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PATENTS ACT 1977

IN THE MATTER of
Application No 8515660 for
Letters Patent by L B (Plastics) Limited

8515660.1
8515660

Statement of reasons

The examiner having raised objections to the application and the applicants having failed to satisfy her that the objections were not well founded, a hearing was appointed for 9 June 1986.

Mr Graham Shipley of counsel appeared on behalf of the applicants, Mr A J McMaster, of Messrs Swindell & Pearson, his instructing patent agents, was also present. Miss Y J Pegler presented the examiner's objections. Following the hearing my decision was communicated to the applicants orally on 13 June 1986. I now provide the following statement of reasons.

The application in suit, No. 8515660, was filed on 20 June 1985 under the provisions of Section 15(4) as a divisional application accompanied by a specification including description, claims and drawings which were identical with the specification of application No. 8233584 (the "parent case") as originally filed.

The parent and divisional specifications were directed to "window frame and door components" and in accordance with the opening paragraphs were concerned with the problem of avoiding separate and expensive retooling in the production of a large variety of shapes and sizes of plastic window and door frames.

It was stated that it was "an object of the present invention to provide a window or door frame component so constructed that it may be used in a variety of locations and fitted with seals and other attachments without requiring modification of the component itself" and this statement is the only statement in the specifications providing information on the applicants objectives. The specifications contained two substantive claims, as follows:

1. An elongated component for use in the construction of a window or door frame in which one external face of the component is provided with at least two longitudinally extending channels incorporating retaining means enabling fitments to be attached to the component.

3. A component for use in the construction of a window or glazed door frame, the component comprising a frame member having inwardly-directed formations adapted to locate a glazing element, outwardly-directed formations which may serve as anchorage or location points when the component is used in the construction of a window frame, and a removable trim strip attachable to said outwardly-directed formations to conceal same when the component is used in the construction of exposed portions of a door frame.

Other dependent or omnibus claims were directed to a set of the components, a bay window construction constructed inter alia from the components and a glazed door constructed from a set of the components.

An omnibus claim was also provided which reads:

16. A component for use in the construction of a window or door frame substantially as hereinbefore described with reference to the accompanying drawings.

and a final claim was as follows:

21. Any novel subject matter or combination including novel subject matter herein disclosed, whether or not within the scope of or relating to the same invention as any of the preceding claims.

The description contained statements of invention corresponding to claims 1 and 3, definitions of various optional and preferred features, an indication of special problems arising with bay windows which were overcome by the frame components and a detailed description of the drawings.

In the course of examination of the parent case, which included citation of three British specifications and an objection that claims 1 and 3 did not relate to the same invention, claim 3 was deleted and claim 1 was restricted by the introduction of further features including those originally present in claim 3, and the application is ready to proceed to grant when the divisional is also in order and any amendments have been made which might possibly arise following changes to or termination of the divisional.

In the examination of the divisional application, with which the present decision is concerned, the Examiner objected, inter alia to claims 1 and 3 as not relating to the same invention and stated that claim 21 should be deleted. In response to this objection, the applicants filed a completely new set of claims which related to a component hitherto not openly claimed, namely a glazing bead and to window constructions comprising said bead, together with a new description which was reframed by the omission of the statement of object, the provision of a statement corresponding to the sole new substantive claim, statements corresponding to two of the appendant claims and a description of the drawings closely based on the original description of the drawings but additionally bringing out features which were not previously mentioned.

The examiner objected to the new specification as not complying with Section 76(2)(a) in a general sense, in that, it was said, "the overall change in content of the application by way of shifting of the invention and addition of subject matter results in the reader being presented with information which is not directly and unambiguously derivable by a person skilled in the art from that originally presented by the application". Objection was also raised under the same subsection in relation to certain particular passages which were considered to comprise added matter.

A further specification was filed on 17 March 1986 in which an attempt was made to deal with at least some of the particular passages objected to, but the main objection was disputed and despite further exchanges of letters, the specification remains as then filed.

The Examiner also raised the objection that the "description" as originally filed did not comprise a "description of the invention" now sought as required by Section 15(2)(b) inasmuch as the drawings

were not a part thereof and no reference was made to any details of the glazing bead: in consequence it was considered that subsequent versions of the specification necessarily comprised added matter.

Mr Shipley's response to this objection was along the lines that the reference to the drawing in the description effectively incorporates every detail of the drawing into the description. I think this is indisputable: in my view Section 15(2)(b) refers to the description and drawings as physical items whereas the effect of the reference is to incorporate the intellectual or technical content of the drawings into the description.

As originally filed, the description made reference at two points only to a "bead" which cooperates with the window or door frame component. Thus on page 2 it is stated that a preferred component has features serving as an abutment for a "glazing element" (by which I understand a sheet of glass or the like) and "locating means for a removable retaining bead which may be attached to retain the glazing element in engagement with said abutment", whilst on page 6 reference is made to "a longitudinally extending glazing bead 11 shown in figure 2 [which] may be engaged so as to retain the glazing element 10 in engagement with the abutment 9". The earlier of these passages corresponds to a passage in an appendant claim. Thus, the description in regard to the glazing bead was cast wholly within the context of the particular construction of window or door frame component with which the specification as originally drafted appeared to be concerned.

