

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. The disclosure and claims of the original parent application are only for a process. Divisional claims (this application) are directed only to an apparatus system. Applicant did not envisage "the apparatus" to form a second invention as a person skilled in the art could use existing apparatus to carry out the process of the parent application.

Objection for failure to recite a patentable combination was overruled.

FINAL ACTION: Modified

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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 070,885 filed December 24, 1969 for an invention entitled:

CONCENTRATION PROCESS

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

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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 070,885. This application was filed in the name of Richard G. Reimus et al and refers to "Concentration Process". 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 refused the application on the following grounds - lack of proper divisional status, claim 1 fails to recite a patentable combination and the application fails to meet Section 36(1) of the Patent Act. Section 39 of the Patent Act and Section 25 of the Patent Rules. In this action the examiner stated:

On December 23, 1969 an apparatus claim was added to 976,750 to serve as a basis for this divisional application, which was filed on December 24, 1969. This apparatus claim (present claim 1) inserted in parent application 976,750 for divisional purposes, was cancelled voluntarily on December 30, 1969, before any action could be taken by the examiner to determine whether or not such claims were adequately supported by the original disclosure, in that Section 38(2) clearly

specifies that the parent application must also describe as well as claim any invention which is made the subject of a divisional application. Applicant's argument that the claimed (herein) "dehydrator means" is supported by the original parent disclosure can not be accepted for the reason that the reference on page 1 lines 21, 22 to complete dehydration by evaporation of water which may be conducted under vacuum conditions, refers to prior art methods and in any event this is considered to be insufficient description of "apparatus". Applicant's reference to the crystallizer-centrifuge part of the apparatus as "constituting dehydrated" means has nothing to do with the claimed "dehydrator means" since both are claimed separately in present claim 1. Accordingly, it is maintained that this application does not have proper divisional status.

In any event, apparatus claim 1 fails 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 (claimed in another application), this can not confer patentability upon the apparatus which must rest on its own novel combination of elements to merit patent protection. In addition, it is maintained that this application fails to meet the requirements of Section 36(1), Section 39 and Rule 25 with regard to providing clear and full support of any apparatus claims.

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, 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.

Further to the above rejection of the claims of this application under Section 36(1) of the Patent Act, the provisions of Section 39 of the Patent Act require that, "in the case of a machine or an invention which admits of illustration by means of drawings, the applicant shall also with his application send in drawings showing clearly all parts of the invention". While the block diagram provided in this application may be useful to illustrate a process, this does not illustrate or show clearly all parts of an apparatus or system as required by Section 39 of the Patent Act.

Also Rule 25 of the Patent Rules requires that "every claim must be fully supported by the disclosure and a claim shall not be allowed unless the disclosure describes all the characteristics of an embodiment of the

invention that are set out in the claim." In this application the disclosure does not set out all the characteristics of an embodiment of the invention claim, indeed, the disclosure is wholly deficient in describing any characteristics of the claimed embodiment; therefore no apparatus claims can be allowed in this application.

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

The examiner has rejected the application as being contrary to Section 38(2) of the Patent Act in that it does not have proper divisional status. This rejection appears to rest on the allegation that parent application 976,754 provides no support for the "dehydrator means" claimed in the subject application.

As the applicant has already pointed out, the claimed "dehydrator means" finds support in the originally filed disclosure of the parent application in page 1, lines 20 - 22, where it is stated "this process of partial freezing is then followed by a complete dehydration by evaporation of water which may be conducted under vacuum conditions". In the final action the Examiner discounts this support for two reasons. He states that the quoted passage is an insufficient description of "apparatus". However the applicants submit that the support is adequate and that it can be readily inferred from the passage quoted from page 1, lines 20 - 22 that "vacuum dehydrator means" should be used to effect the "complete dehydration by evaporation of water ... under vacuum conditons".

In the first complete paragraph on the second page of the final action the Examiner rejects claim 1 as failing to recite a patentable combination. However this rejection is completely unsupported by the citation of any pertinent reference, and appears to rest on the Examiner's contention that "each of the means recited is well known in the art and operates independently of the others". While certain of the elements set out in claim 1 may indeed be well known in the art, it is submitted to be self-evident from a consideration of the applicant's disclosure that the elements of the claimed system of apparatus certainly do not operate independently of each other. In fact the elements combine to produce a unitary result in the concentration process, namely the concentrated extract of coffee or tea.

