Intellectual Property Office

BL O/218/19

26 April 2019

PATENTS ACT 1977

APPLICANT	Batesville Services Inc.
ISSUE	Whether patent application GB1314522.2 complies with section 1(1)(b) of the Patents Act 1977
HEARING OFFICER	Phil Thorpe

DECISION

Introduction

1 Patent application GB1314522.2 entitled "Cremation urn with decorative applique applied to" was filed on 14th August 2013 with an earliest priority claim from US application 12/61683525 which was filed on 15th August 2012. The GB application was published on 9th April 2014 having publication number GB2506741.

2 Despite a number of rounds of correspondence between the examiner and the applicant's attorney, and amendments of the claims, the applicant was unable to satisfy the examiner that the application met the requirements of the Patents Act 1977 (the Act). In particular the examiner was not satisfied that the claimed invention involves an inventive step.

3 The matter subsequently came before me at a telephone hearing on 1st February 2019 at which the applicant was represented by Ms Findlay of Reddie and Grose LLP.

The Patent

4 As shown in the figures reproduced below, the application relates to a cremation urn with a container 12 for receiving the cremation remains of the deceased and a separate receptacle 30 which houses a decorative applique 40. The applique can be an item such as a simulative gemstone 42 or a medallion 50. The specification also discloses a particular shape of urn to help stabilise it thus reducing the likelihood that it could be tipped over.

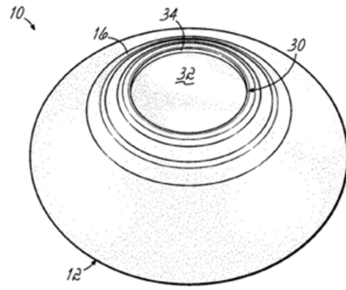

FIG. 1

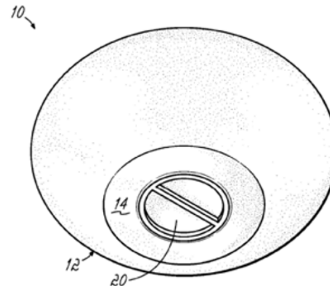

FIG. 2

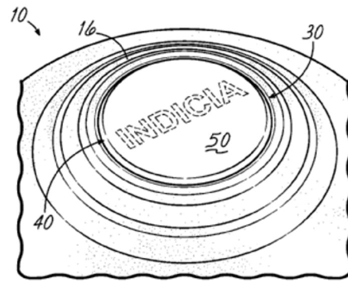

FIG. 3B

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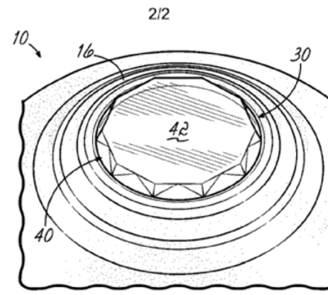

FIG. 3A

5 The independent claims as originally filed were focussed on the provision of the receptacle and the applique. During a number of rounds of correspondence the independent claims were amended to include also limitations in relation to the shape of the container. The latest claims were filed on 13th February 2018 and include independent claims 1 and 12 which read:

> *1. A cremation urn comprising:*
> *a container having a lower end, an upper end, and being sized and configured to receive therein cremation remains of a deceased,*
> *an access cover removably secured on said lower end of said container providing access to an interior of said container,*
> *a receptacle on said upper end of said container, said receptacle having a bottom wall and an upstanding side wall extending peripherally around said bottom wall, and*
> *an applique secured in said receptacle, wherein said container has a circular cross-section that varies from said lower end to said upper end, wherein said cross-section at its largest has a diameter dimension that exceeds a height dimension of said container by a factor of about 2 and wherein said largest cross-sectional diameter dimension occurs nearer to said lower end than to said upper end, thereby stabilizing said urn and reducing a likelihood that said urn will be tipped over.*
>
> *12. A method of personalizing a cremation urn for a deceased comprising the steps of:*
> *selecting a cremation urn comprising:*
> *a container having a lower end, an upper end, and being sized and configured to receive therein cremation remains of a deceased, wherein said container has a circular cross-section that varies from said lower end to said upper end, wherein said cross section at its largest has a diameter dimension*

