

B20/096/90

THE PATENTS ACT 1977

IN THE MATTER of
application No. 8610379 in
the name of Playtime
Electronics Ltd assignees
of Ian B Tragen

DECISION

Application No. 8610379 was filed on 28 April 1986 by Mr Ian B Tragen claiming priority from an earlier UK application made by him on 16 November 1985, and was published on 28 May 1987 with the number 2183076A. On 15 February 1990 Mr Tragen entered into an agreement to assign, and did assign, all his interests in the application to Playtime Electronics Ltd ('Playtime'). On 19 April 1990, section 21 observations were filed as a result of which the examiner decided that amended claims filed by Playtime to meet a novelty objection outstanding when they took over the application introduced matter extending beyond that disclosed in the application as originally filed. Further claims were filed by Playtime, but since the examiner was not satisfied that they met his objection and since the application was by then in its first extended month beyond the normal period of four years and six months for putting the application in order, the matter came before me on 11 June 1990. Mr A J A Bubb of Gee and Co appeared as agent on behalf of Playtime.

The present invention relates to a drumstick modified so as to be able to control electronic equipment connected to it either directly by cables or indirectly by radio. In the main embodiment the drum stick incorporates a small switch located approximately one third the way along its stem, an

embedded vibration transducer, and a cable connector at its end. In use the drum stick is connected to an electronic sound generating device which, when the switch is pressed, is triggered by pulses of alternating electric current generated by the transducer in response to impact of the stick upon a surface. When the switch is not pressed the stick can be used in its usual manner.

The original main claim was -

1. A drumstick incorporating one or more transducers capable of converting vibration to electrical energy.

and the main claim currently on file and to which the examiner has objected is -

1. An electronic percussion instrument, comprising at least one drumstick containing means responsive to impact of the stick on a playing surface for producing an electrical output signal, and an electronic percussion sound generating device arranged to be triggered by said electrical output signal in order to produce an audio frequency percussion signal corresponding to said impact of the drumstick.

The examiner argued that by its use of the phrase 'means responsive to impact' this claim introduces into the specification the notional disclosure of all impact responsive devices other than that disclosed in the original specification, namely a vibration transducer. Given the settled state of the law on this question - and Mr Bubb did not argue to the contrary - there is no doubt in my mind that if the facts are as asserted by the examiner then the new claim does introduce new matter into the specification. However, what Mr Bubb did argue was that the facts were not as stated by the examiner.

According to Mr Bubb adequate disclosure of impact responsive devices is to be found in the following two paragraphs on page 9 of the original specification:-

"A further variation within the scope of the invention is to use a switching system that does not rely on impact or the use of a finger operated switch. For example, by using a mercury tilt switch or other gravity switch within a drumstick it is possible to seem to be playing an invisible drum. This approach is not likely to appeal to serious musicians as the actual point of trigger can be unpredictable. It is more suitable to use as a toy.

Another useful method of incorporating switches would be to use magnetic reed switches within the stick. These could be operated by the use of a magnetised finger ring."

Moreover, argued Mr Bubb, if it is held that this passage is not clear and does not provide adequate disclosure then correction of the passage under section 117 of the Act would be allowable, as a result of which by reference to the priority document the passage could be amended to provide the necessary disclosure.

Having carefully considered Mr Bubb's arguments, I disagree with him on both counts. I do not think that the passage pointed to by Mr Bubb clearly provides the disclosure necessary to support the matter now claimed, and I do not think that correction under section 117 in the manner that Mr Bubb has indicated is allowable. My reasons for these conclusions follow.

First I will consider whether the passage cited by Mr Bubb provides a foundation for his present claim. The nub of the difficulty lies in the first few words of the passage, namely -

"A further variation . . . is to use a switching system that does not rely on impact . . ."

