

IN THE MATTER OF application
No 7932835 for Letters Patent
by RFL Contractor Holding SA

CONFIRMATION OF ORAL DECISION

The Examiner, having raised the objection that the application does not satisfy the requirements of Section 15(4) of the Patents Act 1977 since it contravenes Section 76, the matter was brought to a hearing before me on 14 September 1982, when Mr J R Batchellor appeared as Agent for the applicants and Mr C D Kopkin, assisted by Mr C N Richards, attended as examiner in the case. After hearing Mr Batchellor, I indicated that I was not prepared to allow the application to proceed as a filing under Section 15(4) and the following are my reasons for that decision.

The application, which was filed on 21 September 1979, claims under the provisions of Section 15(4) the filing date 22 May 1979 and the priority dates 26 May 1978 and 22 September 1978, of application no 7917804. Application 7917804, which I shall refer to hereafter as the "main" application, was published under Section 16 under Serial No GB 2026889A on 13 February 1980.

Both applications relate to the design of contactors for contacting liquids with liquids, or liquids with solids or slurries and are particularly concerned with a contactor of the type described in UK Patent Specifications Nos 972035 and 1037573. This type of contactor employs a compartmentalised rotor mounted in a stationary drum and carrying buckets for passage of the phases through each other. The rotor of specification 972035 has compartments formed by axially spaced discs attached by flanges secured to a central shaft. The buckets are formed by bucket tubes parallel to the shaft and threaded through slots in the discs. This construction is said to be difficult and expensive to manufacture and the design is applicable only to contactors of small diameter and length. The rotor of specification 1037573 has compartments formed by axially spaced discs threaded on to tie rods which are parallel to the axis and extend between the end plates of the rotor. The buckets extend between adjacent discs and are supported by the rods. The end discs may be fitted with stub axles, or a spindle passing through the rotor may be used. It is said that this construction cannot be used for large contactors because the stub shaft support

fails to give adequate stability to the long unsupported length of the rotor, sagging of the rotor occurs, and additionally, the rotor rigidity is insufficient to withstand the out of balance forces applied to it under certain circumstances.

The main application promises to provide a rotor construction giving adequate rigidity and is relative easy and cheap to build. This the invention does by constructing the rotor in the form of a "cage" comprising a central shaft to which a pair of end plates is secured, and tie rods secured between the end plates and extending parallel to the shaft whereby the "cage-like" structure is made rigid. The compartments are formed by discs carried by the tie rods and are not secured directly to the shaft. The bucket members are secured to the discs.

In a preferred form, the discs are formed with openings which can receive the bucket member and the openings in adjacent discs are angularly displaced so that each bucket member extends from one disc to the second disc away.

The preferred form is particularly described in the example with reference to two drawings.

As initially filed, Claims 1 and 2 of the main application read as follows:

"1 A contactor for contacting liquids with liquids, or liquids with solids or slurries, comprising a stationary drum having a rotor mounted therein, which rotor comprises a central shaft rotationally supported adjacent its ends, a pair of end plates secured to the shaft, tie rods secured between the end plates and extending parallel to the shaft, spaced compartment-forming discs carried by the tie rods and bucket members secured to the discs.

2 A contactor according to claim 1, wherein the discs are formed with openings to receive the bucket members, the opening in adjacent discs being angularly displaced, so that each bucket member extends from a first disc through a second disc to a third disc."

The present application in addition to acknowledging specification 972035 and 1037573, also refers by number to the main application and contains a recitation of Claim 1 of that application as initially filed. Apart from a passage corresponding to Claim 1, the remainder of the description consists of a sentence indicating the length of the bucket members and means by which they may be secured, and the description by way of example of a contactor construction from which the invention is said to be more readily understood. Both the

sentence and the example find identical counterparts in the main application.

