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**PATENTS ACT 1977**

IN THE MATTER OF Patent Application  
No. 8912373.1 by Anne McManus

**FINAL DECISION**

Application number 8912373 was filed on 30 May 1989, claiming priority from two earlier applications filed on 27 May 1988 and 16 June 1988. The application was published on 29 November 1989 under serial number 2218906A and is entitled "Medicament for various skin and ulcer disorders".

During the course of substantive examination, the examiner, Mrs S E Chalmers, raised objection under Sections 1(1)(a), 1(1)(b), 1(1)(c), 14(5)(c) and 14(5)(d). However no amendments were submitted. During the course of substantive examination the applicant expressed a wish to include a claim or claims to a medicament for oral use, although no such claim was actually filed. The examiner raised objection that any such claim would in any case be open to objection under Sections 1(1)(a) and 14(5)(c).

In the absence of agreement between the applicant and the examiner the matter came before me at a hearing on 27 July 1993. I gave an oral decision refusing to allow the application to proceed to grant and issued on 5 August 1993 a statement of reasons for that decision. The conclusions I set out again below:

"In summary I find that the invention as claimed in claims 1, 2, 3, 5 and 7 is not new as required by Section 1(1)(a), that the invention as claimed in claim 4, insofar as it relates to the treatment of ulcers, and as claimed in claim 8 does not involve an inventive step as required by Section 1(1)(b), that the invention as claimed in claims 6 and 13 is not capable of industrial application as required by Section 1(1)(c), that the invention as claimed in claim 13 is not supported by the description as required by Section 14(5)(c) and that the claims do not relate to one invention or to a group

of inventions which are so linked as to form a single inventive concept as required by Section 14(5)(d).

Given that there are claims to which no objection has been taken, namely claims 9 to 12, or to which objection has been taken only in part, namely claim 4 insofar as it relates to the treatment of ulcers, it follows that, before refusing the application under Section 18(3) I should give the applicant an opportunity to amend the specification, with a view to meeting my findings. I should point out that I can foresee no circumstances under which a claim to oral use could be sustained."

In the event, Mrs McManus appealed against this decision to the Patents Court and appeared in person before Mr Justice Aldous on 20 December 1993. Dismissing the appeal, Mr Aldous commented as follows:

"Her [the applicant's] complaint is that the Principal Examiner failed to allow her a claim to oral use and in particular a claim of the Swiss-type . . .

Mrs McManus says she is entitled to a Swiss-type claim and that she has tried and tested the alleged inventive medicament. She produced to me a document which had been filed at the Patent Office which shows an amendment to her application. Unfortunately that document seeks to introduce new matter into the patent specification as filed, in such a way that it could not have been allowed. There is no power for the Comptroller to allow new matter, and in particular new matter which would found the basis for a Swiss-type claim, to be introduced into an application after it has been filed. He has power to allow amendment, but not amendment of this type.

It follows that the application as filed did not contain a basis for a Swiss-type claim. Furthermore, it is not in my power nor in the Comptroller's power to allow the particular material to be introduced. I therefore have come to the conclusion that the Principal Examiner's decision is correct and cannot be faulted."

Mr Justice Aldous remitted the matter to the Patent Office to give Mrs McManus a further opportunity to amend; and to this end he gave the applicant a final extension of three months in which to put forward amendments i.e. until 21 March 1994.

Mrs McManus filed proposals for amendment by way of a replacement specification on 21 March 1994.

The examiner reported as follows:

"The amendments filed on 21 March 1994 are not allowable as they result in the application disclosing information extending beyond the disclosure in the application as filed in contravention of Section 76(2) of the Patents Act 1977. The information in question relates to the oral use of eggshells in the preparation of a medicament, in particular for the therapeutic treatment of internal ulcers. You are also referred to the Patents Court judgment of 20 December 1993 which dismissed claims to this subject matter and refused to allow such subject matter to be added to the application."

The letter also gave the applicant the opportunity either to submit observations demonstrating that the requirements of the Act had been complied with, or to request a hearing on the matter. No reply was received within the fourteen day period specified and I must now decide the matter on the basis of the papers before me.

The amended specification filed on 21 March 1994 includes new claims which read as follows:

- 1 Oral use of eggshells in the preparation of the medicament.
- 2 Oral use of eggshells as claimed in claim 1 as in the preparation of an oral medicament.

- 3 Oral use of eggshells as claimed in claim 2 in the preparation of an oral medicament for the therapeutic treatment of internal ulcers.
- 4 Oral use of eggshells as claimed in claim 3, wherein the internal ulcers are duodenal, peptic or gastric ulcers.
- 5 Oral use of eggshells as claimed in any one of claims 1-4 wherein the eggshell is in powder, granule or tablet form.

The new specification also includes a description comprised almost entirely of material not to be found in the application as filed - including details of a method of preparing eggshells together with descriptions of the digestive system, the microwave oven and certain other equipment.

I have given careful consideration to the amended application in the light of the judgment of the Patents Court.

I note that all of the claims relate to the oral use of eggshells. Claims 1 and 2 are equivalent to claims for making an oral medicament. Claims 3 and 4 are "Swiss-type claims" to the treatment of internal ulcers, specifically duodenal, peptic or gastric ulcers. Claim 5 specifies the physical form in which the eggshell may be administered. Mr Justice Aldous upheld my earlier decision that the oral use of eggshells as a medicament was prior disclosed in Japanese patent specification 59-137415. In addition, he held that ". . . the application as filed did not contain a basis for a Swiss-type claim. Furthermore, it is not in my power, nor in the Comptroller's power to allow the particular material to be introduced". In accordance with that judgment, and in the absence of any further observations from the applicant, I find that the invention as claimed in claims 1, 2 and 5, is not new as required by Section 1(1)(a), that the invention as claimed in claims 3 and 4 is not supported by the description as required by Section 14(5)(c); and that the amendments submitted in the latest version of the application include added matter contrary to the requirements of Section 76(2).

The extended period allowed in the judgment to submit proposals has expired. As I have found that the application, at the end of the period allowed under Section 20, does not comply with all the requirements of the Act, the application is thereby treated, under Section 20, as refused.

Dated this 30 day of JUNE 1994

D J BARFORD

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Principal Examiner, acting for the Comptroller

