DECISION OF THE COMMISSIONER

UNOBVIOUS: Prior Art Teaches Substances To Be Ineffective.

New claims submitted to replace claims under rejection allowable. Obviousness cannot be established merely by a citation specifically teaching that a process would be ineffective.

FINAL ACTION: Modified claims allowable

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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 30, 1971 on application 985,785. This application was filed in the name of Wolfgang Friemel and refers to "Method Of Making Magnesium Phosphide". The Patent Appeal Board conducted a hearing on May 24, 1972, Mr. G.C. Clark represented the applicant.

In the prosecution terminated by the Final Action the examiner rejected the claims of the application in view of prior art. The prior art cited is as follows:

German Patent

736,700 June 28, 1943 Schotte

In the Final Action the examiner stated in part:

> The rejection of claim 1 to 20 for lack of invention in view of the reference cited is maintained. German Patent 736,700 discloses on page 1 lines 1 to 15 that the problem of reacting magnesium metal and red phosphorus in a controlled manner is recognized. It further teaches that attempts have been made to overcome this problem by employing such diluents as magnesium oxide, magnesium carbonate and ammonium chloride. A common commercial form of magnesium oxide or magnesium carbonate is a light powder having an unpacked weight under 350 g./l. and it is likely that such a powder was employed in the experiments described.

> Claim 1 is refused, too, as anticipated by the reference patent wherein it teaches the use of such diluents as magnesium oxide. It is admitted that the present applicant claims to have employed such materials successfully whereas the reference teaches that these materials were substantially ineffective. However, because claims such as 4 and 6 are directed simply to the use of the known materials and fail to include such new restrictions as may be necessary to make the process successful, these claims are refused as failing to distinguish over the German patent.

In applicant's response of February 29, 1972 he submitted a new set of claims in an attempt to avoid all the objections of the examiner in the Final Action. The applicant also indicated, specifically at the hearing, that he was not interested in the claims presently on file in the application and indicated that there were only two objections outstanding with respect to the new claims; these are anticipation and obviousness.

The applicant discussed at length how the new claims overcome the objections of the examiner and stated in part:

> Concerning obviousness, it is also believed that the fresh claims define a patentable invention. Indeed it is not seen how a broad statement indicating that certain diluents <u>are not substantially effective</u>--which for practical purposes must mean to the skilled man that they will not work--to make a reaction less violent can be said to render obvious a claim directed to the use of those same or similar diluents provided that they have a bulk weight below a certain specified level. The Examiner indicated in the final action that a common commercial form of magnesium oxide or magnesium carbonate is a light powder having an unpacked weight of under 350 grams per liter and that it is likely that such a powder was employed by Schotte. It is believed that this assertion is unjustified. Our reaction is that obviously such a powder was not used and our position is supported by the statement concerning lack of substantial effectiveness in Schotte when read in conjunction with the examples of the present disclosure. Example 1 probably gives the worst results concerning violence of reaction but even here the reaction is described only as violent with white flame. The processes of the remaining examples proceed well and in some cases calmly. The lowest yield of phosphide is 62% and many of the yields are over 70%.

In view of the fact that the applicant has declared no interest in the claims presently on file the Board will not consider these claims and assumes that they did not overcome the objections of the examiner on the grounds stated in the Final Action.

The reference to Schotte discloses on page 1 "The only known method of producing magnesium phosphide is the direct reaction of magnesium with phosphorus. The reaction of the mixture is not possible in open apparatus...known diluents such as magnesium oxide, magnesium carbonate and amonium chloride are not substantially effective".

It is taken as settled that, for a prior patent to constitute an anticipation, it must disclose the same or give information equal in practical utility to that given by the patent in question (Baldwin v. Western Electric, (1934) S.C.R. 94 at 103). In considering new claim 1 it is found that the subject matter of this claim is not anticipated by the reference. The restriction regarding the particular size of the reaction retardants listed in group (a) of the claim is not taught by the reference. If claim 1 is entered all other new claims will include its subject matter either directly or indirectly.

It is also held that the process of new claim 1 is not obvious in view of the applied reference because the compounds of part (b) of this claim are not mentioned in the Schotte patent, and because Schotte states that magnesium oxide, magnesium carbonate, ammonium chloride etc. are not substantially effective. In a similar case, Nestle's Products Ltd.'s application 1970 R.P.C. 4, Mr. Justice Lloyd-Jacob stated: "I am unable to accept that an allegation of obviousness of a process can be established merely by the citation of a document which contains specific teaching that such a process would be ineffective".

The Board is satisfied that the new claims overcome the objection of the examiner on the grounds stated in the Final Action and recommends that the claims on file be refused.

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

I concur with the findings of the Patent Appeal Board and refuse to grant a patent for the claims on file in this application. The prosecution of the application will proceed when the new claims are officially entered. 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 1st day of June, 1972.

Agent for Applicant

Messrs. Fetherstonhaugh & Co.
Ottawa, Ontario.