

BLO /129 /86

PATENTS ACT 1977

IN THE MATTER OF Application  
No 8503830 in the name of  
Mayflower Products Limited.

DECISION

The application was filed on 14th February 1985 together with a request, under the provisions of Section 15(4), that it be accorded the earlier date of filing of 13th June 1984, derived from the applicants' prior application No 8415033.

Following preliminary examination and search under Section 17 the application was published under the provisions of Section 16, being accorded Serial No 2155168A, and also bearing a warning that the date of filing shown on the printed specification was that provisionally accorded to the application in accordance with the provisions of Section 15(4) and was subject to ratification or amendment. Form 10/77 requesting substantive examination of the application under Section 18 was filed within the prescribed period. However in the case of prior application No 8415033 (Serial No 2143773A), which was published on 20th February 1985, no Form 10/77 was filed within the period allowed by Rule 33(2), and in consequence this application was treated as withdrawn, and advertised accordingly. Thus there can now be no question of any further application under Section 15(4) being filed on the basis of this earlier application.

Upon closer scrutiny of the application during substantive examination the examiner was of the opinion that it disclosed matter which extends beyond that disclosed in the earlier application No 8415033 as filed. The applicants were therefore informed that in accordance with the provisions of Section 76(1) the application could not be allowed to proceed as a filing under Section 15(4), and that in view of the decision of the Patents Court in Hydroacoustics Inc Applications 1981 FSR 538 amendment

of the application to delete the additional matter would not allow the earlier date claimed to be accorded. This was contested by the applicants through their agent's letters of 14th May 1986 and 14th July 1986, and a hearing was accordingly appointed on 3rd September 1986 to determine the matter as to whether the application should be allowed to proceed as a filing under Section 15(4).

In their agent's letter of 27th August 1986 the applicants signified that they would not be represented at the hearing. Consequently the matter has been decided on the basis of the documents on file, due account being taken of the arguments set out in the agent's letters of 14th May 1986, 14th July 1986 and 27th August 1986.

The application in suit relates to a thermally insulated portable container of the type used for the storage of foodstuffs or bottled drinks on journeys, having a generally rectangular prismatic body lined with a metal foil-faced plastics material, and provided with an adjustable thermally insulating partition which is a snug fit within the container between opposite internal wall surfaces thereof to thermally insulate one part of the internal space of the container from the remainder. The container, which is a non-collapsible or rigid structure, may be made by forming a hollow rectangular prismatic body with a lining of plastics material having a reflective metal deposited on one surface thereof, closing one end of the hollow body with a fixed panel having a lining of the same material, forming a similarly lined openable closure at the other end, and inserting the thermally insulating partition either parallel to the base or in an upright position between a pair of opposite walls. The lining material may be of a composite metal foil-faced plastics material bonded to a wider sheet of thermoplastic material providing foil-free margins which may be joined by R. F. welding. The thermally insulating partition, which is preferably of relatively stiff construction so that it may act as a platform for articles placed above it, may have at least one reflective metal foil

surface.

The passage of the description to which the examiner has referred as extending the disclosure of the present application beyond that of earlier application No 8415033, is the statement in the paragraph bridging pages 5 and 6 of the specification as filed (lines 13-15 on page 2 of the printed specification) that the physical separation purpose of the partition "is enhanced by the provision of a stiff or rigid core material such as expanded polystyrene."

Turning to the earlier application, which is directed to the construction of the flexible lining material from a reflective metal foil-faced plastics sheet and a larger flexible plastics backing sheet, and its use in the manufacture of a portable container, much of the disclosure is identical to that of the application in suit. It is however manifest that it contains no specific reference to the use of expanded polystyrene as a stiff or rigid core material. Indeed the agent has not denied that there is no explicit reference at all in the earlier application to the use of expanded polystyrene.

