0/146/97

PATENTS ACT 1977

Mrs Wilson
1R32

IN THE MATTER OF Patent
Application No 9517496.7 in the
name of Century Industries Inc

pregrant

DECISION

British application number 9517496.7 has a filing date of 2 March 1994 as the national phase of PCT application number WO94/20777, claiming priority from US application 08024758 filed on 2 March 1993. The first report under Section 18(3) was issued on 30 April 1996; this report contained no serious objections. On 22 July 1996, observations were filed by a third party under Section 21 and forwarded to the applicants. On 28 October 1996, the applicants filed amendments in response to the Section 18(3) report and the Section 21 observations. These amendments included a revised form of claim, which the examiner reported to be unsupported by the description as originally filed and to introduce new subject matter contrary to Section 76. The applicants did not agree, and the matter ultimately came before me at a hearing on 22 August 1997 at which the applicants were represented by Mr C Parry of Saunders & Dollymore. The examiner, Mr R Squire also attended.

The application relates to a multiple valve manifold comprising a manifold block having fluid outlet means, fluid inlet means, passage means connecting the inlet and outlet means, and valves for selectively opening and blocking the passage means.

Such manifolds are employed for connecting a pressure sensor to a pipeline.

Claim 1 as filed recited characterizing features all of which related to the construction of the outlet means. The full statement of claim 1 was as follows, ignoring reference numerals:

A multiple valve manifold for use with a process fluid pressure sensing apparatus, including a manifold block provided with process fluid inlet means and process fluid outlet means, said outlet means being provided in a normally generally horizontal upper face of said manifold block, said block comprising passage means for selectively opening or blocking the communication between said inlet means and said outlet means, and vent passage means for selectively connecting the outlet means with a vent outlet of said block, characterized in that (a) the outlet means is a generally vertical cylindric outlet chamber open on top, formed in said upper face, (b) the vent passage means includes an upstream end portion having the shape of an annular groove formed in the upper face, said groove being concentric with and disposed about said cylindric chamber, (c) an annular dam is disposed between the groove ans the respective chamber, said dam defining a normally generally horizontal circular top edge projecting beyond said upper face a predetermined distance which distance selected so as to locate the top edge of the dam closely to an isolating diaphragm of an associated pressure sensing apparatus, when the block is secured to a body of the respective pressure sensing apparatus.

After amendment, claim 1 read as follows, again ignoring reference numerals:

A multiple valve manifold for use with a process fluid pressure sensing apparatus, including a manifold block provided with process fluid inlet means in a generally planar first face and with process fluid outlet means in a generally planar second face, said second face being spaced from and being generally parallel with said first face, said block comprising passage means for selectively opening or blocking the communication between said inlet means and said outlet means, the outlet means being generally cylindrical outlet chambers open on top, formed in said second face, the inlet means comprising a high pressure inlet and a low pressure inlet and the outlet means comprising a high pressure outlet and a low pressure outlet wherein the spacing between the high and low pressure inlets is different from that of the high and low pressure outlets, said inlet means and said outlet means being all disposed

> generally within a rectangle defined by four mounting bores in the manifold block compatible with mounting bores of an associated pressure sensing apparatus, said mounting bores being generally perpendicular to said first and second faces.

This form of the claim makes no reference to the nature of the outlet means, nor to the presence of vent passage means.

The law relating to amendment of patent applications prior to grant has been considered in some detail by the Court of Appeal in A C Edwards Ltd v Acme Signs & Displays Ltd, [1992] RPC 131, and Southco Inc and Another v Dzus Fastener Europe Ltd, [1992] RPC 299. It is acknowledged by Staughton L J in Edwards v Acme at page 147 that the law relating to added matter is obscure. In both of these cases, amendment by omission of features of the invention was permitted, broadly speaking on the grounds that the amendments did not omit features which a skilled person would have regarded as essential to the invention as originally set out. However it was acknowledged in both cases that an amendment which omitted features of the invention which appeared to be essential to the invention as filed would contravene Section 76. In Southco v Dzus, the words of Aldous J are quoted and endorsed:

> I believe that section 76 is there to prevent the patentee disclosing either by deletion or addition any inventive concept which was not disclosed before but not to prevent a patentee claiming the same invention in a different way.

