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Pat / Linda  
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**PATENTS ACT 1977**

IN THE MATTER OF patent  
No. 2101984 in the name of  
Marley (UK) Limited.

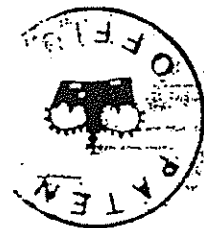
**FINAL DECISION**

Following a hearing which took place on 22 May 1996, I issued an interim decision on 17 July 1996 refusing to allow amendments to UK patent No. 2101984 ("the UK patent") which had been proposed under Section 73(2) with a view to removing conflict with European Patent (UK) No. 0069586. In that decision I allowed the proprietors an opportunity to propose further amendments, but indicated that if no such further amendments were proposed within a period of one month, I should order the revocation of the UK patent.

No further amendments have been submitted. Accordingly, I now order the revocation of the UK patent.

Dated this 10 day of September 1996

A C HOWARD  
Principal Examiner, acting for the Comptroller



**THE PATENT OFFICE**

01/10/96

Pat / Linda  
3Y60

**PATENTS ACT 1977**

IN THE MATTER OF an application  
under Section 73(2) by Marley (UK)  
Limited to amend patent No. 2101984 in  
the name of Marley (UK) Limited.

**INTERIM DECISION**

The question before me relates to an application to amend UK Patent No 2101984 in order to avoid revocation under Section 73(2) of the Patents Act.

UK patent No 2101984 (hereafter "the patent"), which relates to polymer-modified cement mortars, was applied for on 6 July 1982 and was granted on 24 July 1985 to The Marley Roof Tile Company Limited (United Kingdom), now known as Marley (UK) Limited (hereafter "Marley").

The application as filed originally contained *inter alia* the following claims:-

1. A process for the production of mortars and concretes which comprises curing a composition which contains hydraulic cement and an aqueous dispersion of a polymer or copolymer of a methacrylic or acrylic acid ester by means of a two stage curing process, the first stage being carried out at an elevated temperature under conditions of high humidity whereby hydration of the cement is effected, and the second stage being carried out under drying conditions whereby curing of the polymer or copolymer is effected, the said polymer or copolymer dispersion having a viscosity of less than 1,500 cps when measured by means of a Brookfield LVT viscometer using spindle 2, 12 rpm at a temperature of 23°C, and a minimum film-forming temperature (MFT) of not lower than 5°C.

11. Articles made of mortars and concretes modified by means of polymer or copolymer dispersions as defined in claim 1 and having Modulus of Rupture (MOR) values in excess of  $22.5 \text{ MNm}^{-2}$ .

13. Articles made of mortars and concretes containing cenospheres as lightweight aggregate, having a dry density not greater than half that of cement mortar made using a conventional mix with a ratio of sand to cement of 3.5:1, being modified by means of polymer or copolymer dispersions as defined in claim 1.

18. Means for carrying out a process according to claim 1 comprising (i) an aqueous dispersion of a polymer or copolymer of a methacrylic or acrylic acid ester having a viscosity of less than 1500cps when measured with a Brookfield LVT viscometer using Spindle 2, 12 rpm at a temperature of  $23^{\circ}\text{C}$ , and a minimum film forming temperature of not lower than  $5^{\circ}\text{C}$ , and (ii) an antifoaming agent incorporated therein.

In the course of the prosecution of the application, amendments were made in response to an objection under Section 14(5)(d) that the claims did not relate to one invention. The granted patent comprises the following claims:

1. A process for the production of mortars and concretes which comprises curing a composition which contains hydraulic cement and an aqueous dispersion of a polymer or copolymer of a methacrylic or acrylic acid ester by means of a two stage curing process, the first stage being carried out at an elevated temperature under conditions of high humidity whereby hydration of the cement is effected, and the second stage being carried out under drying conditions whereby curing of the polymer or copolymer is effected, the said polymer or copolymer dispersion having a viscosity of less than 1,500 cps when measured by means of a Brookfield EVT viscometer using spindle 2, 12 rpm at a temperature of  $23^{\circ}\text{C}$ , and a minimum film-forming temperature (MFT) of not lower than  $5^{\circ}\text{C}$ .

