**Before The Superintending Examiner.**

1st June, 1956.

**IN THE MATTER OF AN APPLICATION TO AMEND CHILOWSKY'S PATENT.**

*Patent—Amendment—Disclaimer—Correction—Explanation.*

Deletion of one alternative from an appendant claim while retaining it in the description, Held, not to be disclaimer, since the alternative was still claimed—Deletion from both claim and description allowed.

Addition of a further alternative to an appendant claim, Held, (1) not to be explanation, since the original claim was perfectly clear and not in need of explanation and (2) not to be correction—Patents Act, 1949, Secs. 29 and 31 (1).


On 20th January, 1956, C. Chilowsky applied for leave under Sec. 29 of the Patents Act, 1949, to amend the complete specification of L.P. No. 648,293 entitled "Methods of and Apparatus for the Utilization of the Thermal Energy "Released in the Course of Atomic Decompositions".

The first three claims of the specification were as follows:

1. A process for the extraction of heat from a heat generator utilizing the energy freed by atomic decomposition, in chains, of a mass of uranium or uranium compounds bombarded by an initial source of neutrons, in the presence, on the one hand, of substances containing atoms of hydrogen, and, on the other hand, of substances containing atoms of cadmium, or other bodies possessing, in regard to neutrons, a high absorbing power that is independent of temperature, the simultaneous presence of these two substances insuring the stabilization of the atomic decomposition, wherein withdrawal of the released heat from the generator is effected by utilizing the circulation of a liquid, devoid of atoms of hydrogen or calcium, inside the mass undergoing atomic decomposition.

2. A process according to Claim 1, wherein the liquid is preferably a metal or a metallic alloy possessing high thermal conductivity and a large temperature range between the point of fusion and the point of vaporization.

3. A process according to Claim 1 or 2, wherein the liquid is lead, a lead-bismuth alloy, an aluminium-magnesium alloy, sodium, potassium, or a potassium-sodium alloy.

The Examiner reported that certain of the proposed amendments contravened the requirements of Sec. 31 (1) in that they were not by way of disclaimer, correction or explanation. In particular he reported "The proposed deletion from
"the claim of the reference to an aluminium magnesium alloy is not disclaimer because the use of this alloy is described and accordingly still covered by "Claim 1 or Claim 2". The matter came before the Superintending Examiner (Mr. D. H. Reed) acting for the Comptroller-General on 1st June, 1956. At the hearing R. Lochner appeared as Counsel for the Patentee and Mr. A. Holter, Agent for the Patentee, was also present.

The nature of the amendments, so far as relevant to this report, and the subject-matter of the specification, appear sufficiently from the Superintending Examiner's decision given on 11th July, 1956, the material parts of which read as follows:—

This application for amendment was filed on 20th January, 1956, the reason given on Patents Form No. 35 for making the amendment being stated as follows:—

"It is desired to correct certain errors which are apparent in the Specification as printed."

The amendments sought included two in Claim 3 which consist of the insertion of a reference to bismuth in line 2 of the claim, and deletion therefrom of a reference to "an aluminium-magnesium alloy" in line 3 of the claim, and the insertion of a parallel reference to bismuth on p. 9 at line 65 of the description.

The invention here lies in the field of atomic energy and may be said to be concerned with the extraction of the heat developed in an atomic pile which has been "stabilized" in a known way which is set out in Claim 1. According to Claim 1 withdrawal of the released heat is effected by the circulation inside the mass undergoing atomic decomposition of a liquid devoid of atoms of hydrogen or cadmium whilst according to Claim 2 the liquid is preferably a metal or a metallic alloy possessing high thermal conductivity and a large temperature range between the point of fusion and the point of vaporization.

As accepted Claim 3 reads as follows:—

"3. A process according to claim 1 or 2, wherein the liquid is lead, a lead-bismuth alloy, an aluminium-magnesium alloy, sodium, potassium or a potassium-sodium alloy."

As far as the proposal to delete reference to "an aluminium-magnesium alloy" is concerned, the Examiner has raised the objection that reference to its use is still made on p. 9 of the description in the passage from line 64 to line 68, which reads as follows:—

"The liquid metal is, for instance, lead or a lead-bismuth alloy, or sodium or potassium. In certain special cases, it may be of advantage to use an aluminium-magnesium alloy."

At the hearing, however, Mr. Lochner explained that it was intended to disclaim the use as the circulating liquid of an aluminium-magnesium alloy, and that the Patentee was prepared to cancel the reference to such use in the passage I have just quoted. With this additional amendment, the proposed deletion from Claim 3 may in my view be properly allowed.

That being so, only two of the proposed amendments remain for consideration and I will re-quote Claim 3 and the corresponding passage of description on p. 9 omitting the deletions I have now allowed and with the proposed additions included and underlined.
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3. A process according to claim 1 or 2, wherein the liquid is lead, bismuth or a lead-bismuth alloy, sodium, potassium or a potassium-sodium alloy.

The liquid metal is, for instance, lead, bismuth or a lead-bismuth alloy, or sodium or potassium.

