



BL O/064/07

1 March 2007

PATENTS ACT 1977

APPLICANT Alastair Thomas Harper Brown

ISSUE Whether an amendment to patent
 application number GB 0328472.6
 complies with section 76(2)

HEARING OFFICER R C Kennell

DECISION

- 1 This application is directed to a construction of a shopping trolley body. It was filed on 9 December 2003, and was published under serial no. GB 2408968 A on 15 June 2005. Since then the application has been subjected to several rounds of substantive examination. As a result Mr Brown (who is prosecuting his application without professional assistance) and the examiner have been able to reach a measure of agreement about how the claims should be limited to avoid the prior art cited by the examiner, although their final form is still to be settled.
- 2 However, Mr Brown and the examiner have been unable to agree on whether claims to two particular constructions add new information to the specification in contravention of section 76(2) of the 1977 Act which disallows any amendment "if it results in the application disclosing matter extending beyond that in the application as filed". A hearing has been offered on this point, but Mr Brown is unable to attend. He has said that he is content for me to decide the matter on the basis of the papers on file, and this I will now do.

The invention

- 3 Mr Brown's invention aims to reduce the risk of injury and damage inherent in current designs of shopping trolley by eliminating surface projections in likely areas of impact, especially the front vertical corners and the edges where the base meets the front and sides of the trolley. Accordingly, these areas are formed in a curve along either all or part of their length. They may be formed in one or more pieces and may either be an integral part of the structure or be applied to an otherwise complete structure, these alternatives being illustrated in Figures 2 and 3 respectively. The dispute hinges on the latter, which is described in the following terms in the specification as originally filed:

"Figure 3 illustrates in perspective how parts formed to cover the areas of

likely impact could be formed in one or more sections and attached to an otherwise complete body structure.”

“Figure 3 illustrates one way in which these areas could be formed and divided into separate components 2, 3 & 4 to be attached to an otherwise complete body/handle assembly 5 as additional components.”;

from the drawing it appears that each of the components 2 and 4 is an L-shaped element disposed along a side edge of the base and a front vertical edge, and component 3 is a straight element disposed along the front edge of the base.

Arguments and analysis

- 4 It is the view of the examiner that an L-shaped element disposed as above is the only feature of the original specification which can be relied on to render the invention novel and inventive over the prior art. However, whilst Mr Brown is, as I understand it, willing to limit the original claims along these lines if necessary, he wishes also to add two claims which are characterized by the elements being disposed as follows:

“... elements which are positioned along vertical leading edges of the front panel and along side and front edges of the base panel, said elements comprising a first substantially U-shaped element extending down one vertical leading edge, along the base front edge and up the other leading edge”

“...elements which are positioned along vertical leading edges of the front panel and along side and front edges of the base panel, said elements comprising a first substantially U-shaped element extending along one base side, across the front of the base and along the other base side, with 2 elements each extending down the leading vertical edges”;

the question before me is whether these add subject matter.

- 5 Mr Brown accepts that these configurations were not specifically described or illustrated but points out that Figure 3 merely shows one way of applying separate elements to the trolley structure. He explains that he drafted his specification in the broadest possible terms to protect against potential infringement, but did not think it possible and did not wish to describe every construction which might fall within the ambit of the invention. However, he says that he always wanted to cover the use of U-shaped elements and is concerned that if he cannot now include the new claims, it will be easy get round any patent which might be granted.
- 6 However, for a specification to be entitled to its filing date, the matter which it discloses must be present on that date; to add new information at a later date is not therefore allowable. I believe the test to be applied is whether the skilled reader to whom the specification is addressed would regard the matter in question as having been disclosed either explicitly or implicitly in the original specification. To my mind, the fact that a particular construction falls within the scope of the claims or within some generalization of the invention in the description does not necessarily mean that it has been implicitly disclosed,

even if it was something that the skilled reader would realise to be an obvious modification of what was originally explicitly disclosed.

- 7 In the present case it is not disputed, and I agree, that there was no explicit disclosure of U-shaped elements. However, neither do I consider them to have been implicitly disclosed. I accept that the skilled reader would realise the construction of Figure 3 to be just one way of adding separate elements, but the use of U-shaped members is just one of many possible alternatives and there is nothing to point the skilled reader in any particular direction. Therefore, even if the use of a U-shaped member would be novel and inventive over the cited prior art – something which I have not been asked to consider and on which I make no finding - I find that the claims in question disclose matter extending beyond that in the application as filed, and cannot be included.
- 8 I accept that this will be a disappointment for Mr Brown in view of the concerns he has expressed – especially since the disclosure of the U-shaped elements in the correspondence open to public inspection will invalidate any subsequent application for the same subject-matter, whether by Mr Brown or anyone else. However, the relatively limited nature of the specific disclosure would appear to have left Mr Brown with little room for manoeuvre in restricting his claims so as to avoid the prior art cited by the examiner. If, as he says, the use of U-shaped elements was something that he always wanted to protect, it is unfortunate that he made no specific mention of them in the original specification.

Next steps (including appeal)

- 9 If Mr Brown does not agree with my decision he has a right of appeal to the Patents Court. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any such appeal must be lodged within 28 days of the date of the decision. If no appeal is lodged within that period the application will be remitted to the examiner to continue its prosecution.

R C KENNEL

Deputy Director acting for the Comptroller