

PATENTS ACT 1977

IN THE MATTER OF

Patent Application numbers

GB 9522426.7, GB 9616935.4 and GB 9616992.5

in the name of Denis Leslie Wight.

INTERIM DECISION

Introduction

GB 9522426.7, GB 9616935.4 and GB 9616992.5 are patent applications in the name of Denis Leslie Wight (hereafter “the applicant”). UK application number GB9522426.7 which is for a “Rod mounted electric bite alarm” was filed on 2 November 1995 with no claim to priority and was published on 21 May 1997 as GB2307161. UK application number GB 9616935.4 which is for an “Electronic fishing bite indicator” was filed on 13 August 1996 with no claim to priority and published on 18 February 1998 as GB 2315971. UK application number GB 9616992.5 which is for a “Multi purpose electronic fishing rod” was filed on 13 August 1996 with no claim to priority and published on 18 February 1998 as GB 2315972.

Background

GB 2307161 was searched under Section 17 and the results of this search were conveyed to the applicant in a report dated 16 January 1996. No further actions or correspondence occurred on this case until after publication. GB 2315971 and GB 2315972 were also searched under Section 17 by the same examiner and the results of the search reported to the applicant on 4 November 1996 and 5 November 1996 respectively. In the reports on both GB 2315971 and GB 2315972 the examiner stated that the claims filed on both applications were not clear.

In response to the search reports issued on GB 2315971 and GB 2315972 the applicant filed a letter dated 6 November 1996 expressing doubts on the content of the Section 17 search reports. In response, a Deputy Director issued a letter dated 12 November 1996 stating that no view had been taken at that time in relation to the validity of the claims and that this matter would only be considered at the Substantive Examination stage. After publication of the applications requests for substantive examination for each application were received by the due date.

In a letter dated 22 October 1998 the applicant requested accelerated prosecution of the three applications due to “ECONOMICAL AND COMPETITIONAL PRESSURE FROM RIVALS”. On 9 November 1998 the substantive examiner informed the applicant in an official letter that the substantive examination of the three applications would begin immediately. Examination reports under section 18(3) were issued on GB 2307161, GB 2315971, and GB 2315972 on 10 November 1998, 11 November 1998 and 12 November 1998 respectively with response periods of 10 May 1999, 11 May 1999 and 12 May 1999 respectively.

The report on GB 2307161 contained novelty objections against claims 1, 2 & 4 and clarity objections against the claims. The report on GB 2315971 contained novelty objections against all of the claims and also clarity objections against the claims. The report on GB 2315972 contained clarity objections against the claims and objection for novelty or inventive step. The documents that were originally cited in the search report were cited in the examination report to substantiate the objections. The substantive examiner in each of the section 18(3) reports suggested a wording for the claims that would appear to overcome the official objections.

The applicant contacted the Office on 27 May 1999 by telephone to speak to the substantive examiner about the status of the application. It transpired that the applicant had not received the section 18(3) reports due to postal difficulties. The reports were re-issued and each reply period was extended by two months.

The applicant responded to the three section 18(3) reports in a letter dated 23 June 1999 in which he wrote under each application number: “In response to the examination report I

disagree with the points raised and have no reason to file any amendments”.

In response, the substantive examiner issued a further examination report on each application under section 18(3). In each report dated 30 July 1999 he considered that the content of the applicant’s letter did not constitute a reasonable attempt to meet the outstanding objections. The further examination reports re-iterated that a suggested wording for the claims had been included in each previous report and that if the applicant disagreed with the objections then valid arguments should be provided. The examiner also offered an interview to the applicant or a chance to discuss the cases on the telephone. The applicant was informed that unless a suitable response was received refusal of the applications was contemplated.

On 24 August 1999 the applicant wrote to the Office and stated that he did not agree with the examination reports and indicated that he was willing to provide valid arguments “to you (the comptroller), a panel or tribunal in person” and requested an appointment to resolve this issue. An examiner contacted the applicant by telephone on 17 September 1999 and stated that the Office was minded to refuse the applications as the points raised in the examination reports had not been addressed. Before doing so however the applicant would be offered an opportunity to be heard to present arguments as to why the applications should not be refused at a hearing.

Therefore, a hearing to decide the matter was arranged for 25 October 1999. At the hearing, the applicant (Mr Wight) appeared in person and was unrepresented; I was assisted by an examiner (Mr Paul Jenkins).

Relevant law

Under section 18(2) of the Patents Act 1977 the substantive examiner investigates whether an application complies with the requirements of the Act. Further, section 18(3) states that:

If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those

requirements (subject, however, to Section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are so complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.

Paragraph 18.49 of the “Manual of Patent Practice” (MOPP) states that:

Under Section 18(3) the comptroller has the power to refuse an application where the applicant fails to file a satisfactory response to an official report within the period specified therein.

In the circumstances where an inadequate response is received from the applicant, paragraph 18.52 of MOPP states that:

If however the reply is such that it cannot be regarded as such an attempt the applicant should be warned in writing that refusal is contemplated and given two weeks in which to respond to the outstanding matters. If this fails to elicit a response, he should be formally advised that it is proposed to refuse the application as provided by s.18(3) but that before this is done he will be given an opportunity to be heard in the matter.