Mr. Lochner defended these proposals on the ground that they could be considered to be by way of explanation, and made a formal request for Patents Form No. 35 to be amended accordingly. I accordingly returned the form to Mr. Holter and the reasons for making the amendments are now stated thereon to be "By explanation and disclaimer".

In his argument in support of the proposed additions, Mr. Lochner first referred to the well known case of E.M.I. v. Lissen (1939) 56 R.P.C. 23, and particularly the passage in Lord Russell's Opinion on p. 39 that:

"The claims must undoubtedly 'be read as a part of the entire document, and not as a separate document".

He next referred to the equally well known Cleveland Graphite Bronze Company's case (1956) 67 R.P.C. 149 to show that a possible ambiguity in one claim can be resolved or explained by reference both to the description and to a dependent claim. (Lord Normand's Opinion, p. 153 at lines 40 to 52.)

It is therefore a principle of construction, said Mr. Lochner, that an ambiguous claim may be in part explained by the description in the body of the specification which precedes it and in part by what appears in a dependent claim.

Applying that principle to the claims of the specification before me Mr. Lochner submitted that the word "liquid" used in Claim 1 was ambiguous, that the ambiguity was partly explained by Claim 2 which specified that the liquid was a metal or a metallic alloy, i.e., as I understood him, that it qualifies the term "liquid" in Claim 1 so that it must be read as meaning "fused", and that Claim 3 was seeking to explain what appears in Claim 2, and that as it was clear from the description that the use of liquid bismuth is contemplated by the invention, the addition sought to Claim 3 must be justified.

This submission in my view breaks down from the outset for the reason that the term "liquid" used in Claim 1 is in no sense ambiguous. As I construe Claim 1, it covers the use of any substance which is devoid of atoms of hydrogen or cadmium and which is in a substantially liquid state under the conditions in which it circulates inside the mass undergoing atomic decomposition. It is of course possible to say that Claim 1 is wider in terms than the consistory statement at lines 20 to 24 on p. 2 which is limited to the use of a liquid or fused metal or alloy as the heat-transfer vehicle but that is a matter with which I am not concerned here.

Mr. Lochner also referred me to Merck's Application (1952) 69 R.P.C. 285, in which the addition of the words "or by an obvious chemical equivalent thereof" to a number of dependent product claims was allowed. He relied particularly on a passage to be found on p. 288 at lines 9 to 12 of the report which reads as follows:

"The amendments sought merely express with clarity what a true construction of the specification would inevitably secure to the unamended document, and they lead neither to the claiming nor description of new matter nor to any variation in the scope of the claims."

Mr. Lochner suggested that the position here was on all fours with the position considered in Merck's Application, but the Claim 3 before me is, in my view,
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on an entirely different footing from the claims considered in that application. Claim 3 as accepted cannot be construed to include the use of liquid bismuth and on that account the proposed addition to it which must increase its content cannot automatically be allowed on the basis of the judgment in Merck's Application.

The only pronouncement in the authorities on the meaning to be accorded to the word "explanation" in the phrase "by way of disclaimer, correction or explanation" with which I am familiar is to be found in the Judgment of Sir Richard Webster A.G. in the case of Johnson's Patent (1896) 13 R.P.C. 659 at p. 660 lines 53 to 57 of the Report. It is in these terms:—

"On previous occasions I have expressed the view that the words of "Sec. 18 (1) of the Act of 1883, 'by way of disclaimer, correction or "explanation,' were meant to refer to disclaiming something which was "originally wrongly inserted or to explaining something which requires "explanation, having regard to the statement made in the first instance by "the Patentee.'"

In approaching the matter before me I shall have regard to this pronouncement. If I look at the Patentee's Specification I shall indeed find, as was pointed out by Mr. Lochner, that in two places and I think two only, in a description of the invention which is of considerable length, there is a reference to the use of bismuth as the liquid metal or alloy to be used. The first is to be found on p. 2 at lines 95 to 98. It is in these terms:—

"Indeed, the metals and alloys envisaged here as heat vehicles, and most particularly lead and bismuth, have a small absorption power for neutrons, and so their passage or their presence in the interstices of the active material do not in any marked manner affect the conditions of the stabilization."

The second reference is a purely negative one and is found on p. 3 at lines 117 to 119. It follows a description of the conditions in which it is possible to employ potassium, sodium or potassium-sodium alloys as the heat-transfer vehicle, and amongst the advantages alleged for the use of those metals is that "their thermic conductivity is markedly higher than that of lead and that of bismuth."

As against these references must be put the whole of the passage on p. 3 from line 48 to line 125. This passage begins in this way:—

"The invention, furthermore, concerns itself with the choice of metals or "alloys suitable to serve as heat vehicles. This choice will naturally, depend "partly on the contemplated conditions of use."

The passage then proceeds to discuss favourably the use of lead-bismuth alloys, the possible use of tin in such an alloy, and adds that

"Melted lead alone could also, in certain cases be used. It has the "advantage of being inexpensive."

There follows a passing reference to the possible use of mercury, if necessary under high pressure, and after discussing the reasons why cadmium is to be excluded, discusses the conditions under which potassium, sodium and potassium-sodium alloys can be favourably used.

