



PATENTS ACT 1977

APPLICANT Munchkin Inc

ISSUE Whether Patent applications GB1402766.8 and
GB1615839.6 comply with section 1(1)(a)

HEARING OFFICER MRS S E CHALMERS

DECISION

Introduction

- 1 Patent application GB1402766.8 entitled “Spillproof Container Assemblies” was filed on 03/06/2012 and published as GB2507025 on 16/04/14. Divisional application GB1615839.6 also entitled “Spillproof Container Assemblies” was lodged on 16/09/16 and published as GB2541128 on 08/02/17.
- 2 The examiner has maintained through several rounds of examination and amendment that the claims of both GB1402766.8 (the Parent) and GB1615839.6 (the Divisional) lack Novelty in view of the cited prior art.
- 3 Agreement was not reached before the end of the as-of-right extended compliance period of 10/04/17. Amended claims filed on 10/04/17 were considered by the Examiner to be unacceptable and further objections were raised against the Parent and Divisional in Examination reports issued on 04/05/17. Further amendments were filed on 18/05/17 along with requests for discretionary extension of the extended compliance period of the Parent and Divisional and a request for a hearing.
- 4 The issues to consider in this case are:
 - 1) whether the requests for discretionary extensions of time to the period for putting the applications in order under rule 108(3) filed on the 18/05/17 are allowable;

If the requests for discretionary extensions are allowable:

- 2) whether the amendments filed on 18/05/17 bring the applications into compliance with the act;

If the requests for discretionary extensions are not allowable:

- 3) Whether the amendments filed on 10/04/17 bring the applications into compliance with section 1(1)(a).
 - 4) Whether amended claim 1 of the divisional filed on 10/04/17 lacks sufficiency as defined by Section 14(3).
 - 5) Whether the amendments filed on 10/04/17 bring the applications into compliance with all requirements of the act as defined by Section 20(1).
- 5 The matter came before me at a hearing held via video conference on 18/10/17 following a two month postponement requested by the applicants. The applicants were represented by their Counsel Heather Lawrence instructed by their Patent Attorney John Leeming, and an observer Judith Mercer both from J A Kemp. Also present were hearing assistant Helen Edwards, the Examiner John Hewet and an observer Joe Cornfield.

Request for discretionary extension of the compliance period

- 6 I will begin by determining whether the requests for discretionary extension of the as-of-right compliance period are allowable as this will determine which set of claims should be considered.

The Law

- 7 Rule 108 relates to the extension of time limits:

108(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4.

108(2) The comptroller shall extend, by a period of two months, any period of time prescribed by the provisions listed in Part 2 of Schedule 4 where -

(a) a request is filed on Patents Form 52;

(b) no previous request has been made under this paragraph; and

(c) that request is filed before the end of the period of two months beginning immediately after the date on which the relevant period of time expired.

108(3) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by the rules listed in Part 2 of Schedule 4 where -

(a) a request is filed on Patents Form 52; and

(b) the person making the request has furnished evidence supporting the grounds of the request, except where the comptroller otherwise directs.

108(5) Any extension made under paragraph (1) or (3) shall be made -

(a) after giving the parties such notice; and

(b) subject to such conditions, as the comptroller may direct, except that a period of time prescribed by the rules listed in Part 3 of Schedule 4 may be extended (or further extended) for a period of two months only.

108(7) But no extension may be granted in relation to the periods of time prescribed by the rules listed in Part 3 of Schedule 4 after the end of the period of two months beginning immediately after the period of time as prescribed (or previously extended) has expired.

Analysis

- 8 The original unextended compliance period for both the Parent and Divisional applications expired on 10/02/17. This period was extended by two months as of right under rule 108(2), in response to a form 52 filed for each application on 06/02/17, taking the extended compliance period to 10/04/17.
- 9 Amended claim sets were filed for each of the Parent and Divisional applications on 10/04/17. The Examiner telephoned Mr Leeming on 13/04/17 to inform him that further searching of the claims would not take place until after 24/04/17 and to warn that claim 1 of the Divisional was considered to be insufficient. The Examiner invited Mr Leeming to file further amendments to address this issue. No clear reply by date was recorded. On 21/04/17 a further form 52 was filed on the Divisional requesting a discretionary extension to the compliance period under rule 108(3) and was accompanied by amended claims. The reasons given for requesting the discretionary extension were

“The applicant has diligently sought to address the objections raised against this application and the requested extension will not delay processing of the application in view of the fact that the further search previously requested has not yet been carried out”.

- 10 The Examiner stated in his letter of 04/05/17 that he was unable to allow the request for discretionary extension because the reasons and accompanying evidence provided were not sufficient to allow discretion to be exercised.
- 11 A further request for discretionary extension to the compliance period under rule 108(3) was filed on 18/05/17 along with a further form 52 and a set of amended claims for each of the Parent and the Divisional. More detailed reasons for the requests were provided as follows:

“The unusual workloads imposed on the Applicant’s legal staff by the numerous proceedings in which it is involved have made it very difficult to address the objections raised against the present application in the somewhat short time frames allowed”

“The examination process of the present application has involved various objections being raised at a late stage so that the Applicant has not been afforded a proper opportunity to address the current objections”

