



28 June 2010

**PATENTS ACT 1977**

APPLICANT                      Furuno Electric Company Limited

ISSUE                              Whether grant of patent  
   GB 2437619 B should be rescinded

HEARING OFFICER              J E Porter

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**Introduction**

- 1     Patent application GB 0707502.1 (“the 2007 application”) entitled “Doppler Measuring Device and Water Current Meter” was filed on 18 April 2007 in the name of Furuno Electric Company, Limited. The application claims priority from a Japanese application dated 26 April 2006.
- 2     The 2007 application was granted as GB 2437619 B on 3 November 2009 and notification of grant was published in the Patents Journal on 2 December 2009.
- 3     However, on 10 November 2009 a further application GB 0919681.7 (“the 2009 application”) was filed with a request that it be treated as a divisional application under section 15(9), divided from the 2007 application.
- 4     On 25 November 2009 the examiner wrote to the applicant expressing the view that the 2009 application could not be accorded divisional status, because the 2007 application was granted by the time the 2009 application was filed.
- 5     The applicant sent a letter on 27 November 2009 expressing the view that the 2007 application should not have been granted because of deficiencies within it. They requested rescission of grant because these deficiencies and other matters amounted to an irregularity of procedure before the comptroller.
- 6     The examiner’s view remained unchanged and he offered the applicant a chance to be heard. The matter came before me on 28 April 2010, where Mr Michael Williams and Mr Peter Arrowsmith of the patent attorneys F J Cleveland LLP appeared for the applicant. Deputy Director Mrs Rebecca Villis assisted me at the hearing, which was also attended by the examiner, Mr Stephen Otter, and his manager, Dr Susan Dewar.

**The law**

- 7     The relevant provision in relation to the filing of a divisional application is section 15(9), which reads:

*Where, after an application for a patent has been filed and before the patent is granted -*

*(a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and*

*(b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below),*

*the new application shall be treated as having, as its date of filing, the date of filing the earlier application.*

8 Rule 107 of the 2007 Rules<sup>1</sup> deals with the correction of irregularities of procedure before the Office, and reads:

*(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.*

*(2) Any rectification made under paragraph (1) shall be made –*

*(a) after giving the parties such notice; and*

*(b) subject to such conditions,*

*as the comptroller may direct.*

*(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if –*

*(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and*

*(b) it appears to the comptroller that the irregularity should be rectified.*

9 Mr Arrowsmith also made submissions at the hearing in respect of the decision of the comptroller in *Howmet*<sup>2</sup> and the decision of the Court of Appeal in *Virgin Atlantic Airways*<sup>3</sup>. I discuss these submissions in my analysis below.

## **Arguments and analysis**

### *Introduction*

10 It is well-established that an irregularity of procedure before the comptroller opens up the possibility of using rule 107 to rescind grant of the patent in question. The rule may be invoked where that irregularity has occurred in a statutory procedure, or in an established non-statutory procedure on which the applicant may have been expecting to rely.

11 The applicant's submissions cover three arguments, each said to show that an irregularity of procedure has occurred in this case. The main contention is that

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<sup>1</sup> The Patents Rules 2007 (SI 2007/3291 as amended)

<sup>2</sup> *Howmet Research Corporation* BL O/265/05

<sup>3</sup> *Virgin Atlantic Airways Limited v Premium Aircraft Interiors UK Limited* [2010] RPC 8

the examiner should have issued a further examination report relating to alleged inconsistencies between the description of the invention and the claims, rather than sending the 2007 application for grant.

- 12 In the alternative, the applicant argues that his actions amounted to the foreshadowing of a divisional application, and the Office failed to respond to that foreshadowing. In a further alternative, the applicant says that the 2007 application should not have been granted before the deadline set for response to the substantive examination report.
- 13 What I must do is consider whether any of these represent an irregularity of procedure within the meaning of rule 107, and so whether grant of the 2007 application can be rescinded.

