

PATENTS ACT 1977

IN THE MATTER OF

Patent Application GB9718677.9

in the name of

Delco Electronics Europe GmbH

DECISION

Introduction

1. Patent Application GB9718677.9 was filed on 4 September 1997 in the name of Delco Electronics Europe GmbH and published on 10 March 1999 as GB2329020. During the course of the examination procedure the claims were amended to meet novelty and inventive step objections and the description was also amended.
2. In an examination report dated 22 October 2002 objection was raised that the amendments to the description resulted in, firstly, the application disclosing matter extending beyond that disclosed at the date of filing, contrary to section 76(2), and, secondly, the claims not being supported by the description, contrary to section 14(5)(c). Further correspondence between the agent and examiner failed to resolve these matters and consequently they were considered at a hearing on 4 February 2003 at which the applicant was represented by his agent, Mr Michael Denton.

The application

3. The application relates to a system for controlling electrically operable devices. As described, the system has a panel (called a “force responsive panel”) which incorporates manually actuable devices such as buttons and touch sensitive screens. When the buttons etc are actuated, the panel transmits a corresponding force to an array of force sensors, which in turn generate signals to control electrically operable devices.
4. Two such panels are described. The first panel (referenced 26) has manually rotatable actuators and spring-biassed push buttons, each rotatable actuator having a button, offset from the axis of rotation of the actuator so that, as the actuator is rotated, the contact point between the button and the panel traces an arc of a circle. The second panel (referenced 28) has push buttons and a touch screen.
5. Claim 1 as originally filed reads:

A system for operating an electrically operable device comprising support means; a number of force sensors mounted on the support means; force responsive means in engagement with the force sensors; manually actuable means acting on the force responsive means and actuable to alter the force exerted on the force sensors by the force responsive means; means for measuring any change in force sensed by the force sensors due to manual actuation of the manually actuable means; means for determining the position of the force application on the force responsive means due to manual actuation of the manually actuable means from the measured force

change; and means for operating the electrically operable device dependent on the determined position of the force application.

6. Claims 2 and 3 as originally filed are directed to the rotatable and pushable actuators respectively.
7. In a first examination report, documents were cited for lack of novelty against, *inter alia*, claim 1 and an objection to lack of inventive step was raised against claim 3. In response to this, claim 1 was amended to include alternatives corresponding to original claims 2 and 3. In a second examination report, objection was raised that the alternative within the amended claim which corresponded to the original claim 3 did not involve an inventive step. In response to this second report, claim 1 was limited to a system “wherein the manually actuable means comprises an actuator which is manually rotatable about an axis, the actuator having a button which is offset from the rotation axis and in contact with the force responsive means”.
8. The description was also amended. The most significant amendment for the purposes of these proceedings is the replacement on page 2 of a passage which reads:

“The force responsive panel 24 may be any suitable arrangement. Two possible alternative arrangements 26, 28 for the force responsive panel 24 are shown in Figure 1.”

by a passage which reads:

“The force responsive panel 24 may be any suitable arrangement, and may include one or more panels 26, 28.”

The issues

9. In correspondence, the examiner objected that the amendments made to the description introduced added matter contrary to section 76(2), pointing out that the application as filed described the panels 26,28 as alternatives only, there being no suggestion that they might be used in combination. In support of this, the examiner cited the decision in *Flexible Direction Indicators Ltd's Application* [1994] RPC 207 where it was held that section 76 is concerned with what is disclosed, not with that which the skilled reader might think could be substituted.
10. Mr Denton responded that “It would be clearly obvious to a skilled person that any combination of features of panels 26 and 28 could be used. The fact that new claim 1 is a combination of original claims 1 and 2 also supports this position”. He also drew attention to the words of Aldous J in *Bonzel v Intervention (No 3)* [1991] RPC 553 that it is necessary, when considering whether an amendment to the description contravenes section 76, “to ascertain through the eyes of a skilled addressee what is disclosed both explicitly and implicitly in the application”.
11. The examiner also objected that the claims as amended cover panel 26 but not panel 28, whereas the amended description indicates that the system may include the panel 28 alone, thus contravening section 14(5)(c). On this issue, Mr Denton argued that “The

description has already been amended to ensure that coverage solely for panel 28 is not envisaged. Further, on reading claim 1 alone, or in combination with the description, it is quite clear that coverage solely for panel 28 is not envisaged.”

12. I shall deal firstly with the question of added matter.

The law and precedent

13. Added matter is covered by section 76 of the Patents Act 1977. Section 76(2) reads:

No amendment of an application for a patent shall be allowed under section 17(3), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.”

14. The test for compliance with section 76(2), first enunciated in *Bonzel* is quoted, with approval, in *Flexible Direction Indicators*. It requires the following steps to be carried out :

- (1) to ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly in the application;
- (2) to do the same in respect of the patent as granted;
- (3) to 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.

