

IN THE MATTER OF Application
No 8428601 in the name of
John Patrick Thompson

DECISION

The application was filed on 13 November 1984 and relates to a receptacle for holding liquid. Claim 1 as filed reads:

- 1 A receptacle for holding a liquid, the receptacle having a transparent base to which a member, which includes a design, is attached so that the design is viewable through the base.

On substantive examination of the application under section 18 (2), the examiner reported that the subject-matter of the claims was not new and/or did not involve an inventive step as required by sections 1(1)(a) and 1(1)(b) and that certain of the claims, including claim 1, related to matter which was not patentable under sections 1(1)(d), 1(2)(b) and 1(2)(d). This report was communicated to the agents for the applicant in an official letter dated 21 December 1987.

In response to this report, the agents for the applicants filed amendments incorporating a new claim 1. However in a second report under section 18 incorporated in an official letter dated 19 July 1988, the examiner maintained the objections under sections 1(1)(a), 1(1)(b), 1(1)(d) and 1(2)(d). In a response contained in a letter received on 21 November 1988, the agents proposed a further amendment to claim 1 but the examiner reported that the amended claim was also not acceptable. The matter therefore came before me at a hearing on 7 March 1989 at which the applicant was represented by his agent, Mr J P Greene-Kelly. The examiner Mrs L M Harden was also present.

The relevant parts of sections 1(1) and 1(2) of the Act read as follows:

1 - (1) 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;

(c)

(d) the grant of a patent for it is not

excluded by subsections (2) and (3) below;

and references in this Act to a patentable invention shall be construed accordingly.

(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this act, that is to say, anything which consists of-

.....

(d) the presentation of information;

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

The form of claim 1 which I was asked to consider (hereafter 'claim 1 as amended') was that set forth in the agents' letter received on 21 November 1988. This reads as follows:

"A drinking vessel having a transparent base to which a member, which includes a design, is attached so that the design is viewable through the base and wherein the design includes an instructional message associated with the function of the vessel."

A particular embodiment of this drinking vessel described in the specification is in the form of a beer glass having affixed to its base a transfer which bears a design, viewable from inside the glass, incorporating the slogan "don't drink and drive" as an instructional message.

The substance of the examiner's objection was that the only distinction between the drinking vessel claimed and drinking vessels forming part of the state of the art lay in the content of the information presented by the design and that the former was therefore excluded from patentability under sections 1(1)(d) and 1(2)(d). In support of this objection, the examiner referred to the guidelines on presentation of information in paragraph 1.30 of the "Manual of Patent Practice in the UK Patent Office" published by the Patent Office. The first two sentences of this paragraph read:

"Any manner, means or method of expressing information which is characterised solely by the content of the information is clearly excluded, no matter whether this be visual, audible or tangible and by words, codes, signals, symbols, diagrams or any other mode of representation. The mere fact that physical apparatus may be involved in the presentation will not suffice to avoid the exclusion."

The most relevant prior art drinking vessel to which the examiner referred is disclosed in Patent Specification No 494898 (including Provisional Specification Nos 8992/1937 and 9472/1937). This specification describes a drinking vessel or other container having in its base a label, advertisement or decorative element visible through the thickness of the container body and in Figure 3 there is shown a stemmed wine glass having advertising matter provided in its base, this advertising matter being visible through the thickness of the base.

Mr Greene-Kelly did not contest the substance of the guidelines referred to by the examiner but submitted that the

drinking vessel claimed in claim 1 as amended was not characterised solely by the content of the information presented by the design. In support of this submission, he referred me to the decisions in Edgar Rhodes' Application [1973]RPC 243 and I.T.S. Rubber Limited's Application [1979]RPC 318.

In Rhodes, the Patents Appeal Tribunal allowed a claim to a speedometer bearing two scales over which a pointer moved. One scale indicated the speed of the car and the other scale the square of the speed, this being proportional to the kinetic energy of the car. The meter was thus able to indicate to a driver both the speed and the car and also what was termed "impact speed". In its decision, the Tribunal stated at page 247:

"On the information at present available it could be said that this inventor's contribution was the idea that it would be valuable to provide a driver with an instrument which would indicate his "impact speed" coupled with a method of doing this. The invention appears to us to lie not in the information but in the idea of presenting such information and in a way in which this can be done."

Mr Greene-Kelly submitted that the final sentence of this passage applied equally to the circumstances of the application in suit. However, in my view there are two important differences. First is that, whereas in Rhodes the idea of presenting information on "impact speed" to drivers was new, in the case of the present application there is no suggestion that there is any novelty in the idea of presenting the information "don't drink and drive" to drivers. In addition, in Rhodes the way of presenting this information, viz by way of a second scale, was again new whereas in the case of the present application it is known from 494898 to present information so that it is visible through the base of the vessel. In view of these differences, I am unable to accept Mr Greene-Kelly's submission in this matter.

In I.T.S. Rubber, the Patents Court allowed a claim to a blue squash ball on the grounds that the colouring imparted desirable characteristics to the ball. These were that the ball did not mark the walls of the squash court and it had improved visibility in play. Mr Greene-Kelly submitted that in the application in suit, the provision of the "instructional message" on the base of the drinking vessel similarly imparted a desirable characteristic to the vessel and that claim 1 as amended should accordingly be allowed.

