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PATENTS ACT 1977

IN THE MATTER OF

Patent Application No 8806123.9

in the name of Noxell Ltd

DECISION

Application no 8806123.9, entitled "Blister Packs" on Form 1/77, was filed on 15 March 1988 in the name of Noxell Corporation (UK) Ltd, but is now proceeding in the name of Noxell Ltd. In an Official letter dated 3 April 1991 setting out the first report under section 18(3) of the Patents Act 1977 ("the Act"), the examiner objected inter alia that the application did not comply with sections 1(1)(a) and (b) in that the invention at least so far as claimed in claim 1 was not new and did not involve an inventive step having regard to five cited patent specifications.

In his letter of response dated 3 October 1991 and its enclosures, the applicant's agent, Mr J J Day of Reddie & Grose, amended claim 1 and the statement of invention to indicate that a particular component of the claimed blister pack should be "non-peelable". In a further Official letter of 10 December 1991, the examiner objected that the application as amended disclosed matter extending beyond that disclosed in the application as originally filed, contrary to section 76, and warned that the application might be refused unless this matter was deleted. Reconsideration of the cited prior art and the objections under section 1(1) were deferred in the light of the objection under section 76.

The objection under section 76 was addressed in correspondence between the applicant's agent and the examiner but without agreement being reached. In a letter dated 14 May 1992 the agent took up the examiner's offer that a hearing should be appointed to resolve the issue, and it duly came before me at a hearing on 15 June 1992, at which Mr Day appeared as agent for the applicant and the examiner in the case also attended.

The application in suit relates to blister packaging and more especially to tamper and pilfer resistant packaging. Specifically, the packaging is a blister pack of the type in which a blister is retained by trapping it between the layers of a laminated backing card. The specification describes several particular embodiments of blister pack of this type in which a tear-resistant plastics film is provided beneath the blister to prevent removal of goods contained in the pack. One or two layers of film may be provided. When one layer is provided, it may be in one of several fixed positions in or on the laminated card, or it may comprise a loose insert.

Claim 1, the only independent claim, defines the invention in the following terms, the wording in brackets having been added by the agent in response to the examiner's objections under sections 1(1)(a) and (b) and being the subject of the subsequent objection under section 76:

"A blister pack of the type in which the blister is retained by trapping it between two layers of a laminated backing card, wherein a [non-peelable] layer of the laminate lying beneath the blister is formed of tear resistant plastics film such as to prevent removal of the goods from the blister by tearing the card or by pushing them through the back of the card".

The statement of invention on page 1, which is consistent with claim 1 although not identical in wording to it, has been similarly amended.

Amendment of an application for a patent is allowed under section 19 of the Act subject to conditions prescribed in sub-section (2) of section 76 which reads:

"(2) No amendment of an application for a patent shall be allowed under section 17(3), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed".

In interpreting and applying the provisions of section 76(2), I must also have regard to section 130(3) of the Act, which reads:

"(3) For the purposes of this Act matter shall be taken to to have been disclosed in any relevant application within the meaning of section 5 above or in the specification of a patent if it was either claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of prior art) in that application or specification".

The proper interpretation to be placed on these provisions has been considered in number of recent judgments, in particular in Southco Inc v Dzus Fastener Europe Ltd [1990] RPC 587 and A C Edwards Ltd v Acme Signs & Displays Ltd [1992] RPC 131 and [1990] RPC 621. Neither of these judgments was drawn to my attention either by the agent for the applicant or by the examiner, and I do not therefore propose to quote from them. I do, however, consider it important that I make clear that my deliberations in the present case have been informed by the principles as I understand them set out those judgments.

I turn now in detail to the issue before me in the present case.

