

PATENTS ACT 1949

015/94

IN THE MATTER OF an application under
Section 33 by John Reid Valentine for the
revocation of Patent No 1604651 in the
names of Antony Fenwick-Wilson and
Thomas Henry Algernon Llewellyn

FINAL DECISION

Mr John Reid Valentine applied on 21 August 1990 for the revocation of patent no 1604651 on the grounds that the invention claimed in it is not new and does not involve an inventive step, principally having regard to the disclosure of his own patent no 1072970.

Following a preliminary hearing to consider the registered proprietor's request that the application be struck out I held, in a written Interim Preliminary Decision dated 12 November 1991, that Mr Valentine's objection of lack of novelty was clearly unsustainable. I also held that, without prejudice to my eventual conclusion on obviousness, the objection of lack of inventive step was not clearly unsustainable, and hence that the application for revocation should not as a whole be struck out on the grounds of no case or of being "frivolous, vexatious or blackmailing". As to Mr Valentine's status as a "person interested", a necessary qualification to submit a valid application for revocation under the 1949 Act, I allowed Mr Valentine an opportunity to file further evidence on this question before I finally determined it. An appeal by Mr Valentine against my Interim Preliminary Decision was dismissed by Mr Justice Aldous on 30 March 1992.

In correspondence it was agreed that I should reach a decision as to Mr Valentine's status as a "person interested" on the basis of the papers on file, which by then included further evidence that Mr Valentine had filed. In a written Preliminary Decision dated 19 October 1992 I found that Mr Valentine had discharged the onus on him to demonstrate that he is a "person interested" within the meaning of section 33(1). Coupled to the earlier findings in my Interim Preliminary Decision, I held that the entire application for revocation

should not be struck out as requested by the registered proprietor. Also, since I had previously found that Mr Valentine's allegation of lack of novelty was clearly unsustainable, I ordered that the application for revocation should proceed only on the ground of alleged lack of inventive step.

In my Preliminary Decision I gave orders for the resumption of the timetable for filing evidence originally laid down for these proceedings in accordance with rule 42 of the Patents Rules 1968, adding that no further evidence beyond that should be filed by either party except by my leave and direction, acting for the Comptroller. However, in a letter dated 16 January 1993 Mr Valentine asked leave of the Comptroller under rule 43 of the Patents Rules 1968 to file such further evidence. As was reported in an official letter of reply of 12 February 1993, I noted that the usual timetable for filing evidence in this case was somewhat disjointed by the preliminary proceedings. I also noted that, as a consequence of the necessity at earlier stages in these proceedings to restrict the evidence to that relevant to preliminary matters, Mr Valentine may not have had the fullest opportunity to file evidence on the substantive matter in issue. The official letter went on to say that I was therefore minded to grant Mr Valentine the leave he requested and laid down directions for a timetable for the filing of further evidence. No objection was made to this procedure by the registered proprietor, and Mr Valentine filed a statutory declaration dated 24 February 1993.

In further correspondence it was proposed by the Office that, subject to comments from the parties, an oral hearing should not be appointed and that I should reach a decision on the application for revocation on the basis of the papers on file. In the absence of a reply from either party, I shall now proceed to do that.

Mr Valentine's case is set out in a statement with documents attached, filed on 21 August 1990, and also in what has been treated as a supplementary statement (headed "Attitudes") filed on 7 September 1990. His evidence comprises statutory declarations sworn by him dated 16 February, 15 May, 20 May, 28 May and 18 November 1991, 6 April 1992, and 24 February 1993. The registered proprietor has filed no evidence at any stage in these proceedings. Since the sole remaining ground in this action is lack of inventive step, it follows that any evidence not on that subject is inadmissible. In other words, I have been

able only to take account of those parts of Mr Valentine's evidence relevant to the issue of lack of inventive step. However, I do not believe it would be practicable for me to list precisely which of the documents in evidence are, in whole or in part, concerned with inventive step. Suffice it to say that I have, in seeking to give full weight to Mr Valentine's objections, adopted a generous interpretation of what might be admitted. It will be apparent from the lengthy list above of Mr Valentine's evidence that the Patent Office has been lenient in permitting him to file numerous separate items, in recognition *inter alia* of the difficulties he has faced in prosecuting these proceedings himself. Now, however, it is necessary for me to be rigorous in the view I take of the evidence. I note that the absence of evidence or specific argument from the registered proprietor means that wherever Mr Valentine has filed evidence of fact that is in itself sufficient to support the fact alleged, that evidence has not been challenged by the registered proprietor and will therefore be taken to establish the fact.