*Alleged error 1: Failure to issue a further examination report*

- 14 The examiner issued an examination report dated 15 July 2009, with a latest date for reply of 16 November 2009. In that report he raised an objection to plurality of invention, because the application included two independent claims not forming a single inventive concept. He also raised some objections to lack of clarity. The report included the standard warning that no automatic reminders are issued by the Office regarding the filing of divisional applications.
- 15 The applicant replied to this examination report on 16 October 2009. Their attorneys filed a new set of claims and some amended pages of the description and drawings. The claim relating to the second identified invention was deleted, and some clarifying amendments made in response to the report. The examiner re-examined the application and came to the view that the requirements of the Act had been met and so the application was in order for grant. Grant subsequently took place on 3 November 2009.
- 16 The applicant's main argument is that there are a number of outstanding deficiencies in the granted patent which should have been objected to by the examiner, the most notable being that a statement of invention remains on page 10 which corresponds to the deleted independent claim for the second identified invention. However, a number of other alleged deficiencies were put forward too.
- 17 At the hearing, Mr Arrowsmith defined an irregularity of procedure as "a breach in convention or normal practice of the Office". To establish what is the convention or normal practice, he argued that one can look at the Act, the Manual of Patent Practice and also what he called the "normal behaviour of the Office". He pointed out that the Act requires an examiner to investigate whether an application complies with the requirements of the Act, and that section 14(5) requires the claims to be clear and concise and supported by the description and so, as he put it, "the claims as interpreted by the description have to be clear".
- 18 He then drew my attention to parts of various paragraphs of the Manual, which read as follows:

*18.43(a) ...Minor matters which would not lead a skilled worker to misconstrue a claim or which would not be pursued if no amendment were forthcoming, should not be raised.*

- 18.68 *Objection must be raised when, as a result of amendment, there are specifically-described embodiments or statements in the description which are not consistent with the claims, since doubt is thrown on the scope of the claims...*
- 18.44 *Objection should be raised to any obscurities which hinder the understanding of the invention or cast doubt upon the scope of the claims, or to any passage which is inconsistent with the claims...*
- 14.144 *Where there is any serious inconsistency between claims and description, amendments to remove this will be required...*
- 14.147 *It is not essential for a statement of invention to be identical in wording with a main claim, but it must not be inconsistent with such a claim...*

- 19 These passages show, he argued, that the examiner must object to a serious inconsistency between the claims and the description, such as the presence of a statement of invention not corresponding to a claimed invention. He acknowledged that an examiner has what he called “discretion” with respect to what he or she may object to, and he accepted that minor matters may not be raised by the examiner.
- 20 He also contrasted the present case with that considered in the comptroller’s decision in *Howmet*, in which the applicant alleged that the application had been erroneously granted because there was an inconsistency between the claims and the description. Mr Arrowsmith pointed out that the hearing officer was of the opinion that the inconsistency was a minor one which did not amount to an irregularity of procedure and, in that case, the statements of invention corresponded to the claims.
- 21 Mr Arrowsmith went on to refer to paragraph 15 of *Virgin Atlantic Airways*, in which Jacob LJ said:
- ...it would be unrealistic – indeed perverse – for the law to say that the notional skilled reader, probably with the benefit of skilled advice, would not know and take into account the explicit drafting conventions by which the patent and its claims were framed.*
- 22 He used this to illustrate that statements of invention are not there for “no reason” but instead have a significant bearing on claim interpretation. It would be unrealistic to say that the skilled worker would not understand what statements of invention were, and the presence of a statement of invention which did not correspond to an independent claim would, he said, leave the skilled worker uncertain how to interpret the claims, thus casting doubt on their scope.
- 23 This inconsistency, he argued, is therefore not a minor matter (in contrast to the situation in *Howmet*) but represents a serious defect in the application to which an examiner must object, following the guidance in the Manual. The failure to do so in this case was therefore an irregularity of procedure within the scope of rule 107.
- 24 At the hearing I asked Mr Arrowsmith whether he thought the examiner’s assessment was a matter of judgment and, if so, whether erroneous judgments were within the scope of rule 107. Mr Arrowsmith argued that, in this case, the examiner’s assessment was wrong as a matter of fact – “unequivocally wrong because it contrasts with the behaviour which is stipulated by the Patents Act and

by the Manual of Patent Practice”. It was a clear-cut matter and so rule 107 should be used to correct the examiner’s error. He contrasted this with an examiner’s assessment of inventive step – where a degree of judgment was required and it would be wrong to use rule 107 if an examiner had erroneously assessed the matter.