that exceeds a height dimension of said container as claim 1, thereby stabilizing said urn and reducing a likelihood that said urn will be tipped over,
an access cover removably secured on the lower end of the container providing access to an interior of the container, and
a receptacle on the upper end of the container, the receptacle having a bottom wall and an upstanding side wall extending peripherally around the bottom wall,
selecting a colored simulative gem stone from a plurality of differently colored simulate gem stones, and
directing that the selected colored simulative gem stone can be secured in the receptacle.

6 The urn being created by the method of claim 12 differs slightly from the urn defined by claim 1 in for example it requires a specific type of applique however they are similar in substance such that if one is inventive the other is likely to be inventive too. I will therefore base my main consideration of inventiveness on claim 1, which appears to be the broader claim, before checking to see whether this conclusion is also applicable to claim 12.

The law

7 Section 1(1) states (with added emphasis):

> *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) it is capable of industrial application;*
>
> *(d) the grant of a patent for it is not excluded by subsections (2) and (3) or section 4A below;*

8 Section 3 then sets out how the presence of an inventive step is determined. It says:

> *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).*

Determination of inventive step

9 In *SABAF SpA v MFI Furniture Centres Ltd*[1], Lord Hoffmann held that before you can ask whether the invention involves an inventive step, you first have to decide what the invention is. In particular, the first step is to decide whether you are dealing with one invention or, for the purposes of section 3, two or more inventions. If two integers interact upon each other, if there is synergy between them, then they constitute a single invention having a combined effect and one applies section 3 to the idea of combining them. But if each integer performs its own proper function independently of any of the others, and the claim is a mere aggregation or

[1] *SABAF SpA v MFI Furniture Centres Ltd* [2004] UKHL 45

juxtaposition of features, then each is, for the purposes of section 3, a separate invention. The combination of a series of known or obvious features, each playing its usual part in the final entity, is a matter of design or mere collocation, not of invention, and so is objectionable under section 3. Lord Hoffmann noted that:

> "If the two integers interact upon each other, if there is synergy between them, they constitute a single invention having a combined effect and one applies section 3 to the idea of combining them. If each integer "performs its own proper function independently of any of the others", then each is for the purposes of section 3 a separate invention and it has to be applied to each one separately."

10 Further guidance on this can be found in the EPO Technical Board of Appeal decision in T 1054/05 where it was noted that:

> "Two features interact synergistically if their functions are interrelated and lead to an additional effect that goes beyond the sum of the effects of each feature taken in isolation. It is not enough that the features solve the same technical problem or that their effects are of the same kind and add up to an increased but otherwise unchanged effect."

11 In the hearing Ms Findlay identified the invention here as relating to the combination of the receptacle at the upper end and the shape of the container. She went on to argue that these the two features do interact.

12 There is in my view no suggestion that the positioning of the receptacle, with or without the applique, improves the stability of the urn and in fairness to Ms Findlay she did not seek to argue otherwise. What Ms Findlay did seek to argue was that the shape of the container provided stability and that, coupled with positioning of the receptacle, ensured that the contents of the receptacle remain visible.

13 I am on balance prepared to accept this argument. In doing so I drew an analogy here with for example a floating marker buoy having a light on an upper surface wherein the buoy is shaped such that it is predisposed to float with the light uppermost. In that example the shape of the float and the positioning of the light combine to provide a visible light. The invention here is similar. Although not explicitly stated in the application, the objective of the invention is to provide an urn with a receptacle that is visible and which can contain some form of personalisation. The placement of the receptacle at the upper end of the urn will facilitate this as will also the shaping of the urn to reduce the likelihood of the urn tipping over.

