

DECISION OF THE COMMISSIONER

UNOBVIOUS: No prior art cited.

STATUTORY PROCESS: Mere instructions distinguished.

Objections on the grounds of obviousness in the absence of prior art cannot be sustained. It is the whole process put forth as the invention that is considered, which need not show more than one inventive step in the advance made beyond the prior limits of the relevant art. Since no objection has been taken against the apparatus claimed and since an applicant is entitled to claim his invention in different ways, a method claim properly drawn to the invention may also be considered for allowance.

FINAL ACTION: Overruled.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated February 1, 1972 on application 006,177. This application was filed in the name of Herbert F. Wheaton et al and refers to "Capping Conversion Apparatus and Method". The Patent Appeal Board conducted a hearing on June 15, 1972. Mr. G. Seaby represented the applicant.

In the prosecution terminated by the Final Action the examiner refused claims 1, 2 and 8 in that they lack subject matter and inventive ingenuity.

(The decision quoted part of the Final Action which argued that the method claimed is "in essence merely an assembly instructing to be followed" which lies within the exercise of expected skill; and that the apparatus cannot carry out the method as it is the operator who interchanges the parts of the apparatus.)

In the applicant's response of May 1, 1972 he asked for reconsideration of the rejected claims on the grounds of obviousness in any rejection on obviousness must be judged with respect to the state of the art; however, no art was cited. The applicant also objected to the examiners contention that the steps of the method lie within the exercise of expected mechanical skill. (The decision quoted part of the applicants argument.)

This application refers to an improved method and apparatus for applying closures to containers and is particularly concerned with the ready conversion of automated bottling operations from the use of one type of closure can to another.

Claim 1 reads as follows:

The method of converting standard bottle crowning equipment from the application of crown type closures to the application of tear off type closures wherein said standard bottle crowning equipment includes a rotatable crowning turret incorporating a plurality of reciprocating plunger units each of said units including a crowner cylinder within which is mounted

a hollow internally threaded work imparting shaft comprising the steps of threadably (sic) engaging a crimping head to said work imparting shaft, and effecting random rotational orientation of said crimping head relative to said shaft, applying tear off type closures to containers with said crimping head, threadably detaching said crimping head from said shaft, securing a crowning head to said shaft and effecting predetermined fixed rotational orientation of said crowning head relative to said shaft and applying crown type closures to containers with said head whereby interchangeable application of tear off type closures and crown type closures is effected.

As of interest to the circumstance and issue to be decided in the present case, the court in N.R.D.C.'s Application (1961) RPC 135 set forth the following: "If a person finds out that a useful result may be produced by doing something which had not been done by the procedure before, his claim for a patent is not validly answered by telling him that although there was ingenuity in his discovery and that the materials used in the process would produce the useful result, no ingenuity was involved in showing how the discovery, once it has been made, might be applied. The fallacy is in dividing up the process that he puts forward as his invention. It is the whole process that must be considered; and he need not show more than one inventive step in the advance which he has made beyond the prior limits of the relevant art."

Having studied the application and its prosecution, the Board is satisfied that the applicant is entitled to method claims if such claims can be drawn to represent the invention as indicated by the allowable claims.

It is normal practice to allow more than one claim in an application of substantially the same breadth, but couched in different language, such as method and machine claims, provided that each claim stands on its own and complies with Section 36(2) of the Patent Act. Properly worded method and apparatus or machine claims may be set out as covering but two aspects of the same invention. It is also well settled that reasonable latitude is allowed an applicant in setting out his invention in the claims.

Furthermore, in view of the fact that no objection has been taken to the allowance of the claims to the apparatus, it follows that a method claim, if properly drawn to the inventive features, may be considered for allowance. However this is not to be confused with those cases in which novelty resides in mere assembly instructions to use or operate a known apparatus; for any allowable process must contain limitations characteristic of a new and unobvious advance over the art and may rely on novel material limitations to which its procedural steps are applied or in novel variations of the steps per se. It is the whole process which must be considered and only one inventive step over the prior art need be shown.

The applicant has objected to the fact that no prior art was cited to show lack of subject matter or obviousness, however

attention was directed to the evaluation of the state of the art found at pages 1 and 2 of the disclosure which shows that the concept of changeover by using interchangeable assemblies in bottling machines for the purpose of securing different types of closure caps to containers is well known in the art.

However, it is evident that prior to the present invention the common procedure to convert the machine to apply different cans has been to disassemble the complete crowner mechanism including the capping mechanism. The present invention is designed to convert standard bottle crowning equipment to the application of tear off closures without the necessity of disassembling the crowner mechanism as well as the capping mechanism. No prior art has been cited to support the examiner's contention that this is an obvious step, and the Board is satisfied that the grounds of obviousness in the absence of pertinent prior art cannot be sustained.

In the present case, in which, "The invention relates to an improved method and apparatus ... and is particularly concerned with the ready conversion of automated bottling operations ...," the Board is satisfied that a claim drawn in terms of a method directed substantially to the invention as set out in apparatus claim 7, which is indicated as allowable, may be considered for allowance in this application. However, the Board is of the opinion that apparatus claim 3 does not set out the interchangeable feature which appears to be the basis of the invention, and that method claims 1, 2 and 8 may not fully comply with Section 36(2) of the Patent Act.

The Board recommends that the decision of the examiner, to refuse the claims on obviousness, be withdrawn and that the application be returned to the examiner for further examination according to the guidelines set forth herein.

J.F. Hughes,
Acting Chairman,
Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and withdraw the Final Action and return the application to the examiner for resumption of prosecution.

Decision accordingly,

A.M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 30th day of June, 1972.

Messrs. Marks & Clerk,
Box 957, Station B,
Ottawa, Ontario
K1P 5S7