

PATENTS ACT 1977

BCC / 084/85

IN THE MATTER OF Application
No 8221518 in the name of
ARMCO Inc

DECISION

The examiner having reported that amendment of the specification on 11 December 1984 to include new independent claims 11 to 14 (together with corresponding consistory clauses in the description) resulted in the application disclosing matter which extends beyond that disclosed in the application as filed contrary to the provisions of Section 76(2) and also having reported that these new claims were not supported by the description (in particular the original description) as required by Section 14(5)(c), these matters came before me at a hearing on 5 June 1984. The applicants were represented by Mr G C Bayliss and Mr K S Targett of Boulton, Wade and Tennant and the examiner Mr M V Mitchison was in attendance.

The applicants' invention relates to the suspension of an inner pipe from an outer pipe using a hanger apparatus. It is particularly directed to apparatus for use in deep offshore oil wells where the high pressures encountered necessitate the use of heavy pipes producing extremely heavy loads between the pipes.

In the application as filed, the invention was set out in its broadest terms in claims 1 and 10 which read respectively:-

1 The combination of inner and outer pipes and a hanger apparatus for suspending the inner pipe upright from the outer pipe, including an upwardly facing load-bearing shoulder on the outer pipe; first and second downwardly facing load-bearing shoulders on the inner pipe; an expandable split locking ring having a downwardly facing load-bearing shoulder engageable with said upwardly facing load-bearing shoulder on the outer pipe and an

upwardly facing load-bearing shoulder engageable with said first downwardly facing load-bearing shoulder on the inner pipe; and a ring member, shearably coupled to the inner pipe and engaging said split locking ring, for releasably coupling said split locking ring to the inner pipe below said first downwardly facing load-bearing shoulder on the inner pipe, said ring member having an upwardly facing load-bearing shoulder engageable with said second downwardly facing load-bearing shoulder on the inner pipe.

10 The combination of inner and outer pipes and a hanger apparatus for suspending the inner pipe upright from the outer pipe, including an upwardly facing load-bearing shoulder on the outer pipe; first and second downwardly facing load-bearing shoulders on the inner pipe; an expandable locking member having a downwardly facing load-bearing shoulder engageable with said upwardly facing load-bearing shoulder on the outer pipe and an upwardly facing load-bearing shoulder engageable with said first downwardly facing load-bearing shoulder on the inner pipe; and an annular member, shearably coupled to the inner pipe and engaging said locking member, for releasably coupling said locking member to the inner pipe below said first downwardly facing load-bearing shoulder on the inner pipe; said annular member having an upwardly facing load-bearing shoulder engageable with said second downwardly facing load-bearing shoulder on the inner pipe.

The description contained a statement of invention drawn in essentially the same terms as claim 1 and described the invention by way of example with reference to two specific embodiments of the invention illustrated in Figures 1 to 4 and Figures 5 to 8 respectively. The application as originally filed was also accompanied by an abstract, reading as follows:-

Dual ring casing hanger

A hanger apparatus is disclosed for suspending an upright inner pipe (14) from an outer pipe (16) including a

pair of load-bearing rings (10, 12) interposed between the two pipes. The inner and outer pipes have opposed frustoconical load-bearing shoulders (20, 24, 40, 47, 49) receiving the rings therebetween. In one embodiment, both rings engage the inner and outer pipes, with an upper ring (10) being driven outwardly into a locking position by a lower ring (12). In this case, the upper ring is split while the lower ring is solid. In a second embodiment, an outer ring engages both the inner and outer pipes while an inner ring is nested into the outer ring and engages the inner pipe. In this second embodiment, both rings are split.

The abstract was printed as filed (ie without being reframed by the Comptroller under Section 14(7)) and was accompanied by Figure 1 (as suggested by the agent in Section X of Form 1/77 in accordance with Rule 19(4)).

Following the issue of the examiner's first report under Section 18(3), amendments to the specification were submitted. These included four new independent claims 11 to 14, together with corresponding consistency clauses in the description. These claims read as follows:-

11 The combination of inner and outer pipes and a hanger apparatus for suspending the inner pipe upright from the outer pipe, including an upwardly facing load-bearing shoulder on the outer pipe; first and second downwardly facing load-bearing shoulders on the inner pipe; an expandable split locking ring having a downwardly facing load-bearing shoulder engageable with said upwardly facing load-bearing shoulder on the outer pipe and an upwardly facing load-bearing shoulder engageable with said first downwardly facing load-bearing shoulder on the inner pipe; and a ring member, held on the inner pipe below the first downwardly facing shoulder thereon and engaging said split locking ring, for releasably coupling said split locking ring to the inner pipe below said first downwardly facing load-bearing shoulder on the inner pipe, said ring member having an upwardly facing load-bearing shoulder engageable with said second downwardly facing load-bearing shoulder on the inner pipe.

12 An inner pipe and an outer pipe and a hanger apparatus for suspending the inner pipe upright from the outer pipe including a pair of load-bearing rings interposed between the two pipes, the inner and outer pipes having opposed frustoconical load-bearing shoulders receiving the rings therebetween, both rings engaging the inner and outer pipes, with an upper one of the rings being driven outwardly into a locking position by the other, lower ring, the upper ring being split while the lower ring is solid.

13 The combination of inner and outer pipes and a hanger apparatus for suspending the inner pipe upright from the outer pipe, including an upwardly facing load-bearing shoulder on the outer pipe; first and second downwardly facing load-bearing shoulders on the inner pipe; an expandable locking member having a downwardly facing load-bearing shoulder engageable with said upwardly facing load-bearing shoulder on the outer pipe and an upwardly facing load-bearing shoulder engageable with said first downwardly facing load-bearing shoulder on the inner pipe; and an annular member, held on the inner pipe below the first downwardly facing shoulder thereon and engaging said locking member, for releasably coupling said locking member to the inner pipe below said first downwardly facing load-bearing shoulder on the inner pipe; said annular member having an upwardly facing load-bearing shoulder engageable with said second downwardly facing load-bearing shoulder on the inner pipe.

14 An inner pipe and a lower pipe and a hanger apparatus for suspending the inner pipe upright from the outer pipe including a pair of load-bearing rings interposed between the two pipes, the inner and outer pipes having opposed frustoconical load-bearing shoulders receiving the rings therebetween, an outer one of the rings engaging both the inner and outer pipes while the other, inner ring is nested into the outer ring and engages the inner pipe, both rings being split.

In his letter accompanying the amendments and at the hearing Mr Bayliss submitted that claims 12 and 14 were allowable since they were directed to apparatus specifically disclosed in the abstract which formed part of the application as originally filed. He also pointed out that new claims 11 and 13 were of similar scope to the original claims 1 and 10 with the exception (ie omission) of one feature, viz a shearable coupling between a ring or annular member on an inner pipe, and submitted that this omission was justified since this feature was not mentioned in the abstract and indeed had also been omitted from the new claims 12 and 14.

In his letter dated 24 January 1985, the examiner objected to the new claims under Section 76(2) and 14(5)(c) drawing attention to the decision in Protomed BV's Application [1983] FSR 110 and contending that matter present only in the abstract could not be incorporated into the specification. In his reply Mr Bayliss contested the examiner's view that matter could not be transferred from the abstract to the specification and argued that the requirements of Section 14(5)(c) were satisfied in that the new claims were supported by the amended description, there being no requirement that the claims should be supported by the original description. In his letter, dated 15 April 1985 the examiner while conceding that it was matter in the application as originally filed which was relevant under Section 76(2), nevertheless maintained his objection under that Section and under Section 14(5)(c) referring additionally to the recent decision in B & R Relays Ltd's Application [1985] RPC1 and also to Section 125(1) in support of his argument that matter in the abstract should not be used for the purpose of redefining the scope of the invention in such a way that would add matter notionally to the body of the specification. In a further response, Mr Bayliss contended that the examiner had applied the wrong tests by considering i) whether matter had been added to the body of the specification and ii) whether the claims were supported by the original description and iii) that the examiner had erred in applying the provisions of Section 14 in an objection to an amendment of the description and claims.

At the commencement of the hearing, I informed Mr Bayliss that I not only accepted the examiner's view that in pre-grant proceedings it was matter in the application which is to be considered but that I also accepted that since an abstract filed on the date of filing of an application was part of that application by virtue of Section 14(2)(c), matter contained in the abstract could be considered for the purposes of Section 76(2).

The point to be considered under Section 76(2) is therefore whether or not, the matter contained new claims 11 to 14 was fully disclosed in the abstract. According to Section 14(7) the purpose of the abstract is to give technical information, although not for the purposes of Section 2(3). The way in which this is to be done is prescribed in Rule 19, particularly Rules 19(2), 19(3) and 19(5) which read respectively:-

19-(2) The abstract shall contain a concise summary of the matter contained in the specification. The summary shall indicate the technical field to which the invention belongs and be drafted in a way which allows a clear understanding of the technical problem to which the invention relates, the gist of the solution to that problem through the invention and the principal use or uses of the invention. Where appropriate, the abstract shall also contain the chemical formula which, among those contained in the specification, best characterises the invention. It shall not contain statements on the alleged merits or value of the invention or on its speculative application.

19-(3) The abstract shall normally not contain more than 150 words.

19-(5) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.

Mr Bayliss's main argument is straightforward, viz the text of the abstract set out the gist of the invention and since the

new claims are drawn in substantially the same terms as this text, the abstract discloses the matter of these claims so that there is no extension of the matter disclosed.

