

**PATENTS ACT 1977****IN THE MATTER OF Patent Application****No 86 26385 in the name of****Sylvester Kenneth Wardle****DECISION**

The application was filed on 5 November 1986 by the applicant without professional assistance and proceeded to substantive examination. There being no declaration of priority under Section 5(2), the normal 4 years 6 months period prescribed by Rule 34 within which the application should comply with the Act and Rules expired on 5 May 1991.

At the substantive examination stage, the examiner raised objections which the applicant contested but at the expiry of the Rule 34 period the objections were still outstanding.

The question of whether the application was in order at the expiry of the Rule 34 period was brought to a hearing before me on 5 September 1991 but the applicant did not attend. I shall therefore decide the matter on the basis of the documents at present on file.

The specification, under the title "Footpath and pavement cleaner", describes a vehicle for collecting dog excreta and has the following statement of claim:-

1. A two wheeled motorscooter with releasably secured generator vacuum system, waste box, water box, hoses and foot, flexible hoses so the operator by means of these hoses can suck up dog excreta to his right or to his left.
2. A two wheeled motorscooter as claimed in claim 1 to travel on footpaths, pavements, grass, shop doorways, base of trees, with the purpose of removing by sucking up, dog excreta by means of claim 1.
3. A three wheeled motorcycle with releasably secured generator vacuum system, waste box, water box, hoses and foot, flexible hoses so the operator by means of these hoses can suck up dog excreta to his right or to his left.

4. A three wheeled motorcycle as claimed in claim 3 to travel on footpaths, pavements, grass, shop doorways, base of trees with the purpose of removing by sucking up, dog excreta by means of claim 3.

5. A metal foot encased in rubber, which has inside it, a water nozzle, a metal grill which stops leaves going into the waste box while being used as in claim 1, claim 2, claim 3 and claim 4.

6. A footpath and pavement cleaner substantially as described herein with reference to FIGURES 1-3 of accompanying drawing.

In his first substantive examination report, dated 6 February 1990, the examiner raised a number of objections to the claims including the following objections of substance:-

1. The claims of the application do not relate to one invention or to a group of inventions so linked as to form a single inventive concept as required by section 14(5), the inventions claimed being:-

- i) a vehicle as claimed in claims 1-4 and 6,
- ii) a metal foot as claimed in claim 5

2. The invention, as far as its scope can at present be determined, is not new and/or does not involve an inventive step, as required by Section 1(1)(a) and (b), having regard to the matter contained in patent specifications:-

GB 1380006 (MOSSINSOHN)  
US 4426748 (DECANX)

The examiner also advised the applicant to consider employing the services of a patent agent on the ground that the proper drafting of claims to achieve a commercially useful patent requires a high level of expertise.

No response was received from the applicant until a further official letter warning of the imminent expiry of the Rule 34 period was issued on 19 February 1991. In his letter dated 4 March 1991, the applicant stated that he did not realise that he had any time left and queried whether he needed to employ a patent agent. The examiner, in a letter dated 5 April 1991, confirmed that employment of a patent agent was not compulsory

and reminded the applicant of the outstanding objections, the expiry of the Rule 34 period on 5 May 1991, and the procedure for extending the period by one month.

In his response dated 1 May 1991, the applicant rejected both citations on the grounds that his machine did not use bags and also that his machine was not a dry collector like GB 1380006. The applicant also proposed amendments to the description and claims consisting of additional features relating to the excreta collecting box breaking down solid excreta into liquid form to be discharged by a gravity system.

In a further letter dated 15 May 1991, the examiner drew attention to the expiry of the unextended Rule 34 period and the procedure for extending it if the application were to proceed further. He also explained why he considered the citations to be relevant despite the applicant's observations and reminded the applicant of the other outstanding requirements. The examiner also reported that the amendments proposed in the applicant's letter dated 1 May 1991 constituted added matter which was not allowable under Section 76 of the Act. In a reply dated 22 May 1991, the applicant stated that he disagreed with the examiner and did not know of anything else to do to change his findings.

Finally, an official letter dated 17 June 1991 informed the applicant that as the Rule 34 period had expired and the application still did not appear to comply with the requirements of the Act, the application would be treated as refused in accordance with Section 20(1) unless either observations were submitted demonstrating that the requirements had been complied with or the applicant requested a hearing. In response, in his letter dated 15 July 1991, the applicant restated his contention that his invention is distinguished from the prior art by not using bags, which need to be handled, but using chemical and water breakdown to discharge immediately to convenient places of disposal by mechanical or gravitational features. It is noted that chemical and water breakdown and the discharge features were not disclosed in the application as originally filed.

I must now decide whether the application was in order on 5 May 1991. The first outstanding objection relates to Section 14(5)(d) of the Act which reads:

The claim or claims shall relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.

Referring to the present claims, there are three independent claims, apart from the omnibus claim 6. Claims 1 and 3 relate to a two-wheeled vehicle and a three-wheeled vehicle, respectively, each equipped with the same cleaning apparatus and, in my view, can be regarded as relating to the same inventive concept. Claim 5, however, relates to a metal foot with various features which, in my view, are not sufficiently related to claims 1 and 3 to be considered as relating to the same inventive concept as those claims. I am therefore satisfied that the claims do not comply with Section 14(5)(d).

The second outstanding objection of substance is that the invention claimed in claims 1 and 3 is anticipated on novelty or obviousness grounds by the prior art disclosed in GB1380006 and US4426748 and therefore does not comply with Section 1(1) of the Act. Section 1(1)(a) and (b) reads as follows:-

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;

The GB document describes a motor bicycle or tricycle carrying a motor-driven vacuum pump connected through flexible hoses to articulated funnels which are movable to suck up dirt from the pavement on either side of the vehicle, the dirt being discharged into a container in the form of a bag. The US document discloses a motorcycle specifically for collecting dog excreta and provided with cleaning nozzles pivotable into an operative position beneath the motorcycle, a water -spraying arrangement in front of the nozzles and a collecting bag in a housing downstream of the nozzles.

In my view, the GB document discloses all of the features recited in claims 1 and 3, except the waste-collecting box and the water box, and the US document discloses a vehicle of similar type and use to that of the invention employing both a waste-collecting box and a water box, the waste collecting box being constituted by the housing surrounding the waste-receiving bag. Although the applicant contends that his invention is distinguished from the cited prior art by not using bags, in the general vacuum-cleaning art it is well known to use bags and rigid waste collecting containers for vacuum cleaners and therefore, in my view, using a box rather than a bag would not be considered to be inventive in the art.

In defining "inventive step", Section 3 of the Act reads:-

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).

Section 2(2) reads:-


The state of the art in the case of an invention 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 that invention 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.

In my view, a person skilled in the art would consider the step of employing the water supply arrangement of the US document in the machine of the GB document to be obvious and also the use of a waste-collecting box instead of a bag to be obvious in view of the disclosure in the US document and the general vacuum cleaning art. I am therefore satisfied that claims 1 and 3 lack an inventive step in the light of the prior art and thus the present application does not comply with Section 1(1)(b) of the Act.

In the result, I find that the application fails to comply with Sections 1(1)(b) and 14(5)(d) of the Act and, in view of the expiry of the Rule 34 period on 5 May 1991, should be treated as refused under Section 20(1) of the Act.

In accordance with the rules of the Supreme Court, Order 104, Rule 19(2)(a) any appeal must be lodged within six weeks of the date of this decision.

Dated this 1st day of October 1991

  
K C THOMAS  
Principal Examiner, acting for the Comptroller

THE PATENT OFFICE

