DECISION OF THE COMMISSIONER

CONFLICT S. 45(4): C-claims only considered; anticipated by the teaching of the prior art.

The Final Action refused the C-claims and claims dependent thereon. Applicant submitted new set of claims (to which Rule 68 applies), and disagreed that all the claims in the application are "not patentably different" per S. 45(2) action. Since S. 45(4) applies only to the C-claims, no decision was made with respect to any other claim. The subject matter of the C-claims held to be substantially taught by the prior art (originally submitted by this applicant under S. 45(3) and (4) as anticipating) and are refused to both applicants. (See decision on application 963,979).

FINAL ACTION: Affirmed in-part

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This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated November 1, 1971 on application 948,406. This application was filed in the name of Mr. Tien C. Tso and refers to "Method Of Tobacco Sucker Control".

In the prosecution terminated by the Final Action the examiner refused conflict claims C1, C2 and C3 and all dependent claims in view of prior art. The prior art cited is as follows:

1. Saunders et al, "Autoxidant of Fatty Materials in Emulsions", Journal of the Americal Oil Chemists Society, October 1962.

2. Sagarin, Cosmetics, Science and Technology, 1957, Inter Science Publications, Inc. pages 102, 119, 122, 123 and 125.

(The decision quotes the Final Action, in part).

In the response dated January 31, 1972 the applicant submitted a set of 88 claims and discussed at length why these claims should be acceptable as allowable claims. However, the Examiner's action should have been made under Section 45(4) as well as Rule 46 of the Patent Rules and under the provisions of Rule 68 no amendment to introduce new claims may be made without permission of the Commissioner. Therefore the Board does not find it necessary to consider the new claims when making its decision on the rejected conflict claims C1, C2 and C3.

It is also noted that the examiner has refused the claims dependent on the conflict claims, however, Section 45(4) provides for the re-examination of conflict claims only. Section 45(4) reads in part "... conflicting claims ... may submit to the Commissioner such prior art alleged to anticipate the claims: thereupon each application shall be re-examined with reference to such prior art and the Commissioner shall decide if the subject matter of such claims is patentable." (underlining added). Hence, no consideration will be given to claims which are dependent on the conflict claims.

In the circumstance, therefore, the only question which may be decided is whether the subject matter of claims C1, C2 and C3 is taught by the references.

This application relates to a method for controlling the growth of suckers in tobacco plants. Claim C1 reads as follows:

> A composition for inhibiting the growth of suckers in tobacco plants comprising a mixture of an effective amount of a suitable emulsifying agent and at least one lower alkyl ester of a C_6 to C_{18} fatty acid.

It is well established that if an invention is in the discovery of an unexpected and unobvious property of the particular known substance, appropriate claims may set out the novel mode of giving effect to the newly discovered property as a novel method of using that substance, or as a novel composition comprising the particular substance, including mixtures with carriers suitable for the new use.

The Saunders et al reference discloses aqueous emulsions of methyl and ethyl linoleate, and the reference to Sagarin discloses emulsified fatty acid esters, e.g., oil-in-water emulsions containing methyl, isopropyl or butyl esters of fatty acids such as isopropyl palmitate for use as emollients. More specifically the Saunders reference at page 435, lines 33 the bottom of the page of the Sagarin paper.

It is noted that claim C1 refers to an ester (C_6 to C_{18} fatty acid) and an emulsifying agent while claim C2 refers to an ester (C_6 to C_{18} fatty acid) emulsified in water. The composition of claim C3, which is basically a concentrated form of the composition of claim C1 in which the control agent can vary from 90% of the composition to 20%, is considered substantially the same subject matter as claimed in claim C1.

The Board is satisfied that the subject matter of the compound and emulsion mixtures of claim C1, C2 and C3 are substantially taught by Saunders and Sagarin.

The Examiner also relied on the Gilbert v. Sandoz, Ex. C.R. (Sept. 24/70), decision to further reject the claims under consideration. The Board is satisfied that the circumstances in the Gilbert v. Sandoz decision are not analogous with the facts of the present application and this ground is withdrawn.

The applicant has requested clarification on the "method of use" claims which may be considered "not patentably different" from the conflict subject matter in the Office action of May 30, 1969, but such disposition assumes patentability of the conflict claims. As already indicated, the Board may consider the conflict claims (C1, C2 and C3) only at this time. However, it is well established in law that if an invention lies in the discovery of a new unexpected property of a known substance an applicant is entitled to make claims for a new process using that substance.

The Board recommends that the decision of the Examiner, to refuse conflict claims C1, C2 and C3 in view of the cited prior art, be upheld. The Board further recommends that no decision or recommendation be made with respect to any other claim.

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

I I concur with the findings of the Patent Appeal Board and refuse conflict claims C1, C2 and C3 for want of invention. The applicant has six months in which to delete these claims from the application or 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 24th day of May 1972.