

DECISION OF THE COMMISSIONER

REISSUE: Claims to be revised.

Claims allowed in original patent are refused in view of art. The remainder of the claims must be amended to include an additional characteristic. Rejections based on the petition failing to show intent and claims directed to different inventions were not upheld.

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 070,459 filed December 19, 1969 for an invention entitled:

HYDRAULICALLY OPERATED DEVICE FOR CUTTING TREES, LOGS AND THE LIKE

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Agent for Applicant

Messrs. Johnson, Marcus & Wray,  
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 July 22, 1971 on application 070,459. This application was filed in the name of Dick L. Rehnstrom and refers to "Hydraulically Operated Device for Cutting Trees, Logs and the Like".

The petition reads as follows:

1. THAT Your petitioners are the patentees of Canadian Patent 723,956 granted on the twenty-first of December 1965 an invention entitled "Hydraulically Operated Device for Cutting Trees, Logs and the Like".
2. THAT the patent is deemed defective or inoperative by reason of insufficient description or specification and by reason of patentee having claimed more and less than he had a right to claim as new.

3. THAT the respects in which the patent is deemed defective or inoperative are as follows:

(a) The specification, in paragraph one on the first page of the disclosure of said issued patent 723,956 broadly recites the invention as relating to "apparatus for cutting trees, logs and the like and comprising at least one cutting member movable when actuated upon by a hydraulic cylinder" but instead, the invention is more narrowly and correctly concerned with "a cutting member mounted on a frame and movable relative upon actuation of power means" and having the cutting blade and frame arranged such as to provide a jaw "of the open mouth type" for receiving a tree to be severed by particular movement of the one relative to the other, i.e. "in a direction normal to the length of the article".

(b) The specification, in paragraph two of the issued patent, recites the invention as consisting of "apparatus which is designed in such a way that during a cutting operation each point on the blade of the cutting member carries out a movement which has a component in the longitudinal direction of said blade" but more correctly it is a point "on the cutting edge of the blade" which has a component of motion parallel to such "cutting edge". Also, the invention is more narrowly directed to a severing device of the "open mouth type" illustrated in the drawings.

(c) In the paragraph of the specification immediately following the list of drawings, with reference to the issued patent, the apparatus is described with reference to the drawings, as being illustrated in various manners in various positions and more correctly such illustration is with respect to "Figure 1" and it is the "jaw" which is illustrated in an "open position" ready to receive a log. In the same paragraph the point is referred to in reference to the "blade" but more specifically should be referred to as being "on the cutting edge" of the blade.

(d) The paragraph next following that last discussed above, describes the link system as comprising "two link pairs" but more accurately, and what is illustrated is "a pair of links 4a and a pair of links 4b.

(e) The fifth last paragraph incorrectly suggests that the choice of a suitable shape for the "blade" may be chosen to modify the mentioned advantageous effect but instead, it is the shape of the "cutting edge" which is of concern. Reference is also made to the portion located "inside the blade" and such portion, however, is actually located in a position relative to the "cutting edge". The same paragraph also too broadly describes the

actual location of the grooves which are located perpendicular to the "cutting" edge of the blade.

(f) The second last paragraph of the specification broadly describes horizontal attitude of the cutting apparatus by virtue of being suspended but more specifically such position results from "being suspended at its center of gravity

(g) Claim 1 of said patent 723,956 claims more than the patentee had a right to claim by broadly being directed to a particular movement of a cutting blade in a shear during severing. The particular movement consists of "a component in the longitudinal direction of said cutting blade" and such movement is provided by having the cutting member "mounted in a link system having two sets of links". Mounting of a shear blade on a frame by two links providing motion in a blade with "a component in the longitudinal direction of said cutting blade" is known in Canadian Patent No. 529,975 issued September 4, 1956.

The error of claiming more arose because of the patentee having no knowledge of the existence of the Canadian patent 529,975.

In the prosecution terminated by the Final Action the examiner rejected the application for reissue on the following grounds:

- (a) Claims 1 to 21 are not directed to the same invention as the claims allowed in the original patent and which claims are presently on file;
- (b) There is no error in the original claims through applicant having claimed more than he had a right to claim in view of Canadian Patent 529,975, that has come to his attention;
- (c) The petition fails to adduce any evidence of intent to claim all the features of claims 1 to 21 presented in the reissue application, and
- (d) The petition is defective and incomplete.

In this action the examiner stated: (in part)

Comparing claims 1 and 22 for example, claim 1 contains the following limitations not present in claim 22:

- (a) said cutting member and frame defining a jaw having an open mouth

(b) said links being disposed so as not to traverse the bite of the jaw.

Claim 1 however omits many of the limitations of claim 22 including "said cutting member ... having the shape of an oblong plate". Applicant has contended in the letter of May 6, 1971, page 3; 2nd paragraph that the shape of the blade is not a feature of patentability. It is held however that the blade shape is a structural characteristic and is a patentable feature. Since neither of claims 1 and 22 therefore is broader than the other, such claims are deemed to be directed to different inventions. Section 50 of the Patent Act states that a reissue may be obtained for the "same invention" only.

The petition fails to adduce any evidence of intent to claim all features of claims 1 to 21 presented in the reissue application. In the letter of May 6, 1971, page 6, applicant has argued that the presence of features in the disclosure of the application as originally filed is evidence of what applicant intended to cover. It is held however that the inclusion of features in a disclosure does not provide sufficient evidence to support applicant's contention that he intended to claim them. In fact a review of the prosecution of the original patent verifies that at no time did applicant attempt to claim or show any intent to claim the features of claims 1 to 21.