The arguments for and against refusal

The applicant made it clear at the hearing that he had disagreed with the examiner’s opinion on the validity of the three applications and that he did not trust his judgment. He did not challenge the fact that he had not made a satisfactory response to each substantive examination report nor the fact that his last response to each of the reports was out of time. However, he was quite content to discuss potential amendments of the three applications before me at the hearing.

In my opinion, it is clear that the objections put forward in the section 18(3) examination reports are valid. It is also clear that although the applicant responded to these re-issued reports on 23 June 1999 within the extended time periods, the responses were unsatisfactory

in that he did not put forward an “argument, amendment, a request for a hearing or a request for interview” which are considered to be acceptable forms of response. From what is set out in the applicant’s letters of 23 June 1999 and 24 August 1999 it is clear that the applicant did not believe that the applications required amendment.

However, although the applicant did not agree with the examiner’s objections, he indicated in his letter dated 24 August 1999 that he would be willing to provide arguments at a hearing. In my opinion, this action (although outside the specified period for reply) constitutes an attempt by the applicant to advance the applications towards a final decision as to their allowability. Moreover, since it was clear from the section 18(3) reports that the subject matter of the applications could support valid claims, an opportunity was taken at the hearing to consider suitable saving amendments to each application in turn.

Therefore, the applicant and I, with assistance from the examiner, considered the suggestions put forward by the substantive examiner in the section 18(3) reports.

Discussion of proposed amendments

The statement of claim of GB9522426.7 as filed reads as follows:

- 1. A rod mounted Electric Bite Alarm comprising a bite detector and power-pack alarm control unit connected by power leads.*
- 2. A rod mounted bite detector as claimed in claim 1 wherein the swing arm rests on the line and when activated triggers the alarm.*
- 3. A rod mounted bite detector as claimed in claim 1 or 2. (sic) when activated the swing arm is held up by magnet or other enabling free operation of fishing rod.*
- 4. A rod mounted power-pack alarm control unit as claimed in claim 1 wherein the alarm is manually controlled by the rod operator.*

It was established at the hearing that claims 1 and 4 were not novel. It was also established that the combination of the subject matter of claim 3 (when suitably clarified), viz. ‘the swing arm being held up in an activated position by a magnet or other means’, with the subject matter of claims 1 and 2 would appear to both novel and inventive and could form matter for a new claim 1.

The statement of claim of GB9616935.4 as filed reads as follows:

- 1. A MULTI-PURPOSE electronic fishing rod.*
- 2. A MULTI-PURPOSE electronic fishing rod as claimed in claim 1 where as power is supplied to plug-in sockets.*
- 3. A multi-purpose electronic fishing rod as claimed in claim 1 or claim 2 where in any electronic accessory that is not integral to the rod can be used.*

After some discussion, it was accepted by the applicant that claim 1 as presently worded was of broad and indeterminate scope and, insofar as its scope could be determined, was not novel. It was established after some argument that the distinguishing feature of the statement of claim appeared to be the subject matter of claim 3, viz. ‘the fishing rod being adapted, via a plurality of sockets, to supply power to a plurality of accessories which are not integral with the rod’. Again, the combination of claims 1, 2 and 3 (when suitably clarified) would appear to be both novel and inventive and could form matter for a new claim 1.

Finally, the statement of claim of GB9616935.4 as filed reads as follows:

- 1. An electric fishing bite indicator.*
- 2. An audible and visual indicator as claimed in claim 1.*
- 3. An indicator as claimed in claim 1 or claim 2 having electronic sensors provided in a plug-in body to be used in conjunction with an electronic rod.*

It was established at the hearing that claims 1 and 2 were not novel. It was established that the distinguishing feature of the statement of claim appeared to be the subject matter of claim 3 (when suitably clarified), viz. ‘the provision of electronic sensors and a plug-in body to be used in conjunction with a fishing rod with the establishment of an electrical connection between the electronic sensors and a power source’. It was also established that the combination of the subject matter of claim 3 (suitably clarified) with the subject matter of claims 1 and 2 would appear to both novel and inventive and could form matter for a new claim 1.

Decision

In my opinion, the applicant has failed to provide a satisfactory response to the objections set out in the section 18(3) reports originally issued on 10 November 1998, 11 November 1998 and 12 November 1998 for published patent applications GB 2307161, GB 2315971 and GB 2315972 respectively within the periods specified for response.

However, the applicant indicated in his letter of 24 August 1999 (although out of time) that he was willing to provide valid arguments and requested an appointment to do so. At the hearing the applicant indicated that he was prepared to amend the three applications along the lines discussed during the hearing and as previously suggested by the substantive examiner so as to resolve the outstanding objections to the applications.

Therefore, I will allow the applicant one month from the date of this decision to submit amendments to the examiner who assisted at the hearing (Mr Paul Jenkins) with a view to remove the outstanding objections to the claims and description of each of the three applications. In the event that amendments filed by the applicant are not sufficient to remove all outstanding objections, the applicant will be given a further period to place the application or applications in order as specified by the examiner.

If the applicant does not file amendments on any or all of the applications within the period of one month from the date of this decision, then the application or applications shall be refused.

As this is a substantive matter any appeal against this decision must be lodged with the Patents Court within six weeks of the date of this decision.

Dated this 5th Day of November 1999

D J JERREAT

Deputy Director, acting for the Comptroller

THE PATENT OFFICE