

01186197

Mrs Wilson
1R32

PATENTS ACT 1977

IN THE MATTER OF

Patent Application Number

9401937.9 in the name of

Mr Steven Kaye.

Prepared

DECISION

Mr Kaye filed his application on the 2nd February 1994 without the aid of professional assistance. In a letter dated the 10th March 1994, before a request for a preliminary examination and search had been filed, the Office wrote to Mr Kaye suggesting that the specification accompanying the application may not be sufficient because it did not disclose the invention in a manner which is clear enough and complete enough for it to be performed by a person skilled in the appropriate art, contrary to section 14(3) of the Patents Act 1977, and advising him to consider carefully whether he should file a fresh application with a fuller specification. Mr Kaye however continued with his original application unchanged, filing a Form 9/77 and later a Form 10/77 requesting substantive examination.

Mr Kaye was reminded of the possibility that his specification may not be sufficient within the terms of section 14(3) in a number of official letters but continued with his application in its original form. Subsequently, when the examiner issued his substantive examination report on the 25th April 1997, he objected formally that the specification was insufficient. In that report the examiner also objected that the claims were not clear and were not in an appropriate form, and that the invention, so far as this could be determined, was not new as is required by section 1(1)(a) of The Act in the light of two British patent specifications. Mr Kaye disputed these objections which were not resolved by further correspondence. Mr Kaye has not proposed any amendments to his specification and maintained his view throughout that he was entitled to a patent on the basis of the application as it stood. The matter therefore came before me at a hearing on the 15th October 1997 which was attended by Mr Kaye.

Mr Kaye's specification is entitled "Box AB" and relates to a box which is said to translate the

spoken word, either live or as recorded on tape, into computer code which can be word-processed. The user may identify the format he wants by stating the type of document, for example a poem or a court report. There are also references, though only on the page headed "Claims", to the box being used in connection with music. The box is shown in the only Figure and is the size of a pocket calculator with an input at the top, an output at the bottom, and two buttons, A and B. There is no technical description of what is inside the box which might cause it to perform the required functions, and there is no real description of the functions of the buttons A and B which in the original abstract were simply associated with the words "direction" and "content" respectively.

The page of Mr Kaye's specification headed "Claims" reads as follows :

1. - A Box AB the size of a pocket calculator that has the facility to translate spoken word into computer instructions and then to play cassette tape poss fast forward translating into computer talk to computer/word processor for immediate text writing and printing.

Although - word to printed page is its job - a myriad of uses could be employed from the moment of inspiration - recorded on ordinary portable cassette recorder through the Box AB fast forward - into whatever possibilities are tapping into the world of that particular computer packages,

Other uses

Music - Original and other printed in manuscript - orchestrations arrangements - simple melody - words - chords - musicians wishing to display computer images with music possibly transferred to video.

In every field there are possible uses through existing computer technology. All that is needed is the moment of the idea - in this case recorded - translated and produced.

At the hearing I tried to explain the nature of the objections which the examiner had raised, pointing out that it was not in fact at all clear precisely what Mr Kaye considered his invention to be. The result of this uncertainty was that it was difficult to decide whether the invention had been sufficiently described, and that it was difficult to compare the invention with the prior art which had been cited by the examiner. Consequently, in an attempt to set the objections in their proper context, I asked Mr Kaye to identify what he considered his invention was, and in particular what distinguished it from the prior art and the specifications which the examiner had cited.

The first of these specifications is GB 2149172A which describes an apparatus providing a speech recognition facility for a computer in which a digitised audio input from a microphone is compared with data held in a speech store to determine what word or phrase has been spoken. On the basis of this comparison a character string previously entered from the keyboard into a store is selected and fed to the computer. The second specification is GB 2082820A which shows, in Figure 2, a box which translates words dictated into a microphone into binary digital data which are displayed on the video screen of a word processor. In one embodiment, a tape recorder is interposed between the microphone and the translation box.

