

PATENTS ACT, 1949

IN THE MATTER OF an application
No 1413494 by Yates Industries Inc

and

IN THE MATTER OF opposition
thereto by

- (1) Electrofoils Limited
- (2) Gould Foils Limited

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FINAL DECISION

In my interim decision of 15 January 1981 I found that the first opponents had succeeded in their allegation of prior use against the invention as claimed in claims 1 and 2. I allowed the applicants an opportunity to put forward proposals for amendment of their specification to meet that finding. As a result the applicants have offered to amend the claims with consequential amendments to the statement of invention and description, the amendments being said to be by way of explanation or disclaimer and taking the form shown in red and green in the printed copy of the specification filed on 23 March 1981 and now annexed to this decision.

The opponents objected that the applicants' proposals were not allowable and did not meet the requirements of the interim decision. As a result, a further hearing took place on 26 June 1981 at which Mr R Wyand appeared as counsel for the applicants and the opponents were not represented.

The effect of the applicants' amendments is to limit claim 1 to a process in which arsenic, if present, must exceed a minimum level of 0.3 grams per litre. Original claim 7 which introduced a further metallic treatment stage is replaced by new claim 2 directed to a three stage process in which the initial two stage pretreatment is according to claim 1, but need not conform to the minimum arsenic requirement now introduced into that claim. Since the amendments effectively disclaim the use of arsenic at a level below 0.3 gms/litre in a two stage process, they overcome the prior use finding of the Interim Decision.

When the amendments were first submitted to the Office the examiner expressed a prima facie view that the claims related to more than one invention, and this view was taken up by the opponents in their letters of 7 April and 11 May 1981, who relied on remarks made by Mr Justice Graham in Mobil Oil Corporation's

application 1969 RPC at page 597, where at lines 39 to 43 he found that, once the matter has been brought to his attention, the Comptroller was obliged to prevent a specification which related to more than one invention going forward to grant.

At the hearing Mr Wyand argued that the Mobil application was a clear case of plurality of invention, whereas the present applicants were simply disclaiming something that was prior used, under circumstances in which a specific disclaimer as approved in *Shell v Esso*, 1960 RPC 35 would have been an acceptable form of amendment.

I accept that my finding of prior use was such that an express disclaimer of the prior used portion of the field of the invention would have been allowable, and since the proposed amended claims have a similar effect to an express disclaimer, I do not consider that they give rise to an objection of plurality of invention, calling for action by the Comptroller.

The opponents also made the criticism that in view of the admitted close relationship or equivalence between arsenic and the other specified elements, antimony, bismuth, selenium and tellurium the applicants should not be allowed to introduce a limitation with regard to arsenic while retaining unquantified references to these other elements. They argued that having regard to the interim decision the invention as it relates to these other elements is lacking in novelty or is obvious. In my interim decision I made no finding of prior publication, prior use or obviousness with regard to these alternative elements and I concluded that the proved prior use of arsenic was not such as would have led the skilled man to a knowledge of the process involved, and would give no support for an allegation of obviousness. Consequently I find no substance in the opponents' contention that the applicants amendments should extend beyond the exclusion of that which I have found to be prior used.

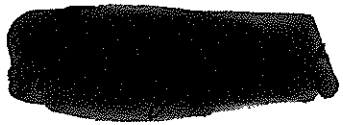
Finally the opponents objected that the amendments arbitrarily selected the lower limit of 0.3 g/l from claim 3 but did not also include the upper limit of 1.5 g/l. Bearing in mind the observation of Mr Justice Whitford in *Screen Printing Machinery Limited's Application*, 1974 RPC 628, that an applicant should not be forced into a position of having to make an amendment of so restrictive a character that in substance he would lose the benefit of the protection to which he ought to be entitled, I see no objection to the amendment on this ground.

In the result I find that the amendments are such as may lawfully be made in these proceedings and that they meet the objections raised by the opponents.

Accordingly I allow the application to proceed to grant with the specification amended in the manner shown in red and green on the print annexed hereto.

In the circumstances of the case I award the applicants one hundred pounds (£100) in respect of their costs in the first opposition and two hundred and fifty pounds (£250) as a contribution towards their costs in the second opposition, and direct that these sums be paid to them by the first opponents Electrofoils Limited and second opponents Gould Foils Limited, respectively.

Dated this 17th day of August 1981



G O BYFLEET

Superintending Examiner, acting for the Comptroller

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