2. A process according to claim 1 in which the polymer or copolymer dispersion is stable at

alkaline pHs of at least 8 and above.

3. A process according to claim 2 in which the polymer or copolymer dispersion has a pH of above 8.
4. A process according to any one of the preceding claims in which the aqueous dispersion contains a copolymer of (i) an alkyl methacrylate or acrylate in which the alkyl groups have from 1 to 8 carbon atoms and (ii) acrylic acid.
5. A process according to any one of the preceding claims in which the said composition contains as aggregate sand having a porosity of less than 1.5% (when measured according to British Standard 812:1967) and/or cenospheres.
6. A process according to any one of the preceding claims in which the first stage of the curing process is effected at a temperature of at least 35°C and a relative humidity of at least 75%.
7. A process according to any one of the preceding claims in which the second stage of the curing process is effected at an elevated temperature.
8. A process according to any one of claims 1 to 7 wherein the said polymer or copolymer is present in the composition at from 10 to 40% by weight, based on the weight of cement in the composition.
9. A process according to any one of the preceding claims in which the second stage of the curing process is effected at a relative humidity of not greater than 50%.
10. A process for the production of mortars and concretes substantially as herein described in any one of the Examples.
11. Articles made of mortars and concretes modified as defined in claim 1 by means of

polymer or copolymer dispersions and having Modulus of Rupture (MOR) values in excess of 22.5 MNm<sup>-2</sup>.

12. Articles according to claim 11 having MOR values in excess of 25 MNm<sup>-2</sup>.

13. Articles made of mortars and concretes containing cenospheres as lightweight aggregate, having a dry density not greater than half that of cement mortar made using a conventional mix with a ratio of sand to cement of 3.5:1, being modified as defined in claim 1 by means of polymer or copolymer dispersions.

14. Articles according to claim 13 having MOR values of at least 12 MNm<sup>-2</sup>.

15. Articles according to any one of claims 11 to 14 having a thickness in section of not greater than 50 mm.

16. Articles according to claim 15 in which the thickness in section is not greater than 25 mm.

17. Articles according to any one of claims 11 to 15 in the form of roof tiles and shingles.

In accordance with Section 73(2), proceedings were opened for revocation of the patent with an official letter dated 23 February 1989 informing the proprietor that the examiner considered the invention claimed in claim 1 of the patent to be the same as that claimed in claim 1 of European patent (UK) No 0069586 ("the EP patent") having the same priority date.

The EP patent includes *inter alia* the following claims:

1. A process for the production of mortars and concretes which comprises curing a composition which contains hydraulic cement and an aqueous dispersion of a polymer by means of a two stage curing process, the first stage being carried out under conditions of

high humidity and the second stage being carried out at an elevated temperature under drying conditions whereby curing of the polymer is effected, characterized in that said aqueous dispersion of a polymer comprises an aqueous dispersion of a polymer or copolymer of a methacrylic or acrylic acid ester, said polymer or copolymer being present in an amount of from 10 to 40% based upon the weight of cement in the composition and said polymer or copolymer dispersion having a viscosity of less than 1.5 Pa.s when measured by means of a Brookfield LVT viscometer using spindle 2, 12 rpm at a temperature of 23°C, and a minimum film-forming temperature (MFT) of not lower than 5°C, and in that said first stage is carried out at an elevated temperature whereby hydration of the cement is effected.

8. Articles made of mortars and concretes produced by a process as defined in claim 1 by means of polymer or copolymer dispersions, having thicknesses in section of not greater than 25 mm, and having Modulus of Rupture (MOR) values in excess of 22.5 MNm<sup>-2</sup>.

