

**OPINION UNDER SECTION 74A**

Patent	<b>GB 2413983</b>
Proprietor(s)	Great Neck Saw Manufacturers Inc.
Exclusive Licensee	
Requester	K.R. Bryer & Co LLP, on 13 November 2008
Observer(s)	Great Neck Saw Manufacturers Inc.
Date Opinion issued	11 February 2009

**Introduction**

1. This opinion relates to a request filed by K. R. Bryer & Co. (“the requester”) as to whether patent GB2413983B (“the patent”), in the name of Great Neck Saw Manufacturers Inc. (“the proprietor”), is invalid as it does not satisfy the conditions of novelty and inventive step of the Patents Act 1977.

2. The patent was filed on 29 September 2004, claiming a priority date of 14 May 2004. It was granted on 28 March 2006, under the title “Foldable Utility Knife”. In particular, it relates to a foldable utility knife provided with a compartment for storing replacement blades.

**The request**

3. The requester seeks an opinion as to whether claims 1 to 22 of the patent are novel and involve an inventive step in view of the following documents:

GB2398754  
US6354007  
US4027386  
US6134788  
NZ528755

4. Of these, the requester acknowledges that GB2398754, US6354007 and US4027386, were cited pre-grant, during examination of the application.

5. It is my understanding that the requester also considers that the following documents are illustrative of the common general knowledge of the

skilled man when considering inventive step:

US6971178  
US6845561  
US6678958  
US6574872  
US4425709  
US4017969  
US3927473  
US3896546  
US3829967  
US3604113  
US3593417  
US3577637  
US3509627

6. The request also includes an annotated copy of the claims of the patent, which refers to corresponding features of the devices shown in US6134788, and GB2396129, an equivalent application to NZ528755.

### **Observations**

7. Observations in response to the request were filed by Barker Brettell LLP, on behalf of the proprietor, on 19 December 2008, and observations in reply were filed by the requester on 30 December 2008. The observations in reply contained reference to four further documents, which were not present in the original request: U6513243, US6446340, US6233830 and US5940970.

### **Preliminary issues**

8. Before I consider the substantive issues of novelty and inventive step, I think it is appropriate to address the following preliminary issues:

- (i) Whether, or to what extent, documents GB2398754, US6354007 and US4027386 should be considered as part of this opinion, as they were considered pre-grant;
- (ii) Whether the further documents cited by the requester in its observations in reply should be considered;
- (iii) Whether all of the documents relied upon fall within the state of the art for the purposes of novelty and inventive step; and
- (iv) In view of points (i) to (iii) above, the basis on which should I proceed with this opinion.

(i) Can GB2398754, US6354007 and US4027386 be considered?

9. Since GB2398754, US6354007 and US4027386 were considered

during the examination of the patent application, the question therefore arises as to whether they should be considered as part of this opinion.

### The law

10. Section 74A(3) of the Patents Act 1977 ("the Act") is the relevant provision here. It states that:

74A.-(1)....

(2)....

(3) *The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so –*

(a) *in such circumstances as may be prescribed, or*

(b) *if for any reason he considers it inappropriate in all the circumstances to do so.*

11. It was held in hearing decision BL O/370/07 (at paragraph 29) that the words "in all the circumstances" of section 74A(3)(b) mean that all factors have to be taken into account when considering the appropriateness of issuing an opinion, including what was cited in the examination phase. The hearing officer also held, at paragraph 32:

*"I think it is reasonable to suppose in general that the examiner will have done his or her job properly in the absence of indication to the contrary, and I see no reason why this assumption should not apply even if the examiner has decided not to raise objection on the basis of any of the citations at substantive examination";*

and at paragraph 33:

*"Having said that, I have to acknowledge the possibility that a decision by an examiner to discount a citation might be shown to have been clearly perverse, in the sense that no reasonable person could have reached it. Only in such a case might it be appropriate to reconsider the citation in an opinion as there could be said to be a new argument".*

12. The requester does not make any detailed arguments based on the documents cited by the examiner, and having looked at them, I do not think that the requester has shown, or suggested, that the examiner's decision based on these documents was in any way unreasonable, or perverse. Although the possibility cannot be ruled out as a matter of general principle that documents which were considered in earlier proceedings could be

combined with newly-identified prior art to make a new argument of lack of inventive step, the requestor has not advanced any such argument, or even referred to the earlier citations in the marked up schedule of claims attached to the request. I do not therefore propose to take these documents into account as part of this opinion.

13. Neither US6134788, nor NZ528755, were considered during the examination stage, and so can be considered for the purposes of both novelty and inventive step.

(ii) Can the new documents introduced in the observations in reply be considered?

#### The law

14. Rule 96(4) of the Patents Rules 2007 states that:

*96.-(1).....*

*(2)....*

*(3)....*

*(4) A person to whom observations are sent under paragraph (3) may, during the period of two weeks immediately after the end of the relevant period, file observations confined to matters strictly in reply.”*

15. The key words here are “strictly in reply”, and although the requester introduces the new documents by way of addressing a point made by the proprietor in its observations, their introduction clearly presents new evidence to which the proprietor has had no opportunity to respond. I therefore will not consider any of U6513243, US6446340, US6233830 or US5940970 as part of this opinion.

(iii) Can all of the documents referred to in the request be considered as state of the art for the purposes of novelty and inventive step?

#### The law

16. The relevant provisions of the Act with regard to novelty and inventive step are set out in sections 1 to 3 of the Act, in particular the following sub-sections:

*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;*
- (a) the invention involves an inventive step;*
- (b) ....*
- (c) ....”*

.....

*“2.-(1) An invention shall be taken to be new if it does not form part of the state of the art.*

*(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any way*

*(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say –*

- (a) that matter was contained in the application for that other patent both as filed and as published; and*
- (b) the priority date of that matter is earlier than that of the invention.*

*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 by virtue only of section 2(2) above (and disregarding section 2(3) above).*

17. Of the documents provided by the requester as representing common general knowledge, US6971178 was published on 6 December 2005, and US6845561 was published on 25 January 2005. Therefore, these documents do not form the state of the art for the purposes of section 2(2), and so their disclosures cannot be considered as representing common general knowledge.