In coming to my decision I have also borne in mind comments in the way of argument made in correspondence touching on the question of obviousness. I have also taken due note of arguments on that point which emerged at the oral hearing.

The patent in suit was published on 16 December 1981 and is based on a complete specification filed on 10 March 1978, deriving priority from an application filed on 13 December 1976. The patent ceased on 10 March 1992 for non-payment of renewal fee and is no longer in force. However, as I noted in my Preliminary Decision, this does not itself dispose of the revocation action, since ceasing for non-payment of renewal fees operates only with effect from the date of lapsing whereas an order for revocation has retrospective effect over the entire life of the patent. A successful revocation action is thus still possible in relation to the period prior to the date when the patent ceased to be in force.

The patent in suit relates to coupons for use in games and competitions, in particular the well-known game or competition known generally as "Spot-the-Ball". Paraphrasing the explanation given in the specification, a "Spot-the-Ball" competition generally involves participants marking with a cross on a photograph or picture the exact position they judge to correspond with the centre of a ball made invisible by retouching. The specification makes it clear that while such competitions can be based on pictures of ball games such as

football, golf, basketball or baseball, the expression "Spot-the-Ball" is also intended in the specification to include games based, for example, on maps of areas in which treasure is supposedly buried or minerals may be found.

The specification also says that judging the winning entry in a "Spot-the-Ball" competition having a large number of entries is difficult because the cross markings have a finite size. In one form, the present invention is said to provide an improved "Spot-the-Ball" competition in which the winning entry can be more readily judged than in the form described earlier.

Claim 1 of the patent in suit is the only independent claim apart from two omnibus claims. It reads:

"An entry and checking coupon for a Spot-the-Ball competition, the coupon including a first area having a graphic representation printed thereon and divided into a plurality of zones each containing a part of the representation, a region for a player to indicate the identity of a zone selected as containing the centre of an object to be located, and a checking portion for the player to record the identity of the selected zone for checking purposes."

In one embodiment, shown in figure 1, a coupon comprises two identical sets of six photographs from each of which the ball has been eliminated. Each photograph is divided into twenty zones by a rectangular grid printed over it. An entry in the competition is recorded by making a manuscript cross in each selected zone of each photograph of one of the sets. This set is detached and becomes an entry coupon. The other set, which is retained by the entrant, is marked in exactly the same way as the first, and constitutes a checking table. In a second embodiment, shown in figure 2, a coupon has six different photographs each divided into twenty zones by an overprinted rectangular grid. The zones are labelled by identifying letters and numbers. Alongside the photographs are a checking table and an entry table, into each of which entries to the competition are recorded.

In the body of the specification, in a paragraph commencing at line 73 of page 1, there appears to be described a form of the invention that differs from either of the two

embodiments illustrated in the drawings. In this form "only a first of the areas contain [sic] a photograph of a football scene. The other areas are blank, save for the grid and each succeeding area represents the selected zone of the preceding area enlarged and divided in turn into a plurality of zones. ... in this form, the final zone selected represents a real life area of the original scene that may be larger than that of the real life football, the centre of which is to be determined." In his declaration of 24 February 1993 Mr Valentine appears to have interpreted this as meaning that in all but the first area the competitor does no more than simply guess numbers. My own reading of this form of the game, however, is that the second and subsequent areas represent enlargements of the zone from the main picture selected by the competitor, and permit refinement of the selected area.

It is stated in the specification that the invention provides a coupon for a "Spot-the-Ball" competition in which the winning entry can be judged unambiguously because each selection is made by indicating a particular selected zone, the exact position within the zone not being of interest.

Mr Valentine's case seems in essence to be that the basic principle of the invention of the patent in suit was previously disclosed in his patent no 1072970 ("970"), and that any further features of that invention are obvious developments, that is their addition to the matter disclosed in 970 required no inventive step. In the counterstatement it is *inter alia* denied, without elaboration of this point, that the invention as claimed in each and every claim of the patent in suit is obvious. For the avoidance of doubt I must make it clear that, although Mr Valentine's arguments include several references to copyright and to particular sections of the Copyright, Designs and Patents Act 1988 relating to infringement of copyright, I have no jurisdiction in these proceedings other than in relation to section 33 of The Patents Act 1949, and must limit my considerations to the question of the obviousness or otherwise of the patent in suit. Similarly, and again in order that there be no misunderstanding, I would make it clear that I am not empowered to consider any question of possible infringement of Mr Valentine's patent 970, now long-since expired. Furthermore, since these proceedings are directed solely to revocation under section 33, I have taken no account in this decision of comments appearing at several places in Mr Valentine's arguments in relation to the registered proprietors.

