

# PATENTS ACT 1977

## IN THE MATTER OF

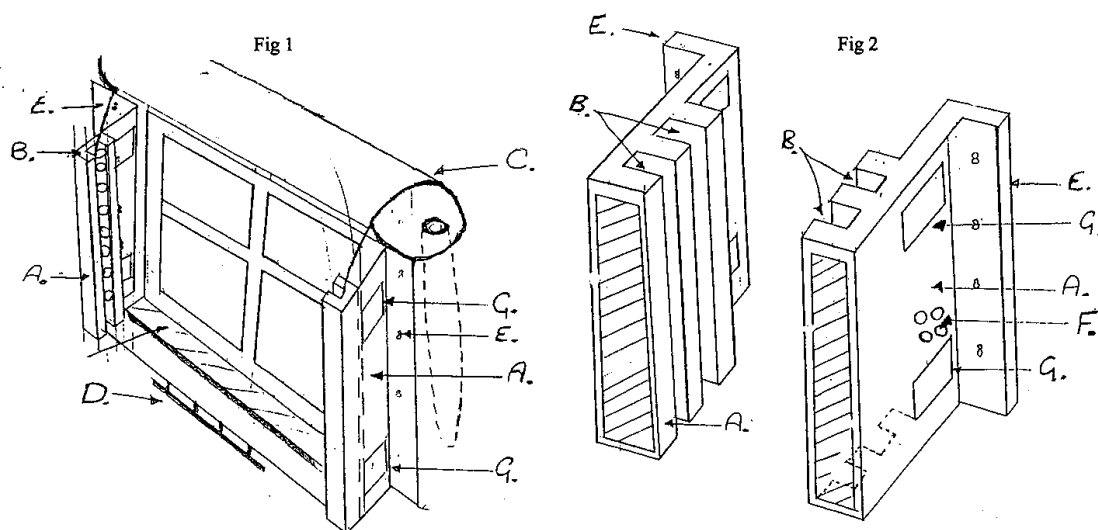
Patent Application GB9907874.3

in the name of Martin Anthony McKenzie

## DECISION

### Introduction

1. Patent Application GB9907874.3 was filed in the name of Mr Martin Anthony McKenzie on 8 April 1999 and published on 10 March 1999 as GB2342697A. It claimed priority from an earlier patent application, GB9824861, filed on 13 November 1998. In the first examination report under section 18(3), dated 28 June 2002, the examiner raised objections, *inter alia*, that the claims lacked clarity and appeared not to be new or inventive. Further correspondence and numerous telephone calls between the applicant and the examiner have failed to resolve these matters and, in fact, some of the amendments proposed by Mr McKenzie have, in the examiner's opinion, introduced the additional objection that they include matter not disclosed in the application as filed. It has now been agreed that a decision on the matters in dispute should be made based on the papers on file.
2. The application relates to a two part frame which may, for example, be fitted to a window frame or window recess. As shown in the figures which are reproduced below, each part comprises a portion (E) for connection to the window from which extends a portion with channels (B) in which detachable roller screens (C) are guided. The screens, which may be of various materials (e.g. for thermal insulation or screening from sunlight), may be motor driven. Ventilation slits (G) may be built into the frame.



3. The latest form of claim 1, filed on 10 June 2003, reads as follows :-  
A thermal insulating barrier window frame, conservatory, or attachment over a window frame, or a peripheral frame adaptation, of which may extend the inner and/or outer recess areas of a window, which at two opposed edges of the window comprises at least one channel, each channel accommodating the edges of a roller screen, each screen formed of a different material providing various functions. The windows and walls systems adaptations however combined and attached are generally characterised by their inner recess areas, and size, shapes and configurations provision manufactured wider, and filled with any suitable insulating materials, allowing substantially increased thermal insulation and barrier protection.

### **Relevant law**

4. The requirement for clarity in the claims is contained in section 14(5) which reads:-  
*The claim or claims shall -*  
(a) *define the matter for which the applicant seeks protection;*  
(b) *be clear and concise;*  
(c) *be supported by the description; and*  
(d) *relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.*
5. Section 1 of the Patents Act 1977 states that a patent may be granted only for an invention which is new and involves an inventive step. The requirements for novelty are specified in section 2. The sub-sections which are relevant for these proceedings are (1) and (2) :-  
(1) *An invention shall be taken to be new if it does not form part of the state of the art.*  
(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 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.*
- Section 3 specifies the requirements for inventive step and it reads as follows :-  
*An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).*
6. Added matter is covered by section 76 of the Patents Act 1977 and subsection 76(2) reads as follows:-  
*No amendment of an application for a patent shall be allowed under section 17(3), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.*