18. As I have noted above, the requester also refers to the features of GB2396129, an equivalent of NZ528755. However, since NZ528755 was published on 30 April 2004, before the priority date of the patent, and GB2396129 published afterwards, I think it is only worth referring to the NZ document, especially since the features relied upon by the requester are present in both.



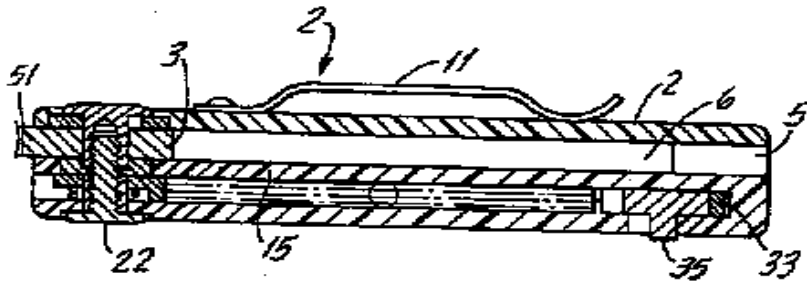


FIG. 4

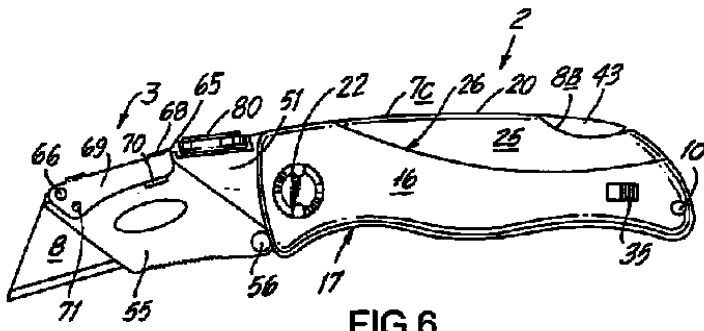


FIG. 6

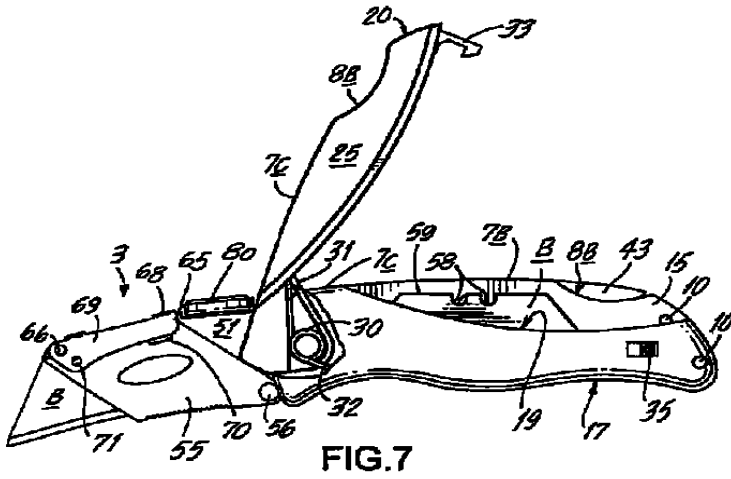


FIG. 7

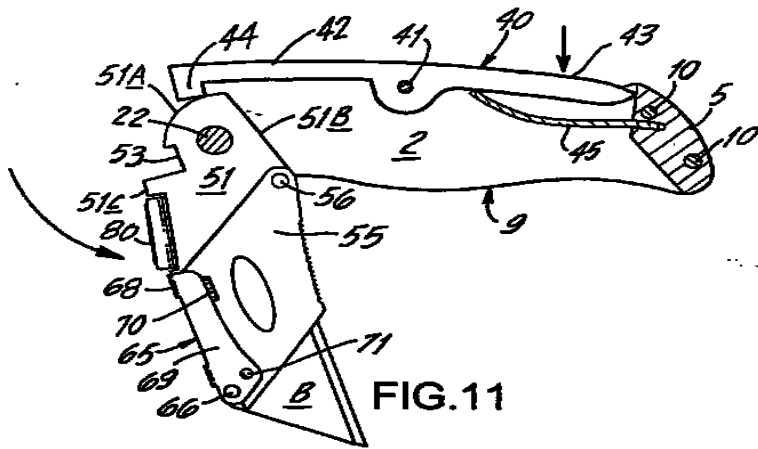


FIG. 11

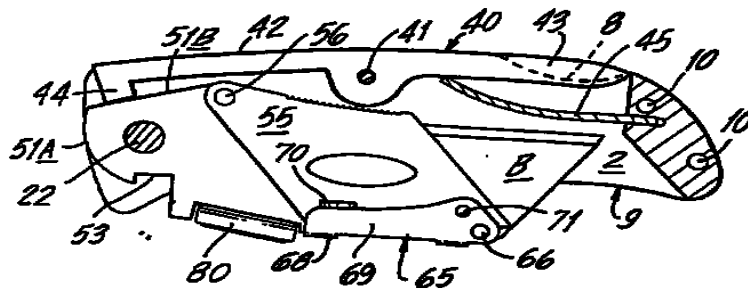


FIG. 12

21. Figures 2, 6, and 7 show a blade B held in a blade holder 3 in an unfolded position, ready for use. A blade lock mechanism 65 pivotally mounted to an upper edge of the blade holder holds the blade in place. Figure 11 shows the blade and blade holder being rotated about pivot 22 towards a folded position. Figure 12 shows the blade and blade holder in its folded position within handle 2, where it occupies a space 6 between walls 2 and 15, as shown in figure 4.

22. Figures 2 and 7 show the blade storage compartment 4, figure 7 showing a cover assembly 20 in a raised position to allow access to the blade storage compartment. Figure 4 shows the blade storage compartment separated from the space 6 that houses the folded blade and blade holder by inner wall 15.