- 12 At the hearing Ms Lawrence provided further arguments to support the allowance of the discretionary extension, beginning with her view that rule 108(3) gives the Comptroller “unfettered” discretion to extend the compliance period. Unfortunately, as I said at the hearing, this is not the case because rule 108(3) is subject to rules 108(5) and 108(7) and rule 30 (which prescribes the compliance period) is one of those rules listed in Part 3 of Schedule 4. Hence, under rule 108(5), the compliance period may only be further extended for a period of two months. Furthermore, under rule 108(7), no further extension may be granted to the compliance date after the end of two months after the previously extension has expired. As a result, even if I allow the requests for the discretionary extension, requests to further extend the compliance date beyond 10/6/17 by filing further form 52s are not allowable because more than two months have elapsed since that date. If I do not allow the discretionary extension, then the compliance date is 10/4/17.
- 13 Ms Lawrence continued with the reasoning that the Applicant couldn’t address issues raised after the compliance period unless the extension was allowed and that the **Julian** citation was raised after the compliance period. She stressed the diligent behaviour of the Applicant in addressing the volume of objections raised, stating that there was no fault on the part of the Applicant, and that they simply ran out of time. She went on to say that the Applicant was led to believe that they could deal with the outstanding issues by the deadline of 18/05/17 and they did so by filing amendments on this date.
- 14 I will address this final point first. Unfortunately this belief is based on a misunderstanding of the covering letter issued by the Examiner on 04/05/17. The letter sets out the options available to the Applicant following the Examiner’s assessment of the applications which found that they did not comply with the act at the end of the as-of-right extended compliance period. In such circumstances the options afforded to the Applicant are; to convince the Examiner that the outstanding objections are unjustified; or, to ask a Hearing Officer to decide whether the application should be allowed as it stands; or, to request a further extension to the compliance period in which to meet the objections. This final option allows the Applicant to **request** a further extension which will be considered subject to the conditions of rule 108.
- 15 The latest date for reply specified on the covering letter was misinterpreted by the Applicant as a deadline for filing amendments when this is not the case. It is a deadline to either convince the Examiner that the outstanding objections are unjustified; or, to ask a Hearing Officer to decide whether the application should be allowed as it stands; or, to **request** a further extension to the compliance period. The amendments filed on 18/05/17 cannot be considered until it had been determined whether or not the discretionary extensions are allowable under rule 108.
- 16 I will now consider the reasons given for the requests and start with the first reason which relates to the amount of work faced by the legal staff. At the hearing I sought further information on the timescales of this work pressure. Ms Lawrence indicated that the issues contributing to the work pressures were present during the 6 months

prior to 18/05/17. It is unusual for work-loads to be accepted as a reason for allowing a discretionary extension except in exceptional circumstances and without any further evidence I am not persuaded that the circumstances in this case should be considered any differently. As such I do not accept that work pressures is an adequate reason to allow the request for discretionary extension.

- 17 The second reason given for the request is the short time scales afforded to the Applicant to address the issues and that these issues were raised at a late stage. I note that the Applicant has twice requested as-of-right extensions to reply to the section 18(3) Examination reports on the Divisional and three times on the Parent. Whilst the Applicant is fully within their rights to take advantage of as-of-right extensions it clearly has the effect of delaying issues to a later stage such that reply periods to subsequent section 18(3) reports become compressed due to the impending end of the compliance period. It is clear to me from the correspondence that the Applicant was fully aware of the time remaining to the compliance period and as such the short time scales specified in the section 18(3) reports should not have come as a surprise. This set of circumstances is common and does not amount to a sufficient reason to exercise the Comptroller's discretion. As such I do not accept that short time scales and issues being raised at a late stage in the processing of the applications is an adequate reason to allow the request for discretionary extension.
- 18 In summary, I find that the reasons given for requesting the discretionary extensions to the compliance periods of the Parent and Divisional are not sufficient. As such the requests will not be allowed. The compliance period for both applications is therefore 10/04/17.

Correction of irregularities

- 19 Given that the compliance period on both applications had expired and no further extensions to the compliance period were allowable under rule 108, I drew Ms Lawrence's attention to rule 107 which covers the correction of irregularities and offered the applicant the opportunity to make submissions with regard to the rule 30 period under rule 107(3). Rule 107 reads as follows:

107(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

107(2)

107(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if— (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and (b) it appears to the comptroller that the irregularity should be rectified.

- 20 I specified a deadline of one week to allow the filing of any submissions.

- 21 Submissions were filed on 23/10/17. These related to the possibility of new reasons for refusal emerging should the discretionary extension be allowed and the amendments of 18/05/17 be considered and found not to fully meet the requirements of the act. These can be summarised as:

“We believe that there are no further grounds in which either of the present patent applications should be refused but in the event that such a ground is now raised we believe it is within the Comptroller’s power under Section 107 to extend the compliance period and it would be appropriate to do so.”

- 22 To support their view, the applicant directed me to the decisions in *Coal Industry (Patents) Ltd’s Application* [1982] RPC 57 and *Mill’s Application* [1985] RPC 339 which are both concerned with the correction of irregularities. In particular, they argue that section 18 imposes an obligation on the Office to raise objections to a patent application and to give the applicant an opportunity to address such objections. Hence they submit that if a late objection against either of the applications were to be raised, it would be appropriate that this irregularity be rectified by giving the applicant an opportunity to amend in response to such an objection.

