

DECISION OF THE COMMISSIONER

IN THE MATTER OF a request for review by the Commissioner of Patents of the Examiner's Final Action under Rule 46(2) of the Patent Rules;

AND

IN THE MATTER OF a patent application serial number 945,191 filed November 12, 1965 by Frank A. Kocian for an invention entitled:

SELF ALIGNING BEARING ASSEMBLY

Patent Agent for Applicant: Meredith and Finlayson.
Ottawa, Ontario.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action refusing to allow application 945,191. The request was granted in accordance with Section 46(2) of the Patent Rules.

In the prosecution terminated by the Final Action the examiner held that the claims of the application were directed to more than one invention, contrary to Section 38 of the Patent Act and Rule 60 of the Patent Rules.

The subject matter of the application deals with a self-aligning bearing assembly adapted to rotatably support a shaft, and consisting of an inner race and an outer race between which antifriction means (such as balls) are placed to permit relative movement between the races. The outer race is fixed in a housing or shroud member provided with radially depending side flanges which terminate short of the inner race leaving a narrow radial gap or discharge path. The outer race has a hole therein which carries a grease fitting which projects through an over-size opening in the housing; grease introduced via this fitting enters the interior of the bearing which constitutes the primary grease chamber. A secondary grease chamber is formed between the depending flanges of the housing and the bearing unit and defined by axially-gapped means. Non-metallic sealing means, specifically triplet sealing elements in one-way series connection, is attached to the ends of the outer race and disposed between the first and second grease chambers, the latter acting to collect grid particles and thereby prevent wear on the seal. The oversize opening in the housing limits rotational movement between the outer race and the housing carrying the fitting, while the ends of the outer race engaging the radially depending flanges limits tilting movement of the outer race by taking up an axial clearance therebetween.

Office Actions were issued on August 16, 1967; March 19, 1968; October 31, 1968 and the Final Action on May 28, 1969. The First Office Action dealt with the patentable merits of the claims in view of prior art in reply to which applicant amended the claims to the form as presently on file. The remaining Office Actions including

the Final Action dealt with a requirement to restrict the claims to one invention only. Applicant replied to each action, but did not amend the claims.

The Office Action of March 19, 1968 raised for the first time the objection that the claims were directed to more than one alleged invention. The examiner cited Section 38 of the Patent Act and Rule 60 of the Patent Rules as authority in requiring restriction of the claims to one invention only, and pointed to claims 1 and 13 as stressing different features of the device disclosed.

Due to the transfer of class 308, Bearings, from section M-1 to M-7 this application was reviewed by another examiner, who in the Office Action dated October 31, 1968 and in the Final Action dated May 28, 1969 reiterated the previous requirement to restrict the claims in this application to one invention only citing Section 38 and Rule 60 as authority. The claims were grouped into three groups A, B and C and the examiner's position with respect to these claims can best be summed up by the following extract from the Final Action:

"It is maintained that the claims are directed to more than one alleged invention and which may be grouped as follows:

- A: Claims, such as claims 1, 2, 3 and 6 are directed to a supporting race and a shroud member with radial end flanges and stress the features of (1) a grease fitting projecting through an oversized opening in the shroud member to shift therewith and limit rotational movement between race and shroud, (2) a portion on the race engaging the end flanges to limit tilting movement.
- B: Claims, such as claims 4, 8, 9 lack the features (1) and (2) of group A but rely upon the features of (3) a primary grease chamber, (4) a secondary grease chamber defined by axially gapped means, (5) narrow radially gapped escape means and (6) non-metallic seals. Certainly, feature (6) is not present in the claims of group A. Contrary to applicant's statement, item (6) cannot be considered equivalent or congruous to item (2) as they serve completely different functions.
- C: Claims, such as claims 13 and 14 fail to recite features (1) and (2) of group A nor define in the same terms the features (4) and (5) of group B, but rely primarily upon the provision of (7) one way opening seals in series connection with the primary and secondary grease chambers; this latter feature is not found in either group A or B.

