

PATENTS ACT 1977

IN THE MATTER OF

patent application GB9800716.4

in the name of Lester Abbott

DECISION

Introduction

1. Patent application GB9800716.4 (the new application) was filed on 15 January 1998 in the name of Lester Abbott claiming under section 15(4) the filing date 13 October 1995 and the priority dates 16 November 1994 and 20 December 1994 of patent application GB9520960.7 (the earlier application).

2. In a letter dated 18 February 1998 the examiner objected that, by virtue of claim broadening, the new application disclosed matter extending beyond that disclosed in the earlier application, thus contravening the requirements of section 76(1), and that in consequence the new application could not proceed as a filing under section 15(4). In a response dated 24 February 1998, Mr Abbott's representatives, Fry Heath & Spence, refuted the objection, accepting that there was claim broadening, but arguing that there was no extension of disclosure.

3. Further correspondence between the examiner and Mr Abbott's representatives failed to resolve the matter, which came before me at a hearing on 30 September 1998. Mr M Downing of Fry Heath & Spence appeared for the applicant, and Mr A Littlejohn assisted by Mr P Foot attended as examiner.

The applications

4. Both the earlier and the new applications are entitled "Frame elements" and relate to

mounting a door or window frame in a wall opening by providing an outer frame in the opening and attaching the door or window frame to the outer frame.

5. The new application is based on the embodiment of figures 5 and 6 of the earlier application. This shows an outer frame which can be mounted in an opening in a cavity wall so that the outer frame lies in the same plane as the cavity, bridging the cavity between the inner and outer leaves of the wall. The outer frame has two dovetail recesses, one adjacent the inner wall leaf and the other adjacent the outer wall leaf. A reversible backstop can be located in either of the recesses. When the backstop is located in the recess adjacent the outer wall leaf, the window or door frame can be inserted from the inside until it abuts the backstop and is positioned thereby in the plane of the outer frame and the cavity. When the backstop is reversed and located in the other recess, the window or door frame can be inserted from the outside until it abuts the backstop and is again positioned thereby in the plane of the outer frame and the cavity.

6. The new application has two independent claims, claims 1 and 4. Claim 4 is word for word the same as claim 8 of the earlier application as filed and reads as follows:

A window or door frame system comprising an outer frame for receiving a window or door frame, the outer frame being fixable to a wall and including an engagement means for interengagement with the window or door frame, and a pair of dovetailed-recesses, one either side of the engagement means, each capable of interengagement with a backstop, thereby to enable the backstop to be fitted in a selected one of two mutually reversed positions, thereby to enable the window or door frame to be fitted from the inside or from the outside.

7. The claim to which objection has been taken under section 76 is claim 1 of the new application. This reads as follows:

A window or door frame system comprising an outer frame fixable to a wall and capable of receiving a window or door frame, and a backstop for limiting movement of

the window or door frame during fitting, attachable to the frame in a selected one of two mutually reversed positions, thereby to enable the window or door frame to be fitted from the inside or the outside.

The law

8. The relevant part of section 15(4) reads:

(4) Where after an application for a patent has been filed and before the patent is granted, a new application is filed by the original applicant or his successor in title .. in respect of any part of the matter contained in the earlier application .. (without the new application contravening section 76 below) the new application shall be treated as having, as its date of filing, the date of filing the earlier application

9. The relevant part of section 76 reads:

76 (1) An application for a patent which-

(a) is made in respect of matter disclosed in an earlier application .., and

(b) discloses additional matter, that is, matter extending beyond that disclosed in the earlier application as filed,

may be filed .. as mentioned in section 15(4) above, but shall not be allowed to proceed unless it is amended so as to exclude the additional matter.

General principles

10. Mr Downing drew upon a number of authorities to set out what he felt were the general principles to be followed when determining issues under section 76. He started from the basic premise that for an amendment to be allowable the application as filed must "contemplate" the matter of the amendment. This is to be judged through the eyes of a skilled reader; if matter would be immediately apparent to the skilled reader, whether explicitly or implicitly, then it is disclosed.

11. This approach follows that laid down in *Flexible Directional Indicators Ltd's Application*, [1994] RPC 207 and *Bonzal & anr v Intervention Ltd* [1991] RPC 553. It is convenient to quote from the headnote to the *Flexible Directional Indicators* decision where the judgement of Aldous J is summarised as follows:

(1) To decide whether the application disclosed matter extending beyond that disclosed in the application as filed, the court must consider the whole of the relevant document, both the text and the claims. The correct approach was the threefold test:-

(a) to ascertain through the eyes of the skilled addressee what was disclosed, both explicitly and implicitly, in the application as filed;

(b) to do the same in respect of the application as sought to be amended;

(c) to compare the two disclosures and decide whether any subject-matter relevant to the invention had been added, whether by deletion or addition

The comparison must be strict, in the sense that subject-matter would have been added unless such matter was clearly and unambiguously disclosed, either explicitly or implicitly, in the application as filed.

