

PATENTS ACT 1977

IN THE MATTER OF

an application under section 27

by Martin Clive-Smith

in respect of patent no. GB 2295381

DECISION

Introduction

1. UK Patent No. 2295381 in the name of Martin Clive-Smith (hereafter referred to as the "proprietor") was filed on 24 October 1995 under application No. GB 9521798.0 claiming priority dates of 24 October 1994 and 11 October 1995. The patent was granted on 29 May 1996. It relates to a platform based cargo carrier for use with shipping containers which are known as "collapsible flatracks".

Matter to be resolved

2. The Comptroller has been requested to exercise discretion with regard to the allowability of an application by the proprietor under section 27 to make amendments to the granted specification, the amendments being to almost every line of the description, most of the drawings, and many of the claims.

Background

3. On 29 October 1997 the pre-grant Examiner issued an official report under section 18(3) which raised outstanding issues of clarity and support. Amendments to the application and observations in response to the Examiner's report were subsequently received by the Patent Office in a letter dated 29 April 1998; favourable re-consideration of the application was requested in the light of these submissions. The Examiner considered that the amendments were suitable to overcome the outstanding objections and put the application in order for grant on 13 May 1998. A Notification of Grant letter was despatched by the Patent Office on 15 May 1998.

4. In a letter dated 1 June 1998, the agent for the proprietor advised the Patent Office that, for greater clarity and linguistic correctness, minor editorial amendments to the description of the application would be submitted as a voluntary amendment within a few days and requested that publication (of the B specification) be postponed. On 3 June 1998 a Formalities Examiner discussed the matter with the agent and, since the grant letter had already issued, advised that the application would be advertised as granted on 17 June 1998 and that a copy of the "B" publication and the certificate of grant would be forwarded to the proprietor on that date. Any correspondence from the proprietor would be considered after 17 June 1998.

5. On 16 June 1998 a formal request for amendment was received on Form 11/77 which included a copy of the amended specification and drawings and a copy of the granted specification and drawings with manuscript amendments.

6. Since there has been a significant exchange of correspondence between the Patent Office and the proprietor concerning the allowability of the amendments, it should to my mind be highlighted. In response to the request, the post-grant Examiner referred to the extensive nature of the amendments and reported that the reason for requesting amendment of the specification under section 27 did not seem to be sufficient. In particular, the Examiner was of the opinion that the amendment requested to claim 1 was more extensive than the reasons given for amendment on Form 11/77, viz. "enhanced clarity, linguistic correctness and correction of minor errors, obscurities or inadequacies, typographical errors or obvious submissions", in that it involved deleting two significant features of the claim. As a result, the Examiner requested fuller particulars of the reasons for requesting the amendment of the specification. The Examiner also pointed out that such an amendment to claim 1 would not be allowed under section 76(3) in that it appeared to add subject matter.

7. The agent filed observations in a letter dated 25 August 1998 seeking re-consideration of the proposed amendment to claim 1 by the Examiner, though advising that there was preference for withdrawal of the amendment rather than have the proposed claim amendment open to misinterpretation. The agent commented that no adverse comment had been made by the Examiner concerning the proposed editorial amendments to the description. In response, in a letter dated 28 September 1998, the Examiner reiterated that the proposed amendments to claim

1 appeared to add matter and that the reasons given for making the amendments were not sufficient to justify the proposed amendments. Furthermore, even if the proposed amendment to claim 1 were not considered to add matter, it would not be allowable since the proposed amended claim 1 was considered to be neither novel nor inventive. The preliminary view of the Examiner was that the Comptroller would not exercise his discretion to allow the amendments without good reason being given. The Examiner also drew the proprietor's attention to **Clevite Corporations Patent [1966] RPC 199**, in which it was held that the Comptroller "is entitled to know what inspired the wish, when he is asked, as he is by this application, to give effect to it by a grant of privilege" and to **Waddington's Ltd's Patent [1986] 158** in which the hearing officer also supported the view that a request to amend under section 27 is discretionary and compliance with section 76 is not itself necessarily sufficient.

8. In a letter dated 26 October 1998 the agent informed the Patent Office that the proposed claim amendments were withdrawn but the proposed editorial amendments to the description would be retained. Since the Examiner was still of the opinion that the reason for requesting amendment of the specification under section 27 did not seem to be sufficient, the applicant was offered an opportunity to be heard before the Comptroller in a letter dated 20 November 1998.

9. The agent for the proprietor contended in a letter dated 18 December 1998 that the amendments were essentially of a straightforward nature, their purpose intuitively apparent and so their allowability should be readily resolvable, without undue scrutiny or administrative burden. A hearing did not seem warranted: should some or all of the amendments be deemed allowable, it was envisaged that they would be effected (subject to advertisement); any non-allowable amendments would be withdrawn. The agent was content for the matter to be determined by the Comptroller on the papers.

10. Following further consideration of the request to amend under section 27, certain points were reported to the proprietor for his consideration in an official letter dated 2 March 1999. In particular, the point was made that no technical or legal defect had been identified in the specification which warranted addressing by the proposed amendments. Also, an application under section 117 might be a more appropriate course for the disposal of some of the proposed amendments. It was acknowledged that the proposed amendments to the claims were withdrawn

by the proprietor and that the Comptroller could entertain a request to correct the specification under section 117. It was further pointed out that the pre-grant Examiner at no stage during the processing of the patent application prior to grant appeared to have been concerned with lack of clarity or understanding of the specification and its invention. The post-grant Examiner also reported my preliminary view that the request to make the amendments, which involves the Comptroller's discretion, should not be allowed, regardless of whether or not section 76 is contravened by one or more of the proposed amendments.

