

PATENTS ACT 1977

APPLICANT Mars UK Limited

ISSUE Whether patent application number GB
0329452.7 complies with sections 1(1)(b)
and 14(5)

HEARING OFFICER C L Davies

DECISION

Introduction

- 1 Patent application number GB 0329452.7 entitled "Multicomponent Meal" was filed on 19th December 2003, claiming priority from a GB application. A search report was issued on 20th May 2004 and the application published on 28th July 2004.
- 2 In the first examination report under section 18(3) issued on 30th September 2005, the Examiner objected that the original claims lacked novelty and clarity and the Agent responded by filing amendments to the original claims. Further reports under S18(3) were issued to which the Agent responded but the Examiner was still not satisfied that the amendments filed overcame novelty/clarity objections raised in her reports and subsequently offered a hearing.
- 3 In a letter of 26th June 2007 based on claims filed with Agent's letter dated 10th May 2007, the Examiner summarised the issues to be addressed at the hearing. In a letter of 5th July 2007, the applicant filed two amended claim sets entitled "Main Request Claims" and "Auxiliary Request Claims", requesting that a patent be granted in respect of the "Main Request Claims". In one final letter issued prior to the hearing and dated 12th July 2007, the Examiner raised an inventive step objection in respect of claim 1 of the "Main Request Claims", in addition to clarity objections. In that letter, the Examiner also reported that she had no objection to claim 1 of the set of "Auxiliary Request Claims", apart from a minor clarity objection. In response, the Agent stated that the Applicant would like to maintain their "Main Request" and requested that should it be rejected, that the Applicant be given the opportunity to discuss the "Auxiliary Request" at the hearing.

- 4 A hearing was held before me on 25th July 2007. Dr Alison Care of Kilburn & Strode, the Applicant's agent, attended as did Mr Andrew Miller from Mars UK Limited and the Examiner, Mrs Kathryn Orme.

The application

- 5 The application relates to a feline multi-component foodstuff which allows the cat to optimise the macronutrient content (ie. protein, fat & carbohydrate) of its diet.

The claims

- 6 The "Main Request Claims" set contained 14 claims, claim 1 reading as follows:

"1. A feline multi-component foodstuff comprising two or more compartmentalised food compositions, of which at least two compositions differ in their content of at least two of fat, protein or carbohydrate when used in allowing a feline animal to vary its consumption of each of the food compositions independently and to achieve an intake of at least two of protein, fat and carbohydrate to an optimum ratio and achieve a suitable nutritionally complete diet."

- 7 The "Auxiliary Request Claims" set contained 13 claims, claim 1 reading as follows:

"1. A feline multi-component foodstuff comprising three or more compartmentalised food compositions, of which at least three compositions differ in their content of fat, protein or carbohydrate when used in allowing a feline animal to vary its consumption of each of the food compositions independently and to achieve an intake of protein, fat and carbohydrate to an optimum ratio and achieve a suitable nutritionally complete diet."

Issues to be decided

- 8 On the basis of the "Main Request Claims" set, the issues to decide at the hearing were inventive step (section 1(1)(b)) and clarity (section 14(5)(b)) in respect of claim 1 (at least).

The law

- 9 The relevant provisions of sections 1 and 14(5) are:

1.-(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -

(a)

(b) it involves an inventive step;

14(5) The claim or claims shall -

(a)

(b) be clear and concise;

The hearing

- 10 At the hearing, the Agent stated that the Applicant wished to proceed with the “Auxiliary Request Claims” set and therefore set aside the “Main Request Claim” set.
- 11 As I have already indicated in paragraph 3 above, the Examiner had previously reported the claims of the “Auxiliary Request Claims” set to be inventive. I had no reason to consider otherwise and confirmed that I accepted the Examiner’s view. Clarity was therefore the only remaining outstanding issue, in addition to consequential amendments to the description.
- 12 Clarity objections were discussed and the Agent offered amendments which I considered to be acceptable.

Conclusion and next steps

- 13 I find that claims 1-13 of the “Auxiliary Request Claims” as further amended at the hearing comply with section 14(5)(b). I now refer the application back to the Examiner to confirm that manuscript amendments made to the description and claims at the hearing are acceptable and if not, request the Agent to file clean copies of the amendments. I am content for the application to proceed to grant on the basis of these clarifying amendments.

Appeal

- 14 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

C L Davies

Deputy Director acting for the Comptroller