



PATENTS ACT 1977

APPLICANT Akagi Nyugyo Co. Ltd

ISSUE Whether amendments to patent application
GB1601247.8 add subject matter

HEARING OFFICER J E Porter

DECISION

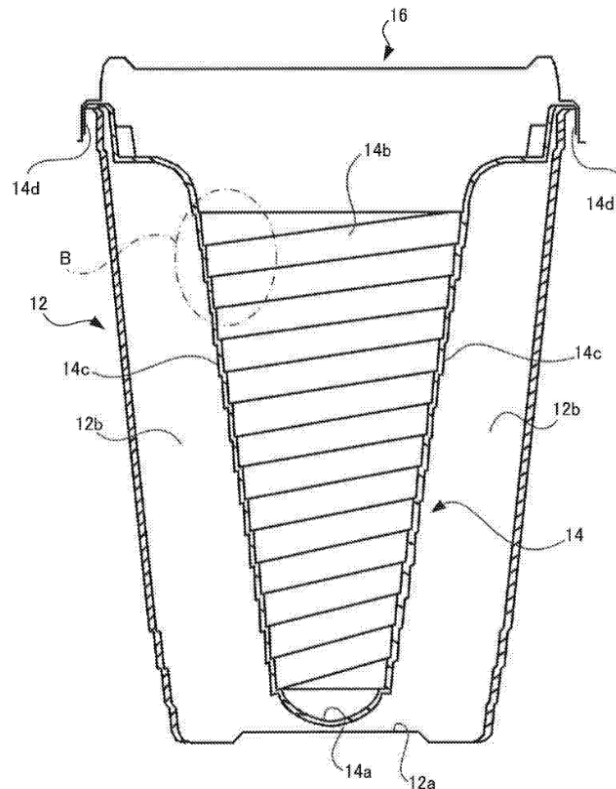
Introduction

- 1 Patent application GB1601247.8 (“the application”) derives from an international application PCT/JP2014/078661 filed under the Patent Cooperation Treaty on 28 October 2014, and claiming a priority date of 27 December 2013. It was published under that Treaty on 2 July 2015 as WO2015/098273 and, after entering the UK national phase, was republished in the UK on 27 April 2016 as GB 2 531 671 A.
- 2 The applicant filed amendments to the application on 15 December 2016, in response to objections raised in the first examination report. The examiner formed the view that those amendments disclose subject matter that was not present in the original application. The point remained unresolved over several further rounds of correspondence.
- 3 The matter was referred for a decision, and a hearing was held before me on 5 November 2018 with Mr Nick Reeve of Reddie and Grose LLP, the patent attorneys representing the applicant. Also present were the examiner, two observers, and Mr Karl Whitfield who was assisting me.
- 4 The compliance date of the application stands at 27 August 2018, having been extended as-of-right by two months, upon the applicant’s request.