Under section 33 of the 1949 Act as amended by paragraph 7 of Schedule 1 of The Patents Act 1977 Mr Valentine has to establish, in order to persuade me to revoke the patent in suit, that the invention, so far as claimed in any claim of the complete specification, is obvious and does not involve any inventive step having regard to what was known or used, before the priority date of the claim, in the United Kingdom. In the well-known case of Windsurfing International Inc v Tabur Marine (GB) Ltd [1985] RPC 59 the Court of Appeal has conveniently identified four steps that I must go through in determining this matter. The first is identifying the inventive concept embodied in the patent. The second is imputing to a normally skilled but unimaginative addressee what was common knowledge in the art at the priority date. The third is identifying the differences if any between the matter cited and the alleged invention. The fourth is deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps which would have been obvious to the skilled man or whether they required any degree of invention.

The inventive concept of the patent in suit may be identified from claim 1 with reference to the description of the specification. Claim 1 can conveniently be characterised, in my judgement, as comprising:

- (i) an entry and checking coupon for a "Spot-the-Ball" competition;
 - (ii) the coupon comprising a first area having printed on it a graphic representation divided into a plurality of zones each containing a part of the representation;
 - (iii) a region for the player to indicate the identity of a zone selected as containing the centre of an object to be located;
- and (iv) a checking portion for the player to record the identity of a selected zone for checking purposes.

Feature (i) makes two things clear. Firstly, it establishes that the invention comprises "a coupon for a ... competition", and I construe that as a coupon per se suitable for use with the particular type of game. Secondly, it requires the coupon to serve both entry and checking roles. The checking role is plainly served by the checking portion of feature (iv), and in my view it is equally plain on a straightforward reading of the claim that the entry

role is intended to be served by feature (iii), which thus might be said to provide an entry portion. In the figure 2 embodiment there is, separate from these two portions, a set of photographs overprinted with grids, and this plainly constitutes the first area of feature (ii). However, in the figure 1 embodiment the area carrying the graphical representation is not distinct from the entry and/or checking portions. Thus I find that it is necessary to construe claim 1 in such a way that feature (ii) either may be provided as a portion of the coupon distinct from the entry and checking portions of features (iii) and (iv) - it might be termed a representation portion - or that it may coincide with one or both of features (iii) and (iv), in which case the coupon will in essence contain only two portions, at least one of which serves both representation and entry or checking functions. It is also necessary to construe claim 1 in such a way as to include the form described on page 1 of the specification but not illustrated in the drawings. This I see effectively as a development of the embodiments of either figure 1 or figure 2, but with additional grids enabling the competitor to define more closely the area he has selected from the picture. As I read this form of the invention, the need for distinct entry and checking portions remains, and I see no inconsistency between this form and the invention as claimed in claim 1.

Since it affects the construction I place upon the invention it is convenient to deal at this point with an argument that Mr Valentine made at various stages during the proceedings, namely that the term "Spot-the-Ball" is inappropriate to describe the type of game disclosed in the patent in suit. In my Interim Preliminary Decision I remarked that the specification of the patent in suit leaves me in no doubt as to the broad category of games to which it intends the term "Spot-the-Ball" to apply, notwithstanding Mr Valentine's view, expressed in correspondence and at the preliminary hearing, that the term is inappropriate. Mr Valentine has since presented this point in more detail and I consider it appropriate that I should deal with it a little more fully in these substantive proceedings.

As contained in his declaration of 24 February 1993, and less directly in his declaration of 18 November 1991, Mr Valentine's argument appears to be that in a true "Spot-the-Ball" game the precise location of the exact centre of the erased ball needs to be found in order to win. By contrast, in the game of the patent in suit the exact location is not of interest, as is clearly stated in the specification, and hence he argues that this game is not properly one

of "Spot-the-Ball". Whilst I recognise that the most common form of "Spot-the-Ball" game is possibly one in which pin-pointing the precise centre of an erased ball is required to win, I have not seen evidence which convinces me that this need be essential, and the specification of the patent in suit leaves no doubt as to the type of game to which it is directed. I therefore consider that the usage of the term in the patent in suit introduces no material uncertainty as to the meaning of the specification as a whole or the scope and interpretation of its claims.

