



BL O/155/06

19<sup>th</sup> June 2006

## PATENTS ACT 1977

APPLICANT                      Martin Anthony Mckenzie

ISSUE                              Whether patent application number  
GB0308071.0 complies with section  
14(3)

HEARING OFFICER              B Westerman

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## DECISION

### Introduction

- 1      Patent application GB0308071.0 was filed on 8 April 2003, by Mr. Mckenzie, who is prosecuting the case on his own behalf. It was subject to a combined search and examination procedure, and many exchanges of correspondence have taken place since between the examiner and Mr. Mckenzie.
- 2      A particular issue was raised by the examiner during this correspondence, upon which no agreement could be reached, and so a hearing was offered, which Mr Mckenzie accepted, but he agreed that the decision be taken on the basis of the papers on the file.
- 3      I have therefore studied the entire contents of the file. There has been much more correspondence than usual, and it is very clear to me that the examiner feels that there are a number of issues to be dealt with before a patent could be granted. However, I am being asked to decide only one of these – whether the description satisfies section 14(3) of the Patents Act 1977. To be absolutely clear, I will not consider the other issues to do with whether or not the application is suitable to be granted, which will remain to be resolved.

### The application and the issue

- 4      The application as filed is entitled “Integrated multifunctional translucent and/or tinted translucent roof and windows adaptation for a road vehicle and the like”.  
I think it will help to put the current issue in context if I recite matter claimed at three significant stages of the application.
- 5      At the date of filing, a description was filed together with a set of 35 claims, one independent (claim 1), and the rest referring back to claim 1. The original claim 1 states:

“An integrated, multi functional, transparent and/or tinted translucent, illuminate roof, windows assemblies, of any suitable materials e.g. plastics and/or safety glass of which may also include the entire body members of a vehicle having size, shape, and configuration to harmoniously form a new range of illuminate vehicle body designs for the 21<sup>st</sup> century.”

- 6 Prior to A publication, amendments to the claims were filed, which in the usual way were published together with the original claims. This amended claim 1 (again, the only independent claim) reads:

“An integrated, multifunctional transparent and/or tinted translucent roof, windows\screens adaptations module for a vehicle or suitable building manufactured of any suitable materials which can include for example a tilt-up only sun-roof adaptation wherein all of the component parts of the sunroof is specifically manufactured of transparent and/or tinted translucent materials.”

- 7 Finally, Mr. Mckenzie, in his letter dated 22 February 2006 suggested two alternative independent claims which are current at the moment and read:

“A. An integrated multifunctional translucent or tinted translucent roof and at least one aperture module for a vehicle or building comprising a translucent or tinted translucent roof structure supporting at least one translucent or tinted translucent fixed or moveable roof panel member”

“B. An integrated multifunctional translucent or tinted translucent roof module for a vehicle, or building comprising and supporting at least one translucent or tinted translucent fixed or moveable roof panel member, and including at least one roof aperture for a moveable sunroof member.”

- 8 The examiner has objected that those parts of the claims filed subsequent to the original filing referring to the applicability of the construction of the invention to a building, rather than a vehicle, are not allowable since they contravene section 14(3) of the Act. The examiner says that, whilst the original description included reference to buildings, the detailed description of the invention all related to constructions in vehicles, and it does not provide the reader with enough information to construct a building, rather than a vehicle, embodying the invention.

- 9 Mr. Mckenzie, on the other hand, points to a list of places in his application where he says the application to a building is mentioned. Referring to the pagination of the A publication, these are: page 1, from line 6; page 1, Summary of invention; and page 2 line 7, which he says “describes features of a vehicle or body panel design where appropriate”. He also relies upon dictionary definitions of the word “Panel” and “Window”. He has made repeated an strenuous submissions that this was always his intention and should not be disallowed.

- 10 He also mentions, in a electronic mail dated 26 May 2006, the possibility that his application could be relevant to the examination of a later application. I do not consider that this is relevant to the issues I am considering here, but have passed a copy of this mail for consideration by the examiner on that other case.