The invention

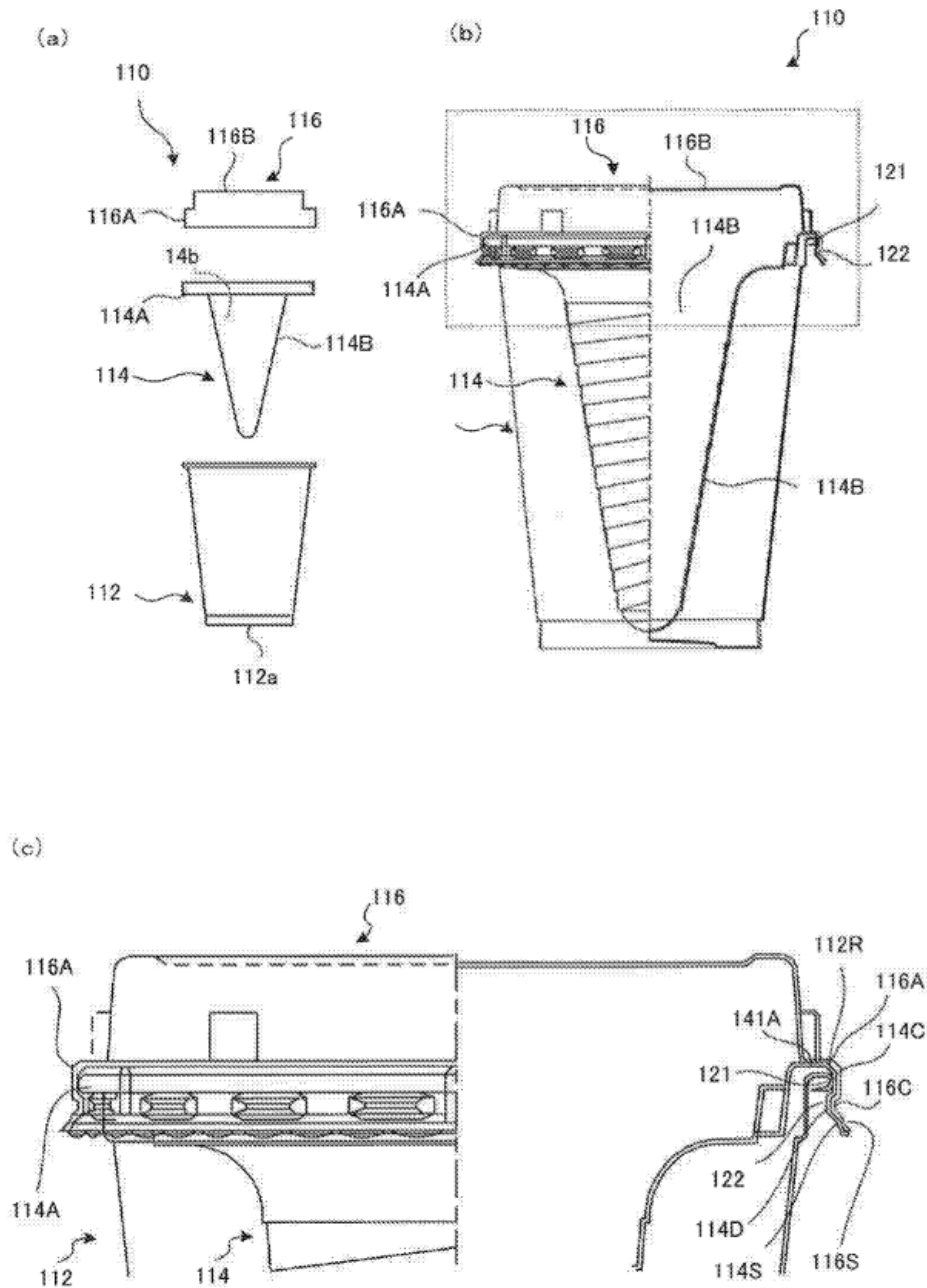
- 5 The application concerns packaging for frozen desserts and associated methods of assembling frozen dessert containers, and in particular containers which hold frozen dessert materials along with separately-contained food or drink material.
- 6 The specification sets out what it calls a “first example”, which is described and also shown in cross-section in figure 2. This example is said to be “included for background interest” but it sets the general context to the invention as well as discussing a number of technical details.

Fig. 2



- 7 The first example shows a molding [sic] container or frozen dessert container 10 with a cylindrical main body 12 for a frozen dessert such as ice cream. The frozen dessert is contained in the inner space 12b.
- 8 It also shows an inner lid 14 and an outer lid 16. The inner lid 14 has an inverted conical shape and is contained partially within the main body 12, the inner lid 14 being fitted to the upper part of the main body 12. The inner lid 14 has an inner space 14b which can hold different edible matter, and the inner lid itself may be edible. The holding portion 14d is used to rotate the inner lid and remove it (and its contents) from the surrounding frozen dessert.
- 9 The outer lid 16 is fitted to the upper portions of the main body 12 and the inner lid 14. According to the description (at paragraph [0019] in the A-published specification, or page 5 line 9 of the later-filed version which had paragraph numbers removed), the outer lid 16 may be substituted for “a seal that can close the main body 12 and the inner lid 14 from above”.
- 10 The specification goes on to describe what it calls a “first embodiment” of the invention, with particular reference to figure 5.

