

DECISION OF THE COMMISSIONER

SUPPLEMENTARY DISCLOSURE: Date Based on Claims only.

Claims per se cannot be treated as "disclosure" under Rules 52 and 53, as defined by Rule 2(e). As is the case with an appln, a filing date cannot be given the date on which claims only are filed.

FINAL ACTION: Affirmed

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.

AND

IN THE MATTER OF a patent application serial number 833,291 filed October 6, 1961 for an invention entitled:

PREPARATION OF PERCHLOROFLUOROPROPANES

Patent Agent for Applicant: Messrs. Smart & Biggar,
Ottawa, Ontario.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated September 9, 1970 refusing to allow the supplementary disclosure.

The Patent Appeal Board conducted a Hearing on May 6, 1971. Mr. R. Fuller represented the Applicant. The facts are as follows:

Application No. 833,291 was filed October 6, 1961 in the name of J.W. Clart et al, and refers to Preparation Of Perchlorofluoropropanes.

In the prosecution terminated by the Final Action dated September 9, 1970 the examiner refused to allow the supplementary disclosure and claims 6 and 7 supported by the supplementary disclosure under Sections 2(d), 28(1) and 29(2) of the Patent Act in view of the following references:

United States Patents		
3,235,612	February 15, 1966	Anello et al
3,258,500	June 28, 1966	Swamer et al

On August 22, 1967 the examiner issued an action under Section 45(2) of the Patent Act initiating conflict proceedings between this application and two copending applications designated as 000,092 and 000,689. Two claims were drafted by the Patent

Office to define the conflicting matter and were identified as C1 and C2. In this action, the applicant was advised that claims C1 and C2 were submitted for conflict purposes only and could not issue to him as they were too broad for his disclosure.

At this time, the applicant of application 000,689 withdrew from the conflict. However the applicant of application 000,092 maintained the conflicting matter.

(Actions and responses under S.45 from Jan. 15, 1968 to April 9, 1969 set out in the decision have been omitted).

On April 29, 1969, the examiner issued an action requiring the applicant to remove claims C1 and C2 which were offered to him for conflict purposes only.

The applicant responded July 4, 1969 cancelling the conflict claims and reasserting them as new claims 6 and 7 supported by a supplementary disclosure which was submitted at the same time. The supplementary disclosure was then given a filing date of July 4, 1969.

(Actions and responses between July 4, 1969 and Sept. 1970 set out in the decision have been omitted).

The examiner pointed out in the final action that, although the supplementary disclosure has been restricted to consist only of the disclosure of claims 6 and 7 (claims C1 and C2) as placed on file on December 22, 1967, this date cannot be considered as the actual filing date of the supplementary disclosure because Sections 52 and 53 of the Patent Rules deal with amendments to the disclosure only. In other words, claims which are directed to matter which falls under Sections 52 and 53 of the Patent Rules cannot be treated as a disclosure of an invention. The matter must first be introduced into the disclosure in accordance with Section 53 before the claims can be considered. In this case, the day upon which the subject matter was introduced into the disclosure is July 4, 1969. Therefore the actual filing date of the supplementary disclosure is July 4, 1969.

In a letter dated December 16, 1970, the applicant made the request for review under Section 46(5) of the Patent Rules. In his request for review, the applicant reiterated the arguments which were submitted in the previous response of May 20, 1970 and presented new arguments as follows:

- a) Since there is no court decision in Canada which is concerned with the state of affairs which exists in the present case, the applicant has turned for guidance to decisions given in Great Britain as he believes that in the absence of any Canadian

decision, decisions of the British Courts are authoritative. In support of his arguments, the applicant has relied on the following Court cases:

- (1) Lawson vs. the Commissioner of Patents - Exchequer Court 1970.
- (2) Tennessee Eastment Co. vs. the Commissioner of Patents - Exchequer Court 1970.
- (3) Moser vs. Marsden 13 R.P.C. 24.
- (4) George Hattersely & Sons Ltd. vs. George Hodgson Ltd. (1904) 21 R.P.C. 525.

The first two Court cases are relied on by the applicant to support his contention that in the absence of any Canadian decisions, decisions of the British Courts are authoritative. The other Court decisions are used by the applicant to support his position that since the Commissioner has allowed amendment of the application so as to include the conflict claims, the conflict claims should be considered as part of the original specification and the alignment of the formal parts of the specification (disclosure and claims) to coincide with one another should not be prevented by a formality. The entire specification may be looked to as the definition of the invention and once this inventive concept is positively set forth, especially by leave of the Commissioner in allowing conflict claims to be added, all parts of the specification should be considered together and should be allowed to be brought into alignment with one another. Doing so, is nothing more than rearranging the form of the total invention which was properly set out during the prosecution of the case by the applicant.

- b) As to whether the amendment to the disclosure was timely in view of the issuance of prior art after the conflict claims had been copied by the applicant, the applicant submits that the disclosure was amended as of the time the specification (claims plus disclosure) was amended. He also argued that this view be taken in light of the ruling of Collins, J.R. (Court case #4 referred to above) holding that the entire application be considered as a unity defining the invention and the holding of Lord Watson (Court case #3 referred to above) that the "... amended claims be ... (considered) on the same footing as if it had formed part of the original application ...". Thus amendment of the specification in one part (i.e. claims) should be considered amendment of the specification as to the other part (i.e. disclosure) at least as to the effective time of such amendment.

