

REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES

[1956.]

25TH APRIL, 1956

[No. 6]

Before THE SUPERINTENDING EXAMINER.

2nd May and 2nd June, 1955.

IN THE MATTER OF GEORGIA KAOLIN COY. LTD.'S APPLICATION.

5 *Applications for patents of addition to co-pending application—Inventions claimed were in respect of subject-matter included in the main specification—Meaning of “invention” in Sec. 26 (1)—Applications refused—Patents Act, 1949, Sec. 26 (1), Sec. 101.*

10 Held, (1) *That when the Act means the “invention claimed”, the word “invention” is qualified accordingly.* (2) *That had the intention in Sec. 26 (1) been to mean the “invention claimed”, the wording of the subsection would have indicated this meaning.* (3) *That the word “invention” in this subsection means “the invention disclosed and described”.* (4) *That an application for a patent of addition to the patent granted for a main invention must be in respect of some further disclosure over and above that of the main invention which further disclosure must moreover be in the nature of an improvement in or modification of the main invention.*

15 The Examiner having raised objections to application for patents of addition on the ground that they were in respect of subject matter included in the main application, a hearing was appointed for 2nd May, 1955, at which *Eric Walker* appeared as Counsel for the Applicants.

20 The relevant facts are sufficiently set out in the decision dated 27th June, 1955, of the *Superintending Examiner* (Mr. *J. V. Hudson*) acting for the *Comptroller-General*, which was as follows:—

25 The Applicants have requested that a patent may be granted on each of these applications [Nos. 4899 and 4938 of 1952] as a patent of addition to the patent to be granted on application No. 4847 of 1952 (hereinafter called the main application). As a result of his examination of the applications and of their accompanying specifications, the Examiner has reported that the applications do not fall within the provisions of Sec. 26 (1) of the Act, in that they are not in respect of inventions which are improvements in or modifications of the invention of the main application, and thus patents of addition to the said main patent cannot be granted on these applications.

30 The complete specification of the main application discloses a method of separating a clay mixture into its component clays by utilising the known fact that in a clay-water mixture the particles of clay may either remain discreetly suspended in the water or, under certain conditions, they may coagulate together to form a glutinous mass. In the former

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case, the clay is said to be deflocculated; in the latter, the phenomenon known as flocculation has occurred. The Applicants have been concerned with the problem of separating, from a naturally-occurring clay mixture, those clays having certain desired qualities, and have found that this can be achieved by adding a selective flocculating agent to an aqueous flocculated suspension of the clay mixture, one of the clay components thereupon becoming flocculated and thus capable of separation from the aqueous suspension by known physical methods. Claim 1 of the main application reads:—“A method of fractionating clay “containing two or more clay components, each susceptible of deflocculation, comprising “the steps of establishing an aqueous suspension of the clay in a condition whereunder “the several clay components are all deflocculated, adjusting the conditions of the suspension “by the addition of a selective flocculating agent so as to effect flocculation of at least “one but not all of the components, precipitating the flocculated portions and separating “the precipitate and the supernatant suspension”. The only examples of suitable selective flocculating agents given in the main application are substances within the class known as hydrophilic colloids, and one such colloid, manno-galactan, is, *inter alia*, specifically 15 mentioned.

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The disclosure of the complete specification of Application No. 4938 of 1952 is in general similar to that of the main application, but the invention claimed is concerned only with the use of selective flocculating agents which are hydrophilic colloids. Claim 1 reads:—“A method of fractionating clay as claimed in claim 1, claim 2 or claim 3 of our co-pending 20 application No. 4847/52 (the main application) wherein the selective flocculating agent “is a hydrophilic colloidal material”.

The disclosure of the complete specification of Application No. 4899 of 1952 is again similar to that of the main application, but the invention here is limited to that form of the method of the main application in which the selective flocculating agent is manno-galactan. Claim 1 reads “A method of fractionating clay as claimed in claim 1, claim 2 25 “or claim 3 of our co-pending application No. 4847/52 (the main application) wherein “the selective flocculating agent is manno-galactan”.

The position may be summarised by saying that the main application is for a patent for the method of separating clays by selective flocculation of clay mixtures, Application 30 No. 4938 of 1952 is for such a method using any one of a specific class of material, *viz.*, the hydrophilic colloids, as the flocculating agent, and Application No. 4899 of 1952 is for such a method using a particular hydrophilic colloid, *viz.*, manno-galactan, as a flocculating agent, the specific class and also the particular colloid being described, but not claimed, in the main application.

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The main and the two other applications were each accompanied by a provisional specification, the three provisional specifications being of even date. The main complete specification was, however, filed on the 20th of February, 1953, and the complete specifications of Applications Nos. 4899 and 4938 on the 23rd and 24th of February, 1953, respectively.

