



**PATENTS ACT 1977**

APPLICANT	Alvin Stanley Lawrence
ISSUE	Whether patent application GB1520033.0 complies with section 76(2)
HEARING OFFICER	Mrs S E Chalmers

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**DECISION**

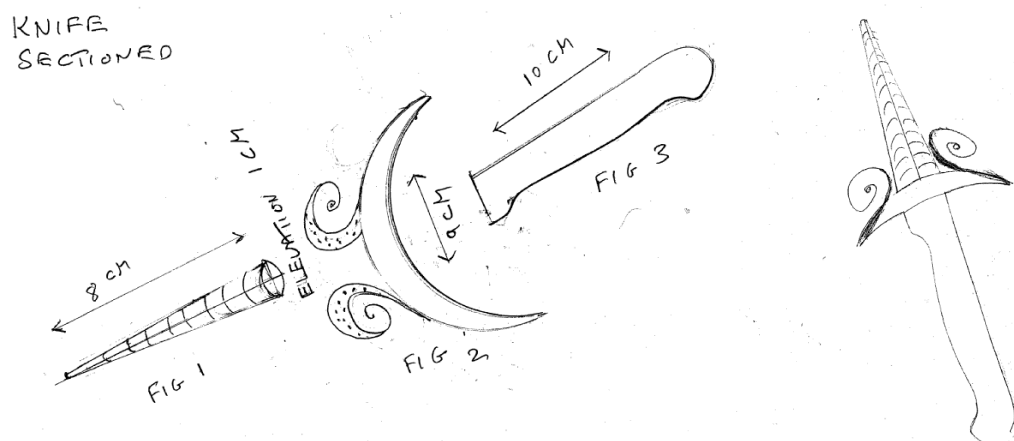
**Introduction**

- 1 Patent application GB 1520033.0 entitled “Oyster safety knife” comprising description and drawings was filed on 13 November 2015 with the claims being filed later on 8 December 2015 (within the period prescribed by Rule 22(1) Patent Rules 2007). The application was published as GB 2544326 on 17 May 2017.
- 2 The initial search was conducted and issued with an examination opinion on 29 April 2016 deferring full examination, warning that the documents found were examples and that further searching might be required at a later stage. The examination opinion set out major points that would be raised if a full examination were conducted including a lack of clarity in the claims and lack of novelty and/or inventive step with reference to three documents. The applicant subsequently requested full examination and filed amended drawings and claims with a letter of 19 July 2016.
- 3 Throughout several rounds of correspondence that followed the examiner has maintained that the amendments of 19 July 2016 result in the application disclosing matter extending beyond that disclosed in the application as filed. The examiner and applicant have been unable to reach an agreement on this issue and the examiner invited the applicant to request a hearing in their letter of 28 September 2018 warning that if they responded without requesting a hearing and without addressing the objections then the application might, nonetheless, be passed for a hearing. The applicant responded on 14 November 2018 with comments but did not request a hearing. The matter has now come to me for a decision on the papers.
- 4 Mr Lawrence is an unrepresented applicant and there is clearly a gap in understanding and communication which has hampered the examination of his application. The examiners processing the case have advised the applicant to consider seeking professional advice in making this application on several occasions and have endeavoured to explain the legal objections in plain English. I have taken this into account in my decision and confirm that I have considered all of the documents on file.

- 5 Questions of lack of novelty, inventive step and clarity in the claims have been deferred pending resolution of this issue. If I find in favour of the applicant, the application will be sent back to the examiner to continue with the substantive examination.

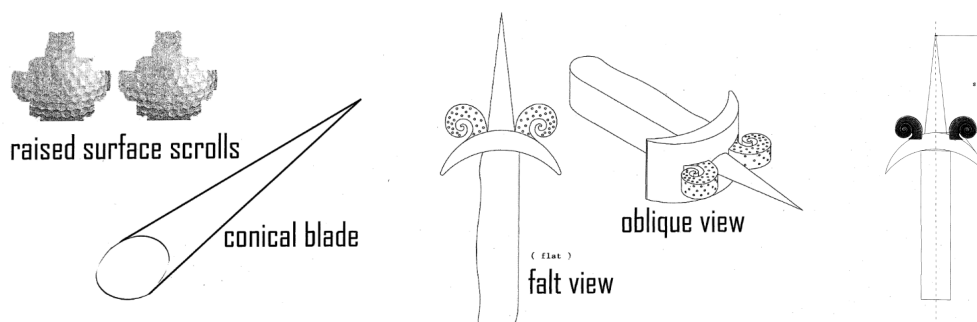
### Invention

- 6 The original description describes an oyster safety knife with a cambered blade rising from a flat rounded tip to a higher elevation at hilt. This shaped blade is said to be designed to facilitate prising open the mollusc and allows for a twisting and turning movement not possible with a conventional flat blade. Side scrolls prevent the blade sliding through the mollusc puncturing the hand holding the oyster thereby protecting both the hand holding the knife and the hand holding the mollusc. The figures below were filed when making the application:



### Amendments

- 7 The amended drawings filed with the letter of 19 July 2016 show:



- 8 The amended claim filed with the letter of 19 July 2016 reads:

*Cone shaped blade acting as wedge locking the blade inside the Oyster; side scrolls, embossed surface, to minimise risk to blade sliding through the Mollusc. Conical shape minimises shell damage when prising open the Oyster; facilitates prising open the Oyster by allowing pivoting motion in all directions.*

## The Law

- 9 The section of the Act concerning added matter is Section 76(2), which reads:

*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.*

- 10 In *Bonzel and Schneider (Europe) AG v Intervention Ltd* [1991] RPC 553 Aldous J described the task of determining whether an amendment result that a patent as granted disclosed matter which extended beyond that disclosed in the application as:

*(1) to ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly in the application;*  
*(2) to do the same in respect of the patent as granted;*  
*(3) 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.*

- 11 In *Richardson-Vicks Inc.'s Patent* [1995] RPC 568 Jacob J summarised this by saying: "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."

