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PATENTS ACT 1977

IN THE MATTER OF Patent Application
No 8329999 in the name of
A B T Hardware Ltd

DECISION

The application was filed on 10 November 1983 in respect of an invention relating to a letterplate of the type intended to be secured over an aperture in a door, wall or panel, and was duly published on 12 June 1985 under Serial no. 2149452A.

In the course of the substantive examination proceedings, the examiner reported initially that the invention as claimed in Claim 1 at least was not new as required by Section 1(1)(a), and following amendment to meet that objection it was reported that the amended claim 1 did not define an inventive step as required by Section 1(1)(b). The applicants' agents contested the latter objection and since they were unable to satisfy the examiner that the objection was ill-founded they requested to be heard. The matter accordingly came before me at a hearing on 29 January 1987, when Mr D J Lucking appeared as agent for the applicants. The examiner, Mr M J Price, was also in attendance.

From the specification as filed, it seems that the applicants originally perceived as their invention the broad idea of substituting a magnet for a spring or a purely gravity bias in a letterplate to hold a flap in sealing engagement with a frame over an opening in the frame. Thus, the preamble of the specification refers to certain disadvantages of prior letterplates having sealing means on the frame and a flap subject to spring or gravity bias, and original claim 1 was directed as follows:

A letterplate comprising a frame, and a flap, the flap being hinged to the frame, the frame defining an opening through

which post can be inserted, the flap and the frame each having magnetic co-operating means which attract one another, to normally retain the flap in a closed condition, but permit opening of the flap for insertion of post, and sealing means being provided between the flap and the frame.

Such an arrangement was said to have been found to alleviate rattling and sealing problems inherent in prior letterplates, and also to reduce the risk of injury to a postman and damage to the post as compared to spring-biased letterplates.

According to the particular description at the date of filing, the "magnetic co-operating means" preferably comprised a proprietary brand of flexible magnet in the form of an elastomer loaded with ferrite powder, since this could constitute part of the required sealing means, but it was stated that any other type of magnet could be used as an alternative. In the illustrated embodiment, rubber or other resilient sealing members 31 are disposed on the frame in channels adjacent the top and the two sides of the opening 17 in the frame, and the preferred flexible magnet 34 is disposed along the bottom of the frame below the opening, being either bonded to the frame or held captive in a re-entrant channel. Since the flap 21 is typically of aluminium, it is provided with a steel strip 40 for co-operation with the magnet. In alternative embodiments, the magnet and the sealing members can be mounted on the flap as well as, or instead of, the frame.

In the first substantive examination report which issued in an official letter dated 20 June 1986, the examiner raised objection under Section 1(1)(a) on the grounds that claim 1 at least was anticipated by the disclosure of the three prior UK patent specifications previously brought to the applicants' attention on the search report issued on 29 October 1984. The applicants were further advised of two other prior UK patent specifications, namely 2094141A and 2041215A which disclosed letterplates with resilient sealing strips, and it was pointed out in effect that

these prior disclosures and the common prior practice of using magnetic seals for refrigerator doors and cat flaps constituted prior art which it would be relevant to take into account when determining whether any amendments to the claims introduced the required inventive step.

The applicants' response to the above objection, as communicated by their agents' letter dated 22 July 1986, was to restrict themselves to the use of their preferred magnet. Thus claim 1 was amended to read as follows:

A letterplate comprising a frame, and a flap, the flap being hinged to the frame, the frame defining an opening through which post can be inserted, the flap and the frame each having magnetic co-operating and sealing means, the magnetic co-operating and sealing means of the frame or the flap being a magnet comprising a resilient elastomer loaded with ferrite powder and permanently magnetised, and the magnetic co-operating and sealing means of the flap or the frame respectively, being an element of magnetic material, whereby the flap and the frame are attracted to one another to normally retain the flap in a closed and sealed condition, but permit opening of the flap for insertion of post.

Following re-examination of the amended application, and a supplementary search under Section 17(7), a second substantive examination report issued in an official letter dated 28 August 1986 in which the examiner raised objection to the amended claim 1 under Section 1(1)(b), arguing that no inventive step was involved in the choice of a well-known magnet to solve well-known and long-standing problems associated with letterplates. As support for the objection, the examiner referred to the applicants' acknowledgement that the specified magnet was a known commercial product, and to recommendations for its use in closing and sealing doors, such as refrigerator doors, as contained in another two cited UK patent specifications revealed by the supplementary search.

That objection was contested firstly in a letter from the applicants' agents dated 2 October 1986, and then in a further letter from the agents dated 2 December 1986, the examiner in the meantime having pursued the objection in a third substantive examination report which issued in an official letter dated 5 November 1986. The hearing was duly arranged in response to a precautionary request contained in the agents' letter dated 2 December 1986, which in the event did fail to satisfy the examiner that the requirements of Section 1(1)(b) had been met.

Having studied the correspondence mentioned above, and had the benefit of hearing Mr Lucking's further arguments on behalf of the applicants, it seems clear to me that the only question to be decided can be stated quite briefly: Was it obvious to a person skilled in the letterplate art at the date of filing the present application to propose the use in letterplates of a known magnet comprising a resilient elastomer loaded with ferrite powder and permanently magnetized?