10. Articles made of mortars and concretes containing cenospheres as lightweight aggregate, having a dry density not greater than half that of cement mortar made using a conventional mix with a ratio of sand to cement of 3.5:1, being produced by a process as defined in claim 1 by means of polymer or copolymer dispersions, having MOR values of at least 12 MNm<sup>-2</sup>, and having a thickness in section of not greater than 25 mm.

In the course of the Section 73 proceedings, the patentees offered through their agent's letter dated 23 May 1989 to delete all the process claims (1-10) of the patent and amend claims 11 to 17 to become claims 1 to 7. Consequential amendments to the consistory clauses were also offered.

The proposed amendments, if effected, would have resulted in independent claims 1 and 3 as follows:

1. Articles made of mortars and concretes modified by means of an aqueous dispersion of a polymer or copolymer of a methacrylic or acrylic acid ester, the said polymer or copolymer

dispersion having a viscosity of less than 1,500 cps when measured by means of a Brookfield LVT viscometer using spindle 2, 12 rpm at a temperature of 23°C, and a minimum film-forming temperature (MFT) of not lower than 5°C, said articles having Modulus of Rupture (MOR) values in excess of 22.5 MNm<sup>-2</sup>.

3. Articles made of mortars and concretes containing cenospheres as lightweight aggregate, having a dry density not greater than half that of cement mortar made using a conventional mix with a ratio of sand to cement of 3.5:1, being modified by means of an aqueous dispersion of a polymer or copolymer of a methacrylic or acrylic acid ester, the said polymer or copolymer dispersion having a viscosity of less than 1,500 cps when measured by means of a Brookfield LVT viscometer using spindle 2, 12 rpm at a temperature of 23°C, and a minimum film-forming temperature (MFT) of not lower than 5°C.

In response the Examiner maintained the objection under Section 73(2), and also objected to the proposed amendments on the grounds that contrary to Section 76 they disclosed and claimed matter extending beyond that disclosed in the granted patent. In the course of subsequent correspondence, the examiner waived the objection under Section 76 but pressed the objection under Section 73.

The matter then proceeded to a hearing before the Principal Examiner acting for the Comptroller (Mr P L Egginton) on 10 July 1991. The Principal Examiner found against Marley under Section 73 but allowed them an opportunity to file further amendments to avoid revocation. In the course of his decision he stated:

"I should perhaps mention that the examiner did raise an objection that the claims as amended disclosed and claimed matter extending beyond that claimed in the granted patent contrary to Section 76(3) but later withdrew that objection, rightly so in my opinion."

After the hearing but before the decision was issued the patentees filed, on 16 July 1991, a new page 3 containing further proposed amendments. This was directed at changing the

passage

- "The present invention is based on the discovery that cement mortars and concretes of still further improved strength can be obtained by modification with certain polyacrylate polymers and copolymers and the use of a curing process in which curing is effected in two stages..."

so as to read

"The present invention is based on the discovery that novel articles made of cement mortars and concretes and having still further improved strength can be obtained by modification with certain polyacrylate polymers and copolymers. Such novel articles are obtainable by the use of a curing process in which curing is effected in two stages..."

Marley appealed to the Patents Court. In the course of these proceedings, Mr Silverleaf, Counsel for the Comptroller, sought leave to raise the matter of alleged extension of claim contrary to Section 76(3)(b) which had not been pursued by the examiner; Aldous J declined to hear Mr Silverleaf's submissions on this point but indicated that if he were to decide that the decision of the Principal Examiner was incorrect (on section 73) he would remit the case to the Office for further consideration. This he did in an Order dated 6 May 1992.

The Comptroller appealed to the Court of Appeal on the construction of Section 73(2). In its judgment dated 21 October 1993 the Court allowed the appeal and ordered that the decision of the Principal Examiner be restored. The matter was remitted to Patent Office for consideration of further proposed amendments.

On 2 December 1993 Marley proposed amendments comprising replacement pages 4, 18 and 19 being equivalent to the amendments proposed on 23 May 1989 together with two alternative forms of disclaimer which seek to remove the overlap of claim between the



patent and the EP patent. The replacement page 4 runs on from the replacement page 3 filed on 16 July 1991 and not from page 3 of the patent as granted, and I have therefore assumed that Marley also wish to have the amendments proposed on 16 July 1991 to be considered in these proceedings.