14 Having determined that I am dealing with one invention I turn now to consider whether that invention is obvious.

15 It is well-established that the approach to adopt when assessing whether an invention involves an inventive step is to work through the steps set out by the Court of Appeal in *Windsurfing*[2] and restated by that Court in *Pozzoli*[3]. These steps are:

> *(1)(a) Identify the notional "person skilled in the art"*
>
> *(1)(b) Identify the relevant common general knowledge of that person;*

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[2] *Windsurfing International Inc. v Tabur* Marine (Great Britain) Ltd [1985] RPC 59
[3] *Pozzoli SpA v BDMO SA* [2007] EWCA Civ 588, [2007] FSR 37

(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?

Identify the notional "person skilled in the art" and the relevant common general knowledge of that person

16 The skilled person has been identified during prosecution of this application to be a designer and manufacturer of cremation urns. I am content to accept that.

17 Such a person will be aware of the range of styles which can be employed when designing the container and the mechanical considerations which need to be factored into this. During the hearing Ms Findlay was happy to accept that this would include an awareness that making a wider diameter in a lower region would increase the stability of the urn.

18 A number of documents have been identified during the prosecution of the application which the examiner believes demonstrate the common general knowledge in relation to possible shapes for the container. The three relied on most recently all relate to ancient jars and containers albeit depicted in modern publications. These were referred to as documents D11–D13 during the examination and I will retain that numbering here. D11 & D12 show a container with a largest diameter which exceeds the height dimension by a factor of about 2 wherein the largest diameter is nearer the lower end than the upper end.

Documents D11and D12

D13 similarly depicts a container having a similar shape with a bulbous section near the lower end of the container however the proportions are not as required by claim 1.

Document D13

19 None of documents D11-D13 relate specifically to funeral urns and I think there is a meaningful distinction in terms of identifying what would represent common general knowledge for the design of containers more generally and what would fall within the common general knowledge for cremation urn design. Whilst perhaps not the clearest evidence on balance I think the designs are however sufficiently similar to those employed for cremation urns to be considered an indication of what types of design would be known in this field to a person skilled in the art. Ms Findlay did not raise any objections to these being indicative of something which would fall within the range of possible shapes known to a person skilled in the art during the hearing.

20 Ms Findlay did however note that whilst there were containers which show this shape, they were clearly only examples of a very wide range of options which could be employed when designing a container and I think this is a reasonable point. In support of this she referred me to a number of documents previously cited by the examiner which were no longer being relied on. These included documents D8-D10 showing the following three ancient jars and containers which were also depicted in modern publications. Again, none of these containers are explicitly for use as urns.

21 The proportions of these containers are also not those required by the claim. All of these shapes will however also be matters of common general knowledge.

Identify the inventive concept of the claim in question or if that cannot readily be done, construe it.

22 The inventive concept is clearly set out in the language of claim 1 which as a whole is relatively straightforward. During the hearing Ms Findlay raised a point regarding the construction of the requirement for the receptacle to be on an upper end of the container. She suggested that the claim should be construed to require the

receptacle to be on the very upper surface of the urn rather than an upper portion in a more general sense with this distinction being relevant when considering the prior art.

23 The approach to construction 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[4]. The starting point for interpreting words will usually be their normal meaning and the wording ‘upper end’ would appear to refer to a region rather than a specific surface. The embodiments in the application refer to the receptacle being on the upper end 16 of the container 12 and the access cover 20 being removably secured to the lower end 14 of the container 12. Whilst the embodiments show the receptacle on an uppermost part of the container and the access cover on the lowermost surface of the container, when read as a whole I cannot see that this provides sufficient reason to depart from what would normally be understood by the language in this context. As such I have construed the term ‘upper end’ to refer to a region of an urn at a top of the urn but not restricted to the very upper surface. Similarly, lower end would not be construed to be the lowermost surface.

