

DECISION OF THE COMMISSIONER

REISSUE: - Not for Same Invention;  
- Inadvertence, etc, and intention to claim.

Amended claims not for the same invention that the patentee attempted to describe and claim in the original specification due to the omission of an essential element and enlargement of the claims to embrace other forms of the rotor. But there was ample evidence that the applicant intended to claim the invention in different terms. Omission of non-essential feature allowed.

FINAL ACTION: Affirmed in part.

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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 104,168 filed February 1, 1971 for an  
invention entitled:

REFUSE GATHERING MACHINE

Agent for Applicant

Messrs. Meredith & Finlayson,  
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  
October 28, 1971 on application 104,168. This application was  
filed in the name of Herbert O. Vinyard and refers to "Refuse  
Gathering Machine".

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The decision reproduced the petition in full which set out  
details in respect of the following defects:

First, that the drawings are defective and do not clearly  
and distinctly illustrate the invention, and in particular,  
are inconsistent with the disclosure; and

Second, the claims are defective for not defining the true  
invention; in one respect being too restrictive in defining  
structure not of principle significance to the invention, and

in other respects being too broad in specifying the structure needed to achieve the advantages of the invention; particularly the relationship between the housing, the discharge opening, the mechanical impeller, and the discharge chute; the essential features and objects of the invention being set out in detail.

The petition set out details of how the error arose without a thorough understanding of the significant features in the light of available prior art, due to the petitioner's lack of appreciation on patent matters and his resulting inability and failure to communicate on such matters and failure to define his true invention. A petition to reissue his U.S. patent was indicated to be allowable.

The prosecution terminated by the Final Action rejecting the application on the following grounds, in summary:

First, the amended claims for reissue are not directed to the same invention as the claims of the patent, covering different combination of elements in that neither one of the independent claims of the application and the patent is broader in scope than the other, since the amended claims have broadened out some of the limitations of the patent claims and have added new limitations;

Second, the applicant has not presented clear evidence that he intended to claim the invention defined in the amended claims; and

Third, the amended claims are not patentable over two Canadian patent references.

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The applicant in his response of January 27, 1972 maintains that the claims avoid the prior art cited by the examiner, and in particular with respect to the discharge opening and other special features of the chute. The applicant also maintains that there is ample proof of intent to claim and has supplemented the petition with an affidavit and other material in support of his intention to claim his invention as set out in claim 1.

The applicant also stated: (in part)

The applicant submits that he is seeking to reissue his original patent for, and that the claims are directed to, the SAME BASIC INVENTION to which his original patent is directed. The applicant was aware that his invention was broader in scope than what has been defined, without his appreciation, in original Claim 1. He was also aware of the other features which, although broadly and/or obliquely referred to in original Claim 1, were required in properly and accurately defining his invention and

and have been included into Reissue Claim 1. The Examiner has quoted extensively from the original Claim 1 and the reissue Claim 1 on the basis of purportedly illustrating that these two claims are not directed to the same combination of elements. On the contrary, the applicant submits that they both relate to the same basic combination of elements and therefore are directed toward the same basic invention.

This implies that reissue is only available when an applicant wishes to change the scope of his claims whereas it is clearly permissible as supported by Section 50(1) and the above cases for an applicant to amend his "specification" to make it more clear and distinct. "Claims" in a patent are part of the specification and they can be accordingly amended to make more clear and distinct the patentee's invention. In making more clear and distinct his "claims", a patentee surely is entitled to amend the terminology of his claims and this is what the applicant has done here. The applicant has removed the narrowing restrictions of the augers but otherwise has simply amended its terminology to make more clear and distinct the relationship between the housing, the discharge opening, the thrower and the discharge chute. The strict application of Rule 60 implicit in the Examiner's action has no part in petitions to reissue where the reason for petitioning is that the original attorney failed to fully comprehend and to describe the invention for which he had been instructed to seek a patent and the patentee seeks to correct this error by clarifying and more distinctly stating what is the basic invention by way of reissue.

The first ground of rejection that, "The claims submitted with the application are not directed to the same invention as the claims in the patent, "is well founded only in so far as it is fundamental that reissue must be for the same invention as the original patent. 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.

In the prosecution of the patent the applicant states, "Claim 1 specifically recites the blades of the thrower rotor as having outer free edges which pass the curved lower portions of the upper and lower chute walls with siping tolerance when the rotor is turned. This is structure not found in the patent to Marr ...."

