



BL O/167/04

9th June 2004

PATENTS ACT 1977

APPLICANT Gloria & Isaac Sodipo

ISSUE Whether patent application number GB9921257.3
lacks inventive step

HEARING OFFICER H Jones

DECISION

Introduction

- 1 Patent application GB9921257.3, entitled "Voice Manager", was filed on 19th August 1999 in the names of Gloria and Isaac Sodipo. During examination of the application, the examiner argued that the claimed invention lacked both novelty and inventive step on the basis of documents found as a result of the section 17 search. The examiner also raised a number of clarity objections in respect of some of the claims. After a lengthy exchange of correspondence where the applicants and the examiner were unable to reach any sort of agreement, the applicants were offered an opportunity to be heard. In accepting the offer of a hearing, the applicants stated that they would not be able to attend. This decision is therefore made on the basis of the papers already on file.

The application

- 2 The application relates to a communication system for use in sports which enables a football manager or coach to communicate with players during training or noisy football matches. The players are provided with earpieces which are designed to fit around a player's ear. The manager or coach is provided with a mouthpiece attached to a carrying case that may also be worn around the waist with a detachable strap. In order to communicate with players, a manager talks into the mouthpiece, which then transmits a radio signal to the earpieces of each of the players. Alternatively, a coach or manager may use a megaphone to communicate with the players.
- 3 The application has ten claims which read as follows:

"1. Voice manager comprises of an earpiece which attaches to the ear of a footballer so that message can be received through the mouthpiece. A mouthpiece whereby the coach of football manager uses to communicate to the Footballer during matches and a manual

microphone which is also used alternatively by the coach/manager during training or football match to communicate to players.

2. Voice manager as claimed in 1 will be fitted around the ears of football players during football matches.

3. Voice manager as claimed in 1 or claim 2, where in the football manager or coach can communicate with the players during football match easily without having to shout across.

4. Voice manager as claimed in 2 or claim 3. The earpiece and mouthpiece work on the same frequency, so as to make communication possible.

5. Voice manager as claimed in 3 or claim 4 where in part of the mouthpiece can be used as an advertisement box.

6. Voice manager as claimed in 4 or claim 5, where in the device can be used effectively in other sports or defence activities or travel expedition.

7. Voice manager as claimed in 5 or claim 6 where in, for safety and comfort, the football manager can strap the mouthpiece around his/her waist with a detachable strap.

8. Voice manager as claimed in 7 or claim 8 where in the device could be subject to sabotage activities towards players, therefore the device must be checked for safety whenever it is used.

9. Voice manager as claimed in any proceeding claim where in the voice manager package will eliminate or reduce the shouting across the field which currently occurs during football match by managers or coaches. Thereby reducing stress, exhaustion and frustration of football managers.

10. Voice manager as claimed in 1 or claim 2 voice manager substantially as described herein with reference to figures 1-3 of the accompanying drawing.”

The law

4 The examiner has argued that the claimed invention is not new and does not involve an inventive step. The relevant sections of the Act 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) *the invention 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) below;*
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- .

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

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3 An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art..”