In first making the objection under section 76 in the Official letter of 10 December 1991, the examiner stated that the restriction of claim 1 to a "non-peelable" layer does not appear to be supported in the specification as filed originally, in which there is no clear indication as to whether or not the relevant layer is peelable. In his letter of reply of 24 December 1991, Mr Day suggested that the term "non-peelable" was "introduced into claim 1 as an amendment by way of disclaimer to distinguish the invention from the citations each of which discloses a blister pack of the type with which the invention is concerned rendered child proof by having a peelable layer which prevents the product from being pushed through the laminate". He submitted that "amendment of the specification by disclaimer in the terms of the prior art cannot be considered to add subject matter".

Mr Day elaborated on this position at the hearing, suggesting that it has always been possible to distinguish from prior art by way of disclaimer, sometimes in the form of a proviso at the end of the claim. He maintained that the broad claim in the application in suit having been anticipated by child-proof packages having a peelable layer of tear-resistant material, it was permissible "to make it patentable" by disclaiming the prior art.

In support of his assertion that he was entitled to make an amendment by disclaimer, Mr Day referred me to two authorities. Both relate to post-grant proceedings under the Patents Act 1949 and concern so-called intermediate generalisations. The first was the Patents Appeal Tribunal's judgment in Screen Printing Machinery Limited's Application [1974] RPC 628, and Mr Day drew my particular attention to the Tribunal's obiter comment summarised in the headnote as follows:

"where a broad claim is found to be prior published, the applicant ought not to be forced into a position of having to make an amendment of so restrictive a character that in substance he would lose the benefit of the protection to which he ought to be entitled".

In addition, I drew Mr Day's attention to the passage of the Tribunal's judgment commencing at line 45 of page 634, which reads:

"It is common enough in the specifications of patents concerned with mechanisms of the type with which this mechanism is concerned to give specific descriptions of features of the mechanism such as registration means but to include claims very much broader than the specific means described. In cases where it could not conceivably be said that there was any disclosure in the body of the specification of any general idea at all it may well be that if nothing more than one specific registering means were disclosed there would not be any possibility of being able to allege that the specification disclosed some generalised idea".

Mr Day's second authority, no particular part of which he chose to emphasise, was Matbro Limited v Michigan (Great Britain) Limited and Another [1973] RPC 823. At the hearing, I read lines 32 to 38 of page 831 to Mr Day as follows:

"Is the description in the specification as a whole, including, as I hold it does, the disclosure in the claims, such that it in substance discloses the use of a steering axis which may be situated at any point between the axles, and not merely as claim 2 in its unamended form claims, "substantially midway between the front and rear axles"?

If the answer to the first part of this question is "no", then in spite of the fact that the proposed amendment to claim 1 may be by way of disclaimer it would not be permissible under the section because it goes beyond the disclosure".

To the extent to which these two authorities can be regarded as relevant to pre-grant amendment under the 1977 Act, I take them to confirm that to be allowable an amendment by disclaimer must not inter alia add to the disclosure of the application, that is it must be supported by the disclosure of the application as filed. At the hearing, Mr Day did not dispute that certain intermediate generalisations are unallowable and that there are occasions when a disclaimer can introduce added subject matter and would be unallowable, and I am at one with him in this.

At the hearing, Mr Day accepted that there was no explicit disclosure in the application as filed of "peelable or non-peelable layers". However, he did argue on several grounds that it was implicit in the original application that the layer of tear-resistant film should be non-peelable. I shall consider each of his main arguments in turn.

First, Mr Day argued, if I may summarise his argument in this way, that non-peelability of the tear-resistant film layer is implicit from the purpose or use of the blister pack of the invention. He drew my attention to page 1 of the specification as filed, the first five paragraphs of which read as follows:

"This application relates to blister packaging and more especially to tamper and pilfer resistant packaging.

In store pilferage of goods from their packages has become extremely prevalent. Blister packs are one prime target for shoplifters.

In those packs where the blister is trapped between the layers of a laminated backing card the product can be fairly easily removed by pushing the product through the back of the card which is normally perforated to ease authorised removal.

