

DECISION OF THE COMMISSIONER

OBVIOUS: In View of Plural Citations.

Claims merely reciting "magnetically holding means for magnetically holding" the crank in position amounts to no more than the common function of magnets as hold-down means without modifying the action or effect of the elements by its substitution for spring means.

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 021,626 filed June 3, 1968 for an invention entitled:

MAGNETICALLY-RETAINED CRANK ELEMENT FOR
LINEAR MEASURING INSTRUMENTS

Agent for Applicant

Messrs. R.K. McFadden & Co.,
Ottawa, Ontario.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated May 17, 1971 on application 021,626. This application was filed in the name of Andre Quenot and refers to "Magnetically-Retained Crank Element For Linear Measuring Instruments".

The Patent Appeal Board conducted a hearing on September 15, 1971. Mr. R.K. McFadden represented the applicant.

In the prosecution terminated by the Final Action the examiner refused claims 1, 2, 3, 4, and 6 on obviousness in view of prior art. The prior art cited is as follows:

References Re-Applied

Canadian Patents
413,313 June 22, 1943 Cl. 248-15 (Dwgs. 1 sh)
Smith

688,746 June 16, 1964 Cl. 2+8-15 (Dwgs. 1 sh)
Dunkelberger et al
707,857 Apr. 13, 1965 Cl. 2+8-15 (Dwgs. 1 sh)
Baermann et al

United States Patent
1,340,712 May 18, 1920

In the Final Action the examiner stated:

Claims 1 and 2 as amended are substantially the same as they were prior to amendment since the amendment only involved the substitution of an equivalent statement for the one deleted. Claims 3, 4 and 6 upon reconsideration have also been found to lack patentable distinguishing matter over the cited art as will be discussed below. Claims 1, 2, 3, 4 and 6 as they now stand are refused for setting forth no more than an obvious substitution of commonly known magnetic holding means for the spring type in a generally old combination. While only broad claims 1 and 2 were refused in the last Office Action, claims 3, 4 and 6 have been found to differ so slightly thereover as to be refusable on the same grounds. Therefore in view of applicant's request for a hearing before the Patent Appeal Board, a hearing on the allowability of the three additional claims (claims 3, 4 and 6) would also be in applicant's interest.

The measuring instrument defined in claims 1, 2, 3, 4 and 6 now differs from the one disclosed in the Hare patent only by the mere substitution of well known magnetic holding means for the spring type shown. The statements relating to the preferred use of a magnetic holding means over the spring type taught by Hare which applicant relies on for "invention" and only sets out, for example in line 7 of claim 1 as "magnetic holding means and in lines 2 and 6 of claim 6 as "a magnet constituting a portion of said crank arm" and "the side flange ... having a portion comprised of ferromagnetic material", respectively, are no more than mere restatements of the commonly known functions and manner use of magnets as a holding means for ferromagnetic materials as shown by the Smith, Dunkelberger et al and Baermann et al references. No more than a mere substitution of commonly known magnetic holding means in place of a spring type in a well known combination, devoid of an inventive adaptation of the preferred means, has therefore been set out.

In the response to the Final Action dated August 17, 1971 the applicant discussed the prior art at length. He then

concluded that the use of a magnet as a securing device when applied to the known winding tape measure under the circumstance was not obvious. In this response the applicant further stated that:

The use of spring retaining means such as shown in the Hare reference is discussed on applicant's disclosure page 2 and the disadvantages of such a construction are also set forth. In the disclosure it is clearly recited that mechanical spring means have the inherent disadvantages that they are prone to defects and breakdown and that their assemblies are both costly and delicate.

These inherent disadvantages of simple mechanical devices have existed in all known winding reels or linear measuring devices until the date of the present invention and yet until the date of the present invention no satisfactory solution had been found. The Board will appreciate that the Hare reference issued in the year 1920 and yet during that 30 year period no one ever obviously arrived at a solution to the long existing problem by simply providing magnetic holding means in place of straight mechanical spring means. Simplicity of invention does not negate patentability, and in many cases the most simple inventions are those which represent the greatest advance in the art and are the most unobvious.

