

DECISION OF THE COMMISSIONER

DOUBLE PATENTING: No Basis for Divisional.

COMBINATION: Known elements acting in sequential order.

Rejected on the grounds of double patenting. Applicant is entitled to one patent for one invention. As originally filed the disclosure and claims of the parent application (now a patent) were only to the process. Divisional claims (this application) are directed only to a system of apparatus. Applicant did not envisage "the apparatus" to form a second invention as a person skilled in the art could lay out existing known apparatus to carry out the process of the parent patent.

Objection for failure to recite a patentable combination was overruled.

FINAL ACTION: Modified

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 055,622 filed June 27, 1969 for an invention entitled:

APPARATUS FOR PREPARING A FREEZE DRIED BEVERAGE

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 June 9, 1971 on application 055,622. This application was filed in the name of John George Muller and refers to "Apparatus for Preparing a Freeze Dried Beverage". The Patent Appeal Board conducted a hearing on November 8, 1971. Mr. J.D. Kokonis represented the applicant.

In the prosecution terminated by the Final Action the examiner rejected the application under: Section 39, Section

38(2), Section 36(1) of the Patent Act, Section 25 of the Patent Rules and also that the claims fail to recite a patentable combination.

In this action the examiner stated:

"On June 11, 1969 present apparatus claims 1 to 3 were added to 981,463 to serve as the basis for this divisional application (filed June 27, 1969). These claims were subsequently cancelled on June 30, 1969 before any action could be taken thereon by the examiner to determine whether or not such claims were supported by the original parent disclosure, since Section 38(2) requires that the parent application must also describe as well as claim any alleged invention which is made the subject of a divisional application. It is maintained that the present application does not have proper divisional status for the reason that the specific arrangement on page 2, lines 19 and 20 with regard to the "heat source means" was not disclosed in the parent application as filed. Accordingly, this application stands rejected for this reason.

Also, apparatus claims 1 to 3 inclusive fail to recite a patentable combination of elements for the reason that each of the means recited is well known in the art and operates independently of the others; each of these means operates in the same way and carries out the same function as before and the end result is simply the sum total of these separate operations. While there may be invention in the process this can not confer patentability upon the apparatus which must rest on its own novel combination of elements to merit patent protection.

Section 36(1) of the Patent Act requires that the specification correctly and fully describe the invention in full, clear, concise and exact terms to enable any person skilled in the art to make, compound, construct or use it; in the case of a machine he shall explain the principle thereof and the best mode in which he has contemplated the application of that principle. In this application there is no disclosure of the principle of the claimed apparatus system nor is there any explanation of the best mode of applying the principle of any such system of apparatus. The disclosure is insufficient to allow any person skilled in the art to make the claimed combination of apparatus, since the disclosure neither describes the claimed elements individually

nor shows how they may be interconnected to provide the claimed combination. In reply to this argument, applicant has provided an affidavit from one who is the inventor named in several closely related patents and copending applications, all assigned to the same assignee as the present application. Such an affiant could not be considered as any ordinary person skilled in the art, nor one who would read the present application without having had the benefit of hindsight in knowing of the alleged invention as it is now installed and operating. Therefore, Section 36(1) has not been satisfied and applicant has no entitlement to claims directed to an apparatus or an apparatus system in this application.

In applicant's response of September 9, 1971 he stated:

The Examiner's objection to the divisional status of the subject application is that the parent application did not describe as well as claim the invention now claimed in the parent application, and specifically did not disclose the matter now contained in page 2, lines 19 and 20 of the present application (see also paragraph (f) in claim 1) namely "heat source means coacting with vacuum means for heating and drying the frozen extract". It is respectfully pointed out that this objection will not be substantiated by an examination of the originally filed disclosure in the parent application. In that disclosure, in describing the coffee making operation, the following passage appears on page 7 commencing at line 2:-

"After the coffee extract has been concentrated by partial freezing and separation of the resulting ice crystals, it is dehydrated to powder form by a method known in the art as freeze drying. According to this method, the coffee extract is frozen to a low temperature and subjected to vacuum conditions so that the ice sublimates away from the mass, leaving only the coffee solids containing but a small amount of water. During the vacuum sublimation of the ice, heat must be supplied to maintain the temperature at the particular level required to maintain the process as the vacuum conditions selected".

