



install the electrical backbox, returning at a later date to prepare and position cables and facias during a subsequent fit. The walls and ceilings would ordinarily be plastered and painted during these fits. The present invention allows the electrician to perform tasks usually associated with a subsequent fit during the first fit as the invention protects the electrical installation from debris, and other contaminants, which may damage the electrical installation due to any subsequent work conducted by other tradesmen. The invention achieves this by providing a reusable cover that can be received by an electrical backbox, wherein the cover is sized to receive electrical wiring or a backbox fascia.

- 7 The claims have been amended since filing and are now as presented, as filed on 13<sup>th</sup> September 2023. There is a single independent claim which reads;

*A device for covering an electrical backbox which contains an electrical terminal and/or fascia comprising an engagement means providing a fitting for releasable engagement with the internal walls of the electrical backbox and a continuous skirt extending away from the engagement means and wiring associated with the external terminal and/or fascia is contained within the skirt and the engagement means comprises a **resiliently deformable** fitting which **surrounds** an open mouth of the skirt wherein the resilient fitting can be compressed and slid into the backbox and then released to flex out to push against the internal walls of the backbox and grip thereto to engage with the internal walls and protrudes from the backbox to enable the fitting to be manually released from the backbox and the fitting comprises cut-outs or indentations or channels arranged to receive backbox features and the skirt enables a user to handle the device for manual attachment and release of the device over the backbox.*

## **The Law**

- 8 Section 1(1) of The Act sets out what is required of a patentable invention.

*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;*

*(b) it involves an inventive step;*

*...*

*and references in this Act to a patentable invention shall be construed accordingly.*

- 9 Section 2 of the Act sets out what 'new' means as follows:

*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 other 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.*

10 Section 3 of the Act sets out what ‘an inventive step’ means as follows:

*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).*

## **Arguments and analysis**

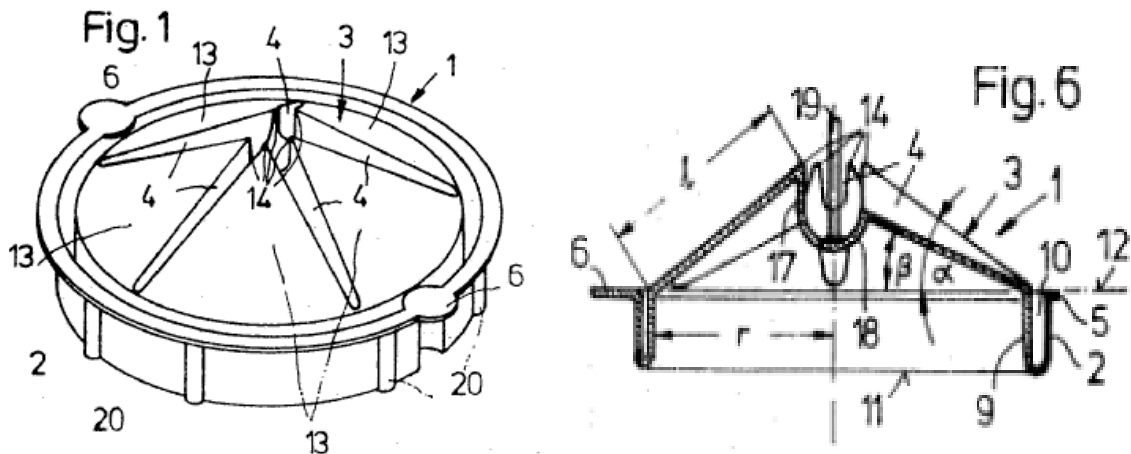
### The claims

- 11 There are no outstanding clarity objections relating to claim 1 of the invention, however, as well as relying on its technical features and how these interact with an electrical backbox, the invention defines the scope of the monopoly sought in terms its functional limitations and, in part, a desired result to be achieved. I am generally content, as is the examiner, with the use of the functional limitations of the claims, specifically;
- (a) “...a resiliently deformable fitting which surrounds an open mouth of the skirt wherein the resilient fitting can be compressed and slid into the backbox and then released to flex out to push against the internal walls of the backbox and grip thereto to engage with the internal walls...”, and
  - (b) “...the skirt enables a user to handle the device for manual attachment and release of the device over the backbox.”.
- 12 Such functional limitations are allowable where the skilled person would have no difficulty in performing this function. Furthermore it is well established that a claim would not be limited to an apparatus *per se* if the design of the apparatus is tied to its functionality with some other bit of apparatus, as it is here.
- 13 The description gives a specific embodiment wherein the resilient fitting is discontinuous in order to achieve the desired result of (a), and the applicant was able to demonstrate a further embodiment during the hearing which, in my mind, the skilled person would arrive at during a simple trial and error process. I am less concerned about (b).

- 14 Therefore, I do not think the skilled person would have any difficulty in performing the function defined in either (a) or (b), and so the scope of the claim inevitably incorporates the claimed adaptations specifically relating to how the device interacts with the electrical backbox.