24 Although it was not really discussed at the hearing, I need also to say something about the reference to the presence of the “applique” in the claim. As I have already noted the description gives a number of examples of what such an applique might be including a simulated gemstone or a medallion. The description notes that the applique provides a way of personalising the urn. However, the description, including as recently amended, also includes with reference to the figure shown above the following:

> “Referring to Fig. 3C, note that receptacle 30 could also be left empty, i.e. no appliqué 40 placed therein, In that case, the bottom wall 32 could be engraved as at 60 with the deceased's name, date of birth, date of death, and the like.”

25 The presence of the applique is however clearly an essential part of the invention claimed in claim 1 as is the selection of a coloured simulative gem stone in claim 12.

26 Ms Findlay also sought to highlight the importance of the visibility of the applique in the invention. This is not explicitly brought out either in the claim or the wording of the description though there is equally nothing to suggest it would not be visible. I would note that the figures do show that the applique is visible and the positioning of the applique on an upper surface further supports this argument. Hence, I believe that the skilled person would understand that the patentee did indeed intend in its claims that the applique would be visible.

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

27 US5379499 referred to as document D1 has been identified as the best starting point for showing the state of the art. This shows, with reference to the figure below, an urn with a container 12 with a removable access cover 30 secured to the lower end of the container. A receptacle 40 is provided at an upper end of the container. This has a bottom wall and upstanding side walls. According to the description objects 64, such as a memorial scroll, small personal items including wedding rings,

[4] *Actavis Group PTC EHF v ICOS Corporation & Ors* [2017] EWCA Civ 1671

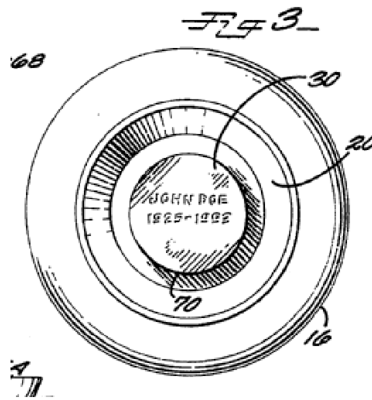
class rings, medals, religious symbols, Masonic insignia, photographs, etc. can be placed in the receptacle 40. The receptacle 40 is sealed by a plug 50. According to the description the objective of the invention is to in effect conceal the presence of the receptacle 40 and its contents which might be personal items of the deceased. It seeks to do this by creating the appearance that the plug 50 seals the main container part of the urn ie the part containing the ashes. This it is suggested would discourage the ideally curious or would be thief from removing the plug 50. Hence in contrast to the invention in issue here the contents of container 40 are not intended to be visible.

Document D1

28 Ms Findlay contended that the container 40 is not provided on the upper part of the urn. I have already determined that upper part is not restricted to the upper surface hence I am satisfied that container 40 is provided on an upper end of the urn. Indeed I would go further to argue that it is also provided on the upper surface of the urn which I take to be the part of the urn on which the flange of the container 40 sits even though this is below the uppermost level of the urn. I do not accept Ms Findlay argument that the upper surface of the urn is the uppermost surface of the outwardly tapering flanges 18.

29 At the hearing Ms Findlay also argued that the contents of container 40 in D1 were not visible and that this distinguished it from the invention in issue where the contents ie the applique were intended to be visible. I accept that the contents of the container in D1, which Ms Findlay did not contest could be considered to be the "applique" of the claimed invention are not intended to be visible. I did note however that the description of D1 notes with reference to the figure shown below that plug 50 "may have a plate 70 attached thereto, engraved or stamped with identifying data

(FIG. 3)”. It is at least arguable that the plug which locates in the container 40 could also be considered as the applique and that that clearly remains visible.



30 It is not in dispute that D1 fails to disclose a largest diameter which exceeds the height dimension by a factor of about 2 though I am satisfied that D1 does meet the requirement that the “*largest cross-sectional diameter dimension occurs nearer to said lower end than to said upper end”.*

31 The differences between D1 and the inventive concept are therefore either just the particular ratio of diameter to height if the plug 50 is considered to be the applique or the particular ratio plus the visibility of the contents of the receptacle if the plug is not considered to be the applique.

