



PATENTS ACT 1977

APPLICANT Clearview Industries Limited

ISSUE Whether application GB1209462.9 complies with sections 14(3) and 14(5) of the Act

HEARING OFFICER

DECISION

Introduction

- 1 The application entitled "A sash window with a biased retractable parting bead" was filed in the name of Clearview Industries Limited on 29th May 2012 claiming an earliest priority date of 10 June 2011. The application was published on 13 February 2013 as GB2493591 A. The original compliance period ended on 28 January 2016 and has been extended to 28 March 2016.
- 2 The examiner maintains that claim 1 (at least) is unclear and that the application lacks sufficient enabling disclosure to perform the invention across the entire breadth of the claim contrary to the requirements of sections 14(3) & 14(5) of the Patents Act 1977. The matter therefore came before me at a hearing on 14 March 2016.
- 3 Although there were a number of other minor issues outstanding, as indicated in the examiner's letter of 22 January 2016, the hearing focussed on the issues of clarity and sufficiency.
- 4 At the hearing, the applicant was represented by Neil Pawlyn of Urquhart-Dykes & Lord LLP. Also present were the examiner, Philip Lawrence, the hearing officer's assistant, Mark Simms, and an observer, Rachel Jones.

The law

- 5 Section 14(3) of the Patents Act states:

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.

6 Section 14(5) of the Patents Act states:

The claim or claims shall -

- (a) ...;*
- (b) be clear and concise;*
- (c) be supported by the description; and*
- (d) ...*

The invention

7 The invention relates to sash window frames including a mechanism which allows the window to tilt inwards to facilitate cleaning. Such windows often use an arrangement with a retractable bead to allow the window to tilt. The invention provides a so-called mechanical “biasing” arrangement in which a projection rides over a surface on the bead or window frame to engage with a slot therein and to thereby move the bead between retracted and extended positions.

8 The most recent set of claims were filed on 19 January 2016. There are a total of 19 claims including a single independent claim which reads as follows:

1. A window comprising:

a window frame defining a window opening;

a window element mounted to the window frame;

a moveable elongate bead member moveable from an extended position in which the bead projects and extends from the frame into the window opening to, in use, overlap an edge portion of the window element, to a retracted position; and

a mechanical biasing arrangement biasing the moveable elongate bead member towards the extended position and comprising a projection, the projection being provided on one of the bead member or a part of the window frame, and further comprising a surface, the surface being provided by the other of the bead member or a part of the window frame, the projection and the surface abutting one another to bias the elongate bead member in the extended position; and in which the surface is provided with a slot and in which the projection and a slot are aligned and the projection enters the slot when the bead member is in the retracted position.

Argument and analysis

9 The examiner argues that the reference to a mechanical “biasing” arrangement in claim 1 is unclear, and that the mechanism disclosed for pushing the bead into the extended position does not constitute what would typically be understood to be a biasing arrangement which would normally require the presence of a spring or other equivalent means. Furthermore, he argues that the application, which includes only a single embodiment having no “biasing” means as such i.e. no spring or similar arrangement for pushing the bead member into the extended position, lacks sufficient enabling disclosure to perform the invention across the entire breadth of the claim.

- 10 At the hearing, Mr Pawlyn argued that the invention could be described as a “biasing arrangement” and that the claims were both clear and supported by the description which was sufficient to enable the person skilled in the art to perform the invention. He also stated that any attempt to remove the reference to “biasing” ran the risk of adding matter.
- 11 It was clear to me, having heard the arguments put forward at the hearing, that the issue was primarily one of whether it was appropriate to use the term “biasing” arrangement in claim 1 to describe the mechanism by which the bead member was pushed into the extended position and not one of sufficiency of disclosure as such. There was no debate as to what constituted the invention, as this was clear from the description, and the embodiment described is in my opinion sufficient to enable the skilled person to put that invention into effect. I therefore asked the examiner and Mr Pawlyn to consider whether they could come up with an alternate form of wording to overcome this objection.
- 12 After a short adjournment, the hearing resumed, and Mr Pawlyn was able to present to me a proposed amendment which he had agreed with the examiner, and which I considered sufficient to resolve the outstanding issues of clarity and sufficiency.

Conclusion

- 13 Having found the amendments proposed during the hearing to resolve the outstanding issues of clarity and sufficiency, I therefore remit the application back to the examiner to complete the examination and for the applicant to file the necessary amendments to the specification.

Appeal

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

Peter Slater

Deputy Director, acting for the Comptroller