12. Mr Downing emphasised the need to interpret what was disclosed through the eyes of a skilled addressee, rather than through the application of a purely literal or legalistic construction, by quoting the well known words of Lord Diplock in *Catnic Components Limited and another v Hill and Smith Limited* [1982] RPC 183 at page 242:

My Lords, a patent specification is a unilateral statement by the patentee, in words of his own choosing, addressed to those likely to have a practical interest in the subject matter of his invention (ie "skilled in the art")

13. Mr Downing went on to acknowledge that "implicit" disclosure does not extend so far

as to include obvious alternatives. Thus if the skilled person comprehends that a particular inventive concept is being communicated by the text, then a corresponding broadening amendment is allowable. If however the skilled reader understands that a narrower inventive concept is being communicated, but is left wondering why the applicant did not claim more widely, then a corresponding broadening amendment is not allowable. Again this point is conveniently made in the summary of the judgement of Aldous J in the headnote to the *Flexible Directional Indicators* decision as follows:

(2) The court was concerned with what was disclosed, not what might have been disclosed and not that which the skilled reader might think could be substituted or had been omitted (p.226).

(3) The disclosure was what was set out in the application, a document in which the applicant disclosed his invention in a manner clearly enough and completely enough to enable it to be performed. The limitation of an invention in a particular way, might have been done so for good reason. The fact that the skilled reader would think of doing it in another way was irrelevant (p.227).

14. Referring me to *AC Edwards Ltd v Acme Signs & Displays Ltd* [1992] RPC 131 and [1990] RPC 621, Mr Downing noted that the disclosure of a claim and the scope of a claim are not the same thing; a claim can very easily cover subject matter without disclosing that subject matter. It follows that, if a claim does not disclose everything that it covers, then there is no need for the application to provide explicit support for everything covered. It is therefore perfectly possible to have a wide claim that covers arrangements which are not described but to be unable to present a narrower claim to certain of those arrangements. Moreover, although obvious alternatives cannot be claimed as such, it does not matter if those obvious alternatives fall within the scope of the amended claim, as long as the borderline drawn in the amended claim is one that is contemplated in the original text.

15. Mr Downing also noted that claim broadening prior to grant is perfectly permissible.

In this connection it is well worth quoting from the judgement of Aldous J in *Southco Inc and Another v Dzus Fastener Europe Ltd* [1990] RPC 587 where, when considering the provisions of section 76, he says at page 615

" .. it is clear that prior to grant the width of the claims can be extended but not thereafter, and in neither case is it permissible to make any amendment which has the result of the application or specification disclosing any matter which extends beyond that disclosed in the application as filed."

and at page 616

"It appears to me that when amendment has been made pre-grant it is not material whether that amendment has the effect of widening or narrowing the monopoly claimed. The Act contemplates that amendments to claims will be made and therefore the ambit of the claim will be altered. What the Act is seeking is to prevent a patentee altering his claims in such a way that they claim a different invention from that which is disclosed in the application. Thus, provided the invention in the amended claim is disclosed in the application when read as a whole, it will not offend against section 76."

Other authorities

16. A number of other authorities were referred to by the examiner during the course of the prosecution of the new application and commented on by Mr Downing at the hearing. In *Van der Lely's Application* [1987] RPC 61, *Raychem Ltd's Applications* [1986] RPC 547 and *Glatt's Application* [1983] RPC 122, the issue was the same as that in the present case, namely claim broadening in divisional applications, and in each of these reported cases the application was refused. Mr Downing felt that the issue was clear cut against the applicant in each of these cases, in that the amendment sought was not contemplated in the application as filed. He noted that in *Van der Lely* the applicant sought to broaden to at least one conveyor when the application referred only to three; in *Raychem* the applicant sought to omit an

explicitly recited process step; and in *Glatt* the applicant sought to omit an air-permeability feature which had to be present for the embodiment to work at all. Similarly in *Flexible Directional Indicators*, which has already been mentioned above, the application as filed described the invention as residing in the addition of a second polymer in the manufacture of a traffic bollard and removal of that feature by claim broadening was refused.