Thus, each of these specifications provides a "box" which converts spoken words into computer-code which can be word processed, exactly as does Mr Kaye's box. When I asked Mr Kaye to say where his arrangement differed from those in the cited specifications, he pointed out that GB 2149172A did not involve a tape recorder and argued that GB 2082820A did not supply data to a "computer". Having considered this, I accept Mr Kaye's argument in relation to GB 2149172A, but not in relation to GB 2082820A. In the latter respect, I pointed at the hearing to page 3 of the cited specification which specifically states that the information goes to a word processor, *eg* for editing. Though when I pressed him Mr Kaye stoutly maintained that there is a difference between a computer and a word processor I have to say that I do not accept this. Indeed, I note from Mr Kaye's specification itself, as quoted above, that he refers to sending the data to a "computer/word processor for immediate text writing and printing". This to my mind underlines the point that a word processor is simply a particular form of computer and that therefore, there is in substance no difference between what is disclosed in GB 2082820A and what Mr Kaye considers is his invention.

In relation to this, I also observed at the hearing that even if I were to accept Mr Kaye's view that there is a distinction between his invention and what is disclosed in GB 2082820A, which I do not, it would still not follow that Mr Kaye is entitled to a patent because to be patentable an invention must involve an inventive step over and above the prior art, as required by section 1(1)(b) of The Act. Consequently, as I put it to Mr Kaye, for him to be entitled to a patent not only did there have to be a difference between his invention and the prior art but that difference had to be an inventive difference. Mr Kaye seemed to have great difficulty in accepting this at the hearing. He seemed to believe that if there were any distinction between his invention and any single prior document, that must mean that he was entitled to a patent. If I understood him correctly, his reasoning was that because the description of an invention had to be sufficient, it had, by definition, to be complete and to include, as it were, everything. So, if someone else then came along with an additional feature which had not been included, that feature would necessarily justify the grant of a patent. He therefore argued that since he had described an additional feature over and above each of the prior art specification, he was entitled to a patent. I tried to explain to Mr Kaye that this was not correct but since, for the reasons set out above, I do not accept that Mr Kaye's invention includes an additional feature, I need not go into this further.

This does however bring me to the issue of whether or not Mr Kaye's description is sufficient. Again this was a concept that Mr Kaye seemed to have some difficulty with but as I said at the hearing, I cannot do better than to repeat the words of the statute, specifically section 14(3), which to my mind states the requirement quite clearly. Section 14(3) states that :

The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

This is the test to apply and Mr Kaye continued to assert that his description was sufficient. To back this up he stated that when he had shown his idea to a potential manufacturer there had been no difficulty and the manufacturer had understood exactly what was required. That however begs the question because whether an invention is sufficiently described depends upon what the invention in question is. To the extent that Mr Kaye's invention is simply a box which will translate speech, either from tape or live, into computer code, I would accept his view that his description is indeed

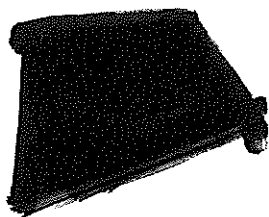
sufficient to enable someone skilled in the art to produce it. The problem with that though is that, for the reasons I have given above, if the invention is simply a box which will translate speech, either from tape or live, into computer code, it is not new and therefore Mr Kaye is not entitled to a patent for the invention for that reason.

As to whether Mr Kaye's invention may comprise something further, having very carefully considered his specification in its entirety, I do not believe that there is a sufficient description of anything else which would provide the required novelty and inventive step. As I said above, there is absolutely no technical description as to how Mr Kaye's box functions and, for example, there is certainly no description of any sort as to how the box might handle music. The result in effect is that the description which Mr Kaye has provided can only be sufficient if what he has invented is no more than is already known, in which case his application must fail for lack of novelty. On the other hand, if Mr Kaye claims to have invented something which is new, then his description is insufficient and his application must fail for that reason.

It follows from the above that I must hereby refuse to accept Mr Kaye's application under section 18(3).

As this is a substantive matter any appeal against this decision must be lodged with the Patents Court within six weeks of the date of this decision, as set out below.

Dated this 20th day of October 1997.



D M HASELDEN

Principal Examiner, acting for the Comptroller.

THE PATENT OFFICE

