



8th December 2008

**PATENTS ACT 1977**

APPLICANT Paul Michael Clements

ISSUE Whether patent application number  
GB 0408648.4 complies with  
section 76(2)

HEARING OFFICER C L Davies

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**DECISION**

- 1 This application relates to a rotary toothbrush powered by a hand-operated lever. It was filed on 19 April 2004, and was published as publication number GB 2413267 A on 26 October 2005. Since then the application has undergone several rounds of substantive examination. As a result the applicant, Mr Clements and the examiner have been able to reach agreement about how the claims should be limited to avoid the prior art cited by the examiner in relation to novelty and inventive step. However, the applicant and the examiner have been unable to reach agreement as to whether the amendments made to the description and claims filed on 16<sup>th</sup> October 2008 include added subject matter which contravenes section 76(2) of the Patents Act 1977 (the Act).
- 2 This issue subsequently came before me at a hearing on 19 November 2008, for which Mr Clements and the examiner, Sarah Barker, were both present.

**The relevant law**

- 3 Section 76(2) of the Act deals with added matter and states:

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.

- 4 Section 14(5)(c) of the Act relates to support and states:

The claim or claims shall-

- (a) .....
- (b) .....
- (c) be supported by the description; and

(d) .....

5 Section 125(1) of the Act is also relevant and states:

For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

### **The invention**

6 The application relates to a rotary toothbrush powered by a hand-operated lever. This lever drives a set of gears to cause rotation of one or more circular head units, comprising nylon bristles surrounded by a ring of silicone rubber nodes, the nylon bristles and nodes being suspended over a cavity. The lever is lockable to the handle of the toothbrush so that the toothbrush can be used as a manual toothbrush in the conventional manner, whilst unlocking the lever allows the toothbrush to be used as a mechanical rotary toothbrush.

7 Claim 1 of the application as originally filed reads [with my emphasis]:

A Variable Function Toothbrush which hand generates controllable speeds of brushing and polishing units which rotate and counter rotate many times via gearing linkages activated by a force on a lever, with said lever capable of being locked for a manual brushing or polishing action, or unlocked and activated for a mechanical brushing or polishing action, and allowing the fitting of same or different shaped units giving permutations of circular rotating with static rectangular units on the same head, and with brush units containing nylon bristles surrounded by a ring of silicone rubber nodes suspended over a cavity which has the flexible property of moulding to teeth contours during the brushing action and greatly increasing the surface contact area, so when slowly rotating, can search out food debris hidden in teeth cavities rather than skipping over them at high speed which accentuates its search capability especially at difficult to reach rear corners of the mouth behind the third molar regions, and with a higher rotational speed can clean the rest of the teeth surfaces with speeds varying from short fast controlled bursts to a constant speed application.

8 The fifth paragraph on page 1 of the application as originally filed reads [again, my emphasis]:

To maximise this surface cleaning area, the design proposes a brush unit comprising a combination of nylon bristles surrounded by a ring of silicone rubber nodes. These nodes greatly increase the surface cleaning area and are able to hold more dental paste in contact with teeth, while the nylon bristles have the usual advantage of flexing and searching deep teeth contours. Further flexing of bristles and nodes is achieved by suspending them over a collapsible cavity and when the brush is pushed against the teeth it has the advantage of accurately moulding to teeth and their contours.

9 Claim 1 as amended and filed on 16<sup>th</sup> October 2008 reads:

A variable function toothbrush, comprising a handle and a head, the handle

containing a geared linkage which can be caused to rotate by way of pressure on a lever associated with the handle, to cause rotation and counter rotation of one or more circular brush suspension elements mounted on the head of the toothbrush, which contains a combination of bristles surrounded by a ring of silicone rubber nodes and suspended over a cavity, and characterised in that the lever is lockable to the handle to allow for manual brushing of the teeth and the lever is also unlockable from the handle to allow for activation of the lever to cause rotation and counter rotation of the one or more circular brush suspension elements to allow for mechanical brushing of the teeth by way of the moving head or heads.

- 10 It is apparent from the above reproductions of claim 1 that the amended claim does not include the word “nylon”. This word has also been deleted from page 1 of the description also filed on 16<sup>th</sup> October 2008 (together with other amendments which were made during the course of substantive examination). At the compliance date therefore, the application no longer includes any reference to the term “nylon”.
- 11 The question before me thus, is whether deletion of the word “nylon” from claim 1 and the fifth paragraph of the description as filed constitutes added subject matter.

