



## PATENTS ACT 1977

APPLICANT Snap-on Incorporated

ISSUE Whether patent application GB1407786.1 contains added matter, contrary to section 76(2) of the Patents Act 1977

HEARING OFFICER pe

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### DECISION

#### Introduction

- 1 Patent application GB1407786.1 relating to an electronic torque wrench was filed on 2<sup>nd</sup> May 2014 by Snap-on Incorporated. The application has a claimed priority of 7<sup>th</sup> May 2013. The application was published as GB2514264 A on 19<sup>th</sup> November 2014. The period under section 20 for complying with the requirements of the Patents Act and its Rules has been extended until 7<sup>th</sup> January 2018.
- 2 The latest amended claims were filed on 14<sup>th</sup> September 2017 and include four independent claims, claims 1,5,15 and 16. The examiner has objected that the amended claims add matter to the application as originally filed contrary to section 76. In a letter dated 6<sup>th</sup> October 2017 the applicant requested a decision on the issue of added matter based on the papers on file.

#### The law

- 3 Section 76 to the extent relevant here reads as follows:

(2) 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.
- 4 Guidance on section 76 has been provided in *Richardson-Vicks Inc's Patent*<sup>1</sup> where Jacob J (as he was then) noted:

*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.*

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<sup>1</sup> *Richardson-Vicks Inc.'s Patent* [1995] RPC 568

and in *Bonzel and Schneider (Europe) AG v Intervention Ltd*,<sup>2</sup> where Aldous J (as he was then) 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].*

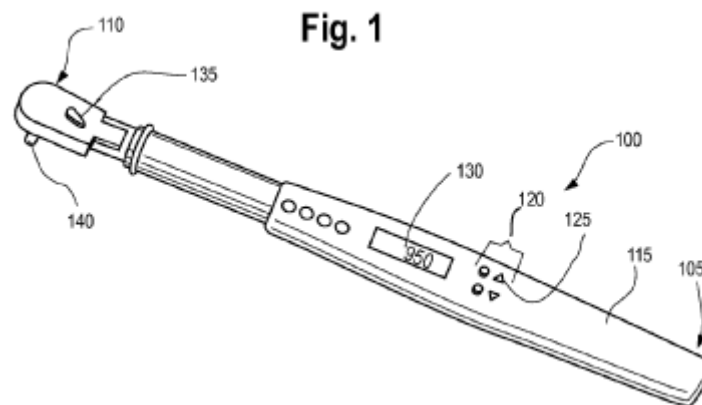
*(c) To compare the two disclosures and decide whether any subject matter relevant to the invention has been added whether by deletion or addition. The comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either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

### The application as filed

- 5 The application as filed sets out the problem to be solved as providing “a torque application tool that can monitor and record the amount of torque and/or angle applied to a work piece in real time, and then transfer this data to an external device such as a computer for further review and analysis to ascertain the optimal torquing procedure”. The description in describing a non-limiting preferred embodiment goes on to note that the computer can

“create a graph that can be analyzed to determine relevant parameters, such as torque and/or angle application amount or duration, of the torquing profile. The parameters of the graph can be analyzed to determine whether the torquing operation was performed properly for a particular work piece or job task.”

It notes further that the data can be plotted and analysed with the external device “to determine an optimum torquing profile to apply to future torquing operations for that particular work piece or job task”.



<sup>2</sup> *Bonzel and Schneider (Europe) AG v Intervention Ltd* [1991] RPC 553

6 The application further notes that the tool (as shown in figure 1 above) has an interface 120 “for allowing the user to input instructions or other information into the tool”. The tool’s control unit includes a memory “for storing data and/or computer programs”, a processor “for controlling operation of the control” and a transceiver “for transmitting and receiving data relating to the tool to external sources, such as a personal computer”. The transceiver is described as:

“any device capable of transmitting data from the tool or capable of receiving data within the tool from an external data source. By way of example, the transceiver 160 can be any type of radio transmission antenna, cellular antenna, hardwired transceiver, or any other type of wired or wireless transceiver capable of communicating with an external device. In an embodiment, the transceiver 160 is a USB port capable of connection with a USB cable or USB flash drive, which is connected or connectable to a personal computer or other external device”.