The applicants vigorously deny that the application is objectionable under Section 39(1) of the Patent Act. The applicant has already filed drawings "showing clearly all parts of the invention", and as has been argued above, and as is supported by the evidence of Ganjaris, the disclosure is in all respects sufficient. Nor is it seen how the drawings, or the disclosure as a whole, would in any sense be improved by the

illustration of details of known elements of apparatus employed in the applicant's system. Such additional unnecessary drawings would be redundant if not confusing. The applicants submit that the Examiner's arbitrary application of a rejection under Section 39(1) of the Patent Act is unjust and is clearly contrary to the intent of the Statute.

The Examiner's rejection under Rule 25 is apparently based upon a misconstruction of the requirements of this Rule. It is submitted that Rule 25 is not concerned with the question of "sufficiency of disclosure" in the sense of Section 36(1) of the Act, which requires the disclosure to be "in such full, clear, concise and exact terms as to enable any persons skilled in the art...to make, construct, compound or use it ..." but rather is concerned with the much narrower point that the characteristics recited in the claim should find support in the disclosure. In other words any characteristic mentioned in a claim should have a counterpart in the disclosure. While the Examiner has not particularized his objection under Rule 25, it is pointed out that all of the characteristics in claim 1, for example, do find support in the disclosure of the subject application, and also in the disclosure originally filed in the parent application.

In the first complete paragraph on page 2 of the final action the Examiner rejects claims 1-3 as failing to recite "a patentable combination of elements for the reason that each of the means recited is well known in the art and operates independently of the others; each of these means operates in the same way and carries out the same function as before and the end result is simply the sum total of these separate operations".

The Examiner's suggestion that "each of the means recited as well known in the art" is of no significance since it is well established that this factor will not effect the patentability of a novel combination of such elements. The applicants submit that the Examiner's statement that the elements of the claimed combination operate "independently of the others" is not correct nor is the contention that the end result is simply the sum total of the separate operations. As will be evident from a reading of the disclosure, the particular claimed combination of elements cooperate to produce a unitary result. The Examiner has failed to show that the claimed combination of elements lacks either novelty, utility or inventiveness, and in the applicant's submission the claimed subject matter is clearly entitled to patent protection.

Applicant also objected to the refusal under Section 36(1) of the Patent Act in that in his opinion the rejection was not well founded. To support his argument an affidavit was filed in the name of I.N. Ganiaris as evidence of the fact that the disclosure of the subject application would be sufficient to enable any person skilled in the art to assemble the claimed system of apparatus.

At the hearing the Patent Agent ably presented the stand of the applicant in an effort to overcome the rejections of the examiner. However, 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 in part only.

This application refers to "Apparatus for Preparing a Freeze Dried Beverage". Claim 1 of the application reads as follows:

A system of apparatus for preparing a dehydrated coffee or tea beverage product from an aqueous liquid extract, comprising:

- (a) concentrating means for partially freezing the liquid extract to form ice therein by indirect exchange of heat across a tubular heat exchange surface between the extract and a circulating refrigerant;
- (b) means coacting with concentrating means (a) for agitating extract and removing ice from said tubular heat exchange surface;
- (c) centrifuge means for separating ice formed in the extract from said liquid extract;
- (d) freezing means for freezing the extract;
- (e) means for removing moisture under vacuum from frozen extract by sublimation; and
- (f) heat source means coacting with vacuum means for heating and drying the frozen extract.

The first ground of refusal by the examiner; the application does not satisfy Section 38 of the Patent Act. Section 38(2) reads: "When the application describes and claims more than one invention the applicant may... be made the subject of one or more divisionals". The original disclosure dealt only with a description of the process. The objects of the invention were set out as a process, the claims were directed to a process only and the examples given were stated to be "illustrative of the process of this invention".