Item 2 is now defective since by introducing the original claims it cannot be said that patentee "claimed more and less" than he had a right to claim as new. Section 50 of the Patent Act provides for reissue if an applicant claims more or less and it is not seen how claims could be defective because of claiming more and less in the original. Applicant has attempted to overcome this problem by inserting claims to different subject matters in the reissue (which has been dealt with in ground A above.) In any case the submission of the original claims in the reissue is evidence that applicant considers the patent is not defective by having claimed "more and less".

Applicant has failed to fully state in the Petition in what respect he considers the patent defective or inoperative in the light of which every new claim of claims 1 to 21 have been framed. In this respect attention is directed to Rule 81 of the Patent Rules.

In the response of December 21, 1971 the applicant went to great lengths, citing twenty-four patents, to show that different elements of the claims are old and should not be considered as essential features.

The applicant maintains that the application for reissue is self-evident of error and compares the teaching of Canadian Patent 529,975 to show that there is error in that applicant claimed more than he had a right to claim as new. The error was in complete inadvertence as the applicant was not aware of the patent in question. The applicant also maintains that he has a right to claim other features, such as, "a crane beam" in that a crane beam is well known in the art.

Applicant also stated: (in part)

Ground D of the objection in the Official Action concerns defective and incomplete petition. Items H and I which are referred to as being cancelled by way of applicant's August 7, 1970 letter, refer to the claims in the corresponding U.S. patent which has since been re-issued. Because of the cancellation of paragraphs H and I, it is indicated that item 2 is now defective since the patentee states therein claiming more and less than there was a right to claim as new. Because of the cancellation in the petition of items H and I, the words "and less" may be deleted or considered inapplicable since there is only one independent claim and which claim claims more than applicant has a right to claim. The petition is, admittedly, poorly drawn for reasons as previously set forth, namely, basing the Petition on re-issue of the corresponding U.S. patent. However, it is deemed, in its present form, sufficient to show the respects with which the patent is deemed defective or inoperative, namely, being too broad because of having a claim which reads on the Disclosure of Canadian Patent 529,975.

Having carefully studied the petition the Board has come to the conclusion that the claims of the original patent fail to explicitly set out his invention since it is evident that the claims are too broad in view of Canadian Patent 529,575. It follows that the applicant may not retain the patent claims as they would defeat the object of the petition.

The first ground of rejection that, "Claims 1-21 are not directed to the same invention as the claims allowed in the original patent," (refiled as claims 22-25 of the present application) is not well founded. On considering what is meant by the same invention under reissue, the court in Northern Electric Co. Ltd. v. Photo Sound Corporation (1936) SCR 649 held that, "... the reissue patent must be confined to the invention which the patentee attempted to describe and claim in his original

specification, but which owing to 'inadvertence, error or mistake', he failed to do so properly; he is not to be granted a new patent but an amended patent." (emphasis added) This statement was also cited by Martland J. of the Supreme Court of Canada in Curl-Master Mfg. Co. Ltd. v. Atlas Brush Limited (1967) SCR 527.

An allowable claim must include, "... power means pivotally connected to the cutting member ...," as this is necessary for a complete claim for operativeness. The characteristic in the original claims, "... having the shape of an oblong plate," may be deleted from the claims in that it was not added to avoid the prior art as the prior art shows a blade of this shape; also since the important limitation is that any point on the cutting edge of the blade carries out a movement which has a component in the longitudinal direction of said cutting edge. Assuming the new claims are of different scope, the Board is satisfied that there is no evidence of newly discovered subject matter in the new claims and that the new claims cover substantially the same invention as that for which the patentee sought to patent in the original specification.

The second ground of rejection that, "There is no error in the original claims through the applicant having claimed more than he had a right to claim as new in view of Canadian Patent 529,975, and at the same time maintain the original claims,"

The third ground of rejection is that, "The petition fails to adduce any evidence of intent to claim all the features of claims 1-21 ..." The applicant may restrict the claims of the patent to more clearly cover the real invention by setting out the feature of, "the open jaw type mechanism having links so arranged as not to transverse the bite." The addition of further limitations in independent claims would also not appear to offend the intent of the petition since there is no evidence of fraudulent intention or that the inventor did not intend to obtain a patent for his real invention which through inadvertence his agent failed to do.

The fourth ground of rejection that, "The petition is defective and incomplete," is no longer an issue since the applicant has cancelled items H and I from the petition and in response to the Final Action the applicant states, "... the words and less may be deleted or considered inapplicable." The remainder of the petition has been considered on its merit.

The applicant asked, "since when does the shape of anything become a patentable feature"? In answer to this it is well established that the shape of an article may become a patentable feature when the particularized shape subserves some new and unexpected mechanical function. Applicant also states that, "... it is evident reissues under present practice in office policy, can only be obtained for the purpose of adding claims of narrow scope ..." This is an erroneous interpretation since reissues with broader claims are valid providing the petition

and changes meet the requirements of Section 50 of the Patent Act and principles established by jurisprudence. The Court in Withrow v. Malcolm 1884 6 OR 12, held that an applicant has a right to claim in a reissue what could have been claimed in the original providing specific conditions are met. The amended petition does not make provision for the issue of broader claims.

In summation the Board finds: (a) the patent claims, present claims 22-25, are not allowable; (b) the addition of the characteristic, to the original claims, that the sets of links are arranged so as not to transverse the bite of the open jaw type mechanism during the cutting operation, while omitting the feature that the blade has the shape of an oblong plate, are permissible. In other words it is suggested that a claim, such as claims 1 and 2 when combined, or any similar claim, may be considered allowable. However, the reference in claim 1 to at least one cutting member may be questioned.

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

I concur with the findings of the Patent Appeal Board and refuse to allow claims 22-25. Claims 1-21 are refused in their present form, however, claims drawn according to the guidelines set forth may be considered allowable. 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 Febtuary, 1972.