Fig. 5



- 11 This shows a frozen dessert container 110 with a main body 112 for containing a frozen dessert, a first lid or inner lid 114 and a second lid or outer lid 116. The inner lid 114 includes a peripheral edge portion 114A fitted to an opening of the main body 112 and the outer lid 116 includes a peripheral edge portion 116A fitted to the inner lid peripheral edge portion 114A.
- 12 There is discussion of how the inner and outer lids engage with the main body, and it is explained how the inner lid and main body are configured to be more easily separable than the fit structure between the inner lid and outer lid. Thus the inner lid 114 is more likely to be removed with the outer lid 116, rather than remaining in the

main body (and the frozen dessert). The specification then goes on to discuss the method of manufacturing and filling the containers, and their use to produce and consume a frozen dessert or drink.

Proposed amendments

- 13 The amended claim set filed on 15 December 2016 gave rise to the added matter objection – specifically that subject matter had been added to (what were then) independent claims 1 and 5.
- 14 During the subsequent rounds of correspondence, some further amendments were filed but these made no further textual changes to the two claims in question, other than claim 5 renumbered as claim 4. The proposed two claims (as already on file) now form the “main request” filed by the attorney upon requesting a hearing. Three auxiliary claim sets were also sent in for consideration but it is not necessary to reproduce them here.
- 15 The two independent claims in question, as sought to be amended, read as follows – with changes from the previous (pre-added matter objection) version of each claim shown:

1. A frozen dessert container assembling method of assembling: a main body capable of containing a frozen dessert; a first lid including a first peripheral edge portion and a protrusion that forms an inner space on an inner radius side of the first peripheral edge portion; and a second lid including a second peripheral edge portion and a cover portion, the frozen dessert container assembling method comprising the steps of:

feeding the main body;

causing the protrusion of the first lid to be contained in the main body to form a mold for molding a recess in the frozen dessert and attaching the first peripheral edge portion to an opening of the main body at a first fitted portion such that the first peripheral edge portion can be removed from the opening of the main body at the first fitted portion with a first force;

and

covering the inner space of the first lid with the cover portion of the second lid and attaching the second peripheral edge portion to the first peripheral edge portion by fitting or sealing such that the second peripheral edge portion can be removed from the first peripheral edge portion with a second force which is greater than the first force so that in a state in which the first peripheral edge portion is separable from the opening more easily than from the second peripheral edge portion.

4. A frozen dessert container comprising:

a main body capable of containing a frozen dessert;

a first lid including a first peripheral edge portion and a protrusion that forms an inner space on an inner radius side of the first peripheral edge portion; and

a second lid including a second peripheral edge portion and a cover portion; wherein

the first lid is configured such that the first peripheral edge portion can be attached at a first fitted portion to the opening of the main body so that the protrusion is contained in the main body in order to form a recess in the frozen dessert, and

the second lid is configured such that the cover portion covers the inner space of the first lid and the second peripheral edge portion can be attached to the first peripheral edge portion by fitting or sealing, wherein the opening and the first and second peripheral edge portions are configured such that ~~in a state in which~~ the first peripheral edge portion is separable from the opening at the first fitted portion with a first force and the second peripheral edge portion is separable from the first peripheral edge portion with a second force which is greater than the first force so that the first the first [sic] peripheral edge portion is separable from the opening more easily than from the second peripheral edge portion.

- 16 There has been no objection to most of the proposed additional text. The examiner's view is that added matter arises because these two claims introduce the option of attaching the second peripheral edge portion of the second lid to the first peripheral edge portion of the first lid by sealing alongside the other features claimed.