Having considered the I.T.S. Rubber decision, I find that I am again unable to accept Mr Greene-Kelly's submission. As I read the decision, the claim to the blue squash ball was allowed because the colouring improved the playing characteristics of the ball and thus had a functional effect. I do not read it as saying that the addition of any desirable characteristic necessarily imparts patentability. In the case of the application in suit, although the instructional message is defined as relating to the function of the vessel, there is no suggestion that the provision of a design incorporating for example the slogan "don't drink and drive" improves the drinking or other characteristics of the vessel in use in any way analogous to the improvements imparted by colouring the squash ball blue.

I would also add that the issue in both Rhodes and I.T.S. Rubber was whether the articles in question constituted a "method of manufacture" within the meaning of section 101 of the 1949 Act and that the same considerations do not necessarily apply in determining what constitutes "the presentation of information" under section 1(2)(d) of the 1977 Act.

Accordingly, I am unable to accept that claim 1 as amended should be allowed on the basis of the decision in either Rhodes or I.T.S. Rubber. In addition and for the same reasons, I find that the only difference between the drinking

vessel claimed in claim 1 as amended consists of the presentation of information within the meaning of section 1(2)(d) and that claim 1 as amended is therefore not patentable under section 1(1)(d).

Mr Greene-Kelly also asked me to decide on the allowability of certain further amendments in the event that I found against claim 1 as amended. The first of these amendments was to introduce into claim 1 the requirement that the message should be viewable through the drinking vessel.

The purpose of this amendment is to distinguish the construction of the drinking vessel claimed from that shown in Figure 3 of 494898 so that the vessel claimed would then no longer be characterised solely by the information presented by the design. However, the relevant disclosure in 494898 is not restricted to Figure 3. As disclosed in the Provisional Specification 8992 at page 1 lines 64-80 of 494898:

".... the plug member is employed for the purpose of clamping an advertisement to the underside of a glass article, such as a drinking vessel (emphasis added) or other article having a transparent base ... and such advertisement is clamped between the plug or member and the surface of the base of the article, so that the advertising matter will be visible through the article (emphasis added) or its base."

It was not in dispute that for the claim to be allowable, the subject-matter introduced by the first amendment must both be new and involve an inventive step. What is meant by involving an inventive step is defined in section 3 which reads:

"3. 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..."

Mr Greene-Kelly sought to persuade me that since the only embodiment of a drinking vessel specifically exemplified in 494898, viz that shown in Figure 3, shows the advertisement visible only through the base, it was not obvious in the light of the above-cited passage to provide a drinking vessel in which the advertising matter was visible through the vessel itself. However, I am unable to agree to this given that a drinking vessel is the only article specifically named in the passage and that viewing the matter through the article is one of only two alternatives disclosed.

Accordingly, in my view, it is obvious in the light of the above disclosure to provide a drinking vessel in which a design in the form of advertising matter attached to the base is viewable through the vessel. I therefore find that the matter introduced into claim 1 by the first amendment proposed by Mr Greene-Kelly would not involve an inventive step within the meaning of section 3 and accordingly would not render the subject-matter of claim 1 patentable.

The second further amendment proposed by Mr Greene-Kelly was to include in claim 1 the subject-matter of claim 5. This reads:

"5. A receptacle as claimed in one of the preceding claims wherein the member is absorbent."

He also offered additionally to include the restriction that the absorbent member was on the outside of the base if this was necessary for the acceptance of claim 1.

Having considered the prior art referred to above, I can find nothing which suggests that the use of an absorbent member is either not new or does not involve an inventive step. I therefore find that the incorporation of the subject-matter of claim 5 into claim 1 would overcome the objection under section 1(2)(d) since the drinking vessel claimed therein

would then be characterised by this subject-matter and not solely by the presentation of information as at present. However, in my view it is also necessary to state explicitly in claim 1 that the adsorbent member is on the outside of the base otherwise the claim would not be supported by the description as required by section 14(5)(c), there being no suggestion in the description that an absorbent member could be provided inside the base.

In reporting her objections to the drinking vessel claimed in the application in suit, the examiner also referred to other drinking vessels allegedly forming part of the state of the art. These vessels are described in a statutory declaration dated 26 February 1987 by Derek Grimes, a product development manager employed by the Ravenhead Company of Burtonhead Road, St Helens, Merseyside and filed on 9 March 1987 as evidence in support of third party observations under section 21 on the question whether the invention is a patentable invention. However, the substance of this declaration has been denied, first orally by Mr Greene-Kelly at the hearing and thereafter by the applicant in a statutory declaration dated 30 March 1989. In the event, I have already decided that neither claim 1 as amended nor the first amendment proposed by Mr Greene-Kelly is allowable. As there was also no suggestion that Mr Grimes' declaration disclosed matter relevant to claim 5, I thus do not need to consider it further.

Having regard to my findings above, I allow the applicant until the expiry of the extended period prescribed under section 20(2) in which to file fresh pages incorporating amendments in accordance with these findings, failing which the application will be refused.

Dated this 20th day of April 1989



L LEWIS

Principal Examiner, acting for the Comptroller

THE PATENT OFFICE

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