32 At the hearing Ms Findlay also referred to US2010/0011549 (Document D2) which was cited during the examination of the patent. As shown in figure 1B below, this document discloses an urn with a main body 20 and a cavity 16 in an upper part of the urn which can be used to display memorabilia such as a medal 18. The contents of the cavity are visible through transparent cover 14.

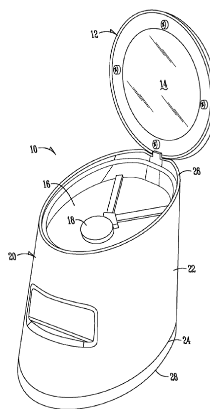


Fig.1B

Document D2

33 The difference between this document and the inventive concept in issue is the shape of the container in particular it fails to show a container that has either the required ration of width to height or the largest diameter nearer to the lower end of the container than to its upper end.

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?

34 The disclosure of D1 is mainly focused on the provision of the second container 40 and the shape of the container is fairly incidental to this. This is most clearly brought out in column 4 lines 16-24 to which I was referred by Ms Findlay. This reads as follows:

> "Container 12 may have any desired, aesthetic shape, including the generally curved shape with outwardly flanged portions 14, 16 shown in FIGS. 1 and 2. Flanges 18, 20 are preferably recessed to conceal plug 30 and provide more stability for urn 10. However, portions 14 and 16 may be straight or inwardly flared rather than outwardly flared as shown, and container 12 may assume other shapes such as a cylinder, pedestal, obelisk and so forth."

35 Ms Findlay contended firstly that there needs to be a trigger to prompt someone to modify the shape of the containers in D1, or for that matter D2, to that of the inventive concept here. In support of this Ms Findlay referred me to *Vernacare Limited vs Environmental Pulp Products Limited*[5] in particular paragraph 41 which reads:

> "41 …. As a matter of principle, the skilled person reads any given piece of prior art with interest. However, as a matter of principle again, once they have done so, there is nothing to say as a matter of law that the skilled person is not entitled to say having read it with interest, "I have read it with interest, but I am not interested." The context is vital. In my judgment there is nothing in this document which adds to the common general knowledge from the point of view of someone reading it in 2006. A skilled person in this case, as I have defined that person, would read it and see nothing of interest in it. There is nothing here, in my judgment, to trigger a skilled person to do anything at all, except perhaps to make a butter tray of that shape if that is what they wanted to do. I think the argument that this would make a hospital product obvious is not one which is fair to inventors and in my judgment the claim is not obvious over Chaplin."

36 It is however useful to consider the patent in issue in that decision. It relates to receptacles and in particular, but not exclusively, to receptacles for use as wash bowls in hospitals, nursing homes and the like. The inventive concept was considered to be well defined in the claim which reads:

> "An upwardly open wash bowl manufactured from maceratable, dried moulded paper pulp, the wash bowl comprising a base wall and an enclosing wall extending upwardly from the periphery of the base wall and defining a liquid-receiving volume, the enclosing wall comprising recesses located on opposite sides of the liquid-receiving volume below the upper periphery of the enclosing wall and forming grip means located below the upper periphery of the enclosing wall for facilitating lifting."

37 Paragraph 41 was considering an attack on obviousness based on a prior art document (Chaplin) disclosing moulded fibre containers or trays commonly known as butter or lard trays. The question that the judge was addressing was whether it would be obvious to make a hospital product based on the disclosure in this document. As he noted context is vital. In that case he concluded that there was nothing in that document that would lead the skilled person to the invention.