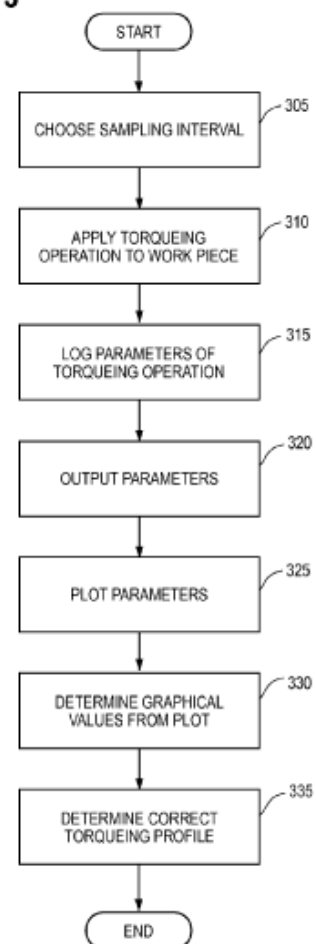
7 The process by which the tool operates according to the preferred embodiment is set out in figure 3. The process begins by the user choosing the interval at which the torquing data is measured, e.g. the interval at which the torque and/or angle values are sensed. The process then proceeds to applying a torquing operation to the work piece and logging the torque and/or angle values of the work piece into the memory.

8 Once the parameters are logged as data in the memory, the data can be output through the transceiver. The application notes that the data can be transferred wirelessly or by any wired means, for example a USB interface through the transceiver to, for example, a personal computer for analysis.

9 The parameters are then plotted for analysis. For example, the parameters can be plotted with the angle on the X-axis and the torque value on the Y-axis. Various graphical values can be determined from the plot and from those values, the correct or optimum torquing profile can be determined.

10 After explaining that the data collected by the tool can be used to determine the correct torquing profile to apply to future work pieces or to determine whether the existing work piece has been properly torqued, the description states that the “operator can be notified by any visual (e.g. LED or LCD), tactile (e.g. vibration) or audible signal that the fastener was properly or improperly torqued.” The description does not provide any further details on how this is achieved.

Fig. 3



## The application as amended

- 11 I will focus at least initially on amended claim 5 as this more clearly brings out the matter that the examiner believes has been added. Claim 5 as amended reads as follows:

A method of analysing torque application data for a tool having a head adapted to apply torque to first and second similar work pieces, a sensor operably coupled to the head and adapted to measure amounts of torque applied to the work pieces, and a memory operably coupled to the sensor, comprising

establishing a frequency at which respective measurements of the amount of torque applied to the first work piece are stored in the memory,

applying the torque to the first work piece,

storing data including the respective measurements of the amount of torque applied to the first work piece in the memory at the frequency;

transmitting the data from the memory to a device external of the tool,

analyzing the data with the device external to the tool to determine an optimum torqueing profile for the first work piece, and

receiving, from the device external to the tool, procedure data including the optimum torqueing profile in the memory for a torqueing operation of the second work piece.

- 12 It is the final step of ***“receiving, from the device external to the tool, procedure data including the optimum torqueing profile in the memory for a torqueing operation of the second work”*** that the examiner argues adds matter.
- 13 The skilled person, who I take to be a person or team of people familiar with designing this type of tool and with an understanding of how it could be used, would ascertain that the application as filed discloses a tool that has the capability to receive data from a device external to the tool. This is clearly brought out in those parts of the description relating to the transceiver that I have referred to above. The skilled person would also understand that the tool’s memory is capable of storing a particular torqueing profile, indeed this is its primary purpose, albeit as part of the process to determine the optimum profile.
- 14 What is less clear is whether the application as filed discloses unambiguously, either explicitly or implicitly, the step of the external device transferring the optimum torqueing profile to the tool. The process, so far as it relates to the preferred, though non limiting, embodiment discussed above ends with the determination of the optimum torqueing profile by the external device. There is no further step of that profile being received by the tool through the transceiver. That the tool is able to alert the user that the fastener was properly or improperly torqued suggests that the tool receives some information to confirm this, or to enable the tool itself to determine it. This could for example be achieved by the tool sensing and capturing the applied torqueing profile, transmitting this to the external device which compares it with the optimum profile and the external device then transmits a confirmation back to the tool if the profiles do or do not match. Alternatively the tool itself could be provided with the optimum profile by the external device and the tool undertakes the

comparison with the sensed profile. This scenario would require the final step set out in the amended claim. However what matters so far as section 76 is concerned is not whether the skilled person, in seeking to give effect to something disclosed in the application, could do it in the way that the applicant now seeks to rely on. Rather what is required is that that way is unambiguously disclosed either explicitly or implicitly in the application as filed and in this case it is not. The proposed amendment to claim 5 therefore adds matter contrary to section 76.