In my view, the consideration is not as simple as this. By virtue of Rule 19 an abstract is required to be a concise summary of the matter contained in the specification and is severely restricted in length. On my reading of the Rule, it is not required to set out all of the essential features of the invention as enumerated in the main claim(s) or the description nor even necessarily to distinguish between such features and those features which form part of a preferred embodiment; indeed to do so may well be impossible given the requirement in Rule 19(3) that the abstract shall normally not contain more than 150 words. I note in the present case that, although the provision of a shearable coupling between a ring or annular member and the inner pipe was presented as an essential feature in the specification as published under Section 16, the examiner did not deem it necessary to use the comptroller's power under Section 14(7) to reframe the abstract to bring out this feature explicitly. I also note that Figure 1 of the drawings which accompanies the abstract (as suggested by the agent under Section X of Form 1/77) shows shear pins 32 which provide the shear coupling even though this function is not mentioned explicitly in the text of the abstract. Accordingly, I do not find that the absence in the abstract of explicit references to the shearable coupling and other features present in the original claims 1 and 10 but not the new claims 11 to 14 constitutes a disclosure in the application as filed of a hanger apparatus without these feature(s) - in my view a more explicit statement or indication would be necessary to provide such a disclosure, eg a statement that the shearable coupling was an optional or preferred feature.

Mr Bayliss also made two further points which call for comment. First, he submitted that since Section 14(7) specifically excludes the abstract from consideration under Section 2(3) then a contrario it is not excluded for any other purpose. I am not satisfied that this is a correct interpretation of Section 14(7) since this exclusion must be read on to the opening statement that the purpose of the abstract is to give technical information.

In any case, I have already decided above that the abstract does not disclose the matter in question. Second, Mr Bayliss submitted that if the text of the abstract had been part of the specification itself then the new claims would not have introduced matter and that, by analogy, the new claims did not introduce matter in the actual circumstances of the application since the abstract formed part of the application. The first limb of Mr Bayliss's argument is based on a hypothetical situation which I am not called upon to decide but, even if he is correct, I do not think it helps him since the second limb is, in effect, based on the proposition that the concise summary which constitutes the abstract is equivalent to a statement of invention in the specification. I do not accept that this is correct for reasons similar to those given above.

Accordingly, I find that the application as amended by the introduction of new claims 11 to 14 and the corresponding consistory clauses discloses matter extending beyond that disclosed in the application as originally filed, contrary to Section 76(2).

The examiner also supported his objection under Section 76(2) by reference to Section 125(1) which reads

125-(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

The examiner particularly noted that this Section omitted any reference to the abstract. In reply, Mr Bayliss pointed to the phrase "unless the context otherwise requires" and argued that since Section 76(2) refers to the "application" and since this includes the abstract then Section 76(2) is such a context for the purposes of Section 125(1). I am not satisfied that the

examiner is correct in referring to Section 125(1) for the purposes of interpreting Section 76(2) but, in view of my findings above which do not rely on Section 125(1), I do not need to decide the matter.

As regards the objection under Section 14(5)(c) that the new claims are not supported by the original description, the decision in B & R Relays Ltd's Application[1985] RPC 1 is of particular relevance since the facts of that case are closely similar to those in the case in suit in that:-

(i) a replacement claim was filed drawn in wider terms than the disclosure in the application as first filed by virtue of the omission of a feature originally presented as essential, and;

(ii) the replacement claim was accompanied by a corresponding statement of invention.

It was decided that:-

"The Act specifically provides under Section 14(5)(c) that the claims of the specification must be supported by the disclosure.

There is no disclosure in the specification which could conceivably support a claim with the omission sought".

Although this decision refers to "the disclosure", since the replacement claim was accompanied by a corresponding statement of invention, I understand this to mean "the original disclosure" and I note from the headnote (3) on page 1 of the reported decision that this is also the understanding of the editor.

Mr Bayliss did not contest this but sought to distinguish the present case on the basis that the relevant matter was contained in the abstract on the date of filing. I have already decided above that the abstract did not contain the necessary matter. In addition, I note that Section 14(5)(c) refers specifically to "the description" and that Whitford J in his decision in B & R Relays refers specifically to "disclosure in the specification".

Accordingly, I also find that the new claims 11 to 14 are not supported by the description as required by Section 14(5)(c).

At the hearing, Mr Bayliss stated that if his arguments based on matter contained in the abstract were not accepted, he wished to submit alternative arguments that the matter of the new claims and corresponding description was contained in the specification itself on the date of filing. However, neither the examiner nor Mr Bayliss was in a position to address me on this at the hearing and I am not called upon to decide this at this stage.

In view of my above findings, I refuse to allow the application to proceed to grant in its present form. In consequence if the applicants wish to pursue the application they should submit amendments to meet my findings within two months of the date of the decision. Alternatively, if the applicants wish to submit further arguments based on matter contained in the specification at the date of filing they should do so within six weeks of the date of this decision.

Dated this 17th day of June 1985

L LEWIS

Principal Examiner, acting for the Comptroller

PATENT OFFICE