

PATENTS ACT 1977

BLO/013/96

IN THE MATTER OF
an application under Section 27
by Howard Samuel Northwood
to amend Patent No 2229114
in the name of David Singer Design Ltd

DECISION

The patent in suit, no 2229114, relates to a method of decorating glass (and other transparent or substantially transparent material) which in brief comprises applying paint and water to the surface of the glass such that they interact to create a particular distribution of paint and allowing the water to evaporate and the paint to dry so as to leave a pattern of paint on the glass surface.

The patent was applied for by and granted jointly to Mr H S Northwood and Mr R C R Mann on 29 April 1992. Ownership and inventorship of the subject matter of the patent were disputed by Mr Northwood during the progress of the patent application and as a result of proceedings under sections 13 and 37 of the Patents Act 1977 ("the Act"), a Patent Office decision issued on 2 August 1994 directing that Mr Northwood be recorded as the sole inventor and transferring ownership to David Singer Design Ltd, of which Mr Northwood was a partner or owner at the time when the invention was developed.

During the course of those entitlement and inventorship proceedings, Mr Northwood informed the Patent Office in letters of 4 March 1992 and 12 October 1992 that he regarded the specification as "sketchy in part and ... lacking in important detail", claiming that it was drafted without his permission or involvement. In the second of these letters he indicated his intention to "submit a more complete description at the appropriate time". This intention reappeared in letters to the Patent Office of 3 July 1993, 26 October 1993 and 19 August 1994. In the first of these three letters Mr Northwood stated that he was "well aware of the restricted content of the patent application ... A coach and horses could be driven through the gaps in our method of painting on glass ... It is my intention to rectify this at the appropriate time". In the second letter

he enquired whether it would be possible "at the appropriate time, to extend the scope of this patent". In the third letter he asked, "Given the exceptional circumstances [that is his lack of involvement in drafting the specification of his invention], would you give your consent to my request to re-draft this patent application, to fully protect my company's invention".

In reply to these remarks the Patent Office, in letters of 22 November 1993 and 5 September 1994, warned Mr Northwood that the provisions for amendment of a patent under section 27 were subject to the provisions of section 76 whereby no amendment could be allowed which added information to a patent or extended the scope of the protection conferred.

As part of the entitlement proceedings Mr Northwood filed on 24 November 1992, as his evidence-in-chief, a statutory declaration which disclosed among other things that, during development, the process of the patent in suit included a masking procedure which preceded the steps of the process as described and claimed in the patent. I shall for convenience refer to this procedure as "pre-masking". This evidence duly became open to public inspection in accordance with the provisions of section 118 and rule 93.

On 24 November 1994 Mr Northwood applied to the Patent Office under section 27 of the Act to amend the specification of the patent in suit to refer specifically to a sequence of steps which in substance corresponded to the "pre-masking" procedure. His accompanying letter made it clear that the amendments were sought to cure the deficiencies perceived by Mr Northwood to exist in the specification as originally drafted. The amendments sought duly became open to public inspection in the same way as the evidence to which I have referred above.

In letters of 3 February and 12 April 1995, the Patent Office advised Mr Northwood that it considered that the proposed amendments were not allowable since they did not comply with the requirements of section 76 and further that since the pre-masking procedure had previously been made available to the public in both his evidence under the entitlement proceedings and in the present proceedings under section 27, there was apparently no way in which this matter could now be protected by a fresh patent.

In further letters to the Patent Office of 20 February 1995 and 11 June 1995 Mr Northwood

expressed his frustration that the system appeared to have deprived him of full and proper protection for his invention. The Patent Office being unable to allow the amendments or to assist him further, Mr Northwood requested a hearing which was held before me on 6 October 1995. At the hearing Mr Northwood represented himself, and was accompanied by his co-director in David Singer Design Ltd, Madame Hauuy, as observer. Mr I R Bloomfield was present on behalf of the Patent Office.

At the hearing, Mr Northwood put two main arguments, which I shall summarise very briefly now but return to in more detail later. The first was that a reference to "masking" in the final paragraph of the specification as granted was in itself a sufficient basis for the amendments sought. The second was that, having been made aware of his desire to amend his patent on several occasions, the Patent Office should have at least warned him that any potentially new technical disclosure in his evidence-in-chief could prevent his obtaining patent protection for that disclosure unless he applied to have it made confidential under the provisions of rule 94.

