

DECISION OF THE COMMISSIONER

STATUTORY - S.2(d): Process and its Product Comprising Living
Microorganism

Process and its product for the production of a composition associating a new attenuated strain with a carrier is not excluded because of the association of living microorganisms.

FINAL ACTION: Overruled.

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 911,153. This application was filed in the name of Herbert W. Smith and refers to "Vaccines".

In the prosecution terminated by the Final Action the examiner refused the application for reasons, first that the claims are directed to a composition of an amended living microorganism with a carrier, and the formation of the said composition does not represent a patentable invention according to Section 2(d), and secondly that the association of the said microorganism with a carrier is not a patentable process since there is no invention in the step of "association" or "dilution".

At the outset the examiner was following Office policy with respect to living matter when the Final Action was written. However, this rejection is withdrawn in view of a change in policy as set out in a recent Commissioner's Decision which held that processes and the products thereof in the microbiological field are not excluded from patentability under Section 2(d) of the Patent Act provided the prerequisites of novelty, unobviousness and, more particularly, utility are satisfied.

With respect to the second ground of rejection, "... that the association of said microorganism with a carrier is not a patentable process since there is no invention in the step of association or dilution.", claims 9-14 inclusive were refused without further explanation. First, the specification must be analysed with respect to the state of the relevant prior art, to decide where the invention lies, for this will aid in the determination of what form of claims will be allowed.

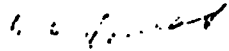
This invention relates to a vaccine composition and the process of making the composition. Claim 9 reads as follows:

A process for the production of a vaccine composition comprising associating the attenuated strain of Salmonella choleraesuis having the reference number A.T.C.C. 15478 with a pharmaceutically acceptable diluent.

Having studied the application the Board takes note of the applicant's response of February 4, 1971, "... the process starts with a new product because the attenuated strain that is employed has been produced by the applicant for the first time and the resulting composition is also new.", to which no objection has been made.

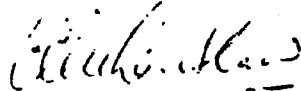
Once this fact is established the Final Action on the second ground of rejection appears to be directly contrary to the teaching of the Supreme Court in the Commissioner of Patents v. Ciba Limited (1959) S.C.R. 378, 272 C.P.R. 82. In this decision it was held that the process was patentable because it started with a new material and produced a new and useful product or in other words the discovery of "utility" in a chemical compound was sufficient to entitle the inventor to a patent for the product and the process whereby it was manufactured.-

In the circumstance, therefore, the Board is satisfied that if the vaccine composition is patentable, to which no objection has been taken, there should be no objection to the process whereby it is manufactured, and recommends that the Final Action be withdrawn.


/s/ 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.

Decision accordingly,


A. M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario,
this 8th day of November, 1972.

Agent for Applicant

Eastman-Kodak Company