



PATENTS ACT 1977

APPLICANT Snap-on Incorporated

ISSUE Whether patent application GB1407732.5 complies with section 1(1)(a) and 76(2) of the Patents Act 1977

HEARING OFFICER Joanne Pullen

DECISION

Introduction

- 1 Patent application GB1407732.5, relating to an electronic torque wrench, was filed on 1 May 2014 by Snap-on Incorporated. The application claims a priority date of 7 May 2013 from US13888685. The application was published as GB2514487 on 26 November 2014. The compliance period expired on 7 November 2017.
- 2 The examiner has objected that the latest amended claims, filed on 6 October 2017, add matter to the application as originally filed contrary to section 76(2) of the Act. The examiner has also objected that claims 1 and 6 lack the novelty required by section 1(1)(a) of the Act. The applicant was offered a hearing and a decision based on the papers on file was requested in a letter dated 30 October 2017.

The law

- 3 I will first consider the issue of added matter. The relevant section of the Act is section 76, of which subsection 2 reads as follows:

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

- 4 Guidance on section 76 can be found in *Bonzel and Schneider (Europe) AG v Intervention Ltd*¹, where Aldous J (as he then was) stated:

¹ *Bonzel and Schneider (Europe) AG v Intervention Ltd* [1991] RPC 553

The decision as to whether there was an extension of disclosure must be made on a comparison of the two documents read through the eyes of a skilled addressee. The task of the Court is threefold:

a) To ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly in the application.

b) To do the same in respect of the patent as granted.

c) To compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition. The comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly.

In this case the second document/disclosure would be the patent as amended.

- 5 A further summary was provided in *Richardson-Vicks Inc's Patent*² where Jacob J (as he then was) stated:

The test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification.

The application

- 6 The application relates to an electronic tool for applying torque and methods for storing information on the tool and exchanging data between the tool and a computer. The advantages of this invention include being able to accurately apply a specified torque/angular displacement to a specific work piece, increases in speed and accuracy in setting up the tool and increases in speed and accuracy in recording measurements made by the tool.

Analysis

- 7 The examiner raised an added matter objection to several of the most recent amended claims which were filed with the agent's letter dated 6 October 2017. I will initially focus on claim 1 which reads:

1. A method of communicating for a tool having a memory and that is adapted to apply amounts of torque to respective work pieces, comprising: communicably coupling a computing device to the tool; receiving, from the computing device, a tool identifier that uniquely identifies the tool; storing, in the memory, the tool identifier and torque values respectively corresponding to the amounts of torque applied by the tool to the respective work pieces; and communicating the torque values to the computing device with the tool identifier.

- 8 The claim appears to be a combination of originally filed claims 6 and 18, and it is the final step of "communicating the torque values to the computing device with the tool identifier" that the examiner considers to add matter.
- 9 In determining whether matter has been added I have taken the skilled person to be a person, or team of people, familiar with the design and use of this type of tool.

² Richardson-Vicks Inc's Patent [1995] RPC 586

- 10 From reading the application as filed, it would be clear to the skilled person that a specific tool identifier, which may be unique to the tool, can be communicated to the tool and stored in the memory of the tool. This information can be ascertained from original claim 18 and from more detailed information found on page 11, lines 8-12 of the description which reads:

“According to an aspect of the present disclosure, a tool specific identifier such as a serial number and/or model number may be received from a computing device to an electronic torque wrench via a communication port, such as a USB port, configured on the electronic torque wrench.”

- 11 There is no explicit disclosure in the application as filed of communication of the tool identifier from the tool to an external computing device, nor has the applicant argued that there is. Therefore, the question to be answered is whether there is clear and unambiguous implicit disclosure of this information.
- 12 It is this point that is addressed in the agent’s letter dated 6 October 2017, which draws attention to page 5, lines 3 to 7 of the application as filed which reads:

‘According to an aspect of the present disclosure, an electronic torque wrench has the capability to store torque and angle log information, representing amounts of torque or angular displacement applied to work pieces, into an internal memory such as flash memory configured on the torque wrench. A method for downloading the log into a computer system for records, archives or quality audit purposes is also disclosed.’

- 13 It is argued that, as the tool identifier is similarly stored in the memory alongside the log then then it is implied that this too is downloaded to the computer system. The applicant attempts to reinforce this argument by identifying advantages of downloading the tool identifier, specifically the possibility of providing an audit trail.
- 14 I am not persuaded by the applicant’s arguments. It is worth noting that the only disclosure of audit functionality in the description is in relationship to the torque and angle measurement information which constitutes a log. There is disclosure of the torque and angle measurement information being time stamped and as such this may also be considered to form part of the log. While a skilled person may consider it to be obvious, and additionally helpful, to communicate the tool identifier along with the log this is not the test to be satisfied. The information must be clearly and unambiguously disclosed either explicitly or implicitly in the application as filed and in this case it is not. The amendment therefore constitutes added matter contrary to Section 76(2).

Further analysis

- 15 The compliance period expired on 7 November 2017 and can no longer be extended to give the applicant an opportunity to remedy the identified added matter, therefore I do not need to consider whether the remaining claims add matter nor the alleged lack of novelty.

Conclusion

- 16 I have based my decision on all of the information available on file and find that claim 1, as amended, adds matter contrary to section 76(2) of the Act. I therefore refuse this application under section 18(3).

Appeal

- 17 Any appeal must be lodged within 28 days after the date of this decision.

J Pullen
Deputy Director, acting for the Comptroller