

DECISION OF THE COMMISSIONER

DOUBLE PATENTING: No Basis for second invention

COMBINATION: Known elements acting in sequential order.

Rejected on the grounds of double patenting. As originally filed the disclosure and claims are directed only to the process, now covered in a divisional application. The present application contains claims directed only to an apparatus system. The applicant did not envisage "the apparatus" to form a second invention as a person skilled in the art could use existing known apparatus to carry out the process as originally filed.

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 976,750 filed November 29, 1966 for an invention entitled:

CONCENTRATION APPARATUS

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 976,750. This application was filed in the name of Richard George Reimus and Anthony Saporito and refers to "Concentration Apparatus". 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 25 and Section 52 of the Patent Rules, Section 36(1) and Section 39 of the Patent Act and that the claims fail to recite a patentable combination.

In this action the examiner stated: (in part)

It is noted that the originally filed specification was not concerned with an apparatus, but was directed instead to a process. It was a process that was set forth as the expressed object of the invention; this process was described, and the specification ended with claims to a process only. Any mention of apparatus was made only indirectly, in relation to the description of the process. Since its original filing this application has been repeatedly amended to expand the scope of the claims and to construe and convert an original description of a process in an attempt to provide support for added apparatus claims.

It is, therefore, maintained that this application fails to meet the requirements of Section 36(1) and Section 39 of the Patent Act and Rule 25 of the Patent Rules, with regard to providing proper support for any apparatus claims for the reasons set forth below. Section 36(1) requires that the specification shall "correctly and fully describe the invention and its operation or use as contemplated by the inventor" which means that the disclosure must contain at least one adequately described specific working embodiment of the claimed apparatus. The individual elements of the claimed system are neither described nor identified sufficiently to provide such an embodiment. For example, the tubular ice crystallizer is mentioned only vaguely, while the washing means was not so much as mentioned in the disclosure as filed, being only implied. Also, this is further evidence pointing to the fact that any person skilled in the art would be unable to use the present disclosure to make the claimed apparatus.

The examiner also objected to claims 1-5 in that they fail to recite a patentable combination of elements for the reason that each element is well known and operates independently of each other.

In applicants response of September 9, 1971 he stated:

In the first paragraph on page 2 of the final action the Examiner details his objection under Rule 36(1), and states that "the disclosure must contain at least one adequately described specific working embodiment of the claimed apparatus".

It is pointed out that such a "specific working embodiment" is described in Page 9 of the originally filed disclosure. It is furthermore submitted that, contrary to the Examiner's suggestion the individual

elements of the claim system are described and identified sufficiently in the disclosure. It is pointed out that the applicant's corresponding United States Application, containing a disclosure essentially the same as that of the subject application, was not found deficient in respect of adequacy of disclosure, and resulted in the issuance of U.S. Patent 3,474,723 containing claims identical to the claims under final rejection in the subject application.

It is submitted that the applicant's disclosure is sufficiently explicit to allow "any person skilled in the art to make an apparatus as claimed in claims 1 to 5", and that the absence of detailed descriptions of the elements which make up the claimed combination, and of detailed drawings of these elements, is of no consequence, and does not suggest that the disclosure is inadequate. The various elements of the applicant's apparatus described in the specification and illustrated in the drawings are conventional items which would be known to any man skilled in the art and could be readily secured by him and assembled together to provide the claimed apparatus. In the circumstances it is submitted that a detailed description or illustration of these items would not only be unnecessary but also superfluous.

Applicant also objected to the rejection under Section 39 of Patent Act in that all of the elements are old and this section does not require redundant illustrations. The applicant further indicated that the rejection under Sections 25 and 52 of Patent Rules is unsupported. The applicant also objected to the grounds of lack of patentable subject matter in the claims in that the examiner failed to show the combination lacks either novelty or inventiveness.

At the hearing the Patent Agent presented a well prepared case 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 Apparatus".
Claim 1 reads as follows:

An apparatus system for concentration of aqueous liquid coffee or tea extract comprising: precooling and holding means, a precipitate separation device, a first line conducting cooled extract from said precooling and holding means to said separation device, a tubular ice crystallizer, a second line conducting separated extract from said separation device to said tubular ice crystallizer, a centrifuge ice separator, a third line conducting a slurry of ice in a concentrated liquid extract to said centrifuge ice separator

from said crystallizer, a fourth line conducting concentrated extract from said centrifuge ice separator, means removing ice from said centrifuge ice separator, and means for washing said ice.

It is noted that the claims as originally filed were process claims. At a later date claims were entered which claimed a system of apparatus. The process claims were then filed in a divisional application. I am of the opinion that the original specification disclosed only one invention and there is no support for separate patents on this application as well as on any other divisional application based on this application.

On a study of this application it is clear from the original specification that 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. 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". This agrees with the affidavit filed by applicant in the name of 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 also apply to the process as originally filed in this application when the only difference in the claimed system is the mere recitation of means (any known) for carrying out the process with no apparatus limitations. Thus it follows that Mr. I.N. Ganiaris, a person skilled in the art, could set up the apparatus from the teachings of this application as filed. Consequently, I am of the opinion that there is not a second invention on which to base claims which can be the subject of a second application as set out 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. Cr. 306; 12 S.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 present application (parent) as filed and in consideration of the affidavit as mentioned above, I am satisfied that a person skilled in the art, has all the information that is necessary to obtain the relevant elements to construct the system to carry out the process of the original specification. 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 Section 36(1). 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 reference to this is set out in the 2nd 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 system of apparatus under Section 36(1) of the Patent Act. The rejection based on Section 39 of the Patent Act and Sections 25 and 52 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 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.