This completes the identification of the inventive concept of the patent in suit, which forms the first Windsurfing step.

The second Windsurfing step requires me to identify what would be the common general knowledge at the priority date of the patent in suit, December 1976, of the skilled but essentially unimaginative person in the relevant art. This brings me to a consideration of Mr Valentine's own patent 970. It is clearly Mr Valentine's contention that this would have been known to the notional skilled man at the relevant time, but Reddie & Grose, acting for the registered proprietor, stated in a letter of 11 January 1991 to Mr Valentine attached to an unsworn document of Mr Valentine's dated 19 January 1991 that their clients knew of neither 970 nor the game described in it when they devised their "Skilball" competition. "Skilball" is apparently the name under which the competition of the patent in suit has been marketed. Mr Valentine's response to this was to state, in his declaration of 16 February 1991, that this was "their problem", and that "it is the patentee's responsibility to ensure that a complete search is carried out". In a letter to the Patent Office dated 13 May 1991 Reddie & Grose argued that 970 is not relevant to the patent in suit because it relates to a different game. To resolve this I need to consider the contents of 970.

970 was published on 21 June 1967, well before the priority date of the patent in suit, and relates to apparatus for playing a game. The complete specification is very short, and it is most convenient to reproduce it here in full.

"This invention relates to apparatus for playing a game.

Equipment: The game consists of a set of pictures prepared as follows:

(a) Each picture is divided into areas which are individually distinguished for reference purposes.

(b) One or more small parts of each picture is reproduced.

The best method of performing the game is with large numbers of players such as newspaper readers, pools or bookmaker's clients, cinema or television viewers. This permits full advantage to be made of the fact that by a combination of pictures and areas many possible answers can result.

Thus large numbers of players can take part in the same game without necessarily being present together yet all are in a position to know precisely the accuracy of their own answers when the result of the game is declared.

Pictures accordingly may be printed in newspapers or on forms or projected on cinema or television screens and at the same time divided into reference areas.

Any number of pictures can be in a set. The pictures can be divided into any number of reference areas. Any number of players can play in the game.

The object of the game is to examine each picture and decide in which area of the picture the reproduced part was.

The player with the most correct answer wins."

970 claims in its only claim:

"Apparatus for playing a game consisting of

- (1) pictures prepared by dividing into reference areas and
- (2) reproductions of small parts of the original pictures substantially as herein disclosed."

I note that Mr Valentine has made several critical comments about what he regards as the "verbosity" of the specification of the patent in suit, but I must observe that, by comparison, the useful disclosure of his own specification 970, upon which he is now mainly relying and from which he is asking me to draw sufficient material to form a basis for revoking the patent in suit, is so abbreviated as to make confident interpretation of exactly what it teaches very difficult. I shall, nevertheless, do what I can with the material he has provided.

In correspondence Reddie & Grose characterised Mr Valentine's game as described in 970 as being "concerned with matching fragments of a picture in the manner of identifying pieces of a jigsaw". At the preliminary hearing Mr Valentine appeared to dispute the appropriateness of this analogy. He focussed my attention on the word "was" in the penultimate sentence of the body of the specification of 970, arguing that the use of the past tense implies that the reproduced part of the picture was no longer present in the picture itself, the promoter of the competition having removed it.

I note that 970 itself provides the only account of Mr Valentine's game apparatus which, on the evidence placed before me, was available at the priority date of the patent in suit, December 1976. I must comment that, although I find interesting Mr Valentine's explanation of his game and of how he intended that 970 should be interpreted, in considering whether the invention of the patent in suit is obvious I can only take account of the document 970 itself, and of how the normal, intelligent, informed reader would have understood it in December 1976. I am satisfied that it would not be correct of me to take significant account of a later explanation of the document if this differs from the straightforward reading of the document itself.