The law

- 17 Section 76(2) of the Patents Act 1977 reads as follows:

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.

- 18 In this case the examiner objected that matter had been added through a process of intermediate generalisation, explained in the *Manual of Patent Practice* as follows:

76.15.3 Amendments which limit the scope of a claim by the introduction of one or more features from the description or claims may in certain circumstances add matter through what is known as "intermediate generalisation". This concept was explained by Pumfrey J in Palmaz's European Patents (UK) ([1999] RPC 47, upheld on appeal [2000] RPC 631):

"If the specification discloses distinct sub-classes of the overall inventive concept, then it should be possible to amend down to one or other of those sub-classes, whether or not they are presented as inventively distinct in the specification before amendment. The difficulty comes when it is sought to take features which are only disclosed in a particular context and which are not disclosed as having any inventive significance and introduce them into the claim deprived of that context. This is a process sometimes called 'intermediate generalisation'."

[...]

76.15.6 It is worth noting that the disclosure of the application includes all the information that the skilled person may ascertain about the invention. An intermediate generalisation is considered to add matter (at least in part) because it results in the skilled addressee being presented with information which they could not have derived from the application as originally filed, concerning the importance of the newly claimed feature. This new understanding is the 'matter' which is added. ...

- 19 The examiner relies on the case law referenced in the passage quoted above, and also refers to *Nokia v IPCOM* [2013] RPC 5 as a basis for it not being permissible to introduce into a claim a feature taken from a specific embodiment unless the skilled person would understand that the other features of the embodiment are not necessary to carry out the claimed invention. Kitchin LJ (as he then was) said this:

59. It follows that it is not permissible to introduce into a claim a feature taken from a specific embodiment unless the skilled person would understand that the other features of the embodiment are not necessary to carry out the claimed invention. Put another way, it must be apparent to the skilled person that the selected feature is generally applicable to the claimed invention absent the other features of that embodiment.

60. Ultimately the key question is once again whether the amendment presents the skilled person with new information about the invention which is not directly and unambiguously apparent from the original disclosure. If it does then the amendment is not permissible.

- 20 The attorney points in his submissions to *Demel v Jefferson* [1999] FSR 204 as providing guidance on how to approach added matter. He notes that the *Demel* judgment refers to the well-known steps set out in *Bonzel and Schneider (Europe) AG v Intervention Ltd* [1991] RPC 553, where Aldous J (as he then was) stated:

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 [or, in this case, the application as amended].

(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.

- 21 The attorney also points to *Demel* recommending the adoption of “a common sense approach” rather than a “narrow literal interpretation”, and how it confirms that the relevant disclosures must be considered through the eyes of the notional skilled addressee. Thus paragraph 29 of the judgment refers to the “natural meaning of the application to a man skilled in the art” and to what it “implicitly, but clearly, discloses”.
- 22 Finally, the attorney also refers briefly to case T 0679/11 from the EPO Technical Board of Appeal, which notes that:

The information content of a European patent application was determined by (i) the explicit i.e. literal disclosure of the invention, namely the description, the claims and the drawings, as well as (ii) the disclosure implicit in the patent application i.e. what any person skilled in the art would consider necessarily implied by the patent application as a whole (e.g. in view of basic scientific laws).

23 I treat this last submission with some caution, as the paragraph relied upon by the attorney is paragraph IX of the judgment, which is clearly stated to be a summary of the respondent's (i.e. patentee's) arguments, and is not part of the reasoned decision by the Board of Appeal. In its reasoning, the Board does go on to consider implicit disclosure, but notes at paragraph 6 that:

An implicit disclosure means a disclosure which any person skilled in the art would objectively consider as necessarily implied in the explicit content. It means no more than the clear and unambiguous consequence of what is explicitly mentioned.

