

DECISION OF THE COMMISSIONER

REISSUE - S.50: Lack of Intent is Claim Not Proven.

Commissioner not satisfied that the applicant has failed to meet the intent of S.50. There is no question of "recapture of subject matter" since no claims were cancelled in the original patent application.

FINAL ACTION: Grounds reversed; Subject to further prosecution.

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 009,562 filed January 10, 1968 for an
invention entitled:

AUTOMOTIVE VEHICLE FRAME STRAIGHTENING DEVICE

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
April 16, 1971 on application 009,562. This application was
filed in the name of Joseph J. Latuff et al and refers to
"Automotive Vehicle Frame Straightening Device".

The petition reads as follows:

That the respects in which the patent is deemed defec-
tive or inoperative are as follows: the claims allowed
in the said patent are too narrow, too specific and
too limited in the protection acquired thereby, by
reason of the patentee claiming less than it had a right
to claim in the patent and that such defects consist
particularly in the following:

- (a) Unnecessary limitations in the claims, and by
way of example:

All of the claims are limited to a device having "inner and outer U-shaped guide-acting frame members", and "means rigidly mounting said frame members ... defining therebetween a U-shaped upwardly opening passage,"; and

- (b) Failure to prosecute claims for the patentees' novel inventive concept; that is, the claims of the patent are far too specific to details of structure which may be readily and easily modified; and which in fact are limited to details of structure which are not present in the present commercial structure in accordance with the patentee's invention.

That the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention in the following manner:

The patentee's original application was prepared and filed with the belief that the claims presented therein covered the subject matter disclosed and that the claims in the original patent were prosecuted with the belief that the claims finally allowed covered the patentee's invention; and, in fact, patentee sold an exclusive license under said patent to Marquette Corporation, a corporation of the State of Delaware, U.S.A., having its principal place of business at Minneapolis, Minnesota, U.S.A., with a mutual understanding that the claims of the patent actually covered the patentee's invention; but since the issuance of the above-identified patent a United States patent, a copy of which is attached, which is the counterpart thereof, issued with the unnecessary limitations omitted therefrom causing the patentee's attorneys to review the claims of the above-identified patent and discover the defects.

Because the above-identified patent issued prior to the United States counterpart and because the claims in the said patent were allowed on the first action by the Patent Office, the defects were not discovered until the said patent and the United States counterpart were compared.

That knowledge of the new facts in the light of which the new claims have been framed was obtained by Your Petitioner on or about the 30th day of October, 1966 in the following manner;

On or about the date of the signing of a license agreement between patentee and Marquette Corporation, patentee's attorneys and Marquette Corporations's

attorneys compared the claims in the above-identified patent and the United States counterpart whereupon the defects in the said patent were discovered. Prior to the said license agreement there was no occasion to study the claims of the said patent since the Patent Office accepted the application therefore on the first action and the patentee was thereafter preoccupied with the prosecution of the counterpart United States application. Upon discovering the defects, and as soon as financially and timely practicable, patentee authorized its attorneys to begin collecting information and preparing a petition for the reissue of said patent, which attorneys in due course and in the sequence of their workload prepared the present petition.

In the prosecution terminated by the Final Action the examiner refused the application for reissue in that applicant did not intend to claim in the original patent what he claims in the reissue. In this action the examiner stated:

The rejection of the application is maintained and the reason for such rejection is that the Applicant did not intend to claim in the original patent what he claims in the reissue application. If the applicant intended to claim the invention in a new way before the first United States Patent Office action and before the Notice of Allowance mailed by the Canadian Patent Office, he could have filed a voluntary amendment. The fact submitted by the applicant that he amended the United States claims after January 24, 1966 does not prove that he intended to claim the invention in Canada in the new form on or before November 19, 1964 when he filed the Canadian application or at any other time before the allowance.

The applicant in his response of July 16, 1971 stated:

Affidavits by each of the inventors named in the above identified application are enclosed together with an affidavit of the attorney who prepared the application for the original patent and it is believed that these clearly establish that the applicants intended to claim the invention in the original application in the manner in which it is claimed in the present application and that failure so to claim the invention arose from a lack of a full understanding of the invention on the part of the attorney who prepared the original application and unfamiliarity with patent terminology on the part of the inventors. Thus the present case is closely similar to the Curlmaster case and it is submitted that the re-issue application is clearly allowable. The Examiner, therefore, is respectfully requested to withdraw

his final Action and pass the case to allowance. Failing that, this constitutes a request for a review by the Commissioner.

After reviewing the ground for rejection set forth by the examiner, as well as the arguments set forth by the applicant, I am not satisfied that the rejection is well founded or at least I find the prosecution is such that a proper decision cannot be made.

Applicant referred to Curl-Master v. Atlas Brush 1967 52 C.P.R., P. 51 Supreme Court decision and attempted to draw an analogy in support of obtaining broader claims in the reissue. In the Curl-Master decision the patent was held to be defective by reason of insufficient description and this resulted from a mistake, namely a failure by the patent agent fully to comprehend and to describe the invention for which he had been instructed to seek a patent. I find that we do not have a similar situation here; such being the case the defence based on Curl-Master is irrelevant on fact.

Notwithstanding the above, and the inconclusiveness of the Petition, the affidavit by the applicant dated May 19, 1971 cannot be overlooked. The affidavit reads in part:

That on or about 21 October, 1963 I ordered the preparation of a patent application on an automotive vehicle frame straightening device, which patent application I fully intended to cover several modifications of the automotive frame straightening device, which modifications my co-inventor, Joseph J. Latuff, and myself were experimenting with prior to 19 November, 1964;

That I am completely unfamiliar with patent terminology and fully believed that all of the modifications to the automotive vehicle frame straightening device were included within the language of the claims of the Canadian patent application filed 19 November, 1964, which patent application resulted in Patent No. 731,981.

I note from the above that certain modifications, which the applicant states he intended to claim, were carried out before the filing of the original patent application. Applicant has not indicated what the nature of the modifications were. Furthermore this is not apparent from claim 1, which claim is not clear and distinct. Also, this claim is not supported by the disclosure. Part (a), for example, reads "... guide-acting frame members each having opposed legs spaced apart a sufficient distance to receive a vehicle therebetween". The subject matter of the underlined portion is not supported by the disclosure of this application or of the original application.

Applicant is advised, with respect to a reissue application, that there is a balance of interest between the public's right to abandoned subject matter and the potential loss of a patentee's valuable property rights through erroneous claiming. In striking this balance, a patentee is given preference and is permitted to eradicate his ostensible abandonment, provided certain carefully defined conditions are satisfied. One of the conditions, which may be an issue here, is that the reissue must be for the same invention, and it must also meet all the other requirements of Section 50 of the Patent Act. I find there is no question with respect to recapture of subject matter in view of cancelled claims in that no claims were cancelled in the original patent application. It is also permissible, in some circumstances, to delete an unnecessary restriction in a claim which forms no part of the real invention.

I am not satisfied, beyond reasonable doubt, that the applicant has failed to meet the intent of Section 50 of the Patent Act; however, further prosecution is necessary and in the circumstance, therefore, I recommend that the decision of the examiner, to refuse the application on lack of intent to claim, be withdrawn for the reasons set forth.

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

I concur with the finding of the Patent Appeal Board and I am therefore setting aside the Final Action and returning the application to the examiner for further prosecution.

Decision accordingly,

A.M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 13th day of October, 1971.