

BLO/014185

PATENTS ACT 1977

IN THE MATTER OF an
Application No 8410872
in the name of
Canon KK and another

DECISION

The application was lodged on 28 April 1984 claiming, under the provisions of Section 15(4), the filing date of 16 September 1981 which is the filing date of Application No 8127994 (the "main application") from which it is sought to divide it. As filed, the description and claims were identical with those of the main application as they then stood. This fact was referred to in an accompanying letter which indicated that an amendment would shortly be filed directing the claims to "claims 21 to 29" of the main application in its then current form. This is, in fact, a reference to further claims which it had been sought to introduce into the main application during prosecution but which had been rejected by the examiner. When the foreshadowed amendments were filed on 2 May, they consisted of these rejected claims together with amendment to the description whereby statements corresponding to the main claims as filed were replaced by statements corresponding to the proposed new main claims. In his report of 18 June 1984 covering both preliminary and substantive examination, the examiner reported, inter alia, that these claims represented added matter contrary to Section 76 and, furthermore, that they were not supported by the description as filed contrary to Section 14(5)(c). The applicants disagreed and the matter came to a hearing before me on 16 January 1985 at which they were represented by their agents Mr K D L Beresford and Mr J C Warden, and Mr C A Clarke attended as examiner.

Mr Beresford sought first to establish the degree of certainty which, in his submission, is necessary before a decision adverse to the applicant can be reached in pre-grant proceedings of the kind at issue. He suggested that, since Section 72(d) and (e) of the 1977 Act admit as grounds for revocation both the disclosure of matter beyond that disclosed in the application as filed, and the extension of protection by an amendment which should not have been allowed, it was appropriate to treat these issues at the pre-grant stage with leniency and to maintain objection only in the very clearest case.

He further suggested that the standard of certainty under the 1977 Act should be even higher than that applicable in similar circumstances under the 1949 Act since, under the earlier Act, there had been no opportunity to review the permissibility of an amendment made before grant as there now is.

In support of this view, he referred to cases decided under both Acts, viz, Eastman Kodak Company (Stimson's) Application 1968 RPC 454, International Playtex Corporation's Application 1969 RPC 362, Swift & Co's Application 1962 RPC 37, Dunlop Holding Ltd's Application 1979 RPC 523, Protomed BV's Application 1983 FSR 110, Glatt's Application 1983 RPC 122 and two recent unreported decisions, those of RTL Contactor Holdings Ltd Application and B & R Relay's Application.

I do not consider I need to deal at length with these cases and the points Mr Beresford sought to make on them. I have considered them all in reaching the conclusion that the current and established practice in proceedings of this kind in the Office whereby the applicant is given the benefit of any reasonable doubt is the correct and proper course which should, therefore, be followed in this case. I may add that I have had no difficulty in reaching my decision on this basis.

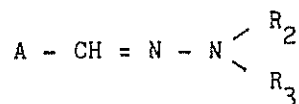
Turning now to the substantive issue, both the present application and the main application are concerned with the use of certain organic compounds as a charge transport material in electrophotographic photosensitive members which are well-known devices widely used, for example, in certain kinds of photocopiers. The points at issue are, in essence, what are the organic compounds disclosed for this purpose in the application as filed? and are the new claims and other amendment proposed in accordance with this disclosure?

The claims objected to are those at the end of the printed specification deemed to have been filed on 16 June 1984 (sic) under the provisions of Rule 36. Only claim 1 requires full consideration and it reads:

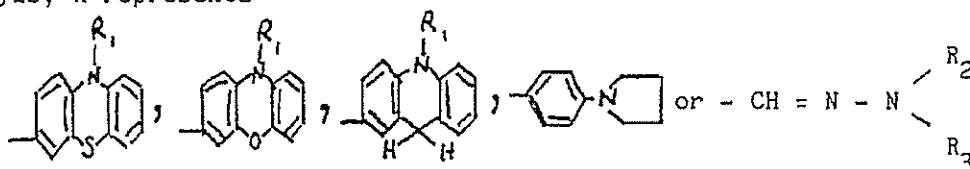
"1 An electrophotographic photosensitive member comprising a charge generation layer composed of amorphous silicon, and a charge transport layer which contains a hydrazone compound."