It seems to me that a careful reader of 970 who had not had the benefit of hearing Mr Valentine's own more recent explanation would have been in some doubt as to whether the "reproduced part" of the picture continued to be visible in the main picture, or whether it had been erased. On balance though, and partly on the strength of the way I had myself interpreted the document before Mr Valentine presented his alternative to me, I am inclined to the view that the natural meaning is that the reproduced part remains visible in the main picture. I think that there are two main factors pointing towards this interpretation. First, the use of the word "reproduction", with its connotation of copying, itself seems very strongly to suggest that the original still exists. Second, I believe that had the intention been to erase the part in question from the original picture the reader would have expected to see this explicitly stated. In the absence of such a statement I consider that the natural conclusion is that the part remains visible in the original picture as well as in the "reproduced part". Against this, I do not find that the use of the word "was" in the context described by Mr Valentine would have been likely to have persuaded the reader that the opposite meaning

was intended. Had "was" been replaced by "had been" then I might have reached a different conclusion, but I am required to construe the document as it is (and was), not as it might have been. I have been presented with no direct evidence of how the person skilled in the art would have interpreted 970 in December 1976, and in the absence of this I incline to the view that what I have, on balance, regarded as the natural reading is the one which would have prevailed at that time. I say this in full recognition of the fact that Mr Valentine's intention in drafting the specification may have been otherwise, but this merely underlines my earlier comment about the adequacy of 970 as useful disclosure.

On this reading the game to which 970 relates seems to me to differ from "Spot-the-Ball" games to the extent that there is no erased or hidden feature in the picture over which the reference grid has been superimposed. The competitor does not, on this understanding of the 970 game, have to exercise his skill or guesswork to decide where the erased or hidden feature should be located, as is the case in "Spot-the-Ball". Rather he has to find where on the gridded picture the small part of that picture that has been reproduced elsewhere actually belongs. Once he has identified the correct location he will, apparently, on the basis of the disclosure of 970, and unlike the competitor in "Spot-the-Ball", be able to confirm the correctness of his choice by directly comparing the reproduced area with the corresponding part of the main picture. On this basis I am forced to conclude that Mr Valentine's game, as described in 970, the document he principally relies upon for his obviousness objection, differs from the generality of "Spot-the-Ball" games, including that claimed in the patent in suit. Of course, if I am wrong in this conclusion as to how 970 would have been understood in December 1976, and if Mr Valentine's explanation given at the preliminary hearing in fact represents how the document would have been interpreted, then the similarity between Mr Valentine's game and that of the patent in suit becomes clear.

In my Interim Preliminary Decision I described the common technical field in which both 970 and the patent in suit lay as being that of mass-participation gambling games, and, following the more complete analysis that I have now undertaken, I still regard that as an appropriate definition of the relevant art within which the notional skilled but unimaginative person can be regarded as operating. It includes "Spot-the Ball" and similar competitions, but probably also extends for example to football pools and the like. It seems to me that this

effectively defines a sector within which all organisations are in mutual competition, and would thus need to be fully alert to the activities of rivals. A notional skilled but unimaginative person in this art would, in my view, have been familiar with all competitions of this type which were offered to the public at that time or previously, and would also have been expected to be aware of whatever literature was generally available on the subject, including patent literature. I am entirely satisfied that the game described in 970 falls within this general field, whether it is interpreted in the way that I have concluded is correctly based upon the natural meaning of the words, or in accordance with Mr Valentine's explanation. It follows, therefore, notwithstanding that it has been said on behalf of the registered proprietor, albeit not under oath, that the devisers of "Skilball" were not aware of 970, that I am satisfied that this document would be one of those which the notional person I have identified would have been expected to know of at the relevant time.

To complete the second step required by Windsurfing I have to identify what other material Mr Valentine has succeeded in establishing as being within the common general knowledge of the notional skilled man whom I have described earlier at the priority date of the patent in suit, namely December 1976. I have emphasised this date because Mr Valentine made reference in his many declarations to a number of competitions offered to the public, but for most of them he has provided no evidence to suggest that they were available to the public as early as December 1976, and therefore that they would have been known at that time to the notional skilled man. I do not propose to make any further reference to such competitions since they are of no relevance to the sole consideration now before me, namely whether the invention of the patent in suit is obvious.

The only published game in relation to which Mr Valentine provides evidence that it was available as early as 1976 is a Littlewoods' game called "Trap-the-Ball". In his declaration of 18 November 1991 he refers to an exhibited letter from Vernons Pools which he asserts is independent unsolicited evidence that Littlewoods' "Trap-the-Ball" operated commercially in 1969. He contends that analysis of that letter reveals the expert view that his game (of 970), Littlewoods' game and "Skilball" are the same. In his declaration of 24 February 1993 he again refers to the Vernons Pools' letter.