After careful consideration, as I understand it, the main thrust of the arguments set out in the agent's letters is that the skilled reader of the earlier specification would appreciate that polystyrene would be one of a group of materials having the required strength and insulating properties to render them suitable for use in constructing the partition. Thus in the agent's letter of 14th May 1986 it is contended that the references in both specifications to:

"..... Its prime function is to act as a separator or baffle separating, physically and thermally, a lower compartment ..... from the remainder of the internal volume."

would be understood by the addressee to indicate a combination of

insulating and mechanical properties in the material of which the partition is to be made, and that such a reader would have a sound knowledge of the available thermal insulating materials both in their general classifications - polyethylenes, polystyrenes etc - and in their predominant mechanical characteristics, such as tensile strengths, rigidities, densities and the like. Reliance is also placed in the agent's letter of 14th May 1986 inter alia upon the reference in the final paragraph of the description in the earlier specification to the use of foil-faced polyethylene foam instead of foil-faced plastics sheeting in making the lining material. It is alleged that the reader will draw naturally on his or her stock of general understanding of the required characteristics of the materials involved, and has the benefit of specific prompts regarding the required stiffness of the material by the applicants in their earlier specification, all this being compendiously embraced by the word "disclosure". The letter also acknowledges that expanded polystyrene is just one of a group of materials having the necessary strength which will fit it for the manufacture of the partition.

It is further argued in the agent's letter of 14th July 1986 that the skilled reader would be aware that for the manufacture of insulated containers polyethylene foam is obtainable in a range of grades from soft and resilient to stiff according to the requirements of the particular case. Attention is also directed to the teaching of Specification 1568294 (Waterman), which is one of the documents listed by the examiner as a result of the search effected under the provisions of Section 17 in connection with the application. This specification is directed to a container lined with a heat insulating material comprising a base insulating material, preferably expanded polystyrene, having attached thereto a metallised plastics film, it being stated that the expanded polystyrene has low thermal conductivity and has the advantage that it provides the container with additional rigidity. This specification does indicate however that other materials could be used instead of polystyrene.

The examiner's attention has been invited in the agent's letter of 14th May 1986 to the following words of the headnote to EPO Decision T06/80 (OJEPO 10/81 at 434)

"Where a further functional attribute of an element of a device disclosed in a document is immediately apparent to a person skilled in the art reading the document, such attribute forms part of the state of the art with regard to that device,"

It is acknowledged that this decision was promulgated in the context of prior art disclosures relevant under Section 2, and that Section 76(1) proscribes the inclusion of "matter which extends beyond that disclosed in the earlier application." It is however argued that these are merely two sides of the same coin - the comparison of the contents of a specification with the external data - so that the EPO decision is equally applicable in the present divisional situation, it being necessary for the examiner to show that it would not be immediately apparent to a person skilled in the art reading the applicants' earlier specification that it extended to (a) "a stiff or rigid core"; (b) "of expanded polystyrene".

In the official letter of 26th June 1986 the examiner has pointed out that the decision (T06/80) is concerned with inventive step or obviousness, and for assistance when assessing the criteria to be applied when considering additional subject matter he has referred to the relevant part of the Guidelines for Examination in the European Patent Office March 1985, namely Part C, Chapter VI, paragraphs 5.4 and 5.8.

Paragraph 5.4 states that "An amendment should be regarded as introducing subject matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by addition, alteration or excision) results in the skilled person

being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art in what has been expressly mentioned. The test for additional subject matter therefore corresponds to the test of novelty given at IV, 7.2."

This is reflected in the EPO decision T201/83 (OJEPO 10/84 at 481), referred to in the agent's letter of 14th July 1986 in support of the applicants' case, which states that the test for compliance with Article 123(2) EPC is basically a novelty test, ie no new subject matter must be generated by the amendment.

Turning to Chapter IV, 7.2 it is stated:

"Thus, when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the document; this is a matter of obviousness."

Chapter VI, paragraph 5.8 states that

"Alteration or excision of the text, as well as the addition of further text, may introduce fresh subject-matter. For instance, suppose an invention related to a multi-layer laminated panel, and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment of this example either to alter the outer layer to polypropylene, or to omit this layer altogether would not normally be allowable. In each case the panel disclosed by the amendment example would be quite different from that originally disclosed and hence the amendment would introduce fresh subject-matter and therefore be unallowable."

It is the applicants' case that the criteria for assessing subject matter as set out in the European Guidelines are not

appropriate for assessing the question of added subject matter under the Patents Act 1977. In support of such contention they point out in their agent's letters of 14th July 1986 and 27th August 1986 that Section 76 is not included among those sections of the Act specified in Section 130(7) as being so framed as to have, as nearly as practicable, the same effect in the United Kingdom as the corresponding provisions of the European Patent Convention, in this case in Article 123(2) of the Convention.

