

PATENTS ACT 1949

01/10/93

IN THE MATTER OF

an opposition by Blakes Fireworks Ltd
to proposed amendments under Section 29
to Patent No. 1580579
in the name of Le Maitre Fireworks Ltd.

DECISION

On 25 February 1992 Le Maitre Fireworks Ltd ("the applicants") applied under Section 29 to amend the complete specification of their Patent No. 1580579, published in 1980. The proposed amendments were considered by an examiner who reported that they were allowable in principle subject to advertisement.

Subsequent to advertisement, Blakes Fireworks Ltd ("the opponents") lodged, on 15 June 1992, an opposition to the proposed amendments followed shortly thereafter by a statement of case. The patentees responded with a counterstatement but neither party filed any evidence. Accordingly, in an official letter dated 26 March 1993 both parties were invited to inform the Office within 2 weeks if they wished to be heard in the matter. The applicants indicated that they did, but no response was received from the opponents.

The papers were then sent to me, and on reading them I formed the provisional view that the proposed amendments are allowable. I therefore directed that a letter be sent in the following terms to the two parties:

"The hearing officer has read the papers in this case in preparation for the hearing that was to be appointed. However since the opponent to the proposed amendments has not indicated an intention to attend a hearing, it seemed right to inform you that the hearing officer has formed the provisional view that the proposed amendments are allowable and consequently a hearing may be unnecessary.

In view of this, the Office has decided not to appoint a hearing, on the basis that one will be appointed:

- (a) if on a closer view of the papers the hearing officer considers that his provisional view might be wrong; or
- (b) if either party so requests within 2 weeks from the date of this letter.

A formal decision will be issued if neither party requests within the set period."

The official letter was issued on 3 August 1993 and no request for a hearing was received by 17 August. I have therefore studied the papers again, and now issue this decision.

Patent No. 1580579 in its unamended form is entitled "Improvements in or relating to Pyrotechnic Devices" and the complete specification opens with the statement:-

This invention relates to improvements in pyrotechnic devices and is particularly, but not exclusively, concerned with such devices intended for use in producing stage effects such as, for example, flashes, explosions or smoke effects.

The way in which the device operates can be readily understood from Claim 1, the sole independent claim, which reads:-

A pyrotechnic device comprising a hollow receptacle, a pair of electrical contact pins extending through a wall of the receptacle for insertion into an electrical socket and exposed internally of the receptacle, a fuse-wire secured and electrically connected between the exposed parts of the contact pins internally of the receptacle, a charge of pyrotechnic material within the receptacle and in contact with the fuse-wire and a closure for the receptacle of a weaker material than the remainder of the receptacle such that it will break or rupture under the pressure generated by ignition of the pyrotechnic material.

The applicants have sought to amend the specification by replacing the words "pyrotechnic device" in the first line of Claim 1 with "theatrical effect generator", corresponding

amendments being proposed throughout the remainder of the specification. The reason given for the proposed amendments are stated on Form 35 as being "by way of clarification".

The opponents have objected to these proposals on grounds which can be summarised as follows:-

1. In being "by way of clarification" they are not in accordance with Section 31(1) of the Patents Act 1949 which states that no amendment shall be effected except by way of disclaimer, correction or explanation.
2. The applicants could not have only recently become aware of the need for the amendments and the consequent delay in seeking leave has been prejudicial to the interest of competitors.
3. The applicants have not given the real reason for the proposed amendments which, in the view of the opponents, is to make good an invalid patent in the light of prejudicial prior art, the amendments in any event being ineffective to overcome such prior art.

I will consider the opponent's grounds in turn, mindful of the requirement in Section 29(2) that "Every application for leave to amend a specification under this section shall state the nature of the proposed amendment and shall give full particulars of the reasons for which the application is made".

The first ground of objection was valid at the time the application was made, but has been corrected in the counterstatement, where the applicants have made it clear that the amendments (other than to the names of the applicants for the patent) are by way of disclaimer. The proposed amendments quite clearly have the effect of limiting the monopoly and therefore meet the terms of section 31(1).

The second and third grounds depend on a finding that the applicants have shown a lack of candour by withholding information from the Comptroller about relevant prior art, or have been guilty of undue delay in dealing with relevant prior art.

The applicants have admitted in response that they have recently been made aware of only one other relevant prior art document apart from those cited during the examination prior to grant, namely GB Patent No. 657717 in the name of Schermuly. The applicants have also admitted that they were aware of this patent at the time of the application to amend but did not consider it worthy of bringing to the Comptroller's attention. They point out that the Schermuly device was not proposed for plugging in and does not have a pair of contact pins for insertion into an electrical socket, adding that it could not have fulfilled the purpose for which the pyrotechnic device as originally claimed was designed.

I have studied the Schermuly patent, which was published in 1951. It discloses a flare device especially for use by distressed airmen in dinghies. The flare has a screw threaded end cap to fit into the conventional bulb holder of a battery torch. Alternatively the end cap can be provided with pins to fit into a bayonet type bulb holder. Insulated wires extend from the end cap to opposite ends of a fuse disposed within the flare tube such that when the torch switch is pressed, the fuse ignites the flare composition presumably rupturing the metal foil end closure soldered to the steel tube.

Schermuly differs from the unamended Claim 1 by not having the required arrangement of contact pins, and by not having a fuse-wire connected between the exposed parts of the contact pins. To my mind these differences are substantial enough to lead me to the conclusion that Schermuly does not render claim 1 as granted either obvious or lacking in novelty.

The applicants appear to be proposing to limit their monopoly from an abundance of caution rather than actually in order to validate a claim that is not new or not inventive. In such circumstances, they do not, as I understand the case law on this subject, have a formal obligation to disclose at the outset the close prior art that they are being cautious of. Nonetheless, they will, as this case demonstrates, usually be asked to disclose it during the

course of the proceedings, and therefore time and expense will be saved by if the prior art is mentioned in the application to amend.

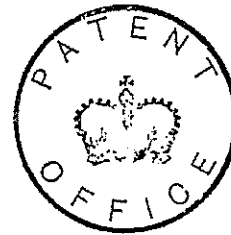
It follows that there are no reasons why the the Comptroller's discretion to refuse the amendments should be exercised against the applicants and I allow the amendments that are indicated in red ink on a copy of the printed specification filed by the applicants with their application.

Both parties have requested an award of costs but in the circumstances I make no order.

Dated this 17 day of August 1993

W J LYON

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE