



31 August 2010

**PATENTS ACT 1977**

APPLICANT                      Martin Anthony Mckenzie

ISSUE                              Whether amendments to patent  
   application number GB 0604646.0  
   complies with section 76

HEARING OFFICER              Ceri Witchard

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**DECISION**

**Introduction**

- 1 Patent application GB 0604646.0 ('the application') was filed on 8 March 2006 and published on 5 September 2007, under the publication number GB 2435667. The title of the invention is given as 'Lighting and illuminated roller shutter designs, screens and the like'.
- 2 There have been numerous rounds of correspondence between the examiner and the applicant. The most recent set of claims were filed on 21 May 2010. The examiner issued an examination report in relation to these claims raising a number of issues, the key issue being that the newly filed claims contained added matter. The applicant, Mr Mckenzie, responded, arguing that the claims did not add matter and subsequently requested a hearing.
- 3 Mr Mckenzie did not wish to attend in person and agreed to a decision being taken on the papers.

**The application**

- 4 The application describes the problem in modern towns of businesses and shop front being closed up, particularly overnight, with drab steel shutters which may be vandalized. This therefore makes town centres unappealing places to be and deters visitors. The invention is directed towards ways of making the shutters or similar arrangements used more attractive.
- 5 There has been much correspondence between the examiner and the applicant, resulting in many alternative claims being filed. The most recently filed claims, sent to the examiner on 21 May, are:

i. An integrated translucent roller shutter with at least one light integrated into at least one shutter slat for controlling various illumination effects. Characterised by Integrated security equipment such as street video surveillance displayed on roller shutter, Shutters, security shutters, roller curtains, roller blinds or apertures, partitions, or moveable or rigid upright partitions of various types, shield designs, or integrated door designs to display or advertise thereon or LED light source providing integrated advertising.

ii. Primarily plastics integrated translucent or tinted translucent shield adaptations as security equipment such as street video surveillance designs integrating displays on roller shutter, Shutters, security shutters, roller curtains, roller blinds, partitions, or moveable or rigid upright partitions of various types, or integrated with door designs, characterised by translucent or tinted translucent shield designs and to display or advertise thereon, or via LED light sources and systems providing integrated advertising.

iii. An integrated translucent roller shutter with at least one light source integrated into at least one shutter slat(s) comprising street video surveillance, displays, or advertising on the slats

6 The claims, and description, refer interchangeably to roller shutters, security screens, blinds, shields, doors, partitions. For ease of reference throughout my decision I refer to these all simply as 'shutters'.

### **The law**

7 The relevant section is 76(2). This reads:

(2) No amendment of an application for a patent shall be allowed under section 15A(6), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

### **Period for putting the application in order**

8 The prescribed period for putting this application in order expired on 23 May 2010. Mr Mckenzie was informed of this on a number of occasions. He was also informed that he could extend this date by two months by filing the relevant form and fee. Mr Mckenzie has not filed the required form or fee and the opportunity for him to do so has now lapsed. Therefore the period for putting this application in order has expired and there is no avenue available to Mr Mckenzie to extend this period or to make further amendment to his application.

9 As the period for putting the application in order has expired the decision for me is whether, on the date the compliance period ended, the application was in fact in order for grant. If I find that the application was not in order at this point it will be refused.

## Relevant case law

- 10 The test for considering whether subject matter has been added is set out in *Bonzel*<sup>1</sup>. Although the *Bonzel* case involved an amendment being made post-grant the test to be applied remains the same. It is not disputed that this is the appropriate test. This can be summarized as:
- i. Ascertain through the skilled addressee what is disclosed, both explicitly and implicitly in the application.
  - ii. Do the same in respect of the amended version
  - iii. Compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition. The comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly.
- 11 This was summarized by Jacob J. in *Richardson-Vicks Inc.'s Patent* [1995] RPC 568, "the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification."

## Argument and analysis

- 12 The examiner has argued that Mr Mckenzie has added subject matter by way of his most recent amendments by disclosing three features which he argues were not disclosed within the original specification. These features are:
- a. The inclusion of street video surveillance within the shutter (as in claims i, ii and iii above).
  - b. The inclusion of 'integrated security equipment' (as in claim i above)
  - c. The inclusion of 'shield adaptations' (as in claim iii above)
- 13 These features are to a certain extent interrelated. However, I shall consider each separately.

