

PATENTS ACT 1977

IN THE MATTER OF

an application under section 27

by Peter Antony Hulmes to amend

Patent No 2185221 in the name of

Peter Antony Hulmes

DECISION

Background and History

Patent No 2185221 entitled "Safety aero turbo of opposite handed rotational inertial torques" was granted on 29 December 1988 to Peter Antony Hulmes. On 15 September 1997, Mr Hulmes filed Form 11/77 to amend his patent under section 27, the reasons given being "for clarity betterment by sketch updatings" and "to ensure aero jet technologies do not fall behind 1986 filing date to help martian sojourner to walking vehicle initiative". Accompanying Form 11/77 were pages indicating Mr Hulmes' proposals to amend both the description and drawings of his patent.

These proposals were considered by an examiner and it was reported in an Official letter dated 15 October 1997 that in his opinion some amendments were allowable and others were not as they disclosed new matter. The letter invited Mr Hulmes to withdraw those proposals considered not allowable, or to submit observations.

In response, Mr Hulmes filed a fresh set of proposals, this time including amendments to the claims as well as to the description and drawings. These were received in the Patent Office on 3 November 1997. A further document, apparently indicating further proposals, was received on 11 November 1997. These two sets of proposals differed from one another in several respects

and, in an Official letter dated 11 December 1997, the examiner reported that, so far as he could understand Mr Hulmes' intentions, again some of the amendments were allowable and others were not as they added matter. Unfortunately, this letter crossed with yet another set of proposals received from Mr Hulmes on 24 November 1997.

In a letter dated 13 December 1997, Mr Hulmes appeared to reject the examiner's opinion regarding the non-allowability of some of his proposals and in a further document filed 22 December 1997, he sent in more proposals for amendment.

The examiner discussed the situation with Mr Hulmes on the telephone on 6 January 1998 and an Official letter followed on 14 January 1998 explaining relevant patent legislation governing allowability of post-grant amendment under section 27 and again reporting that, in the examiner's opinion, Mr Hulmes' latest proposals were allowable only in part. The letter also referred to Mr Hulmes' right to withdraw all or some of his proposals, to comment on the examiner's observations or to have the matter decided at a hearing.

On 19 January 1998, the Office received a letter and enclosures from Mr Hulmes which apparently amounted to a further rejection of the examiner's opinion regarding the latest proposals. Further documents received on 12 and 26 February 1998 seemed to imply that Mr Hulmes might abandon the application to amend his granted patent.

On 13 March 1998, the Office received another letter from Mr Hulmes about the application to amend his patent. The letter is difficult to follow and this is reflected in the Official letter of 25 March 1998 issued in response which indicated that, as far as the examiner could understand matters, it seemed that Mr Hulmes' intended to proceed only with the textual amendments previously indicated as allowable under section 27, and not with the amendments to the drawings. A copy of the patent specification amended on this basis was enclosed with the Official letter which also mentioned that the amendments would be advertised in the Patents and Designs Journal in the normal way unless Mr Hulmes responded within two weeks of the date of the letter.

On 6 April and 13 May 1998, the Office received more documents from Mr Hulmes including further copies of his patent specification indicating previously proposed amendments. Neither of

these communications appeared to rebut the assumption that Mr Hulmes' intention was to proceed only with the textual amendments previously indicated as allowable. Accordingly, these amendments were advertised in the Patents and Designs Journal on 10 June 1998, and no opposition to them has been received.

It is convenient to mention at this stage that Mr Hulmes had sent a letter of complaint to the comptroller under the Patent Office's "Box 49" complaints procedure on 21 May 1998. While acknowledging the help he had received from the Office, he nonetheless expressed concern at the difficulties he was experiencing with the application to amend his patent. This was treated in the Office as a rejection of the previous assumption that Mr Hulmes' had abandoned his proposals to amend the drawings. Accordingly, the examiner reconsidered the latest version of the drawings, which had been received on 13 May 1998, and it was reported in an Official letter dated 15 June 1998 that in the examiner's opinion they were not allowable as they included detail of airframe constructions and of the turbine and compressor constructions which were not present or disclosed in the patent as granted. A hearing was offered to resolve the matter.

Mr Hulmes returned annotated copies of this Official letter, which were received on 25 June and 1 July, the annotations appearing to indicate that he did indeed wish to proceed with his proposals to amend the drawings. Accompanying documents included further text and drawings but none of these appeared to amount to further proposals to amend his patent specification. Two further items of correspondence were received subsequently, the last being dated 26 August 1998, but again, neither appears to make further proposals for amendment.