- 23 I do not think *Coal Industry* is of assistance here since it is concerned with an application on which, following the filing of amendments, an examination report was prepared in the Office but never issued. This is clearly not the case here. The judgment in *Mill’s Application* directs that, with regard to an “omission”, the obligation on the Office need not necessarily be of a legally enforceable nature. While it is true that section 18(3) requires the Office to raise objections and to give the applicant the opportunity to reply, the decision, the statute states that:

“the examiner shall investigate, to such extent as he considers necessary [emphasis added]... whether the application complies with the requirements of the act and rules...”

- 24 Examination is therefore a matter of judgment; whether this judgment is correct or not is a separate question from whether the examiner, having come to that view, followed the correct procedure. It is clear from the files for these applications that the examiner has been diligent in re-examining each set of amended claims filed and in issuing examination reports in timely fashion. The applicant has not argued there are irregularities in the processing of the case to date, their request is concerned with objections that might or might not arise in the future. In my view, no procedural irregularity has occurred.

Compliance date

- 25 Having found that the requests for discretionary extensions are not allowable I am not required to consider any of the claims filed after the end of the extended compliance period of 10/04/17 on either the Parent or the Divisional. It remains for me to decide whether the amendments filed on 10/04/17 enable the Parent and Divisional applications to comply with the act as required by section 20(1):

20(1) If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the

rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.

The applications

- 26 The applications relate to spillproof drinking assemblies, particularly those than can be used as training cups for toddlers. These assemblies typically comprise a lid with a drinking opening allowing a limited flow of liquid and a container body that are provided with mating helical threads to enable the lid to be securely fastened to the container body by screwing. If the lid is not fully screwed on, this can result in the leakage of fluid and the ingress of air. On the other hand, if the lid is overtightened, deformation of the threads and sealing surfaces can occur and the lid can be difficult to remove. The invention is concerned with providing visual assurance to users that there is the proper degree of tightening between the lid and container body.

Claims

- 27 Claim 1 of the Parent filed on 10/04/17 is as follows (integers (a) to (g) added to aid the subsequent analysis):
- (a) A spillproof drinking assembly, comprising:*
 - (b) a container body having a sidewall, a first upper open end and a lower closed end;*
 - (c) a cylindrical portion extending upwardly away from the first upper open end of the container body, the cylindrical portion including at least one threaded fastener on an outer surface of the neck to receive a cap;*
 - (d) the container body having an upper surface between the cylindrical portion and the sidewall, with a portion projecting downwardly and outwardly in an externally convex shape;*
 - (e) a substantially flat platform projecting from the externally convex portion of the upper surface;*
 - (f) and a snap projection disposed on the platform, wherein the snap projection extends upward, away from the platform to a predetermined height;*
 - (g) a lid for threadably attaching to the cylindrical portion, the lid defining an opening for viewing the snap projection when the cap is attached to the cylindrical portion.*
- 28 Claim 1 of the Divisional filed on 10/04/17 is as follows (integers (a) to (g) added to aid the subsequent analysis):
- (a) A spillproof drinking assembly, comprising:*
 - (b) a container body having a sidewall, a first upper open end and a lower closed end;*

- (c) *a cylindrical portion extending upwardly away from the first upper open end of the container body, the cylindrical portion including at least one helical thread on an outer surface of the neck to receive a lid;*
- (d) *the container body having an upper surface between the cylindrical portion and the sidewall, with a portion projecting downwardly and outwardly in an externally convex shape;*
- (e) *a snap projection disposed on the container body; and*
- (f) *a lid for threaded attachment to the cylindrical portion, the lid comprising a flexible tab projecting downwardly and positioned to deflect over the snap projection at a location above the convex portion of the upper surface when the lid is threaded to the neck,*
- (g) *the lid configured to permit visual confirmation of deflection of the flexible tab.*

Novelty

29 In order to determine the issue of Novelty the following sections of the act apply:

Section 1(1) *A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -*

(a) *the invention is new;*

Section 2(1) *An invention shall be taken to be new if it does not form part of the state of the art.*

Section 2(2) *The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.*

Analysis

30 The figures of the Parent and Divisional applications are identical. Figures 1 and 7 are included to aid in the assessment of the citations.