Application to the present case

17. Mr Downing felt that looking at the claims on the earlier (or parent) application was of little use; the new application is not divided from just the *claims* of the earlier application, "so anything contemplated anywhere in the parent application can form the basis for the divisional application". The passage in the earlier application on which he relied to justify claim 1 of the new application is to be found at page 3 lines 5 to 11. This passage (hereafter "the quoted passage") reads as follows:

To the knowledge of the inventor, no window or door frame system which included a backstop for the sub-frame has been provided which is capable of allowing inward or outward fitting of the frame. Thus, previously, in systems which have the preferable sealing and robustness characteristics offered by a backstop, it was necessary to decide from which direction the window would be fitted during building of the wall. This constraint is eliminated by the present invention.

18. Mr Downing felt that the final sentence of this paragraph "is a clear and unambiguous statement to the skilled reader that the inventive step lies in the reversibility of the backstop. An invention which is put across by that paragraph to the skilled person is that of a backstop which can be removed or reinserted so as to fit the window from the other direction". He argued that the breadth of the new claim is "at exactly the breadth of that paragraph".

19. At the hearing the examiner pointed out that the quoted passage follows a statement of invention corresponding to claim 8 of the earlier application and that in his view the skilled reader would interpret the quoted passage in the context of that statement of invention rather

than take it to be a broadening statement. Mr Downing however felt that if the examiner were right on this point, it would follow that the skilled reader would always see the claims as presenting the widest scope communicated by the text, thus making claim broadening impossible, contrary to the quoted authorities. He argued that to interpret the quoted passage correctly it has to be looked at in the context of the whole of the introduction to the earlier application, not just in the light of the statement of invention corresponding to claim 8. This introduction has several statements of invention worded in accordance with a corresponding number of independent claims and Mr Downing noted that whereas in some cases a paragraph following a statement of invention begins "Preferably .." thereby hooking that paragraph to the preceding statement of invention, there is no such hook linking the quoted passage to the statement of invention corresponding to claim 8.

20. One final angle from which this question has been approached is the argument that if, in the embodiment described, the backstop were reversed within the same recess, the result would be that the window or door frame would end up out of position in line with the brickwork, rather than in line with the cavity as the skilled person would expect. This point was raised by the examiner in a letter dated 25 May 1998. At the hearing Mr Downing refuted the suggestion that the skilled person would conclude that the frame should always end up in the same position; he held that it is not essential, there is nothing in the specification to say that it is essential, and to say that it would be obvious to the skilled person goes against the quoted case law.

Conclusions

21. The general line of approach that I have to take is clear from the authorities to which Mr Downing referred me. The one rider that I would add to his interpretation of the authorities concerns the *Edwards* case. His general point that a claim can very easily cover subject matter without disclosing that subject matter, and that, if a claim does not disclose everything that it covers, then there is no need for the application to provide explicit support for everything covered is right. Aldous J states in the *Edwards* decision at page 643 of the 1990 RPC referred to above that "The fact that a claim is broad enough to cover a feature

does not mean that it is disclosed". However as I noted at the hearing, this decision relates to a case of intermediate generalisation, in that claim 1 was substantially *limited* by pre-grant amendment to a form intermediate that of claim 1 as filed and the embodiment as described. It was this intermediate form of claim which was allowed by Aldous J. and it was in this context that he that he found no contravention of section 76, stating at page 644 that "Claim 1 as granted is more limited than claim 1 in the application but the granted claim is supported by the description as required by section 14(5) of the Act. In my view there has not been any extension of the disclosure".

22. The position in the present case is not one of intermediate generalisation. I accept that there is no need for an application to provide detailed support for *everything* covered by a claim, in fact it would clearly be ludicrous if that were the case given that a central function of claims is to generalise from the particular. However it seems to me that it does not follow from this that a broadened claim will necessarily find sufficient support in the application as filed to satisfy section 14(5), and that if there is not sufficient support then the claim will necessarily cover something which was not contemplated in the application as filed and which therefore constitutes an extension of disclosure contrary to section 76.

23. I turn now to consider the context and content of the quoted passage in the earlier application in the light of the above conclusions. The paragraph preceding the quoted passage begins "In a variant form, the present invention provides .." and then goes on to recite the wording of claim 8 of the earlier application, that is to say it describes a system comprising a pair of dovetailed-recesses each capable of interengagement with a backstop, thereby to enable the window or door frame to be fitted from the inside or from the outside. Following this paragraph the quoted passage goes on to say that to the knowledge of the inventor no window or door frame system which included a backstop for the sub-frame has been provided which is capable of allowing inward or outward fitting of the frame, describes the disadvantages of the prior art, namely that in systems which have the sealing and robustness characteristics offered by a backstop it was necessary to decide from which direction the window would be fitted during building of the wall, and concludes with the statement that "this constraint is eliminated by the present invention".

