PATENTS ACT, 1977

BL O/097/83

IN THE MATTER OF application
for Letters Patent No 2058718
in the name of TDK Electronics
Company Limited

DECISION

The Examiner, Mrs Harden, having raised objection on the ground that the subject matter of the application was not an invention under Section 1(2)(d) as it consisted of the presentation of information, and also on the ground that the invention claimed did not involve an inventive step as required by Section 1(1)(b), the case came before me for hearing on 19 April 1983. The applicants were represented by Mr Bankes.

The specification relates to a cassette for magnetic tape which is fed from one reel to another and guided along its path by at least two guide poles which preferably are mounted in holes in the base of the cassette. The tape is in direct contact with a first of these guide poles which therefore requires a smooth surface to avoid damage to the tape whereas the tape does not engage the second pole directly but contacts a roller with a smooth surface which is rotatable on the second pole. Given this construction, a considerable cost saving can be effected by not finishing the second pole to the high degree of smoothness as is necessary for the first pole.

The specification opens as follows:

> "The present invention relates to a magnetic tape cassette, a particular application being as a video tape cassette.
>
> As shown in Figure 1 of the accompanying drawings, a conventional video tape cassette comprises ....."

It then continues with a description of the constructional features of the cassette, not only with reference to Figure 1 but also with reference to the only other figure, Figure 2. The clear implication is that all of the constructional features disclosed in the specification were, at the time of the declared priority date (9 September 1979) of the application, well known, and Mr Bankes did not in any way deny this.

A difficulty arises in the correct assembly of the cassettes owing to the fact that the two poles are preferably of the same size and may not be very easy to distinguish from one another visually, and if the poles were to be placed in the wrong holes in the base, the tape would be damaged by contact with the less smooth one. The contribution made to the art by the applicants is that at least one of the poles is coloured to facilitate the correct selection of the poles in relation to the holes. The colour may be applied in any desired manner to all or part of the surface, such as an end surface. or. where the poles are made of a synthetic resin, the resin may be pigmented.

Claim 1 reads:

> "A magnetic tape cassette comprising a first guide pole directly contacting a magnetic tape and a second guide pole onto which a guide roll directly contacting with said magnetic tape is rotatably fitted, wherein at least one of said guide poles is colored so as to distinguish between the different guide poles."

Claim 2 specifies that the poles are of substantially the same size, Claim 3 that the poles are fitted into holes formed in a half case of the cassette so as to project inwardly from said half case, and Claim 4 is an omnibus claim for a magnetic tape cassette according to Claim 1 substantially as herein described with reference to the accompanying drawings.

On 3 February 1983, subsequent to the first report of the Examiner following the substantive examination of the application, additional claims 5 and 6 were filed. Claim 5 reads:

> "A method of assembling a magnetic tape cassette comprising two half cases enclosing a magnetic tape which includes the steps of inserting into a half case of the cassette a first guide pole having a smooth surface for direct contact with the tape, and a second guide pole, and fitting a rotatable guide roller axially over the second guide pole for rolling contact with the tape. wherein one of said first and second guide poles is coloured to distinguish it from the other. to ensure correct positioning of the guide roller."

and Claim 6 is an omnibus claim for a method according to Claim 5 substantially as herein described with reference to the accompanying drawings.

It is to be noted that Claim 5 states that the function of the colouring of one of the poles is to ensure correct positioning of the guide roller. Although

"ensure" is perhaps too strong a word, it is apparent that correct positioning of the roller would be facilitated, but the specification as originally filed made clear that the purpose of the differential colouring was to prevent "inadvertent swapping of guide poles" which I take to mean the placing of the poles in the wrong holes in the base. I shall, therefore, for the purposes of the matters raised before me, read this claim as though the stated purpose was to facilitate the correct positioning of the poles in the base of the cassette and, if the application were to proceed, it would in my view be necessary to amend the claim in this respect. If the claim were to be read as it stands, it would not materially affect the reasoning or conclusions on the matters in issue which follow.

In other respects, Claims 5 and 6 are supported by the description and, in general terms, and subject to patentability criteria, are allowable.

In respect of the objection raised by the Examiner under Section 1(2)(d), Mr Bankes drew my attention to Rhodes' Application [1973] RPC 243 in which case the two judges constituting the Patents Appeal Tribunal, sitting in banc held that the application, which related to a speedometer with an additional scale indicating impact speed, constituted a manner of new manufacture and so fell within the definition of invention set out in Section 101 of the Patents Act, 1949. It does seem to me that, in some respects, the nature of the invention in the present case is similar to that in Rhodes' Application. Thus the cassette claimed is novel, and the novelty does not reside so much in the information presented as in the idea of presenting the information for some useful purpose (to put the matter in very broad terms). In the decision in Rhodes' Application, it is stated (at page 249) in respect of AEW's Application (1924) 41 RPC 529, which related to an odometer for a car having coloured figures to indicate when a service was due and which was refused:

> "It was an old instrument arranged to present alternative information which had never been presented upon such an instrument before".

And then (at page 250):

> "We venture to think that in fact the Odometer case was distinguishable in principle from W's Application to which we have already referred. It was accepted in W's Application that coloured buoys as an article of manufacture, were old and well known. We observe further that the Solicitor General was not referred, so far as appears from the report, to the decision which had been given in Cooper's Application to which we have already referred".

W's Application is reported at (1914) 31 RPC 141.

In Cooper's Application (1902) 19 RPC 53, the invention concerned the layout of printed matter on the page of a newspaper so as to enable the paper to be folded without producing a fold across some of the print. The decision in Rhodes' Application also refers to Fishburn's Application (1940) 57 RPC 245 in which tickets were printed to enable them to be torn in different ways without loss of information carried by one of the halves. In allowing that application to proceed Morton, J stated:

> "Thus the alleged invention is, in my view, designed to serve a mechanical purpose."

