

PATENTS ACT 1977

APPLICANT JOE SPITERI-SARGENT

ISSUE Whether amendments to patent
 application GB 0710779.0 comply with
 section 76

HEARING OFFICER Stephen Probert

DECISION

- 1 In my earlier decision (BL O/086/08) in this case I concluded that the invention described in this application did not comply with sections 1(1)(c) and 14(3) of the Act. However, I allowed one month from the date of that decision for the applicant to file amendments to the description and claims (without offending section 76 - “added matter”), to make them comply with those sections of the Act.
- 2 Amendments were filed within the set period, but having considered them carefully, I have decided that they cannot be allowed because they would result in the application disclosing matter extending beyond that disclosed in the application as filed, contrary to section 76(2). I am therefore refusing this application under section 18(3) for failure to comply with sections 1(1)(c) and 14(3) of the Act.

The Relevant Law

- 3 Section 76(2) deals with added matter. It reads:

(2) No amendment of an application for a patent shall be allowed under section 15A(6), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

Reasons

- 4 In my earlier decision, I concluded that the apparatus, as described, could not possibly become unstable and/or rotate (see paragraph 25). Therefore I indicated that the description (and claims) would have to be amended to remove any suggestion that the operation of the apparatus would continue beyond the first stage — ie. when the buoyant member rises within the frame of the apparatus.

- 5 In my view the amendments proposed to the claims (with the exception of the so-called omnibus claims 7-9) would have been acceptable. But the amendments proposed in relation to the description would have retained several references to the apparatus rotating or becoming unstable. For example, page 4 lines 1-10 & line 21, page 9 lines 16-20, page 14 line 19 and page 18 lines 9 & 11.
- 6 The reference on page 9 states that structure “must be re-set” by rotating the pump motor about the machine pivot point. As the structure cannot become unstable or rotate by itself, it follows that this re-setting must be achieved by some means external to the apparatus itself. But there is no suggestion of the structure **being re-set** (or rotated) by means external to the apparatus in the application as filed; only that it would re-set itself by rotating about the machine pivot, after having become unstable.
- 7 I am sure that the skilled person would be able to think of several methods of achieving this re-setting or rotation of the structure using external means, but none of them are disclosed (implicitly or explicitly) in the application as filed. Moreover none of them would be consistent with the stated purpose of the invention — because the amount of energy required to re-set the structure could never be less than the energy provided by the apparatus up to that point. The concept of resetting or rotating the structure (by unspecified means) is therefore added matter.

Conclusion

- 8 I have already found that the invention described in this application in its unamended form does not comply with sections 1(1)(c) and 14(3) of the Act. Having allowed the applicant an opportunity to amend the application to make it comply with those sections of the Act, I have now decided that those amendments would add matter (contrary to section 76(2)) and cannot be allowed. I therefore refuse the application under section 18(3) of the Act, for the reasons given in my earlier decision (BL O/086/08) with the consequence (under section 16(1)) that it will not be published.

Appeal

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

S J PROBERT

Deputy Director acting for the Comptroller