I must therefore consider the specification as filed. This begins with a discussion of the prior art in which the function of the manifold for connection to a pressure sensing transmitter is explained. As a result of the introduction of a new type of pressure transmitter, the previous standard spacing between two delivery ports became effectively obsolete. The prior solution to the problem posed by this change of spacing was to insert, between the manifold and the pressure transmitter, a so-called planar flange with inlets at the old spacing and outlets at the new spacing. This flange includes means for venting fluid. However, the flange adds

potential leakage points, occupies a significant amount of space, and is expensive to produce and maintain.

The object of the invention is stated to be to provide an improved manifold, to secure reliable operation in use, to improve accuracy, to reduce the cost of manufacture, and to reduce the height of the manifold body.

Without explaining how the invention achieved these objects, the specification then went straight into a statement in conformity with claim 1 followed by statements setting out further features of the invention, one of which approximately corresponds to claim 5 as filed and the other of which corresponds to claim 6 as filed.

In the amended specification, the prior art statements have been retained, but the statement corresponding to the original claim 1 has been replaced by one in conformity with the revised version of claim 1, followed by a further statement corresponding to the new claim 2, which includes the features originally in claim 1.

The examiner held the view that a skilled reader of the specification as filed would have concluded that the essential features of the invention were substantially those set out in claim 1, notwithstanding the absence of any statement as to how the invention achieved the objects. The new claim 1 sets out an entirely new invention, including a feature, that the inlet means and the outlet means are all disposed generally within a rectangle defined by four mounting bores in the manifold block, which was not even referred to in the specification. In this respect, this feature could almost be considered new subject matter, but for the fact that it is deducible from the drawings.

In his submissions at the hearing, Mr Parry raised the following issues:

1. The specification as filed contained more than the single invention claimed, and had he chosen to file a divisional application directed to the invention which now forms the subject of claim 1 there would have been no objection.

The considerations as to whether the claims of a divisional application are allowable are no different from the present situation. I refer to an unreported decision in Plantronics' Application, (SRIS C/96/85), in which a divisional application was directed to the features of one of the figures of the drawings. In the decision in this case, Falconer J stated:

> "I accept, of course, that in assessing disclosure for the purposes of section 76, one is entitled to look at the whole of the parent specification when considering a case whether or not a divisional application under section 15(4) is possible and is properly based on what is disclosed in the parent specification. What is disclosed in the parent specification must in every case be a question simply of the proper construction to be given to the parent specification."

Thus, if the new claims are unacceptable in the present specification they would also have been unacceptable in a divisional application.

As to whether the specification contains more than one invention, I shall be considering this matter later.

2. The features of the invention claimed in the new invention are all present in the application as filed and are therefore supported by the description.

It is true that the features of claim 1 are present in the disclosure. However, they are not present in a form which would alert a reader to them constituting an invention. I return to Southco v Dzus, this time to the words of Aldous J reported in [1990] RPC at page 616:

"There is no definition in the Act of what is meant by the word "matter" and I believe that this word is wide enough to cover both structural features of the mechanism and inventive concepts. Section 125 points to the claims being the part of the specification in which the invention is specified, whereas section 14 points to the specification as being the part which contains a description of the invention. Thus it is reasonable to look at the claims construed as part of the whole document to see what was the invention and generally to the specification for the way the invention can be performed."

I understand this to mean that "matter" can either be structural features or inventive concepts. I am satisfied that the structural features are not added. However that is not the question before me; I need to be satisfied also that the inventive concept is not added.

3. The statement starting on page 4 line 29 which the examiner regarded as a statement of invention was not in fact a statement of invention.

The statement in question begins with the words "in general terms, the present invention provides..." and continues in terms precisely corresponding to claim 1. Even if this is not a statement of invention, it points the reader firmly in the direction of the invention claimed in claim 1 and does not suggest that the invention could be anything else.

4. One of the stated objects of the invention is to reduce the height of the manifold body, which is not achieved by the original invention but which is achieved by that sought in the amended specification.

Mr Parry selected this object from several which are set out. While, as I have stated above, it is not wholly clear how the invention claimed achieved these objects, I do not consider them to be so far divorced from the invention as originally claimed as to make the reader think that the true invention was anything other.

5. The specification contains several references to features of the invention which were not consistent with the invention as originally claimed.

Mr Parry directed my attention to a number of such references. On page 4, after the statement corresponding to claim 1, there are two references "according to a further feature of the present invention" and "according to still another feature of the present invention". The second of these corresponds to claim 6 as filed, and is consistent with familiar practice in patent applications in which a statement corresponding to claim 1 is supplemented by such "further features" corresponding to features of appendant claims. The first is less easy to explain, since it refers to "actuating stem portions" and "the second face section" as if these features had been referred to previously, which they have not. This renders this statement obscure and not reliable. My interpretation of these further features is that they are supplemental rather than indicative of independent inventions.