24. There is little doubt to my mind that the quoted passage is picking up on the theme first introduced in the preceding paragraph of allowing inward or outward fitting of the frame whilst using a backstop. The absence of the linkword "Preferably" is not I think of any significance, since the quoted passage is not aimed at introducing further detailed definition of what is set out in the preceding paragraph; it is directed primarily to pointing out the advantages of such a system over known systems. In consequence it seems to me that to the skilled reader there is an obvious and straightforward connection between these two paragraphs. In other words in my view the skilled person is more likely than not to read the quoted passage in the context of the preceding paragraph rather than in isolation.

25. Taken in this context, I construe the quoted passage to say that in prior systems using a backstop to position a window or door frame the user had to decide from which direction the frame would be fitted during building of the wall, and that this constraint is eliminated by the present invention, *that is to say the invention as set out in the preceding statement of invention* (my italics). In consequence I find myself in disagreement with Mr Downing that in its broadest aspect the "invention which is put across by that paragraph to the skilled person is that of a backstop which can be removed or reinserted so as to fit the window from the other direction". I find nothing here to provide support for any system other than one with two recesses.

26. Mr Downing argued that taking the two paragraphs together would inevitably mean that the skilled person would see the claims as presenting the widest scope presented by the text thereby making claim broadening impossible, contrary to the quoted case law. It seems to me however, *per Southco*, that the central question here is not whether or not claim broadening *per se* is allowable but whether or not taking these two particular

paragraphs together, the skilled person would conclude that the requested broadening extended the disclosure. If he would so conclude then it is this extension of disclosure which is precluded by case law.

27. Turning next to the argument that if, in the embodiment described the backstop were reversed within the same recess, the result would be that the window or door frame would end up out of position over the brickwork, Mr Downing argued that there is nothing in the specification to suggest that the skilled person would conclude that the frame should always end up in the same position. I note that in the earlier application there are systems described where the frame extends over the brickwork, but that in the only embodiment described in which a reversible backstop is used there is no suggestion of any arrangement other than that in which the frame bridges the cavity. I note that the description at page 14 of the earlier application states that "When it is desired to fit the window, for example at the end of construction, the backstop 138 can be fitted either in recess 136a or in recess 136b according to the direction of desired fitting of the window .." I note also that such an arrangement would appear to be essential in the described embodiment to enable the various interconnecting elements of the system to perform their proper functions.

28. It seems to me therefore that there is nothing in the specification to suggest anything other than that the frame and the backstop operate with two recesses each capable of interengagement with the backstop to enable the described positioning to be achieved. Moreover I doubt that the use of any other arrangement would be obvious to the skilled reader, but even if it were, *per Flexible Directional Indicators* that would be irrelevant.

29. In summary then I conclude that the provision of two recesses is not presented as peripheral or optional in the earlier application, that the only embodiment described requires two recesses to work and that the claims in the earlier application directed to that embodiment specifically require two recesses. The only possibility of relief is provided by the quoted passage on page 3 which I have dealt with above. It follows to my mind that a skilled addressee would conclude that the whole teaching of the earlier application is directed exclusively to the two recess system and does not contemplate any other. I find therefore that claim 1 of the new application does not find support, explicit or implicit, in the earlier application. In consequence the claim necessarily covers matter which was not contemplated in the application as filed and cannot therefore be regarded as clearly and unambiguously disclosed, either explicitly or implicitly, in the application as filed. It follows that this

constitutes an extension of disclosure contrary to section 76.

30. I also find support for this line of reasoning in the particular circumstances of the *Raychem*, *Glatt* and *Flexible Directional Indicators* cases. In each of these, claim broadening through omission of a feature held to be essential in the application as filed was refused, which seems to me to be on all fours with the present case. I also find support from the *Van der Lely* case in which broadening from "three conveyors" to "at least one conveyor" was refused, which seems to me to be on all fours with the broadening from "two recesses" to "at least one recess" in claim 2 of the new application.

31. I find therefore that the new application discloses matter extending beyond that disclosed in the earlier application, thus contravening the requirements of section 76(1), and that in consequence the new application cannot proceed as a filing under section 15(4). Clearly it is possible to amend the application to meet the point and I therefore allow two months from the date of this decision for the submission of amendments to the Office to exclude the additional matter. It will be necessary to ensure that all of the claims are free of objection under section 76 and that consequential amendment is made where necessary. It will then be possible to begin the normal examination procedure under section 18. If no such amendments are proposed then I shall order that the application proceed with a date of filing of 15 January 1998.

Appeal

32. This decision being on a substantive matter, under the rules of the Supreme Court any appeal against it must be filed within six weeks.

Dated this 20th day of October 1998

D J BARFORD

Principal Examiner, acting for the Comptroller

THE PATENT OFFICE