

OPINION UNDER SECTION 74A

Patent	GB 2406044
Proprietor(s)	Panasonic Corporation of North America
Exclusive Licensee	
Requester	Ms Nerys Hucker, on 9 December 2009
Observer(s)	
Date Opinion issued	8 March 2010

The request

1. The comptroller has received a request from Dyson Technology Limited (the Requester) to issue a validity opinion in respect of patent GB 2406044B (the Patent) granted to Matsushita Electric Corporation of America, now Panasonic Corporation of North America. The Requester asks that opinion take account of the following patent documents:

D1 – GB 2324956 A
D2 – WO 99/34722 A1
D3 – US 4384386
D4 – EP 0947155 A2
D5 – US 1770643
2. The Patent has a priority date of 3 October 2000. It was granted on 11 May 2005 and remains in force. All of the documents D1 to D5 listed above lie in the period defined by section 2(2) of the Patents Act 1977.
3. The Requester's position is that claims 1, 4, 7 and 8 of the Patent lack novelty in the light of D1. There is a brief indication that the Requester believes that these claims are obvious in the light of D1. The Requester then goes on to argue that claims 1 to 8 of the Patent are obvious in the light of a variety of combinations of D1 to D5.
4. The Requester acknowledges that US 4268769, the parent application of

D3, was considered during the substantive examination of the Patent. However the Requester contends that the use of D3 rather than its parent allows new questions to be posed, either by virtue of matter disclosed in its claims or by virtue of its new combination with D2.

5. The Requester also acknowledges that D4 was considered during the substantive examination of the Patent by the IPO, but not in combination with D2.

Observations

6. No observations have been received in response to the request.

Should D3 and D4 be considered in this opinion?

7. The IPO will not issue an opinion if the request merely covers an issue that has been sufficiently considered during the examination of the patent. The Requester asks that D3 be considered as a new document because it contains matter in its claims that is not explicitly disclosed in its parent US 4268769, but the Requester does not point to any of the claims of D3 in the arguments presented in the statement that accompanies the request. This distinguishes the present circumstances from those of opinion 19/09 in which the Requester used the extra, new information to support its arguments. Therefore I do not believe that I can consider D3 as a new document on the basis that its claims allow new questions to be asked because no questions are based on those claims.
8. However the Requester uses D3 in combination with D2 as the basis for some of his arguments. This combination is a new combination because D2 was not considered during substantive examination of the Patent at the IPO.
9. Similarly the Requester's combination of D4 with D2 is a new combination.
10. It follows that these new combinations allow new questions to be asked and that since there are new questions being asked neither D3 nor D4, when used in such new combinations, should be excluded from being considered in this opinion.

Claim 1 of the Patent

11. The Patent has a single independent claim, claim 1, that reads as follows:

A bagless vacuum cleaner, comprising:

a nozzle assembly;

a canister assembly;

a dust collection assembly carried on said canister assembly;

a suction fan and drive motor carried on said canister assembly; and

a rotary agitator with a self-contained agitator drive motor carried on said nozzle assembly.

12. Although this claim is couched in simple language its proper scope cannot be established readily because there are passages in the description that appear to contradict and/or conflict with the claim and the final lines of the claim are not clear. To resolve these difficulties I shall follow the usual *Kirin-Amgen*¹ approach to construe this claim, i.e. “what would a person skilled in the art have understood the patentee to have used the language of the claim to mean?”
13. The Requester has defined such a skilled person as someone, more likely a team of people, working in the design and manufacture of vacuum cleaners. This person or team of people will have such common general knowledge that they are familiar with the workings of vacuum cleaners particularly bagless ones. I am happy to adopt that definition.
14. The first problem arises in respect of “*a dust collection assembly carried on said canister assembly*”. This portion of the claim is consistent with the passage at page 8 lines 4 & 5, but it is contradicted by the passage at page 16 lines 16-18 which states that the dust collection assembly may be carried on the nozzle assembly.
15. A second set of problems arises in respect of “*a suction fan and drive motor carried on said canister assembly*”. This passage does not specify any relationship between the suction fan and the drive motor although it is clear from the description of the preferred embodiment that this particular drive motor is intended to drive the suction fan – see page 8 lines 5-8 for example. This passage of the claim further states that the suction fan and its associated drive motor are carried on the canister assembly but a contradictory passage in the description at page 8 lines

¹ *Kirin-Amgen Inc v Hoescht Marion Roussel Ltd* [2005] RPC 9

8-10 states that the suction fan and the motor may be carried on the nozzle assembly.