Most attempts to improve the pilfer resistance of blister packs have revolved around a complete encasement of the product and backing card in a casing of plastics material, the so called "clam shell" pack. Such packs use a very large amount of plastics material, conventionally styrenes, cellulose, and vinyls. Apart from cost consideration this results in an environmental problem in the disposal of the pack.

One of the main pre-requisites of a pilfer resistant package is the length of time that it takes to open the pack and remove the goods. If a pack is difficult to open quickly the would be pilferer is deterred because of the higher risk of detection. Furthermore, if pack integrity is maintained this enables the inclusion of detection devices within it."

Thus, Mr Day's first argument in essence is that it is implicit from the context set by these paragraphs that the tear-resistant layer must necessarily be non-peelable because the pack would otherwise not be tamper and pilfer resistant. While I can certainly accept these paragraphs of the specification at face value, I am not persuaded that they indicate that the tear-resistant layer must necessarily be non-peelable, or that the skilled man would consider it implicit from the application as originally filed that it was so. Paragraphs 1 to 5 of page 1 set out to my way of reading them the problem which the invention seeks to overcome and at least one way it has been tackled before. I do not read them as necessarily implying anything about how the invention solves the problem, and hence as supplying the implicit disclosure required. Thus, a variety of ways might be conceived whereby these problems of tampering and pilfering might be tackled, and the object of hindering them achieved, for example by providing a tear-resistant layer that is not "non-peelable" but merely difficult to peel. At the hearing, Mr Day responded to this suggestion by acknowledging that this might be another possible solution, which seems to me to detract from the strength of his assertion that the implicit disclosure is of a non-peelable layer. However, he took the view that if he wished to make an amendment by referring to a certain peel resistance or strength it would be totally unallowable, but that to say that it is not peelable at all is allowable. I have to say that I have some difficulty with this hypothesis, and while I can agree with its first limb I cannot accept the soundness of its second.

A second and related argument might be developed from claim 1, and the statement of invention at paragraph 6 on page 1, of the application as filed which make clear that the blister pack of the invention is "such as to prevent removal of the goods from the blister by tearing the card or pushing them through the back of the card". However, this goes only as far as saying that the blister pack of the invention is tamper and pilfer resistant. I do not believe that the skilled man would infer from this anything about the peelability of the tear-resistant layer.

I am reinforced in this view of the disclosure, explicit and implicit, of paragraphs 1 to 6 of page 1 and of claim 1 as originally filed and hence of these first two arguments by two points. First, the application in suit says at the foot of page 1 that:

"The tear resistant layer may be incorporated in the backing card in any desired fashion".

This suggests to me a degree of freedom inconsistent with the layer being implicitly non-peelable. Second, the five specifications cited by the examiner all disclose peelable layers of tear-resistant material, suggesting that in the packaging field tamper resistance is not necessarily consonant with non-peelability. On the basis of that cross-section of the prior art, the skilled man would not be led to think that non-peelability is inherently linked to prevention of the unauthorised opening of blister packs. Mr Day's response to this latter point was that the tear-resistant layer in the packs described in the citations can be peelable because they are directed at child proofing, not tamper and pilfer resistance which he argued is a quite different field in which the present invention lies. I am not convinced by this argument. That the cited packs are intended to be child proof does not to my way of thinking take them into a different field from the present invention as Mr Day would have me believe. Children are as likely as adults to tamper with packages and, regrettably, can also be pilferers and shoplifters, so that the application in suit's references to tamper and pilfer resistance must surely encompass resistance to children as well as adults. Also, it is not the case that the strength of adults and children is necessarily so different that a child-proof pack, albeit peelable, would not provide significant resistance to at least some adults. Indeed, some child-proof packs are notoriously difficult for many parents to open. The

broad aim of the present invention to provide a tamper and pilfer resistant package could therefore be achieved by, say, a child-proof pack having a hard-to-peel layer. It is not therefore implicit in my view that the layer must be non-peelable for the purpose of the invention to be met.