The Examiner objected that, since the inventions in respect of which the two applications 40 in question had been made were disclosed in the complete specification of the main application as examples of the main invention, the said inventions were in fact already within the main invention as so disclosed, and thus could not be regarded as improvements in or modifications of that invention.

Section 26 (1) of the Act, which lays down certain conditions which must be fulfilled 45 before a patent can be granted as a patent of addition, states:—

“Subject to the provisions of this section, where application is made for a patent in “respect of any improvement in or modification of an invention (in this Act referred to “as ‘the main invention’) and the applicant also applies or has applied for a patent for “the invention . . . the comptroller may . . . grant the patent for the improvement or 50 “modification as a patent of addition”.

Mr. Walker submitted that the word “invention” in this subsection must mean the main invention so far as it is claimed in the complete specification of the main application. He referred to Sec. 26 (7), where for the first time in the section the word “invention” is

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qualified by reference to the "invention claimed" and to the "invention described", and argued that it would not be a proper construction of the section to read back the meaning "invention described" on to the word "invention" where that word first occurs in Subsec. (1). Consideration of the whole of Subsec. (7), however, shows, in my opinion, that the argument is not applicable. The subsection reads "The grant . . . shall not be refused . . . on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of the main invention described in the complete specification relating thereto . . .". It seems to me that the word "invention" has been qualified as "invention described" to distinguish it from the phrase "invention claimed" which is used in the same subsection. I do not think the wording of this Subsec. (7) in any way indicates that the word "invention" in Subsec. (1) must not be construed to mean "the invention described", or that it must be construed to mean "the invention claimed".

Mr. Walker also drew attention to an anomaly which, he considered would arise under Sec. 26 (3) if the word "invention" in subsection (1) were held to mean "invention described" or "invention disclosed". Subsec. (3) permits the complete specification of both patent of addition and the main patent to be filed on the same day. Since under Sec. 4 (3) (b) of the Act, an applicant is bound to disclose in his complete specification the best method of performing the invention known to him, he would be precluded from filing on the same day a complete specification describing a main invention, and also a complete specification in respect of a patent of addition to the main invention and describing an improvement in said main invention. Sec. 26 (3), insofar as it relates to complete specifications of even date, could then only be operative in respect of modifications of the main invention, but not in respect of improvements therein. As I see it, however, Sec. 26 (1) lays down certain provisions which must be fulfilled before a patent can be granted as a patent of addition, and if, when these provisions have been properly interpreted, it is found that for any reason an application falls outside them, the provision of Subsec. (3) cannot be operative.

Mr. Walker further argued that, since no objection would have arisen on the grounds of plurality of invention had all the claims of the two applications in question been in the complete specification of the main application, and the two said applications had not been made, and also that no objections on the grounds of over-lapping of claims would have arisen had the two applications and the main application all been completely independent applications—and I agree in general with both these suppositions—it seemed to him illogical that the present applications comprising their present claims could not proceed as applications for patents of addition.

In considering the construction to be placed on Sec. 26 (1) of the Act, I have turned to the definition of "invention" given in Sec. 101 (1). This reads: "In this Act, except where the context otherwise requires, the following expressions have the meaning hereby assigned to them, that is to say—

"invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies and any new method or process of testing applicable to the improvement or control of manufacture, and includes an alleged invention".

45 The definition does not, however, in my view, determine whether or not the word "invention" in the context of Sec. 26 (1) must there be further qualified as meaning "the invention, so far as claimed". I have also looked at the other sections of the Act in which the word "invention" is used, for example, Sec. 7 (1), which reads

" . . . the invention, so far as claimed in any claim of the complete specification . . ." 50 and Sec. 4 (3), which states

"Every complete specification (a) shall particularly describe the invention . . . and (c) shall end with a claim or claims defining the scope of the invention claimed".

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From all this I conclude that, in the Act, when it is the "invention claimed" which is in question, the word "invention" is qualified accordingly. In my judgment, therefore, had the word "invention" in Sec. 26 (1) been intended to mean "the invention claimed", or "the invention, insofar as the applicant, in the light of all the circumstances of prior "art, etc., has decided to seek protection for it", then the wording of the subsection would have indicated this meaning. In my view, the word "invention" in this subsection means the main invention disclosed and described, and an application for a patent of addition to the patent granted for a main invention must be in respect of some further disclosure over and above that of the main invention which further disclosure must, moreover, be in the nature of an improvement in or modification of the main invention.

I decide, therefore, that I must refuse to allow the two applications to proceed. I may add there would be no objection to the amendment of the complete specification of the main application to include the claims of the two applications in question. Any necessary consequential amendments would also be allowed.

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