The prior art

- 15 The applicant has been able to overcome the majority of citations during the examination process, the examiner presently relies exclusively on DE 3203834 A to demonstrate that the invention is not new and/or does not provide the necessary inventive step. For the purpose of the hearing a translation of DE 3203834 A, provided by the EPO, has been relied upon.
- 16 DE 3203834 A relates to a protective cover for an electrical backbox which, in use, prevents plaster and other contaminants entering the backbox. The protective cover of DE 3203834 A, illustrated below, comprises a plug ring 2, a flexible ring wall 9 and a hood wall 3 comprising a plurality of pockets 4 which join at annular wall sections 17 and hemispherical base 18. The outer diameter of the plug ring is adapted to the standard inner diameter of a commercially available flush mounted backbox and, in one embodiment, is approximately 60mm. The plug ring is provided with reinforcing ribs 20 as shown in the figures below. The protective cover may be made in one piece from plastic such as polyethylene.



- 17 The protective cover of DE 3203834 A, in use, is inserted into a backbox such that the hood prevents plaster and other contaminants entering the backbox. The hood is biased into the position as shown in the figures above due to the elasticity of the ring wall 9 as well as the pockets themselves. However, when applying plaster over the protective cover using a float, the envelopes are pushed flush with the backbox so as not to interfere with the adjacent plaster finish. Having applied the plaster the envelopes will push the plaster finish outward giving a visual indication of the location of the back box.

Arguments

- 18 The examiner argues that the plug ring 2 is flexible and would be suitably compressed, slid into a backbox, and released to flex out so as to push against the

internal walls of the backbox. The examiners argument finds basis in the assumption that the plug ring has the same properties as the ring wall due to its integral manufacture.

- 19 DE 3203834 A discusses a plug ring wall thickness of approximately 1 mm, wherein the ring wall and hood have a thickness of 0.2-0.4mm. Furthermore the plug ring is provided with reinforcing ribs 20. Therefore, it is absolutely clear to me that the plug ring is intended to have a different property to the ring wall and the hood. Therefore I do not think it is correct to simply infer the properties of the ring wall onto the plug ring, and it cannot be implied from the teaching of DE 3203834 A that the plug ring is flexible.
- 20 Furthermore, the protective cover of DE 3203834 A is discussed exclusively with respect to pressing the protective cover into the backbox, therefore I understand the protective cover of DE 3203834 A to be a press, or push, fit device. This is distinguishable from a device that would be compressed, slid and subsequently released in order to achieve an adequate fit.
- 21 Therefore, in my mind there are clearly at least two fundamental distinctions between the invention and DE3203834 A, consequently the invention is novel with respect to DE3203834 A.
- 22 The examiner additionally argues, notwithstanding their novelty objection, that it would be obvious to install the protective cover of DE3203834 A such that it is compressed, slid into the backbox and then released to flex out to push against the internal walls of the backbox. The examiner further asserts that the protective cover of DE3203834 A would be installed in one of two ways;
  - (a) the plug ring has a diameter exactly matching the internal diameter of the backbox, or
  - (b) the plug ring has a diameter greater than the internal diameter of the backbox.

The examiner concludes by asserting that it would be obvious to install the protective cover of DE3203834 A by compressing, sliding and releasing, and additionally opines that this would be arrived at as a matter of course.

- 23 It is my understanding from reading the present application that the compression, insertion and release are sequential. During installation method (a) provided by the examiner there would be no compression or release, and during installation method (b) compression and sliding would be simultaneous as the protective cover is pressed into the backbox, and there would be no release until the protective cover is removed from the backbox. Therefore I find it difficult to follow the examiners reasoning used to arrive at the invention.
- 24 It appears to me that the protective cover of DE 3203834 A, which is sized to correspond with the internal diameter of the backbox, would be installed by installation method (a) thereby there would be no requirement to compress and release before and after insertion, respectively. Furthermore, I am unable to identify any reason the protective cover of DE 3203834 A would be adapted, or used, in such a manner.

- 25 Therefore the invention provides an inventive step over DE 3203834 A.
- 26 In light of the above analysis of the prior art it has not been necessary to apply the test set out in *Windsurfing*<sup>1</sup>/*Pozzoli*<sup>2</sup> which is the conventional approach to determining an inventive step.

### **Other matters**

- 27 Claim 3, which is appended to claim 1, reads;

*A device according to claim 1 or claim 2 wherein fitting can be stretched and/or compressed to engage with the electrical backbox.*

- 28 The examiner has observed that this claim casts doubt on claim 1 by claiming that, rather than being compressed, the fitting may be stretched. However, if the fitting could be stretched over the backbox then the fitting would not engage the internal walls of the backbox which appears to be fundamental to the invention. Furthermore, if in order to be stretched over the backbox the backbox must be installed such that it projects past the surface on which it is being installed; again this seems at odds with the kernel of the invention. Therefore claim 3, and supporting passages in the description, are clearly erroneous and do not influence how the scope of the main claim would be construed.

### **Conclusion**

- 29 I consider that patent application GB 1905132.5 satisfied section 1(1)(a) and 1(1)(b) of the Patents Act 1977 when the section 20 compliance period expired on 14<sup>th</sup> November 2023. As no further matters are outstanding, this application is remitted to the examiner for completion of the necessary steps to grant this patent

### **Appeal**

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

### **Peter Mason**

Deputy Director, acting for the Comptroller

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

<sup>2</sup> *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588