

## REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES

1957]

10TH APRIL, 1957

[No. 6

Before THE SUPERINTENDING EXAMINER.

17th July, 1956.

## WELWYN ELECTRICAL LABORATORIES LTD.'S APPLICATION FOR A PATENT.

*Application for a Patent of Addition—Objection by Examiner that the later application was not made "in respect of any improvement in or modification of" the main invention—Application not permitted to proceed under Sec. 26 (1) unless claims limited to matter not disclosed in the main specification*

*Patents Act, 1949, Sec. 26 (1).*

*Held*

10 (1) *That for a Patent of Addition regard must be had to the invention disclosed and described in the earlier specification and the application must be made in respect of some further disclosure which is of the nature of an improvement or modification.*

15 (2) *That the claims of a Patent of Addition must be specifically directed to such an improvement or modification.*

*Observed*

*The mere claiming in a later application of the invention of an earlier application from a different aspect, or of subject-matter contained in the earlier specification but not claimed therein, does not fulfil the purpose of Sec. 26.*

20 *Georgia Kaolin Coy. Ltd.'s Application [1956] R.P.C. 121, and P. & S.'s Application (1952) 69 R.P.C. 249 referred to.*

25 The main specification No. 716,259 described a method of making an electrical condenser and certain constructional features of the condenser but the relevant claims were restricted to the *method* of making the condenser. In a later application for a Patent of Addition, the specification described with certain minor additions, the same constructional features, and the claims were so drawn as to cover those features, viz. features described but not claimed in the main specification.

The Examiner having objected that the application had not been made in respect of any improvement in or modification of the invention set forth in 84908

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Patent No. 716,259, a hearing took place before the *Superintending Examiner* (Mr. W. E. Watts) acting for the *Comptroller-General*, at which Mr. Anthony Walton appeared as Counsel for the Applicants.

The parts of the decision of the *Superintending Examiner* which are material for the purposes of this report were as follows. 5

The specification of Patent No. 716,259 relates to electrical condensers of the kind consisting of thin plates or foil of metal such as aluminium or copper separated by an insulating material. Methods for making such condensers are described whereby metal plates are dipped in a suspension of powdered glass in water or other suitable liquid and dried, the glass then being fused to form 10 coatings. The plates are then folded and fitted together and again dipped in an aqueous suspension of powdered glass and dried to form an envelope. The plates are then heated and placed in a press which is heated to fuse the glass and simultaneously pressure is applied to the coated plates. Thereafter, the assembly 15 may be coated with another glass composition to provide resistance to atmospheric attack. Examples of this coating material are given in the specification. In another method the plates are coated with glass and are rolled together whilst hot pressure being applied during rolling. Machines for making the condensers either by the pressing or rolling process are also described. 15

The specification in its opening paragraphs sets out the invention in the following terms:—"According to the present invention a method of making a condenser comprises coating at least two plates with a suspension of glass powder in a liquid, drying the coatings, assembling the plates together to form a condenser, fusing the glass on the condenser and applying pressure to the condenser while the glass is in fused condition". It is stated that the use of a suspension 20 of glass powder in a liquid is an essential feature of the invention and that the application of pressure while hot, although known with molten glass dipping, is a necessary feature in combination with the use of a suspension. The specification also indicates that the invention includes a special machine for use 25 in making condensers. The statement of claim is confined to a method of making a condenser (Claims 1 to 15) which method in its broadest aspect is 30 consistent with the invention set out above, and to a machine for carrying out one of the methods described (Claims 16 and 17). 30