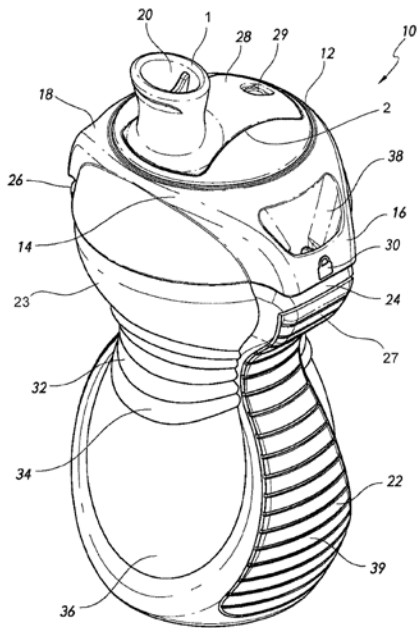


FIG. 1

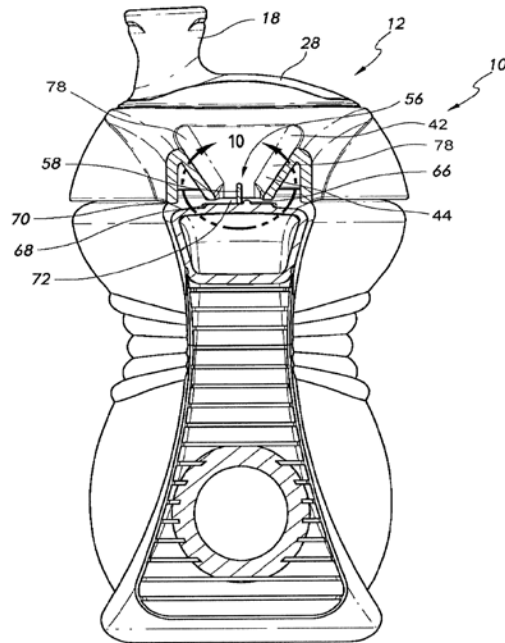


FIG. 7

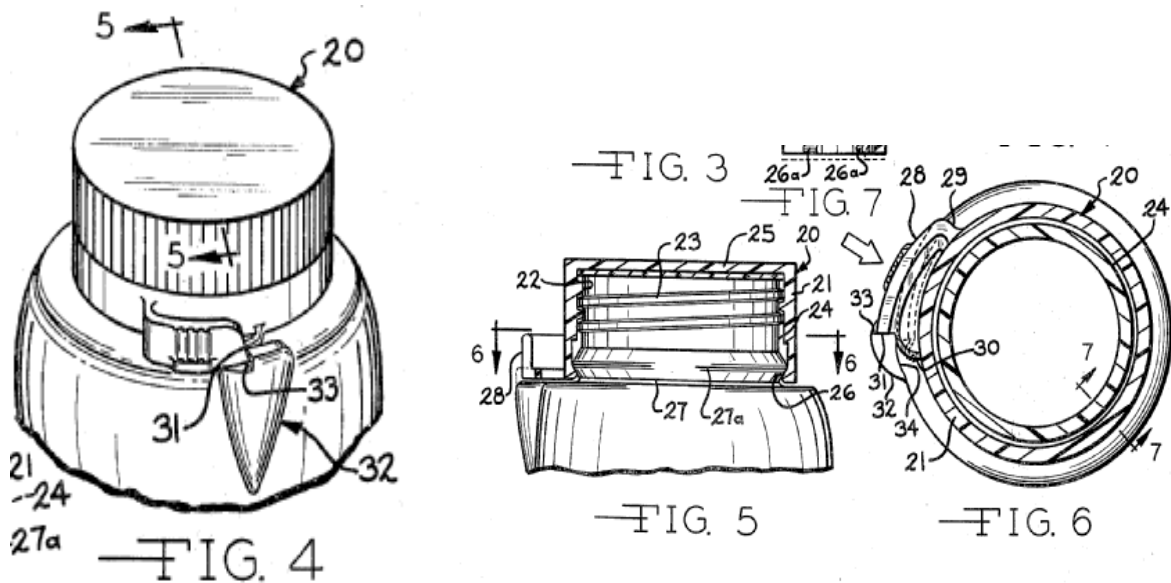
- 31 For the purposes of the analysis, in the Parent, reference numeral 10 represents integer (a); reference number 22 is integer (b); reference number 64 is integer (c); reference number 24 is integer (d); reference number 68 is integer (e); reference number 66 is integer (f); and reference numbers 12 and 38 comprise integer (g). In the Divisional, reference numeral 10 represents integer (a); reference number 22 is integer (b); reference number 64 is integer (c); reference number 24 is integer (d); reference number 66 is integer (e); reference number 58 is integer (f); and reference number 38 is integer (g).

Construction of claims

- 32 Two issues of construction arise before I consider the novelty of the claims. At the hearing Ms Lawrence raised concerns that the broad interpretations adopted by the Examiner went against the convention of purposive construction and that several alternative interpretations of features of the claims had been applied by the Examiner at different stages of the examination process and that some parts of the claims appeared to have been taken out of context.
- 33 I turn first to the phrase “spillproof drinking assembly” ie integer (a). This was construed broadly by the Examiner in his pre-hearing report of 03/07/17 to include “a vessel with a narrower neck than the rest of the vessel” in the light of paragraph [0006] of the original description. Ms Lawrence disputed this interpretation saying that the passage relied on by the Examiner refers to an unrestricted opening in the lid which is small enough to limit the amount of fluid that can be spilled if the container assembly is dropped or inverted. There was no reference to a vessel with a narrower neck than the rest of the vessel.