In order to comply with Section 38 of the Patent Act, namely, that the claims must be limited to one invention only, the Rule 60 unity test must be satisfied. To satisfy Rule 60, there must be a claim broader in scope than any other claim. It follows that the features of the broadest claim must be recited in all other claims, in the same or more restricted scope. The present claims do not claim one invention in broad and narrower scopes but claim independent alleged inventions in different terms as set out above.

Claims 5, 7, 10, 11, 12 and 15 set forth various features in such migratory combinations that they may not be exclusively grouped with any one of the three representative groups now in the application. In amending to limit the claims to one invention, applicant may assert such claims as will have unity of invention with the broad claim chosen from Group A, B or C."

The applicant in his response of September 9, 1968, April 28, 1969 and August 28, 1969 made the following submissions which can best be stated by quoting verbatim, pages 2 to 9 of applicant's remarks in his request for review dated August 28, 1969, in which applicant presents all the arguments previously made of record:

"In the second Official Action, dated March 19, 1969, the amended claims 1, 2, 3 and 6 and substitute Claim 15 presumably were examined and were neither rejected on any new art of Class 308, nor on the art of Class 308 previously cited, nor was there any indication that the examination of these claims necessitated a search in a class other than Class 308. Applicant had made a bona fide attempt to advance the application to allowance as is required under Rule 43(3) of the Patent Rules. However, a new objection was now set forth alleging that the claims were directed to more than one invention, and citing amended Claim 1 and original Claim 13 as examples. There was no indication as to what was considered to be the distinct invention claimed in each of these two claims, and which of the remaining claims could be grouped under amended Claim 1 or original Claim 13, nor was there any art cited to show classification between amended Claim 1 and original Claim 13 and where it was now necessary to search outside of Class 308 of the classification system for an examination of the invention claimed in the amended Claims 1, 2, 3 and 6. Accordingly, applicant in response to the second Official Action requested art to show classification between the claims and where it was now necessary to search in two or more classes for examination of the complete invention claimed.

In the third Official Action of October 31, 1968, no art was cited to show classification but a further invention was then alleged to be present between original Claims 4, 5, 7 to 12 inclusive and substitute Claim 15, which were grouped in B, and original Claims 13 and 14 which were grouped in C. It was submitted in response to this third Official Action that since the claims of Group B and C had been already examined on the merits, the prosecution was closed thereon. Since this application had been transferred from Examining Group M-1 to Examining Group M-7, it was submitted that full faith and credit should be given to the search and two actions of the previous Examining Group M-1 unless there was a clear error in one or both of the earlier actions or knowledge of other prior art. Clearly the vagaries of subjective opinions of different Examiners in patent prosecution must give way to uniformity of Patent Office Practice. The applicant, therefore, traversed the requirement for limitation of claims between Groups B and C. Further, in response to the third Official Action the applicant submitted that the certain features numbered (3) to (6), inclusive, alleged in the third Official Action to be present only in Group B were also present in Groups A and C. In addition, it was submitted that the features numbered (1) and (2) alleged in that Official Action to be only in Group A were also present in the claims in Groups B and C. Applicant therefore traversed the requirement for limitation of the claims between Group A and Group B and C and presently maintains that the requirement by the Examiner in this regard should be withdrawn.

In the Final Action by the Examiner pursuant to Rule 46 dated May 28, 1968, again no art was cited to show classification but the general requirements of the two previous Official Actions (2nd & 3rd) were maintained. Although certain of claims set forth in three groups in this action are the same as those so grouped in the third Official Action, the claims previously alleged to be solely within Group B, namely; Claims 4, 5, 7 to 12 and 15 were reduced to Claims 4, 8 and 9 whereas Claims 5, 7, 10, 11, 12 and 15 are now purported to "set forth various features in such migratory combinations that they may not be exclusively grouped

with any one of the three representative groups now in the application". The applicant again submits that the vagaries of subject opinion examination has overridden the requirements of uniformity in Patent Office Practice which is not only desirable but essential to meaningful communication and prosecution of a patent application.

Nevertheless, the applicant submits that Claims 1-15 inclusive are all directed to one and the same invention and are analogous, and that all claim congruent devices for carrying the invention into effect - a unique self-aligning bearing assembly.