## Street video surveillance within the shutter

- 14 The original application specifically mentioned street video surveillance only once, at the end of the paragraph entitled 'Background of the invention'. The paragraph tells the story of one particular Council's attempts to deter businesses from using plain steel roller shutters to close up their shops. The Council was said to be concerned that this created a bleak image of rows of steel shutters, which were often vandalized. The Council's hopes were that they could use planning guidance to encourage businesses to adopt more stylish alternatives. This paragraph ends with the sentence '*The introduction of street video surveillance allows much more creative and sensitive designs for shop front*

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<sup>1</sup> *Bonzel & Schneider (Europe AG v Intervention Ltd)* [1991] RPC 553

*security on the whole, and home owners in general.*' Following the paragraph discussing the background of the invention, there is a further paragraph entitled 'Summary of the invention'. This paragraph describes the use of illumination and lighting effects within security screens.

- 15 On reading the background paragraph, skilled reader would understand that the invention is to overcome a problem that is a situation in which it is desirable to reduce the number of dull, plain shutters in a high street. He would understand from the final sentence of this paragraph that the introduction of street video surveillance makes it possible to introduce more creative shop front designs, implicitly because the chance of them being vandalized is reduced by the fact that they are being monitored. He would then understand there to be the disclosure of the applicant's claimed invention in this area, that is the use of lighting or illumination effects to make more attractive shutter arrangements.
- 16 On considering the amended version of the specification, incorporating the new claims, claims i and iii now both include the possibility of video surveillance being displayed on the shutters. The first claim refers to 'integrated security equipment such as street video surveillance displayed on the shutter', whilst the third claim refers to 'one light source integrated into at least one shutter comprising street video surveillance displays'. The skilled reader would read this as teaching a shutter of some type, having means to incorporate within the shutter the display of video.
- 17 On comparison of the two disclosures, it is clear that subject matter has been added. The current claims disclose the use of video surveillance within the shutter in a way that the skilled reader would never have envisaged on reading the original application. The mere mention of video surveillance in the original filing, in an entirely different context, cannot be considered to disclose the use of video surveillance in the manner of the current claims. Therefore the amendments to the claims add matter, contrary to section 76.

### **Integrated security equipment**

- 18 The original disclosure refers to 'security equipment' in the discussion of the background to the invention. Here the phrase is used in reference to the shutters that could be adopted within the high street, it is used in a sentence discussing the Council's hope that more attractively designed shutters will be introduced, making the high streets a more inviting place than it is presently. The skilled addressee would understand that this phrase is used generally to discuss the nature of the invention, which relates to ways in improving the appearance of shutters used on shop fronts and businesses by using 'sympathetically designed security equipment'.
- 19 The amended disclosure includes a claim (claim i above) to a shutter having, amongst other features, 'integrated security equipment such as video street surveillance'. This implies to the skilled reader that there is some additional form of security equipment integrated within the shutter.

- 20 On comparison it is clear that the amended specification now teaches the skilled addressee something that was not taught in the originally filed documents. That is the integration of some form of security equipment within a shutter. Again the mere mention of the phrase 'security equipment' in a particular context within the specification does not permit the applicant to introduce a new arrangement that would not have been understood by the skilled addressee to have been disclosed in the original specification. Therefore the amendment to the claims adds matter, contrary to section 76.

### **Shield adaptations**

- 21 This issue is slightly different to the two previous issues, in that the phrase 'shield adaptations' is not used anywhere within the originally filed specification. The originally filed description and claims refer to '*shields*' as one of the alternative words for a shutter. There is also a brief discussion of the use within another patent of a particular type of security protection or *shielding*. The skilled addressee would therefore consider that the original application teaches that a shutter, which may be alternatively described, as a shield, can be made more aesthetically pleasing by incorporating illumination or lighting effects
- 22 It is not entirely clear what is meant by the term 'shield adaptations' within the newly filed claims. There is no definition given either within the claim or the description. The newly filed claim refers to '*shield adaptations as security equipment such as street video surveillance*'. The skilled addressee would consider the phrase 'shield adaptations' within this context. Therefore he would consider this to disclose some form of adaptation to the shield, the shield being one of the ways of referring to the shutters being used to close up shop fronts and the like, to allow security equipment to be incorporated within it.
- 23 Again on comparison, the skilled addressee would consider the amended specification to be disclosing an arrangement which he would not have considered to be disclosed within the originally filed specification. Therefore the amendment adds matter and contravenes section 76.

### **Conclusion**

- 24 I find that the amendments to the claims add matter and therefore contravene section 76 of the Act. As the period within which this application must be placed in order has now expired I refuse this application.
- 25 The last examination report raised a number of other issues, relating to novelty, inventiveness, plurality of invention and clarity of the application. Mr McKenzie did not respond specifically to these points in his submission and, as I have already concluded that the application cannot be granted due to the presence of added matter, I have not decided these points.

## **Appeal**

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

**C L Witchard**

Deputy Director acting for the Comptroller