23. Claim 1 is the only independent claim, and specifies:

*A utility knife comprising a handle and a blade holder, said blade holder being pivotally mounted on said handle for movement from an unfolded position to a folded position, said handle having a space adapted to receive at least a portion of said blade holder when the blade holder is in its folded position, said blade holder having means for holding a blade thereon, the space in the handle also enclosing a cutting edge of the blade when the blade holder is in*

*its folded condition, and said handle comprises a blade storage compartment, said storage compartment being in a location spaced from said space.*

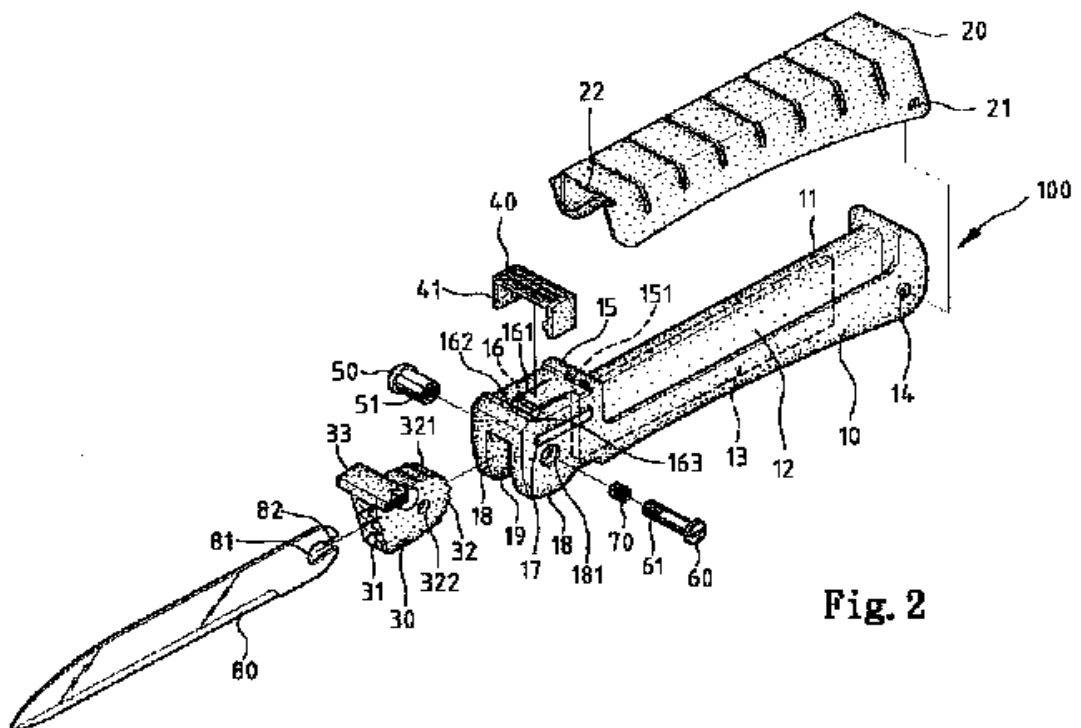
24. Claims 2 to 21 are appendant to claim 1, and claim 22 is an 'omnibus' type claim. They will be discussed in more detail below.

### **Novelty**

25. The relevant provisions of the Act with regards to novelty are found sections 1 and 2, set out above.

### US6134788

26. This document discloses a tool holder for different types of blade. A selection of the drawings of this document is reproduced below:



**Fig. 2**

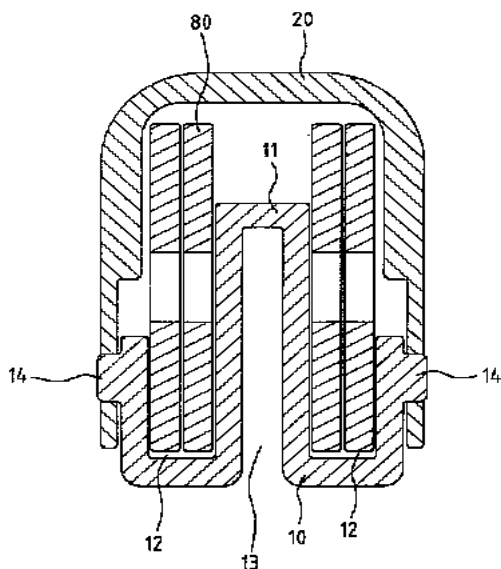


Fig. 5

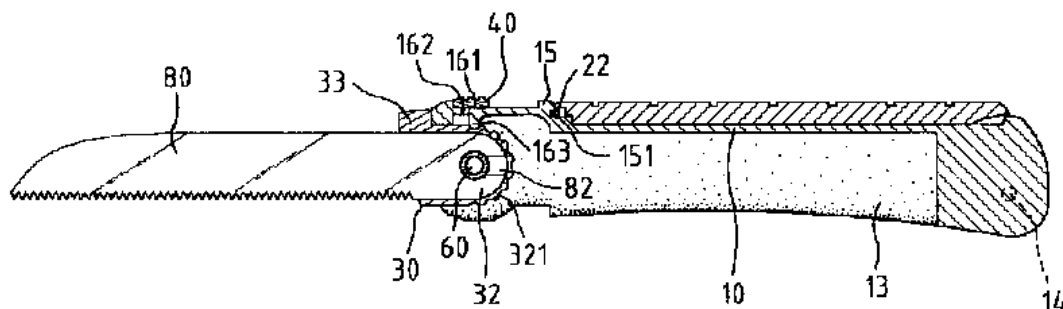


Fig. 8

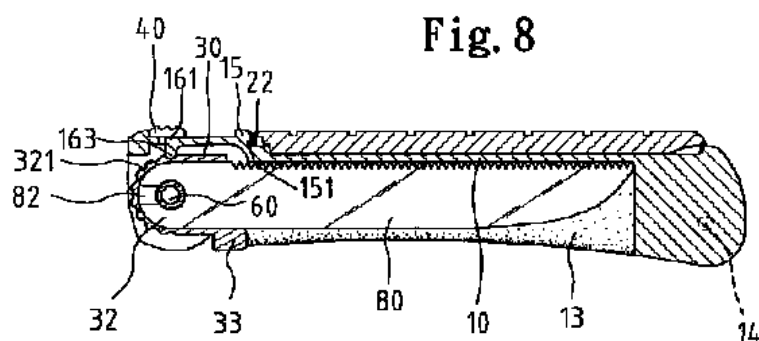


Fig. 10

27. The above figures show a blade 80 foldable about pivot 60 between an unfolded position, as shown in figure 8, and a folded position, as shown in figure 10. The blade is received within a fixing seat 30, which is itself secured to one end of a handle 100. A base 10 of the handle defines two compartments 12 separated by a blade receiving compartment 13, as shown

in figure 5. Spare blades may be kept within the two compartments 12, and the blade receiving compartment 13 receives the blade in the folded configuration.

