

DECISION OF THE COMMISSIONER

STATUTORY S. 2(d): Apparatus Involving Mental Step By Its Operator

A claim for an apparatus involving "means-plus-function" elements does not include its operator and the exercise of human judgement as an essential part as held in the Final Action. However, directing such a claim to a "closed-loop system" may be misleading and amendment suggested.

FINAL ACTION: Overruled

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated February 9, 1972 on application 070,479. This application was filed in the name of John Wildberger and refers to "Manual Reference Input System For Process Computer". The Patent Appeal Board conducted a hearing on May 11, 1972. Mr. A. Nelson represented the applicant.

In the prosecution terminated by the Final Action the examiner refused the claims of the application under Section 2(d) of the Patent Act as being outside the statutory field of invention.

(The Decision quotes two paragraphs of the Final Action).

In the response of April 3, 1972 the applicant stated in part:

In this Final Action, the Examiner rejected Claims 1 to 6 for the reason stated in the third paragraph, which paragraph reads as follows:

"In order that the system claimed in claims 1-6 may be put into practice, it is necessary that a computer operator exercises human judgement."

Then, in the following paragraph he justifies his reasoning by quoting from the disclosure and commenting on these quotations. What he says here is true; certainly operating equipment constructed according to the invention claimed would require considerable skill on the part of an operator.

This also holds true for many other types of equipment on which apparatus claims are granted regularly. For example, operating a novel adding machine covered by apparatus claims could well require a great deal of skill by the operator, particularly if the machine is to be put to its best use. In other words, the mental and physical skill of the adding machine operator provides the link which makes the use of the invention successful. In the case of the invention disclosed in this application, the operator certainly is an important link in making effective use of it.

If the Applicant were claiming a process setting out the manipulative steps that an operator would follow in using the apparatus to control a manufacturing operation, it is agreed that the process would involve mental judgement on the part of the operator. However, the claims in the application are not directed to a process, but to apparatus. Nowhere in the claims is there any positive recitation of an operator performing manipulative steps.

This application relates to "Manual Reference Input System For Process Computer". (The Decision quotes claim 1).

It is noted that the claims are rejected under Section 2(d) of the Patent Act, and more specifically: "In order for the system claimed in claims 1-6 to be put into practice, it is necessary that a computer operator exercise human judgement".

Having studied the prosecution of the application it appears that claim 1 has been interpreted by the examiner to read, with reference to the system, as a closed loop system and that the operator is a necessary part of that system. The Board disagrees with this interpretation for the following reasons.

It is noted that the system set out in claim 1 includes components designated as follows: manual reference input program 19, systems program 12, regulator program 14, output program 15, scan program 16 and display program 20.

The claim is written in the form of a combination comprising "Means-plus-function elements", and it is well settled that this is a proper form of claim if it is unambiguous and meets the requirements of Section 36(2) of the Patent Act. Further, it has been established that the claiming of "means-plus-function elements" in an apparatus do not necessarily embrace a human being as an essential part of the claim. However, if the Board had to consider a process setting out manipulative steps that an operator would follow in using such an apparatus to control a manufacturing operation, then the rules which apply to the consideration of mental steps would govern.

Notwithstanding, the Board agrees with the examiner that the preamble to the claim with respect to the system might be misleading, and therefore it is recommended that claim 1 be amended to read: "In a process control computer comprising..." (or the equivalent). It is also suggested that the 4th line of claim 2 be amended to read: "...detector for signalling or displaying the malfunction...", and that the last six words of claim 3 be deleted.

The Board is satisfied that there is no basis for the objection on the grounds that the judgement of the operator forms part of the apparatus as claimed, but simply relates to that part of the disclosure covering the operation of the apparatus.

The Board recommends that the decision of the examiner, to refuse the claims of the application on the grounds stated, be withdrawn.

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

I concur with the findings of the Patent Appeal Board and withdraw the Final Action. The application is returned to the examiner for further prosecution.

Decision accordingly,

A.M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 29th day of May, 1972.

Agent for Applicant

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