The alternative forms of disclaimer proposed read as follows:

(1) We make no claim to articles as defined in claims 8-11 of European Patent (UK) No 69586 as granted on 2 April 1986. Subject to the foregoing disclaimer, what we claim is:

(2) We make no claim to articles prepared by a process claimed in any of claims 1-7 of European Patent (UK) No 69586 as granted on 2 April 1986 nor to articles as defined in claims 8-11 of said European Patent (UK). Subject to the foregoing disclaimer, what we claim is:

On reconsidering the proposed amendments subject to the proposed disclaimers and in the light of the judgment of the Court of Appeal, the examiner came to the view that the amendments would extend the scope of the patent as granted, contrary to Section 76(3). The basis of this view was that he construed the phrase "modified as defined in claim 1" in claims 11 and 13 of the patent as restricting claims 11 and 13 to articles produced by the process claimed in claim 1. In partial support of this view, he referred to the amendments made in the course of pre-grant proceedings in relation to the application on which the patent is based which were aimed at avoiding an objection of plurality of invention under section 14(5)(d), and also to an amendment made to the EP patent while still pending in the course of proceedings before the EPO. The examiner also objected that if either form of disclaimer were to be allowed, the remaining claims would not be supported by the description.

In support of the proposed amendments, Marley relied on expert evidence as to the proper construction of the term "modified as defined in claim 1", which they submitted would be

understood by the person of ordinary skill as referring only to the polymer modification of the composition and would not include the two stage curing process given in claim 1. In addition, they disputed the relevance of the pre-grant amendments or of proceedings before other patent offices to the determination of the matter at issue.

The matter came before me at a hearing on 22 May 1996, at which Mr Henry Carr, instructed by Messrs Frank B Dehn & Co, appeared for Marley.

Section 73(2) provides:

73.-(2) If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent.

Possible amendments under Section 73 are restricted by Section 76(3) which provides:

76.-(3) No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it -

- (a) results in the specification disclosing additional matter, or
- (b) extends the protection conferred by the patent.

The extent of protection conferred by the patent is defined in Section 125(1) which provides:

125.-(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

The only matter at issue is whether the amendments offered are allowable under the relevant provisions of the Act. It is not in dispute that should the amendments be allowable, the patent thus amended would no longer fall foul of Section 73(2).

It is convenient to deal first with the question of the prosecution history. Mr Carr submitted to me that the prosecution history is irrelevant in this case in which the key issue is the scope of the claims of the granted patent. I was referred to *Glaverbel SA v British Coal Corp (No. 2)* [1993] RPC 90, *Southco Inc v Dzus Fastener Europe Ltd* [1992] RPC 299 and *Kastner v Rizla Ltd* [1995] RPC 585.

The principles to be applied in construing the claims of a patent were set out by Mummery J in *Glaverbel*. These are (as summarised in the headnote):

(1) The question on construction was how the language of the specification would have been understood at the time of publication (or possibly at the time of filing) by those to whom it was addressed. The meaning of the specification must be ascertained from the particular language in which it was expressed, as seen in its objective factual setting.

(2) In aid of construction, extrinsic evidence of relevant circumstances surrounding the preparation of the specification was admissible. For example, evidence could be given of the state of the art at the time of the specification among those to whom its teaching was addressed, and to explain the meaning at that time of scientific and

technical terms, words and phrases used in the specification and in the relevant art.

(3) A relevant expert was entitled to give evidence of what the specification would have taught him and whether workers skilled in the art could have carried the description into effect.