Applicant maintains its submission that within the claims of the invention the features numbered (3) to (6) inclusive, alleged to be present only in Group B are also present in Groups A and C; that the features numbered (1) and (2), alleged to be present only in Group A are also present in Groups B and C and further submits that the feature numbered (7) alleged to be present only in Group C is present in Groups A and B. The details of that earlier submission are repeated hereafter for convenience of reference:

The "(3) primary grease chamber" of Group B is congruous to "interior grease chamber" of Group A, and is congruous to "primary grease chamber means" of Group C;

The "(4) secondary grease chamber defined by axially-gapped means" of Group B is congruous to "axial clearance" of Group A, and is congruous to "secondary grease chamber means" of Group C;

The "(5) narrow, radially gapped escape means" of Group B is congruous to "narrow gap" of Group A and is congruous to "external discharge path" of Group C;

The "(6) non-metallic seals" of Group B, contrary to the examiners' statement is submitted to be congruous to "(2) a portion etc." of Group A; and is congruous to "(7) one-way opening seals" of Group C;

The "(1) a grease introducing fitting" of Group A is congruous to "fitting means" of Group B and is congruous to "primary grease chamber means . . . adapted to be charged with lubricant" of Group C; and

The "(2) a portion on the race etc." was shown to be congruous to items (6) and (7) above; and

The "(7) one-way opening seals" was shown to be congruous to items (2) and (6) above.

Applicant therefore maintains it has shown that the features numbered (3) to (6) which were alleged to be present only in Group B, are also present in Groups A and C; that features numbered (1) and (2) alleged to be present only in Group A, are also present in Groups B and C; and that the feature numbered (7) alleged to be present only in Group C is also in Groups A and B. If an invention consists of several parts, some of which are subordinate, those subordinate parts will not be protected unless applicant specifically claims them and, indeed, it is submitted it is only reasonable that the applicant should be able to protect itself by rephrasing things and combinations differently in another claim in the same application to allow the applicant to achieve the rightful scope of protection permitted by the Patent Act.

Applicant therefore maintains that the Examiners' requirement for limitation of the claims between Group A, Group B, and C should be withdrawn.

In support of the applicant's position of traversing the requirement for limitation of the claims, applicant sets forth Section 36(2) of the Patent Act which reads:

- (2) The specification shall end with a claim or claims stating distinctly and in explicit terms the things or combinations that the applicant regards as new and in which he claims an exclusive property or privilege.--

The terms of Section 36(2) permit applicant to claim a range of equivalents commensurable with his invention. There is no limitation to the number of claims to things or combinations which may be presented in one application. Hence, Section 36(2) is applicable to applicant's application which does comply therewith and does end with a number of claims to the things or combinations that applicant regards as new and in which he claims an exclusive property or privilege. Therefore, if the invention consists of several things, parts or elements, some of which are subordinate, those subordinate things, parts or elements will not be protected unless the applicant claims them as is applicant's privilege to do under the terms of Section 36(2).

Next, in support of the aforementioned position, applicant sets forth, in part, Section 38(2) reading:

- (2) Where an application describes and claims more than one invention the applicant may, and on the direction of the Commissioner to that effect shall, limit his claims to one invention only, and the invention or inventions defined in the other claims may be made the subject of one or more divisional applications. . . ;--

The terms of Section 38(2) clearly and unequivocally provide that the application must not only claim two inventions but must also describe two inventions before the claims shall be directed to be limited to one invention. Throughout applicant's application only one invention is described. The unique self-aligning bearing assembly and the new and useful result it produces in combination with certain subordinate parts, things or elements. Under the rights granted the applicant under Section 36(2) of the Patent Act, recited previously, the applicant ends the application with a number of claims to the things or combinations that applicant regards as new and in which an exclusive property or privilege is claimed. Hence, the application is not within the scope of Section 38(2) of the Patent Act; and therefore there is no basis for the requirement to limit the claims under Section 38 of the Patent Act.