### Claim 1

28. Turning to the requirements of claim 1 of the patent, pivotally mounted fixing seat 30 clearly performs the function of a blade holder, which is received within compartment 13 in its folded position, as shown in figure 10. When in the folded position, the cutting edge of the blade is also enclosed within compartment 13. Spare blade compartments 12 are "spaced from" blade receiving compartment 13 by separation wall 11 of base 10.

29. The only issue remaining is whether or not the disclosure of this document can be regarded as a "utility knife", as required by claim 1, since there is no mention of this term anywhere in US6134788. According to the principles of claim construction set out in *Kirin-Amgen and others v Hoechst Marion Roussel Limited and others* [2005] RPC 9, I must put a purposive construction on the claims, interpret them in the light of the description and drawings as instructed by section 125(1) the Act, and take account of the Protocol to Article 69 of the European Patent Convention. The correct approach, as set out by Lord Hoffmann in *Kirin-Amgen*, is to determine what a person skilled in the art would have understood the patentee to have used the language of the claim to mean. The Concise Oxford English Dictionary (9<sup>th</sup> edition) defines the term "utility knife" (otherwise known as a Stanley (RTM) knife) as a "very sharp knife having a replaceable blade", and I think this is fully consistent with the use of this term in the patent. Hence, although there is no mention in US6134788 of the term "utility knife", I believe that the skilled person would understand it as being a knife of this type, and that this document therefore anticipates claim 1.

30. I shall now go on to consider the appendant claims.

### Claim 2

31. Claim 2 specifies:

*A utility knife according to claim 1, wherein said blade storage compartment comprises a pair of opposed first and second walls, a base connecting said opposed walls and an open slot.*

32. These features can clearly be seen in figure 5, reproduced above. Each of the spare blade storage compartments 12 includes opposed first and second walls with a connecting base, which define an open slot. Claim 2 is therefore also anticipated by this document.

### Claim 3

33. Claim 3 specifies:

*A utility knife according to claim 2, wherein a cover is mounted on said blade storage compartment to overlie and close said open slot, said cover being movable from a closed position closing the open top to an open position opening the open top.*

34. Cover 20 is pivotable about knurls 14 provided in the base 10, and is pivotable between an open position, and a closed position, in which it covers the compartments 12. Therefore, claim 3 is also anticipated.

### Claim 4

35. Claim 4 specifies:

*A utility knife according to claim 3, wherein said cover is pivotally mounted within said open slot.*

36. It is clear from figure 2 of US6134788 that cover 20 is not mounted "within" either of the spare blade compartments 12; rather it is mounted to the outer walls of the handle 10. This claim is therefore novel over US6134788.

### Claim 5

37. Claim 5 specifies:

*A utility knife according to claim 3 or 4, wherein said second one of said opposed walls forms an outer wall of the knife and wherein said cover has a depending skirt adapted to mate with said outer wall.*

38. There was some dispute between the requester and the proprietor as to the meaning of the word "mate" as specified in this claim. In its observations, the proprietor suggests that none of the prior art relied upon by the requester shows a mating of the cover with the handle as required by claim 5; though it does not submit any reason why. The requester argues that the words "adapted to mate with" must be construed more broadly than that.

39. The only reference to this feature in the description of the patent with regard to the drawings is in the sentence bridging pages 4 and 5, where it states that "A skirt 25 depends from the top surface 7C and has a lower curved convex edge 26 which conforms to and mates with concave edge 19 in the outer wall 16 to close the blade storage compartment 14". This is shown in figures 2 and 6 of the patent, reproduced above. I do not think that this passage in any way leads the skilled person to depart from the everyday

meaning of the word "mate", which the Concise Oxford English Dictionary (9<sup>th</sup> Edition) defines as "to fit well". I am of the opinion that cover 20 shown in US6134788 can reasonably be said to "mate" or "fit well" with the base 10, as is shown for instance in figure 5. I therefore conclude that claim 5 is anticipated by this document, when dependent on claim 3.

#### Claim 6

40. Claim 6 specifies:

*A utility knife according to claim 5, wherein hook means are provided on said cover.*

41. It says at column 3, lines 40 to 43, of US6134788 that "A head 15 is formed on the other end of the base 10 and includes a mortise 151 for releasably engaging with a tenon 22 on the other end of the cover 20". It seems to be clear from figure 7 that tenon 22 comprises a hook shaped element that engages with mortise 151. I therefore consider that claim 6 is also anticipated by this document.

#### Claim 7

42. Claim 7 specifies:

*A utility knife according to claim 6, wherein latch means are provided on said outer wall adapted to cooperate with said hook means to hold the cover in the closed position.*

43. In the patent, a latch 35 is provided which cooperates with hook 33, as can be seen in figure 8. However, in US6134788, hook-shaped tenon 22 locates within mortise 151, which cannot be considered the same as a latch. Claim 7 is therefore novel over this document.

#### Claim 8

44. Claim 8 specifies:

*A utility knife according to any one of the preceding claims, wherein a magnet is mounted in said blade storage compartment to hold the blades in place therewithin.*

45. There is no disclosure in this document of the use of a magnet within blade storage compartments 12 to hold the blades in place. This claim is therefore novel over US6134788.

#### Claims 9 to 13

46. Claim 9 specifies:

*A utility knife according to any one of the preceding claims, wherein said handle comprises a side wall and wherein the first wall of the blade storage compartment is mounted on said side wall in spaced relationship thereto to form the said space in the handle.*

47. This feature of the invention is most clearly shown in figure 4 of the patent, where a side wall 2 of the handle is mounted in a spaced relationship from a first wall 15 of the blade storage compartment. It seems to me that such a feature is not present in US6134788. It is clear from the figures of this document, particularly figure 5, that base 10 is made in one piece. Therefore, neither of the walls of the blade storage compartment can be said to be “mounted” to the side walls of the handle in a “spaced relationship”, and so claim 9 is novel with regard to this document.

