

BLO/034/89

PATENTS ACT 1977

IN THE MATTER OF Patent Application
8610745 in the name of Andras Szucs

STATEMENT OF REASONS

Application 8610745 was filed by Mr Andras Szucs on 1 May 1986, claiming priority from application 8511199 filed on 2 May 1985. The application was published on 17 December 1986 under number GB 2,176,229A.

The published specification describes various beams for ready assembly with other components into formwork or like structures. The beams have a web (21), and flanges (22, 23) at each end which extend to a lesser extent on one side than the other. These lesser extensions are utilized to connect the beam with other components such as another beam. Each lesser extension comprises, at the upper end at least, a pair of limbs (25, 26), defining Tee-slots (24). The inner limbs (26) taper towards their free ends, so producing a sloping bearing surface which will cooperate with corresponding sloping surfaces of connectors in the structure, yielding a wedging action, and assisting in accommodating tolerances. In figure 7, the shorter flanges at both ends define T-slots. Correspondingly both inner limbs (26, 28) are tapered.

The formwork structure itself can be seen in figure 1. A series of vertical props (10), support a series of beams (20). The beams, joined longitudinally where necessary, support transverse secondary beams (13), which in turn support plywood sheets, on to which concrete is poured.

The search report cited several specifications, including the applicant's own earlier specification GB 2,147,344. This was published on 9 May 1985, ie after the priority date of the current application, but has an application date of 21 September 1984, and an earlier priority date still.

The first substantive examination report, which issued on 18 November 1987, raised the objection, inter alia, that the invention appeared not to be new having regard to the disclosure in GB 2,147,344. After various rounds of correspondence to try to settle the issues raised, amendments were filed on 25 July 1988 which, in addition to deleting figures 1 to 6 and the corresponding description, incorporated a revised form of claim. It will be necessary to refer later to that form of claim which also gave rise to objection. However, in his letter of 25 October 1988, the applicant indicated that he had reconsidered his earlier amendments, and now wished to reinstate most of the text and figures which had been deleted and also to submit a new claim 1. These proposed amendments have not yet been formally incorporated in the specification.

The proposed Claim 1 reads as follows:

"The structural beam of the type described having at least one shorter flange portion extending from the web with reducing thickness wherein a surface bounding said flange portion is facing towards that principal axis of inertia of the beam section which is substantially normal to the web and where said web and said surface enclose an angle that is larger than 90°."

The examiner could not accept the proposed amendments and further correspondence and discussion over the telephone took place. Some progress was made but the examiner maintained an objection to the proposed amendment on the grounds that it did not comply with the requirement of Section 1(1)(a) of the Act because the invention claimed was not new having regard to the matter contained in GB 2,174,344 and forming part of the state of the art by virtue of Section 2(3).

This question came before me at a hearing on 21 March 1989. Mr Szucs attended the hearing and Mr H A Reeve was also present as examiner.

Specification GB 2,174,344 describes formwork structures, including beams and includes six figures. These figures are identical to the first six figures of the current application as filed and published. The current application has an identical description of the figures 1 to 6 but also has an additional figure, figure 7, the description of which also relates back to figures 1 to 6. At the hearing, Mr Szucs accepted that what he now proposes to claim, in particular that the face of at least one shorter flange nearer the principal axis of inertia of the beam makes an obtuse angle with the web, was shown in the drawing of the earlier application. He argued, however, that this is not an anticipatory matter for the purposes of Section 2(3).

Section 2(3) reads:

"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 ..."

This Section then treats such "matter", once it has been officially published, as though it had in fact been published at its priority date. That is, it forms part of the state of the art, as from that date, for the purposes of Section 1(1)(a). It should be noted however that it is to be "disregarded" when considering inventive step - Section 1(1)(b) considerations - by specific provision of Section 3.

Mr Szucs argued that the interpretation of "matter" in the phrase "matter contained in an application for another patent", in Section 2(3), should be different from the interpretation of the same word in the phrase "matter ... which has at any time before the priority date of that invention been made available to the public" in Section 2(2). Whereas "matter" in Section 2(2) can be taken to include any disclosure, Mr Szucs contended that "matter" in Section 2(3) covers inventive matter only. By that I understand him to

mean matter which relates to the invention claimed in the earlier application.

In support of this contention, Mr Szucs argued that any matter which was not inventive would be available to the public and therefore constitute an anticipation by virtue of Section 2(2). I could not accept that argument since it seems to be perfectly possible for an application to include matter which is sufficiently novel and inventive to support a valid claim even though no claim is made for it.

Mr Szucs explained that at the time of making his first application, he was aware of one advantage only for the sloping flanges, namely that they were stronger than what had previously been proposed. At the time of making the current application, he was however able to identify three further advantages. The sloping flanges enabled reactive forces to be inclined rather than vertical; they made for easier disassembly; and the arrangement was able to take up tolerances.

It was part of Mr Szucs's argument that the crucial feature of at least one sloping flange, though shown, is not described in his earlier application. Mr Szucs argued that this feature was merely a "draughtsman's fancy" present by "chance", though this does not seem to be entirely consistent with his statement that he appreciated at the time one advantage of the sloping flanges. Mr Szucs argued further that a drawing per se does not disclose an invention; without accompanying description the significance of what was shown would not be apparent. If its significance were apparent, it would only be by obviousness - which is specifically excluded from the effect of Section 2(3) by Section 3.

I did not accept this argument. A sloping flange face was shown in the drawings of application GB 2,147,344 and anyone looking to the published application for a way of performing the invention would be encouraged to use such a sloping face,

thereby achieving all the benefits which would flow from doing so.

Mr Szucs also pointed to the fact that in earlier proceedings under Section 8 in respect of GB 2,147,344, the Superintending Examiner had observed that the showing of a sloping flange was an "immaterial" difference from certain beams exhibited in the proceedings. However the question before the Superintending Examiner was one of ownership and the referrors did not claim ownership of the concept of a tapering flange. It was in that context that the Superintending Examiner regarded the tapering flanges as immaterial and I do not consider that his observations assist me in deciding the quite different question of notional prior publication which is now before me.

When a word is used twice in the same section of an Act, there is a presumption that it means the same on each occurrence. Having considered all of Mr Szucs' arguments, I concluded that there was no reason to depart from this and interpret the word "matter" differently in Sections 2(2) and 2(3). In particular, the phrase "for another patent" in Section 2(3) qualifies "application" rather than "matter". That is, it serves to identify what sort of application is relevant, rather than to direct attention to inventive matter. It appears to me that the word "matter" must be given its full broad meaning so as to include anything disclosed in a relevant application. If Parliament had intended a more restrictive interpretation, this could have been indicated by choosing different wording from that used in Section 2(2).

For these reasons I concluded that the examiner's objection that the proposed amendments do not meet the requirements of Section 1(1)(a) is well founded and I refused to allow the application to be so amended. I indicated at the Hearing, that the applicant has 6 weeks from the date of that Hearing to file satisfactory amendments.

At the Hearing I did consider, with the examiner's assistance, whether the claims filed on 25 July 1988 would form a satisfactory basis for amendment. Subject to omission of the limitation to 135' and clarification along the lines discussed at the Hearing, and subject to further scrutiny, these would seem to form a satisfactory basis for amendment.

Having informed Mr Szucs of my decision to refuse the amendments at the hearing, he has a period of 6 weeks from the date of the hearing to enter an appeal if he so wishes.

Dated this 10 day of April 1989



C G M HOPTROFF

Principal Examiner, acting for the Comptroller

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