- 15 The examiner has objected that the amendment to claim 1 similarly adds matter. I am not persuaded that the position is necessarily as clear as it for claim 5. The amended claim 1 reads as follows:

A tool having a head adapted to apply torque to first and second similar work pieces comprising:

an interface adapted to receive a sampling interval indicating a predetermined frequency;

a sensor operably coupled to the head and adapted to measure, at the predetermined frequency, respective amounts of torque applied to the first work piece, thereby creating torque measurements respectively representing the amount of torque applied to the first work piece at the predetermined frequency;

a memory operably coupled to the sensor and adapted to receive and store data including the torque measurements; and

a transceiver operatively coupled to the memory and adapted to;

transmit the data to a device external of the tool which then determines an optimum torqueing profile for the first work piece based on the data; and

receive from the external device the optimum torqueing profile for applying torque to the second work piece.

- 16 It is I believe important to note firstly that this is a claim to a tool. In other words it is a product claim unlike claim 5 which is a method or process claim. Hence any limitations included in claim 1 would be expected to be functional or technical limitations relating to the tool itself. The claim seeks however to define a number of the features of the tool by what they are “adapted to” do. The phrase “adapted to” has generally been considered to mean the same as “suitable for”<sup>3</sup> and I can see no reason why that would not be the case also here. So for example the receiver needs to be suitable for transmitting torqueing data to an external device and receiving optimum torqueing data back from the device.

- 17 The application as filed clearly discloses that the transceiver needs to be suitable for transmitting the sensed torqueing data to the external device. It also makes it clear that the transceiver is suitable for receiving data from the external device. The question is whether the requirement that it is suitable for receiving the particular optimum torqueing data imposes any further functional limitation on a receiver that is just stated as being able to receive “data”. In other words is the nature of the data associated with the optimum torqueing profile such that the transceiver requires some particular functionality or feature? I struggle to see how the particular nature of

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<sup>3</sup> *FH Brundle v Perry* [2014] EWHC 475 (IPEC)

this data would impose any such additional requirements on the transceiver. If that is the case then amending the claim to refer to the transceiver being adapted to receive the profile does not as a matter of substance add anything to the claim. Hence the amendment cannot be considered to add matter. I would stress that this does not mean that the amended claim does not give rise to other objections for example clarity or that it overcomes the objection or defect that the amendment was presumably intended to overcome. Those are not matters for me here. I would add also that if I am wrong about this clause not defining a limiting feature of the receiver, then the amendment would fall foul of section 76 since the application as filed does not unambiguously disclose, either explicitly or implicitly, any such feature of the transceiver.

- 18 Added matter objections have also been made against amended claims 15 and 16. Claim 15 relates to a tool including a processor *“including instructions to ... receive from the external device, via the transceiver, and store in the memory the optimal torque profile; and use the optimal torque profile for a future torqueing operation of the second work piece”*. For the reasons I have already set out, I am satisfied that the application does not unambiguously disclose, either explicitly or implicitly, either the step of the transceiver receiving from the external device the optimum torqueing profile. Further the application as filed does not similarly disclose the tool as having a processor with instructions to do that. Claim 15 as amended also therefore adds matter contrary to section 76.
- 19 Amended claim 16 is directed to *“An external device”* that amongst other things is adapted to *“transmit to the tool the optimal torque profile to be used by the tool for a future torqueing operation of the second work piece”*. Again for the reasons set out above I am satisfied that there is no suitable disclosure of this and hence claim 16 also adds matter contrary to section 76.

### **Conclusion**

- 20 I find that claims 5, 15 and 16 as amended on 14<sup>th</sup> September 2017 add matter to the application as filed contrary to section 76. The amendment to claim 1 that is considered by the examiner to add matter does not as I have construed the claim limit the claim in any meaningful way and hence does not add matter. If the applicant is able to demonstrate that the amendment limits the scope of the claim then it will add matter contrary to section 76.
- 21 I am not in a position to refuse this application since there is time remaining before the expiry of the extended compliance period and the applicant may be able to put forward further amendments that overcome the added matter objection and which are also otherwise acceptable. The onus is therefore on the applicant to file such amendments. If no further amendments are filed then the application will be refused once the compliance period as extended has expired.

### **Appeal**

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