The present specification refers specifically to Patent Specification 716,259 and recites Claim 1 of that specification. Furthermore it refers also to the features 35 claimed in Claims 3 and 4. According to the opening paragraphs, the invention resides in an electrical condenser comprising a plurality of metal plates having a glass dielectric, said plates being bent and fitted into each other, and a protective outer coating of a glass of another composition having better resistance to atmospheric attack than the glass dielectric. Claim 1 claims a condenser having 40 these features. Preferred mixtures for the protective coating are specified viz. (a) mixtures including the materials and ranges quoted in lines 71 to 77, p. 3, of Specification 716,259 with the difference that the range for PbO viz. 5-17 parts by weight is altered to a range of 5-20 per cent., and (b) mixtures of the materials referred to in (a) but having different ranges. As examples falling within the 45 ranges under (b), the three examples given in lines 80 to 88, p. 3, of the prior specification are again quoted together with two further mixtures not disclosed in that specification. The present specification also makes it clear that although the condenser may be made by the method described and claimed in Specification 716,259, any other method of making the condenser may be used. 50

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From the above survey of the prior specification and the present application, it will be seen that the scope of Claim 1 of the application is broad enough to embrace a condenser having constructional features which are described in the earlier specification but which divorced from the method claimed are neither set out as constituting the earlier invention nor claimed as such. Further the scope of the claim is sufficiently broad to cover not only a condenser made by the method claimed in the earlier specification but also one made by any other method. Moreover its scope not only includes the further variations in the ranges of the mixtures which may be employed for the protective coating but also those specified on p. 3 of the earlier specification. The overall ranges are claimed in the appendant Claims 2 and 3 of the application. The features of the appendant Claims 4 to 7 also are all disclosed in the earlier specification.

In support of his objection, the Examiner relied on the decision of the *Superintending Examiner* in the matter of *Kaolin's Application* [1956] R.P.C. 121. 15 In that case the *Superintending Examiner* decided that the word "invention" in Sec. 26 (1) means the "invention disclosed and described" and 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.

In the first place Mr. *Walton* questioned the correctness of that decision. He submitted that the "invention" (the main invention) referred to in Sec. 26 (1) must mean the invention *claimed* and that in consequence an application for any improvement in or modification of the invention *claimed* is admissible as one for 25 a patent of addition. He argued that the invention of the present application *viz.* the condenser as claimed in Claim 1 is admissible as a modification of the main invention as set forth in the "method" claims of the earlier specification. In support of his submissions he referred to the many instances in the Act where mention is made of "invention" and "matter published" with the view 30 to supporting his contention that "invention" means "invention claimed". But even on the basis of the decision in the *Kaolin* case (*supra*) Mr. *Walton* submitted that he was entitled to a patent of addition in the present case. He admitted that claim 1 does not specifically claim any improvement in or modification of the condenser *described* in the earlier specification, but he argued that as Claims 2 35 and 3 specifically embrace modifications of the invention *described* in the earlier specification and therefore qualify under the *Kaolin* decision for inclusion in a patent of addition, Claim 1 which also embraces those modifications should be allowed, particularly as there is nothing in the Acts to prevent the inclusion of a broad claim in an application provided it is properly based on the disclosure. 40 In this connection he submitted that the phrase "in respect of" in line 2 of Sec. 26 (1) means in effect "containing", and that in consequence any application for a patent which contains an improvement in or modification of the main invention should be regarded as coming within the section.

I have carefully considered the submissions made at the hearing by Mr. *Walton*, 45 but I have come to the conclusion that I am unable to allow the application with the claims in their present form to proceed as one for a patent of addition.

As previously indicated the scope of Claim 1 is sufficiently broad to embrace,

50 (a) a condenser already disclosed in the earlier specification comprising a plurality of metal plates bent and fitted together and having a glass dielectric and an outer protective coating of glass of another composition, but unrelated in any way to any particular mode of manufacture,

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(b) a condenser as in (a), or having the features referred to in (a) and made by the method already disclosed in the earlier specification, and wherein the protective coating may be made of the mixtures disclosed in that specification,

(c) a condenser as in (a) or having the features referred to in (a) and made in accordance with the method of the earlier specification, and wherein the protective coating may be made of mixtures disclosed for the first time in the present specification.