(4) The following was inadmissible, either to enlarge or to restrict the ordinary meaning of the language of the specification, and was not relevant for the purpose of discovery of documents:

(a) direct evidence of the subjective intentions, thoughts and opinions of the inventor and his professional advisers and agents, including pre-existing documentary evidence of those intentions and opinions as might be found in correspondence passing between his patent agent and the Patent Office or in documents relating to applications for corresponding foreign patents;

(b) evidence of subsequent conduct to show how the specification was in fact acted upon and understood, although such evidence might in certain circumstances be used to raise an estoppel;

(c) the opinion of expert witnesses on the construction of the specification and the ambit of the claims made in it.

(5) The plaintiff's United States patent and documents relating to the application for it were not admissible to construe the specification of the patent in suit. Cross examination of the inventor or other employees or agents of the plaintiff about the United States patent and the steps taken to apply for it would not be relevant or admissible on construction.

(6) In so far as witness statements served by each side contained expressions of opinion by experts about the construction of the specification of the patent in suit,

that evidence was not admissible on construction.

In applying these principles to construe the claims of the present patent as granted, the possibility cannot be excluded that evidence of the meaning to the skilled addressee of a particular word or expression used in a claim might be adduced in the course of prosecuting an application. However, there is no suggestion that such is the case here. At best, what was said in the prosecution of the application can only amount to evidence of the intention of the applicant or his advisors at that time. I have therefore disregarded the pre-grant prosecution history of this patent and the EP patent in coming to my decision.

Turning now to the main point at issue, the key lies in the construction of the of the expressions

"Articles made of mortars and concretes modified as defined in claim 1 by means of polymer or copolymer dispersions" in claim 11; and

"Articles made of mortars and concretes containing cenospheres as lightweight aggregate, ... , being modified as defined in claim 1 by means of polymer or copolymer dispersions" in claim 13.

If these passages are construed as limiting the scope of the claims in question to articles made by the process of claim 1, then the articles must be subjected to the two stage curing process defined in claim 1 and the proposed amendment is not permissible because it includes no such limitation. However, if the expression "modified as defined in claim 1" is construed as relating only to the compositional element of the claim, then the proposed amendment does not extend the scope of the protection conferred and is allowable under Section 76(3).

Mr Carr referred me to expert evidence as to the meaning of the term "polymer-modified". This was in the form of an affidavit by Professor Swamy from Sheffield University. Exhibited to this affidavit were a number of papers on the subject of cements having

improved properties containing polymeric species. I am satisfied from this evidence that the expression "polymer-modified" is, and was at the priority date of the UK patent, a term of the art which when used in relation to cement compositions indicates that the compositions in question contain polymeric species. However, to quote from page 3 of the Affidavit of Professor Swamy:

"I therefore understand the term 'polymer-modified' when used in connection with cements and concretes to mean containing a polymer or copolymer species and subjected to at least a simple drying process to ensure film formation".

Thus, polymer-modification necessarily includes a curing step, although the expression in its general sense carries no implication as to the precise nature of the curing process.

Mr Carr argued that the use of the expression "using polyacrylates as hereinafter defined for the purpose of modification" on page 3 of the patent at lines 20-21 should be compared to the passage which is effectively the consistory clause for claim 11 on page 4 which states "according to a further feature of the present invention, there are provided moulded articles made of mortars and concretes modified as hereinbefore defined by means of polymer or copolymer dispersions...". Mr Carr submitted that the things which are "hereinbefore" and hereinafter" defined are the same, namely the particular attributes of the polymers or copolymers.

I agree that the expression "polyacrylates as hereinafter defined" does refer to the compositions referred to in the following consistory clause (and thereby in claim 1). The polymers and copolymers defined in claim 1 are a subset of the class of compounds known as polyacrylates, and this is a perfectly normal and reasonable interpretation of this construction. However, the passage on page 4 does not have the same construction. This refers to "articles made of mortars and concretes modified as hereinbefore defined". What is being defined here is the modification of the mortars or concretes (or possibly of the articles made of mortars and concretes, which comes down to the same thing). Since "modified" can be understood as incorporating a curing step, it would be logical to

interpret this as referring back to the whole of the consistory clause relating to claim 1. I do not agree that it would be logical to conclude that it is the attributes of the polymer or copolymer which are being defined at this point, since the reference to polymer or copolymer dispersions only comes later in the sentence. This is of course simply to restate the main point at issue, and I therefore do not find this particular passage of assistance one way or the other in resolving the question.

