



PATENTS ACT 1977

APPLICANT David John Jones

ISSUE Whether patent application GB1714567.3 complies with Section 14(3), Section 14(5)(b), and Section 76(2) of the Patents Act 1977

HEARING OFFICER Mr. Peter Mason

DECISION

Introduction

- 1 Patent application GB1714567.3 was filed on 11 September 2017. It was published as GB 2558705 A on 18 July 2018. It claims priority to 12 January 2017 from earlier application GB1700546.3.
- 2 The applicant has chosen to process their application themselves rather than to use the services of a patent attorney or the like. Consequently, the application was examined within the Office's Private Applicant Unit (PAU) which specialises in processing applications from self-represented applicants.
- 3 A combined search and substantive examination report was issued on 22 February 2018 reporting the claims were of unclear scope amongst other things. Following many rounds of correspondence, the examiner formed the firm opinion the application could not be granted and in their letter of 8 August 2019 invited the applicant to request their views be heard by a hearing officer; the applicant declined this opportunity.¹ Following further correspondence, the examiner informed the applicant in their letter of 24 January 2020 that they were referring the application to a hearing officer to decide whether it meets the requirements of the Patents Act 1977 (hereafter, the Act). An in-person hearing was agreed with the applicant and arranged for 27 February 2020. However, the applicant subsequently asked to cancel that hearing.² Unfortunately, that coincided with the truly exceptional on-going circumstances of the national lockdown caused by the COVID-19 pandemic. Subsequently, the applicant has declined to attend any telephone or video hearings as are held for all other applicants in the current circumstances. The applicant has

¹ Applicant's email of 9 August 2019

² Applicant's letter of 10 February 2020

repeatedly insisted they must have the opportunity to attend an in-person hearing.³ The applicant declined the final offer to arrange a telephone or video hearing⁴ and so the application has been forwarded to me to make a decision based on all the papers on the file.

The invention

- 4 The application describes a bricklayer's 'profile tool' for positioning a building line when laying courses of brickwork. The tool comprises a staff attached to a clamp. The clamp has jaws to attach the tool to the brickwork while bolts and handwheels allow positioning. Arrangements of stays and hitches variously hold the tool in place and allow the line to be positioned at gauge marks. The application states essential parts are extruded from aluminium, steel or composite materials. The application briefly indicates parts of the tool can be utilised as components in a variety of other building situations.
- 5 The application was filed with a single main claim directed to one or more extrusion dies along with 35 dependent claims. The claim set has been amended on several occasions with the current single claim being filed on 14 August 2018 and directed to extrusion dies:

I hereby claim unique extrusion dies to produce aluminium or steel or a composite material which can be cropped to use as a construction configuration for all architectural designed buildings whereby its specific fabrication and friction and gauge marks will allow the unit to set for all the dimensions of the whole integral unit to work in unison and will also govern for all types of building material and construction dimensions to build any configuration of wall whereby the clamp jaws have a hammer head feature that will allow it to fix to any construction material without causing damage to that material whereas the lower jaw will adjust in a staff through sliding aperture to actuate on and with a thread bolt of which the upper jaw can fix to any length of the staff to allow the hand wheels and main bolt nut and other adjusting screws in each jaw which are protected in the jaws internal aperture which will gather in all of the essential parts to fix the unit to the lowest fulcrum pressure of staff line pull and in order to set the unit to plumb or an angle which will govern the dimensions for setting the line hitch to each gauge mark and allow the process of incrementally setting the line hitch in its hitch slot for any architectural design of wall which likewise will also allow for an incrementally adjustable friction plate to carry additional devices in its recess or about the staff if needed that will allow bolts to actuate against or with or on the staff or across a wall to fix and allow the construction to progress without any obstructions from the integral clamp staff device.

The issues to consider

³ Applicant's correspondence: email of 27 March 2020; email of 2 April 2020; email of 28 April 2020; email of 30 April 2020; letter dated 12 May 2020; letter dated 30 September 2020; email of 3 October 2020; letter dated 10 October 2020

⁴ Office correspondence (email) of 29 September 2020

- 6 The examiner's objections to the application are set out in their letter of 24 January 2020. There are three issues:
1. Whether the invention is sufficiently disclosed as required by Section 14(3)
 2. Whether the amended claim discloses added matter as set out in Section 76(2)
 3. Whether the amended claim clearly defines the scope of the invention as required by Section 14(5)(b)
- 7 Although the examiner has not explicitly stated it, the sufficiency question is one of classical insufficiency. This is conveniently described by the judge in *Zipher Ltd v Markem Systems Ltd*⁵:

"The first, or so-called classical insufficiency, is where following the express teaching of the patent does not enable the skilled addressee to perform the invention." (paragraph 363)

- 8 If the conclusion of this issue is that the application is sufficient, then I will be able to move on to the other issues. However, if I decide the application does not clearly teach how to perform the invention, then the other points do not need to be considered because there can be no remedy..
- 9 I think it will be useful for me to explain why there can be no remedy for applications which do not sufficiently disclose their invention. Patent legislation allows only very restricted *amendment* or *correction* to an application once it is filed. That is, aspects of a patent application might be able to be made more clear or more certain, and clear errors can be corrected, but it is a pillar of the global patent system that no new information can be added after the application has been filed. Section 76(2) of the Act expressly states:

(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.