15. In *Flexible Direction Indicators*, having quoted this test, Aldous J went on to say at page 226 line 42 that:

“The section [ie 76(2)] is concerned with what is disclosed, not with that which the skilled reader might think could be substituted or had been omitted”

16. Mr Denton also drew my attention to a number of decisions of the European Patent Office, namely T54/82 (*Mobil*), G1/93 (*Advanced Semiconductor Products*), T583/93 (*Hymo Corp*) and T873/94 (*Toshiba*). The examiner also cited T685/90 (*Fujitsu*). I note that, although section 76 is not one of the sections of the Act included in section 130(7) as being so framed as to have, as nearly as practicable, the same effects in the UK as the corresponding provisions of the European Patent Convention, it is generally accepted that section 76 should be construed in conformity with articles 123(2) and (3) of the Convention.

17. *Mobil*, which is concerned with what might be implicitly disclosed when a range of compounds is described, teaches that there is nothing in the European Patent Convention which prohibits in all circumstances the reading together of different parts of a single document. In brief, the disclosure in one example of a C18 alkenylsuccinic bis-oxazoline and in another example of a C18-24 dimer alkenylsuccinic mono oxazoline was held implicitly to disclose a C18-24 alkenylsuccinic bis-oxazoline.

18. *Toshiba*, which is concerned with the relationship between parent and divisional applications, teaches that the applicability of the so-called “novelty test” (see below) in relation to article 123(2) always depends on circumstances, the underlying principle being that a proprietor should not be allowed to improve his position by adding subject matter which could be damaging to the legal security of third parties. In this case it was considered that it would be plain to a skilled person that a component used in one embodiment could advantageously be used in another.
19. The “novelty test” referred to in *Toshiba*, is explained in the *Guidelines for examination in the EPO*. Part C, Chapter VI, 5.4 states, when considering the question of added matter:

“At least where the amendment is by way of addition, the test corresponds to the test for novelty given in IV, 7.2”

and Chapter IV, 7.2 states:

“A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document.... Thus, when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the documents; this is a matter for obviousness.”

20. Having regard to the “novelty test”, Mr Denton’s attention was drawn by the examiner to the *Fujitsu* decision. Here the Board of Appeal stated that, because the application as originally filed constitutes part of the state of the art as regards later applications, it must be construed as it would be under the law of novelty, that is taking into account its whole disclosure, express or implied, but not considering subject-matter obvious over this. The examiner considered that the “novelty test” quoted in *Fujitsu* supported the case for there being added matter since it too was concerned with what is derivable directly and unambiguously from the document as filed.
21. Finally I turn to the *Hymo* and *Advanced Semiconductor* decisions. The *Hymo* decision is concerned with narrowing a claim by adding a feature previously described as optional. The *Advanced Semiconductor* decision relates to extending protection by deleting a feature from a claim. Since no objection lies against any of the claims in the present application as they stand, I find no assistance at all from these particular authorities.

Argument

22. At the hearing Mr Denton maintained that, having amended the claims by combining the original claims 1 and 2, he was entitled to amend the description to bring it into agreement with the claims and remove any ambiguity; and, in his view, this was what the amendments did. Furthermore he argued that, following *Mobil* and *Toshiba*, it was permissible to “mix and match” different parts of the description. In this respect, in support of the amendments made, he drew particular attention to the passage at page 3 lines 4 to 6 of the application as filed which reads:

“Any suitable combination of rotatable and pushable actuators and touch screens may be used in the force responsive panel 24 of the present invention”.

23. He also maintained that, whilst in the application as filed there was no explicit disclosure of more than one panel, two panels were *implicitly* disclosed, and he drew attention to the drawings which show two panels.

Analysis

24. I turn first to the *Bonzel* test, the first step of which requires me to look carefully at the application as filed. The last paragraph of page 2 of the description states that panels 26,28 are “alternative arrangements for the force responsive panel 24”. It goes on to state that the first panel 26 has both rotatable and pushable actuators and the second alternative arrangement, panel 28, has pushable actuators and a touch screen. It then states that any suitable combination of actuators and touch screens may be used in the force panel. In this respect, the original description is quite clear and unambiguous - there is a force panel 24 and it may take the form of *either* the panel shown at 26 *or* the alternative panel shown at 28.

25. I also consider that the passage to which Mr Denton drew my attention is clear - there may be a combination of rotatable and pushable actuators and touch screens but they are positioned on a single panel 24. Mr Denton considered that the drawings provide some support for his assertion that there is implicit disclosure of more than one panel but I do not accept this argument since the description and drawings when read together clearly show the two panels as alternatives. Hence, in my view, only a system with a single force panel 24 which may take the form of the panel 26 or 28 is clearly and unambiguously described in the original document. There is therefore no explicit disclosure of a combination of panels; and moreover I am not persuaded that there is anything in the application as filed to *imply* that such a combination is envisaged, that is to say I can see no implicit disclosure either.