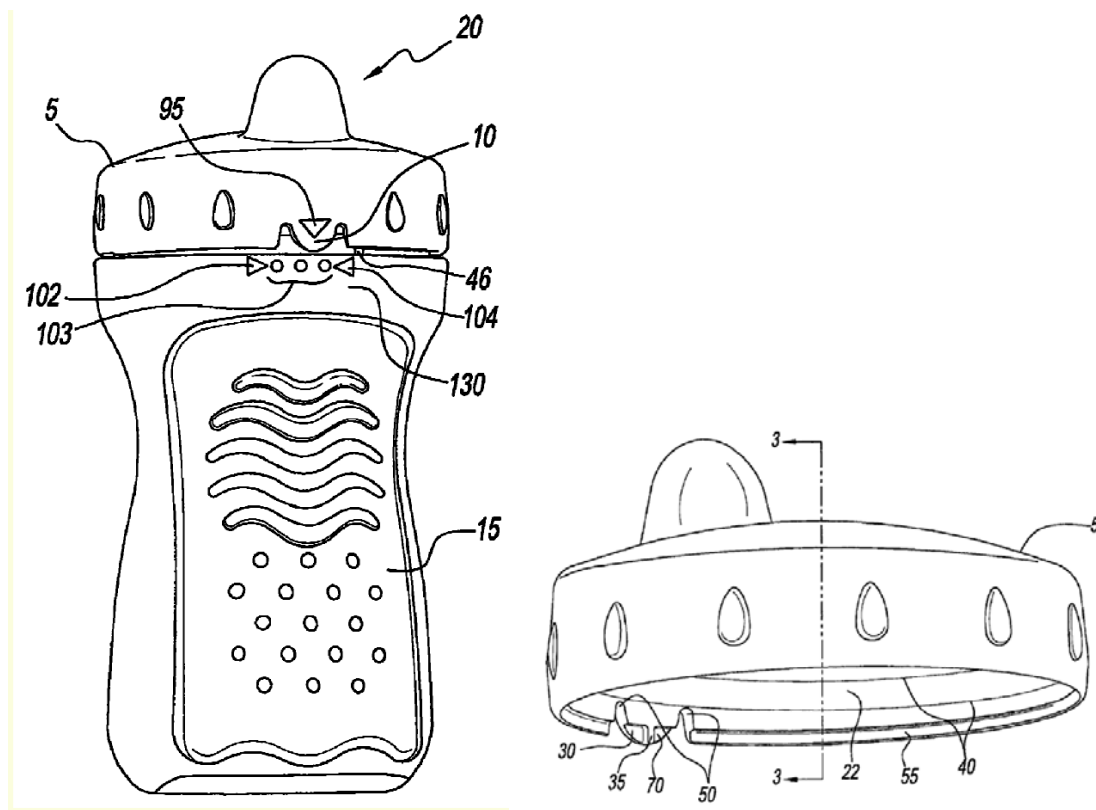
- 34 I agree with Ms Lawrence on the construction of this phrase. Although there is no unambiguous definition of “spillproof drinking assembly” given in the description, the introduction says that that the “subject disclosure relates generally to the field of feeding accessories and more particularly to spillproof container assemblies, such as those than be used as training cups for toddlers”. Paragraph [0003] states that “such products (ie spillproof container assemblies) typically include a container body such as a cup or baby bottle and a lid that is constructed and arranged to form a seal with respect to the container body. The lid is provided with an opening to permit controlled passage of fluid from the container body for drinking purposes.” I note that this disclosure is consistent with the described embodiments and the rest of the specification which is limited to training cups. I observe that this feature is not defined in claim 1 of either the Parent or the Divisional and, although no objection was raised by the examiner, would appear essential for the assembly to be capable of fulfilling its stated purpose. I shall therefore construe “spillproof drinking assembly” as container assemblies comprising a body and a lid wherein the lid is provided with an opening to permit controlled passage of fluid from the container for drinking purposes.
- 35 Turning to the second issue, the Examiner also took a broad interpretation of the phrase “*the lid defining an opening for viewing the snap projection when the cap is attached to the cylindrical portion*” in claim 1 (integer (g) of the Parent. He noted that the term “opening” was not defined in the application as filed and argued that “opening” could be interpreted as meaning an opening between two members and construed as “the gap between the bottom of a lid and the top of a container body”. Again, Ms Lawrence disputed this interpretation. She submitted that a viewing port 38 was clearly shown, in for example Figure 1, and described in further detail in the specification and which is required by integer (g) to be defined by the lid.
- 36 Again I agree with Ms Lawrence that the examiner’s construction of this phrase is too broad. I note that the term “opening for viewing” was introduced into claim 1 of the Parent in amendments filed on 27/03/17 and that the Examiner did not raise any specific objection to this term during the examination process. However, from consideration of the application as filed, the description contains references to “opening” when discussing aspects of the invention relating to the passage of fluid i.e. the opening which allows drinking. The references to a “viewing port” are used consistently to refer to the means which enable visual confirmation of an optimum closed position. It appears to me that it was clearly in the mind of the inventor at the time of drafting the application that the term “opening” and the term “viewing port” were intended to refer to distinctly different features of the invention and that there was no other means of permitting visual confirmation of the optimum closed position envisioned by the inventor at the time of drafting the application. That said, in my view the term “opening for viewing” is not supported by the specific nature of the description which only discusses one way of viewing the snap projection and that is through port 38. For the purposes of this decision, I shall therefore construe the phrase “the lid defining an opening for viewing ...” as “the lid defining a viewing port” where “port” is accorded its normal meaning as a window contained within a wall of a structure.
- 37 I shall now consider the 5 citations and assess their relevance to the main claims in turn of the Parent and Divisional Applications.

Citation 1 US3989152 Julian.