Rule 60 of the Patent Rules as applied consistently by the Examiners throughout this prosecution obviously is at variance with the terms of Section 36 and 38 of the Patent Act. The terms of the Patent Act prevail over the Patent Rules. In support of this position, applicant sets forth Section 12(1)(a) of the Patent Act, which reads:

- 12(1) The Governor in Council, on the recommendation of the Minister, may make, amend or repeal such rules and regulations as may be deemed expedient (a) for carrying into effect the objects of this Act, or for ensuring the due administration thereof by the Commissioner and other officers and employees of the Patent Office;--

In other words, the Patent Rules must be in harmony with the terms of the Patent Act. Nothing in the Rules can contravene the terms or intention of the Sections of the Patent Act.

In further support of applicant's final position, applicant now sets forth Rule 24, of the Patent Rules, which reads:

- 24. Claims must be complete independently of any reference to any document referred to in the disclosure; a broader claim should precede a narrower, and any additional characteristic described in a narrower claim should be added to those described in a broader claim by referring to the broader claim by number.--

Under the first part of Rule 24 it is mandatory that the claims be complete per se and that it is not permissible to incorporate a reference in the claims to any document, such as the drawing referred to in the disclosure. Under the second part of Rule 24 it is desideratum that a broad claim precede a narrow claim, and that a narrow claim be dependent on the broad claim. The applicant, under the second part of Rule 24, has the right to present claims in the application which are either dependent or independent in form or a mixture of both. This is in harmony with Section 36(2) of the Patent Act. Hence, the Examiner, in holding that all the claims must recite all the features set forth in the broadest claim in the same or more restricted terms, is restricting the form and content of the application, contrary to the provisions of Section 38(2) and hence contrary to the terms of Section 12(1) (a) of the Patent Act, and is depriving applicant of its rights under Section 36(2) of the Patent Act and Rule 24 of the Patent Rules."

Upon review and careful consideration of the grounds for rejection set forth by the examiner as well as all the arguments presented by the applicant, I am satisfied that the rejection is well founded and must conclude that the claims are directed to more than one invention. The groupings of the claims A, B and C are correct as stated in the Final Action of May 28, 1969 and with regard to the remaining claims 5, 7, 10 to 12, and 15 these may be grouped as follows: Claims 5, 7, 10, 11 and 15 with group A or B, and claim 12 with group B or C.

Contrary to applicant's position it is not necessary, in determining unity of invention to cite art to show classification between the claims nor is it necessary to indicate why it is essential to search outside of class 308 Bearings for an examination of the invention disclosed. One can certainly have more than one invention in the same field, in this case Bearings, witness the considerable number of patents that have issued in this class. As regards citation of art, this is sometimes helpful in determining unity of invention in claims which rely upon a specific improvement over the prior art, but it is not essential to do so. I suspect that applicant's remarks in this respect may be more pertinent to United States practice which is known to differ substantially from the guidelines used in Canada with regard to determining unity of invention.

At this point, I wish to state that I am in complete agreement with the guideline set forth on page 2 of the Final Action, as expressing the proper interpretation of Section 38 of the Patent Act and Rule 60 of the Patent Rules and for the record I quote therefrom

"In order to comply with Section 38 of the Patent Act, namely, that the claims must be limited to one invention only, the Rule 60 unity test must be satisfied. To satisfy Rule 60, there must be a claim broader in scope than any other claim. It follows that the features of the broadest claim must be recited in all other claims, in the same or more restricted scope".

In connection with the submission that "the vagaries of subject opinion examination has overridden the requirement of uniformity in Patent Office Practice" I would point out to the applicant that in each of the Office Actions, the proper guidelines were set forth regarding unity of invention. In the first Action on this issue, claims 1 and 13 were mentioned as illustrative of defining different inventions; there was no indication that these were the only two inventions defined. Subsequent actions grouped the claims in more detail, but the guidelines set forth in each instance are essentially the same.

