

0160191

PATENTS ACT 1977

IN THE MATTER OF Patent No.2110303
in the Name of SHOKETSU KINZOKU KOGYO
KABUSHIKI KAISHA

and

IN THE MATTER OF an application for
Revocation thereof by FESTO KG

DECISION

In my interim decision dated 29 August 1989 I found claims 1 to 4 to be lacking in inventive step. I allowed the patentees two months in which to submit proposals for amendment and to identify subject matter on which it could be said that the omnibus claim, claim 5, was valid. In a second interim decision, dated 9 July 1990, I found a proposed detailed omnibus claim to be valid and gave the patentees two months to submit a copy of the specification complying with rule 40(7) and incorporating the claim. An appeal to the Patents Court from my second interim decision was dismissed on 8 February 1991.

The required copy of the specification was filed on 30 August 1990. It incorporates the detailed omnibus claim, and omits the previous claims and the statements of invention and advantage (page 3 line 5 to page 4 line 5). Minor amendments are also made on page 4, lines 6-10 and page 7 lines 23-24. All these amendments are accepted by the applicants in their letter of 11 September 1990 and in my view are allowable.

The specification filed on 30 August 1990 also omits the final part of the description (page 8 line 8 to page 9 line 5). This comprises a table and accompanying text comparing the attractive force between the arrays of magnets with the force in otherwise equivalent rodless cylinders in which the magnets are arranged in a conventional (figure 1) manner. The accompanying letter states that the deletion was

"in order to ensure full consistency between the description and the claims."

In their letter of 11 September 1990 the applicants object that this deletion is unjustified and contrary to Section 76 of the Act. They say:

"Given that the sole remaining claim is an omnibus claim which must be interpreted by reference to the description and drawings, it is submitted that the deletion of any descriptive matter must necessarily have the effect of broadening the scope of the claim....."

In their letter of 11 October 1990 the patentees reply:

"If Table 1 and the associated description were to be retained then we feel that the passage would be open to the interpretation that it is describing the measurement of the attraction forces between magnet rows of rodless cylinders which have the various features which are set forth in the amended claim, at least in those instances where the magnet arrangement is in accordance with the invention. In our view such an interpretation cannot however be derived from the originally filed British specification

and consequently we feel that it is the retention of Table 1 and its associated description which could give rise to an objection under Section 76.

Conversely, in the present instance we cannot understand how the proposed deletion can offend against Section 76. We hasten to say that should the Hearing Officer prefer the view expressed in [the applicants'] letter, we have no objection whatsoever to reinstating the passage in question."

When the papers in this case were returned from the Patents Court after the appeal, they were referred to me for consideration, and I directed that an official letter be issued in reply to the patentees' agents' letter of 11 October 1990, saying that:

"The Hearing Officer's provisional view is that he would be inclined not to entertain a controversial amendment at this stage in the proceedings and therefore that the deleted passage from pages 7 and 8 should be reinstated.

The patentees are asked, within four weeks of the date of this letter, to request a hearing on the point, or to file replacement pages so as to reinstate the deleted matter. In the latter event a decision will be issued as soon as possible allowing the amendments."

The replacement pages were filed on 4 April 1991. I am satisfied that the new specification filed on 30 August 1990, but with the replacement pages just mentioned, complies with the requirements of my second interim decision, and I hereby allow the specification to be amended accordingly.

Dated this 20 day of May 1991



W J Lyon
Superintending Examiner, acting for the Comptroller

PATENT OFFICE