This claim may be compared with claim 1 of the specification as filed which is on page 17 of the printed specification and reads:

"1 An electrophotographic photosensitive member comprising a layer containing a hydrazone compound represented by the formula:



wherein R_2 and R_3 are each unsubstituted alkyl or substituted alkyl, unsubstituted aralkyl or substituted aralkyl, or unsubstituted aryl or substituted aryl, with the proviso that R_2 and R_3 are not simultaneously alkyls, A represents



wherein R_1 is $C_1 - C_5$ alkyl, unsubstituted aralkyl or aralkyl."

Thus, the claim objected to is narrower than the original claim in requiring the member to comprise a charge generation layer composed of amorphous silicon and a charge transport layer but, at the same time, is broader in being no longer restricted to the use of hydrazones satisfying the recited general formula.

I did not understand there to be any disagreement over the introduction of the narrowing features I have referred to. Indeed, they appear to be clearly disclosed in the original description in terms which make their simultaneous importation into a claim unobjectionable. However, the examiner maintains that the only hydrazones disclosed in the specification as filed for use in electrophotographic photosensitive members are those of the specified general formula so that reference to the presence of "a hydrazone compound" embraces also hydrazones not contemplated in the specification as filed and the invention it is now sought to claim goes far beyond what was originally disclosed in this respect.

Mr Beresford did not dispute that the amendment sought broadens the claim as the examiner suggests but he argued that there was a basis for this broader reference to hydrazone compounds generally in the original disclosure. In support of this contention, he drew my attention to various passages in the original description. However, I understood him to accept that, in order to determine what is disclosed, a patent specification should be read and

construed as a whole and that passages should not be taken out of context.

His first point concerned the opening paragraph of the description which reads:

"The present invention relates to electrophotographic photosensitive members and more particularly to electrophotographic photosensitive members containing hydrazone group compounds."

He suggested that this passage implied at the very outset that the invention was concerned broadly with hydrazones and not with any particular restricted group of such compounds. I cannot accept that construction. The paragraph seems to me quite typical of the kind of statement with which patent specifications almost invariably begin and which does no more than indicate in general terms the field in which the invention lies. The imprecise expression "hydrazone group compounds" seems to me to have just the qualities of generality and imprecision appropriate to a non-definitive, introductory statement of this kind but to be quite inappropriate to a definitive statement of invention. I do not think it likely it would ever be taken as such by an addressee with any experience of reading patent specifications even if read in isolation. In the light of what is said later on in the description, I consider such an interpretation to be wholly implausible.

The passages from line 7 to line 55 of page 1 of the printed specification discuss prior art and refer primarily to the various kinds of photoconductors which have been proposed, and their advantages and disadvantages.

Mr Beresford suggested it was significant that there was no mention of hydrazones having been used in this connection and he suggested that this again implies that what he referred to as "unspecified hydrazones" may be used in the invention. I do not think this can be accepted either. I do not see how the wholly negative feature of the absence of any mention of hydrazones in this passage can be interpreted as a positive suggestion of anything concerning the scope of the invention, or of the disclosure if this be different.

The next passage at page 1 line 57 to page 2 line 16 begins with the words:

"According to the present invention, there is provided an electro-photographic photosensitive member comprising"

and it goes on to specify hydrazones of a general formula substantially identical with that in claim 1 as filed. The minor disconformity of wording

and subsequent slight confusion as regards the meaning of this formula is due, I understand, to minor amendment made to the main application during prosecution having been imperfectly carried over into the present specification and nothing turns on it.

Mr Beresford did not dispute that this passage is in the conventional form for a statement of invention but he drew attention to the passage closely following at page 2 lines 20 to 50 which is, in part, repetitious of it. This passage begins:

"The specific hydrazone compounds used in the present invention are represented by the formula"

The formula in the original claim 1 is then repeated but with further particularisation of what the substituents R_1 , R_2 and R_3 may be. He suggested that the word "specific" here equated with "preferred" and that the repetition in this passage would have been unnecessary if the earlier passage had been intended to be a limitative definition of the particular hydrazones to be used in the invention. Again I find it impossible to read into these passages the significance which Mr Beresford suggested exists. The first seems to me incapable of being read as anything but a straightforward statement in definitive terms of the scope of the invention with respect to the hydrazone compounds to be used and, as such, to go a long way towards controverting Mr Beresford's entire thesis. The second appears simply to be intended to provide some further particularisation of, presumably advantageous, values for the variables R_1 , R_2 and R_3 in the general formula. I cannot myself find any further significance in them.