Further passages pointed out were page 5 lines 10-12 and the disclosure relating to Figure 7 from page 8 line 31. He pointed out that Figure 7 was not present in the priority document, and that references to Figure 7 had been added as it were as an afterthought. Since this is the figure which discloses the features of the original claim 1, this is a crucial observation.

On page 5, it is thus stated that "a preferred exemplary embodiment will now be described in detail with reference to Figures 2-5". It could be argued that this strongly indicates that the invention is contained within these drawings, and that this means that the claims as filed do not reflect the true invention. In one sense this reference is in conflict with claim 1. However, for clarification one may turn to the list of figures, in which Figure 4 is described as "section IV-IV of Figure 3 with certain parts, later shown in Fig. 7, omitted for clarity" and Figure 5 is described in similar terms. The conflict then appears resolved; Figures 2-5 are consistent with the invention claimed, but simply do not show its features.

In a similar vein, I was directed to the description relating to Figure 7, which begins "an important feature of the invention is shown in Figure 7". I am asked to consider that this

means no more than it says, ie that the features shown in Figure 7 are important, but not essential. I cannot accept this. The combination of a reference to an important feature with the inclusion of that feature in the main claim adds up, in my opinion to a strong pointer to the invention.

6. The abstract points to the invention being that now claimed, not that originally claimed.

Mr Parry directed my attention to the Manual of Patent Practice, paragraph 76.08, which states: "in order to determine the original teaching of an application, the whole of the description, any drawings and any claims and/or abstract which was or were present on the filing date may be considered." Later in the same paragraph the Manual states: "in considering the content of the abstract, it should be borne in mind that an abstract forming part of a patent application is required to be a concise summary of the matter contained in the specification, and is severely restricted in length. The absence of a feature from the abstract does not therefore mean that it is unessential to the invention. Claim broadening relying on the abstract for its basis is hence not normally allowed."

The abstract published with the PCT application from which the GB application is derived includes the following statement: "The invention eliminates the use of a so-called parallel flange used by the manufacturers of pressure transmitters to accommodate the difference in the centres of connecting parts of the instrument from that previously used by the industry. The device is also provided with an arrangement which facilitates the venting of entrapped air."

While this statement, in common with other references discussed above, is not clearly consistent with the invention as originally claimed, it does not point to the invention now sought to be claimed in any clearer terms. A discrepancy undoubtedly exists, but in my view it is one which suggests that the abstract is incorrect rather than the claim.

My feelings are, I believe, supported by consideration of the priority document, from which the invention originally claimed in the GB application was absent. A comparison of the GB application and the priority document reveals that there was an apparent change of heart as to the nature of the invention. In the priority document, the claims relate to features more closely related to, but not identical to, those of the new claims. The specification is therefore drafted with this in mind. In filing the later application, the applicant is assumed to have abandoned the inventive concept of the priority document in favour of that set out in the claims originally filed with the PCT application and the GB application derived from it. In so doing, some inconsistencies remained, but it is these inconsistencies which need to be sorted out, rather than relying upon them as an indication that the invention was not that originally claimed.

7. The decision and considerations in Southco v Dzus are founded on a specification disclosing a single invention which was broadened rather than one which disclosed more than one invention as is the case in the present instance.

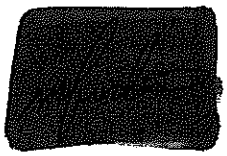
I am not satisfied that the specification as filed indicated more than one invention for the reasons set out above. Thus I do not see any distinction from the issues discussed in Southco v Dzus.

I am not persuaded by Mr Parry's arguments. The application as filed, for all its inconsistencies, set out an inventive concept. The amended version seeks to replace that inventive concept with one which could not be inferred from the specification as filed, and that, applying the teachings of patent practice, constitutes the addition of matter contrary to Section 76(2) of the Patents Act 1977.

I therefore refuse the amendment to the application. The application must therefore be restored to satisfy the requirements of Section 76(2). The period prescribed by Section 20 for placing the application in order for grant expires on 2 September 1997. However, under the provisions of Section 20(2), that period is extended until the period within which an appeal to

this decision may be brought. This being a substantive issue, that period is 6 weeks from the date of issue of this decision.

Signed this 29th day of August 1997



M G WILSON

Principal Examiner, acting for the Comptroller

THE PATENT OFFICE