### **The argument**

(a) *Clarity and added matter, claim 1*

7. In the first examination report the examiner raised many clarity objections pointing out the necessity to draft each claim in the form of a single sentence which defines clearly the matter for which protection is sought in terms of the technical features of the invention. The applicant has proposed numerous amendments but, in the examiner's opinion, they have not met the clarity objections and have, in some instances, resulted in the introduction of matter not clearly disclosed in the application as filed.
8. With reference to claim 1, the examiner argued that :-
- (a) the reference to inner and/or outer recess is unclear since there is only one recess, the screens being designed for the interior of a building,
  - (b) there is no disclosure in the application as filed of the recess being "filled with any suitable insulating materials",
  - (c) there is no disclosure in the original application of the device being formed as the frame, rather than as an adaptation for a frame, and
  - (d) the phrase "characterised by their inner recess areas, and size, shapes and configurations provision manufactured wider, and filled with any suitable insulating materials, allowing substantially increased thermal insulation and barrier protection", though not entirely clear in scope, constitutes added matter since, in the application as filed, there is no explicit reference to width, except that the frame may be "sized, shaped and configured" to fit any suitable window.
10. Following the request for the matter to be decided on the papers, Mr McKenzie sent a letter dated 18 June 2003 to the Patent Office in which he refuted some of the examiner's objections. Since I have found some of Mr McKenzie's arguments hard to follow I replicate them exactly where appropriate.
11. In respect of the objection (a) above he wrote as follows :-  
"In the context of the products, or combination of products described as providing "Sophistication, Modernity, Quality Choices, and Wider product ranges". The claim "inner and/or outer recess area" are configured wider including any suitable materials fitted into this area, also includes window frame system, and a wall system, is evidence of obviousness, under the doctrine of wider implication, Equivalents, and Substitutions of the products adaptations, and not adding technical features."
- In respect of objection (b) Mr McKenzie maintained that :-  
"....under the aforementioned doctrines, It is conceivable that the word "Filled" could be included to describe the technical features of the invention".
- In respect of objection (c) he wrote :-  
"A main frame adaptation is clearly shown in the drawings at figure 1. A key to understanding the scope of the specifications, is in the background of the invention, where the problems to be solved are double glazed windows, conservatory's, single paned windows, doors and walls all provide insufficient thermal insulations protection".
12. I have considered Mr McKenzie's arguments but, in my view, the latest amended claims are still objectionable for lack of clarity and added matter. Claim 1 still consists of two

separate sentences and, as the examiner pointed out, claims comprising disjunctive sentences have always been considered objectionable on the grounds of ambiguity since they give rise to uncertainty as to the precise monopoly sought. Moreover, each of these sentences includes phrases which are unclear and/or add matter. In the first sentence, the expression objected to under (a) above is unclear for the reasons given by the examiner. Having read the application as originally filed carefully I can find no disclosure, either explicit or implicit, of the recess being “filled with any suitable insulating materials”. Furthermore, whilst I agree with Mr McKenzie that figure 1 shows a main frame *adaptation*, I can find nothing in the original application to support the idea that the invention may be formed as the main frame *per se*. It would appear from Mr McKenzie’s letter that, because the application included a reference to “equivalents and substitutions”, he is under the impression that it is allowable to add any matter which would be obvious to the skilled man. However it is well established patent law that matter which is not disclosed in the application as filed, but which the skilled reader would find obvious to add, is not regarded as having been implicitly disclosed. In the second sentence the phrase “adaptations however combined and attached are generally characterised by their inner recess areas, and size, shapes and configurations provision manufactured wider” is both unclear, unsupported by the application as filed and does not define in technical terms the matter for which protection is sought. I would also point out that the significance of the expression “each screen formed of a different material” is also unclear since the claim embraces the possibility of only one screen.

(b) *Novelty*

13. Numerous amended sets of claims have been filed all of which have given rise to clarity objections and these have made it difficult for the examiner to decide the precise scope of the monopoly claimed and hence what would fall within the ambit of the claims. However several prior art documents have been cited which the examiner considers demonstrate that the concept of thermal/solar protection at a window by means of one or more screens having their edges in grooves in the window frame, or in grooves in a member attached to a window frame, is known.
14. GB 2010367A, published 27 June 1979  
This document shows frame members for a double glazed window, each frame member having a channel for the double glazed pane and one or more further channels for one or more roller blinds carried in a casing. At the base of the or each blind is a guide rod which is carried in channels in the frame. One of the roller blinds is a light- or sun-shielding element. An air extraction device may be provided in the casing.  
  
EP 0142596 A1, published 29 May 1985  
This document discloses an attachment designed for connection to an existing window frame and to the window recess to form a chamber housing a number of roller blinds. The blinds, which provide thermal insulation, are lowered in channels.  
  