### **The Law**

- 11 Objection has been taken under section 14(3), which states:

*“14(3) The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.”*

- 12 It is clear, from section 125, that the invention is that specified in the claim or claims of the specification. Whilst recourse may be had to the description, in this section this is stated to be to interpret the claims.
- 13 Because Mr. Mckenzie has no professional representation, I should also make clear that section 72(1)(c) would allow any third party to apply for revocation after grant on the same grounds as section 14(3).
- 14 I am also conscious of the long-established principle that, at this stage of the life of a patent application, I should exercise the benefit of any real doubt in favour of the applicant.

### **Assessment**

- 15 I am aware that there have been cases considering section 14(3) before the courts over the years. The examiner, in expressing the objection has not referred specifically to any of these. This in my view in the context of this case was the right thing to do since most of the cases, and certainly the most recent ones, have been complicated chemical cases where the difficulty of understanding the subject matter would only have complicated this issue for Mr. Mckenzie.
- 16 However, in considering section 14(3), I think it is helpful to quote the succinct expression of the law contained in Lord Hoffman’s speech to the House of Lords in the decision in *Kirin-Amgen Inc v Hoechst Marion Rousel Ltd*<sup>1</sup> at the beginning of paragraph 103.

*“Whether the specification is sufficient or not is highly sensitive to the nature of the invention. The first step is to identify the invention and decide what it claims to enable the skilled man to do. Then one can ask whether the specification enables him to do it.”*

- 17 Having read the reports from the examiner, it is clear to me that this is the line of reasoning that she has taken in formulating the objection.
- 18 It does, however, put me in a dilemma, since the claims are not yet finalized.

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<sup>1</sup> [2004] UKHL 46, reported as [2005] RPC 169

- 19 According to Lord Hoffman, I must first identify the invention and decide what it claims to enable the skilled man to do. Whilst the precise details are not finalized, the more recent claims are saying that the invention is in a roof structure which is translucent, and which includes an aperture and a moveable or removable panel which is also translucent, where translucent may also include tinting. The invention is said to enable the skilled man to build such a roof in the context of a vehicle or alternatively in the context of a building.
- 20 I have to say that my first reaction was that, given that the claims will need further amendment, it would be inappropriate to come to a settled and final conclusion. However, having reviewed the correspondence, I am sure that this would not be useful in progressing the application. I have therefore decided to come to a view doing the best I can on the basis of the application as it stands and in the light of the arguments currently deployed, and express the thought processes relevant to this issue in the hope that this proves helpful in the further prosecution of the application.
- 21 The description of the invention begins with sections entitled "Field of the invention" (first paragraph of page 1); "Background of the invention" (second paragraph of page 1); and following the title "Summary of the invention" on page 1, the rest of the description.
- 22 The section "Field of the invention" quite clearly and explicitly states, and has always stated, that the invention may, in addition to the use in vehicles may also extend to "any suitable building construction where appropriate" (quoted from the "Field of the invention").
- 23 However, the rest of the description is exclusively concerned with constructions of vehicles. The "Background of the invention" is entirely concerned with issues to do with vehicles. The summary of the invention begins with a specific statement that it is to do with road vehicles. I can find no other clear and specific reference to a construction in a building. In coming to this conclusion, I have paid particular attention to the other passages that Mr. Mckenzie identified, but can not agree with him that these mention anything other than vehicular applications
- 24 I therefore entirely agree with the examiner that the detailed description of the application all refers specifically to vehicles, and, on a close reading, it is in fact a list of features and materials which are to be incorporated into the roof construction. Thus, the description provides an extensive list of constructional information for vehicles, but only a bald statement that it can be used in a building roof.
- 25 There is therefore, much teaching in the specification about vehicles. In the correspondence, Mr. Mckenzie has asserted, with support of dictionary definitions, that this teaching could be applied to buildings. In his letter of 16 January 2006 he says:

"Simply because I referred to "A motor vehicle" as an exemplified description does not render obsolete the wider implications, equivalents, and substitutions of other products mentioned either implicitly or explicitly.