Claim 1 of the present application reads as follows:

"1 A contactor for contacting liquids with liquids, or liquids with solids or slurries, comprising a drum divided into a plurality of inter-connected compartments by spaced rotatable discs, the discs being formed with openings to receive bucket members, the openings in adjacent discs being angularly displaced so that each bucket member extends from a first disc through a second disc to a third disc."

The objection raised by the Examiner lies in respect of the invention of a contactor without tie rods, which form the applicants intend to be comprehended, and in my opinion is comprehended, by Claim 1 of the present application although there is no particular description of that constructional form of contactor. The Examiner considered that such a form was not broadly described in the main application and accordingly the invention claimed in Claim 1 was not fairly based on the disclosure in the main application. The present application was therefor considered implicitly to disclose subject matter not to be found in the main application and to contravene Section 76 of the Patents Act 1977. In view of the judgment in the case of Hydroacoustics Incorporated's Application, FSR (1981) 538, the Examiner reported that the present application should not be allowed to proceed as an application under Section 15(4) of the Patents Act 1977.

At the hearing, Mr Batchellor explained that the present application was typical of divisional applications which had been allowed by the Office over many years and derived from the disclosure in the main application of a particular feature namely the arrangement of discs and bucket members such that each bucket member extends from a first disc through a second disc to a third disc. In his opinion, the present application contains no further disclosure and each and every individual feature of the construction claimed in Claim 1 is to be found in the main application as initially filed. Claim 1 had been drafted to comprehend a contactor with or without tie rods and for this reason the construction particularly described and illustrated by way of example in the main application had been adopted for the present application.

Mr Batchellor questioned whether the "fair basis" test was the correct test in the present circumstances. Both in the case of United-Carr Incorporated's Application, 1971 RPC 23, and in Garrod's Application, 1968 RPC 314, the "fair basis" test had been applied in circumstances involving amendment of an

application under the Patents Act 1949, and Mr Batchellor was not altogether satisfied that the guidance contained in those authorities could be properly applied in the case of a divisional application filed under the provisions of the Patents Act 1977. Mr Batchellor pointed out that Section 15(4) of the 1977 Act allows the new application to be filed in respect of any part of the matter contained in the earlier application and providing the new application does not contravene Section 76, the new application is to be treated as having, as its date of filing, the date of filing of the earlier application. Mr Batchellor drew my attention to the fact that the prohibition on the inclusion of added matter in divisional applications is found in paragraph 1 of Section 76 whereas the prohibition on the inclusion of added matter in amending an application is to be found in paragraph 2. Mr Batchellor suggested that this division within Section 76 may be taken as an indication that the drafters of the Act intended a different approach as regards added matter in the case of a divisional application from that in the case of the amendment of an application.

To my mind, the fundamental issue in determining additional subject matter is essentially whether one document presents the informed reader with relevant information which the other document does not. As I understand it this was the philosophy applied under the 1949 Act and I have no reason to believe that the philosophy to be applied under the 1977 Act is in any way different. I therefore take the view that the guidance contained in the several precedent cases established under the 1949 Act may be followed under the 1977 Act. As far as I am aware the most recent authoritative guidance on the general approach to the claim-broadening problem is set out in Garrod's Application, International Playtex Corporation's Application, 1969 RPC 362, and Unilever Limited (Sneath's) Application, 1978 RPC 617. As I understand them, the principles to be distilled from these cases are as follows. The first criterion to be applied is to determine whether the matter is fairly based on the disclosure in the specification as initially filed. The second criterion to be applied is to determine whether the invention sought to be monopolized is comprehended by the initial disclosure. Thus while the matter may be found to be fairly based on the initial disclosure, it is not allowable if it is of a potentially inventive character having regard to the initial disclosure.

I do not accept that the division within Section 76 is indicative of a difference of intent in the approach to be adopted for a divisional application and an amendment of an application. If a difference in approach was adopted a situation could obtain where a monopoly claim denied under one paragraph could be allowed under the other paragraph. Thus by adopting a more liberal approach

for paragraph 1 than that for paragraph 2 of the Section, a monopoly not allowed when sought by amendment of the claims of an application could possibly be obtained by filing a divisional application containing the amended claim. Put more bluntly, the prohibition of Section 76(2) could be circumvented for the cost of filing a divisional application. To my mind the terminology of Section 76 indicates that the same approach should be adopted for a divisional application and for an amendment of an application or patent.