In the opinion of the Board this is the basic point of novelty over the prior art, and furthermore, it appears to be an essential feature for the operativeness of the invention in that the applicant states, (Exhibit A) "Another object is to be able to load material regardless of moisture content. This machine will load liquid, slurry or dry material." Without this specific characteristic the device will not fulfill such a promise. Therefore, there is no doubt that the applicant had envisioned this as a basic part of the invention and any new claim obtained on reissue must include the following characteristic or its equivalent, "... said blades having outer free edges which pass said curved walls with wiping tolerance when the rotor is turned...."

Notwithstanding the above, the characteristics in the original claims with respect to the augers may be deleted as the Board is satisfied from a study of the exhibits and the affidavit that the augers were intended to be regarded as optional as stated in the original description of the invention to his patent agent dated February 14, 1966 describing that: "This machine cleans a strip six feet wide. The augers are each two feet leaving two feet in the center for throwers. This would vary on the width of strips to clean (sic) and the size of box to be loaded. If the box is as wide as the strips to be cleaned their (sic) is no need for augers." (emphasis added). The Board is also satisfied that the width of the discharge chute has no specific relation to the basic invention and from the above quoted statement of the applicant it appears that if the augers were removed the chute would be the same width as the throwers, and by inference it would be substantially the same width as the box; therefore, no restriction with respect to this characteristic would appear to be necessary.

The second ground of rejection that, "The applicant has not presented clear evidence that he intended to claim the invention defined in the independent claim submitted with this reissue," is basically well founded. However, the determination made under the first ground of rejection affects this decision. As maintained, the present claims cover a different invention from the invention of the original patent, therefore, the determination with respect to the present claims in regard to intent does not have to be considered. Notwithstanding the above, the Board is satisfied that ample evidence, i.e. the exhibits plus the affidavit, has been presented in response to the objection to show that the applicant had intended to claim the invention in different terms than that covered by the Patent; thus, in the opinion of the Board, an appropriate amended patent may be granted.

The third ground of rejection that, "The present claims are not patentable over the Canadian patents to James and Latendresse," is basically well founded in that claim 1 does not avoid the prior art as far as the basic invention is concerned. Whether claim 1 avoids the prior art in some unessential details of the chute construction which is not the basic inventive concept is immaterial since, as previously discussed under the first ground

of rejection, an essential characteristic that, "... said blade having outer free edges which pass said curved walls with wiping tolerance when the rotor is turned ...," must be included in an allowable claim. An applicant is permitted an amended patent provided strict conditions are met; one of which is that the amended patent must be for the same invention as that of the original patent in that an applicant is not permitted a claim on reissue which avoids the prior art by limitation completely different from those set out in any claim of the original patent. In any event, there is no indication in the patent or the supplemental material that the applicant intended to rely on specific arrangements of the margins of the housing and the chute, which the applicant now claims in order to avoid the prior art.

The Board does not disagree with the applicant's contention that Section 50 of the Patent Act permits the applicant to amend his specification to make it more clear and distinct, or that the applicant has a right to claim more or less than in the original patent, providing of course that all the other requirements of this Section are met. The applicant relies on the Curl-Master decision to claim differently if the new claims relate to the same basic combination of elements; again the Board does not disagree, however, aside from all other considerations of this decision, it is not considered the same basic combination of elements when the patent claims a loader with an auger, central thrower paddles, a central discharge chute and the specific wiping action of the blades; as compared with the reissue claims which encompass other types of rotors, including a flail-type loader with a full width discharge chute having details which are specific to the latter type loader; as of interest, see Canada Patent 704,877 issued in September 18, 1964.

The Board is satisfied, beyond reasonable doubt, that the applicant has met the intention of Section 50 of the Patent Act with respect to inadvertence, accident or mistake. However, in summation the Board finds: (a) that the present claims are not allowable in their present form for reasons as discussed herein, and (b) that the original patent claims or claims of similar scope may be considered allowable while omitting the characteristics with reference to the augers and the specific width of the chute.

The Board recommends that the decision of the examiner, to refuse the application in its present form, 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 on the reissue application in its present form. The applicant has six months in which to appeal this decision in accordance with Section 44 of the Patent Act.

Dated at Ottawa, Ont.  
March 10, 1972.

Decision accordingly,  
  
A.M. Laidlaw,  
Commissioner of Patents