As the description is and claims is referring to those innovative products as well, No matter how briefly in origin.

I see no grounds to simply give up significant aspects of my inventions scope, and technical features, Thus significantly reducing the usefulness of the application without proof or sufficient reason. This is not simply about commercial potential, Rather more importantly, This is about the Patent Offices acknowledgement and support regarding the scope and details of my ideas as filed.”

- 26 Whilst I have sympathy with Mr. Mckenzie, the examiner's, and my, duty is to apply the law. The whole ethos of the patent system is to encourage innovation. It does this by ensuring the patentee is fairly rewarded for the new information he provides about an invention that he has made available. This reward is to allow him to prevent others, for a limited time, from doing what he has specified in his claim without his permission. Once this time has expired, then the payback for the world at large is information which can freely be used. The law is there to make sure, amongst other things, that this information really is of help to people other than the patentee once they are free to use it, and to this end sets out various requirements to balance the reward to the applicant and the value of making information public for others to use. One of these requirements is that set out in section 14(3) which I have set out above.
- 27 There is no doubt in my mind that the technical problems and constraints in construction a vehicle roof or a building roof are very different, and that different skills are necessary for the skilled man in either context. Static structural problems arise in buildings, whereas dynamic problems predominate in vehicles. In both, the designer has to be sensitive to safety, but again the different contexts impose different constraints. This argues for the second test of Lord Hoffman to be addressed to different skilled men in the two contexts.
- 28 Both the examiner and Mr. Mckenzie are agreed that there is enough information here to teach a vehicular engineer how to embody the constructional features of the invention contained in the claims. The examiner, however, is firmly of the opinion that the description does not provide sufficient information for the civil or building engineer. Mr. Mckenzie is equally convinced that there is. In deciding which of these two is right, I have no evidence to fall back upon apart from my personal background and experience, which, coincidentally, over my career in the Office, has included spells, albeit some time ago, working on building and on vehicular subject matter.
- 29 Having read the claims in their various forms, they are all telling the skilled man to produce a construction with particular features.
- 30 I find much information in the application directed to teaching the vehicular engineer in terms which I find to be useful in letting him use his background, training and skill to make constructions according to the claims.
- 31 It could be argued that if the civil or building engineer were supplied with a specification as set out by one or more of the claims of what is to be

constructed, the usual mechanical or civil engineering techniques which form part of their experience would enable them to design and construct a device falling within the claims without invention.

- 32 From the opposite viewpoint, however, it could equally be argued that the civil or building engineer attempting to make the construction has no specific information, and would be required to translate information about a vehicle and adapt the specific information of the application about vehicles to enable him to construct a building. It could therefore be said that the claims insofar as they extend to a building are speculative, and the description does not give the civil engineer enough information to allow him sufficiently readily and without invention to adapt the detailed proposals about vehicles.
- 33 It is established law that I should only refuse grant of an application in the clearest possible case. In the light of the direct conflict of views; the absence of supporting evidence either way; and the incomplete nature of the examination process for other issues, I think this enjoiner should apply here for the form of the independent claim at the current level of generality. It is my judgment that the benefit of the doubt balance should be given to the applicant in weighing the two opposite arguments above, and therefore I do not refuse the application.
- 34 However, I should make abundantly clear that this decision applies to the form of independent claim currently under consideration. At this stage, the objections have been made at the general level, and the issue has not been argued in correspondence for every claim currently on file. I have therefore not been able to consider the issue for every current claim, hence the following warning. If, for other reasons, the independent claims are restricted to some detailed feature from the description and/or from a later claim, then it may be that a further objection could arise under section 14(3).

### **Conclusion**

- 35 I have given the benefit of the doubt to the applicant, and do not refuse the application on the basis of the independent claims currently under consideration. The application will be returned to the examiner to continue the examination process. The warning contained in paragraph 34 should, however, be borne in mind.

### **Appeal**

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

**Bruce Westerman**

Deputy Director acting for the Comptroller