48. Having found that claim 9 is novel, it follows that claims 10 to 13 must also be novel as they are appendant to it.

#### Claims 14 to 21

49. Claim 14 specifies:

*A utility knife according to any one of the preceding claims, wherein said blade holder comprises a main wall and a guard wall mounted on said main wall and moveable from an open position to a closed position overlying said main wall, said main wall having means to hold a blade thereon whereby a blade is interposed between said main wall and said guard wall when said guard wall is in its closed position.*

50. The guard wall allows access to the blade holder so that a blade can be inserted. As I noted above, I consider that fixing seat 30 performs the function of a “blade holder” for the purposes of claim 1. Fixing seat 30 is shown most clearly in figure 2, and is described at column 3 line 65 to column 4, line 9. It is clear that the fixing seat 30 does not possess what can be considered a “guard wall” that is moveable from an open position to a closed position. Rather, the blade 80 is inserted by placing it within groove 31, and it is then secured by the action of a latch member 50 on an engaging hole 81 of the blade.

51. I therefore conclude that claim 14 is not anticipated by this document. Since claims 15 to 21 are appendant to this claim, it follows that they are not anticipated either.

#### Claim 22

52. Claim 22 is an 'omnibus' type claim, and is not anticipated by this document.

NZ528755

53. NZ528755 is in the proprietor's name, Great Neck Saw Manufacturers, Inc. The following figures show its main features:

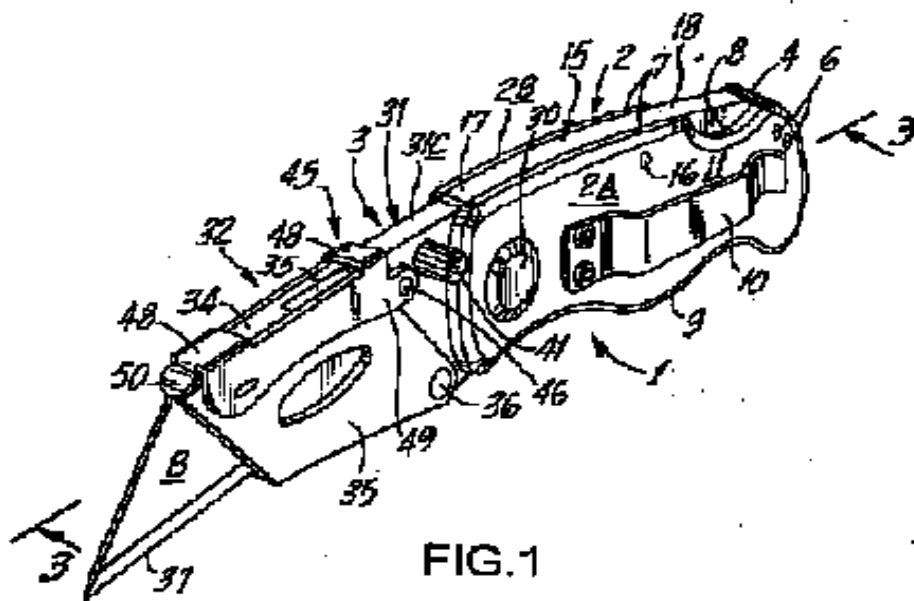


FIG. 1

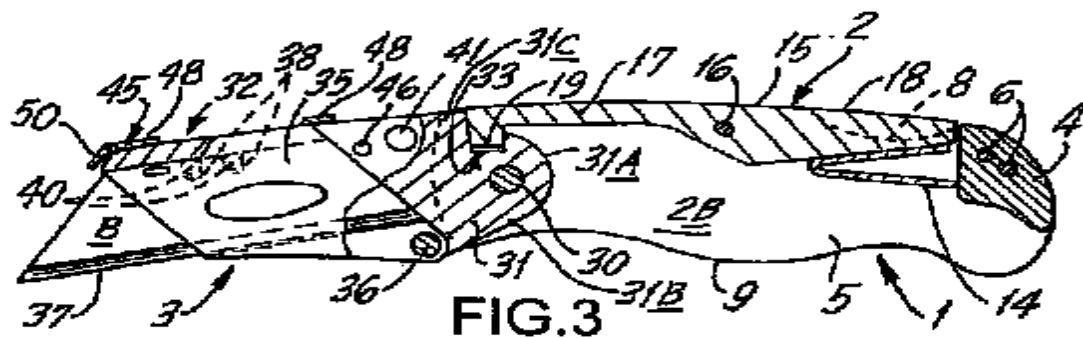


FIG. 3

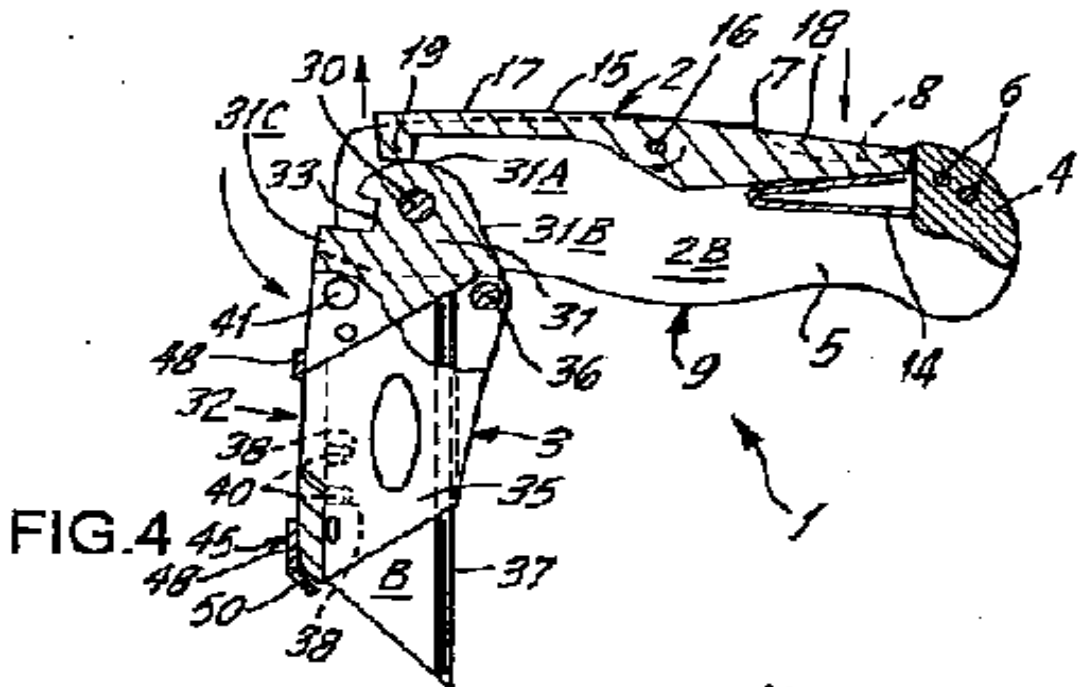


FIG. 4

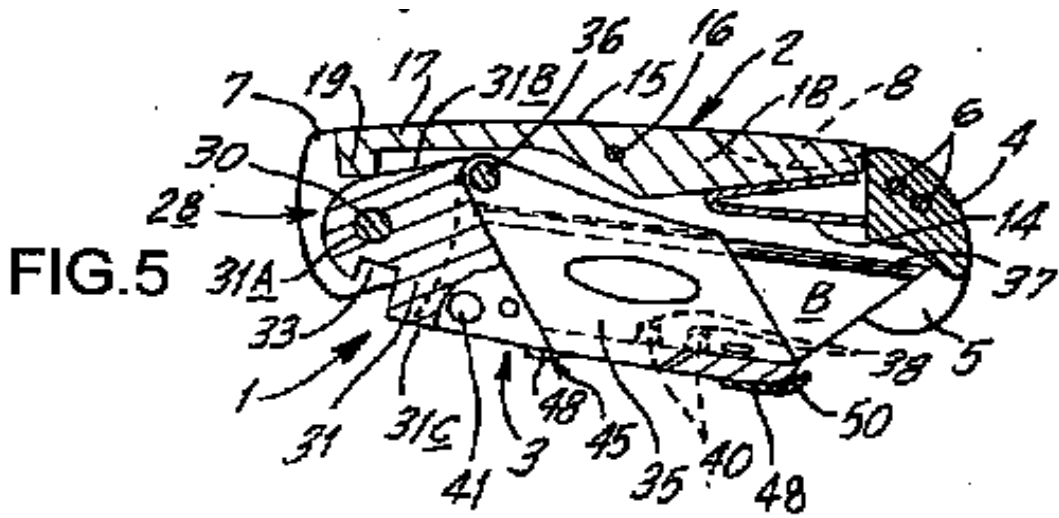


FIG. 5

Claim 1

54. As the above figures show, the knife disclosed by this document has a blade holder 3 that is pivotally mounted to a handle 2, between a folded position, in which a cutting edge of the blade is enclosed, as shown in figure 5, and an extended position, as shown in figures 1 and 3. In some regards it is very similar to the arrangements shown in the patent. However, although it possesses some of the features of claim 1, there is no disclosure in this document of a blade storage compartment within the handle of the knife. NZ528755 therefore does not anticipate claim 1, or any of the other claims.

## **Inventive step**

55. Having found that claims 1 to 3, 5 and 6 are anticipated by US6134788, I shall now consider whether the remaining claims involve an inventive step. The relevant provisions of the Act here are provided for by sections 1 and 3, set out above. Although not referred to by either side in the request or subsequent rounds of observations, I shall follow the test for inventive step as set out in *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588, the restated version of the well-known Windsurfing approach. In particular, I have to:

- (1)(a) Identify the notional “person skilled in the art”;
- (1)(b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art, or do they require any degree of invention?

56. I shall now apply this approach for the remaining claims of the patent, considering in turn each of US6134788 and NZ528755 as the “state of the art”.

### The person skilled in the art

57. I take the person skilled in the art here to be someone with practical knowledge of, and experience in, the design and manufacture of utility knives; the meaning of “utility knife” having already been considered above.

### The common general knowledge

58. The requester provides a number of documents that it submits represent the common general knowledge at the priority date of the patent (14 May 2004):

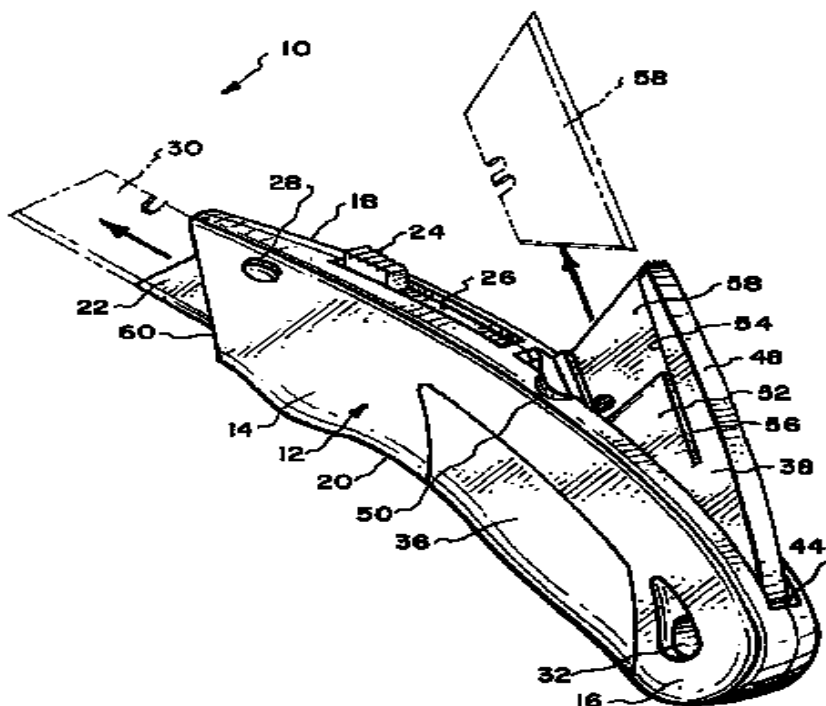
US6678958  
US6574872  
US4425709  
US4017969

US3927473  
US3896546  
US3829967  
US3604113  
US3593417  
US3577637  
US3509627

59. It does not go into any detail regarding these documents, except to suggest that they show it was well known to provide utility knives having a handle provided with a cover for enclosing a region containing replacement blades. I think it is worth briefly considering these documents in more depth.