- 25 I have considered all these arguments carefully and it seems to me that, as a general principle, when an examiner is called upon to assess whether an application complies with the Act or not, he exercises his judgment as to whether that is the case. As Mr Arrowsmith’s example noted, the examiner’s judgment is exercised in determining whether certain documents show that the invention is obvious. But an examiner also, as in this case, exercises his judgment as to whether there are serious defects which make the scope of the claims unclear.
- 26 Now Mr Arrowsmith said that this was actually a “matter of fact” and I agree that it is a matter of fact whether an invention is novel and inventive, whether claims are clear and supported, and so on. But an examiner must use his judgment to come to a view on those facts. In this case the examiner judged that, as a matter of fact, the claims were clear and any remaining deficiencies were of a minor nature (and he later outlined why he had come to this view in his letter of 3 December 2009). On the facts, the applicant and his attorneys now disagree with the examiner and say that the deficiencies are more serious. But this is a disagreement about the examiner’s judgment of the facts. It does not mean that a procedural irregularity has occurred.
- 27 With respect to the attorney’s points about the guidance in the Manual, I agree that one can generally look to the Manual or well-established Office practice to determine if a procedural irregularity has occurred. However, I do not think it follows that everything on which the Manual gives guidance can be regarded as procedural; nor can every alleged failure to follow that guidance be regarded as a procedural failing. In this case I do not think it was a procedural failing for the reasons I have explained.
- 28 With regards to *Virgin Atlantic Airways* and the attorney’s points about the role of the statement of invention and the skilled person’s understanding of it, I do not disagree that the statement of invention is important and can affect claim clarity. But the point is that the examiner came to his view on these matters in this case, and it is not for me to use rule 107 to allow that exercise of judgment to be revisited – just because the applicant now thinks it was not right.
- 29 I agree that, in *Howmet*, the hearing officer decided that it “strained credulity” to suggest that the minor error in question in that case would render grant erroneous. But I cannot see any discussion in that decision of whether a more serious error or inconsistency in the description or claims would amount to a procedural irregularity within the meaning of rule 107.
- 30 In terms of procedure it is clear that the examiner re-examined the application on the basis of the amendments filed, to assess whether it met the requirements of the Act. Having come to the view that it did, he followed the correct procedure by not issuing a further examination report, but by marking the application in order for grant and taking the necessary associated procedural steps. I can see no

procedural irregularity which occurred within the meaning of rule 107.

- 31 It follows that I do not need to come to a view on whether the examiner or the applicant is right about any deficiencies in the clarity of the claims, and whether these are serious or minor. If the applicant is concerned that the examiner's view is wrong, and deficiencies remain, then the solution provided by the legislation is to apply to amend the granted patent under section 27 to put the matter right.

*Alleged error 2: Failure to respond to foreshadowing of divisional application*

- 32 Paragraph 8 of the attorney's letter of 27 November 2009 states that the continued presence of a statement of invention corresponding to the deleted independent claim constituted "non-abandonment of that subject matter, and an indication that the applicant may wish to seek independent protection for that subject matter".
- 33 Mr Williams reiterated this view at the hearing and argued that one of two things should have happened before the 2007 application was granted. Either the examiner should have clarified whether the applicant wished to file a divisional application in relation to the subject matter, or he should have sought deletion of that statement of invention by issue of a further examination report.
- 34 I have already concluded that no procedural error occurred in respect of the fact that the examiner decided not to issue a further report. I must therefore now consider whether a procedural error occurred because the examiner did not seek to clarify the applicant's intentions.
- 35 Mr Williams said that he would have expected the standard warning letter ("EL26") or at least a telephone call from the examiner clarifying the applicant's intentions. He argued that the failure therefore amounted to a procedural error to which rule 107 applied.
- 36 Paragraph 15.46 of the Manual sets out the Office's practice with respect to the foreshadowing of divisional applications. It is a lengthy paragraph but I think the relevant parts are as follows:

*If a divisional application has been foreshadowed in the most recent letter but not yet filed, and the application is in order for grant, an "in order" marking on the parent application should also be deferred...*

*If a divisional filing is "foreshadowed" in circumstances where division appears unlikely, the applicant should be asked for further details of his intentions). EL26 should be issued to inform the applicant that re-examination of the application will be deferred and if found to be in order after two weeks will be granted....*

*When an application is found to be in order and a divisional has been foreshadowed in an earlier letter partway through the examination process, eliciting a response from the examiner as outlined above, no further reminders will be issued and the application may proceed to grant. If no such responses have been made, EL26 should issue. The application can be sent for grant earlier if the applicant or agent requests this in writing.*

- 37 However, as was said in *Irwin*<sup>4</sup>, there is a difference between, on the one hand,

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<sup>4</sup> *Irwin Industrial Tool Company* BL O/247/09

the applicant foreshadowing a divisional application – that is to say, indicating clearly that a divisional application is likely to be filed in the future – and, on the other, the Office or an examiner being expected to assess the probability of a particular applicant filing a divisional application based on that applicant's prosecution of the application or other actions they may have taken.