Mr Beresford also drew attention to wording further on in the description contrasting the use of the expression: "a hydrazone compound represented by formula (1)" at page 3 lines 26 and 29 with the use of: "the hydrazone compounds of the invention" at page 6 lines 46 and 52 and page 7 lines 1, 21 and 50. He suggested that there must be some distinction so that formula (1) cannot be meant as definitive of the hydrazones to be used in the invention.

Even if this were accepted, it does not appear to follow that the proper scope of the invention in this respect is that which it is now sought to claim or, indeed, any other position intermediate between this extreme and that of the claim 1 as filed. However, I am entirely unconvinced that any distinction of substance can or should be drawn. The most natural and, to my mind, most

reasonable interpretation is that these expressions are mere variations of language having exactly the same meaning in the context of this specification.

Finally, Mr Beresford referred to a declaration made by Dr Garratt, a Reader in organic chemistry at University College, London. After he had studied the specification, Dr Garratt was asked to comment "whether a reader with a good knowledge of general organic chemistry would form the view," (on reading the description), "that hydrazones other than those particularly specified in lines 10 to 30 of page 17 (ie in claim 1 as filed) would be useful in the construction of electrophotographic photosensitive members the subject of the invention?". The answer which he gives in paragraph 7 of his declaration is that he would. Dr Garratt also discusses the interpretation he himself would put on various parts of the description and appears to concur generally with the views Mr Beresford himself put to me and with which I have already dealt.

In my view, useful as it may be, the declaration is open to some criticism. In the first place, I am by no means satisfied that, being a skilled organic chemist, Dr Garratt is representative of the notional skilled addressees of an invention concerned with electrophotographic photosensitive members. In particular, it would seem likely that his wide knowledge of organic chemistry could lead him to conclusions on organic chemical considerations which would not be reached by others without that knowledge. On the other hand, although he does not mention it, it would seem likely that he has some knowledge also of electrophotography. so I would not discount entirely his conclusions on these grounds.

In the second place, the question put to Dr Garratt does seem to me to be distinctly leading in character. One cannot resist speculating whether his response would have been the same had the question put not referred directly to the possibility of using hydrazones other than those particularly specified. However, in my view the most serious criticism goes to the very substance of the question put to him. It appears to me that the point at issue is not whether a reader of the specification would "form the view" that hydrazones other than those set forth in claim 1 as filed would be useful for the purpose of the invention but whether there is anything in the specification which instructs him that this is so. Dr Garratt was not asked and so did not answer this question and, although he indicates that he detects implications in the description of some broader aspect of the invention, he, like Mr Beresford, does not point to a single instance of wording which might be taken as a positive indication that a broader aspect exists or what it may be.

This, to my mind, is the essential point and one which distinguishes the present case from that of United Carr's Application (1971 RPC 23) to which Mr Beresford also drew my attention. In that case, there was a slight but nevertheless quite positive indication of a wider aspect of the invention. On careful study of the present specification I have been unable to find any positive indication that any hydrazones other than those covered by the general formula were contemplated at the time it was drafted. The specific examples, the detailed description and, in my view, even the more general statements are fully in accord with this view and it is my firm opinion that there is no other reasonable construction which can be put upon the description considered as a whole. Even if this were not so, there must be serious doubt that the claim 1 which is sought has any proper support insofar as it covers hydrazones not within the general formula since the particular description is confined entirely to consideration of compounds lying within its relatively restricted bounds.

Precisely the same considerations apply to the other new main claim sought, claim 5, which is also for electrophotographic photosensitive members which, although defined differently from those of claim 1, are also specified as containing "a hydrazone compound" without further qualification, and to the remainder of the new claims sought which are all ultimately appendant to claim 1 or claim 5 and also include this matter.

Accordingly, I must uphold the examiner's objection in respect of all of the new claims and other amendment filed on 2 May 1984 and refuse to allow any of this matter to be incorporated. It follows that the application, if it is to proceed, must do so on the basis of its contents prior to these amendments having been sought, and that no further amendment can be permitted which extends the scope of the invention with respect to the hydrazone compounds to be used beyond that defined in claim 1 of the specification as filed. Any further response the applicants may wish to make to the examiner's report dated 16 June 1984 should reach the Office by 26 March 1985, this being the last day of the prescribed (and unextended) period allowed under Rule 34 for meeting the requirements of the Act and Rules.

Dated this 13th day of February 1985

A J NEEDS
Principal Examiner, acting for the Comptroller

PATENT OFFICE