The problem that the examiner saw in this passage was that, because in the description preceding the passage the phrase 'switching system' is used only once when it is apparently used to refer to the switch or switches included in the drumstick as opposed to the vibration transducer itself, and because the only other similar phrase used in the description is the phrase 'advanced switching control system', which also is apparently used to refer to the switch or switches included in the drumstick, no switching system that does rely upon impact has apparently been described, and therefore the implication in the passage that such a switching system is being varied so as not to rely upon impact, does not make sense. Not so, argued Mr Bubb. Because the passage in question only makes sense if a switching system that does rely upon impact has been described, then it follows, as I understood him to argue, firstly that in the passage the phrase 'switching system' must be taken to include the vibration transducer - since this, albeit indirectly, does respond to impact - and secondly that the passage implicitly discloses that any switching system that does rely upon impact, rather than one limited to a vibration transducer, can be used in the drumstick. I do not accept this argument, and in particular I do not accept that the two lines quoted above implicitly disclose the use of any impact responsive device in addition to the express disclosure of the vibration transducer. I am prepared to accept that the first two sentences of the passage disclose the use of a mercury tilt switch or other gravity switch instead of a finger operated switch, and that the last part of the passage discloses the further possibility of using a magnetic reed switch. However, all of these variations are directed to the switch per se, and nothing that I have seen in the specification or heard from Mr Bubb convinces me that there is any disclosure of a drumstick that does not incorporate a vibration transducer.

Other possible constructions of the passage in question were put forward by Mr Bubb, but since the only construction that might have provided a foundation for the present claims is the one which I have just discussed, nothing useful is served by discussing them. Having considered all of Mr Bubb's submissions on the passage I am satisfied that the skilled man when reading the passage in context would not derive from it directly and unambiguously, or implicitly, any disclosure of the use in a drumstick of impact responsive devices in general.

I now turn to Mr Bubb's second approach, namely the correction of the passage in question under section 117 of the Act by reference to the priority document. In principle, if an error is present in a specification - and Mr Bubb argued that if I found that the passage was not clear then an error was present - then that error can be corrected by reference to the priority document. However, the evidentiary burden placed upon an applicant who wishes to correct an error is high since according to the Rules for a proposed correction to be permissible it must be immediately evident that nothing else would have been intended.

Looking at the priority document Mr Bubb argued that it is clear from two particular passages on pages 1 and 6 to which he drew attention that it discloses the use of impact responsive devices in addition to vibration transducers. That may well be true, but I do not accept that the disclosure in the priority document of a feature that is not also in the application claiming priority from that document is necessarily evidence that the drafter of the application has made an error. It seems to me that one must consider the nature of the omission and the relationship of the two documents to each other.

In the present application, there are many differences between the two documents. For example the priority document includes on page 1 the following introductory passage:-

"This invention introduces the provision of a drumstick within which an electronic trigger mechanism is contained. The trigger is in the form of an electromagnetic or other electromechanical transducer, a switching system or a number or combination of these things. Provided also is a method of transferring the signal from the stick to other electronic apparatus using a releasable cord, a convenient method of connecting two such sticks to other electronic apparatus is also provided."

whereas the corresponding passage on page 2 in the present specification is -

"This invention introduces the provision of a drumstick incorporating one or more transducers capable of converting vibration to electrical energy.

The transducer is in the form of an electromagnetic or other electromechanical transducer.

Advantageously one or more electrical switches are also incorporated into the drumstick.

The resulting electrical signal is conveniently transferred from the stick to other electronic apparatus by means of a releasable cord, or by means of a wireless transmitter."

and this difference, as well as several others, appears to me to be the result of a conscious act of judgement by the drafter rather than the result of an error. In view of this, and in the absence of any other evidence, in my opinion it can only be assumed that the words used by the drafter of the specification of the present application accurately reflect his intentions. It follows therefore that I do not think that in the present case the priority document affords any guidance at all as to the

intentions of the drafter of the application. This being my opinion, it also follows that I do not need to consider the actual corrections that were put forward by Mr Bubb.

In conclusion I support the examiner's objection that claim 1 currently on file extends the disclosure beyond that contained in the original specification and that it therefore contravenes section 76 of the Act. Accordingly I refuse to allow the application to proceed unamended.

The remaining claims currently on file were not discussed at the hearing and I make no finding in respect of them.

Any amendments directed at overcoming the examiner's objection that Playtime wish to submit should be filed within a period of three weeks from the date of this decision below. In the absence of the submission of any such amendments within that period the application will stand refused.

Any appeal from this decision should be filed within a period of six weeks from the date of this decision below.

Dated the 15th day of June 1990



B J Phillips
Principal Examiner, acting for the Comptroller