YES, BUT IS IT ART?

By John McKnight, Partner, Spoor & Fisher

Having a registered intellectual property (IP) right (or monopoly) on an article is quite a thing. It gives you the right to prevent others from making, using, selling, offering to sell or importing your article, and that is a competitive advantage that can be worth something in the market place.

But before anyone can expect such special treatment, there is the question of just what you have to give, in order to receive.

IP Offices are not in the business of just handing out monopolies and in order to be the recipient of one, you need to show that you have made a contribution to the human knowledge base. You cannot expect any special treatment on yesterday's news, so it is Rule No. 1 that a patent or design right will only be granted against something that is absolutely new, in the sense that the article in question must never have been made available to the public anywhere on the face of the planet prior to the day on which the rights in question were applied for. (Of course, some exceptions apply, and the situation is different in the United States and other countries which broadly follow US law.)

Novelty is not the only burden to overcome before you can bank your patent or design right, however. Other criteria also need to be satisfied, such as the need for the contribution to be "inventive", i.e. not obvious, in the case of patents, generally not *contra bona mores* (another essay in itself, I can assure you) and not specifically excluded by statute, but today we concentrate on the simple novelty aspect of patent or design rights, and in particular, just what prior references can be considered to anticipate such a monopoly right.

As you might imagine, IP attorneys make a living out of crafting IP monopolies to (just) avoid cited prior publications and advancing vociferous argument as to why their clients are deserving of the right to exclude others.

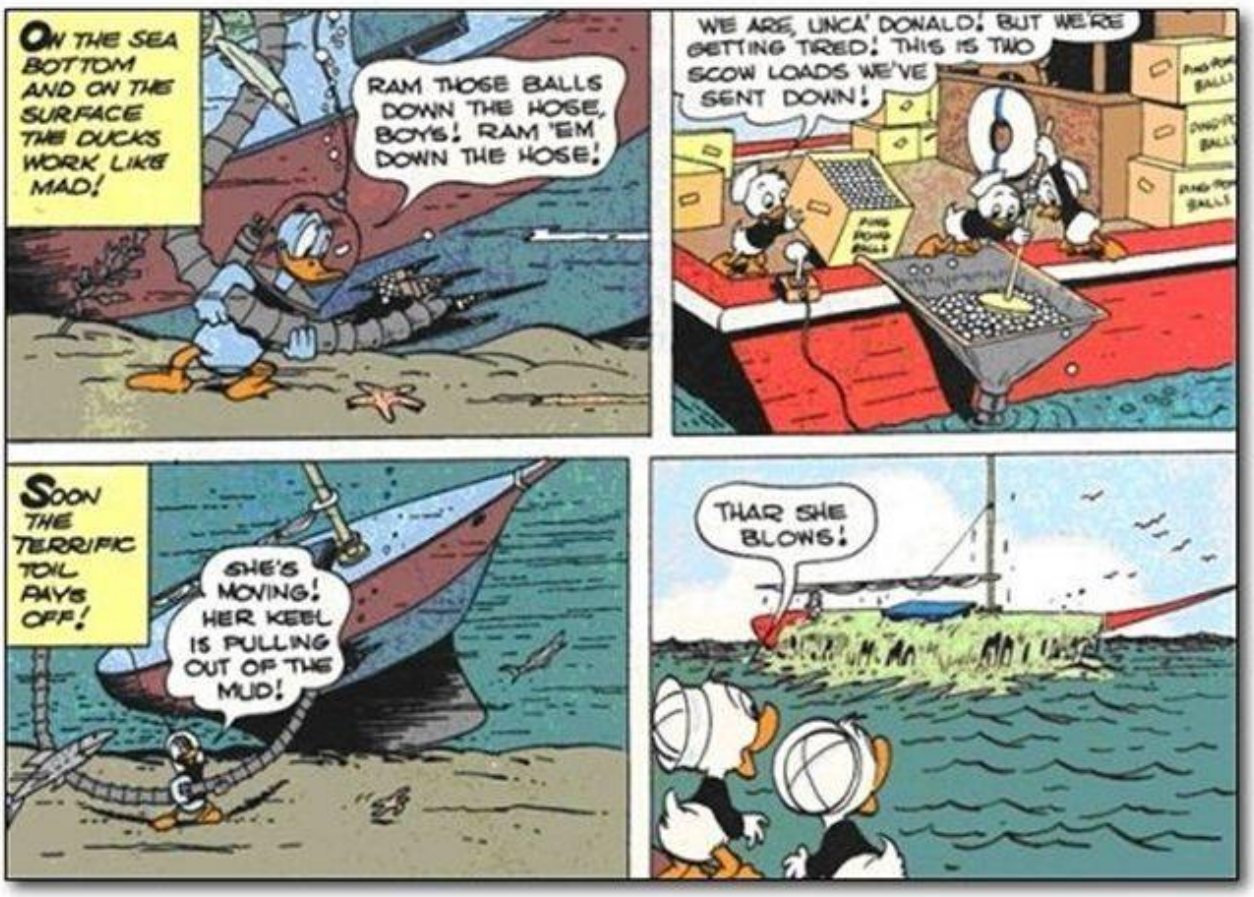
In so doing, IP attorneys are very used to receiving reams of earlier patents, scientific journals and other mind-numbing references (prior art) cited by patent and design examiners, which prior art supposedly expounds (anticipates) their client's contribution in one guise or the other.