A fundamental difference of opinion having been reached between Mr Hulmes and the examiner regarding the allowability of the proposed amendments, a hearing was appointed for 8 October 1998 to decide the matter. In the event, Mr Hulmes did not attend on the appointed day and it now falls to me to decide the matter on the papers.

Relevant Law

Amendment of the specification of a granted patent at the request of the proprietor, is governed by section 27 of the Patents Act 1977, the relevant part for present purposes being sub-section (1) which reads as follows:

"**27.**-(1) Subject to the following provisions of this section and to section 76 below, the comptroller may, on 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."

The "following provisions" referred to in this sub-section relate to amendment where there are proceedings pending before the court or the comptroller, to the effect of an amendment made under section 27, to amendment by the comptroller to acknowledge a registered trade mark, and to opposition under section 27. None of these provisions concern us here.

Section 76, referred to in section 27(1), has three sub-sections, the first two of which are not relevant to the present proceedings as they relate to amendment of patent applications rather than granted patents. However, sub-section (3) is relevant and reads as follows:

"**76.**-(3) No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it -

- (a) results in the specification disclosing additional matter, or
- (b) extends the protection conferred by the patent.

It follows from section 27(1) and section 76(3) that the comptroller may, on an application made by a proprietor, allow the specification of a patent to be amended only if it does not result in the specification disclosing additional matter, and does not extend the protection conferred by the patent.

The word "may" in section 27(1) makes it clear that the comptroller is not compelled to allow amendment but may do so in the exercise of discretion. It is settled practice that discretion is exercised only if the proposed amendments effect a proper cure for a defect which they are intended to rectify. I interpret the reasons given by Mr Hulmes on Form 11/77 for requesting amendment to mean that he wishes to rectify obscurities in his patent specification.

Allowability of Amendments to the Text

In correspondence with the Patent Office Mr Hulmes has submitted many different proposals for amending the text of his patent specification. Some of his later proposals appear to contradict earlier ones thus making it difficult to ascertain exactly which amendments Mr Hulmes wishes to make. The Official letter of 25 March 1998 indicated that, except in three specific instances, the textual amendments proposed by Mr Hulmes on 22 December 1997 were allowable and proposed that he should proceed on the basis of the allowable amendments. The letter invited him to respond within two weeks if this did not meet with his approval. No clear rebuttal was forthcoming either within the two week period, or indeed afterwards, and although further documents were received subsequently, none appeared to put forward new proposals for amendment to the text.

I am satisfied, therefore, that Mr Hulmes is content for the textual amendments indicated as allowable in the Official letter of 25 March 1998 to be made to his patent specification. These were advertised in the Patents and Designs Journal dated 10 June 1998 and no opposition to them has been received. These amendments will accordingly be effected in the granted specification.

For completeness, I have considered the three specific amendments which in the opinion of the examiner were not allowable.

The first of these concerns the opening sentence of the specification which reads:

"Since the development of the aero engine in 1908 and the jet engine in 1943 flight safety using mono-propulsive units has been untenable technically and aerodynamically."

Mr Hulmes proposed in documents filed on 22 December 1997 that "1943" be replaced by "1923".

There is a great deal of debate concerning the history of the jet engine and various dates have been quoted for the many important developments that have taken place over the years. The patent specification is not specific about which particular development in jet engines it is referring to in its opening sentence and so it is not possible to ascertain the veracity of the date quoted or whether the reader would be confused by it. Accordingly, I am not satisfied that changing "1943" to "1923" would provide any clarification of the sentence in question, or indeed of the specification as a whole. It follows that the proposed amendment fails to effect a proper cure for a defect and, for this reason, I decline to exercise the comptroller's discretion to allow it.

The second amendment was proposed in claim 6. Following an earlier proposal for amendment which the examiner has allowed, the claim reads:

"6. An aeroplane according to any of claims 1 to 5 having an even number of engines eg two, four."

In the documents filed on 22 December 1997, Mr Hulmes proposed to make further amendments by changing the words "eg two, four" to read "ie two, four, eight.."

I do not consider that claim 6 is in any way unclear or inadequate in the absence of this further amendment. It is clear from the wording of the claim that a two-engined and a four-engined configuration are examples of even numbers of engines, and that other configurations would be possible, including an eight-engined configuration. However, that is not a valid reason for allowing the claim to be amended after grant to specifically include the possibility of an eight-engined configuration. Moreover, it could be argued that the amendment proposed would disadvantage Mr Hulmes as it would exclude, for example, six-engined configurations from the ambit of the claim. Accordingly, I again decline to exercise the comptroller's discretion to allow the proposed further amendment.

The third amendment was proposed in claim 8 which reads:

"An aeroplane according to any preceding claim wherein the engines are pure jet engines".

