

PATENTS ACT 1977

IN THE MATTER OF Patent Application
No 9002101.5 in the name of
Paul Daryl Hocking

DECISION

Application 9002101.5 was filed on 30 January 1990 by Mr Hocking, and published as GB2240410 on 31 July 1991. During preliminary examination, a search was performed, but no prior art was brought to Mr Hocking's attention. The request for substantive examination was filed on 11 December 1991, and the examiner's first report to the Comptroller communicated to Mr Hocking in an Official letter dated 7 May 1993, stated that the examiner considered that the invention claimed was not patentable by virtue of Section 1(2)(b), and that one of the claims was obscure in scope.

No reply was received to this report until after a letter issued on 13 May 1994 forewarning of refusal by virtue of there being no reply within the period specified in the previous Official letter. Mr Hocking then filed, on 6 June 1994, a letter disputing the examiner's view as to the patentability of the invention. Notwithstanding the late response, the examiner replied to this letter in an Official letter dated 9 June 1994, stating that it was still his opinion that there was no patentable invention, and offering a hearing to resolve the matter. The matter came before me at a hearing on 21 July 1994, which the applicant did not attend, and so I have decided the matter on the papers on file, including the exchanges of letters subsequent to the appointment of the hearing, which also raised the objection as to whether the application was excluded by Section 1(2)(d) as presentation of information.

At no time in the proceedings were amendments offered, and the subject matter of the application is set out in claim 1, which I reproduce here:-

1. An analogue timepiece comprising a face and pair of hands which rotate about a common axis each at different speeds to indicate the time of day, the face having provided on it one or a series of alpha numeric symbols, the hands of the timepiece

at least when together indicating one time of day, forming at least part of an alpha numeric symbol which is associated with the or the series of, alpha numeric symbols provided on the face.

Claims 2 to 5 are of appendant form; claim 6 is a claim of the usual "omnibus" form; and claim 7 reads:-

7. Any novel feature or novel combination of features as herein disclosed and/or shown in the accompanying drawings.

The central matter to be decided, therefore, is whether the invention is one that is excluded from patentability by Section 1(2)(b) and/or 1(2)(d), which provide:-

(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-

(a)

(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;

(c) ...

(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.

Returning to the invention claimed, it is not in dispute that the hands of the timepiece are driven, and function, entirely conventionally, and that therefore the contribution to the art made by the present application depends entirely upon the relationship between the hands and the markings on the face.

The objection made initially was that this fell within the exclusion of Section 1(2)(b), that this was a purely aesthetic distinction. Mr Hocking, in his letter dated 31 May 1994, argues at some length that this is not the case, referring to the subjective nature of the interpretation of the word "aesthetic". As he developed his argument, as I understand it, he went on to identify the invention as the combination of the usual analogue timepiece working in

conjunction with the calligraphic method by which humans communicate.

This to my mind goes to the heart of the problem. The distinction from what is known is essentially dependant upon the intellectual perception of the user, and does not perform anything which has a technical effect. Mr Hocking has argued that the invention lies in the idea that it would be valuable to provide a user with a display which passes a message, albeit at particular times only. This message has no technical function or content, but merely conveys information.

On the other hand, the distinction is not in terms of a particular design or other subjective decoration as such, and I therefore hold that the invention is not excluded from patentability by the reference to aesthetic creations in Section 1(2)(b). Furthermore, I do not in any sense see that the display of the invention could be seen as a literary, dramatic, musical or artistic work as such, and so hold that the invention is not excluded from patentability by Section 1(2)(b).

However, given that there is nothing new in the message itself, nor in the timing function of the timepiece, it is clear that the intent of the invention is to pass an intelligible message to the user. The patentability of invention in this area has been considered by the Courts many times, and it has been held that, to be patentable, the presentation must serve a functional, rather than merely intellectual, purpose. In this case, I consider that the invention is merely concerned with the presentation of intellectual information, and therefore hold that it is excluded from patentability by Section 1(2)(d) of the Patents Act 1977.

I have carefully considered claims 2 to 6, and the description, but can see no saving amendment which would enable claims to a patentable invention to be formulated. Claim 7, objected to by the examiner at the first stage, does not meet the requirements of Section 14(5), which requires that the claims define the matter for which the applicant seeks protection and be clear and concise, and the application also falls on this ground.

I therefore refuse this application.

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

Dated this 28 day of July 1994



B WESTERMAN

Principal Examiner, acting for the Comptroller



THE PATENT OFFICE