24 That seems to be on all fours with the “clearly and unambiguously” wording of the final *Bonzel* step. Thus I agree with the attorney that the cases above set out the correct approach that I must adopt when assessing added matter. I should add that *Nokia* seems to be entirely consistent with the other case law referred to here.

Analysis

25 As already noted, the added matter point is simply the question of whether added matter arises because the amended claims introduce the option of attaching the second peripheral edge portion of the second lid to the first peripheral edge portion of the first lid by sealing, in the context of the other claimed features.

26 It is not in dispute that – within the context of the first example – there is disclosure at paragraph [0019] that the container “*may include, instead of the outer lid 16, a seal that can close the main body 12 and the inner lid 14 from above*”.

27 However, the examiner argues that it is the first embodiment which describes how an inner and outer lid are nested together, and how the degree of fit (and thus the frictional force) between the inner lid 114 and main body 112 is weaker than the degree of fit (and frictional force) between the inner lid 114 and outer lid 116 – in order to facilitate removal of the inner lid with the outer lid.

28 Thus the examiner argues that “the skilled person would understand how to vary the coefficient of friction between the outer and inner lid, and the inner lid and main body, in order that a greater force will be required to remove the outer lid from the inner lid, than to remove the inner lid from the main body. However, there is no teaching or support in relation to the degree of fit between a first lid and the main body, and a **seal** and the first lid” in order to facilitate removal of the inner lid with the outer seal. In particular, the examiner notes that the term “degree of fit” used in the first embodiment indicates shaped lids with a degree of rigidity, and not the attachment of a flexible film seal as an alternative to the outer lid.

29 This leads the examiner to conclude that the amended claims combine two sub-classes of the invention in order to make an unallowable intermediate generalisation – one being a subclass which uses a seal in place of the outer lid, and the other being a subclass where the force needed to remove the outer lid from the inner lid is greater than the force needed to remove the inner lid from the main body (which I shall call the “different forces” feature).

30 The applicant disagrees and advocates the “common sense approach” referred to in *Demel*. They argue that the two sub-classes identified by the examiner are not disclosed in a particular and isolated context with no inventive significance and as

such do not (when combined in the claim) form an intermediate generalisation in the sense discussed in *Palmas*. They are not distinct, separate embodiments but form part of a more general teaching. To say that there is no disclosure in the specification of the combination of the different forces and sealing features is, they argue, to overlook what is both explicitly and implicitly disclosed. These points were made in further detail at the hearing.

- 31 In particular the applicant contends that it is incorrect to view the different forces feature as depending entirely on the fit between the two lids and the main body, such that it cannot be combined with an example of the invention which employs a seal. They argue that the skilled person would understand that the drafter of the specification contemplated a seal as an alternative to the outer lid within the overall teaching, and that the different forces feature could then be achieved by applying a suitable adhesive.
- 32 As well as the paragraph [0019] seal reference, the applicant points to other references in support of a seal feature. They contend that the wording of paragraph [0048] has the effect of carrying through the seal alternative of the first example as an option in the first embodiment. They also point to paragraphs [0091], [0106] and [0114] which refer to the frozen product being “filled and sealed”.
- 33 The applicant also points to paragraph [0125] which states that “*if the inner lid peripheral edge portion 114A of the inner lid 114 is designed to have sufficient strength, the outer lid 116 may be a seal-shaped cover member*”. The attorney explained that the Japanese character in the original PCT application could be used to refer to a seal, cover or sticker which is adhered to form the seal (such as a sealed film covering a yoghurt pot). Thus, at the hearing, the attorney explained his understanding that at this point the draftsman contemplated including a yoghurt-pot type of lid instead of the alternative, already disclosed, outer lid. He contends that this amounts to explicit disclosure (admittedly very brief) of the claimed feature, either because paragraph [0125] qualifies all of the previous disclosure or because the paragraph qualifies the first embodiment which also contains the different forces feature.
- 34 Further regarding paragraph [0125], the attorney had argued in an earlier exchange with the examiner that the reference to “sufficient strength” meant that sufficient strength is required to avoid deformation of the inner lid during removal of the outer seal, and so this was clear teaching that the removal force of the outer seal was higher than the removal force of the inner lid from the main body.
- 35 The examiner rejected this view, pointing out that there is no discussion in the paragraph or the adjoining ones about the different forces feature, and suggesting that the “sufficient strength” reference was a pointer back to earlier discussions in the embodiment concerning how the inner lid could enhance the strength of the frozen product and main body. Thus paragraph [0125] was teaching that, if the inner lid itself had sufficient strength to maintain the necessary overall strength of the product and main body, no further support in that regard was needed from the outer lid which could thus be replaced by a seal-shaped cover member.
- 36 The attorney made clear at the hearing that he regarded the examiner’s view on this interpretation point as “entirely reasonable” but did not resile from also regarding the