Mr Hulmes proposed to add the words "eco green" after the word "pure".

In the context of claim 8, "eco green" connotes some form of special ecological design of jet engine. As the patent specification in its originally filed form makes no mention of ecological considerations in the choice of jet engine to be used, I am satisfied that the proposed amendment would result in the specification disclosing additional matter contrary to section 76(3)(a). Such amendments are not allowed under section 27(1) and I therefore find that this amendment is not allowable.

Allowability of Amendments to the Drawings

I now turn to Mr Hulmes' proposals for amending the drawings of his patent specification. The various items of correspondence which Mr Hulmes has sent to the Patent Office have included several different proposals for amending the drawings. I have reviewed them all, and I am satisfied that the set of nine sheets of drawings which Mr Hulmes filed on 13 May 1998 represent the latest version of his proposals.

In order to reach a decision as to whether these proposals are allowable, I have studied all nine sheets in detail in the light of what was originally disclosed in the drawings, description and claims of Mr Hulmes' patent specification. Taking each of the proposed sheets of drawings in turn:-

Sheet 1/9: All four new drawings on this sheet differ from the originals in the overall aeroplane design. The number of blades is different on the propellers shown in Figure 1(a) and there is additional detail added to the tailplane shown in Figures 1(c) and 1(d). Whilst the number of blades might be trivial, the overall aeroplane configuration and the tailplanes are unusual. There is nothing in the original disclosure to suggest, either explicitly or implicitly, the different aeroplanes, the number of blades or the tailplanes shown in the proposed drawings. I am therefore led to the conclusion that they add matter contrary to section 76(3)(a).

Sheet 2/9: This sheet comprises two new drawings which show a different aeroplane of unusual configuration. There is no basis for this design anywhere in the original disclosure and I therefore find that these drawings would also add significant matter.

Sheet 3/9: This sheet depicts five aeroplane drawings whereas the original showed only one. The new drawings again illustrate different, unusual aeroplane designs. The text "unbreakable perspex wing section" also appears on the new sheet. As neither the new aeroplane designs nor the new text was disclosed originally, I find that this sheet of drawings adds matter.

Sheet 4/9: This sheet is to do with the blades of a turbine used in the invention. The original drawing was extremely diagrammatic. The new drawing has more detail about the shape of the blades and the manner of their attachment, and shows a relationship between the parts originally shown as "cams" and "rockers". Whilst these changes are possibly on the edges of what a skilled man might have read into the original drawing, I consider that there is significant added matter, particularly since the original text did not explain the drawing at all.

Sheet 5/9: The changes here are to do with the overall aeroplane design, the new drawings showing unusual configurations. There is nothing in the original disclosure to suggest these configurations, either explicitly or implicitly, and accordingly I find that sheet 5/9 adds matter.

Sheet 6/9: Again, I am drawn to the conclusion that the new drawings add matter inasmuch as they show different, unusual aeroplane configurations, and include some detail, not originally present, of the number and shape of the turbine blades.

Sheet 7/9: The new drawings depict turbine construction in far greater detail than did the original drawings and the blade attachment ends are of a different shape. As in Sheet 4/9, the original sheet was rather more diagrammatic, and there is nothing in the original disclosure to assist in giving basis for the more detailed constructions shown in the proposed drawings. I therefore find that Sheet 7/9 adds matter.

Sheet 8/9: This sheet is to do with the construction of a compressor used in an engine for the invention. As there is no basis in the original document for the proposed amendments which show the compressor blades in significantly greater detail, I find that there is added matter.

Sheet 9/9: The differences here are in the overall aeroplane configuration which is unusual and which was not originally disclosed. Again I find that this constitutes added matter.

As I have found that each of the proposed new sheets of drawings would add significant matter in contravention of section 76(3)(a), I find that none of them are allowable amendments under section 27.

Summary

In summary, I have considered the three amendments to the text of Patent No 2185221 which were proposed by Mr Hulmes on 22 December 1977, and which were reported to be not allowable in the Official letter of 25 March 1998, are I have found that they are not such as may be properly made under section 27. I have therefore refused to allow them. The remaining amendments to the text, which were reported to be allowable in the Official letter, will be made to the patent specification in due course.

I have also considered the proposed new sheets of drawings submitted by Mr Hulmes on 13 May 1998. I have found that each would add significant matter in contravention of section 76(3)(a) and that therefore they are not allowable amendments under section 27.

Appeal

This being a technical matter, the time within which an appeal can be lodged against my findings is six weeks from the date of this decision.

dated this 22nd day of October 1998

P E REDDING

Principal Examiner, acting for the Comptroller

PATENT OFFICE