Applicant has attempted to show how the features listed as (1) to (7) in the Final Action dated May 28, 1969 are present in all the groupings A, B and C and listed these as to how they are congruous. I cannot agree with applicant's comparison which I find incomplete and in certain instances incorrect. The claims in group A recite features not found in either B or C. In equating the "grease introducing fitting" of group A to "fitting means" of group B and to the "primary grease chamber means" of C, applicant has ignored the feature (1) specifically underlined by the examiner, namely, the provision of an oversized opening in the shroud member through which the fitting projects and limits rotational movement between race and shroud. I cannot find this feature in any of the claims listed under group B or C. Applicant has also equated feature (2) "a portion on the race engaging the end flanges to limit tilting movement" to "non-metallic seals" of B and "one-way opening seals" of C. This is entirely incorrect. The "sealing means" of B or C have no function in limiting tilting movement which is accomplished by one of the ends of the outer race engaging the corresponding radial side flange.

The claims in group B define features not found in either A or C. The claims in this group specifically define the (4) secondary grease chamber by axially gapped means and (5) narrow radially gapped escape means with the limitation that the axial gap is greater than the narrow radial gap. The claims in group A recite "axial clearance" which is for the purpose of giving limited tilting movement and no mention is made of a secondary grease chamber. A bearing could have the latter without the "axial clearance" for the purpose of limiting tilting movement. The claims in group C merely define broadly "a secondary grease chamber means" which is clearly much broader than feature (4) as defined in B. Also, reference to the "narrow gap" in group A and "external discharge path" in group C are clearly of much broader scope than feature (5) in group B.

Finally, the claims in group C define (7) one-way opening seals in series connection between broadly defined primary and secondary grease chambers. I find no structure or feature of the same scope in the other two groups of claims A or B. In fact the claims of group A, contain no reference to such seals, since the alleged equivalent

"a portion of the race engaging----" clearly refers to the end of the race and not any seals which are not designed to limit tilting movement of the race. In any event, this description and that in the claims of group B as "non-metallic seals" are clearly not of the same scope as feature (7) of group C.

Accordingly, it is clear to me that each group of claims A, B and C recites or stresses distinct and separate features, there being no claim broader in scope than any other claim. Rule 60 has therefore not been satisfied and hence the requirements of Section 38 have not been met.

In support of his position of traversing the requirement to limit the claims to one invention, applicant has presented considerable discussion of and refers specifically to Section 36(2), Section 38(2), Section 12(1) (a), Rule 60 and Rule 24, in that order.

I cannot seriously disagree with applicant's interpretation of Section 36(2), that "there is no limitation to the number of claims to things or combinations which may be presented in one application" nor with the statement that "the terms of the Patent Act prevail over the Patent Rules", based on Section 12(1) (a). It should be noted, however, that Section 36(2) deals with applications and before a patent can be granted based on this or any other application, the requirement of Section 38(1) that "a patent shall be granted for one invention only" must be met. In other words, an application which contains claims to things or combinations regarded as new cannot be allowed in one application, unless they are directed to one invention only. If they are not, Section 38(2) makes provision for filing divisional applications on the separate inventions.

To determine or ensure that the claims in an application are or are not directed to one invention, the examiner has properly applied the Rule 60 unity of invention test. There must be a claim broader in scope than any other claim. Using applicant's own terms, Rule 60 is clearly in harmony with and does not contravene Section 38(1) of the Act.

Finally, applicant makes the point that under the terms of Section 38(2) the application must also describe as well as claim two inventions, whereas he only describes one invention. To this, I would reply that any invention claimed must find proper support in the disclosure to be properly allowable. I would further point to the objects of the invention on pages 2 and 3 of the instant disclosure as indicating, and this is important, the three general categories of subject matter listed under A, B and C by the examiner. Applicant's final reference to Rule 24, which gives him the right to present claims in either dependent or independent form, or both, is not disputed; nor is it essential although desirable that a broad claim must precede a narrower claim or that the latter be dependent on the broad claim. However, applicant cannot infer from this that a claim broader than any other claim is not required; such a claim must appear somewhere in the application and preferably the first claim should be the broadest.

The rejection of the examiner is upheld.

Decision accordingly,

Dated at Ottawa, Ontario
this 14th day of July, 1970

A.M. Laidlaw,
Commissioner of Patents.