That letter is dated 21 May 1990 and includes the following passage:

"The type of Spotting the Ball competition which you advocate is not one which is new to us, indeed Littlewoods Pools operated a "Trap the Ball" back in the late 1960's whereby clients required to forecast a number of matches and they did of course have a definitive correct solutions [sic]. You will also note that a new competition has commenced entitled Skilball and this operates the same type of scheme under discussion".

First, I would observe that the letter itself is not a sworn statement by its writer and hence is not admissible as evidence about the "Trap-the-Ball" game. However, even if I were to overlook that fact, I have to say that its evidential value is low, as it does not go into any detail about the games involved. It would not be uncommon for several games to be spoken of as being the same or similar, but which in fact might have significant detailed differences. I do not consider this letter to be of any practical help in determining the matter of the obviousness of the invention of the patent in suit.

In his declaration of 18 November 1991 Mr Valentine says that Littlewoods promoted their "Trap-the Ball" competition in the national press. In his declaration of 6 April 1992 he refers to an exhibited photocopy of an extract from *The Sunday Post* of 20 July 1969, which included, in an item reporting on the likely outcome of various football pools competitions, the following words: "Correct solution to Littlewoods Trap-the-Ball No.15 - A.21, B.24, C.1, D.21 and E.14". He says that this commercial promotion was seven years before the patent in suit was applied for. In his declaration of 24 February 1993 he refers again in similar terms to the same extract and adds that Littlewoods' "Trap-the-Ball" competition used a coupon in its commercial promotion. In his declaration of 16 February 1991 he says that Littlewoods' "Trap-the-Ball" consisted of five pictures divided into reference areas. This brief description of the "Trap-the-Ball" game has not been challenged by the registered proprietor of the patent in suit, and I note that it is consistent with the format in which the results were reported. I can therefore conclude that it is a factual account. However, I would emphasise that Mr Valentine has provided no evidence either as to the nature of the game beyond the fact that it comprises five pictures divided into reference areas, or as to

the coupon which he states was used. That is particularly critical, since the invention in the patent in suit is actually the coupon.

On several occasions Mr Valentine has asked the Patent Office to approach Littlewoods for full details of their "Trap-the-Ball" competition. However, I must emphasise that the onus for establishing grounds for revocation lies with the applicant for revocation, and it is not the role of the Patent Office to make the applicant's case for him by seeking evidence in addition to that submitted by the applicant. That can be no different simply because the applicant for revocation represents himself in proceedings before the Comptroller, and consequently does not have the advantage of legal advice. In my Interim Preliminary Decision I drew Mr Valentine's attention to the benefit to be obtained from having professional legal advice and representation, and the great difficulty that may exist in making one's best case without it in a complex field of law. Mr Justice Aldous echoed these sentiments at the appeal hearing. It is perhaps particularly in procedural matters, including the filing of evidence, where the layman is likely to encounter such difficulties. Mr Valentine had it in his own powers to approach Littlewoods for details of "Trap-the-Ball", or alternatively to examine newspaper archives to find a cutting which more clearly indicated the nature of the game and its coupon. He was, after all, able to submit a cutting from the relevant period which reported the result of one of the competitions.

In his declaration of 18 November 1991 Mr Valentine states, in the context of newspaper layout, that "newspapers have for years ran [sic] a multitude of different games with entry forms", but he has provided me with no evidence of any such competitions that would assist me in reaching a conclusion as to the obviousness of the invention of the patent in suit. He has also exhibited a selection of bookmakers' entry coupons, with comments as their content, but the only one of these coupons bearing a clear and full date was published in 1992, long after the priority date of the patent in suit.

The outcome, then, of my investigation of the second Windsurfing step is for me to conclude that the notional skilled but unimaginative person in the art of mass-participation gambling games would, as part of his common general knowledge, have been aware of Mr Valentine's patent 970, and I have indicated how I believe he would have understood it. He would also

have known of Littlewoods' "Trap-the-Ball" competition, though I have been given very little information as to the nature of that game, and even less about its coupon. I can conclude also that he would have known generally about, for example, football pools, newspaper competitions and bookmakers' competitions, but Mr Valentine has shown me no evidence of what constituted the state of the art in these various areas at the relevant time, and in particular has provided no evidence whatever about the coupons that were in use in these or any other areas at and before the priority date of the patent in suit.

