

PATENTS ACT 1977Pat / Linda
3Y60**IN THE MATTER OF**Patent application 9307397.1
in the name of Petra Fischer**DECISION**

Application 9307397.1, entitled "Convertible motor vehicles", was filed on 8 April 1993, claiming a priority date of 14 April 1992 and was published as GB2266082 on 20 October 1993.

A first report under Section 18(3), issued on 29 November 1994, raised an objection under Section 1(1)(b) that, in the opinion of the examiner, the invention did not involve an inventive step. In response, amendments were made, but the examiner maintained the objection. Further exchanges of correspondence ensued, without agreement being reached, and so the matter came before me on 8 October 1996, where the applicant was represented by Mr Abbie and Mr Baldwin of her Agents. Mr Twin appeared as the examiner in the case.

On the day prior to the hearing, Mr Abbie faxed to the Office a copy of a statement by a Hans Vogt, in support of his case. I indicated at the hearing that I could not admit this evidence as it is not in the form required by Rule 103(1). However, I did indicate that I was prepared to hear submissions on this document on the understanding that the document be presented later in the proper form. I will return to this document below.

As indicated by the Title, the invention is concerned with convertible motor vehicles, and the form of claim 1 before me at the hearing was as follows:-

"1. A cabriolet based on a basic production model sedan/coupe, at least in the engine space, and with an internal combustion engine in the engine space, characterized in that

said internal combustion engine is a diesel engine which is at least similar in construction to a diesel engine used in said basic production model."

Claims 2 to 12 are all of appendant form, and independent claim 13 is to a process for production of cabriolets, and recites features which identify the cabriolets with those of claim 1.

I think it is first appropriate to note that the Search under Section 17 only revealed one publication, which the examiner coded "A" according to the usual convention as a document indicating technological background. It is also worthy of note that the Search extended to a perusal of the periodicals "Parker's Car Price Guide" and "Diesel Car".

The examiner's view was set out in the first Section 18(3) report dated 29 November 1996, and I do not think the subsequent correspondence has altered this view, and his basic objection, in substance. I think it is useful here to use his words, quoted from that report as a summary of the objection:-

"...a skilled automotive engineer would have been of the opinion, at the present priority date, that, given a basic production car model with a number of body options which include a convertible version and a choice of engine options which include a diesel engine, the combination of the convertible and diesel options would have required no technical innovation.

Indeed, it is stated at page 4, lines 8, 9 of this specification that "no difficulties arise from this, either as regards substitution or as regards mounting" and at page 2, lines 4 to 7 that "all the varieties of engine which are accommodated in the basic model (sedan/coupe) can also be built into the convertible version practically without any changes.

It is not disputed that, despite there having been no technical barrier, diesel convertible cars have not been mass produced. The reason therefore appears to have been based

on marketing, rather than engineering, decisions. Perhaps the view was taken by motor manufacturers that the "image" of the convertible was not in keeping with that of the diesel engine....."

Thus, the objection is taken under Section 1(1)(b), which reads;

"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)

(b) it involves an inventive step

(c)"

And this is further explained by Section 3, which states:-

"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 only of Section 2(2) above (and disregarding section 2(3) above)."

Mr Abbie's response was put to me at the hearing and at greater length in the correspondence prior to the hearing, all of which I have carefully considered in coming to my decision.

He was particularly careful to emphasise that the claims are not merely to the incorporation of any diesel engine into any convertible vehicle, but is, if I can paraphrase, concerned with mass-produced vehicles based upon standard production models. This I fully accept.

He drew my attention to the reported cases of *Hickton's Patent Syndicate* 1909 26 RPC 339 and *Mutoh Industries* [1984] RPC 35. I accept his contention that these establish the law as being that if it was not obvious to have the idea of doing a particular thing the mere fact that once you have got the idea the actual way of putting this into effect might not require invention did not stop you having something that was perfectly patentable.

The question then turns upon whether the basic idea is inventive, and I think that this is at the heart of the problem.

Mr Abbie contended that vast numbers of cabriolet cars based upon production sedan/coupés have been produced over a long period of years. Equally, he also contended that sedan/coupe cars with diesel engines had been produced for many years, drawing attention to a published used car price guide publication in support. From my own general knowledge, and the results of the search under Section 17, I accept that this is the case. Given this, he says, since there is nothing to show that before the priority date, anyone had contemplated installing diesel engines in standard production cabriolets, there must be presumption that the invention is not obvious.

The examiner drew attention to the decisions in *Windsurfing International v. Tabur Marine* [1985] RPC 59 and *Hallen v. Brabantia* [1991] RPC 195 as drawing a distinction between "technical" and "commercial" obviousness. In the *Brabantia* case, the Court of Appeal approved of the decision in the *Windsurfer*, in particular the part of the decision which reads "What has to be determined is whether what is now claimed as invention would have been obvious, not whether it would have appeared commercially worthwhile to exploit it".

On this point, Mr Abbie submitted that there was a technical prejudice against using diesel engines in cabriolet cars. He alluded to the well-known characteristics of the diesel engine as being noisier and more prone to vibration than petrol engines, and to the well-known characteristics of cabriolet bodies as being again more prone to vibration. He stated that, surprisingly, the apprehension of the technical expert has not been borne out in practice. I think it is worth noting here that the specification itself does not disclose this advantage, and at the hearing, in response to my question, Mr Abbie was unable to say whether this advantage had been observed in any actual vehicles other than that referred to in the documents submitted in support, which were an extract from a German periodical "Focus"; another extract from the German periodical "Gute Fahrt"; and to the above-mentioned statement from Herr Vogt.

