



PATENTS ACT 1977

APPLICANT	Mr Brian Eke
ISSUE	Whether patent application GB1605739.0 complies with section 1(1)(b) of the Patents Act 1977
HEARING OFFICER	J. Pullen

DECISION

Introduction

- 1 Patent application GB1605739.0 relating to a wheeled luggage case was filed by the applicant, Mr Brian Eke, on 2 April 2016. The application was published as GB 2548927 A on 4 April 2017.
- 2 In his initial combined search and examination report the examiner, Mr Gary Clements, found the invention to lack an inventive step over what had been previously disclosed in other published patent applications. He raised an objection under section 1(1)(b) of the Patents Act 1977 ("the Act"). There followed several rounds of correspondence between the examiner and the applicant without agreement being reached.
- 3 A hearing was offered, and the matter came before me at a hearing attended by Mr Eke on 13 March 2019. I am grateful to Mr Eke for the helpful discussion of his invention at the hearing. I confirm that in reaching my decision I have taken into account all information in the documents on file and the arguments presented by Mr Eke at the hearing.

The application

- 4 The examiner issued a pre-hearing report dated 27 November 2018, setting out the outstanding issues to be decided at the hearing. That report relates to the amendments accompanying Mr Eke's letter dated 1 June 2018 received by the Office on 4 June 2018.
- 5 Mr Eke responded in a letter received by the Office on 23 January 2019, and included amended copies of his claims, description, drawings and abstract. Although they have not been formally submitted, Mr Eke confirmed during the hearing that these are the claims he wished to be considered and therefore, these were the claims discussed at the hearing. I note that the difference between these claims and those considered by the examiner in his last report is minimal and concerns only the removal of the feature

that the diagonally opposite edge is raised “by means of an extended telescopic handle”.

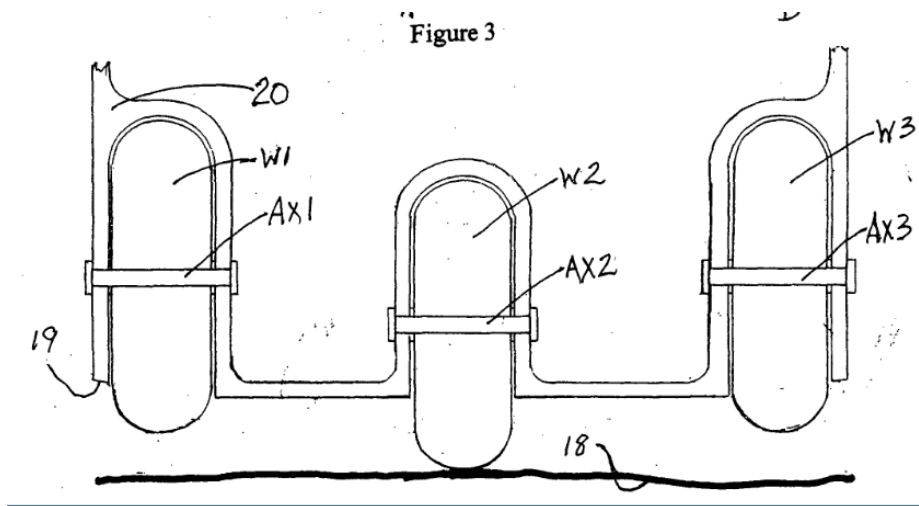
6 There is therefore one independent claim to consider:

Claim 1:

A wheeled luggage case comprising:

A storage portion and a triple wheel assembly integrated at a lower corner of the storage portion and comprising three wheels spaced apart, with the middle wheel positioned to protrude below the two outer wheels, wherein when in the operative position with the diagonally opposite edge raised, the case can be wheeled either balanced on the central wheel, or on two wheels when tilted laterally for an outer wheel also to have rolling contact with a level floor.

7 Included below is figure 3 from the application illustrating the proposed wheel assembly, with a central wheel (W2) which extends further from the body of the case than two adjacent wheels (W1 and W3).



The law

8 The relevant section of the Act is s.1(1)(b), the most relevant provisions of which (with my emphasis added) are:

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) ...;

(b) it involves an inventive step;

(c) ...;

(d) ...

9 Section 3 of the Act then sets out how an inventive step is determined, and reads:

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).