Significantly, however, this long passage does not refer positively to the use of metallic bismuth, so it may be inferred that its use is not to be among the first choices which commended themselves to the inventor.

I can now pass straight to p. 9 and consider so much of the passage from which Claim 3 is derived as now remains relevant. I should first mention that the passage in question follows a description of Fig. 1 of the drawings and of the
manner in which circulation of the liquid metal takes place through the mass undergoing atomic decomposition and through the heat exchanger described with reference to that figure. It will be remembered that the passage on p. 9 reads:

“...The liquid metal is, for instance, lead or a lead-bismuth alloy, or sodium, or potassium.”

It will be observed that (except that there is no reference to potassium-sodium alloys, an omission which is remedied in Claim 3, or to the possible use of mercury) the list of liquid metals instanced is the same that is given in the passage on p. 3 from line 48 to line 125, in which the choice of metals or alloys for heat-transfer purposes is under consideration.

In other words the instanced metals are, as one might expect, selected from those which have already received special consideration and one might say commendation from the inventor. In these circumstances can it fairly be said that the proposal to include bismuth as an instanced metal in the passage under consideration is “to explain something which requires explanation having regard to the statement made in the first instance by the Patentee”? In my opinion, it cannot, and to allow the proposed insertion would in my view, extend to an unwarrantable extent the meaning which has hitherto been accorded to the word “explanation” as used in the expression “disclaimer, correction or explanation” which has been found in successive Acts in relation to applications to amend Complete Specifications which have been accepted and published. I must therefore refuse to allow the proposed amendment on p. 9 to be made.

I am satisfied that similar considerations must be applied to the proposal to add a reference to bismuth in Claim 3, and shall accordingly refuse to allow this proposal also.

Indeed, as far as Claim 3 as accepted is concerned it is a specific claim to the use of certain metals and alloys as the liquid heat-transfer means. Its boundaries are not in doubt and it is in no sense of the word an ambiguous claim. In my view it is a contradiction in terms to suggest that this claim is in need of explanation, or to suggest that a proposal to add to its content, as the inclusion of a reference to bismuth must do, can be by way of explanation.

Although the original reason given for making the amendments namely “the correction of errors which are apparent in the specification as printed” has been abandoned I should perhaps state that in my view these proposals to add a reference to bismuth in Claim 3 and in the corresponding statement of description on p. 9 (and it was conceded by Mr. Lochner at the hearing that the proposal so far as it affects Claim 3 is equivalent to adding a new appendant claim) could not be regarded as being by way of correction in the light of the judgment of the Patents Appeal Tribunal in the matter of The Distillers Company’s Application (1953) 70 R.P.C. 221; and it may be noted in this connection that the certified translation of the French specification on which the claim to the priority date of 28th July, 1939, is based, and the form of the British specification which became open to inspection under the proviso to Sec. 91 (4) of the 1907 Acts on the 11th June, 1948, are both in agreement with Claim 3 and the relevant passage on p. 9 in the form in which they were accepted. (See pp. 25 and 39 of the said translation and p. 25 and Claim 3 of the “as open” document.)

Moreover the proposed additions could not be regarded as being by way of disclaimer because they add to the content respectively of Claim 3 and the corresponding passage on p. 9.
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In the result I allow the following amendments:—

P. 9 lines 66 to 68. Delete “In certain special cases, aluminium-magnesium “alloy”.”

P. 11 line 19. Delete from Claim 3 the words “an aluminium-magnesium “alloy”.”

and reject the following proposed amendments:—

P. 9 line 64. Insertion of “comma” after “lead”.

line 65. Replacement of “or a” by the words “bismuth or a”.

P. 11 line 18. The addition after the word “lead”, of the words “bismuth “or”.

IN THE HIGH COURT OF JUSTICE—CHANCERY DIVISION.

Before MR. JUSTICE HARMAN.

18th January, 1957.

THOMAS RICHFIELD & SON LTD. v. SPEEDY CABLES LTD.

Trading name—Passing-off—Interlocutory injunction restraining the use of certain names in connection with the business of the Defendant Company.

T.R. carried on business as “T.R. & Son Ltd.”, his brother A.R. carried on business as S.C. Ltd.

T.R. commenced an action for passing-off, alleging that the Defendant Company was sending out in connection with its business letters signed T.R. and moved for an interlocutory injunction. It appeared from the evidence that the letters were written by a stepson of A.R. who for some time past had been using the name T.R.

Harmann, J., granted an interlocutory injunction restraining the Defendants until the trial of the action from using the name “T.R.” in connection with their business and from using the name “R.” in such connection without taking steps to distinguish their business from that of the Plaintiff Company. The costs of the motion were made costs in the action.

This motion came on before Harmann, J., on 18th January, 1957.

P. Stuart Bevan (instructed by Judge, Hackman & Judge) appeared on behalf of the Plaintiffs.

W. A. Bagnall (instructed by Stanley Jarrett & Coy.) appeared on behalf of the Defendants.