16. A third set of problems arises in respect of *“a rotary agitator with a self-contained agitator drive motor carried on said nozzle assembly”*. The preferred embodiment has an agitator drive motor mounted within the agitator – see figure 2. Nowhere in the description, apart from the statement of invention that corresponds to claim 1, is the agitator drive motor said to be self-contained. It is not clear if it is the agitator, its drive motor or a combination of the two that should be carried on the nozzle assembly. The passage at page 16 lines 13-16 states that the drive motor can be positioned either within or without the agitator and either on the nozzle assembly or on the canister assembly. The passage at page 5 lines 13 & 14 muddies the waters in a similar fashion.
17. Some further guidance on how to construe claims is given by Pumfrey J in *Halliburton v Smith* [2006] RPC 2. At paragraph 68 he lists the principles of claim construction. It appears to me that principle (g) is the most appropriate one of those principles to apply when there are inconsistencies between the claim and the description, as in the case of the Patent:

“(g) if the patentee has included what is obviously a deliberate limitation in his claims, it must have a meaning. One cannot disregard obviously intentional elements.”
18. In the light of the straightforward manner in which the patentee has drafted his claim I take the view that the patentee has deliberately limited that claim to state that the dust collection assembly is carried on the canister assembly and that the suction fan and drive motor are also carried on the canister assembly.
19. Pumfrey J adds some more guidance at paragraph 69:

“It is very rare that some sensible meaning cannot be attributed to the words used in a patent claim, but where a claim permits alternative interpretations it is possible to be left with no alternative but to take the most straightforward.”
20. This guidance will assist me to resolve both the relationship between the suction fan and the drive motor and the relationships between the rotary agitator, the agitator drive motor and the nozzle assembly.
21. It is my view that when faced with the various ambiguities and contradictions surrounding claim 1 the most straightforward approach available to the skilled person is to identify claim 1 with the described

preferred embodiment shorn of all alternatives.

22. It is my view that the skilled person would understand that the drive motor specified in “*a suction fan and drive motor carried on said canister assembly*” is the motor used to drive the suction fan.
23. Adopting the same approach to “*a rotary agitator with a self-contained agitator drive motor carried on said nozzle assembly*” it is my view that the skilled person would take this passage to mean that the agitator drive motor is located within the rotary agitator and that the combination of the rotary agitator and its drive motor is carried on the nozzle assembly.

Are claims 1, 4, 7 and 8 of the Patent novel in the light of D1?

24. D1 relates to power supply arrangements for electric motors that may be used to operate a vacuum cleaner. A secondary motor is built into and drives a brush bar or agitator. This secondary motor derives its power supply from a primary motor. The function of this primary motor is not stated explicitly but I infer from the opening of the description that the primary motor drives a suction fan that provides a suction airflow through the cleaner. In D1 the brush bar or agitator of a vacuum cleaner is said to be usually mounted in the dirty air inlet located in the cleaner head, what the Patent refers to as a nozzle assembly.
25. The Requester argues that although a canister assembly and a dust collection assembly are not mentioned explicitly in D1 the skilled person would infer their presence as part of the implicit disclosure. The Requester then goes on to argue that the mounting of the dust collection assembly upon the canister assembly should also be inferred, leading one to conclude that D1 anticipates claim 1 of the Patent.
26. I agree with the first part of the Requester’s argument. I believe that a canister assembly and a dust collection assembly are necessarily present if the apparatus is to function as a vacuum cleaner. I disagree that a dust collection assembly mounted upon the canister assembly is necessarily present. A variety of mounts are available, one only has to look to the Patent for some examples. Thus I believe that a dust collection assembly mounted upon the canister assembly does not form a part of the implicit disclosure of D1.
27. Nor do I believe that the feature of the suction fan and its drive motor being carried by the canister assembly can be inferred in D1. Such a feature cannot be taken as a part of the implicit disclosure of D1.