## Objections

- 12 The examiner objects that the drawings and inclusion of the following phrases in the amended claim of 19 July 2016 results in the application disclosing matter extending beyond that disclosed in the application as filed:

- i) The replacement drawings ('computer graphics') provide more detail; in particular the detail concerning the blade being conical, raised surfaces and a measurement (65) contained within the "top down view" drawing.
- ii) "*Cone shaped blade*". The original description described the blade as being "*cambered either side*" and not cone shaped. The original drawings show the blade with multiple lines, but these lines do not convey that the blade is conical as these lines can be taken as merely patterns.
- iii) "*embossed surface*". In the original specification there is no disclosure of embossed surfaces, nor would it be clear and unambiguous from the originally filed drawings or description.
- iv) "*minimising shell damage when prising open the oyster*" - the original description does not disclose the blade acting in this way.
- v) "...*by allowing pivoting motion in all directions*" - the original description discusses how the cambered shape "*allows for a twisting and turning*

*movement*”, but there is no disclosure of the shape allowing for movement in all directions.

- vi) “...*acting as a wedge locking the blade inside the oyster*” - the original description does not disclose the blade acting in this way.
- vii) The removal of the feature of the rounded flat tip from claim 1 is considered to broaden the scope of the invention and in doing so adds matter. This is due to the rounded flat tip being an essential feature of the invention and there being no suggestion in the original specification that the knife could have any other shaped tip.

## **Arguments**

- 13 The applicant argues (in relation to points (i) and (iii) above) that the original drawings included dots on the scrolls which were intended to indicate that they were not smooth but indentured/embossed. The applicant also asserts that the initial drawings were not meant to be definitive and there was a clause/caveat included with drawings stating that it was not a definitive representation of the invention.
- 14 Mr Lawrence also states (in relation to point (ii) above) that the change from cambered shape blade to a conical shape occurred following experiments. He also asserts that there is a common feature of curvature between cambered shape blade and conical shaped blade.
- 15 Lastly the applicant suggests (in relation to point (vii) above) that the change from a rounded tip to a pointed tip is an evolution of invention resulting from experiments.
- 16 None of Mr Lawrence’s letters make any comment about points (iv) to (vi).

## **Analysis**

- 17 Mr Lawrence’s comments make it clear that he accepts that the replacement drawings (‘computer graphics’) provide more detail than those originally filed. Indeed, that seems to have been his intention in filing them. I conclude that the replacement drawings add matter.
- 18 Mr Lawrence’s comments also make it clear that he accepts that the feature of a “cone shaped blade” was not included in the original description which instead described the blade as being “cambered either side”. Whilst there may be some overlap between the meanings of the terms “cambered” and “conical” the two do not mean the same thing (if they did there would be no need to use the new term). The lines on the blade in the original drawing would be interpreted based on the original description as illustrating the blade is cambered, not conical. That this change resulted from experiments is not important; such experiments should have been conducted before filing an application or a new application filed. I find that the feature of a “cone shaped blade” adds matter.
- 19 With regards to the “embossed surface” Mr Lawrence’s comments suggest that the amendments were intended to clarify what was originally disclosed; namely that the dots on the scrolls in the original drawings were intended to indicate that they were

not smooth but indented/embossed. However, it is common for drawings accompanying patent specifications to include shading to distinguish between parts. At best the original disclosure is ambiguous as to whether those dots are indicative of there being indentations, embossing or are merely shading. There is no clear and unambiguous disclosure in the original application that the dots represent indentations or embossing. As such this also amounts to added matter.

- 20 The features of “minimising shell damage when prising open the oyster”, “allowing pivoting motion in all directions” and the blade “...acting as a wedge locking the blade inside the oyster” all describe the intended benefit and function of using the conical blade. None of these benefits and functions were stated in the original description. However, if the cambered blade would achieve the benefit and/or function accordingly, then these features might be regarded as implicit. Even if that were true explicitly stating the benefit and/or function would be unnecessary as it wouldn’t add anything. On balance I find that each of these features is added matter.
- 21 The original description states that the provision of a flat rounded tip is to facilitate prising open of the mollusc and this feature may also contribute to reducing the likelihood of puncturing the user’s hand holding the mollusc. There is no suggestion that the tip could be any other shape. Mr Lawrence states that the removal of this feature was the result of experiments thereby implying that these experiments showed it is not essential after all. However, that is not apparent from the original description which suggests that the rounded tip is necessary to facilitate prising open of the mollusc. Omitting this feature from claim 1 therefore also adds matter.
- 22 If the application was moving towards being granted I would be minded to allow Mr Lawrence a further opportunity to amend his application to meet the requirements of the Act. However, the application has not moved in the right direction and nor has Mr Lawrence heeded the advice given despite many opportunities that have been given to him. I do not consider it appropriate to offer him a further opportunity to do so now.

### **Conclusion**

- 23 I have found that the amendments of 19 July 2016 contain added matter, and thus contravene Section 76(2) of the Act. I therefore refuse the application under Section 18(3).

### **Appeal**

- 24 Any appeal must be lodged within 28 days after the date of this decision. I urge Mr Lawrence to consider this matter carefully and seek professional advice before appealing this decision. The costs are likely to be high should he be unsuccessful.

**Mrs S E Chalmers**

Deputy Director, acting for the Comptroller