

PATENTS ACT 1977

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IN THE MATTER OF

Application No 9201793.8 in the  
name of Zan Michael Zannetos

**DECISION**

This application was filed on 28 January 1992 in the name of Zan Michael Zannetos and relates to a slicing machine for cutting slices from a foodstuff, eg doner kebabs. The application was published on 4 August 1993 and examination was requested on 13 August 1993. The first examination report under Section 18(3) was issued on 17 May 1994 and objection was made *inter alia* to lack of novelty. A response was received on 1 August 1994 proposing amendments to distinguish this application from the cited prior art, viz GB 2238229 (Turedi) which relates to a food slicer.

On 8 September 1994, Section 21 observations were received by the Office from Hulse & Co., viz. that on 7 January 1992 the applicant was visited by Messrs Keelan and Turedi and the applicant sold a food slicer as indicated in figures 1 to 3 of this application to Mr Keelan. Since the date of the invoice for the commercial sale was before 28 January 1992, the priority date of this application, Hulse & Co. concluded that the application was invalid.

The examiner wrote to the applicant c/o Forrester Ketley & Co. on 15 November 1994 raising an objection against the text of the application and drawing attention to the Section 21 observations; 4 months was set as the period for response. The examiner was of the opinion that the letter filed under Section 21 was not sufficiently detailed to raise an objection of prior use under Section 1(1)(a). The examiner added that it was possible that it was based on a slicer made under the instructions of GB 2238229 (Turedi). However, since the amendments made to the claims of this application were considered sufficient to avoid anticipation by GB 2238229 it appeared to the examiner that no further action was required in respect of the observations. On 17 January 1995 amendments to the text of the application were received in response to the

Official Letter of 15 November 1994.

On 8 February 1995 the examiner received a telephone call from Hulse & Co. to question whether it was possible to file further Section 21 observations. The examiner agreed that it was possible but added that stronger documentary proof would be necessary and that perhaps the matter would be better dealt with post grant in Court where witnesses could be cross examined by Counsel. Supplementary Section 21 observations were subsequently received from Hulse & Co. on 9 February 1995 and included *inter alia* a copy of an invoice dated 7 January 1992 and a witness statement by Michael Zannetos that he received a visit by Messrs Keelan and Turedi on 7 January 1992.

In a telephone conversation on 3 May 1995 the examiner informed Hulse & Co. that no comment could be made on the state of the application in view of Section 21(2). On 17 May 1995 Hulse & Co. informed the Patent Office that they had been instructed by clients to make preparations for the filing of a Statutory Declaration by Mr Keelan, whom it was alleged had been sold a knife by the applicant on 7 January 1992, and the knife in question. Further Section 21 observations were received by the Office on 1 June 1995 and included the knife as an exhibit. The examiner copied these further Section 21 observations to the applicant on 26 July 1995 and reported to the applicant under Section 18(3) that he was of the opinion that the exhibit and supporting documents showed clear prior use of the slicing device as claimed in claims 1 to 9 and 12 of the application. Moreover, the features claimed in claims 10, 11 and 13 to 15 and 17 appeared obvious upon close inspection of the exhibit.

The examiner confirmed in a subsequent telephone conversation with the applicant's agent on 27 September 1995 that the period for reply to the Section 18(3) report would end two months from the date of the telephone conversation, viz. 27 November 1995. This action repaired the omission of a formal period for reply in the Official Letter dated 26 July 1995. On 16 February 1996, the examiner wrote to the applicant reminding him that no reply had been received to the last Official Letter. He advised the applicant that a hearing would be appointed to decide the matter if no adequate response to the Official Letter was received by 18 March 1996. Accordingly, on 11 July 1996 the Hearings Clerk wrote to the applicants' agent offering the applicant an opportunity to be heard.

In the absence of any acknowledgement to the invitation to attend a hearing, the decision whether to refuse this application as not complying with the requirements of the Act will be decided on the basis of the papers and exhibits on file.

This application has been the subject of three sets of observations under Section 21, viz those made on 9 September 1994, on 8 February 1995 and on 1 June 1995. Until the receipt of the final set of observations it would appear that the substantive objections to the application had been removed and the earlier Section 1(1)(a) objection had been met. However, the observations filed on 1 June 1995 removed the benefit of any doubt that the examiner may have given the applicant relating to a possible objection of prior use.

I now have before me exhibits marked "EPK.1" and "EPK.2" and a Statutory Declaration from Mr Keelan. Exhibit "EPK.1" is a copy of the receipt for the purchase of the knife from the applicant and exhibit "EPK.2" is the knife in question. The Statutory Declaration states that Mr Keelan purchased the knife from the applicant on 7 January 1992.

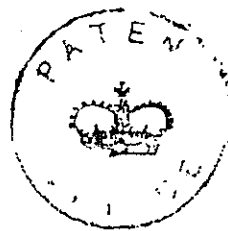
Upon close inspection of the exhibit "EPK.2", the top and cross-sectional views of the knife appear identical to figures 1 and 2 of this application. In addition, the roller of the exhibit "EPK.2" appears to be identical with the embodiment of a roller shown in figure 3 of this application. Therefore, in my opinion, claims 1 to 9 are not novel if it can be shown that the exhibit "EPK.2" formed part of the state of the art at the filing date of this application. I am also of the opinion that *prima facie* claims 10-14 of this application lack inventive step with regard to the coupling arrangement of the knife to a power source. Claim 16, which relates to a method of using a slicing device according to any one of claims 1 to 15, is also objectionable.

To decide whether the exhibit "EPK.2" forms part of the state of the art I have before me the Statutory Declaration made by Eamon Peter Keelan on 26 May 1995. It states that on 7 January 1992 Mr Keelan visited ZM Engineering Ltd with a colleague Mustafa Kaya Turedi and purchased a "Kebab King" electric slicing knife from the applicant Mr Zannetos. Mr Keelan acknowledges exhibit "EPK.1" as a photocopy of the receipt for the purchase and exhibit "EPK.2" as the cutting head of the knife that was bought from the applicant on 7 January 1992.

In the light of this Statutory Declaration and supporting documents filed as observations under Section 21, I am satisfied that the exhibit "EPK.2" was made available to the public by use and so formed part of the state of the art at the filing date of this application.

Consequently, it is considered that the specification did not comply with the requirements of the Act within the specified period and accordingly, subject to any appeal, the application is refused under Section 18(3). A period of 14 days from the date of this decision is allowed for appeal.

Dated this 8 day of August 1996



D J JERREAT

Principal Examiner, acting for the Comptroller

**THE PATENT OFFICE**