My attention was directed by the Examiner to Johnson's Application (1930) 47 RPC 361 in which the colouration, for identification purposes, of fertilizer was held not to be patentable. That case was not covered by the review in the Rhodes' Application decision and in my view it is less pertinent to the present case than are the cases referred to in that review. The invention was concerned with identification alone and did not serve any mechanical purpose.

All of the above cases were decided under legislation in which "invention" was defined by reference to the Statute of Monopolies. The Patents Act, 1977, under which the present case falls to be decided, sets out in the words of the consultative document, Patent Law Reform, "a general concept of patentability" which is "supplemented by a non-exhaustive list of exclusions". Thus, according to Section 1(1)(c), an invention must be capable of industrial application, and under Section 1(1)(d), the grant must not be excluded by, inter alia, subsection (2). I should emphasise that no objection has been raised under Section 1(1)(c) and indeed, in my view, the invention as disclosed is clearly one that is capable of industrial application. According to Section 1(2)(d), anything which consists of the presentation of information is not an invention but, as Mr Bankes pointed out, there is a proviso to Section 1(2) which reads:

> "but the foregoing provision shall prevent anything from being treated as as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such."

He suggested that the purpose of this proviso was to exclude from patentability only those inventions which were concerned solely with the presentation of information whereas in the present case the information, viz the differential colouring of the poles, was of assistance in facilitating the correct assembly of the cassette.

I pointed out that the present Claim 1 included a cassette having poles which had been differentially coloured subsequent to assembly, and that therefore, as all constructional features of the cassette itself were acknowledged to be conventional, the contribution made by the invention of that claim lay in the presence of information regarding the two poles, in the abstract as it were, that is to say without any particular function in relation to the assembly or use of the cassette. I suggested therefore that, to the extent that the claim included such a cassette, it was, under the provisions of Section 1(2)(d), not an invention for the purposes of the Patents Act, 1977. Claims 2 to 4 are no different in this respect. Mr Bankes then proposed the deletion of Claims 1 to 4. The additional claims, 5 and 6, are directed to the method of assembly making use of the differential colouring of the poles, and in my view the improvement over the prior art incorporated in these claims does not clearly relate to the presentation of information as such. Hence, bearing in mind the proviso to Section 1(2), to which I have referred above, I was not persuaded that the invention as presented in those claims was one which ought to be held at the application stage to be excluded by Section 1(2).

It was therefore necessary to consider the other objection which had been raised by the Examiner, that is the objection under Section 1(1)(b), viz, lack of inventive step. It was submitted by the Examiner firstly. that all of the constructional features of the cassette were acknowedged to be conventional; secondly, that given the desirability (for economic reasons) of using different poles. which might visually be difficult to distinguish, and the necessity (to avoid undue wear on the tape) of correctly positioning those poles in the cassette. the problem of how best to ensure their correct assembly was in no way unexpected; and thirdly, that the solution to that problem adopted by the applicants, that is the differential colouring of the poles, was an obvious one. Before the declared priority date of the application (9 September 1979), the use of colour for identification purposes in such cases as tickets, stamps and poisons was well known to everyone; and in many games, for example snooker, it was commonplace to use colour to characterise different pieces and to enable them to be correctly positioned on a table or board. Moreover, it was standard practice and known by all householders that, to facilitate the correct assembly of the leads of a three-core electrical cable in a three-pin plug or socket, those leads were differentially coloured. and such apparatus was sold with instructions explaining which coloured leads should be connected to which terminals of the apparatus. It was also well known that fuse-links for domestic electrical consumer units were colour-coded according to rating and that the sockets into which they were to be placed were correspondingly coloured

to facilitate their correct assembly. In the game of squash, balls having different physical properties (in particular different degrees of bounce) had for a long time borne spots of different colours so that suitable balls might be selected for play in accordance with the degree of experience of the player.

Mr Bankes did not deny these uses of colour to facilitate correct identification, selection, positioning or assembly but he emphasised that, small though the contribution to the art might be, the applicants' improvement did have surprisingly great economic value. He said that by using the method of the application the applicants have achieved a reduction in the reject rate for assembled cassettes of from 10 to 15% to almost zero. However, in my view, even if the consequence of the improvement. and there is little doubt that the new process does constitute an improvement, were beneficial on a surprising scale, the improvement itself was an obvious one to make in the light of such everyday procedures as those which have been referred to above as being within the common experience of us all, and the benefits to be obtained from its use were those one would expect. It follows from Section 3 that if the invention is obvious, not only to a person skilled in the art of assembly of such items as cassettes but to a person familiar with the everyday appurtenances of modern life, it lacks inventive step and consequently is not patentable under the provisions of Section 1(1)(b).

Although, at the hearing, I reserved my decision on the question whether Claim 5 involved an inventive step, I did ask Mr Bankes whether, should I find against the applicants on that ground, there was any feature disclosed in the specification which might introduce an inventive step into Claim 5. The only feature to emerge was the fact that the colour difference was useful at two stages of the assembly: firstly in associating the poles correctly with the holes in the base of the cassette and secondly in placing the roller on the correct pole. This is merely using the same type of procedure at two different stages in the assembly operation and cannot in my view introduce an inventive step. I myself can detect nothing in the specification which would introduce an inventive step into Claim 5 so that. not only do I find that Claim 6 also lacks inventive step but I find that there is no possibility of drafting a claim which would be supported by the description and which would involve an inventive step. I therefore refuse to allow the application to proceed to grant and find it unnecessary to offer an opportunity for amendment.

Dated this 9th day of May 1983

R E BRIDGES
Principal Examiner, acting for the Comptroller

PATENT OFFICE