Both of the two periodical extracts were apparently published after the priority date of the application, and both refer to a diesel cabriolet produced by Volkswagen. Although full translations were not provided, translations of the particular passages relied upon were quoted in letters. The "Focus" article (which I observe is clouded somewhat by what I perceive as

journalistic hyperbole) on the one hand does provide support for the fact that the cabriolet diesel is "unheard of", but it also posits a list of vehicles thought "impossible by the value of marketing experts", with the diesel convertible included, and goes on to say that the particular cabriolet mentioned powered by a diesel engine "..should combine, what did never belong together according to the opinion of the drivers: ..." (my emphasis added in both cases). These latter two passages, in my view, lend support to the contention that the prejudice against the diesel engine in a cabriolet is a commercial, marketing decision, not a technical one. The "Gute Fahrt" article is perhaps a more measured piece of journalism, and appears to be a road test report concerned with the Volkswagen diesel cabriolet, indeed making the point that, in this vehicle, vibration and noise are low.

The statement from Herr Vogt is also enlisted in support. As I have said previously, I consider that this is, in its current form, inadmissible. However, if I had found it admissible, I would comment that, whilst Herr Vogt's long experience in the automotive industry adds further confirmation that the problems of vibration and noise would be the perception, I accept from my general knowledge that this is the case. It also repeats the finding of the "Gute Fahrt" article. On the other hand, I would also highlight the passage in his statement which says "These problems would probably be disturbing to a pleasure driver wishing to enjoy the vehicle's performance". This to me is a further signal that the prejudice is a perception of the market response.

Mr Abbie also referred me to the *General Tire* case [1972] RPC 457 to say that the test for obviousness must follow the normal dictionary definition of the word, which I accept. He also made reference to the could/would tests expounded in *Technograph Printed Circuits Ltd v. Mills & Rockley (Electronics) Ltd* [1972] RPC 346; EPO technical board decision T02/83; and *Johns-Manville Corporation's Patent* [1967] RPC 479. I find this last case particularly relevant, in particular the passage on page 494, which states "I think that "would be" puts it too high if it postulates prior certainty of success before actually testing the polymers in the filtration process; it is enough that the person skilled in the art would assess the likelihood of success as sufficient to warrant actual trial." The *Technograph* case puts this in a slightly different way, on page 356 where it is said that "So what he [the skilled man] must be

supposed to have done is to try everything which would appear to him as giving any prospect of valuable results." Both of these decisions were reviewed and applied in the *Brabantia* judgement.

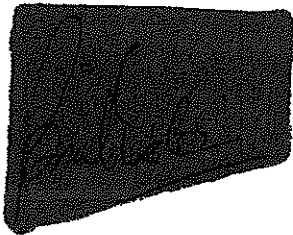
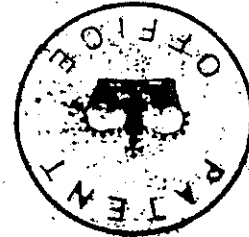
In many ways, this is an unusual case in that no actual documentary evidence is relied upon by the examiner in support of a Section 1(1)(b) objection. However, it is clear to me that the two elements put together to make up the vehicle claimed, that is the cabriolet body and the diesel engine are well-known. Given the propensity of car manufacturers, even at the priority date of the application, to provide a range of options as to body type, and engine size and type within a particular model range it seems to me that there is no technical difficulty in marrying the diesel engine and the cabriolet body, and this is acknowledged in the specification. It is clear to me that the skilled man could have tried this, but did not. That is to say, I do not consider, even without documentary evidence additional to the acknowledgement of this in the specification, that there is any technical or practical barrier needing invention to overcome in putting the combination together. I should therefore look to whether the skilled man would have tried it, assessing the likelihood of success as sufficient to warrant trial. Based upon the submissions and documents put in on this case, it seems to me that the decision not to do this is indeed one based on the perception of the market demand and thus the chances of commercial success. In these circumstances I feel that the law as expressed in the *Windsurfer* and *Brabantia* cases, lead me to agree with the examiner. I therefore conclude that there is no technical inventive step in the invention at least as claimed in claims 1 and 13.

In coming to this decision, I have taken full account of Mr Abbie's submissions based upon the law as represented by the reported cases *Swift's Application* [1962] RPC 37 and *General Electric Co's Applications* [1964] RPC 413, from which it is clear that the Comptroller's jurisdiction to refuse an application should only be exercised in the clearest cases. This is a premise that I readily accept, but I am also conscious of the general public interest in not granting clearly invalid patents. I am convinced in this particular application that the wider public interest outweighs the interests of the applicant, and consider that the present application falls into the category of the clearest cases.

Having found, as I have, that the independent claims must be refused, then I must turn to any saving subject-matter which I can perceive. At the hearing, Mr Abbie said that he could not tell me of anything on which the applicant could rely, but would need to take instruction on this. So, although I must say that I can not see anything which could save the application, since I have not been addressed in detail on the rest of the specification, I allow the applicant the opportunity, during the time remaining of the acceptance period (which due to the operation of Section 20(2) now runs until the end of the period allowed for appeal from this decision), to propose amendments in order to meet my decision above. Failing satisfactory amendment, the application will stand refused at the end of this period.

Since this is a substantive matter, the period for appeal is six weeks from the date of this decision.

Dated this 11 day of OCTOBER 1996

A dark, rectangular redaction box covering the signature of the Principal Examiner.

B WESTERMAN

Principal Examiner, acting for the Comptroller

THE PATENT OFFICE