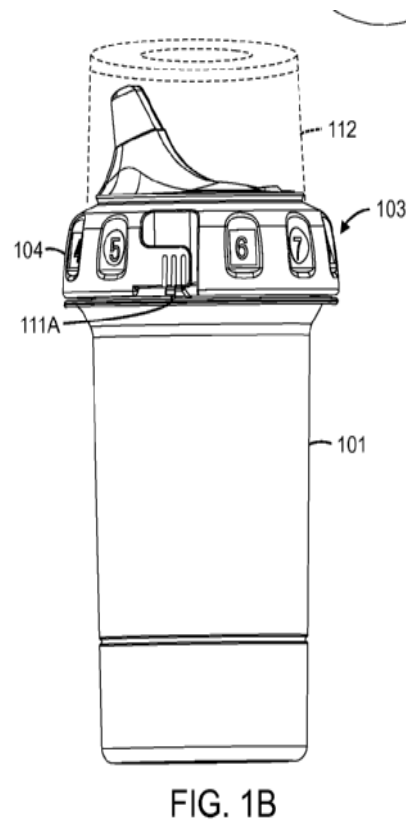
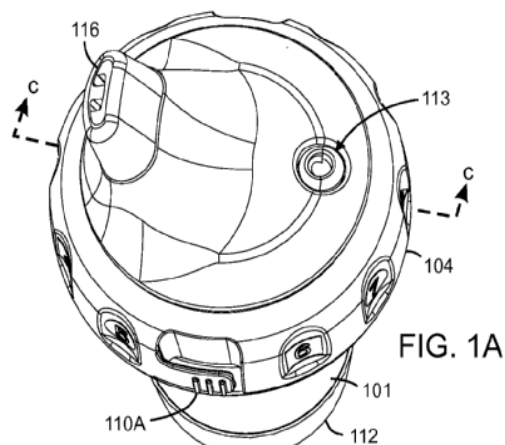
- 39 Considering claim 1 of the Parent, the Examiner took the view that this document showed a container which was considered to be a "spillproof drinking assembly" (integer (a)) and that vertical abutment 33 was the snap projection (integer (f)). Regarding requirement (g), the lid 20 defined an opening bordered by web 28, bridge 29 and the outer surface of the lid. The abutment 33 could be viewed through the opening when the lid was attached to the cylindrical portion. Ms Lawrence disagreed saying that the invention related to a child-resistant locking means for a twist action container cap and not to a spillproof drinking assembly. She also pointed out that Figure 6 shows that when the lid is in its closed position, abutment 32 abuts web 28 to prevent removal of the lid. I agree.
- 40 Considering claim 1 of the Divisional, integer (f) requires a flexible tab projecting downwardly and positioned to deflect over the snap projection. Lines 34-44 of column 3 state that "as the cap is further rotated, the web 28 is flexed inwardly to the dotted position shown in Figure 6. However, the web does not project downwardly and I do not consider Julian discloses a spillproof drinking container for the reasons given above.
- 41 Julian is not considered to anticipate claim 1 of either the parent or the divisional.

Citation 2 US2009242562 Valderrama.



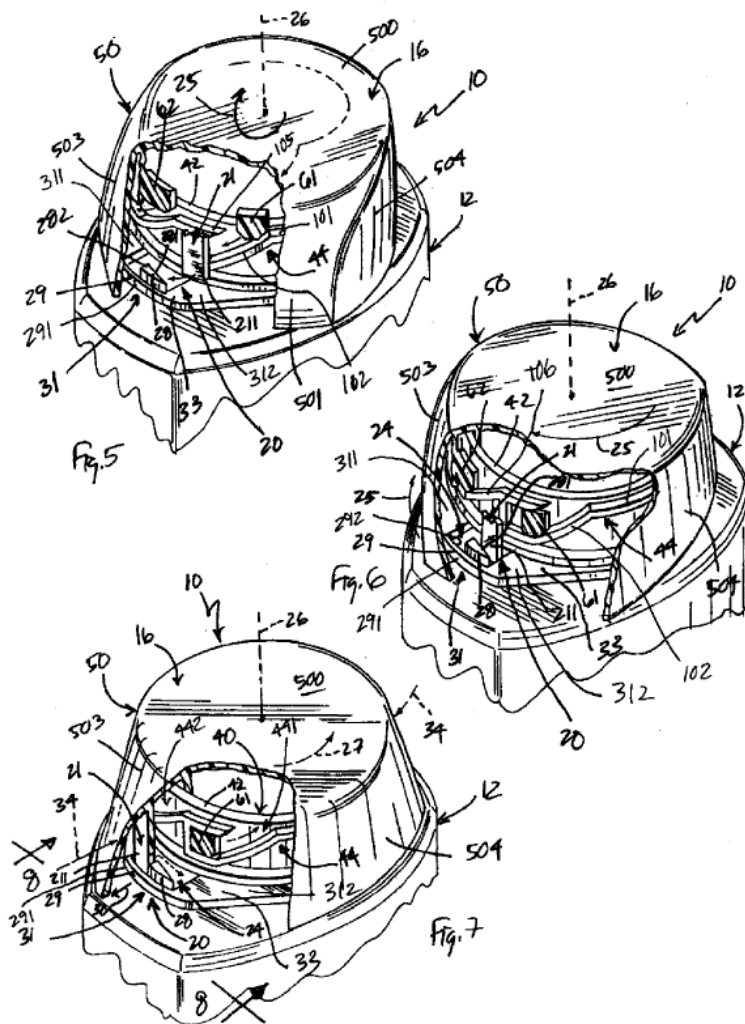
- 42 Considering claim 1 of the Parent, the Examiner took the view that rib 46 on the container meets the requirements of integer (f) and he interpreted the gap between the lid and horizontal surface of the container body to constitute the required “opening” of integer (g). Audible indication of the closing of lid is provided when the downwardly projecting flexible tab moves over rib 46 and deflection of flexible tab 30 can be seen through “openings” 50 either side of the tab eg by looking at movement of the tab from a “side on” perspective. The Examiner also noted that it is not a requirement of the claim that the substantially flat platform must project outwardly from the convex portion of the upper surface. Hence while the horizontal “platform” at the top of the container projects inwardly, it still meets requirement (e).
- 43 Ms Lawrence argued that rib 46 is not visible through openings 50 when the lid is closed because the view is obscured by tab 30. Closure is instead indicated by markings 95, 102, 103 and 104 on the outside of the container. She also noted that, according to paragraphs [0029] and [0032], the rib is positioned on the “lip” or neck of the container body not a platform so requirements (e) and (f) are not met. Ms Lawrence also asserted that integers (d) and (e) were not met since there was no disclosure of a substantially flat platform projecting from the externally convex portion of the upper surface. Whether or not (g) is met is moot because I agree that requirements (d), (e) and (f) are not met.
- 44 Similar considerations apply to the Divisional in that requirements (d) and (e) are not met. As such Valderrama is not considered to anticipate claim 1 of either the Parent or the Divisional.