“sufficient strength” reference as being understood by the skilled person to point to the different forces feature. In any event he reiterated that the skilled person would understand from the teaching of paragraph [0125] that, so long as the condition required by the different forces feature was satisfied, it was possible to replace the rigid outer lid with a seal-like cover in the first embodiment.

37 For completeness, it was noted at the hearing that there was no disagreement over the skilled person being a specialist in the technology of packaging food.

38 In accordance with *Bonzel*, I must ascertain through the eyes of the skilled addressee what is disclosed, both explicitly and implicitly, in the application as filed in respect of the point at issue.

39 I deal first with applicant’s reliance on paragraphs [0091], [0106] and [0114] which refer to the frozen product being “filled and sealed”. I note that paragraph [0091] in particular makes this reference in the context of this sentence:

In addition, due to the double structure of the inner lid 114 and the outer lid 116 in the lid portion, the strength of the frozen dessert product 20 in which the frozen dessert 18 is filled and sealed can be enhanced.

40 It seems to me that the skilled person would understand immediately from the context of the entire description that the frozen dessert needs to be satisfactorily contained, so it does not leak out. Hence the inner and outer lids need to engage in a way which achieves this. Given the context in which “sealing” is mentioned in paragraph [0091], it seems clear to me that the skilled person would take “sealing” here as being no more than a reference to the inner and outer lids engaging to achieve the aim of no leakage of the dessert. I do not agree that it teaches any specific alternative method of achieving the desired containment.

41 Similarly, I do not think the references in paragraphs [0106] and [0114] get the applicant any further in this regard, since they are also in my view general references to the dessert being filled into the container, and then suitably contained using the lids described. I believe this takes the sort of “natural meaning” and “common-sense approach” advocated in *Demel*.

42 Paragraph [0019] is of course different. Here, there is explicit differentiation made between the outer lid and an alternative seal solution. This is not in dispute but it does not by itself solve the added matter point because the reference falls within the first example which (as already noted) does not contain the different forces feature.

43 I then turn to the arguments over paragraphs which are said to link the features of the first example and the first embodiment – namely paragraphs [0048] and [0125].

44 On paragraph [0048], the only sentence of relevance seems to be the one which states that “In the first embodiment, configurations of which descriptions are omitted are similar to those of the main body 12, the inner lid 14 and the outer lid 16 of the first example”. I fail to see how this clearly and unambiguously carries through the seal alternative from the first example, in the way contended by the applicant.

45 Turning to paragraph [0125], I reject the applicant’s argument that it explicitly qualifies all of the previous disclosure. The preceding paragraphs and the reference

numerals in paragraph [0125] all point the skilled person to a clear understanding that the paragraph refers to the first embodiment. I also think it highly unlikely that the skilled person would understand that the reference to “sufficient strength” of the inner lid peripheral portion is an implicit teaching that the removal force of the outer seal from the inner lid is to be higher than the removal force of the inner lid from the main body. I agree with the examiner that a much more likely understanding would be that the outer lid could be replaced by a seal-shaped cover member provided the inner lid by itself has sufficient strength to maintain the required rigidity of the main body. Nevertheless, it seems wholly clear that paragraph [0125] plants in the skilled person’s mind the general idea that the first embodiment may, as an alternative, have the outer lid replaced with a seal-shaped cover.