Claim 1 of the specification as granted reads as follows:

" A method of decorating glass as hereinbefore defined comprising the steps of:

1. applying to a first surface of the substrate sequentially in any desired order one or more droplets of water or aqueous liquid and a paint medium which is immiscible with water so that the paint medium surrounds the or each droplet;
 2. applying to the interior of the or a predetermined one of the droplets at a point adjacent its periphery an aliquot of paint medium immiscible with water, and allowing or encouraging said aliquot to spread around the interior periphery of the droplet;
 3. allowing the paint medium or media to dry and the water or aqueous liquid to evaporate;
- and
4. spraying or otherwise applying over said entire first surface a layer of paint medium compatible with said paint medium or media used in steps 1 and 2."

The amendments sought before the hearing comprise principally the introduction into the process of claim 1 as granted a series of steps concerned with patterning a glass surface using a mask to define the pattern. The steps forming the process of the specification as granted then follow

as an optional procedure for providing a pattern in the background areas originally covered by the masking material. I should perhaps add that the amendments as set out in the application presented the masking steps each as separate claims and for convenience I will summarise the steps sought to be introduced as follows:

- 1) degreasing the glass surface;
- 2) applying a masking material to the surface;
- 3) applying a design on the mask;
- 4) cutting out and removing the cut-out portions of the design;
- 5) applying paint to exposed areas of glass and allowing the paint to dry;
- 6) protecting the painted design by applying a compatible paint;
- 7) removing the remaining mask.

I should add at this point that the amendments to claim 1 and to the statement of invention were different in scope, those to claim 1 being somewhat narrower, but I think that the above steps as I have summarised them cover the essentials of what was now sought to be included.

The general description and the description of the preferred embodiment are also modified to provide further detail of the masking procedure, for example that the masking material is a self adhesive plastic sheet, that the design is applied to the mask by means of tracing paper, that the design is cut out by means of a pointed blade, that the paint medium used is thinned enamel paint applied with a brush, and that various coloured paints may be used in combination. Additional passages relating to the protection of the design with a glass sheet or adhesive felt and to the appearance of the finished product are also proposed.

The majority of the remaining amendments are merely consequential upon those outlined above,

for example to change claim dependencies to reflect the altered nature of the main process. Other than those, there are two deletions. The first is of a passage referring to the use of articles according to the invention as "clothing or table tops and the like", the second of a passage concerning masking which I will come to later. There is also a small addition to the introduction wherein the process of the invention is said to involve painting on the glass a predetermined design or random pattern, the word "design" being added.

In submitting that the amendments did not add subject matter Mr Northwood sought to rely on a passage on page 4 of the specification as granted and which reads as follows:

"If so desired, part or parts of the substrate may be masked, at least during the early stages of the method. This enables different parts of the substrate to be decorated differently."

Having considered the proposed amendments relating to the pre-masking procedure, and having read the specification as granted, both in considerable detail, I am led to the conclusion that neither the above passage nor any other part of the granted patent provides any disclosure either explicit or implicit of the steps sought to be introduced even in their broadest conception as outlined above. It is not sufficient in my view for the skilled man merely to be pointed by the disclosure in the general direction of masking and then left to use his own skill and knowledge to achieve the result required. As the Patent Office pointed out, the well established principles are that for a process to have been disclosed there must have been clear and unmistakeable directions in the original specification for the skilled man to carry it out. At the hearing Mr Northwood admitted that a skilled man "might not be able to work out exactly what that process of masking involved" from the original disclosure.

Thus, I find that the proposed amendments relating to the pre-masking procedure would result in the specification disclosing additional matter, contrary to section 76(3)(a), and are therefore not allowable. The only amendments sought which do not relate to the pre-masking procedure are the two deletions and the addition of the word "design" in the introduction, all of which I noted earlier. I do not find these three amendments objectionable under section 76.

At the hearing Mr Northwood put forward, should I not allow the amendments as originally

proposed, an alternative and much simplified form of amendment based on the incorporation of a passage from page 2 of his above-mentioned evidence-in-chief. The passage reads as follows:

"We moved on from simple geometric and similar patterns which required only masking with adhesive strip to more ambitious designs where the whole area of the glass was covered by self-adhesive plastic roll.