28. In short claim 1 of the Patent, when construed in the manner that I have construed it above, is novel over D1. It follows that claims 4, 7 and 8 are similarly novel.

Are claims 1, 4, 7 and 8 of the Patent obvious in the light of D1 alone?

29. I shall follow the usual *Pozzoli*² approach to decide this question. I have identified the relevant skilled person and their common general knowledge at paragraph 13 above. The inventive concept is recited in claim 1 of the Patent as I have construed it above.
30. The immediately preceding paragraphs indicate that the differences between what is disclosed in D1 and what is recited in claim 1 as I have construed it lie in how the various parts or assemblies are mounted together.
31. By itself D1 provides very limited information about the physical construction of a vacuum cleaner. There is no explicit teaching of a canister assembly, a dust collection assembly or how those two assemblies should fit together with a suction fan and its associated drive motor and a nozzle assembly. There is nothing to lead the skilled person towards the particular arrangement set out in claim 1 of the Patent.
32. Thus I believe that claim 1 of the Patent is not obvious in the light of D1 alone. It follows that claims 4, 7 and 8 also are not obvious in the light of D1 alone.

Is claim 1 of the Patent obvious in the light of D2 when combined with either D1, D3, D4 or D5?

33. Again I shall follow the well-known *Pozzoli* approach in deciding this question. As before the skilled person or team, the common general knowledge and the inventive concept have been identified above.
34. In respect of this question the Requester's argument can be summarized as D2 provides all the features of claim 1 except for the integral motor within the rotary agitator but this missing feature is to be found in either D1, D3, D4 or D5, and so claim 1 is no more than an obvious combination of these documents.
35. Adopting the language of claim 1 as I have construed it above and interpolating the references from the figures of D2 it is clear that D2

² *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

shows a bagless vacuum cleaner (A) comprising a nozzle assembly (C), a canister assembly (B), a dust collection assembly (F, G) carried on said canister assembly and a suction fan and its associated drive motor (E) carried on said canister assembly. A rotary agitator (36) is shown carried on the nozzle assembly but no details are given concerning how it is driven.

36. Therefore I agree with the Requester that the differences between claim 1 as I have construed it and D2 lie in the details of the rotary agitator and its drive arrangement.
37. I also agree with the Requester that each one of D1, D3 and D4 discloses a rotary agitator brush driven by a motor mounted within that brush in the context of a vacuum cleaner and that this rotary agitator assembly is carried at the nozzle assembly of the vacuum cleaner.
38. D5 discloses a similar powered rotary brush assembly for use in a floor brush. There is no mention of a vacuum cleaner in D5 but the Requester contends that this rotary agitator assembly is suitable for use with a vacuum cleaner.
39. There is no simple rule as to whether information from different documents, or from different parts of a single document, can properly be combined as a "mosaic" to provide a case that an invention is obvious. In order to establish that a combination of teachings from the prior art shows an invention to be obvious, it must be likely that the skilled person would have considered those teachings together. In *Dow Chemical Company (Mildner's Patent)*, [1973] RPC 804, Whitford J indicated that in order to establish obviousness from a combination of documents it is necessary to consider the extent to which you can conclude that the documents are ones which the seeker after information would come across and would consider together.
40. Laddie J in *Pfizer Ltd's Patent* [2001] FSR 16 at paragraph 66 stated:

"When any piece of prior art is considered for the purposes of an obviousness attack, the question asked is "what would the skilled addressee think and do on the basis of the disclosure?" He will consider the disclosure in the light of the common general knowledge and it may be that in some cases he will also think it obvious to supplement the disclosure by consulting other readily accessible publicly available information. This will be particularly likely where the pleaded prior art encourages him to do so because it expressly cross-refers to other material. However, I do not think it is limited to cases where there is an express cross-reference. For example if a piece of prior art directs the skilled worker to use a member of a class of ingredients for a particular

purpose and it would be obvious to him where and how to find details of members of that class, then he will do so and that act of pulling in other information is itself an obvious consequence of the disclosure in the prior art.”.