- 10 Matter which ‘forms part of the state of the art by virtue only of section 2(2)’ is all matter which was made available to the public before the priority date of the application in question.
- 11 As I explained at the hearing, in determining whether the invention of an application includes an inventive step we must follow precedent case law. The approach to be followed in assessing whether an invention provides such an inventive step is that laid down by the Court of Appeal in *Windsurfing*¹ and restated, by that Court, in *Pozzoli*². The relevant test comprises the following steps:

(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?

Assessment

- 12 To determine whether the invention does or does not involve an inventive step it is necessary to work through these steps.

Step (1)(a): Identify the notional “person skilled in the art”

- 13 In his report the examiner identified the person skilled in the art as a designer or manufacturer of luggage. Mr Eke had no objection to that, and nor do I.

Step (1)(b): Identify the relevant common general knowledge of that person

- 14 This skilled person would know about luggage in general, and about wheels, castors, handles, common construction materials *etc.*

Step (2): Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

- 15 At the hearing Mr Eke agreed that we are concerned with the triple wheel assembly and determining whether it is inventive over the prior art. As noted above, although the latest version of the formally filed claims define an extended telescopic handle, that is

¹ *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59

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

not where the inventive concept of the claims lies. Mr Eke has re-drafted his claims to leave out that feature, although he has yet to formally filed these claims.

- 16 Therefore, the inventive concept of the independent claim is: a wheeled luggage case having a triple wheel assembly comprising three spaced apart wheels, with the middle wheel positioned to protrude below the two outer wheels, such that the case can be wheeled either balanced on the central wheel or, when tilted, with an outer wheel also in rolling contact with the floor.

Step (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

- 17 At the hearing we discussed some of the prior art patent applications cited by the examiner. As I explained to Mr Eke, the purpose of this was to establish what was known at the time of the application being filed.
- 18 We first discussed GB 2488116 A (EKE), an earlier patent application of Mr Eke’s. Figure 16 (reproduced below) shows a luggage case having two outer wheels (29) and a central wheel assembly (19a) which protrudes out further from the body of the case than the outer wheels.

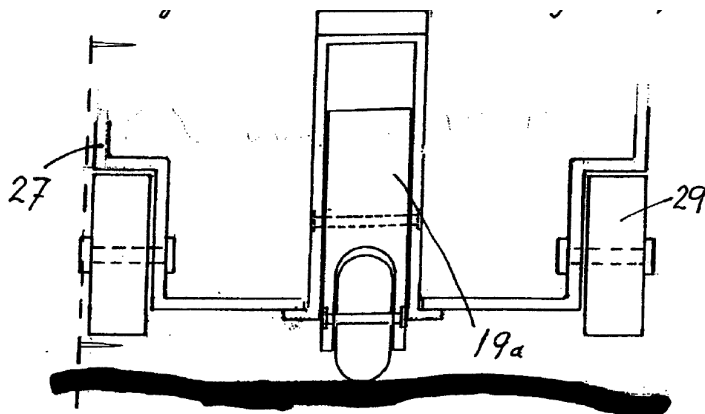


Figure 16

- 19 Mr Eke emphasised, and I accept, that this central wheel assembly has two wheels (as can be seen in figure 19, reproduced below), and so is different from the single protruding central wheel of his present invention.

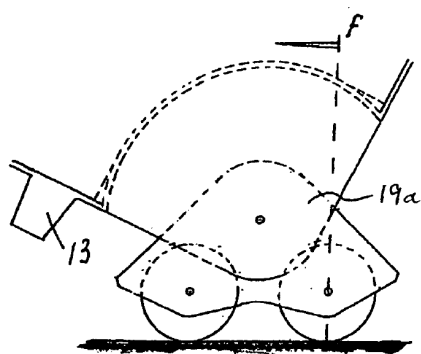
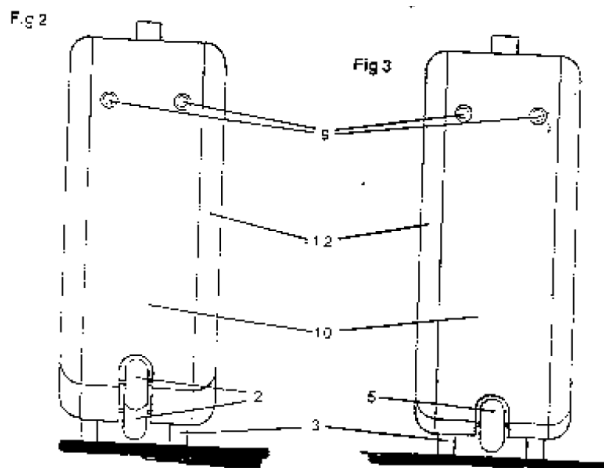