US6678958, US3927473, US3604113, US3593417 and US3577637

60. Each of these documents shows a knife having replacement blades stored within a storage means inside the handle, which pivots outwardly to allow access to the blades. An example of such an arrangement is illustrated by figure 3 of US6678958, reproduced below, which shows a blade dispenser 38 pivotally mounted to a housing 12:

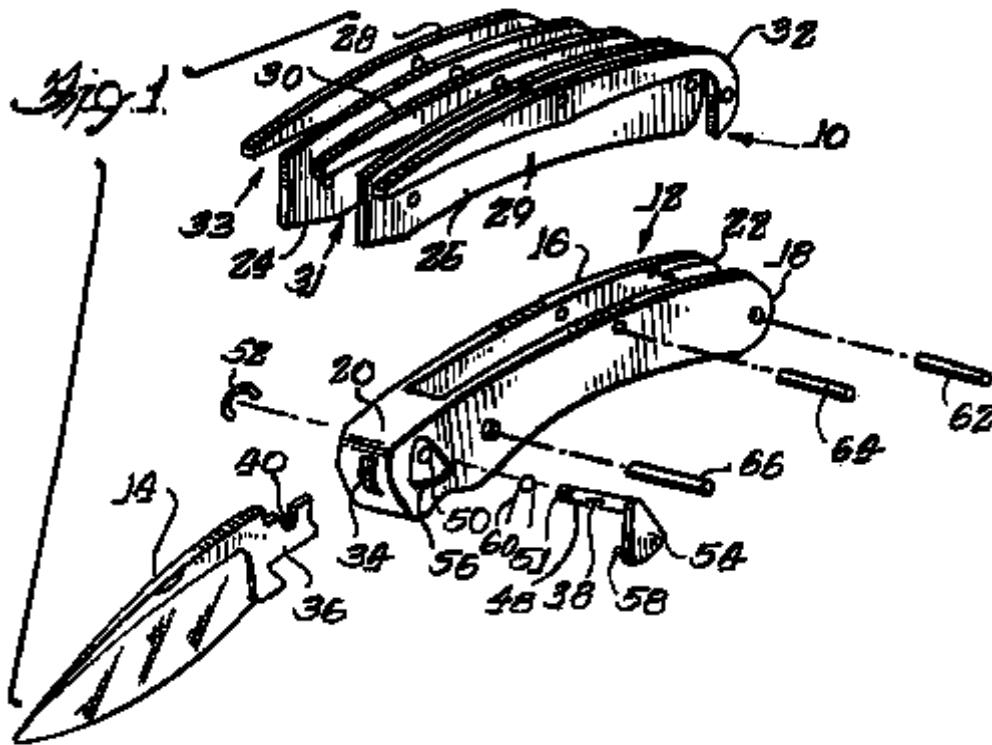


61. I do not think that any of these documents shows a knife provided with a cover for a blade storage compartment.

US6574872 and US3509627

62. Each of these documents discloses a knife where replacement blades

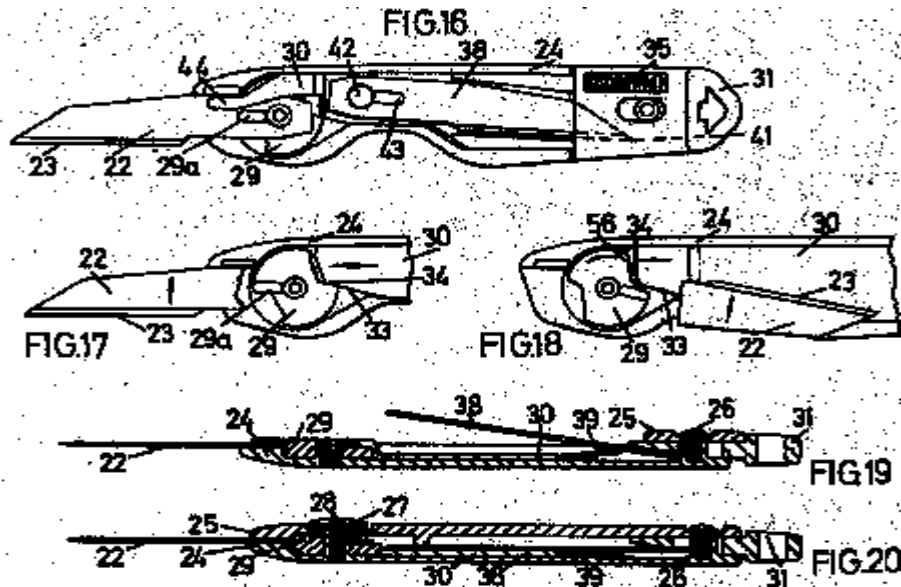




64. Alternative blades are stored within a number of slots provided inside the handle. The blade is not foldable, but is fixed in position during use and replaced by separation from the handle. The blade storage slots of the handle are not provided with a cover.

US3896546 and US3829967

65. These documents have a common assignee, and similar disclosures. Each shows a folding knife provided with blade storage means within the handle. Figures 16 to 20 of US3829967 are reproduced below, and show a blade 22 in its folded position, and a spare blade 38 stored within the handle. It is noted from figure 20 that the spare blade is not stored in a compartment that is spaced from the space in which the folded blade is received within the handle; rather, it is stored in the same space. For this reason, these documents do not represent novelty citations against claim 1. The blade storage compartments shown in these documents are not provided with a cover.



US4017969

66. Although the abstract of US4017969 refers to pivotally mounted replacement blades within the handle, on viewing the description and drawings of this document I can find no clear disclosure of such a feature. The embodiments shown in the drawings do not seem to show a storage compartment for replacement blades. I therefore do not find this document of any use in deciding the matter in hand.

#### Summary

67. I conclude from the above documents that the provision of replacement blade storage compartments in utility knives formed the common general knowledge of the skilled person at the priority date of the patent. I also think that the skilled person would have been aware that such compartments could be provided with a pivotally mounted cover.

#### Claim 4

68. Claim 4 is set out above, and I identify its inventive concept as being the provision of a utility knife having a folding blade stored in a space in a handle that is spaced from a blade storage compartment, the blade storage compartment comprising a slot, and a cover mounted pivotally within the slot.