41. The Manual of Patent Practice³ also counsels caution when mosaicing individual documents together:

In determining whether an invention is obvious in the light of a given document combined with common general knowledge, other documents, or instances of prior use, there are two major considerations: (i) whether the skilled person could reasonably be expected to find the document in conducting a diligent search for material relevant to the problem in hand (see 3.26 & 3.44) and (ii) whether, if he had found the document, he would have given it serious consideration. So far as (ii) is concerned, relevant factors may be the age of the document (see 3.38 & 3.39) and whether, if it is one of a large number, there was any reason why the skilled person should have selected it (see 3.88). Passages which lead away from the applicant's invention must be taken into account as well as those that lead towards it. It is relevant in looking at a prior document to consider whether the matter of interest to the obviousness question constitutes a principal feature of the prior document or whether it is mentioned merely as a detail in the performance of an entirely different concept, without any recommendation to the reader which would encourage him to use it in different circumstances.

42. There can be little or no doubt that D1 to D5 are documents that the skilled person would come across in conducting a diligent search. D1, D2, D3 and D4 all lie in what can be called the vacuum cleaner art whilst D5 lies in a closely-related art.
43. Would the skilled person have given serious consideration to the combination of D2 with any one of D1, D3, D4 or D5?
44. On the one hand the principal feature of D2 is an improved airflow cleaning arrangement; the rotary agitator is merely a peripheral detail.
45. On the other hand each one of D1, D3 and D4 indicates that there are advantages in terms of size and weight to be gained by introducing a rotary agitator driven by a motor mounted within the agitator. D1 specifically concerns itself with bagless vacuum cleaners and there is nothing in D3 or D4 to indicate that their rotary agitator assemblies would not function as described if they were applied in the context of a bagless vacuum cleaner.

³ MOPP 3.75.1

46. On balance I believe that the skilled person would recognize and readily appreciate the advantages that would accrue from the teachings of D1, D3 or D4. To me it follows that the skilled person would assess the likelihood of success sufficient to warrant at least a trial – it would be “obvious to try”. I believe that the skilled person would seriously consider combining or mosaicing together D2 and the teachings of any one of D1, D3 or D4.
47. I do not believe that the skilled person would combine D5 with D2. D5 does not lie in the vacuum cleaner art and no particular advantages are specified for its invention. There is nothing here to motivate a combination or mosaic.
48. Thus I believe that claim 1 as I have construed it does not involve the required inventive step in as much as it is obvious in the light of the combination of D2 with any one of D1, D3 or D4.

Dependent claims

49. The characterizing features of claims 2, 3, 4 and 5 are clearly visible in at least both D2 and D4, and so none of these claims involve an inventive step.
50. The characterizing feature of claim 6, a control switch on the vacuum cleaner hand grip, is shown in D4. Consequently I agree with the Requester that this claim is obvious.
51. Both D1 and D4 discuss a gearing mechanism being used to convey drive from the agitator drive motor housed within the agitator to the agitator, and the gearing mechanism of D1 is described as epicyclic which is a well-known synonym for a planetary gearing mechanism (see Wikipedia for example). Therefore neither claim 7 nor claim 8 involves an inventive step.

Opinion

52. I conclude that the claims of the Patent are invalid because claim 1 lacks an inventive step in the light of any one of D1, D3 or D4 when combined with D2 and because dependent claims 2 to 8 lack any inventive step in the light of the combinations of D1, D2, D3 and/or D4 that I have discussed above.

Application for review

53. 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.

Peter Easterfield
Examiner