26. Applying the second part of the test, I turn to the amended passage in the description which reads:

“The force responsive panel 24 may be any suitable arrangement, and may include one or more panels 26, 28.”

27. This passage may be notionally rewritten without, it seems to me, any alteration in meaning as follows :

“The force responsive panel 24 may be any suitable arrangement, and may include panel 26 or panel 28 or a combination of panels 26 and 28.”

28. This then is an explicit disclosure that the system may include two panels 26 and 28. Applying the comparison specified in the third part of the test, I consider that such a concept is not clearly and unambiguously disclosed in the application as filed, either explicitly or implicitly, and thus its introduction results in matter being added, contrary to section 76.

29. As made clear by Aldous J in the passage from *Flexible Direction Indicators* quoted above, the question to be addressed is what is disclosed, not what the skilled man might think. That is to say it is not a question of what is obvious to the skilled man. It may or may not be obvious to the skilled man reading the application as filed to use a combination of panels, but that is irrelevant; what is relevant is that there is no explicit or implicit disclosure in the application as filed of a combination of panels.
30. I turn next to Mr Denton's argument that following *Mobil* and *Toshiba*, it is permissible to "mix and match" different parts of the description. There is no dispute in the light of the passage at page 3 lines 4 to 6 of the application quoted above that there is implicit disclosure of a single panel which incorporates any of the features shown in either of the panels 26 and 28, provided, of course, that it includes a rotatable actuator as required by claim 1; and indeed this is arguably on all fours with the decisions in *Mobil* and *Toshiba*. However I do not think that this case law allows extrapolation from a single panel to two panels since, rather than involve reading across features from one embodiment to another, such an amendment would require the *combining* of different embodiments.
31. I turn next to the EPO "novelty test". *Toshiba* refers to what the text of a specification would make plain to a skilled man and states that this *could* legitimately be added, and indicates that a "novelty test" will not always be appropriate in order to determine whether an amended application contains added matter but will depend on the circumstances of the case. EPO case law has not been consistent in this respect however. For example *Fujitsu* states that the question of added matter must be construed as it would be under novelty, what a "hypothetical expert" might have thought did not affect what the application as filed disclosed or implied. Whilst I am required to give consideration to EPO case law I am not bound by it, and in instances such as *Toshiba* where the novelty test is not strictly applied, EPO case law appears to be in direct conflict with the established UK case law by which I am bound.
32. However at the hearing, Mr Denton agreed that the "novelty test" was indeed an appropriate test to apply. It was also agreed at the hearing that the "novelty test" involved determining whether or not the application as amended could destroy the novelty of a claim which would not be destroyed by the application as filed. Mr Denton felt that his amendment satisfied the "novelty test" in that the combination of panels was implicitly disclosed in the application as filed. However, on the basis of the conclusions I have already reached, I find that whilst the application as filed would not destroy the novelty of a claim requiring two panels, the application as amended could do so. Thus application of the "novelty test" leads me to the same conclusion as the test in *Bonzel*, namely that section 76(2) is contravened.
33. Finally on Mr Denton's argument that he is entitled to amend the description to bring it into agreement with the claims and remove any ambiguity, I think the key issue here is that whilst amendment to the description may be made which *falls within* the scope of the claims, that may not necessarily satisfy the requirements of section 76. As discussed at the hearing for instance, a system with ten panels would fall within the scope of claim 1 as amended but, as I think Mr Denton agreed, would indeed contravene section 76. Similarly, whilst I do not think there can be any doubt that the amendment to the description relating to a combination of panels clearly falls within the scope of claim 1 as

amended, equally to my mind and for the reasons I have already given there is no doubt that the amendment contravenes section 76 by introducing new matter.

Section 14(5)

34. I turn finally to the question of support under section 14(5). I do not think I need to go into any great detail here. Mr Denton agreed at the hearing that the description as amended includes panel 28 alone, and that this does not incorporate a rotatable actuator as now required by claim 1. It follows inevitably it seems to me that section 14(5)(c) is contravened.

Conclusion and next steps

35. I have found that the description as amended discloses matter extending beyond that disclosed in the application as filed, contrary to section 76(2). I have also found that the claims are not supported by the description as amended, contrary to section 14(5)(c).
36. Clearly it is possible for the application to be amended to rectify this. The normal period for putting the application in order has been extended, for reasons which are not material to this decision, to 1 February 2003. This period has been extended by one month under rule 110(3), and is automatically extended under section 20(2) until the end of the appeal period specified below. The applicant has until then to submit amendments to meet the objections outstanding under section 76(2) and section 14(5)(c). If such amendments are not filed I shall refuse the application.

Appeal

37. This being a decision other than on a matter of procedure, the period for appeal is six weeks from the date of this decision.

Dated this 17th day of February 2003

DAVID BARFORD

Deputy Director, acting for the Comptroller

THE PATENT OFFICE