69. The knife shown in US6134788 differs from the inventive concept of claim 4 in that it does not show a cover mounted within the slot of the blade storage compartment; rather, the cover is mounted to the outer surface of the handle. However, since none of the documents submitted by the requester discloses, or even suggests, the possibility of pivotally mounting a cover within

a blade storage compartment, I do not think there is any basis on which this claim could be considered obvious from US6134788. In any case, even if the requester had shown such a feature was common general knowledge, I can find nothing in this document that would motivate the skilled person to alter the cover arrangement shown in US6134788 in such a way. Mounting the cover 20 within the blade storage compartments 12 would necessarily result in less space to store spare blades, which I believe the skilled person would regard as disadvantageous. I therefore find that claim 4 involves an inventive step with regard to this document.

70. The knife shown in NZ528755 differs from the inventive concept of claim 4 in that it does not possess a blade storage compartment spaced from the space in which the folded blade is received, and it does not show a blade storage compartment in the form of a slot, where a cover is pivotally mounted within the slot. It follows on from my analysis of US6134788 that the requester has not provided any evidence that could lead me to think that the skilled person would find these differences obvious in view of what is disclosed in NZ527855.

#### Claim 7

71. I identify the inventive concept of claim 7 as being the provision of a utility knife having a folding blade stored in a space in a handle that is spaced from a blade storage compartment, the blade storage compartment being provided with a cover that has a hook, which cooperates with latch means provided on an outer wall of the knife to hold the cover in a closed position.

72. The difference between the above identified inventive concept and what is shown in US6134788 is that this document does not disclose a latch means that cooperates with hook means 22 of the cover 20. Again, however, none of the documents supplied by the requester shows, or suggests, the use of such a latch means that cooperates with a hook on a cover. In view of this, I cannot find that claim 7 is obvious from this document.

73. The knife of NZ528755 does not have a blade storage compartment, a cover for the blade storage compartment provided with a hook, or latch means that engage with the hook to keep the cover in a closed position. Again, none of the documents supplied by the requester shows, or suggests, these features, and so claim 7 also involves an inventive step over what is disclosed by this document.

#### Claim 8

74. I think the inventive concept of this claim can be summarized as the provision of a utility knife having a folding blade stored in a space in a handle that is spaced from a blade storage compartment, and where a magnet is

mounted within the blade storage compartment.

75. The knife shown in US6134788 differs from the inventive concept of claim 8 in that it does not have a magnet mounted within the blade storage compartment. I agree with the proprietor that none of the documents provided by the requester discloses such a feature, and I can find no reason to conclude that this claim is obvious from US6134788.

76. Again, the differences between the identified inventive concept of claim 8 and NZ528755 are greater still, as this document does not disclose a blade storage compartment spaced from the space that receives the folded blade, or a magnetic means mounted within the blade storage compartment. Clearly, I cannot find that claim 8 is obvious from this document either.

### Claims 9 to 13

77. I regard the inventive concept of claim 9 as being the provision of a utility knife having a folding blade stored in a space in a handle that is spaced from a blade storage compartment, a first wall of the blade storage compartment being mounted to, but spaced from, a side wall of the handle.

78. The knife shown in US6134788 differs from the inventive concept of claim 9 in that neither of the blade storage compartments 12 has a first wall mounted to, but spaced from, a side wall of the handle. The figures show that base 10, which defines the blade storage compartments 12 and the space 13 for receiving the folded blade, is made from one piece. However, once more, none of the documents submitted by the requester teaches an arrangement where a side wall is mounted to, but spaced from, a wall of a blade storage compartment, and so I cannot conclude that this claim is obvious from US6134788.

79. NZ528755 does not disclose a blade storage compartment spaced from the space in handle in which the folded blade is kept, and where a first wall of the blade storage compartment is mounted to, but spaced from, a side wall of the handle. It therefore follows on from the above that I cannot find claim 9 to be obvious from this document either.

80. Since I have found that claim 9 involves an inventive step, it follows that claims 10 to 13 also involve an inventive step.

### Claims 14 to 21

81. I identify the inventive concept of claim 14 as being a utility knife having a folding blade stored in a space in a handle that is spaced from a blade storage compartment, where a blade holder is provided that comprises a main wall and a movably mounted guard wall, between which the blade is mounted.

82. US6134788 differs from this inventive concept in that it does not show a blade holder comprising a main wall and a movably mounted guard wall. The only document provided by the requester that shows such an arrangement is NZ528755. Conversely, NZ528755 differs from the inventive concept of claim 14 in that it does not disclose a blade storage compartment in the handle spaced from the space that receives the folded blade.

83. Taking US6134788 as the starting point, the knife blades it shows are clearly designed to be introduced by insertion into an end slot 31 of unitary blade seat 30, and I can find nothing in this document that teaches the desirability of providing side access to the blade seat 30, of the type shown in NZ528755. Therefore, I do not think that combining the disclosures of these documents in this way is a feasible argument.

84. On the other hand, taking NZ528755 as the starting point, I think that the skilled person would appreciate that this document teaches a knife having a compact design. As can be seen from figure 5, reproduced above, the blade B and blade holder 3 occupy the whole of space 5 between handle halves 2A and 2B in the folded position. Consequently, although I have concluded above that blade storage compartments were part of the common general knowledge, I think the skilled person would conclude that there is no room available in the knife shown in this document for such a compartment, and that this is deliberate. It would take significant re-designing of the handle shown in this document to arrive at an arrangement that falls within the scope of claim 14, and in my view this could only be achieved with the benefit of hindsight.

85. I therefore consider that claim 14, and also claims 15 to 21, involve an inventive step with regard to US6134788 and NZ528755.

#### Claim 22

86. Omnibus claim 22 cannot be considered obvious from either US6134788 or NZ528755.

#### **Conclusion**

87. I therefore conclude that:

(i) Claims 1 to 3, 5 and 6, lack novelty with regard to US6134788, but do not lack novelty with regard to NZ528755.

(ii) On the basis of the evidence presented to me, claims 4, and 7 to 22 involve an inventive step.

### **Application for review**

88. Under section 74B and rule 98, the proprietor may, within three months of the date of issue of this opinion, apply to the comptroller for a review of the opinion.

### **NOTE**

*This opinion is not based on the outcome of fully litigated proceedings. Rather, it is based on whatever material the persons requesting the opinion and filing observations have chosen to put before the Office.*

Gareth Prothero  
Examiner