

DECISION OF THE COMMISSIONER

STATUTORY: Section 2(d)

DIVISION: Rule 60

Rejection under 2(d) in conformance with Patent Office guidelines at the time the action was written, is withdrawn, due to change in directed policy.

Amendments to Rule 60 requirement do not fully overcome the objection, further amendments are suggested.

FINAL ACTION: Withdrawn, further amendment suggested.

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 930,144 filed May 7, 1965 for an invention
entitled:

METHODS AND MEANS FOR STATISTICAL VARIANCE
ANALYSIS OF SHEET MANUFACTURING PROCESSES
USING SCANNING AND DWELLING GAUGES

Agent for Applicant

Messrs. Alex, E. MacRae & Co.,
Ottawa, Ontario.

This decision deals with a request for review by the
Commissioner of Patents of the Examiner's Final Action dated
June 25, 1971 on application 930,144. This application was
filed in the name of Albert B. Bishop 3rd and refers to "Methods
And Means For Statistical Variance Analysis of Sheet Manufactur-
ing Processes Using Scanning And Dwelling Gauges".

In the prosecution terminated by the Final Action the
examiner rejected claims 1 to 5, 21 and 22 as not defining
patentable subject matter under Section 2(d) of Patent Act.
Also the examiner rejected the application in that applicant
has failed to restrict his claims to a single invention.

In the Final Action the examiner stated: (in part)

With regard to the question of unity of invention applicant states that he considers claim 21 to be the broadest method claim and claim 23 to be the broadest apparatus claim. Examination of the claims shows this statement to be incorrect. As indicated in the last Office Action all of the characteristics recited in the broad claim must appear in all of the remaining claims with the same or narrower scope. Claim 21 recites for example "causing said gauge to dwell at a point along said width". This step is not found in claims 3, 4 or 5. Claim 23 in its turn recites "means for causing said gauge to dwell at a point along said width". No means equivalent to these are found in claims 6, 9 to 14 or 17 to 20. In view of this applicant has failed to restrict his claims to a single invention and the claims cannot be allowed in this application.

In applicant's response of September 21, 1971 he stated:

(In part)

In regard to the Examiner's requirement for restriction applicant is prepared to amend the claims as follows:

Claim 3, line 8, after "comprises" insert --causing at least one of said gauges to dwell at a point along said width,--.

Claim 6, line 13, after "signal," insert -- means causing at least one of said gauges to dwell at a point across said width,--.

Claim 9, line 6, after "said material" insert --means causing at least one of said gauges to dwell at a point across said width,--.

Claim 12, line 6, after "said material" insert --means causing at least one of said gauges to dwell at a point across said width,--.

Having considered the first ground of rejection, "claims 1-5, 21 and 22 do not define patentable subject matter under Section 2(d) of the Patent Act", I find that this stand was generally in conformance with Patent Office guidelines at the time the Final Action was written. However, it has since been decided that this is not a proper ground of rejection and therefore the rejection based on this ground will be withdrawn.

The second ground of rejection is based on the stand that, "the claims are not restricted to one invention". It is noted that applicant presented an amendment to overcome this objection, however, I am of the opinion that this amendment does not fully overcome the objection. To overcome this objection applicant should also amend claim 20 line 3 to read "...gauge means adapted..." and amend the remaining portion of the claim to reflect this change. Furthermore, claim 23 lines 6, 9 and 12 should be changed to read, "...said gauge means...." This change will reflect line 3, "...gauge means...", of this claim.

I recommend that the rejection under Section 2(d) of the Patent Act be withdrawn and a further amendment be made, as discussed herein, to fully overcome the rejection of lack of unity of invention in the claims.

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

I concur with the findings of the Patent Appeal Board and withdraw the rejection based on Section 2(d) of the Patent Act. However, I am not satisfied that the amendment to overcome lack of unity of invention is complete. Applicant has six months in which to appeal this decision in accordance with Section 44 of the Patent Act or to overcome the rejection by amendment in a manner as discussed herein.

Decision accordingly,

A. M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 30th day of December 1971.