But prior art is not limited to esoteric publications brought up from the bowels of some public repository.

In 1965 inventor Karl Krøyer received a patent in the United Kingdom (GB1070600) for an invention claiming that buoyant bodies could be inserted into a sunken vessel to thereby raise the vessel.

Karl Krøyer also applied for his patent in the Netherlands but this application was refused because the Dutch Patent Office found an old issue of a Donald Duck comic dating from 1949 which showed the same invention. Since an invention has to be new to be patentable, the application was not allowed.

The Donald Duck story *The Sunken Yacht* (by Carl Barks) shows Donald and his nephews raising a ship by filling it with ping pong balls forced through a tube.



In 1964, the freighter Al Kuwait capsized at the docks in Kuwait's harbour and Karl Krøyer (after lodging his application with the Patent Office, naturally) successfully used his invention to raise the sunken vessel. Some of you may also recall a recent episode of the television program *Mythbusters* in which approximately 27,000 ping pong balls were used to raise a sunken vessel. Donald and his nephews were clearly on the ball.

Not to be outdone by the Dutch authorities, however, the United Kingdom Patent Office (UKPO) saved some face when, in 1983, Paul Graham Usher applied for a patent for an “Entry Signal System for Pets”. Essentially, the invention is a doorbell set low down so that a dog can press it to ask to be let in through the dog-flap.

The UKPO cited a popular British comic, *The Beano*, No.2015, page 1 as prior art to anticipate Mr Usher’s invention. As can be seen below, the front cover had a drawing of Foo Foo, one of the character’s dogs, pressing a button next to the front door with his nose asking to be let into the house.

Mr Usher did eventually receive a patent (GB2117179) with the ambit of monopoly suitably limited to avoid the cited prior art, as unearthed by the well-read UKPO examiner.

This trend of using popular culture to anticipate (and thereby deny) monopoly rights is alive and well today. In the currently ongoing case of Apple suing Samsung for several of Samsung's Galaxy products allegedly infringing a number of Apple's patents and designs in their mega-selling iPad, Samsung used Stanley Kubrick's ground-breaking 1969 film, *2001: A Space Odyssey* to allege that Apple were not the first to have come up with the outward appearance of a tablet device like the iPad.

From the file of the matter as heard in the Netherlands:

"Attached hereto as Exhibit D is a true and correct copy of a still image taken from Stanley Kubrick's 1968 film "2001: A Space Odyssey." In a clip from that film lasting about one minute, two astronauts are eating and at the same time using personal tablet computers. The clip can be downloaded online at

http://www.youtube.com/watch?v=JQ8pQVDyaLo. As with the design claimed by the D'889 Patent, the tablet disclosed in the clip has an overall rectangular shape with a dominant display screen, narrow borders, a predominately flat front surface, a flat back surface (which is evident because the tablets are lying flat on the table's surface), and a thin form factor.

The patent in question is a design patent covering the ornamental design of the iPad, with Apple claiming that the Samsung Galaxy Tab is substantially identical to that design. By pointing to an example of a similar design made public in 1968, even if not an actual functioning tablet device, Samsung hopes to demonstrate that there is little variation possible when designing a tablet and show that the general concept used by Apple for the iPad has actually been circulating for decades. "

(Kubrick's film was completed in November 1968 but only released in 1969.)

This strategy seems to have worked because although a district court in the Hague ordered that Samsung's subsidiaries be banned from selling Galaxy smart phones (and not tablets) in the Netherlands (and *de facto* many European Union countries) as of October 13th, the ban only applies to the Samsung Galaxy S, Galaxy SII, and Galaxy Ace phones.

The judge upheld Apple's claim concerning only one specific patent - EP2059868 - which outlines an interface for viewing and navigating photographs on a touch screen phone.

Which just goes to show how valuable IP can be, and possibly more importantly, how vulnerable monopoly rights can be to seemingly banal prior art references. So next time you come upon your IP attorney reading The Beano, stop for moment. It is more than likely they are conducting in depth research, rather than reviewing the next addition to their library.

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