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[5] *Vernacare Limited vs Environmental Pulp Products Limited* [2012] EWPCC 41

38 Secondly Ms Findlay emphasised that because the skilled person could modify the urns in D1 and D2 was not enough to demonstrate obviousness. What matters is whether the skilled person would do that. She referred in this respect to paragraph 47 of *Vernacare* which was considering whether it was obvious to make a wash bowl from paper pulp (the first attack). This reads:

> "47 I do not accept this first attack. It seems to me it is based on submissions and evidence to say that one "could" use routine options to end up inside the claim. That is true, but again it is not fair to inventors. Although the law is not as simple as saying that "could" is not enough to show obviousness, whereas what one needs is always "would", on the facts of this case, with a simple invention, it is plain that one "could" do all of these things. The issue is whether there was a motivation to make a specific arrangement of strengthening ribs which would end up inside the claim. There was no evidence of that and nothing that was put to Mr. Waller established that one would be motivated to make recesses which actually satisfied claim 1 on this approach. I reject Mr. Davis' first attack over common general knowledge alone."

39 Ms Findlay's final point, again drawing on *Vernacare*, was to argue that if the invention here is obvious why has it not been done before especially given the simplicity of the invention?

40 It is I believe important to remember that the question of obviousness is fact specific. There is a danger in seeking to draw too heavily from earlier cases though I accept that Ms Findlay was only seeking to draw some broad principles and then apply them to the facts in issue here. The first and second essentially relate to the question of motivation. On this I would observe that a lack of motivation is not fatal to an attack on obviousness though motive can be one of many factors that need to be considered when answering whether something is obviousness. I suggested to Ms Findlay that the motivation here would be the desire to improve the stability of the urn shown in D1. Ms Findlay's response was that the skilled person would not necessarily be moved to make either of the urns in D1 or D2 more stable and if they did then they would not necessarily choose the particular shape of the inventive conceptive here.

41 I am not persuaded. Clearly the stability of the urn will be a key design feature. This is recognised in the part of the description taken from D1 that is reproduced above. Ms Findlay highlighted the presence of flanges 16 in D1 which provide stability with the suggestion that this would lead a person skilled in the art away from making further adaptions to increase stability. That may be the case. Equally it might be that a person seeking to increase the stability of the urn in D1 might look first to increase the width of the contact points between the urn and its supporting surface. But what matters is whether it would be obvious to the skilled person that further increasing the width of the bulbous lower part of the urn in D1 would lead to the urn being more stable, or at least prone to tip less far. Notwithstanding that there are any number of possible designs for containers that will be known to the skilled person, I think it is fair to say that the skilled person would be drawn to the sort of shapes shown in D11-13 which are already similar to that shown in the figures of D1 and that they would arrive at the specific proportions set out in the claim with no inventive effort.

42 It would also I believe be obvious to the person skilled in the art seeking to improve the visibility of the applique in D1, assuming that the engraved plug 50 is not to be considered the applique, would be able to do so without any inventive effort. He could for example simply remove the plug.

43 I would note finally that the fact that no one has sought to do this before the inventor here does not, especially in the absence of any clearly presented reasons as to why it had not been done before, alter my view on obviousness.

44 Having concluded that claim 1 is obvious in light of D1 it is not necessary to go on and consider whether it is also obvious in light of D2. I would observe however I believe that D1 presents a much stronger starting point than D2 such that if I am wrong on D1 then I would expect the invention also to be inventive in light of D2.

Claim 12

Claim 12 essentially differs from claim 1 in the additional requirement for the applique to be a coloured simulative gem. Given the presence of a decorative attachment to the plug of D1 I think it would be obvious to replace this with a simulative gem such that the claim also lacks an inventive step.

Dependent claims

45 Consideration of the novelty and inventiveness of the dependent claims has been deferred in the examination process and this hearing does not therefore cover them.

Conclusion

46 Having carefully considered the arguments I am of the view that the invention as defined by claims 1 and 12 is obvious having regard in particular to the disclosure in US5379499 (Document D1).

47 Since there may be scope for amendments to be made to render the claims novel and inventive and with time possibly remaining to the compliance period I am remitting the case back to the examiner to consider any further amendments.

Appeal

48 Any appeal must be lodged within 28 days after the date of this decision.

Phil Thorpe
Deputy Director, acting for the Comptroller