The design was then traced upon the plastic cover and then cut out with a sharp pointed blade and removed piece by piece allowing the paint applied to the glass surface contained within its plastics wall to dry".

While I have also given this proposal careful consideration, I believe it fails for the same reason that I have given in connection with the original proposals, namely that it would add subject matter contrary to section 76. I must therefore reject it.

Turning now to Mr Northwood's submission that the system had operated unfairly to cause prejudicial disclosure of his pre-masking procedure and so deprive him of full and proper protection for his invention, I must say that I have some sympathy with his feelings. The patent system is very complex and full of pitfalls for the unwary and particularly those attempting to proceed without professional help. In this context I should record here that at the time of the filing of the crucial evidence in the section 37 proceedings, that is 24 November 1992, Mr Northwood was dealing through a solicitor who had completed and filed (on 9 July 1992) the relevant form of authorisation to act on his behalf. Mr Northwood assured me at the hearing that the solicitor was acting primarily as an address for service, and this appears to be borne out by the papers since at this time the Patent Office was receiving authoritative correspondence direct from Mr Northwood as well as various papers from his solicitor.

Mr Northwood admitted at the hearing that the fact that a solicitor was involved had caused some confusion in his dealings with staff at the Patent Office who, quite rightly, were cautious of any direct dealings with a patentee once an "agent" had been nominated. Whatever the precise arrangements regarding the solicitor at the relevant date, I think it is fair to say that the fact that a solicitor was involved would inevitably have had some influence on the degree to which the

Patent Office felt it necessary to advise Mr Northwood of every possible pitfall in the process of prosecuting his entitlement case. This is not to say that the Patent Office staff were less than helpful in this regard, and indeed at the hearing Mr Northwood went out of his way to assure me to the contrary; I merely to record that there were grounds for the Office to assume that Mr Northwood had ready access to professional advice.

I should now look more closely at the way in which the Patent Office dealt with the apparently crucial piece of evidence filed in the course of the section 37 proceedings. At the hearing, Mr Northwood directed my attention to a series of letters from the Patent Office, dated 12 October 1992, 3 July 1993, 14 October 1993 and 25 January 1994, which set out the intention of the Office to withhold from public inspection, in accordance with the provisions of rule 93(5)(a)(i), certain passages of documents which he had filed because those passages were considered to contain disparaging matter. I believe I understand Mr Northwood correctly in saying that he was contending that these letters showed that there were provisions in the patent system for confidentiality and that the Patent Office scrutinised evidence and correspondence to search for matter which should be withheld from public view. If this was so, he submitted, then the Office should at least have warned him, before his evidence became open to public inspection, that by disclosing technical matter in it he would be prevented from subsequently obtaining patent protection for that matter. He stated at the hearing that he was not aware at the time of filing the evidence that it could later prejudice his rights in this regard.

Mr Northwood's further but related point was that in letters to the Patent Office, to which I have referred above, he had indicated his intention to seek patent protection for the missing matter and this should have alerted the Patent Office to the presence of such matter in his evidence so that an appropriate warning could have issued before that matter became open to public inspection.

In considering these submissions I note that Mr Northwood made no request for confidentiality for the matter in question when he first filed the evidence on 24 November 1992. The letter accompanying his evidence did, however, contain a request that two photographic exhibits forming part of that evidence be kept confidential for commercial reasons. To my mind this indicates two things. The first is that Mr Northwood was aware that evidential matter could be withheld from public inspection, or at least was determined to ask that it should be. The second

is that despite that awareness or determination, he did not at that time seek any confidential treatment for the bulk of his evidence, and in particular the matter now in question.

I also note that the terms of the only one of Mr Northwood's letters which were filed at the relevant time, that is that dated 12 October 1992 and filed with his evidence on 24 November 1992, and from which I have quoted above, implied that he was merely considering getting protection for some undisclosed further subject matter and gave no clear indication that the matter to which he was referring was that in the accompanying evidence.