- 46 This sets the context for a wider point, and I must bear in mind that the question of what the skilled person would take from the disclosure and be able to accomplish is a question of fact to be decided on the balance of probabilities.
- 47 On that basis, I think there is force in the argument that the skilled person would – more likely than not – perceive a degree of interplay between the first example and the first embodiment, seeing the former as setting out context and details for the latter, and encouraged in that view by the common terminology, the closely-related reference numerals for common components (14 and 114, 16 and 116, etc), and so on. I also think on this basis that, when the skilled person reads paragraph [0125], they will not have forgotten about paragraph [0019] and the clear alternative suggested there of replacing the outer lid with a seal.
- 48 With reference to *Nokia* and *Palmas* this means I accept, on the balance of probabilities, that it would be apparent to the skilled person from paragraphs [0019] and [0125] that the seal alternative is generally applicable to the claimed invention, and is not disclosed only in the particular context of the first example alone, when reading the specification as a whole. This means it is not susceptible to creating an intermediate generalisation when added to the claim.
- 49 The skilled reader would thus have understood the specification to disclose sealing, as an alternative to fitting, for attaching the peripheral edge portion of the second lid to the peripheral edge portion of the first lid, within the context of the different forces feature of the first embodiment. It follows that the skilled person would understand that the explicitly-disclosed different forces feature would require, as an implicit but clear and unambiguous consequence, that it should be harder to remove the seal from the inner lid than to remove the inner lid from the main body, and I find it is more likely than not that this would be within the scope of the skilled person to achieve. If there is doubt on this factual point then I accept that the applicant is entitled to the benefit of that doubt.
- 50 This analysis answers the first *Bonzel* question. The answers to the remaining *Bonzel* questions are straightforward. The application as currently amended also discloses the above, through the same text and also the disputed additional claim wording. Thus in comparing the two disclosures no subject matter has been added. The disputed claim wording does not present the skilled person with new information about the invention which is not directly and unambiguously apparent from the original disclosure.

51 Having concluded that the main request does not add any subject matter, there is no need to go on to consider the auxiliary requests.

Outstanding clarity matters, and the compliance period

52 The examiner raised two potential clarity issues that could arise in the circumstances where the amended claims were found to be acceptable. It was agreed at the hearing that these points were minor. They concern, first, whether certain the passages of text identified in paragraph 18 of the pre-hearing report obscure the scope of the invention by referring to being “according to the present invention” and, second, whether the first example (as discussed above) obscures the scope of the claims since it does not include the different forces feature.

53 In terms of the first point, the passages identified are not strictly word-for-word in accordance with the claims, but I am satisfied there do not appear to be inconsistencies that would cause the skilled person to question the scope of the claims. I note that the claims are fully supported by statements on invention on pages 2 and 3 of the current version of the description.

54 Turning to the second point, I have already noted that the first example is stated as being “included for background interest”, and that figure 5 is referred to as the “first embodiment” of the invention (and, by clear implication, the only embodiment). This figure and embodiment has its own set of slightly different reference numerals from the first example, and is itself consistent with the claims. For these reasons I do not see that the skilled person would have difficulty construing the scope of the claims because of the presence of the first example. In particular, I do not see that they would struggle to understand the scope of the claimed different forces feature.

55 Hence the application complied with the requirements of the Act and Rules on the compliance date. This renders moot any question of whether there is a legal basis for extending the compliance period further, or whether there is a legal basis for allowing further amendments. I make no finding in that regard, although I am grateful to the attorney for making submissions on these points after the hearing at my request.

Conclusion

56 The claims forming the main request do not add subject matter to the application as filed. The application was in order for grant on the compliance date.

Dr J E PORTER

Deputy Director, acting for the Comptroller