The Examiner further rejects the application as failing to meet the requirements of Section 36(1), Section 39 and Rule 25 with regard to providing clear and full support of any apparatus claims.

In the third complete paragraph on the second page of the final action, after paraphrasing Section 36(1) the Examiner states "in this application there is no disclosure of the principle of the claimed apparatus system or is there any explanation of the best mode of applying the principle of any such system of apparatus". Although this objection is based upon the language of Section 36(1) of the Patent Act, it is difficult to give it any clear meaning. In the absence of any judicial comment on the meaning of the words "machine" and "principle thereof" as used in Section 36(1) it is difficult to ascribe any clear meaning to this language. However the applicants submit that the word "machine" as used in this Section of the art does not extend to cover a system of apparatus such as the one claimed in the subject application. On the other hand if the

word "machine" is given a broad enough interpretation to cover the claimed system of apparatus, it will clearly cover other "machines" which do not have any "principle". The word "principle" has many meanings, but in the context of Section 36(1) of the Patent Act it would appear to mean something akin to "general law of operation". If the word "machine" is given a narrow construction such as "apparatus" for applying mechanical power, then perhaps many machines could be said to have a "principle"; for example, an internal combustion engine may operate on the principle of a theoretical thermal cycle. To expand the scope of the word "machine" beyond its ordinarily significance to include an apparatus system such as that claimed in the subject application would make the wording of this Section of the Act irrational and unintelligible since many things falling within such a broad interpretation of the word "machine" clearly do not have any "principle" at all.

It is submitted that the object of Section 39 of the Patent Act is the same as that of Section 36(1), namely to ensure full and accurate disclosure of the invention. It is clearly going beyond the intention of the statute to cite Section 39(1) in attempting to enforce a requirement for additional drawings where the invention is already sufficiently fully described and illustrated to enable any person skilled in the art to practice it. Since the individual items of the applicant's system of apparatus are known in the art, a detailed description or illustration of these would be superfluous and contrary to Section 36(1) of the Patent Act which requires that in describing the invention, the specification should be "concise".

In the final action the Examiner states that the application fails to meet the requirements of Rule 25 "with regard to providing clear and fully support of any apparatus claims". In the last paragraph on page 2 of the final action the Examiner states:-

Also Rule 25 of the Patent Rules requires that "every claim must be fully supported by the disclosure and a claim shall not be allowed unless the disclosure describes all the characteristics of an embodiment of the invention that are set out in the claim". In this application the disclosure does not set out all the characteristics of an embodiment of the invention claimed, indeed, the disclosure is wholly deficient in describing any characteristics of the claimed embodiment; therefore no apparatus claims can be allowed in this application".

It is clear from the above quoted passage that the Examiner has placed an incorrect construction on the wording of Rule 25. Contrary to what the Examiner implies, Rule 25 does not require that the disclosure should "set out all the characteristics of an embodiment of the invention claimed". It is noted that the wording of Rule 25 required that the disclosure should describe "all the characteristics of an embodiment of the invention that are set out in the claim". Thus it is the characteristics that are claimed that the applicant is required by this Rule to disclose and not simply "all the characteristics of an embodiment of the invention".

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 "Concentration Process" Claim 1 reads as follows:

An apparatus system for concentration of aqueous liquid coffee or tea extract comprising: extract forming means to a tubular ice crystallizer, a centrifuge ice separator, a line conducting a slurry of ice in liquid extract from said crystallizer to said centrifuge, means introducing wash water into said centrifuge, a line removing washed ice from said centrifuge, a line removing ice freed extract from said centrifuge, a vacuum dehydrator means, a line conveying extract from said centrifuge to said dehydrator means and a line removing dried extract product from said dehydrator means.

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 of 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 when the only difference in the claimed system is the mere recitation of means (known) for carrying out the process with no apparatus limitations whatsoever. 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 on which to base claims which can be the subject of a divisional application as approved by Section 38(2) of the Patent Act. 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. In the case of Mineral Separation vs. Noranda Mines (1947) Ex.C.R. 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 and in consideration of the affidavit as mentioned above, any one skilled in the art could assemble the system as claimed. 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. 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 apparatus system as claimed forming any part of the invention, or a second invention, in the original application and this is distinctly set forth in the 2nd paragraph of the Final Action. The court, Riddell v. Patrick Harrison & Company Ltd. (1956-60) ExCR. 213, has held: "... 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.

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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.