Mr Carr also referred me to the judgment of Balcombe J in this case before the Court of Appeal, reported at [1994] RPC 231 pages 238-239 which reads as follows:

"Before the judge Marley adduced evidence to the effect that it was possible to produce concrete articles with the particular composition and properties claimed in claim 1 of the UK patent without using the precise process required by claim 1 of the European patent. The Comptroller-General of Patents ... adduced no evidence to the contrary; the judge held that the conclusion of the Principal Examiner as to fact could not be supported and that it was not implicit that, when making a concrete article as claimed in claim 1 of the UK patent, the process of claim 1 of the European patent must be used. Against that part of the judgment there is no appeal."

However, this conclusion of the Principal Examiner was in relation to the patent as proposed to be amended. As I have said, it is not in dispute that the product *per se* claims of the patent as proposed to be amended extend beyond the main process claims of the granted patent (which are broadly equivalent to those of the European patent). As regards the fact that Dr Lynn (the inventor) recognised that it was possible to produce concrete articles with the particular composition and properties claimed in claim 1 of the UK patent without using the precise process required by claim 1 of the European patent, I do not find this particularly helpful in determining what the granted patent would have taught the skilled man.

It was put to me that the skilled man would not understand or infer from the granted patent

that products containing the defined polymers can only be produced by the two stage process. This is clearly true; it is acknowledged on page 2 of the specification itself that it is known to modify cement mortars by the use of polyacrylate ester emulsions. These fall within the scope of the polymer compositions defined in claim 1. At least one of the proprietary emulsions mentioned as having been used in the prior art is also used in the composition according to the invention. However, these prior art mortars are stated to have inferior Modulus of Rupture (MOR) values. I can find no suggestion at this point in the patent that drying or curing regimes other than those falling within the scope of claim 1 could give the desired improved strength. I note in this context the passage at lines 2-7 of page 3 of the patent, which states

"The present invention is based on the discovery that cement mortars and concretes of still further improved strength can be obtained by modification with certain polyacrylate polymers and copolymers and the use of a curing process in which curing is effected in two stages...".

This passage is of course the subject of the amendment proposed on 16 July 1991, which, if allowed, would make clear that the mortars and concretes of the invention do not need to be made by the use of a two stage curing process.

Mr Carr placed great importance on the use at this point of the word "and" in the phrase "and the use of a curing process". He sought to rely on this to demonstrate that the discovery is twofold, and that the "still further improved strength" would be understood by the skilled man as being attainable without recourse to the curing process. In support of this proposition, he argued that the word "modification" does not refer to the two-stage curing process because it goes on to use the word "and" as an additional factor. However, I have some difficulty with this reasoning. While I have no problem with accepting that there are two elements to the invention, namely (1) the use of the defined polymer compositions and (2) the two-stage curing process, the teaching of page 2 of the patent is that the first element on its own is conventional and cannot achieve MOR values to the required levels. The natural conclusion from this is that both elements are essential to the



invention.

I note that in paragraph 5 of Professor Swami's affidavit there is an implication that the example given on page 13 of the patent is outside the scope of claim 1, in that he refers to a "one stage cure and maturation process". A similar point is made in Dr Lynn's evidence. However, to quote from lines 4-7 of page 13 of the patent:

"In particularly dry climates such as for example that of California, USA, it may be possible to carry out the second stage of the process at ambient temperature and humidity."

There is nothing in claim 1 to exclude the possibility that the second stage of the curing process may be carried out at ambient temperature and humidity. This example is therefore fully consistent with claim 1.

Moreover, at lines 16-21 of page 13 it is stated:

"It will be understood that there are other methods which may be used for carrying out the two stage curing process in accordance with the invention. For example a vacuum oven, microwave oven or radio frequency drier may conveniently be used to accelerate the second stage of the curing process under drying conditions."