While the argument is age old it must again be stated that as winding reels or winding tape measures are so old (as witnessed by the 1920 Hare patent) and as the properties of magnetic material as holding assemblies have also been known for hundreds of years the question must still be asked that if the solution was so obvious why was it not arrived at many, many years ago. The only way that such a question can be answered is by concluding that such a solution is not obvious. Clearly, if applicant's structure is so obvious it would have been utilized by those knowledgeable in the trade at a time much earlier than the present application, and the failure of those people knowledgeable in the art to appreciate the significance is a clear indication that the structure defined is not obvious and represents a new and useful patentable invention. This fact is incontestable. Both magnets and linear measuring instruments of the winding variety have been known for many, many years and the fact that the use of magnets on such instruments has never before been contemplated or used is a clear indication of the presence of inventive ingenuity and for this reason the Canadian Examiner's submission of obviousness is believed to be completely incorrect.

Commercial success may be considered as being an indication of patentability, and if the commercial success is of any magnitude then there must be a presumption of patentability. While the practical commercial success of a new article does not automatically demonstrate the presence of inventive subject matter it does however raise a strong presumption that invention is necessary to produce it and when there has been a long unsatisfied demand for an article and that article is produced and which results in considerable practical success there is a presumption that it is only by an exercise of the inventive faculty that the inventor has been able to meet the long unsatisfied requirement. As properly stated by Tomlin J. in *Samuel Parkes & Co. Ltd. v. Cocker Brothers Ltd.*, (46 RPC 241 at 248) - "the truth is that, when once it has been found, as I find here, that the problem had awaited solution for many years, and that the device is in fact novel and superior to what has gone before, and has been widely used, and used in preference to alternative devices, it is, I think practically impossible to say that there is not present that scintilla of invention necessary to support a patent".

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

At the hearing the Patent Agent reviewed the stand of the applicant and stressed the point that in his opinion the device as claimed was in fact a new combination and therefore a patent should be granted.

The consideration to be resolved is whether the subject matter of Claims 1, 2, 3, 4 and 6 is obvious in view of the prior art.

The application is directed to a linear measuring instrument with means for magnetically holding a crank arm. Claim 1 reads as follows:

An improved linear measuring instrument comprising a rotatably mounted winding drum; a linear measuring tape removably wound on said winding drum; mounting means for rotatably mounting said winding drum; a crank arm connected to said winding drum, said crank arm having a winding position operable to effect rotation of said winding drum and a nonwinding position; and magnetic holding means for magnetically holding said crank arm in at least one of the winding and nonwinding positions.

The basic reference to Hare discloses a Winding-Reel having a winding drum, means mounting the drum for rotation and a crank arm connected to the drum, said crank arm having a winding and nonwinding position. The patents to Smith, Dunkelberger and Baermann show that the use of magnets as holding, hold-down or securing devices is a well known and obvious expedient.

With respect to applicants argument that since the application of a magnet to a linear measuring instrument is not known the combination (as defined in claims 1, 2, 3, 4 and 6) must be inventive. This combination may be new, however, it must also show some degree of unobviousness.

I find claims 1, 2 and 3 differ over the cited reference (Hare) by a single statement (line 7 of claim 1) which in effect amounts to no more than a statement of the commonly known function of magnets as a hold-down means, as shown by the cited Smith, Dunkelberger et al and Baermann et al references. This, in my opinion, is clearly mere substitution in an obvious manner, and is merely taking advantage which is to be expected as a result of the well known purpose to which magnets may be used. This is, the action or effect of none of the elements embraced by the combination is modified in any material way by the fact that a magnetic means has been used instead of the spring means. Claims 4 and 6 differ over claims 1, 2 and 3 only in that the hold-down magnet is placed in positions which are considered obvious.

Applicant stated that claims similar to the rejected claims are allowed in United States and West Germany and while it is agreed that this is of interest, it is not considered persuasive. Applicant has also stated that the device has been a commercial success. Commercial success may assist in determining the presence of invention in cases of substantial doubt, but in all cases it must be viewed with caution as such success may well be due to causes extraneous to the invention. However, the presence of invention has not been denied in view of allowable claims, therefore, the subject of commercial success is not a matter of contention. This also applies to the question of durability and economy of production as discussed by the applicant in his attempt to prove a presumption of patentability.

I hold that the subject matter of claims 1, 2, 3, 4 and 6 lack the attribute of inventive ingenuity over the teachings of the prior art.

I recommend that the decision of the examiner, to refuse claims 1, 2, 3, 4 and 6, be upheld.

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

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I concur with the findings of the Patent Appeal Board and refuse to grant a patent on claims 1, 2, 3, 4 and 6. Claims 5, 7, and 8 will be considered as allowable when written in independent form. The applicant has six months in which to appeal this decision in accordance with Section 44 of the Patent Act.

Decision accordingly,

A.M. Laidlaw,
Commissioner of Patents.

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