



PATENTS ACT 1977

APPLICANT	Dr Sade Tolani
ISSUE	Whether application GB 1318513.7 complies with section 1(1)(a), 1(1)(b) and 76(2)
HEARING OFFICER	J Pullen

DECISION

Introduction

- 1 Patent application GB1318513.7 entitled "My Medical eCard" was filed on 20 October 2013 and published as GB2519358 on 22 April 2015.
- 2 The examiner, Mr Alan Phipps, maintains that the invention is not new and/or lacks an inventive step and that there is also an issue of added matter due to amendments made to the claims during processing. Despite several rounds of correspondence the examiner and the applicant, Dr Sade Tolani, have been unable to agree on the matters at hand. The examiner offered the applicant the opportunity to be heard, the applicant declined and consequently the application has been forwarded to me to decide "on the papers".
- 3 I confirm in reaching my decision that I have considered all of the documents on file.

The invention

- 4 The invention is concerned with a credit-card sized USB device which can store medical data. The card is intended for use by a patient, and contains blank forms which can be filled in by the user to store relevant medical information.
- 5 The original application contained claims in an unconventional format, and as a result the essential features of the invention were unclear. After some correspondence between the examiner and the applicant on this matter a set of claims, defining what the applicant deemed to be the essential features of the invention, were filed.
- 6 I will base my decision on the most recent set of amended claims filed on 31 October 2016, in which claim 1 defines the invention as:

“My Medical eCard is a user-oriented credit-card shaped USB device, which can inserted be (sic) into any USB port without the need for additional/non-standard software, containing blank medical forms, which can be filled in by the user and stored digitally, solely on the device itself, unless manually transferred by the user”

The law

Novelty and inventive step

- 7 Section 1 of the Act sets out a number of requirements with which an application must comply before a patent can be granted. The relevant parts of that section read as follows:

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

- 8 Sections 2 and 3 of the Act are also relevant to the determination of novelty and inventive step, the following subsections being pertinent to the present case:

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

2(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. 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).

Added matter

- 9 Section 76(2) of the Act states:

No amendment of an application for a patent shall be allowed under section 15A(6), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

Interpretation

Added matter

- 10 As stated in paragraph 6 above, I will base my decision on the most recently filed set of claims.
- 11 In the amended claims filed on 31 October 2016, the applicant has introduced to claim 1 the term “user-oriented”, which is not present in the original application. From reading the applicant’s letter filed on 4 August 2016 along with the amendments which first introduce this term, it seems it is intended to indicate that the user fills in the forms rather than a medical professional. From reading the original description,

this is clearly how the card is intended to be used. The term “user-oriented” may also be interpreted to mean, for example, that the card is for the benefit of the user, or that the information thereon pertains to the user. Although it may be interpreted in a number ways, as suggested above, each of these meanings is implied in the description. Therefore the term “user-oriented” is not considered to be added matter under s 76(2).

- 12 The same claim also includes the phrase “without the need for additional/non-standard software”. There is no mention of this feature in the application as originally filed, nor are there examples of what “standard” software may comprise within the original application. As what may be considered “additional” or “non-standard” is entirely a matter of opinion, and may vary greatly depending on the setting in which the card is being used, the phrase constitutes added matter under s 76(2).

Claim construction

- 13 Although the issues I have to decide are whether the claimed invention is new and inventive and whether the amended claims contain added matter, it is an essential requirement of patent law that the claims are clear. The patent must include one claim that defines all of the technical features that are essential to the invention. This requirement is independent of the whether the invention is new and inventive, and before I consider these issues I must first construe the wording of the claims to decide what they are seeking to protect.
- 14 I have considered the term “user-oriented” above with regard to added matter. However, I am of the opinion that the term does not clearly define a technical feature and does not clearly limit the claim, therefore I cannot consider this term to define the invention.
- 15 It is stated in the claim filed on 31 October 2016 that the forms are stored solely on the device. However, the claim then goes on to state that they may be “transferred” by the user. Claim 6 of the original application also states that the contents of the medical card may be transmitted by the user. Therefore, it appears that the forms may, or may not, be stored solely on the device depending on the user’s wishes. As such this cannot be considered a limiting feature of the invention.
- 16 The examiner has summarised in his report of 31 August 2016 that, in his opinion, the invention is “a credit-card shaped USB device for storing medical records”. This would seem to be a reasonable statement of the invention. However, the applicant feels strongly that the inventive concept is that the card is for the user alone and not for medical professionals. To reflect this the invention should be defined as “A credit-card shaped USB device for storing medical records for personal use”. I will use this to assess the invention against the prior art.