### **Arguments and analysis**

- 12 The examiner maintained the view during substantive examination that deletion of the word “nylon” from the phrase “nylon bristles” constitutes added subject matter, contrary to section 76(2). The examiner noted, and Mr Clements agreed at the hearing, that the original specification included no mention of any other material which could be used to manufacture the bristles. The examiner therefore considered that the skilled person reading the application as filed would understand that the bristles are to be made of nylon, and that no other material was contemplated by the applicant at the time of filing the application. Consequently, the examiner considered that deletion of the word “nylon” would introduce bristles made of any number of other materials and that such an introduction constitutes added subject matter.
- 13 By his own admission, Mr Clements accepted in correspondence during substantive examination and at the hearing that the deletion of “nylon” has the effect of broadening the scope of claim 1. This in itself indicates to me the possibility that added matter may have been included.
- 14 At the hearing, Mr Clements put forward two main arguments. His first argument centred around *Catnic Components Ltd. v Hill & Smith Ltd.* [1982] RPC 9 (hereafter “*Catnic*”). He argued that the current specification should be given a purposive construction rather than a purely literal one, the question being whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it had no material effect on the way the invention worked.

- 15 Mr Clements explained that the use of “nylon” bristles has no effect on the working of his invention and it is therefore not an essential requirement that the toothbrush bristles be made of nylon. He explained that the skilled reader would understand that the bristles could be manufactured from a range of other materials which are suitable for use as toothbrush bristles.
- 16 In response to this argument presented by Mr Clements, whilst I appreciate that “nylon” bristles might not be essential to the working of the invention, in my view, *Catnic* has no bearing on this particular case which centres around the issue of added matter, as that particular judgment considered the question of how a claim should be interpreted when considering whether infringement has taken place. I make no further comments in this respect.
- 17 Mr Clements’ second argument was that the term “nylon” is not clear in scope because it is a Trade Name which covers a wide range of different chemical structures. I believe the word “nylon” had common usage at the time of filing the application. I also believe that a skilled person in the field of toothbrushes would understand precisely what is meant by “nylon” in the phrase “nylon bristles” and would have knowledge of which types of nylon would be suitable for use as toothbrush bristles. I therefore do not believe that use of the term “nylon” is in any way unclear in this particular case and I am satisfied that use of the word “nylon” to describe “nylon bristles” would not obscure the scope of the claim.
- 18 As I see it, having considered the points raised by Mr Clements at the hearing, the question I must consider is whether the skilled reader to whom the specification is addressed would regard the application as originally filed to have disclosed, either explicitly or implicitly, that the toothbrush bristles could be manufactured from a material other than nylon. Mr Clements agreed that the only disclosures within the original specification which related to the nature of the bristles were the three occurrences of the phrase “nylon bristles”, as highlighted in paragraphs 7 and 8 of this decision. I can see no implication in the specification as filed that the use of any material other than nylon was contemplated. For this reason I consider that deletion of “nylon” from both claim 1 and the description constitutes added subject matter and is therefore not allowable.
- 19 During the hearing Mr Clements also raised the possibility that he might be able to amend the specification to include the word “nylon” in the passage on page 1, whilst leaving the word “nylon” absent from claim 1.
- 20 To help me decide whether this is allowable, I now refer to sections 14(5)(c) and 125(1) of the Act.
- 21 Section 14(5)(c) of the Act requires that the claims “shall be supported by the description”. In my opinion, the only disclosure relating to the nature of the bristles which would be present in Mr Clements’ proposed description is that the bristles are made of nylon. The description would therefore only provide support for nylon bristles and would not provide support for the bristles being made from any other material. Consequently, an amendment to include the word “nylon” on page 1, whilst leaving the word “nylon” absent from claim 1 would not be allowable because the claims would not be supported by the description.

22 In any event, I understand from section 125(1) of the Act that the claims should be interpreted in the light of the description. In my opinion therefore, a claim which includes “bristles” whilst the only bristles mentioned in the description are “nylon bristles” would consequently be interpreted as being for “nylon bristles”. Given this interpretation, the scope of the claim would be limited to include only “nylon bristles”.

### **Conclusion and next steps**

23 I conclude that claim 1 and page 1 of the description on file at the compliance date are not allowable because they include added matter contrary to section 76(2), for the reasons set out above. On this basis, I must refuse the application under section 18(3).

24 However, it is possible for Mr Clements to overcome this issue by filing further amended pages and inserting the word “nylon” before the word “bristles” on line 4 of claim 1 and also into the first sentence of the final paragraph of page 1 to specify “... a combination of nylon bristles ...”. I can accept such amendments because Mr Clements filed a Form 52 and appropriate fee, on the day of the hearing, to extend the compliance date to 19 December 2008.

25 Amended pages should now be filed by the extended compliance date of 19 December 2008 if this application is to proceed to grant. Failure to do so will mean that after this date, Mr Clements will need to seek a discretionary extension to extend the compliance date further. In the event of such an extension not being allowed, the application would then be refused under section 18(3).

### **Appeal**

26 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any such appeal must be lodged within 28 days of the date of this decision.

**C L DAVIES**

Deputy Director acting for the Comptroller