- c) Finally, the applicant submitted, after discussing subsections (1)(a), (3), (4), (5), (7) and (8) of Section 45 of the Patent Act, that once the conflict has been declared, the Commissioner is lacking any discretionary power based on the Patent Act, to disallow the claims made by the applicant for the purpose of a conflict.

After reviewing the grounds for rejection set forth by the examiner, as well as the arguments both written and oral set forth by the applicant I am satisfied that the rejection is well founded.

At the Hearing the Patent Agent Mr. Fuller ably presented the case for the applicant by expanding and re-emphasizing points made during prosecution.

The basic question to be resolved is, what is the effective date of the supplementary disclosure?

Section 2(e) of the Patent Rules reads as follows: (Quoted)

Section 53 of the Patent Rules reads as follows: (Quoted)

It is evident from the definition of "disclosure" in Section 2(e) of the Patent Rules and the language of Section 53 of the Patent Rules that claims which are directed to matter which falls under Sections 52 and 53 of the Patent Rules cannot be treated as a disclosure of an invention. The matter must first be introduced into the disclosure in accordance with the provisions of Section 53 before the claims can be considered.

I find that the subject matter of claims 6 and 7 was not submitted by the applicant as an amendment to the disclosure, but was submitted by the Patent Office as Claims C1 and C2 for conflict purposes only. This was clearly set forth in the Section 45(2) action dated August 22, 1967. When applicant entered claims C1 and C2 on December 22, 1967 for the purposes of defining the conflict he did not argue that these claims formed part of his disclosure. It was also made clear at that time that his disclosure would not support these claims.

At the Hearing the Patent Agent suggested that under former Section 68 of the Patent Rules an amendment could not be made during conflict proceedings. It has been the policy for many years that a supplementary disclosure may be filed to obtain an effective filing date even though it may not be entered at the time of filing.

With respect to the two British Court decisions relied on by the applicant to support his position that since the Commissioner has allowed amendment so as to include the conflict claims, the conflict claims should be considered as part of the original specification, I find that they are not pertinent as the subject matter of these decisions do not refer to amendments to the disclosure as defined by Section 53 of the Patent Rules.

I turn now to applicant's position that once the conflict has been declared, the Commissioner is lacking any discretionary power, based on the Patent Act, to disallow the claims made by the applicant for the purpose of a conflict, I fail to see how this position can be relevant in the present situation. The conflict claims were rejected after the conflict was dissolved and in order to overcome this rejection, the applicant, after cancelling the conflict claims, filed a supplementary disclosure and reasserted these claims as claims 6 and 7 supported by the supplementary disclosure. The present rejection is not based on the fact that these claims were conflict claims but on the fact that the actual filing of the supplementary disclosure took place more than two years from the date of the two cited United States patents.

As a matter of interest applicant's attention is directed to his response of May 15, 1968 in which he directed attention to two United States Patents. The applicant stated:

U.S. 2,745,866 teaches that substantially the same catalytic process may be conducted at temperatures between about 125-600°C., the only difference between this reference and the aforementioned U.S. 2,436,143 being the use of chromium fluoride which is oxidized in situ, apparently to the oxide of the catalytic chrome compound.

Thus the basic process of the conflict claim(s) is anticipated by U.S. 2,436,143, the only distinction being the temperature range. It is submitted that the higher temperature employed in the conflict claim(s) does not add any inventive limitation but only spells out a variable in the process which is well-known in the catalytic art especially as indicated in U.S. 2,745,866.

Wherefore, in view of the foregoing reasons it is respectfully solicited that the conflict be dissolved with regard to all parties and furthermore any claim or claims remaining in either specification be rejected over the foregoing U.S. Patents.

Here I find that the applicant maintains that there is no invention in the subject matter involved.

The applicant has maintained that once claims 6 and 7, which were not supported by the disclosure, were entered in the application, this should give the applicant the right effective as of that date, to enter the subject matter of the claims into the disclosure at a later date. This only holds true of claims of an application as originally filed. On the other hand, if claims only were filed with an original application, no application number or date would be given as it would be an incomplete application. By the same token if claims only are filed at any time after the original filing date then no supplementary disclosure date could be given for such claims.

I have concluded that the claims now indicated as supported by the supplementary disclosure should bear the date of the supplementary disclosure, the date the subject matter of claims 6 and 7 was introduced into the disclosure, i.e. July 4, 1969 and not the date when they were given to contest a conflict with the qualified remark that they were not supported by the disclosure and could not be awarded to the applicant.

It is assumed that the two United States Patents issued in 1966 are pertinent as references against the claims as the applicant has not raised any argument except one based on date.

I recommend that the decision of the examiner, to reject claims 6 and 7 supported by the supplementary disclosure (effective date July 4, 1969) under Section 28(1) and 29(2) of the Patent Act in view of the prior art cited, be upheld.

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

I concur with the finding of the Patent Appeal Board and refuse to allow claims 6 and 7. The applicant has 6 months in which to appeal this decision in accordance with Section 44 of the Patent Act or remove the rejected subject matter.

Decision accordingly,

A.M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 17th day of May, 1971.