The third Windsurfing step requires me to identify the differences if any between the material cited in the revocation action and the alleged invention of the patent in suit, and I shall make the comparison first with 970. I have already explored what I have regarded as a distinction between the games to which 970, on its natural reading, and the patent in suit respectively relate, concluding that they are essentially different, the picture in the game of 970 not having, in so far as I have been able to understand from the very sparse description available to me, features erased or hidden, unlike that of the patent in suit. However, I note that the apparatus of 970, at least in its embodiments which are in printed form, has in common with the coupon of claim 1 of the patent in suit what I have identified as feature (ii) of claim 1, namely "a first area having a graphic representation printed thereon and divided into a plurality of zones each containing a part of the representation", so this feature alone provides no distinction. Likewise I believe that I must conclude that in such printed form the apparatus of 970 effectively constitutes a coupon, so again there is no distinction in this respect. I note that if I am wrong in my reading of 970, and if Mr Valentine's recent explanation is in fact the one that the reader in December 1976 would have understood from the document, then my conclusion that there is no distinction between claim 1 of the patent in suit and the disclosure of 970 as regards the "first area having a graphic representation" and the existence of a coupon would be unchanged.

I must also note that I have had to construe claim 1 of the patent in suit simply as being "suitable for" use with the relevant game, which in this context amounts in my judgement to little more than that it must be capable of use with the game. I have also had to construe it sufficiently broadly to encompass the variety of embodiments disclosed in the specification, including those in which feature (ii), the representation portion as I have previously analysed

the claim, coincides with either of features (iii) or (iv), the entry and checking portions. Nevertheless, I am satisfied that it differs from 970 in comprising separate entry and checking portions.

Applying the third Windsurfing step to the only other piece of usable prior art which I have found to emerge from the second Windsurfing step, namely the Littlewoods "Trap-the-Ball" competition, is not an easy or rewarding exercise since I have been given so little information about "Trap-the-Ball". Mr Valentine's uncontested evidence on the subject enabled me to conclude only that it involved a coupon, and that it included representations divided by grids. To this extent the disclosure it brings to my consideration adds nothing of moment to that of 970, and I am driven to essentially the same conclusions as to differences relative to the patent in suit as I reached with regard to 970.

I must therefore turn to the fourth and final Windsurfing step, deciding whether the differences I have identified from step three, viewed without knowledge of the alleged invention of the patent in suit, constituted steps which would have been obvious to the skilled person or whether they would have required any degree of invention.

Mr Valentine has argued that the differences in subject matter between the patent in suit and 970 are in effect unimportant or obvious. In his declarations of 16 February 1991 and 24 February 1993 he has suggested respectively that what the patent in suit adds to the disclosure of 970 are "verbose references" or "content that is non-essential". While I have noted these comments, I do not believe they are germane to the question of whether or not the invention claimed is obvious. Also, in his supplementary statement (headed "Attitudes"), Mr Valentine has drawn up a table of comparison between 970 and "Skilball", which he regards as the practical embodiment of the invention of the patent in suit. However, even if I were to ignore the fact that in these proceedings I have to consider the patent in suit as such and the invention as it is claimed in the patent, rather than advertisements for or reports about "Skilball", I find this table of no help to my present consideration, since it essentially compares the two games rather than the coupons, which constitute the invention upon which I must focus attention.

Mr Valentine makes a more precise assertion in his statement, where he says that "of necessity it must be a promoter's decision the precise design best suited for his purpose when it comes to printing or projecting pictures or entry forms". He continues "the game [of the patent in suit] nevertheless is being played to my rules. My 1072970". He goes on to say that 970 consists of a set of pictures and that clearly the particular pictures chosen are the promoter's decision. I agree that the particular pictures used are a matter of choice and that their selection cannot involve an inventive step. However, since claim 1 does not mention picture selection, this particular point is of no relevance in these proceedings.

Elsewhere in his evidence, in his declarations of 6 April 1992 and 24 February 1993, Mr Valentine argues on two counts that whether or not to provide an entry coupon at all (let alone of the sort claimed) is an optional matter for the promoter's decision. First, he refers to the "Scotgoal" competition from *The Sunday Mail* of 29 March 1992, which is exhibited to his declaration of 6 April 1992, and notes that the preferred entry is by telephone call. This he says is further support for his contention that means of entry is a matter for the promoter to decide, and not part of the game. However, this example of "Scotgoal" is from well after the priority date of the invention and is therefore not relevant for reasons I have already given.