They maintain in consequence that the corresponding EPO Guidelines Chapter VI, 5.4 and 5.8, are not relevant to the present consideration, and that paragraphs 5.6 and 5.6a are in fact the correct criteria to be considered namely:-

"If, however, the applicant can show convincingly that the subject-matter in question would, in the context of the invention, be so well-known to the person skilled in the art that its introduction could be regarded as an obvious clarification, the amendment may be permitted."

and

"Where a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully, yet it can be deduced without difficulty by a person skilled in the art from the application<sup>as</sup> filed, subsequent clarification of that effect in the description does not contravene Article 123, paragraph 2".

When the wording of Section 76(1) of the Patents Act 1977 is compared with that of Article 123(2) of the Convention it will be seen that both proscribe the extension of either the original disclosure or content, ie "added subject matter". Neither, however, are concerned with the definition of added subject matter, which is a matter for judicial interpretation. That being so I am not persuaded that the failure of Section 130(7) to

refer to Section 76(1) is relevant to the present case. It is my view, therefore, that it is appropriate to have recourse to the European Guidelines Chapter VI, 5.4 and 5.8 in determining what in effect constitutes added subject matter, and indeed this corresponds to United Kingdom practice in such situations. However, whether or not the European Guidelines, which to my mind in any event can serve only as a general indication of the basic principles to be applied, are relevant to the present case, it seems to me that the issue to be decided is whether the present application presents the skilled reader with information relevant to the invention which the earlier application does not.

Turning now to the applicants' earlier specification it is I think clear that the partition should be of thermal insulating material, and at least in the case where it is positioned parallel to the base in a horizontal position, have sufficient rigidity to support the articles contained in the upper compartment of the container. At lines 80-82 on pages 2 of the printed Specification reference is made to forming the partition with one or both surfaces of heat-reflective composite sheeting, thereby improving its thermal insulating characteristics. No further specific constructional information in respect of the materials used to form the partition are provided, the reference in the final paragraph of the description upon which the applicants rely, to foil-faced polyethylene foam being used instead of foil-faced plastics sheeting apparently being directed to the material used for lining. It may be apparent to the skilled reader from this passage, particularly having regard to claim 7, that foil-faced polyethylene foam may be used in the construction of a partition having heat reflective surfaces. However, it seems to me that a wide range of materials having thermal insulating properties and suitable rigidity could well be suitable for use for the partition, and that in specifying in the application in suit that the partition may be provided with a stiff or rigid core material of expanded polystyrene, even although this may be obvious to the skilled reader, additional matter has been introduced into the specification extending the



disclosure beyond that of the earlier application. Thus it will be seen that the use of expanded polystyrene is introduced for the first time in the application in suit, and that such disclosure would be effective in anticipating the novelty of any later similar specific disclosure, whereas that of the earlier specification would not. I find support for this view by reference to two recently reported cases. Thus in Chinoi's Application 1986 RPC 39 at page 42 the hearing officer refused the addition to the specification of further information even although this may have been obvious to the reader. Similarly in Ward's Applications 1986 RPC 50 at page 54 the hearing officer refused to allow an amendment which would have increased the specificity or particularisation of the origin disclosure.

Moreover, I am not persuaded of the relevance of the European Guidelines Chapter VI, paragraphs 5.6 and 5.6a to the present case. As the applicants themselves acknowledge, a range of materials could be suitable for use in constructing the partition in question. However they have failed to demonstrate that the skilled reader would single out expanded polystyrene from these so as to satisfy the necessary criteria of an unambiguous clarification of the text of the prior application.

In the result, I find that the application in suit discloses matter which extends beyond that disclosed in the earlier application as filed, and thus contravenes the provisions of Section 76(1). Accordingly I refuse to allow the application to proceed as a filing under Section 15(4).

Finally, in correspondence between the agent, Mr Clark, and the office prior to the hearing, the agent has questioned the impartiality and what he describes as the technical sincerity of the examiner. I would add for the record that the examiner concerned is very experienced in patent matters, and has worked for more than twenty years on this area of subject matter. However, even if he were not so experienced, as Mr Clark must know, in a situation where an agent or applicant and the examiner

cannot agree, it is established practice, and in accordance with the Act and Rules, to bring the matter to a hearing before a senior official of the Office. This has been done and in reaching my decision, I have taken no account of the personal attack upon the examiner, and have been concerned solely with the technical and legal arguments expressed.

Dated this 24<sup>th</sup> day of September 1986

C M EDWARDS

Principal Examiner, acting for the Comptroller.



THE PATENT OFFICE