COMMISSIONER'S DECISION

REISSUE: Lack of Intent to Claim; No mistake; Prior Art Known Before Original Allowed.

No evidence was apparent to doubt that the statement that the applicant was unaware that he should amend his patent until several years after the prior art was known, or that the applicant has not acted in good faith or did not intend to claim the present subject matter.

FINAL ACTION: Overruled.

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This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated May 3, 1972 on application number 096,160. This application was filed in the name of Sandvikens Jernverks Aktiebolag and refers to "Threaded Drill Rod Element".

In the prosecution terminated by the Final Action the examiner rejected the application for reissue on the following grounds (reproduced in reduced form):

(a) The applicant failed to satisfy the Office that he was not aware of the teachings of United States prior art before issue of the Canadian Patent.

(b) The applicant's failure to see the necessity of limiting the claims of his Canadian application does not constitute an error arising from inadvertence, accident or mistake.

(c) The fact that the prior art was cited in opposition proceedings was sufficient to alert the applicant that the teachings of the prior art may be pertinent to the claims in his Canadian application.

(d) The petition is therefore rejected for lack of intent to claim the subject matter now claimed since his failure to limit the claims to clear the prior art did not arise from inadvertence, accident or mistake as defined by Section 50 of the Patent Act.

The petition reads as follows (in part):

(1) That Your Petitioner is the patentee of Patent No. 745,931 granted on the 8th day of November 1966 for an invention entitled "Threaded Drill Rod Element".

(2) That the said Patent is deemed defective or inoperative by reason of insufficient description or specification and by reason of the patentee having claimed more than it had a right to claim as new.

(3) That the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention in the following manner:

(a) Your petitioner is a company having its place of business in Sandviken, Sweden. The patent division of the company translated the basic Swedish application No. 6534/64 into English from the original Swedish text. Your Petitioners Patent agents filed the translated application on May 26th,

1965 and it matured to Patent No. 745,931 on November 8th, 1966.

(b) However, the translation effected in Sweden inadvertently included numerous grammatical errors and improper choices of technical terminology resulting in the disclosure and claims being vague and indefinite in some aspects and without any fraudulent or deceptive intention, your Petitioners Patent agents prosecuted the application to patent failing, at the time, to comprehend and claim the invention properly in view of such errors.

(c) Your Petitioner intended to claim the thread profile of Patent 745,931 in external and internal form thereby using the wording "external or internal" in line 1 of claim 1. This resulted in a vague definition of details of the thread profile as the external thread has concave flanks and the internal thread has convex flanks. Due to differences between Swedish and Canadian patent practice, Your Petitioners Swedish patent department failed to properly claim the two profiles of thread.

(4) That knowledge of the new facts stated in the amended disclosure and in the light of which the new claims have been framed was obtained by your Petitioner on or about May, 1969 in the following manner:

(a) Opposition proceedings which are still pending were taken against the basic Swedish application in April 1966 but the patent division of your Petitioning company did not reply to the proceedings until September 1966 after the Canadian application had been allowed. The Swedish opposition proceedings brought to light U.S. Patent No. 2,052,011 of August 25th, 1936 (Class 225 - 64) which was not located by Your Petitioners Patent agents of record during prosecution of the Canadian application No. 931,611 nor during the prosecution of the corresponding U.S. application, now U.S. Patent No. 3,388,935 of June 18th, 1968 by your Petitioners U.S. patent attorneys.

(b) An examination of U.S. Patent No. 2,052,011 showed that it had a similar type of thread as that in Your Petitioners Swedish application and Canadian Patent inasmuch as it shows in Figure 2 a thread profile having a flat trough 4'. Your Petitioner, in examining his other Patents including Canadian 745,931 found that the term "bevelled crest" appearing in Canadian Patent 745,931 was wrong and that the patent was therefore defective.

(c) Additionally it was also found that the claims in Canadian Patent 745,931 did not include limitations essential for distinction of the invention over the prior art, namely U.S. Patent 2,052,011.

(d) Your Petitioner did not at that time realize the necessity of limiting the Canadian Patent 745,931 and it took several years of experience with the opposition proceedings in Sweden to find the proper manner of defining the thread profile over the prior art.

(e) Between October 1968 and May 1969 Your Petitioners Patent agents reviewed Patent 745,931 in view of U.S. Patent 2,052,011 and as a result it was considered that the patent was defective and inoperative because of the

abovementioned errors and mistakes. It was, however, the original intent of your Petitioner that proper English phraseology, technical terms and claim limitations be used so that the disclosure and claims should read in accordance with the amendments made hereto but the applicant failed to do so by reason of the errors that rose from inadvertence, accident or mistake and the failure of Your Petitioners Patent agents to properly comprehend the invention at the time of filing and prosecution.

In the applicant's response of August 2, 1972 he stated in part:

(a) The final action dated May 3, 1972 rejects the reissue application "for lack of intent to claim the subject matter now claimed since his failure to limit the claims to clear the prior art did not arise from inadvertence, accident or mistake, as defined by Section 50 of the Patent Act". The prior art referred to is United States Patent 2,052,011 which was first notified to applicant in opposition proceedings involving applicant's corresponding Swedish application but which was not studied carefully by applicant in relation to its bearing on the claims of applicant's Canadian patent 745,931 until the opponent in the said opposition proceedings, at a hearing on October 6, 1968, asserted a construction of its teachings which, if accepted, would give patent 2,052,211 a broader anticipatory value than applicant had previously regarded it as having.

(b) The possibility of patent 2,052,011 being afforded such construction (which construction applicant did not accept and does not now accept) led applicant to review inter alia its Canadian patent 745,931 to consider the effects of such possible construction of United States patent 2,052,011 and it was in the course of such review that it became apparent that the claims of the Canadian patent were defective in a way which not only would raise a question of anticipation by United States patent 2,052,011 if it were afforded such construction, but also because of an inaccuracy of wording which extended the scope of the claims to cover thread structures which were not included in what applicant regarded to be his invention.

(c) Had applicant been aware that the claims which were granted in patent 745,931 incorrectly described what he regarded as his invention he would have amended said claims even in the absence of knowledge of United States patent 2,052,011. It was the bringing home to applicant of the fact that claims 1-3 of patent 745,931 covered more than he was entitled to claim as his invention (which resulted from review triggered by the assertion of the opponent in the Swedish opposition of an untenable construction of United States patent 2,052,011 in 1958) which moved applicant to seek reissue rather than mere knowledge of the existence of United States patent 2,052,011 or its teachings which teachings do not amount to an anticipation of claims 1-3 of patent 745,931, nor the claims submitted in this reissue application. If the fact that claims 1-3 of patent 745,931 extended to more than applicant had a right to claim as his invention had been in the applicant's mind (i.e. if applicant has realized then what he realized later as a result of the review referred to) applicant, if he had intended the claims of his patent to cover more than he had a right to claim as his invention, would not have felt called upon to limit his claims by reason only of prior teachings of patent 2,052,011. The point here is that in order to suggest, as the final action appears to suggest, that the applicant intended to adopt the wording of claims 1-3 because he was aware in 1966 of the existence of United

> States patent 2,052,011 is to suggest that applicant deliberately sought to obtain an invalid patent in circumstances where it was perfectly open to him to obtain a valid patent. Such a suggestion is not only unwarranted but contrary to all reason as well as being contrary to the facts asserted in the petition for reissue and which are affirmed by affidavit.

Having studied the prosecution of this application the Board finds that the main questions to be decided are whether or not the petition should be rejected for lack of intent to claim the subject matter now claimed and whether it appears that the error arose from inadvertence, accident or mistake as defined by Section 50 of the Patent Act.

This application refers to threadably coupled drill rod elements and the like. Amended claim 1 reads as follows:

> Drill rod coupling for percussion drilling comprising a threaded rod and a matching threaded sleeve and being of the type suitable for connecting rods for percussion drilling, said threads having a relatively high pitch and a generally wave-shaped profile, the threads being adapted to respond to a low disconnection torque and to provide a high fatigue strength and having the following features in combination:
>
> (a) the threads have at least two starts,
>
> (b) the flank angle of the rod thread between the flank and a normal to the drill rod axis has a minimum in the vicinity of the crest of the rod thread, where it is 50-60°,
>
> (c) the flank angle of the rod thread increases gradually from said minimum towards the bottom of the thread, a substantial portion of the flank comprising the base portion thus having a concave shape and the radius of which is at least as great as the depth of the thread,
>
> (d) the flanks of the threads are symmetrical and inclined equally with regard to said normal,
>
> (e) the crests of the rod threads are beveled and have a profile substantially parallel to the drill rod axis, and
>
> (f) the crests of the rod threads are spaced from the bottoms of the matching sleeve threads.

It is noted that this is a more restricted claim than any claim in the original patent; therefore, there is no question of attempting to recoup abandoned subject matter, or whether the reissue is not in the public interest.

This application was filed May 26, 1965, after it had been translated from the basic Swedish application, and was allowed August 2, 1966 and issued to patent November 8, 1966. Opposition proceedings were taken against the Swedish application in April 1966 and a response was made to these proceedings in September 1966. The Swedish opposition proceedings

brought to light United States patent 2,052,011 which issued in August, 1936.

The Final Action contends that, since the applicant was aware of the United States patent 2,052,011 before the original application was allowed, the only recourse was amendment during the prosecution of the original application. But the applicant states that the Swedish opposition, from the beginning, did not contain anything that looked anticipating, and that the illustrations of this patent clearly distinguished from his invention.

The Board find that no reason is evident on which to doubt the applicant's statement that: "It was not until several years later, 10.6 1968, that our opponents pointed out a passage in the text which in his opinion referred to a not illustrated embodiment that would be closer to our invention. We have since taken the position that the said passage is so obscure that it cannot be regarded as an anticipating teaching." (emphasis added)

Consequently, in the opinion of the Board it was not until 1968 that the applicant became aware that he should more clearly define his invention and that he had claimed more than he intended to claim as new.

The Board, therefore, is satisfied that the applicant acted in good faith and has met the intention of Section 50 of the Patent Act with respect to inadvertence, accident or mistake. Also, there is no indication that the applicant did not intend to claim the presently claimed subject matter. Moreover, it is in the public interest that the patent be amended with claims of a more restricted nature.

The Board recommends that the decision of the examiner, to refuse the petition, be withdrawn.

R.E. Thomas
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.

A.M. Laidlaw
Commissioner of Patents

Dated at Ottawa, Ontario,
this 12th day of September, 1972.

Agent for Applicant

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