Novelty

- 17 The examiner has cited a number of documents during the search and examination of the application. It is noted that these are examples and do not form an exhaustive list of prior art. The documents are listed below:

D1 US2008/0041940 A1 (WEEKS)

- D2 US2006/0010012 A1 (FRANZBLAU et al.)
- D3 US2006/0080137 A1 (CHAMBERS et al.)
- D4 US2008/0306774 A1 (GEORGE et al.)
- D5 GB2440041 A (HES Ltd.)
- D6 DE202009015034 U1 (KOLBERG et al.)

- 18 Documents US'940, US'012, US'774, GB'041 and DE'034 each show credit card shaped devices with a USB port, which contain medical data. US'137 is not shaped like a credit card, but is a USB stick which is carried by and updated by the user. Standard forms are available on the USB stick for the user to fill in with medical information.
- 19 Document US'940 describes a card shaped to fit in a user's wallet, having a collapsible or rigid USB jack (see figure 7). The device is uploaded with a user's medical details and carried around in the wallet. Important emergency information is unencrypted and can be read by emergency personnel in the case of an accident. The user's entire medical history, including X-rays and lab results, can be added to the flash drive. The applicant has argued that this differs from her invention because it requires "additional" or "specialist" hardware and software and refers to paragraph 0028 to support her argument. This paragraph describes how emergency workers will need a means to read the USB at the scene of an accident. However this is also true of her own invention, and there is nothing to suggest US'940 would require anything other than standard hardware or software. The paragraph in question discusses how the establishments might need to purchase hardware for processing payments from the smart card feature of US'940, but this is not relevant to the medical smart card of this application per se.
- 20 The applicant asserts that the card of the invention is for use by the user, and this distinguishes it from US'940, GB'041 and DE'034, in which the data is added or manipulated by medical personnel. The invention as defined in the claim construed above is for "a credit-card shaped USB device for storing medical records for personal use". There is no essential technical feature of the device of the invention which makes it solely updateable by the user, so this would simply be a preferred method of using the card. Any of the cards disclosed in these prior art documents could also be used by the patient if desired.
- 21 The applicant has argued that in her invention the information is not stored anywhere other than the card, it is not linked to the internet. However, it is noted that in the originally filed claim 6 it is stated that the user may choose to "save or transmit" the contents of the USB device. Neither of the devices in US'940 or US'774 require the medical data to be uploaded via the internet.
- 22 It is implicit that the information on the device of the application is available to relevant medical staff in appropriate circumstances. This requires the information to be read and possibly downloaded. In paragraph 0032 of US'940 it is stated that medical staff may update information on the patient's card as well as updating their own records. This is achieved with the patient's card being connected to a computer

via a USB, rather than via the internet. Furthermore, as there is no essential technical feature of the device of the invention which prevents the data on it from being transmitted via the internet, or any servers, it is merely a user's choice as to what they do with their data and how they allow it to be stored and/or transmitted.

- 23 In his report of 31 August 2016 the examiner cited US'137 and US'012 as examples of devices which are updated and maintained by the user. The user adds his or her own medical details to the fields provided on blank forms. In US'012 the device can be in the shape of a credit card with a USB port. This document clearly discloses all of the features of the invention. The applicant has not put forward an argument in her letter of 10 October 2016 as to how her invention differs from this device.
- 24 US'137 does not show a credit card shaped device so does not demonstrate a lack of novelty in the device of the application at hand.
- 25 I have construed the claim and considered the arguments put forward by the applicant and the examiner. Having assessed the claimed device against the cited prior art, I find that the claimed device is not new in light of US'940, US'774, GB'041, DE'034 and US'012.

Other matters

- 26 Since I have already decided that the invention is not novel in relation to a number of prior art documents, I do not need to consider inventive step.

Conclusion

- 27 I have found that the independent claim, as construed, lacks novelty. I have read the specification carefully but I am unable to identify any saving amendment. I therefore refuse the application under Section 18(3).

Appeal

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

J Pullen

Deputy Director, acting for the Comptroller