11. In response, the agent sought to preserve the option of the consideration of the proposed amendments as corrections under section 117 rather than as amendment under section 27 and suggested that the Patent Office draw up a tentative list of what would qualify as corrections under section 117. Those which were considered tenable would stand and those which were not could be withdrawn.

12. After careful consideration of the agent's comments, the Examiner reported in a letter dated 13 May 1999 that the onus was on the proprietor to list any corrections and supply the list to the Patent Office. The Examiner gave the proprietor one month in which to identify the corrections and indicate further action to be taken regarding the remaining proposed amendments. If, at the end of one month, the request to amend under section 27 was not withdrawn, then the hearing officer would decide whether or not the Comptroller should exercise his discretion to allow amendments to go forward for a full investigation as to their allowability in the absence of a sufficient reason for proposing the amendments.

13. The agent for the proprietor made further submissions in a letter dated 11 June 1999 and confirmed that a written ruling upon whether the Patent Office was inclined to exercise discretion in this instance would be acceptable and would forego an opportunity to be heard.

The law

14. Section 27(1) of the Patents Act 1977 states as follows:

“Subject to the following provisions of this section and to section 76 below, the comptroller may, upon an application made by the proprietor of a patent, allow the

specification of the patent to be amended subject to such conditions, if any, as he thinks fit.”

It is clear that the Comptroller’s power to allow amendment is discretionary.

The issues

15. Since amendment may be refused if the Comptroller considers the application undeserving in the circumstances, I have first to decide which circumstances I should consider in the present case. It seems to me that they are (1) has there been undue delay in applying for amendment once its desirability had become known or should have become known to the proprietor, (2) are the reasons for making the amendments sufficient, and (3) do the amendments cure any defect which prompted the formal application to amend.

16. Form 11/77 states that the amendment consists of various editorial amendments which are shown on a copy of the specification and that the reason for requesting the amendments is for “enhanced clarity, linguistic correctness and correction of minor errors, obscurities or inadequacies, typographical errors or obvious omissions”. The amended copy of the specification includes amendments to almost every single line of the description, amendment to claims 1, 5, 10, 14, 16 - 18, 20, 29, and 31 - 34, and amendment to figures 2 - 6 and 8 of the drawings. Since the proposed amendments include re-phrasing, re-paragraphing, amendment of terms and expressions and correction of obvious errors of transcription, the first impression of the amended description is that it has been completely re-drafted.

17. Amendment of the specification was always open to the proprietor during processing of his patent application as a voluntary amendment. However, at no time prior to the issue of the grant letter did the proprietor indicate that he wished to submit voluntary amendments to enhance clarity and obscurities before grant of the specification. Likewise, at no time during the processing of the patent application to grant did the pre-grant Examiner object to such a lack of clarity and obscurity in the description as to invite the proprietor to make such extensive amendment.

18. It is clear upon reading the specification that there are some errors of transcription, clerical errors and mistakes that were not rectified before grant of the specification. Therefore, it may be argued that the reasons for some of the proposed amendments, ie. those that correct obvious errors and mistakes, are sufficient. The reasons for amending claim 1 on Form 11/77 are insufficient and have not become evident during the exchange of correspondence between the proprietor's agent and the Patent Office.

19. With regard to the curing of any defects in the specification, these have only been identified in general terms in the sense that the proprietor wishes to obtain enhanced clarity, linguistic correctness, and correction of minor errors, obscurities or inadequacies, typographical errors or obvious omissions. However, no single specific defect has been identified.

Summary of decision

20. With regard to the timeliness of the request, although the proprietor applied immediately after grant of the specification, no indication was given as to when the proprietor first became aware of the defects in the specification that the amendments were intended to cure. Indeed, throughout the processing of the patent application only the statement of claim had been amended. The description has remained as it was originally filed on 24 October 1995 and was published as filed. However, I am aware that on 19 March 1998 Lewis & Taylor advised the Patent Office that they no longer wished to act for the proprietor and that on 28 April 1998 Tillbrook & Co filed a Form 51/77 informing the Patent Office that they were the new address for service. It was subsequent to this change of agent that the application to amend was requested though there was still no indication as to when the proprietor first became aware of the defects in the specification.

21. Since I am of the opinion that the reasons given for making the proposed amendments pertain more to the correction of errors in patents and applications under section 117 of the Patents Act 1977 than amending the specification after grant under section 27 of the Act, I find that the reasons given for amendment are insufficient. This is particularly so with regard to the request for the amendment of claim 1.

22. With regard to the issue of the amendments curing a defect, the post-grant Examiner has already stated in correspondence that the granted patent was not an unclear document, had not been shown to be defective, and that the skilled public would not have any difficulty in understanding the matter disclosed in the patent specification. Upon reading the specification I concur with the Examiner's opinion.

Conclusion

23. In the light of the above summary, I am of the opinion that the Comptroller's discretion should not be exercised in this particular case. However, should the proprietor wish to apply for correction under section 117 of the errors that have been identified by the post-grant Examiner in the official letter dated 2 March 1999 then the application will be duly considered by the Examiner.

Appeal

24. Finally, the period within which any appeal to the Patents Court from this decision must be lodged is 2 weeks from the date of this decision.

Dated this 6th day of September 1999

D J JERREAT

Deputy Director, acting for the Comptroller

THE PATENT OFFICE