Argument

- 5 The examiner bases his objections on four US patent documents all published before the priority date of the application.
- 6 US4885797 discloses a communication system for use in coaching swimmers which comprises a mouthpiece used by the coach to relay messages via a radio link to speakers mounted in a cap worn by the swimmer. The aim of the system is to overcome the difficulty of communicating between a coach and swimmer in the noisy surroundings of a swimming pool, although the description also recognises that the system could also be used in most other sports. Figure 10, in particular, illustrates a receiver unit placed in a sweat band for use in foot sports.
- 7 US5537667 discloses a similar system, again for use in coaching swimmers, where a coach communicates via a radio link to a receiver placed in a cap worn by the swimmer.
- 8 US5537667 discloses a two way radio communication system which enables a player of a team game, e.g. American Football, to send and receive verbal instructions between him/herself and other team members, umpires, referees or coaches. Speakers for relaying instructions are mounted within the player's helmet.
- 9 US4972468 discloses a earpiece and microphone mounted on the ear of a user, although no specific reference is made to use in coaching sports.
- 10 The examiner argues that these documents demonstrate that radio communication systems which allow a participant in a sporting activity to receive instructions from a coach are well known. Although there is no direct disclosure of a player receiving instruction via an ear mounted earpiece, the examiner argues that the technical features of the applicant's earpiece are entirely conventional and that it would be obvious to a man skilled in the art to use such an earpiece in such a way.
- 11 The applicants argue that their invention is an unique idea that has not been plagiarized from any earlier communication systems. They also point to differences between the documents cited by the examiner and their own invention, and argue that these differences are sufficient to be regarded as inventive. In particular, most of the citations are intended for swimming and not football, and it is not clear at all whether those intended for coaching swimmers would be suitable outside the swimming pool. They also argue that the use of ear mounted earpieces bestow particular advantages over cap or helmet mounted speakers.

- 12 There seems little doubt that the examiner is correct in his assertion that radio communication systems which allow a participant in a sporting activity to receive instructions from a coach are well known - such systems are clearly disclosed in US4885797, US5537667 and US5537667, and the use of such systems in football matches is specifically referred to. I am not persuaded by the applicant's argument that the communication systems for use in coaching swimmers cited by the examiner would not be suitable for other applications. In fact, two of the citations specifically refer to use in sports other than swimming. In addition, I can find nothing in the specification of the application to suggest that the invention has been specially adapted in a way to provide advantages when communicating with football players.
- 13 That said, I must agree with the applicants that none of these citations disclose precisely the invention as claimed and disclosed in the application. Therefore, the issue that I must decide upon is whether the differences between the applicant's invention and the prior art constitute steps which would have been obvious to the skilled man, or whether they require any degree of invention.
- 14 The main difference between the citations and the claimed invention is the use of an ear mounted earpiece for relaying instructions from a coach to a player. The examiner has relied upon the disclosure in US4972468, published in November 1990, as evidence that ear mounted earpieces were well known before the priority date of the patent. He argues that it would be an obvious step for a man skilled in the art to use such an earpiece in communication systems such as those disclosed in US4885797, US5537667 and US5537667. In their letters responding to the examiner's objections, the applicants seem not to have addressed this point.
- 15 I see little reason why an ear mounted earpiece could not be used to relay instructions from a coach to a player in much the same way as the speakers provided in US4885797, US5537667 and US5537667. I am also satisfied that ear mounted earpieces were well known before the priority date of the application and that there is nothing unique in the applicants' earpiece that distinguishes it from those already known. I am in no doubt, therefore, that the use of an ear mounted earpiece for relaying instructions from a coach to a player does not require any degree of invention.
- 16 There are also other differences between the citations and the invention as claimed and as disclosed in the application. Claim 1 refers to a manual microphone which the coach can use to communicate with players. The manual microphone takes the form of what is conventionally known as a megaphone, and, indeed, the applicants acknowledge in their correspondence that the manual microphone is an existing product applied in a known way. There can be little doubt that this difference does not involve an inventive step. A final difference is that the coach or manager's mouthpiece is linked to a carrying case that may be strapped around the waist. The examiner has not referred to any piece of prior art to support his objection that housing a microphone on a body in this way would not require any degree of invention, nor have the applicants offered any argument to the contrary. Given that the application places little significance on this particular feature of the invention, I am in no doubt that this feature would be obvious to a man skilled in the art.

Conclusion

- 17 I have found that the invention as claimed and as disclosed in the application does not involve an inventive step. I therefore refuse the application under section 18(3) on the grounds that it does not meet the requirement of section 1(1)(b).

Appeal

- 18 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days. It should be noted that the period prescribed by rule 34 of the Patents Rules for putting the application in order expires on 12th June 2004. Under section 20(2) of the Act, the period for putting the application in order is automatically extended to expire at the end of the period allowed for appeal or until such a date as the court may determine.

H Jones

Deputy Director acting for the Comptroller