Second, he says in his declaration of 6 April 1992 that "a patent has been granted for sticking a so called entry checking coupon on to my 1072970", and, in his declaration of 24 February 1993, contends in effect that checking coupons are obvious, being a promoter's decision and not part of the game, as he puts it. He argues that adding a coupon to a game of snakes and ladders would not be patentable, so neither should be one added to his 970.

I have carefully considered Mr Valentine's assertions about whether a coupon is really optional in connection with the type of game in question. However, I believe he may not have fully appreciated the point that I have made several times in this decision, that the invention of the patent in suit, as defined in claim 1, lies not in the "game" as an abstract entity, but in the entry and checking coupon defined there. Moreover, while I have already observed that I find it possible to interpret 970 as disclosing a coupon in the broadest sense, I have to conclude that Mr Valentine has not produced any evidence to demonstrate to my

satisfaction that it was obvious at the priority date of the patent in suit to the notional skilled but unimaginative person in the field to include in such a coupon as might be taken to be disclosed in 970 both entry and checking portions, so as to produce a coupon within the scope of claim 1. Since Mr Valentine has given me so little information on "Trap-the-Ball", I am equally unable to conclude that the skilled person would have found it obvious to incorporate both entry and checking portions on the coupon, and, indeed, if he had done so, whether this would have resulted in a coupon which fell within the terms of claim 1 of the patent in suit. Finally, the absence of evidence as to the state of the art at the relevant time as regards such things as football pools, newspaper competitions and bookmakers' activities precludes my forming any judgement that the skilled man would have found it obvious to make whatever adaptation or development would have been necessary to produce the coupon of claim 1.

Having carefully considered all the evidence and argument before me, I am not persuaded that the invention claimed in claim 1 is obvious. In the light of this conclusion, I do not believe I need to give separate consideration to claims 2 to 8 since they are dependent on claim 1. The two omnibus claims, 9 and 10, although not dependent on claim 1, are certainly of narrower scope and are in my view not obvious on the evidence before me.

Mr Valentine has at various points in his evidence suggested other grounds on which certain of the claims of the patent in suit should be rejected, and the patent therefore revoked. For example, he has asserted in his declaration of 6 April 1992 that an entry coupon is not patentable matter within the meaning of the Act, and that the invention of the patent in suit is simply an excluded design or mathematical method and not an invention within the meaning of the Act. Also, in the same declaration and in his declaration of 24 February 1993, Mr Valentine has suggested that claim 7 relates to an "illegal numbers lottery". He has also mentioned false suggestion and representation in this last declaration. However, none of these grounds was pleaded originally or later and, as I have made clear early in this decision, I am required to direct my attention in this decision solely to the allegation of obviousness.

In summary I find that Mr Valentine has failed to show that the invention, so far as claimed in any claim of the complete specification of the patent in suit, is obvious. This being the sole ground left in the action, I dismiss the application for revocation under section 33.

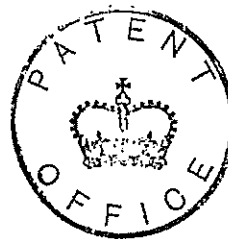
I must consider what costs should be awarded in respect of the action before the Comptroller, including its preliminary stages. It is the long-established practice that costs in proceedings before the Comptroller are not intended to compensate parties fully for the expense to which they may have been put. They are instead generally intended as a contribution towards that expense, and are awarded at the Hearing Officer's discretion subject to guidance from a scale that is published from time to time. I regard the outcome of the preliminary proceedings as having been fairly even, the request for striking out being dismissed but only after one of the original grounds, that of lack of novelty, had been struck out and after Mr Valentine had been given a further opportunity to file evidence. In relation to the substantive proceedings, I consider it appropriate in coming to an award to bear in mind that the registered proprietor did not reply to several actions or file any evidence, and that no hearing took place at that stage. In the final outcome, however, the application for revocation was unsuccessful on all counts. In all the circumstances I consider it appropriate to award the registered proprietor the sum of two hundred pounds (£200) as a contribution to costs, and I direct that this sum be paid to the registered proprietor, through the registered proprietor's patent agents, Reddie & Grose, by the applicant, Mr Valentine.

This being a substantive matter, the time within which any appeal must be lodged is six weeks from the date of this decision.

Dated this 14 day of December 1993

DR F FERDINANDO

Superintending Examiner, acting for the Comptroller



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