

PATENTS ACT 1977

BLO / 185 / 83

IN THE MATTER OF Patent Application
No 7909783 in the name of
Fruehauf Corporation

DECISION

The examiner having raised objections under Sections 1(1)(a) and 14(5), the matter came before me at a hearing on 2 September 1983 when Mr A M Dowler appeared as agent for the applicants and Mrs P Everett attended as the examiner in the case.

The application which was filed on 20 March 1979 without claiming priority, is concerned with the construction of refrigerated compartments forming part of a vehicle body, the compartments having roofs and side walls of structural foam sandwiched between inner and outer skins. In order to allow the carriage of, for example, meat, hanging from the roof within the compartment, the roof includes load carrying beams extending across the width of the compartment these being mounted on a top rail structure at each end, the top rail structures having downwardly extending portions secured to both the outer and inner skins of the respective side wall. Claim 1 of the application, as published under Section 16, defines these constructional features and further states that the arrangement is such that loads are transmitted from the roof beams to the downwardly extending portions of the top rail structure through a portion of the top rail structure that is between the planes of the outer and inner skins of the side walls.

At substantive examination of the application in accordance with Section 18, the examiner raised objection to claim 1 under Section 1(1)(a) citing application No GB 2,019,788A published 7 November 1979, and claiming priority from a United States application dated 16 March 1978. The cited application is concerned with the manner in which loads are suspended from the roof beams in refrigerated vehicle bodies, but the invention is described with reference to an insulated compartment of the type which is the subject of the present application, Figure 2 in particular of the cited application showing a cross-sectional view of substantially the arrangement described in the present

application with respect to Figure 3 thereof.

Since the cited application was published after the priority date, ie the filing date, of the present application, the matter disclosed is only available for citation as prior art against the present application if the requirements of Section 2(3) are satisfied. In fact the applicants did not deny that an objection of lack of novelty lay against the application in the form as published under Section 16, and they attempted to deal with this by insertion of a disclaimer reading:

"An insulated compartment is disclosed and claimed in our co-pending Applications Nos 790933 (Serial No 2,019,788) and 8203042 (Serial No 2,096,066), and no claim is made herein to an insulated compartment as claimed in either of those Applications."

Application No 82 03042 was divided out from the cited parent application under Section 15(4) on 3 February 1982 and was published under Section 16 on 13 October 1982. The examiner was not satisfied that this met the objection of anticipation and also raised objection under Section 14(5) taking the view that the insertion of the disclaimer rendered the scope of the claims, and particularly claim 1, obscure. The applicants responded by amending the wording of the disclaimer to refer to matter contained in either of the specified applications rather than to what was claimed therein.

At the hearing Mr Dowler submitted that the disclaimer sought to be included in the specification referred specifically and only to the particular combination of constructional features disclosed in the applications noted. I am not convinced that the proposed wording would limit the disclaimer in this way, since it refers simply to "any matter" contained in the applications, but in any event, even if the wording were to be amended so as to make this clear, I am not of the opinion that such a disclaimer would provide an acceptable form of amendment since its effect would be the exclusion of one of the two particular disclosed examples of the invention defined generally by claim 1 of the application.

Mr Dowler further suggested, in the present application, that the general form of claim 1 modified by the disclaimer does not nullify the general claim entirely but only in respect of the specific form disclaimed, leaving a claim to the general constructional arrangement except the specific arrangement

disclosed in the applications noted, but again since the specific form or arrangement is one of the particular examples of the present invention then I do not consider that this would result in a definition of a monopoly of which the scope can be clearly determined.

It was further submitted that in cases where the claim was considered to be clear and the wording of a modifying disclaimer was also clear then this would necessarily result in a clear definition of the monopoly being sought, but this would only be so in cases where the difference between what is being claimed and what is being disclaimed is clearly able to be determined, and would not apply to the present application where what is being disclaimed comprises the contents of the specifications of two applications so that this difference is not readily determinable.

Finally, Mr Dowler suggested that the present application ought to be allowed to include a general claim of the form originally included since it was only by the accidental order in which the United States and British cases were filed that Application No 2,019,788A included a drawing and description of one form of the present invention. However, since the cited application clearly includes a construction falling within the scope of claim 1 of the present case, and prior publication in respect of Section 2(3) is not disputed then it is clear that claim 1 of the present application must be amended so as to exclude what is disclosed in the cited application. I do not consider that the inclusion of a disclaimer such as is sought in the present instance provides an acceptable form of amendment since it would allow amendment to meet any Section 1(1)(a) objection by insertion of a disclaimer specifically listing the cited matter, and since the inclusion of such disclaimers would not allow the scope of the claims modified thereby to be clearly determined. Accordingly I refuse to allow the application as proposed to be amended to proceed to grant.

Dated this *20th* day of *September* 1983

E J LAWRENCE

Principal Examiner, acting for the Comptroller

PATENT OFFICE