At the hearing, Mr Shipley drew my attention to the second, more particular statement referred to above. He emphasized the words "may be" which I have underlined and urged that they meant that the glazing bead is capable of being attached and were thus of descriptive significance, rather than meaning that a glazing bead was optional which he considered to be manifestly not so. That may well be so, but I do not infer in either case that the description in any sense goes beyond the relationship between the glazing bead shown and the other components shown. It appears to me that the reference to the glazing bead is not relieved of the burden of the context to which I have referred. Put alternatively I find here no suggestion that the glazing bead is, or could be, of general applicability. I

recognise that, ex post facto one can imagine a reader speculating as to whether or not the glazing bead might be applied to other frame constructions, but he would then, I think, be straying beyond the bounds of apprehension and understanding of the drawings and description into the area of invention and would not be in the position of the notional skilled, but non-inventive, reader.

off.
I therefore took the view that ~~in depriving~~ the description of the glazing bead ^{having been deprived} of its original context, and ~~in thus opening up~~ the possibility of its applicability in all manner of undisclosed window and like frames, ^{having thus been opened up} the description notionally discloses matter which extends beyond that originally disclosed and is open to objection under Section 76(2)(a), and it followed that the claims are likewise unacceptable.

Claim 1 currently reads as follows:-

1. A glazing bead comprising an elongated member adapted to be inserted between a pane or panes of glass and a window frame to retain the glass in the frame, the glazing bead comprising first retaining means at or adjacent its outer edge engageable with a co-operating retaining member on the frame and second retaining means at or adjacent its inner edge, said second retaining means comprising oppositely acting retaining formations engageable with at least one co-operating retaining member on the frame, each retaining formation being arranged to be more firmly engaged by movement of the bead in a direction to disengage the other formation.

I observe that the nature of the window frame is unspecified saving that it must have at least one "retaining member" to engage cooperatively with "retaining means" and "retaining formations" on the glazing bead at the "outer" and "inner" edges respectively thereof. The glazing bead itself is defined, to my mind, in terms which are extraordinarily indefinite and in consequence of the inspecific nature of the defined frame, it amounts to little more than a glazing bead having retaining means at or near each edge, one of which has "oppositely acting retaining formations", the significance of the latter expression being derivable to some extent from the drawing, but clearly embracing a wide range of possible retaining means.

It appeared to me quite clear that this claim is not supported by the original description, namely the glazing bead illustrated in the drawings, which has many characteristics not present in the claim, the most obvious of which (to my mind) would seem to be its hollowness and its ability to cooperate with yet another member (not referred to at all in the description but shaded by means of dots in the drawings) to secure the glass. The omission of these features at least, following the arguments advanced in the decision on Protoned's application [1983] FSR 110, notionally adds matter to the description which was not present in the original specification and thus the amendment was not allowable under Section 76(2)(a) on this basis also.

As I have indicated above, the examiner also raised the question whether or not the applicant is entitled to any claim at all to the glazing bead per se, that is to say to the glazing bead unassociated with a window or door frame such as appeared originally to be the sole invention.

In this connection, Mr Shipley directed my attention to claim 21 which I have quoted above. He suggested that in consequence of the presence of this claim, readers were put on notice that what the applicants are seeking is protection for ~~are~~ all the inventions which are disclosed, which might at some time prior to grant be made the subject of a monopoly claim or claims.

The purpose of a claim as indicated in Section 14(5)(a) is to define the matter for which an applicant seeks protection, by which I understand that the obligation is laid upon an applicant to define his invention in the claims in such a way that an interested party may know from the claim alone (interpreted if need be by the description and drawings as provided by Section 125(1)) whether or not a given article, process etc whether real or putative falls or would fall within the defined field. Under the Patents Act 1907-1932 in *E & M I Ltd v Lissen Ltd* 56 RPC 25 page 39, Lord Russell stated that:

"the function of claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly."

That principle appears to me equally relevant under the Patents Act, 1977.

Claim 21 purports to devolve upon the interested party the obligation of determining the novelty of each and every disclosed feature or combination of features before the protected field can be ascertained. This in my view is entirely inappropriate, I think the claim fails in its purpose and that the reader is free with impunity to disregard it.

Mr Shipley also mentioned, but did not comment on claim 16 which I have quoted above. Although in form directed to "a component" not otherwise particularised, I have no doubt that claim 16 must be regarded as relating only to the window or door frame component with which the specification as originally drafted appeared to be concerned.

I therefore felt confident in applying the words of the Hearing Officer in Glatt's application (1983 RPC 122 at page 126) to the present application.

He said

"Third parties who, potentially, may be affected should not, it seems to me, have to face monopolies which were neither clearly sought nor founded by the inventor at the date of filing, but which were conceived later and claimed post hoc".

and this was supported in the Patents Court in the following terms

"The Principal Examiner has come to the conclusion that [the claim] is not [supported by the description] and I think he is quite right in reaching this conclusion upon this basis, that the applicants are putting this claim forward as covering something which quite plainly, to my mind, was never within the contemplation of the invention as described in the specification".

I have no doubt that the monopoly now sought to be claimed was "not within the contemplation of the invention as described" in the originally filed specification, and on this ground also I found against the applicant.

I was informed that the European Patent Office examiner had raised no objection to a claim or claims to the glazing bead unassociated with other components being inserted after the filing date in a European Patent application corresponding to the present parent application. I am not however persuaded to revise my view of the present case, especially since Section 76 is not referred to in Section 130(7) as being so framed as to have the same effect as the corresponding provisions of the European Patent Convention and further since the absence of an examiner's objection could not, in any case, provide any form of authority in relation to the European Patent Convention.

In accordance with RSC Rule 14(2), the applicants have a period of 6 weeks from the date of the decision, viz 13 June 1986, in which to appeal.

Although I am unable to envisage any form of amendment to the specification which would dispose of the objections without laying the application open to objection under Section 18(5) vis-a-vis the parent application, the applicants are nevertheless at liberty under Section 20(2)(b) to submit amendments until the expiry of the period allowed viz until 25 July 1986.

Dated this 24th day of June 1986



M.G CURRELL

Principal Examiner, acting for the Comptroller

PATENT OFFICE