DE 3309613 A1, published 27 September 1984  
This document discloses an attachment for connection to a window frame in which a plurality of motor driven blinds ride in slots in hollow members.
15. Amended claim 1 relates to a thermal insulating window frame or window frame

attachment which has at least one channel at opposed edges of the window to accommodate a roller screen, made of insulating material. The possibility of more than one screen, with the screens being of differing materials is also envisaged. The above documents, which form part of the state of the art for the purposes of section 2, disclose these features. Whilst the other details in claim 1 which relate to “areas, size, shapes and configurations” are not technical features, any attachment would need to be constructed to fit the window for which it was intended and all the prior art documents show such constructions. Consequently I find that claim 1, though unclear in scope and containing added matter, comprises merely known technical features and is therefore not novel, as required by section 1 of the Patents Act.

16. Turning now to the appendant claims, claim 2 specifies the use of “suitable materials” and this is implicit in the prior art cited. Claim 3 specifies vertical channels and, whilst in the context of the claim the use of the term “vertical” is not wholly clear since no orientation of the frame is specified, the prior art shows channels having the same orientation as the embodiment described in this application. The additional feature of claim 6, a ventilation grille, is shown in GB 2010367. Claim 8 introduces the feature that the screens are motor driven and such screens are described in DE 3309613. The additional feature of claim 13, independent operation of the screens, is shown in, for example, GB 2010367. Claim 14 introduces the feature that the frame is adapted to take an attachment for a curtain or pelmet and the prior art devices are suitable for attaching e.g a track for a curtain. Claim 16 introduces the feature that the frame extends completely round the member to which it is to be attached and such a frame is shown in EP 0142596. The “suitable detachable or fixed fastening means” specified in claim 17 is implicit in all the documents cited. Hence I find that the inventions of claims 2, 3, 6, 8, 13, 14, 16 and 17 are all known from the prior art listed above.

(c) *Inventive step*

17. Many of the appendant claims relate to features which are conventional in the art in question. Claim 4 introduces the additional feature that the channels are horizontal, which results in a claim lacking clarity since, as stated above, the orientation of the frame is not otherwise defined. However it is well-known to provide horizontally moving screens for vertical window frames and hence the feature is not considered inventive. Claim 9 is only properly appendant to claim 8 since it specifies that “the motors are driven by a programmable electronic control unit”. The introduction of such a device would be obvious to the man skilled in the art since such control units are well-known for closing curtains and blinds at specified times. The use of programmable lighting as a security deterrent is similarly well-known and hence claim 10 (which should only be appendant to claim 9) is not inventive. Claims 11 and 12 specify that the frame/screens are tinted, translucent or opaque and this is a design feature of individual choice not a technical feature. The additional feature of claim 15, that the screens are changeable according to function, season and desire, is similarly a matter of design. Hence I find that claims 4, 9, 10, 11, 12 and 15 do not include an inventive step.

(a) *Added matter in the appendant claims*

18. Claim 5 introduces the feature that “the space between the sealed doubled glazed window panes however configured are fitted wider”. Although it is not entirely clear what is

meant by this phrase there is no corresponding explicit or implicit disclosure in the original application. Hence the claim discloses matter extending beyond that disclosed in the application as filed. Claim 7 has the additional feature that “the frame channels includes any suitable component or mechanisms to provide detachably sealed, and retained smooth upward, downward, or sideways movement of the glazing, or screens”. In the application as filed there is no disclosure of any such component or mechanism within the channels. Hence this claim also discloses added matter.

### **Conclusions**

19. I have decided that the amended claims 1, 2, 3, 6, 8, 13, 14, 16 and 17 are not novel and that claims 4, 9, 10, 11, 12 and 15 lack an inventive step. These claims do not therefore satisfy the patentability requirements of section 1 of the Patents Act 1977. I have also found that some of the claims contain added matter contrary to section 76 and that some of the claims are not clear and hence do not comply with section 14(5). Whilst amendments could be made to meet the clarity and the added matter objections, having read the original application in its entirety I can find no technical features which could be added to the claims in order to meet the patentability requirements. Accordingly I refuse the application under section 18(3) on the grounds that the application does not comply with section 1.

### **Other matters**

20. Despite an assurance from Mr McKenzie that he only intended to submit for the Hearing Officer’s consideration the letter dated 18 June 2003, subsequent to the drafting of this decision a further amended claim was filed. This claim, although drafted as a single sentence, still gives rise to many of the clarity and added matter objections with which I have already dealt. It includes the technical features of claim 1 considered above and the additional feature of claim 6, i.e. a ventilation grille. Since I have already found claim 6 lacking in novelty I do not intend to consider this late-filed claim further.

### **Appeal**

21. The appeal period is 28 days from the date of this decision.

Dated this 25th day of June 2003

JACKIE WILSON  
Deputy Director, acting for the Comptroller

**THE PATENT OFFICE**