On a complete study of the parent application, it is clear from the original specification that the applicant did not envisage "the apparatus" to form a second invention; or even as a significant aspect of the invention for which application was

made. This agrees with the affidavit by Mr. I.N. Ganiaris wherein he stated: "... since I have knowledge of such equipment and would have no undue difficulty in obtaining the relevant elements and interconnecting them in the necessary manner to construct the claimed system of apparatus". Surely this would apply to the process of the original parent application (now patent 832,291 January 20, 1970) when the only difference in the claimed system is the mere recitation of means (Known) for carrying out the process. Thus it follows that Mr. I.N. Ganiaris, a person skilled in the art, could set up the apparatus from the teachings of the parent application as filed, and there appears to be no second invention in which to base claims which can be the subject of a divisional application as approved by Section 38(2) of the Patent Act.

In the case of, Mineral Separation vs. Noranda Mines (1947) Ex.Cr. 306; 12 C.P.R. 99, it was held that: "the disclosure must describe the invention and its operation correctly and fully; so that when the patent expires those skilled in the art will be able, having only the specification, to make use of the invention". Applying this to the parent application which issued to patent on January 20, 1970 and in consideration of the affidavit as mentioned above, any one skilled in the art could assemble the system as claimed. Therefore, I am satisfied that the process claims and the process dependent product claims in the patent already granted represents the full extent of the protection to which applicant is entitled. To allow the system claims of the present application would do nothing more than extend monopoly for the invention already patented and would have the effect of restraining its free use to the public for an extended period should a patent be allowed to issue from this application. Shortly stated, applicant is entitled to only one patent for one invention.

Assuming the facts on which the foregoing conclusion has been made, Section 36(1) of the Patent Act is not a proper ground of rejection for some of the reasons stated relating to insufficiency of disclosure. Under the circumstances I am satisfied that a person skilled in the art, as noted in the affidavit, has all the information that is necessary to obtain the relevant elements to construct the claimed system to carry out the process of the originally filed claims. The disclosure indicates the type of element to be used and further cites patents etc. to show suitable elements. This, of course, is based on the contention that there is but one inventive concept and noting further that the system of apparatus is nothing more than means (any known) plus the process steps with no apparatus limitations whatsoever and according to the applicant all of the apparatus is well known in the art.

The examiner is affirmed with respect to his stand on some of the other requirements of this section. I quote

Section 36(1) in part "The applicant shall ... fully describe ... shall particularly indicate and distinctly claim the part, improvement or combination which he claims as his invention". (underlining added). I find there was no indication whatsoever of the system of apparatus as claimed forming any part of the invention, or a second invention, in the original application and this is distinctly set forth in the 3rd paragraph of the Final Action. The court, Riddell v. Patrick Harrison & Company Ltd. (1956-60) Ex. Cr. 213, held that: "...it is a basic rule of patent law that an invention cannot be validly claimed unless it has been described in the specification in the manner required by law. The legal requirement has been made statutory by Section 36(1) of the Patent Act ..." The circumstance in this application is analogous to the case referred to above, except in that case the apparatus was properly described but not the process and the process claim was held invalid. Therefore, I am satisfied that the applicant is not entitled to the claims directed to the apparatus system under Section 36(1) of the Patent Act. The rejection based on Section 39 of the Patent Act and Section 25 of the Patent Rules are encompassed by the issues raised under Section 36(1) of the Patent Act and require no further discussion.

The examiner stated that claim 1 fails to recite a patentable combination. However, to make this decision the tests proving lack of novelty and inventive ingenuity must be satisfied and this can only be done in reference to the prior art, and in the present situation this determination has not been made. Notwithstanding the above, I am satisfied that an association of known elements cooperating to produce a new unitary result which is not attributable to any one of the elements is a true combination, which if unobvious is a patentable combination, even though the elements act only in sequential order. In response to an objection made by the applicant, the Board has no quarrel with the contention that all the elements of a patentable combination may be old in that any inventive concept must reside in the combination itself.

The applicant has referred in his brief to certain patents and Patent Appeal Board decisions as indicating precedent for the allowance of the instant claims on appeal. The Board proceeds on the basis that each application should be decided on its own merits giving proper consideration to its own particular facts. Applicant has also stated that similar applications have been allowed in the United States; while this may well be of interest it is not necessarily persuading in that the statutes and particular situation may properly differ.

I recommend that the decision of the examiner, to refuse the application on the grounds as discussed herein, be upheld.

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

I concur with the findings of the Patent Appeal Board and refuse to grant a patent. 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 22nd day of December 1971.