The clear message of these passages is that methods other than those described in the specific examples of the patent may be used in the curing process but all have to comprise at least the two stages defined in claim 1.

It is against the above background that the skilled man would read the claims. While "polymer modified" is a technical term for certain types of cements and mortars in the general sense, all cements and mortars have to undergo some kind of curing step and the use in the patent of the expression "modified as defined ..." is therefore not inconsistent with the notion that a particular curing process is essential to the invention. Accordingly, I

can see no justification for the proposition that the skilled man would in the present context construe this expression so as to exclude the curing process, given that the whole thrust of the teaching of the patent is that the curing process defined in claim 1 goes hand in hand with the composition defined in claim 1 to give the desired result.

I therefore find that the proper construction to be placed on the words "modified as defined in claim 1" in claims 11 and 13 of the patent is to include both the compositional and process elements of claim 1. Consequently I find that the proposed amendments to the claims would extend the protection conferred by the patent contrary to Section 76(3)(b), and that the proposed amendments to page 3 would result in the specification disclosing additional matter contrary to Section 76(3)(a). For these reasons I refuse to allow the patent to be amended.

In the event that my finding under Section 76(3) is appealed and I am found to be wrong, it would be expedient to deal at this point with two further questions.

The first concerns the question of support for the proposed claims by the description. The examiner made an objection that if either of the proposed forms of disclaimer were to be allowed, the remaining claims would not be supported by the description. Mr Carr took this to be an objection based on Section 14(5), the relevant provision of which states

14.-(5) The claim or claims shall -

...

(c) be supported by the description;

...

The basis of Mr Carr's submission was that this ground of objection is only available pre-grant and is not available as a ground of resisting an amendment offered under Section 73(2). In particular, he argued that Section 76(3) is a complete code of grounds of objection to amendment of a granted patent. In the alternative that this ground is held to be available, Mr Carr submitted that the patent so amended would be supported by the

description; in this he relied on the same submissions as he had put in relation to the section 76 objection.

I was not referred to any authorities on this point.

I find Mr Carr's submission on the alternative formulation persuasive. Although the net effect of the proposed amendments would be to result in a rather bizarre "shell-like" scope of protection which extended as it were all round the outside of the main substance of the disclosure but excluded the described embodiments, if the proposed amendments to the claims and description are held not to extend the scope of the patent or to disclose additional matter, I see no further possibility for objection that the thus amended claims would not be supported by the description.

I therefore find that the proposed claims would be supported by the description in the event that they and the proposed amendments to the description are found to be allowable under Section 76. In view of this finding, it is not necessary for me to address the point about whether this objection is available in proceedings under Section 73.

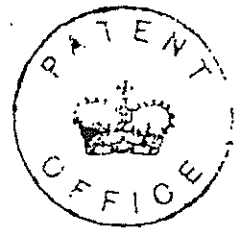
The second of the further questions for me to deal with is the form of the disclaimer. Two alternatives were originally offered. Both disclaim articles as defined in claims 8-11 of the EP patent, but only the second alternative disclaims articles prepared by any process claimed in the EP patent. Mr Carr suggested to me that if the amendments were to be allowed, this should be on the basis of the second alternative, which makes it clearer that all possible overlap is disclaimed. I agree with this conclusion. Accordingly, if the proposed amendments are allowable under section 76, the amendments made should incorporate the second alternative form of disclaimer ie the version appearing on page 18a filed on 2 December 1993.

In view of my findings under Section 76, I do not believe it is likely that any form of amendment could be found to overcome the objection under Section 73. However, I am prepared to allow Marley the opportunity to propose further amendments and any such

proposed amendments should be filed within a period of one month of this decision.  
Failing that, I shall order the revocation of the patent.

The period for appeal is six weeks from the date of this decision.

Dated this 7 day of July 1996



A C HOWARD

Principal Examiner, acting for the Comptroller

**THE PATENT OFFICE**