- 10 Therefore, if I cannot find the information I need in the application as it was filed on 11 September 2017, then the only solution would be to add new information. That new information would, by definition, extend beyond what was disclosed in the application as filed.

Whether the invention is sufficiently disclosed

- 11 The requirement to sufficiently describe the invention of an application is set out in Section 14(3) of the Act:

⁵ [Zipher Ltd v Markem Systems Ltd \[2009\] FSR 1](#)

(3) *The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.*

12 A useful summary of the rationale for the legislation on sufficiency is set out in *Zipher*⁶:

“...the purpose behind the objection is to prevent a patentee laying claim to products or processes which the teaching of the patent does not enable in the relevant sense.” (paragraph 362)

13 Turning to the specific issue in this application, I can readily summarise the sufficiency problem: the specification describes a bricklayer’s profile tool but the application’s claim is directed to extrusion dies. The examiner has raised the issue that they do not consider the invention of dies to be sufficiently disclosed and they reiterated the point in each of their examination reports.

14 The applicant’s response to the examiner’s last letter reiterated that in their experience those who had bought their products, and whom they considered to be skilled in the art, understand how to use them.⁶ The applicant goes on to explain ownership of the dies and associated technology. SAPA, who I understand are a company specialising in aluminium profile extrusion, provide the die and extrusion technology. The applicant retains ownership of “the unique design features of the SAPA die plates” . The applicant then explains the benefits of the specific form of their profile that is formed by extrusion.⁷

15 What we’re concerned with here is whether the *invention* is disclosed sufficiently clearly enough and completely enough for the person skilled in the art to perform that *invention*. Section 125(1) of the Act sets out that the invention is what is set out in an application’s claim.

16 Turning to the claim before me, I note the skilled addressee is presented with a claim to extrusion dies: “I hereby claim unique extrusion dies...”. However, reading through the remainder of the claim I can find no definition of specific structures or properties of the dies themselves. What the claim does set out is what properties the resultant extruded material might have. For example, the extruded material can be cropped; nonetheless, this is not a feature of the dies and it is not clear how the dies could impact on this. In any case, there can be no doubt the applicant is seeking protection for extrusion dies and this must be the invention.

17 The description and figures give me no additional information on the dies being claimed. The description of the application describes a profile tool. Aside from its opening lines, all of the description refers to the arrangement, use and benefits of the profile tool. I can find no description of the dies nor any direct properties of the dies. Furthermore, the specification does not describe how the product is manufactured or formed; that is, it does not describe the dies or the forming process. Without these

⁶ Applicant’s letter of 29 January 2020, paragraph 6

⁷ Applicant’s letter of 29 January 2020, paragraph 7

there is no direction or instruction for the skilled addressee to follow in order to perform the *invention*.

- 18 Comparing the description and the claimed invention, it is clear to me the applicant is attempting to claim a product (the dies) which the specification does not enable the skilled addressee to perform. Furthermore, because the dies were not described when the application was filed, I cannot see any remedy which will allow any claim to the invention of the dies. I must conclude the application does not meet the requirements of sufficiency. As such, the application cannot proceed to grant in its present form.
- 19 The applicant has been given repeated opportunity to address the issues with their application. They are seeking protection for their extrusion dies but have not sufficiently disclosed them. The examiner has proposed the claims could be directed to the embodiment of the builder's tool⁸ but the applicant did not maintain that direction, later arguing the "claim will not work without the details of the dies features".⁹ As such, I cannot see any likelihood of a valid claim being submitted.

Added matter and clarity

- 20 As I stated above, resolving the issues of added matter and clarity will not resolve the overriding issue of sufficiency. As such, I do not need to give them any further consideration.

Decision

- 21 I find that the invention claimed in application GB1714567.3 to be insufficient in that the specification does not disclose the invention in a manner clear enough and complete enough to be performed by a person skilled in the art as required by Section 14(3) of the Act. I therefore refuse this application under Section 18(3).

Appeal

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

Mr. Peter Mason
Deputy Director, acting for the Comptroller

⁸ For example, examination reports of 29 November 2018 and 3 May 2019

⁹ Applicant's email of 12 August 2019