As noted above, in pursuing the objection the examiner has relied largely on the disclosure of such magnets in two prior UK patent specifications, namely 1025616 and 875807, and on references therein to the magnets being suitable for use, inter alia, with doors, windows and other closure members by virtue of their holding and sealing qualities. In addition, however, the examiner has been influenced by the general availability of such magnets at the filing date, which seems to be uncontested, and their widespread use in everyday appliances such as refrigerators. In the view of the examiner, this suggests that a person skilled in the art of letterplates must be assumed to have been well aware of the magnets and readily capable of recognising the possibility of their application to letterplates. As reported in the official letter dated 5 November 1986, these factors were considered to distinguish the present case from Mutoh Industry Ltd's Application [1984] RPC 35, since in that case Mr Justice Whitford was convinced that it would not have

been obvious to a "drawing board man" out of his own background (emphasis added) that he would find the solution to his particular problem (of reducing frictional resistance to movement of a drawing apparatus) by consulting a "bearing man".

In the agents' letter dated 2 October 1986, it was observed briefly that the cited specifications contained no teaching to lead a person skilled in the art to use the magnet in question in a letterplate, and that the magnet would have been adopted for such use by now if it had indeed been obvious to do so since it had been found by the applicants to solve well-known and long-standing problems with letterplates. These arguments were reiterated in the agents' letter dated 2 December 1986 and by Mr Lucking at the hearing, and in Mr Lucking's view it was significant that on the evidence of the cited specifications the magnet had been known for well over 20 years and yet had not previously been proposed for use in letterplates. According to Mr Lucking, in spite of numerous prior proposals such as those cited by the examiner, magnetic letterplates relying on metal-to-metal contact had not been widely accepted due mainly to the limited life of the magnets used and to rusting problems, and so the applicants had in effect followed a distinctly unpromising path in their search for a new and useful letterplate. In the event, however, they had been rewarded when it transpired, somewhat surprisingly, that their preferred choice of magnet overcame the above problems and provided an effective seal.

In Mr Lucking's submission, the examiner's objection was based on ex post facto analysis, and it should be borne in mind that letterplates belong to a relatively "low-tech" art whereas the chosen magnet belonged to a relatively "high-tech" art, and it was not obvious to look to the latter for a solution to problems faced in the former. The circumstances of this case, in his view, were in fact analogous to those under consideration in the Mutoh case, and on the basis of the decision arrived at in that case there was no reason why a letterplate manufacturer or user should be expected to look for outside assistance, eg from a

person skilled in the art of magnets or refrigerator doors.

For my part, having given careful consideration to the decision reached in the Mutoh case, I am not persuaded that it is of any real assistance to the present applicants. In reaching his decision in that case, Mr Justice Whitford was influenced by the fact that there was no history of any specific problem which was inhibiting marketing or use of the apparatus under consideration and which would have led a manufacturer or user of that apparatus to look for outside assistance from some specialist to whom the solution would have been obvious. Moreover, in a passage relied on by the examiner in the third substantive examination report (as noted above), the judge also indicated that he was not satisfied that it would in fact have been obvious to the manufacturer or user to approach a particular specialist, for he was quite sure that it would not have been obvious to the manufacturer or user out of his own background that that is where he would find the solution to his problems. In the present case, however, on the applicants' own admission there were specific problems associated with prior magnetic letterplates which could arguably have led them to seek specialist advice, and the general availability and widespread use of the magnets in question might also reasonably be expected to have led the applicants naturally to consider their adoption in letterplates, with or without consultation of specialists. In the circumstances, therefore, I find myself in agreement with the examiner's contention that the present case is distinguished from the Mutoh case.

As to the question of whether the examiner in this case has based his objection on ex post facto analysis, whilst I fully appreciate that such a charge is indeed often well-founded, as when a seemingly logical explanation as to how an invention came about is constructed by abuse of the benefit of hindsight, I am also aware that the charge is one which is almost invariably relatively easy to make but rarely susceptible to being satisfactorily refuted on purely objective grounds. In the present case, the applicants have been particularly concerned to

argue that the disclosure in the cited prior specifications of the magnet adopted by them in no way suggests its application to letterplates, and that the failure of others to realize its potential in letterplates supports their view that there is a strong prima facie case for concluding that an inventive step was involved in that realisation. However, the examiner also relied on the fact that the applicants had adopted a magnet which on their own admission was available on the market, and they have not contested his suggestion to the effect that the magnet had in fact become generally available and been widely used in a variety of applications since its original disclosure. This leads me to the view that by the date of filing a situation had been reached where the magnet stood alongside other types of magnet in the market for consideration for a particular application according to its relative advantages, and to my mind a person setting out to design a magnetic letterplate could be expected to investigate what types of magnet were available and readily to appreciate the potential utility of the magnet in question, particularly in the light of a knowledge of the shortcomings of existing letterplates. I am therefore forced to the conclusion that the examiner's reasoning is not founded on ex post facto analysis, and that there is a valid objection to the amended application on the grounds that it fails to meet the requirements of Section 1(1)b). I am accordingly not prepared to allow the application to proceed to grant in its present form.

At the hearing, Mr Lucking did not attempt to argue that further amendment of the claim to incorporate some other feature(s) disclosed would overcome the objection. Nevertheless, I am prepared to consider any amendment which the applicants may wish to put forward with a view to meeting my finding, and I allow a period of one month from the date of this decision for the filing of any such amendment. Failing satisfactory amendment, the application will stand to be refused at the end of the period prescribed by Section 20(1) and Rule 34. In that connection, I should perhaps just add that having carefully reviewed the existing dependent claims, I consider it unlikely that I could be

persuaded that any of those claims defines an inventive step. Claim 3, which refers in broad terms to one or more resilient deformable sealing members, is the only dependent claim which seems to merit serious consideration, and in regard to that I would simply observe that at the hearing Mr Lucking conceded that it would be obvious to employ a bar magnet and sealing members in combination in a letterplate, and in my view it would be obvious to propose replacing the bar magnet in such a letterplate by a magnet as specified in claim 1.

Dated this 6th day of March 1987

M W HILLS

Principal Examiner, acting for the Comptroller

