

**PATENTS ACT 1977**

APPLICANT Arctic Circle Limited

ISSUE Whether Patent Application GB0612849.0 complies  
with the Patents Act 1977

HEARING OFFICER A Bartlett

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**DECISION****Introduction**

- 1 Patent Application GB0612849.0 entitled "A compressor" was filed on 28 June 2006 claiming an earliest priority date of 1 July 2005. It was subsequently published as GB2427902 on 10 January 2007.
- 2 The invention seeks to improve the efficiency of compressors of the sort commonly employed in refrigeration equipment, air conditioning systems or heat pumps. To this end, the compressor is provided with cylinders having bores of different diameters and thus different capacities.
- 3 In response to the examiner's objection that the claims as originally filed were not novel and inventive over the prior art, the applicant has sought to amend claim 1 to specify certain characteristics of the control system used to control the compressor. The details of that control system are contained in a co-pending application which is cross referenced in the description of the present application. However that co-pending application was not published until after the filing date of the present application. The subsequent and extensive correspondence between the examiner and the applicant's attorney, Mr Graham Jones of the Patent Attorneys Graham Jones & Company has focussed on what (if any) characteristics of the control system can be introduced into claim 1 without adding matter contrary to section 76 whilst ensuring that the specification discloses the invention clearly and completely enough for it to be put into practice by the skilled person as required by section 14(3).
- 4 The examiner and attorney having been unable to reach agreement, the matter came before me at a hearing on 1 December 2011. Mr Jones represented the applicant (by telephone) and the examiner, Mr Alastair Kelly also attended.

## The issues

5 Claim 1 as filed reads

“1. A compressor comprising cylinder bores which are of different diameters, pistons in the cylinder bores, valve plate means, and gasket means.”

6 As last amended with the agent’s letter of 25 August 2010 the claim reads:

“1. A compressor comprising cylinder bores which are of different diameters, pistons in the cylinder bores, valve plate means, gasket means, and a capacity control device for varying the bore displacement capacity of the compressor by switching cylinder bores on and off, whereby the combination of the cylinder bores being of the different diameters and the capacity control device being able to switch cylinder bores on and off enables the compressor to operate to a load profile for which the compressor is being used and not to operate at over capacity by providing greater total compressor displacements than are need for the load profile.”

7 The cross reference is included at page 5 of the description in a paragraph that reads as follows:

“A capacity control device is provided. This capacity control device (sic) described in our co-pending Patent Application No. 0513287.3 entitled A Compressor and filed 29<sup>th</sup> June 2005.”

8 The co-pending application is further discussed on page 7 in a paragraph that reads:

“By combining the compressor of the present invention with the invention of the above mentioned co-pending patent application for the individual bore capacity control, it is possible to switch various cylinder bores on and off. The varying cylinder bore sizes and therefore different displacements within the compressor, allow for the control of capacity steps, and the matching of load profile more precisely to the application the compressor is being used for.”

9 The paragraph on page 5 containing the cross reference was amended with Mr Jones’ letter dated 12 January 2011 to read:

“A capacity control device is provided. The capacity control device 28 varies the bore displacement capacity of the compressor by switching various cylinders on and off.”

10 Mr Jones accepts that the cross referenced application was not published at the filing date of the present application and that matter contained in it cannot be incorporated into the present application. There is clear case law showing that to be the case – for example in his judgment in *Halliburton*<sup>1</sup> Pumfrey J made it clear that a cross referenced document must have been published at the date of filing of the application for the reference to be effective. Where the examiner and Mr Jones disagree is whether the content of the remainder of the specification (including what is said about the cross referenced application) provide support for the proposed amendment to claim 1 and are sufficient for the skilled man to work the invention.

11 The examiner has reported that in his view the skilled reader would understand the wording of the cross reference itself and the further description of it to imply that for

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<sup>1</sup> *Halliburton Energy Services Inc v Smith International (North Sea) Ltd* [2006] RPC 2

the invention now claimed in claim 1 to work, it must employ the control system disclosed in the co-pending application. As the cross-referenced application was published too late for its contents to be incorporated into the present specification, he considers that the invention is not disclosed in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art as required by section 14(3). Furthermore the examiner has reported that an amendment which has the effect of suggesting that control systems other than that disclosed in the co-pending application could be used to implement the invention adds matter contrary to section 76. In his view the amendment to the paragraph on page 5 filed with the Agent's letter of 12 January 2011 has that affect and adds matter.

- 12 For his part, Mr Jones considers that the skilled man would not consider the specification, when read as a whole, to imply that the invention could only be put into effect using the control system of the co-pending application. Moreover he considers that the specification contains sufficient disclosure to enable the skilled man to put the invention into practice without recourse to the cross-referenced application. He also argues that as the applicant is required to remove the cross reference, it is not reasonable for the examiner to rely on its wording in determining whether the amendment to the description adds matter.
- 13 I agree with Mr Jones. First, I do not consider there to be anything in the specification as originally filed which the skilled man would understand teaches that it is essential that the compressor control system must be the one in the co-pending application. The cross reference does not categorically say it must be and whilst the passage on page 7 makes clear that it can be, there is nothing to suggest it has to be. Moreover, it is clear from the final paragraph of the description that what is described is merely an example and that modifications to that are intended to be covered. In my view the skilled man would understand the teaching of the application as a whole to be that the control system must be capable of switching cylinders on and off so that the compressor can efficiently meet current demand. I do not consider he would understand it to mean that the control system of the co-pending application must be used.
- 14 On the sufficiency point, the requirement to remove the cross reference does not extend to everything that is said about the cross referenced document in the present application. Anything that I can deduce about the content of the co-pending application from the present specification itself (and without recourse to the co-pending application) is part of the present disclosure. In this instance the description clearly discloses what the control system must do for the invention to work – it must turn the different diameter cylinders bores on and off thus allowing the compressor to meet demand efficiently. Given that information I consider the skilled man would be able to perform the invention without recourse to the information contained in the co-pending application and thus that the specification is sufficient in this respect.
- 15 As regards added matter, the applicant has been required to remove the reference to the co-pending application and I can see nothing in the consequential amendments on pages 5 and 7 that add matter to that originally disclosed.

## **Conclusion**

- 16 In my view the specification is sufficient for the person skilled in the art to be able to implement the invention now claimed without recourse to the cross referenced co-pending application. Thus in my view it is sufficient following amendment to remove that reference, an amendment necessitated by the reference not having been published at the date of filing of the present application.
- 17 I also consider that the amendments do not add matter.

## **Other matters**

- 18 A number of other aspects of examination, notably consideration of novelty and inventive step, were deferred pending resolution of the added matter and sufficiency issues. I therefore remit the application back to the examiner to complete the examination.
- 19 That the compliance period expired on 3 March 2011 would normally be something of a problem should that examination reveal that the application in its present form is not in order for grant. However I note that there was a substantial delay between the applicant's response dated 12 January 2011 and the examination report issued 1 April 2011 during which expiry of the compliance date occurred. I consider that to be an irregularity in Office procedures and exercise the Comptroller's discretion to extend the compliance period by six months from the date of this decision under rule 107(3).

## **Appeal**

- 20 Having found in the Applicant's favour this might be somewhat academic but under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal against this decision must be lodged within 28 days.

**A BARTLETT**

Deputy Director acting for the Comptroller