Mr Batchellor also sought to distinguish the circumstances of the present application from those in the Hydroacoustics case in that in the present application the applicant has not added subject matter in an explicit manner, the invention claimed in the present application representing a broadening of the invention claimed in claim 2 of the main application by the omission of the requirement for tie-rods. While the Court may not have addressed itself to this particular situation, guidance as to how Section 76 is to be interpreted is to be found in the Court's Judgment. Thus, in a passage bridging pages 547-8 of FSR [1981] it is said:

"Section 76(1), so far as relevant for present purposes, provides:

"76(1). An application for a patent (the later application) shall not be allowed to be filed ... as mentioned in section 15(4) above, in respect of any matter disclosed in an earlier application if the later application discloses matter which extends beyond that disclosed in the earlier application, as filed"

Quite clearly, therefore, not only is there no procedure under the 1977 Act or 1978 rules corresponding to rule 13(2) of the 1968 rules whereby cascading divisional applications were possible under the 1949 Act, section 76(1) cited above makes it mandatory for the Comptroller to refuse to allow to be filed under section 15(4) of the 1977 Act any divisional application which contains additional matter not disclosed in the parent application."

This interpretation of Section 76(1) is not in any way restricted to circumstances wherein matter is added in the form of an identifiable distinct entity and, in my view, is applicable to all circumstances wherein matter is found to have been added. It is well established that claim broadening may result in the introduction of fresh subject matter and I am satisfied that if the present application is found to contain added matter, the guidance contained in the Hydroacoustics decision may be followed.

Having dealt with the issues of principle raised by Mr Batchellor, I now turn to the situation in the present case in which the invention claimed in the present application may be considered to comprehend the result of broadening the invention claimed in Claim 2 of the main application by omission of the requirement for tie rods. To determine whether such a broadening constitutes the addition of subject matter it is necessary to read the whole of the main application to decide what is described and to appreciate the significance of the arrangement of discs and bucket members.

As I see it, the whole of the invention described in the main application is concerned with a contactor having a rotor construction which gives adequate rigidity, and is relatively easy and cheap to build. The invention solves the rigidity problem by constructing the rotor in the form of a "cage" in which tie rods secured between end plates make the "cage-like" structure rigid. There is no suggestion that such a "cage" can be constructed without the use of tie rods, or that any other component of the rotor contributes to making the structure rigid. There is also no suggestion that the arrangement of discs and bucket members contributes in any way to solving the rigidity problem or that a rotor having adequate rigidity could be constructed without the "cage" structure. Indeed, at the hearing, Mr Batchellor conceded that the informed reader of the main application would not find any suggestion of such a construction in the main application as initially filed.

For these reasons I concluded that the present application in so far as it comprehends a contactor having a rotor constructed without the use of tie rods presents the informed reader with relevant information which is not to be derived from the earlier disclosure in the main application.

Thus, whereas the individual features identified in the claims of the present application are disclosed in the main application, the construction without tie rods comprehended by the claims is not specifically or broadly described therein and the claims cannot be regarded as being fairly based on the earlier disclosure. Furthermore, although no reference is made in the present application to the rigidity requirements of rotors, in so far as the construction may have been found to have adequate rigidity without the necessity of tie rods, such a development is of potentially inventive character having regard to the earlier disclosure.

Accordingly I found that the present application discloses matter which extends beyond that disclosed in the main application as filed and offends Section 76 of the Patents Act 1977.

I therefor refused to allow the application to proceed as a filing under Section 15(4) of the Patents Act 1977.

Dated this 1st day of October 1982

J Winter

J WINTER

Principal Examiner, acting for the Comptroller

PATENT OFFICE