Figure 19 f

20 Mr Eke also noted that this central protruding wheel assembly was not part of the invention claimed in his earlier application. I do not dispute this, however what matters is what has been disclosed. The existence of this earlier application means that an item of luggage fitted with a central wheel assembly protruding further than a pair of outer wheels had been made public by the time the application under consideration was filed.

21 We moved on to consider GB 2338703 A (EKE), another of Mr Eke's own earlier applications. Figures 2 and 3 (reproduced below) show a case with a central multiple wheel assembly (2) flanked by supports (3). An alternative case shows a central single wheel (5) flanked by supports. Again, it is immaterial what was claimed in this earlier application, what matters is the overall disclosure.



22 We also briefly discussed US 2005/0000771 A1 (FERON). This shows the provision of wheels of different diameter which may be offset.

23 I note that there were other documents cited by the examiner. These documents serve to demonstrate features of wheeled luggage design which would have been available to a skilled person at the date of filing of the present application and are relevant to the dependent claims.

24 Of the prior art we have considered, the closest is '116. The difference between the inventive concept and what was disclosed in that earlier application is a central single wheel, rather than a central wheel assembly having two wheels. A central single wheel is shown as an alternative to a central dual wheel assembly, in the context of luggage, in '703.

Step (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?

25 Mr Eke emphasised the advantage of a single wheel over a dual wheel assembly, in giving greater balance and manoeuvrability. I do not dispute that this may provide an advantage.

26 Mr Eke also noted that we have no prior disclosure by any luggage designer or manufacturer of a triple wheel assembly wherein a single central wheel protrudes

below a pair of outer wheels. Again, I accept this to be true, however this would relate to the novelty of the invention which is not under dispute.

- 27 What needs to be determined is whether the skilled person would require any inventive ingenuity to replace the central dual wheel assembly, disclosed in '116 with a single central wheel? I do not believe that the skilled person would, it would seem to be a matter of routine workshop modification to replace a dual wheel assembly with a single wheel. I believe the disclosure in '703 of a single wheel as an alternative to a dual wheel assembly reinforces this point.
- 28 Therefore, I conclude that the difference between the cited prior art and the present invention would have been obvious to the skilled person and would not have required any degree of invention.
- 29 The dependent claims define other optional aspects of the invention; that the three wheels are on the same axle, with the middle wheel being of larger diameter, or that the outer wheels are on separate axles, or that a handle is provided on the opposite side of the case to the wheel assembly. All of these aspects individually are known from the cited prior art.

Other matters

- 30 For completeness, I note that in addition to the inventive step objection there is an outstanding objection to added matter. As I explained to Mr Eke during the hearing this objection arose as the handle shown in the latest filed drawings is different to that in the original drawings, so it may be easily overcome by returning the drawings to those originally filed. There is no need to consider this further.
- 31 Mr Eke noted that the amended claims he filed 13 September 2016, in response to the original combined search and examination report of 4 August 2016, were not examined until after his application had been published on 4 October 2017. This meant that when his application was published he was not aware that there were objections which had not been overcome by his amendments. He advised that had he received a second examination report prior to publication he would have had opportunity to decide to withdraw his application before it was made public.
- 32 Mr Eke also drew my attention to misdirected mail: an examination report forwarded to him in a handwritten envelope from Peterborough, having evidently been wrongly sent to an address there. This was reported to the relevant section at the time the error was identified.

Conclusion

- 33 I find the application lacks an inventive step as required by Section 1(1)(b), I therefore refuse the application under Section 18(3).
- 34 As I refuse the application on the grounds of obviousness it is not necessary for me to go on to formally consider the added matter objection.

Appeal

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

J. PULLEN

Deputy Director, acting for the Comptroller