

DECISION OF THE COMMISSIONER

IN THE MATTER of a request for a review by the Commissioner of Patents of the Examiner's Final Action under Section 46 of the Patent Rules (Prior to the Amendment by Order-in-Council P.C. 1970-728 effective June 1, 1970).

AND

IN THE MATTER of a patent application serial number 971,145 filed September 23, 1966 for an invention entitled:

METHOD AND APPARATUS FOR WORKING WOOD

Patent Agent for Applicant: Messrs. Marks & Clerk,
Ottawa, Ontario.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated May 7, 1970 refusing to allow application no. 971,145. The request was made in accordance with Section 46 of the Patent Rules.

The facts are as follows:

The application relates to a Method and Apparatus for Working Wood and was filed September 23, 1966 with a Swedish convention date of September 24, 1965. The invention is defined in the two claims in the application as follows:

A process for sawing wood logs comprising; successive feeding of the log irrespective of quality and size, radioscopically detecting the internal quality and external configuration of said logs, photoelectrically detecting the smallest dimension of said logs, feeding the quality and dimensional information to a computer memory; computing the proper positions of successive adjustable saws in accordance with said quality and dimension information; adjusting said saws in accordance with signals from said computer; and sawing the logs with said saws; whereby said logs are sawed to get the maximum yield of usable lumber consistent with the quality and dimensions of the initial wood object.

A plant for sawing wood logs comprising conveyor means for carrying said logs successively; means for radioscopically detecting the internal quality and external configuration of said logs, means for rotating said

logs for aligning, photoelectric means for detecting the smallest dimensions of said logs; computer means; means for feeding quality and dimensional signals to said computer form said radiosopic and photoelectric detecting means; adjustable saws for sawing said logs; and means for adjusting said saws in accordance with said quality and dimensional details.

Correspondence ensued between the applicant and the examiner with the examiner rejecting the originally filed seven claims on the ground that they lacked inventive ingenuity. In response the applicant traversed the rejection and argued that the absence of prior art suggested the presence of novelty and ingenuity.

The examiner then took the stand that an important element of the invention was not fully described and further objected to the use of the term "quality" as not being sufficiently defined. The applicant expressed the view that the element in question (radioscopic device) would be readily available to the person skilled in the art and therefore no further description should be required.

The examiner followed this with an action on February 12, 1970 in which he reiterated the previous objection to "quality" and "radioscopic device" and further rejected the application under Section 36 of the Act for insufficiency in that a suitable computer was not described and the photoelectric sensing means was not supported by the disclosure. The examiner took the stand that failure to insert descriptive matter in regard to these elements would result in the disclosure being held contrary to Section 36(1) of the Act.

The applicant responded by amending the disclosure to insert identification of the radioscopic device in the manner suggested by the examiner, and also defining the computer.

On May 7, 1970 the examiner issued a Final Action under Section 46 of the Patent Rules (prior to amendment by Order in Council P.C. 1970-728 effective June 1, 1970). The application was rejected for insufficiency of disclosure with respect to detecting means 4, radiosopic device 7, photoelectric means 11 and computer 12 and also that the term "quality" was not defined. The examiner took the stand that the expanded descriptive matter (page 2 line 30 to page 3 line 6) inserted by the previous amendment was new matter and held that the attempt to identify a suitable computer was vague and misleading. The applicant was also required to provide full identification of the various detecting elements.

On August 5, 1970 the applicant requested a review of the rejection by the Commissioner. The applicant argued that the

examiner had first taken the stand that the computer could be a well known computer whereas in a later Action he rejected the application as not describing a suitable computer. Argument was also advanced that "quality" was a term which would be understandable to a person skilled in the art and that although the devices 4, 7, 11 and 12 were not described in detail in the original disclosure it was felt that such detailed description was unnecessary for a person skilled in the art. It was indicated that a list of the various parts was being prepared and the list was submitted on September 24, 1970.

A hearing was arranged and held before the Patent Appeal Board on November 3, 1970 with Mr. George Seaby representing the applicant.

Mr. Seaby argued that "quality" was an accepted term to one skilled in the art and submitted copies of two articles "Guiding Principles for Grading of Swedish Sawn Timber Redwood and Whitewood" and "Directions for the Measuring of Roundwood" which made it clear that "quality" means the interior and exterior characteristics of wooden objects.

It was argued that detecting means (element 4) would be readily available to persons carrying out the invention and examples of the use of such detecting means was given. It was argued that x-ray scanning by a radiosopic device (element 7) could be readily used by a person skilled in the art. It was pointed out that photoelectric devices (element 11) are well known and their use in the present invention would present no difficulty to a person skilled in the art. Finally it was argued that the selection and programming of a computer to perform in the required manner would not involve the exercise of the inventive faculty.

I have studied the prosecution and carefully considered the written and oral argument by the applicant and its representative and also the oral argument by the director of the Mechanical Division and I find that this invention is one which requires a large amount of technical knowledge and skill to put into operation, however the exercise of such knowledge and skill is not inventive. In my view the original disclosure could have been drafted in such a way as to better describe the elements entering into the invention, but since each of the elements was known at the time of filing I see no objection to expanding the description as was done in the amendment dated April 13, 1970.

The view was expressed by the Examiner that the information submitted in applicant's letter of September 24, 1970 should properly have been inserted in the disclosure in some comparable form. I do not find such a requirement in the

Final Action and in my view the information was submitted for the purpose of convincing the examiner that the various elements were, in fact, known and available and I do not feel that such restrictive information is required in the disclosure.

In regard to the use of the term "quality" in the claims, I am satisfied, as a result of applicant's submission, that this term has a definite and well known meaning in the lumber industry and should therefore be acceptable.

I find, that the disclosure is sufficient to support the two claims in the application and therefore the examiner's rejection should be reversed.

R. E. Thomas,
Chairman,
Patent Appeal Board.

I agree with the findings of the Patent Appeal Board and direct that the application be remanded to the examiner for further action.

Decision Accordingly,

A.M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario
this 20th day of November, 1970