Mr Day's third main argument as to the implicit disclosure of a non-peelable tear-resistant layer rests on references on page 2 to "heat seal lacquers", which he contended cannot by definition be peelable. However, when challenged on this, Mr Day agreed both that the specification does not make it clear that heat seal lacquers are always non-peelable and that he has adduced no evidence to support his contention that they are. Moreover, the specification does make other statements relevant to a consideration of the bonding provided between the layers. As Mr Day accepted when it was put to him, in at least some of the embodiments described on page 3 and shown in the drawings, a pressure-sensitive adhesive is provided adjacent the heat seal lacquer. Thus, in such a construction of blister pack, if the tear-resistant layer is to be non-peelable, that pressure-sensitive adhesive would, as well as the lacquer, need to be non-peelable. However, page 1 of the specification says that "the tear-resistant layer may be incorporated in the backing card in any desired fashion". Furthermore, while the specification is silent as to the peelability of the heat seal lacquer and the pressure-sensitive adhesive, it does say on page 2 that the adhesives used depend on the materials of the pack components and are well known in the art. It refers to the use of heat seal lacquers, for instance at lines 7 and 13 of that page, only by way of example and they are not suggested as being essential to (all embodiments of) the invention.

It seems to me that heat seal lacquers are a class of materials likely to have a range of peelabilities and I cannot simply accept without corroboration that they are necessarily all non-peelable. Moreover, I cannot accept that the lacquers used here are necessarily non-peelable. However, even if I were to accept Mr Day's contention that they are, or were wrong in not doing so, I am not persuaded that it is reasonable to interpret the application as necessarily being limited to the use of adhesives, including heat seal lacquers, which produce a non-peelable bond. So this argument too fails in my view to establish the necessary disclosure.

Mr Day's fourth line of argument as to implicit disclosure is that while there is no disclosure of non-peelable and peelable layers, the term "layer" is a generic one which discloses only two alternatives, a peelable layer and a non-peelable layer, and that the limitation to a non-peelable layer is a restriction of the disclosure, not added matter. In his support, both in his letter of 30 March 1992 and at the hearing, he cited paragraph 76.12 of the Patent Office's "Manual of Patent Practice" (Second Edition), which reads:

"76.12 If a generic term used in the document can be regarded as necessarily disclosing a relatively small number of particular alternatives, then restriction to one of these may be an allowable amendment. For example, if a pump or valve is disclosed as for use with "fluid" then it is reasonable to construe this as disclosing use with either liquid or gas, so that a statement that use with only one of these is contemplated can be regarded as a restriction of the disclosure rather than as added subject-matter".

The examiner's rebuttal, as presented in the Official letter of 11 May 1992, was that the word "layer" cannot be regarded as a generic term specifically disclosing a limited number of forms of layer, but would appear merely to define a thickness of material spread over an underlying surface with no indication of any particular form of bonding to that surface. I put it to Mr Day that the argument which he was presenting in regard to peelability could equally be applied to many other possible properties of the pack, for example that it was porous or non-porous, or even say green or not green. Mr Day said that he "could have said all sorts of things that these layers had not to be" and "that there are so many things that could go in the specification". He did then qualify these remarks with the comment that whether or not disclaimers based on these properties were permissible would depend on the inherent requirements of the packs of the prior art cited. As I understand this, it would mean that if the cited art showed blister packs which had porous layers, he would consider himself entitled to amend the application to disclaim that his applicant's packs were, that is to specify that they were non-porous.

