inventive in patent law terms.

Conclusion

34. I have found that the invention claimed in claim 1 does not provide an inventive step as required by section 1(1)(b) of the Act. The remaining claims all relate to design features of the bag such as the material it is made from and the way it is fastened, none of which are inventive. I am unable to identify any amendments that could form the basis of a valid claim and consequently I refuse this application under section 18(3).

Appeal

35. Any appeal must be lodged within 28 days

A BARTLETT

Deputy Director acting for the Comptroller.

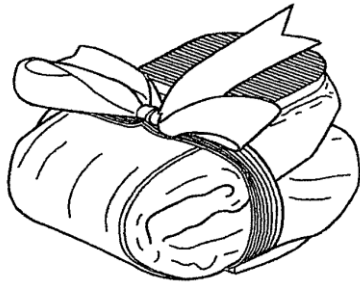
Annex A

GB 2443937 (Feet Fairies)

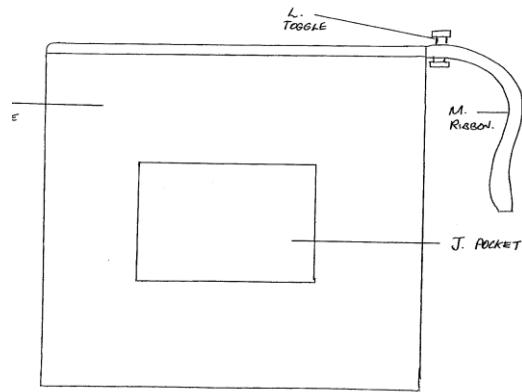
The Feet Fairies document is the prior art acknowledged in the present application. It discloses a foldable shoe and an associated carrier in combination. As described with reference to figure 4 thereof, the carrier serves both to retain the folded shoes and also a larger bag which can be unfurled from the carrier and used to carry a conventional (more bulky) pair of shoes with the carrier then forming a pocket J on the larger unfurled bag K.

FIGURE 4

4/4



Perspective view (folded)



HOPKINS discloses a footwear carrier 20 in which a pair of foldable slippers 10 is stored and which converts into a larger bag which can be used to carry a conventional (bulkier) pair of shoes and other accessories.

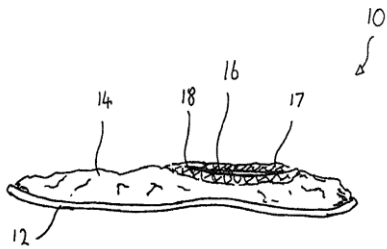


Fig. 1

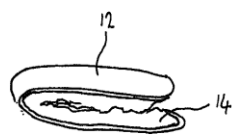


Fig. 2

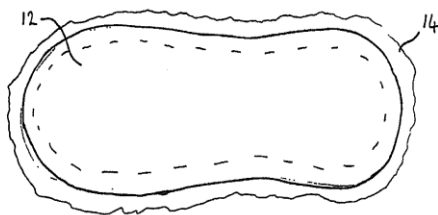


Fig. 3

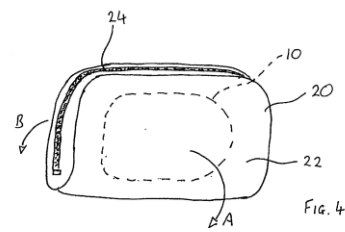


Fig. 4

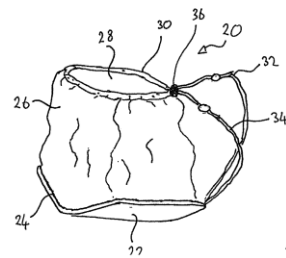
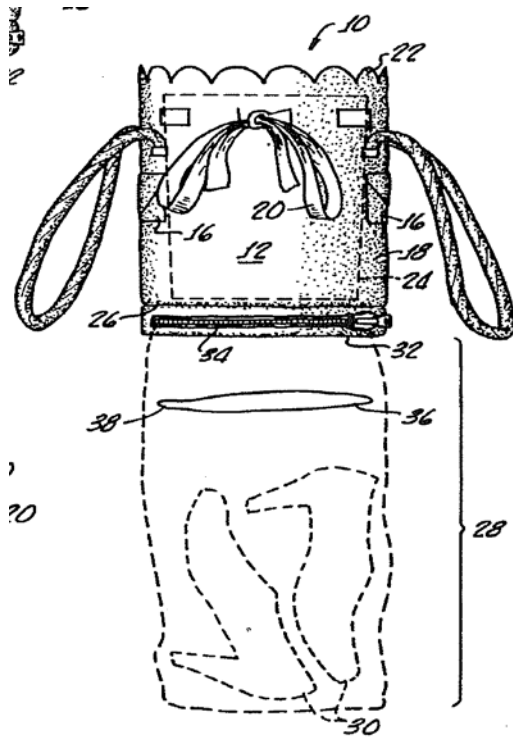


Fig. 5

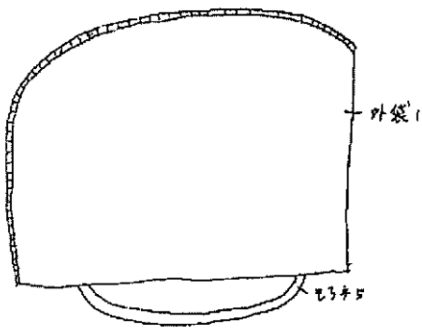
US 5158220 (GLASS MARNE A)

GLASS discloses a multifunction carrier used to carry shoes and a casino coin cup. Folding slippers can be stored in either the main compartment 12 of the carrier or a pocket thereof 32 and the pocket also houses a larger folded, rolled up bag 28 that can be unfurled and used to carry a larger pair of shoes.

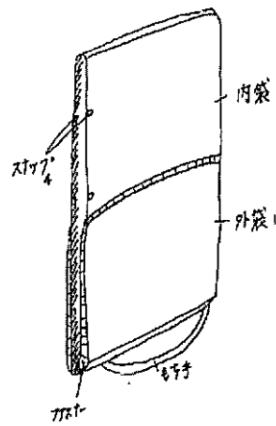


IWAZAWA discloses a bag for carrying shoes which is convertible between a small capacity configuration for foldable shoes or slippers (figs 1 & 4) to a larger capacity (figs 2 & 3) for carrying dress, non foldable shoes.

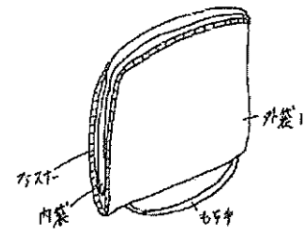
【図1】



【図3】



【図4】



【図2】