I should add here that there had previously been, as a preliminary to the launch of the section 37 proceedings, some correspondence between Mr Northwood and the Patent Office concerning another request of his that matter in a letter to the Office dated 23 October 1990 be kept confidential. In a reply dated 7 November 1990, the Patent Office stated:

" Please note that there is a general obligation on the office to lay open to the public all correspondence on a published application. The office does have powers to direct that certain correspondence or documents be kept confidential but this is having been provided with specific reasons."

This warning was restated in a subsequent letter from the Patent Office on the same matter and dated 24 December 1990. A fuller account of all the provisions concerning public inspection of documents and those for confidentiality was given to Mr Northwood in the Office letter of 9 December 1992.

There was some further correspondence that is pertinent to the issue of the Patent Office advice given to Mr Northwood and to which I shall refer briefly at this point. The first item was a letter from the Patent Office of 22 November 1993 in reply to Mr Northwood's letter of 26 October 1993 foreshadowing the present application for amendment and to which I have already referred. It states:

"... it is also pointed out that the Comptroller's exercise of his discretion to allow amendment will be subject to the provisions of section 76 (also enclosed). Thus it will not be possible to amend

the patent to extend its scope."

This warning was restated in a subsequent letter from the Patent Office of 5 September 1994 when it was added that "... no amendment will be allowed if it results in the patent disclosing additional information..."

Finally, there was a letter from Mr Northwood of 10 September 1994, which I note is subsequent to all these warnings about correspondence being made public, in which Mr Northwood again appears to disclose the substance of the pre-masking procedure without any request for confidentiality.

It seems to me from all this correspondence spread over a considerable period of time that the Patent Office gave proper warnings regarding confidentiality and the effect of section 76 on the allowability of any amendments that might be sought. It would be very difficult for me to conclude that the Patent Office had acted improperly or without due care in this regard. The remaining point is whether such warnings were enough. Although the Patent Office scrutinises documents to identify matter which might be considered disparaging of any person, it would be unreasonable in my view to expect the Office also routinely to look out for and identify subject matter which might potentially form the basis for patent protection. Such a circumstance is, in my view, sufficiently catered for by the warnings which all private applicants receive and which were addressed to Mr Northwood on a number of occasions before the relevant time.

It might be said that in the present case Mr Northwood's allusions to further protection should have alerted the Office to the presence of the matter in question in his evidence. However, to my mind the terms of the relevant ones of his letters which I have quoted above tend to point away from this possibility. Mr Northwood appeared by virtue of his request for confidentiality of the two photographic exhibits to be clearly aware of the confidentiality provisions and that his evidence would become open to public inspection. In this light I believe it would be unreasonable for the Office to be expected to suspect that he was at the same time unaware that this public disclosure would prevent patent protection for matter described in his evidence, and all the more so given the fact that at the time in question the Office had every reason to believe that Mr Northwood had access to professional advice. In the result, I conclude that while the

consequence from Mr Northwood's point of view is very unfortunate, it is the operation of the law which now prevents Mr Northwood from seeking fresh patent protection for the matter he has publicly disclosed, and that the Office's warnings and advice in all the circumstances of the case were fair and reasonable.

I have examined the evidence filed during the section 37 proceedings and the disclosures made in the abovementioned letter of 10 September 1994 and concluded that both these documents do indeed publicly disclose the substance of the matter for which Mr Northwood would now wish to seek patent protection. Furthermore, that matter has also been made public in the course of the present proceedings. There is therefore no doubt in my mind that the matter in question is now in the public domain and precluded from patent protection by virtue of the provisions of sections 1(1)(a) and 2(2), which require that a patent may not be granted for matter which has already been made available to the public. Regrettably, I can therefore see no way in which Mr Northwood can be helped out of his difficulty so as to obtain patent protection for that matter.

At the hearing I asked Mr Northwood whether, if I found, as I now have done, against the allowability of the proposed amendments relating to the pre-masking procedure, he wished to pursue the proposed deletions. He indicated that he did not, and I believe I understand him correctly when I take this to include the addition of the word "design" as noted above. Accordingly, I refuse the application for amendment in its entirety.

This being a technical matter, the period within which an appeal can be lodged against my findings is six weeks from the date of this decision.

Dated this 21 day of December 1995



S N DENNEHEY

Principal Examiner, acting for the Comptroller

THE PATENT OFFICE