I cannot accept this line of argument. The fact that it is possible for a "layer" to be peelable or non-peelable, porous or not, or anything else, does not amount to disclosure that it is or

is not any or all of these. The term "layer" in my view means a thickness of material spread over a surface and as such does not admit of two alternatives only, as it can embrace many pairs of alternatives which may or may not apply. Not everything within the ambit of a word can be regarded as being disclosed by the mere use of that word. The situation envisaged in paragraph 76.12 of the Manual is quite different. To take the example it gives, the word "fluid" is generally understood, unless the context demands otherwise, to mean "gas or liquid", and its use would therefore usually constitute disclosure of the two alternatives. I might add that the implicit disclosure of the term "fluid" is itself limited and would not extend to other possible properties of fluids divorced from the common meaning of the term. For example, while the use of the word "fluid" would usually provide support for the introduction of a reference to a gas, it would not do so for an odourless gas. This last example seems to me to bear some comparison to the amendment made in the present case.

Each of Mr Day's arguments thus seems to me to fail to support his assertion of implicit disclosure of a "non-peelable" layer of tear-resistant film. There is, however, a point which the examiner raised in the Official letter of 10 December 1991 which I must also consider, namely the fact that in one of the embodiments described in the paragraph bridging pages 1 and 2 of the specification, the tear-resistant film is provided as a loose insert and would not therefore appear to be of a clearly non-peelable form. Mr Day seemed not to regard this embodiment as inconsistent with a disclaimer based on non-peelability. Strictly I suppose if the film layer is not attached it is not wrong to say that it is non-peelable, but this is only because peelability is then a meaningless concept. I therefore regard this embodiment as inconsistent with the contention that the tear-resistant film layer is inherently non-peelable, and hence consider that it would tend to steer the skilled reader away from the inferring that it is.

I should note here that the examiner did not object to the clarity of meaning or scope of the term "non-peelable". It is a term of art, understood by persons skilled in the packaging field, and I need say no more than that I recognise it as such.

It seems to me quite clear from the authorities to which Mr Day drew my attention and from section 76(2) itself that to be allowable a disclaimer must inter alia not introduce new matter,

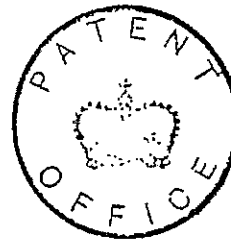
that is it must find support in the application as filed. This disclosure need not be explicit, it may be implicit and recognisable to the skilled man. I have carefully considered all the arguments put by Mr Day both in correspondence and at the hearing, but, for the reasons I have given above, I am not persuaded that the application as originally filed contains any disclosure that the layer of tear resistant film should be non-peelable. The addition of a reference that it is would in my view alter the teaching of the application and present the reader with information not directly, clearly and unambiguously derivable by a person skilled in the art from that originally presented. I therefore uphold the examiner's objection and find that the amendment inserting "non-peelable" into claim 1 and the statement of invention, be it regarded as disclaimer or not, is not allowable under section 76(2), and I therefore refuse to allow the application to proceed to grant in its present form.

At the hearing, Mr Day suggested that he may have put the disclaimer in the wrong form and accepted that there may be difficulties with the wording he actually used. He therefore asked me also to consider whether I would be prepared to allow an amendment by disclaimer which referred to the non-peelability of the tear-resistant layer but in different terms. Having given the matter careful consideration, I find myself unable to envisage an amendment which depended on the peelability of this layer which I would be prepared to allow. Fundamental to my decision on the present wording is the finding that the application as originally filed does not disclose, explicitly or implicitly, the peelability of this layer, so any amendment reliant on that property must be unallowable for the same reason. That the amendment might be a disclaimer would be immaterial if section 76 were to be contravened.

If the added matter is deleted, as I have found that it must be if the application is to proceed, the examiner's objections under section 1(1)(a) and (b), which were not the subject of the hearing, remain to be overcome. Bearing in mind that the unextended period provided under section 20 for putting this application in order expires on 15 September 1992, I allow under section 18(3) four weeks from the date of this decision, subject to any appeal, for the filing of observations or amendments to overcome those objections, as well as amendments deleting the added matter.

Since this is a substantive not a procedural matter, the time within which an appeal may be lodged is six weeks from the date of this decision.

Dated this 23 day of July 1992



S N DENNEHEY

Principal Examiner, acting for the Comptroller

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