As regards (a) above, since the features of the condenser in the two cases are identical it cannot be said that the claims of the present application are concerned with any improvement in or modification of the condenser described in the earlier specification. Moreover no broad claim is made in the earlier specification to the constructional features of a condenser *per se* and no emphasis is placed in the description of that specification on the features of such a condenser when not related to the particular method employed for making the condenser. Therefore it also cannot be said I think that the earlier specification, whether approached from the standpoint of the "invention claimed" or the "invention disclosed and "described", discloses as the "main invention" the broad concept of the condenser as now claimed. In my view therefore this broad aspect of the present invention is neither concerned with the main invention of the earlier specification nor with any improvement in or modification thereof. The same considerations apply also to that aspect of the present invention which embraces condensers having the constructional features as claimed in Claim 1 and disclosed in the earlier specification and made of the mixtures also disclosed in that specification (see (b) above). As regards the alternative mentioned in (b) above, namely, a condenser made in accordance with the method constituting the main invention of the earlier specification, a claim for such a condenser would in essence be a claim for the earlier invention and therefore cannot be regarded as one made in respect of any improvement in or modification of that earlier invention.

In my view Sec. 26 only enables an applicant or a patentee to protect some further disclosure over and above that of the main invention, a disclosure which must be in the nature of an improvement in or modification of that invention. The mere claiming in a later application of the main invention from a different aspect, or of subject matter contained in the earlier specification but not claimed therein does not in my opinion fulfil the purpose of the Section.

It is quite clear I think that if a claim of a later application is based on an earlier disclosure, that claim could not relate to any improvement in or modification of the earlier invention. This of course would be clearly demonstrated if a Sec. 7 relationship existed between the two cases since the claims in the later application would obviously be invalid by reason of prior publication (see *P. and S's Application (1952) 69 R.P.C. 249*). In cases such as the present application, where a Sec. 8 relationship exists, it is of course possible in a later application to claim an earlier disclosure and at the same time avoid conflict of claim. But if such a claim is co-terminous with the earlier disclosure it cannot be said I think that the application is concerned with any improvement or modification and in my view such an application would not qualify as one suitable for a Patent of Addition. These considerations lead me to the conclusion that for an application for a Patent of Addition, regard must be had to the invention disclosed and described in the earlier specification and the application must be made in respect of some further disclosure which is of the nature of an improvement or modification. In this respect therefore I agree with the decision given in the reported case of *Kaolin's Application* referred

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to above. Moreover I hold the view that the claims in a Patent of Addition must be specifically directed to such an improvement or modification; otherwise the patent, if granted, would not be a patent for the improvement or modification as called for by the section. For these reasons I am unable to allow in the 5 present application claims which are so broad that they include condensers which come within categories (a) and (b) referred to above.

This brings me to category (c) *viz.* (1) a condenser as in (a) having a protective coating made of the additional mixtures referred to in the present specification; or (2) a condenser as in (a) made in accordance with the method claimed in the 10 earlier specification and limited to the additional mixtures. It will I think be clear from what I have said already that I regard also the broad aspect referred to in (c) (1) above as unsuitable for a claim in the present application, since it is not specifically related to the main invention of the earlier specification. However I should regard a claim for (c) (2) as allowable since although such a claim 15 would claim the constructional features of the condenser, the condenser would result from the method claimed in the earlier specification *i.e.* "the main invention" and would also specify the "improvements in or modifications of" disclosed in the present specification. Alternatively and by reason of the relationship which exists between the two cases, I should be prepared to accept a Claim 1 20 which in addition to the features now claimed is however limited to both the method claimed in the earlier specification and also the *full* ranges of mixtures disclosed in the present specification provided that suitable disclaiming references are made in the body of the specification to the ranges already specified and 25 claimed in the prior specification in order to ensure that the nature and scope of the improvements or modifications claimed are brought out clearly.

I decide therefore that failing amendment to limit the scope of the claims in the manner suggested above I shall be unable to allow the application to proceed as one for a Patent of Addition.