

DECISION OF THE COMMISSIONER

INSUFFICIENT EXAMINATION

No proper decision can be made on the grounds of obviousness solely on common general knowledge when the prosecution has not dealt with the matters that should be considered.

FINAL ACTION: Withdrawn

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 002,404 filed October 13, 1967 for an invention entitled:

METHOD FOR ELECTRODEPOSITION OF PAINT

Agent for Applicant

Messrs. Sim & McBurney,
Toronto, Ontario.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated September 1, 1970 refusing to allow the claims of the application.

The Patent Appeal Board conducted a hearing on May 27, 1971 at which Mr. M. Steward presented argument for the applicant.

Application 002,404 was filed on October 13, 1967 in the name of G.G. Strosberg and refers to "Method for Electrodeposition of Paint".

In the prosecution terminated by the Final Action dated September 1, 1970 the examiner refused the claims of the application in that applicant failed to show how the use of two tanks assist in any unobvious way in achieving better control of the electrodeposition process.

In the response of November 23, 1970 applicant made objections to the Final Action in that the examiner relied solely on the ground of obviousness in the light of common general knowledge.

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 not satisfied that the prosecution dealt with all the points which should have been considered.

It is noted that applicant has referred to assembly line problems, page 2 line 19, "As a practical matter, coating workpieces of different size and shape within a single coating tank often provides assembly line problems both inside and outside the tank...". Also, reference was made to these problems in applicant's actions of July 9, 1970 and November 23, 1970.

In my view the considerations which should have been resolved are:

- 1) What are these problems?
- 2) How were these problems solved?
- 3) Were these problems solved in such a manner as to give rise to the dignity of invention with respect to novelty, utility and inventive ingenuity? In other words was there an unexpected result in the use of a two tank arrangement over the use of a one tank arrangement.

In the circumstance, therefore, I find that no proper decision can be made with respect to the disposition of this application. In view of this I recommend that the application

be returned to the examiner for further prosecution.

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

I agree with the findings of the Patent Appeal Board and withdraw the Final Action. I am returning the application to the examiner for resumption of prosecution under the guidelines set out herein.

Decision accordingly,

A. M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 3rd day of June, 1971.