Citation 3 US2010147862 Keefe.



- 45 Considering claim 1 of the Parent, the Examiner took the view that this document shows that tab 111A (feature (e)) can be seen through an “opening” underneath flap 110A and would also be visible if someone looked through the opening above the flap, or to the right of the flap thus fulfilling (g). Ms Lawrence disagreed and pointed out that when the lid is closed, the tab is hidden by the flap. Whether or not this feature is shown is moot since the feature of “*the container body having an upper surface between the cylindrical portion and the sidewall, with a portion projecting downwardly and outwardly in an externally convex shape*” identified as integer (d) of claim 1 of the Parent and Divisional is not present.
- 46 As such Keefe is not considered to anticipate claim 1 of either the Parent or the Divisional.

Citation 4 US2010051572 Beecroft



47 Considering claim 1 of the Parent, the Examiner took the view that the horizontal flat platform 33 between the neck and the shoulders of the container met requirement (e) and that tab blocker 28 is the snap projection required by (f). On a broad interpretation, the required "opening" (g) was constituted by the main opening in the bottom of the lid, and that viewing of tab 28 could be achieved when the lid is attached to the container but not fully closed by looking through the gap created between the lid and the container. Ms Lawrence argued that this document does not disclose "A spillproof drinking assembly" identified as integer (a) in claim 1 of the Parent and Divisional. Instead it relates to a child-resistant canister. She further argued that tab 28 would not be visible when the cap is on. Figures 5-7 show cut-out views of the closure sequence of the lid and that none of the features shown in the cut-out section would be visible when attaching the lid. Hence integer (g) is not disclosed. She also submitted that Beecroft did not disclose integers (e) or (f). Tab blocker 28 is disposed on the horizontal support platform 33, not on the upper surface of the container as required by (e) and tab lock 21 is positioned to deflect inwardly, not over tab blocker 28 as required by (f).

48 I agree that Beecroft fails to disclose all of the required features. Beecroft is therefore not considered to anticipate claim 1 of either the Parent or the Divisional.

Citation 5 US6105801 Minnette

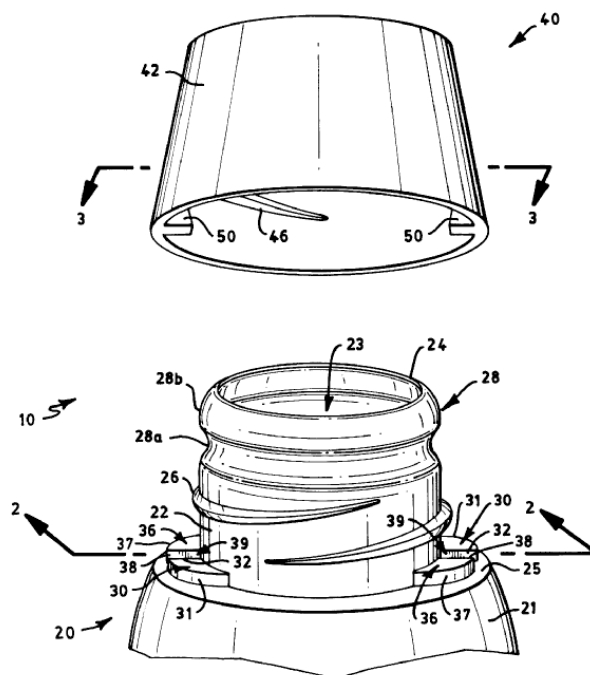


FIG. 1

- 49 Considering claim 1 of the Parent, the Examiner took the view that the locking lugs 30 constituted the snap projection (f) and that the required “opening” in (g) was constituted by the gap between the lid and container as the lid is being attached to the neck. Ms Lawrence disagreed and opined the Examiner’s argument was speculative and that the lugs could not be seen when the lid was closed. The arrangement thus did not meet requirement (g) of the Parent or Divisional. She also argued that again this document does not disclose “A spillproof drinking assembly” identified as integer (a) in claim 1 of the Parent and Divisional. Nor does it disclose “a substantially flat platform projecting from the externally convex portion of the upper surface” identified as integer (e) in claim 1 of the Parent.
- 50 I agree with Ms Lawrence’s view. As such Minnette is not considered to anticipate claim 1 of either the Parent or the Divisional as it does not disclose all of the required integers.
- 51 In summary, none of the 5 citations are considered to show a lack of novelty of claim 1 of the Parent or of claim 1 of the Divisional in respect of the claims filed on 10/04/17.

Inventive Step

- 52 Although the issue of inventive step was not raised in the pre hearing report or at the hearing I will for completeness briefly consider the inventiveness of the claims at 10/04/17, as it is necessary to determine whether the Parent and Divisional applications were in compliance with all aspects of the act at 10/04/17.