- 38 It follows that I do not see how removing a claim but leaving the corresponding statement of invention in place amounts to the foreshadowing of a divisional application for the subject matter of that removed claim. There may have been a number of reasons why the applicant wished to prosecute the 2007 application in this way, or it may have been unintentional. But to argue that, in this case, the Office should have concluded that a divisional application was being foreshadowed is not one that I can accept. In a conclusion that is consistent with *Irwin*, I think that to accept such action as amounting to foreshadowing would be to impute to the Office a far greater ability to see inside the mind of the applicant and his patenting strategy than can be possible in practice.
- 39 Since I am not persuaded that retention of the statement of invention was a foreshadowing of a divisional application, it follows that I can see no error in procedure which occurred in this respect.

*Alleged error 3: Grant of 2007 application before expiry of the period for response*

- 40 At the hearing, Mr Williams explained that the applicant had always intended to file a divisional application, a fact of which the attorneys were aware. At the time of responding to the examination report, the attorneys had drafted claims for a divisional application and had sent them to the applicant for approval.
- 41 The attorneys accepted that, ideally, the applicant's reply to the examination report would have included a statement reflecting the intention to file a divisional application, thereby prompting the examiner to issue an EL26. Although such a statement was not included, they argued that the applicant could reasonably have expected to be able to file a divisional application within the period for responding to the examination report (i.e. by 16 November 2009). The 2007 application should not, therefore, have been granted until after this date.
- 42 I must therefore consider whether a procedural error was committed when the examiner did not hold back grant of the 2007 application until after the latest date for response to the examination report.
- 43 As I have discussed, on receipt of the reply of 16 October 2009 and its accompanying amendments the examiner re-examined the application and, in his judgment, found it to be in order for grant. I have also concluded that there was no foreshadowing of a divisional application. I also note that there was no indication in the attorney's letter that the response represented anything other than a full response to the examination report, and it concluded as follows:

*We trust that the foregoing amendments place this application in a form which allows grant of a patent thereon. Should this not be the case, we request a further opportunity to respond to the Examiner's objections.*

- 44 Mr Arrowsmith argued that the paragraph must be taken as a whole and the

second sentence was important. He considered that “as a matter of fact the application was not in order for grant because there was a statement of invention that didn’t correspond to the independent claims. So in that case we requested further opportunity to respond to the objection that should have been raised”.

- 45 I of course agree that it was reasonable to ask for a further opportunity to respond if, in the examiner’s view, the application was not in order. But the clear message from the final paragraph was that, if the examiner’s view was that the application was in order, then grant was desired – and it was clearly the applicant’s view at the time (although I accept they now think differently) that the amendments placed the application in order for grant. There is no suggestion that, in the absence of a further report from the examiner, the applicant wished to make further submissions or take further action on the 2007 application. As I have already concluded above, there was also no foreshadowing of a divisional application.
- 46 That being the case, I think it was reasonable for the examiner to treat the response as a full response to his examination report, and so not to expect anything further from the applicant. In the absence of any foreshadowing of a divisional application, and with the examiner having concluded that, in his view, there were no further objections to raise, it was right to send the application for grant when the examiner did. I do not see why it would have been necessary or appropriate for the examiner to hold back the grant of the 2007 application until the expiry of the period for reply to the examination report.
- 47 I conclude that there was no irregularity of procedure when the 2007 application was sent for grant after the reply from the applicant had been received but before the expiry of the period for reply.

### **Conclusion**

- 48 I can identify no irregularity of procedure and I conclude that there is no basis on which to consider exercising discretion under rule 107 to rescind the grant of the 2007 application.
- 49 The 2009 application remains filed after the grant of the 2007 application. It follows that it cannot be accorded divisional status under section 15(9) and must proceed with a filing date of 10 November 2009.



## **Appeal**

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

**Dr J E PORTER**

Deputy Director acting for the Comptroller