

0/96/93

PATENTS ACT 1977

IN THE MATTER OF Patent Application

No 8828002 in the name of

James Ralph Slingo

DECISION

Mr Slingo filed his application on 30th November 1988 and has prosecuted it himself as it passed through the usual stages to that of substantive examination with the first report under section 18(3) being issued in an official letter dated 12th February 1992. This raised several objections, the more serious of which were (a) that the claims lack an inventive step over the game apparatus in GB505,365(Lee) contrary to the requirements of section 1(1)(b), (b) that it seemed that "any other claims that might be constructed from your description are or will be bad for obviousness", (c) that the description is unclear and (d) that formal drawings should be supplied. Several letters dealing with these objections were exchanged between the examiner and Mr Slingo, but Mr Slingo did not submit any amendments to the claims and the examiner maintained that objections (a) and (b) were still outstanding and so a hearing was appointed for 11th May 1993 to decide this matter. Mr Slingo indicated that he would not attend and this decision has been made on the basis of the papers already on file.

Before considering this matter I wish to set out the course of events leading to the appointment of a hearing as Mr Slingo appears to have misunderstood whether his application had been refused in two of the official letters.

The first report set out the objections and also gave a detailed rebuttal of a favourable analysis of the invention compared with the citation of GB505365(Lee) which Mr Slingo had obtained from a firm of patent agents, F J Cleveland & Co, and which he had filed with his

request for substantive examination on 15th May 1990.

Mr Slingo responded in a letter received on 8th April 1992 which did not propose any amendments but highlighted the differences between his invention and that of Lee and asked the examiner to reconsider the objections to the drawings. The letter also objected to "the decision not to grant a patent".

I have inspected the examiner's letter of 12th February 1992 and I am satisfied there is nothing therein to suggest a decision had been made to refuse to grant a patent. The examiner's second report in a letter dated 1st May 1992 stressed that a decision not to grant a patent had not been made and maintained the objections from the first report, putting forward a number of clarifying elaborations.

Mr Slingo did not respond and, as is normal practice, the Patent Office issued a standard letter on 13th March 1993 warning that, as no reply had been received, it was intended to treat the application as refused at the end of the period prescribed under rule 34, and added that any observations which might affect refusal should be submitted as soon as possible.

Mr Slingo replied in a letter dated 18th March 1993 stating that he had not responded (to the letter of 1st May 1992) because it "actually refused a patent on my horse racing game", and went on to emphasise the popularity of his game.

I am at a loss to understand why Mr Slingo should have thought his application had been refused when, as stated above, the letter of 1st May 1992 stressed that no decision had been made. None the less, the examiner gave Mr Slingo the benefit of any doubt and in a letter dated 31st March 1993, stressed firstly that no decision to refuse the application had been made and secondly that the objections raised in the official letter dated 12th February 1992 are still outstanding and explained that he could make suitable amendments to meet the objections, advance arguments to counter the objections or withdraw the application and that a hearing would be appointed in the event of an unsatisfactory response.

Mr Slingo's response in an undated letter received on 13th April 1993 consisted of a revised description, revised drawings and an offer to change the name of his game. But no amendments or arguments were submitted on the objections of lack of inventive step. It therefore appears that Mr Slingo is relying on his previous arguments and considers the claims to be allowable in their present form.

It was after this response that the hearing was appointed.

The invention concerns board game apparatus with a segmented track set out to represent a race course with certain segments being designated water jumps and others fences and is played with markers representing horses and riders, dice, play-money and odds cards. The water jump and fence segments are command squares some of which carry advantages and some penalties for a player who lands thereon. It has three claims as follows:

1)The racing game is a horse racing game designed to give enjoyment to the family.It is a board game with six named horses and colours for the riders.The horses race according to the amount of score by each player with a dice.Each player can choose the name of any horse they fancy in each race.There is fake money designed especially for the racing game for the purpose of betting on a horse just to add an extra interest for those who win.

2)The racing game as claimed in (1) wherein also has make-believe fences which can be an advantage or disadvantage to each player when trying to win the race.

3)The racing game substantially as described herein with reference to figures 1-5 of the accompanying drawings.

The chief difference between Mr Slingo's apparatus and the game apparatus in Lee is that the latter represents a flat race without water or fence jumps, but it does have segments designated as other forms of racing features which are command squares some of which carry advantages and some penalties for a player who lands on them. Lee also has six tracks,

fake money, betting and is played with dice.

But claim 1 does not specify that the apparatus includes jumps of any kind and, whilst it is not entirely clear, all of the technical features therein are to be found in Lee and I find that claim 1 is not novel as is required by section 1(1)(a).

Claim 2 is novel in that Lee does not disclose any fences. The claim does not set out a clear working relationship between the fences and the other features of the apparatus, but interpreting it in the light of the description, the fences are those segments of the track which are designated as fences and which function as command squares. These do not have any functional distinction over the command squares in Lee which designate advantages or penalties for other features of the track, e.g. for "soft going" and for "downhill". Thus claim 2 differs from Lee only in that the command squares in the former are designated "fences" and in the latter as other race features. This distinction is not of a technical nature and I therefore find that claim 2 lacks an inventive step contrary to the requirements of section 1(1)(b).

I have inspected the description to construe claim 3 and I am satisfied that the only other feature of note not provided in Lee is the provision of the water-jumps. but these again are command squares which carry a penalty if landed on and are functionally the same as command squares in Lee which also carry penalties.

I therefore find that claim 3 also lacks an inventive step contrary to the requirements of section 1(1)(b).

Mr Slingo has on several occasions pointed to the novelty and popularity of his game. The novelty, at least so far as the preferred embodiment is concerned, is not at issue but as I have indicated above, the features which distinguish Mr Slingo's invention from Lee do not provide an inventive step. Similarly arguments concerning popularity do not establish the game includes an inventive step.

Because of what I have said above concerning construing claim 3, it follows that I do not consider there is any prospect of an allowable claim being formulated which would include

an inventive step over Lee and I therefore refuse the application under section 18(3).

This being a substantive matter, any appeal should be lodged within 6 weeks of the date of this decision.

Dated this 27th day of May 1993

[Redacted signature]

T SAUL

Principal Examiner, acting for the Comptroller