- 53 I do not believe that it is likely that when faced with the cited prior art the notional skilled person would be motivated to adapt any of them in such a way as to arrive at either of the presently claimed inventions without the need for inventive ingenuity. As such, claim 1 of the Parent and claim 1 of the Divisional are considered to be inventive over the cited prior art.

Sufficiency

- 54 The section of the act concerning sufficiency is section 14(3) which reads:

14(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.

- 55 Since issues of sufficiency often involve consideration of whether the description provides support for the claim, section 14(5)(c) is also relevant:

14(5)(c) The claim or claims shall be supported by the description

- 56 Since issues of lack of support can lead to the inclusion of added matter, section 76(2) is also relevant:

76(2) No amendment of an application for a patent shall be allowed ... if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

Analysis

- 57 The Examiner raised the issue of insufficiency by excessive claim breadth in a telephone conversation with Mr Leeming on 13/04/17 following amendment of claim 1 of the Divisional to include the phrase "*the lid configured to permit visual confirmation of deflection of the flexible tab*" identified as integer (g) in claim 1 of the Divisional. The Examiner argued that newly introduced integer (g) encompasses embodiments that go much further than the original disclosure and that the skilled person is not taught how to work the invention across the breadth of the new requirement. The Examiner objected to this phrase considering it to add matter by intermediate generalisation.
- 58 Having reviewed the Divisional application I am of the opinion that the issue here is one of support rather than sufficiency. In particular, the breadth of scope of integer (g) is not supported by the specific nature of the description which only discloses one example of permitting visual confirmation of deflection of the flexible tab and that is via a viewing port 38.
- 59 Turning now to consideration of claim 1 of the Parent. The term "opening for viewing" was introduced into claim 1 in amendments filed on 27/03/17. The Examiner did not raise any specific objection to this term during the examination process or in the pre hearing report. However, prior to the hearing, I asked to be addressed on support for this phrase. At the hearing Ms Lawrence stated that the viewing port is considered to provide the necessary support for the term "opening for viewing" in claim 1 of the Parent and, following a brief recess, that it is also considered to

provide support for the phrase “*the lid having an opening configured to permit visual confirmation of deflection of the flexible tab*” in claim 1 of the Divisional. In addition Ms Lawrence pointed out that the amendments to claim 1 of the Parent and Divisional filed on 18/05/17 address this point as both now specifically contain reference to a “viewing port”. However, this argument is moot in the light of my decision not to allow a further extension to the extended compliance period.

60 As noted above in the discussion of “Claim Construction”, the description as filed contains references to “opening” when discussing aspects of the invention relating to the passage of fluid i.e. the opening which allows drinking. The references to a “viewing port” are used consistently to refer to the means which enable visual confirmation of an optimum closed position. It appears to me that it was clearly in the mind of the inventor at the time of drafting the application that the term “opening” and the term “viewing port” were intended to refer to distinctly different features of the invention and that there was no other means of permitting visual confirmation of the optimum closed position envisioned by the inventor at the time of drafting the application. As such, it seems that the scope of the phrase “*the lid having an opening configured to permit visual confirmation of deflection of the flexible tab*” in claim 1 of the Divisional is not supported by the description as filed, and adds matter contrary to section 76(2).

61 Viewed from another perspective, the essential features of an invention must be present in the independent claims. Since the viewing port appears to be an essential feature it should be mentioned in claim 1. The description does not disclose or suggest that visual confirmation of an optimum closed position may be achieved in any other way than via the “viewing port”. The current wording of claim 1 of the Divisional to include any means of configuring the lid to permit visual confirmation of the deflection tab is not supported. In my view, the scope of the term “opening for viewing” in the Parent is not supported by the specific nature of the description which only discusses one way of viewing the snap projection and that is through port 38. It is also considered to add matter contrary to section 76(2).

Other issues

Parent application GB1402766.8

62 There are two further objections raised by the Examiner that remain relevant to claim 1:

(a) Line 5 of claim 1 refers to “the neck”. Firstly, the claim is unclear because there is no antecedent in the claim for this term and secondly there is no mention of this term in the description as filed.

(b) Line 5 and line 15 of claim 1 refer to “a cap”. Firstly, the claim is unclear because there is no mention in the description as filed for a “cap” and secondly, the claim contains an internal inconsistency because it would appear that “cap” and “lid” are used to define the same feature.

Divisional application GB1615839.6

- 63 There is a further objection raised by the Examiner that remains relevant to claim 1. Line 5 of claim 1 refers to “the neck”. Firstly, the claim is unclear because there is no antecedent in the claim for this term and secondly there is no mention of this term in the description as filed.
- 64 Claim 1 in both the Parent and the Divisional applications therefore do not comply with section 14(5).

Conclusion

- 65 I have decided that the requests under rule 108(3) filed on 18/05/17 for discretionary extensions of time to the period for putting the applications in order are not allowable. The extended compliance period therefore expired on 10/4/17.
- 66 I find that claim 1 of both GB1402766.8 (Parent) and GB1615839.6 (Divisional) complied with section 1(1)(a) as of the 10/04/17 but that these claims lacked clarity and support as required by Section 14(5).
- 67 I therefore refuse applications GB1402766.8 and GB1615839.6 for failure to comply with the act by the end of the compliance period.

Appeal

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

Deputy Director, acting for the Comptroller